

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Amplifier Technologies, Inc. )  
  )  
    Opposer,                      )  
  )  
    v.                                  )  
  )  
Audio Technologies              )  
    Incorporated,              )  
  )  
    Applicant.                      )  
  )

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Opposition No. 91152553  
Serial No.: 75/264,786

Mark:          ATI-AUDIO TECHNOLOGIES INCORPORATED  
Goods:        Professional audio products

**OPPOSER'S BRIEF RESPONDING TO APPLICANT'S MOTION TO DISMISS**

Opposer, Amplifier Technologies, Inc., requests that the Trademark Trial and Appeal Board deny the Motion to Dismiss brought by Applicant, Audio Technologies, Inc., and submits this brief in response to Applicant's motion.

I. FACTUAL BACKGROUND

Opposer, Amplifier Technologies, Inc., (hereinafter “Amplifier Technologies” or “Opposer”) commenced use of its mark ATI-AMPLIFIER TECHNOLOGIES INC. at least as early as 1995 in connection with “audio and video system components for consumer audiophile and home theater use.” Amplifier Technologies filed an application to register its mark on June 10, 1999. The Examining Attorney refused registration of Amplifier Technologies mark based upon a perceived likelihood of confusion with the mark ATI-AUDIO TECHNOLOGIES INCORPORATED, Serial No.: 75/264,786, owned by Applicant, Audio Technologies, Inc. (hereinafter “Audio Technologies” or “Applicant”).

Amplifier Technologies then approached Audio Technologies regarding an agreement between the companies regarding use and registration of their respective marks. Although the parties did not reach an agreement, Audio Technologies agreed that confusion between the marks was unlikely and noted in writing that Audio Technologies’ target markets and channels of trade were different from those of Amplifier Technologies. Amplifier Technologies submitted the statement by Audio Technologies to the Examining Attorney, who still maintained the likelihood of confusion objection. Amplifier Technologies then filed this Notice of Opposition on July 30, 2002.

Also, Applicant admits in its Brief that “Audio Technologies uses the mark ATI Audio Technologies Incorporated to identify Applicant’s *professional* audio products for *studio and sound reinforcement applications*. . . .”

## II. LEGAL ANALYSIS

### A. The Motion to Dismiss Should be Denied Because Applicant Properly Has Stated a Claim Upon Which Relief Can Be Granted Pursuant to Rule 12(b)(6).

#### 1. Applicable Standard on a Motion to Dismiss

As stated by the Trademark Trial and Appeal Board, a motion to dismiss for failure to state a claim upon which relief may be granted is a test “solely of the legal sufficiency of the plaintiff’s pleadings.” Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd., 22 U.S.P.Q.2d 1594, 1597 (T.T.A.B. 1992). To successfully withstand a Motion to Dismiss, a plaintiff’s pleading (opposer in a opposition proceeding) need only to allege such facts as would, if proved, establish that the opposer is entitled to the relief sought. See Abbott Laboratories v. Brennan, 952 F.2d 1346, 1354 (Fed. Cir. 1991). A Motion to Dismiss an opposition should be denied if (1) the plaintiff has standing to maintain the proceeding and (2) a valid ground exists for denying the registration sought therein. See Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 1026 (C.C.P.A. 1982).

Audio Technologies has not challenged Amplifier Technologies’ standing to maintain the proceeding. The only issue is whether Amplifier Technologies has set forth a statutory ground for opposition.

#### 2. Opposer Asserts a Valid Statutory Basis for Opposition under 15 U.S.C. §1063.

The notice of opposition, taken as a whole, must be liberally construed in the light most favorable to opposer and may not be dismissed absent a finding that opposer could prove no set of facts based on the notice of opposition that would yield the relief sought. Universal City Studios Inc. v. Cleveland Museum of Natural History, 39 U.S.P.Q.2d 1382 (T.T.A.B. 1996), citing Scotch Whisky Assoc. v. United States Distilled Products Co., 952 F.2d 1317, 21 U.S.P.Q.2d 1145 (Fed. Cir. 1991) (emphasis added).

Amplifier Technologies has established a valid statutory basis for opposition--whether Applicant has the exclusive right to register the mark in such a broad manner as to encompass Opposer's goods and its trade channels, namely "audio and video system components for consumer audiophile and home theater use." Amplifier Technologies has alleged in its Notice of Opposition that Audio Technologies' has not used its mark in Opposer's trade channels and, thus, that such trade channels should not be encompassed by Audio Technologies' description of goods in its application.<sup>1</sup>

Based on current information and the current status of this opposition and for purposes of Applicant's Motion, the following, if proven, will entitle the Opposer to the relief sought:

(1) There is no likelihood of confusion between Opposer's mark when used in connection with "audio and video system components for consumer audiophile and home theater use" and Applicant's mark when used in connection with "professional audio products for studio and sound reinforcement applications, namely audio consoles, audio splitters, microphones and line drivers, mixers, headphone drivers and meters" when restricted by "not for consumer audiophile and home theater use." (Applicant has admitted that confusion is unlikely because the parties offer different goods, which are in different channels of trade and offered to different target markets.<sup>2</sup>)

(2) The Patent and Trademark Office has taken the position that confusion is likely if Applicant's description of goods is not limited by "not for consumer audiophile and home theater use." (Based on Applicant's present description of goods, the Examining Attorney

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<sup>1</sup> Amplifier Technologies' statutory ground for opposition is analogous to a request for partial cancellation on the grounds of abandonment of the mark as to the trade channels sought to be excluded from a registration under 15 U.S.C. § 1064. See Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG, Spezialfabrik Fur Reitbekleidung, 34 U.S.P.Q.2d 1266 (T.T.A.B. 1994).

<sup>2</sup> Audio Technologies wrote to Amplifier Technologies that Audio Technologies was not in the "consumer electronic business" and that "there should be no confusion in commerce and trademarks." See Exhibit A.

has suspended Opposer's application finding that confusion may be likely with Applicant's application if it matures to registration.)

(3) The basis for the Patent and Trademark Office's position is that Applicant's present recitation of goods in its application encompasses Opposer's recited goods. (See comment to (2) above).

(4) If the description of Applicant's goods is restricted to recite "not for consumer audiophile and home theater use," the Examining Attorney should remove Opposer's application from suspension and permit it to proceed because Audio Technologies' application no longer should be considered an obstacle to registration of Opposer's application. See 15 U.S.C. §1068 and *Euro-Star, Inc.*, *supra* at footnote 1.

Thus, if Opposer's showing with respect to items (1)–(4) above is sufficient to carry its burden, then Opposer would be entitled to the relief requested in its Notice of Opposition, namely, that Applicant be required to restrict the description of goods in its application as requested in the Notice of Opposition, relief that is specifically provided by 15 U.S.C. § 1068.

Accordingly, Amplifier Technologies respectfully submits that it could prove sufficient facts based upon the Notice of Opposition to obtain the relief sought and that Audio Technologies has not met the high burden necessary to support a Motion to Dismiss.

B. Applicant's Motion Should Be Treated as a Motion for Summary Judgment

Finally, to the extent that Applicant's motion under Rule 12 (b)(6) presents matters outside Opposer's Notice of Opposition, Rule 12 (b)(6) provides that the motion shall be treated as one for summary judgment and disposed of as provided in Rule 56, and all parties shall be given reasonable opportunity to present all material made pertinent to such a motion by Rule 56.<sup>3</sup>

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<sup>3</sup> Opposer respectfully submits, however, that if this Motion is treated as a Motion for Summary Judgment, it should be denied as not appropriate at this stage in these proceedings.

For example, Applicant's brief argues that Audio Technologies' first use is 1979. However, Opposer Amplifier Technologies alleges that Audio Technologies has not used its mark in the consumer audiophile field so that there is an issue of priority and exclusivity with respect to Applicant's use in Opposer's channels of trade.

III. CONCLUSION

For the foregoing reasons, Amplifier Technologies respectfully requests that Audio Technologies' Motion to Dismiss be DENIED.

Respectfully submitted,

Amplifier Technologies, Inc.

Date: October 9, 2002

By:



Frank J. DeRosa, Esq.

Monica B. Richman, Esq.

Brown Raysman Millstein Felder & Steiner, LLP

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New York, New York 10022

(212) 895-2014

Attorney for Opposer

EXHIBIT A



AUDIO TECHNOLOGIES INCORPORATED  
Dedicated to sound engineering

FACSIMILE TRANSMITTAL

TO: Mike Portello  
Amplifier Technologies, Inc.

DATE: 1 February 2001

FROM: Sam Wenzel - ATI

PAGE 1 of 1

SUBJECT: Trademarks

Dear Mike:

We do not yet have trademark approvals, therefore signing an agreement at this time is premature.

We have no problem with the proposed agreement submitted, however, feel that a paragraph which specifically addresses the markets each of our company sells to should be incorporated by your lawyer into the agreement thereby showing no conflict of commerce.

Audio Technologies, Incorporated - ATI's areas of commerce are Broadcast, Professional Audio, and Communications. We are not in the consumer electronics business. After looking at your website, it is our understanding that your area of commerce is the consumer, audiophile, and principally home theatre applications, therefore there should be no confusion in commerce and trademarks.

If you have any questions or know any more about the status of the trademarks, please contact me.

Please give me your comments.

Very truly yours,

ATI - AUDIO TECHNOLOGIES, Inc

Samuel B. Wenzel  
President

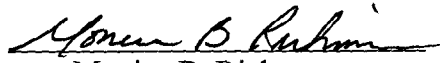
SBW/lcc

**Certificate of Service**

The undersigned hereby certifies that a copy of the foregoing Opposer's Answer to Applicant's Motion to Dismiss in connection with Opposition No. 91152553 has been served upon the attorney for Applicant on October 9, 2002, by depositing same in the United States Mail, first class postage prepaid, in an envelope addressed as follows:

STEPHAN P GRIBOK  
DUANE MORRIS & HECKSCHER LLP  
1 LIBERTY PL  
PHILADELPHIA PA 19103-7396

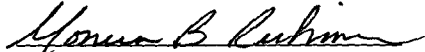
Dated: October 9, 2002

  
Monica B. Richman



**Certificate of First Class Mailing**

I hereby certify that this Opposer's Answer to Applicant's Motion to Dismiss in connection with Opposition # 91152553 is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Box: TTAB No Fee, Assistant Commissioner for Trademarks, 2900 Crystal Drive Arlington, Virginia 22202-3513 on October 9, 2002.

By:   
Monica B. Richman

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10-15-2002

Attorney Ref. No. 10246/01

U.S. Patent & TMOfc/TM Mail RcptDt. #26

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Serial No.: 75/264,786

Mark: ATI-AUDIO TECHNOLOGIES INCORPORATED  
Goods: Professional audio products

**OPPOSER'S ANSWER TO APPLICANT'S MOTION TO DISMISS**

Opposer, Amplifier Technologies, Inc., pursuant to 12(b)(6), Fed.R.Civ.P., requests that the Trademark Trial and Appeal Board deny Applicant's Motion to Dismiss on the grounds that Opposer has alleged such facts as would, if proved, establish that Opposer is entitled to the relief sought. Opposer bases its position upon the reasons and legal authorities set forth in the accompanying Opposer's Brief Responding to Applicant's Motion to Dismiss.

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TRADEMARK TRIAL AND APPEAL BOARD

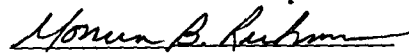
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Respectfully submitted,

Amplifier Technologies, Inc.

Date: October 9, 2002

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