

ESTTA Tracking number: **ESTTA309727**

Filing date: **10/05/2009**

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

Proceeding	91190326
Party	Defendant SecurLinx Holding Corporation
Correspondence Address	MICHAEL B. PALLAY STEPTOE & JOHNSON PLLC PO BOX 2190 CLARKSBURG, WV 26302-2190 UNITED STATES trademarks@steptoe-johnson.com
Submission	Reply in Support of Motion
Filer's Name	Michael B. Pallay
Filer's e-mail	trademarks@steptoe-johnson.com
Signature	/Michael B. Pallay/
Date	10/05/2009
Attachments	reply.pdf ( 4 pages )(18289 bytes )

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

TeleTracking Technologies, Inc.,

Opposer,

Opposition No. 91190326

v.

SecurLinx Holding Corporation,

Applicant.

**REPLY IN SUPPORT OF APPLICANT'S MOTION FOR  
PARTIAL JUDGMENT ON THE PLEADINGS**

Opposer improperly includes conclusions of law in its list of “facts” that are deemed to be true for purposes of Applicant’s motion. Contrary to Opposer’s position with respect to several of its “factual” assertions, “[c]onclusions of law are not taken as admitted” when considering a motion for judgment on the pleadings. *Ava Enterprises Inc. v. P.A.C. Trading Group Inc.*, 86 USPQ2d 1659, 1660 (TTAB 2008). Opposer improperly asserts as a “fact” that “[u]se by applicant of the trademark IDTRAC is likely to result in confusion, mistake or deception with Opposer’s TRACKING family of trademarks, or in the belief that applicant or its products /service are in some way legitimately connected with, licensed or approved by Opposer.” (Opp’n to Mot. 3) However, likelihood of confusion is a question of law. *China Healthways Institute Inc. v. Xiaoming Wang*, 491 F.3d 1337, 1339, 83 USPQ2d 1123, 1124 (Fed. Cir. 2007). Therefore, Opposer’s assertion in this regard is not deemed to be true for purposes of Applicant’s motion. Similarly, Opposer’s assertions regarding a lack of abandonment of its marks, a lack of a bona fide intent to use the mark IDTRAC in commerce by Applicant, and the Application being void for various reasons are also legal conclusions and therefore not deemed to be true for purposes of Applicant’s motion.

Opposer raises as an issue of material fact that would preclude judgment on the pleadings the scope of its family of TRACKING marks and whether Applicant's mark would be viewed as a member of said family. (Opp'n to Mot. 5) However, Applicant argues that its IDTRAC mark is so dissimilar to "TRACKING" that their use cannot cause consumer confusion. (Mot. 8) Applicant lists factual dissimilarities between its mark and Opposer's asserted TRACKING family based upon the information contained in the Notice of Opposition. Applicant concludes that there can be no consumer confusion because the dissimilarity is dispositive. Generating a more complete factual record would not be relevant to the ultimate question of consumer confusion given that the striking dissimilarity between Applicant's mark and Opposer's asserted family is dispositive. Judgment on the pleadings is therefore not precluded, and in fact is proper under these circumstances.

Opposer criticizes Applicant's comparison of the marks as being focused on differences between the marks rather than similarities and as being "rigid" and "technical." (Opp'n to Mot. 5-6) Opposer forgets that "[o]ne DuPont factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks." *Ava Enterprises Inc. v. P.A.C. Trading Group Inc.*, 86 USPQ2d 1659, 1660 (TTAB 2008) (emphasis added). Applicant is merely following the law as set forth in *Ava*, and appropriately discusses the dissimilarities of the marks in its Motion. It should also be noted that Applicant does state that the only significant similarity in appearance between the marks is the use of the four letters "TRAC." (Mot. 4)

Opposer also criticizes Applicant for using information that is not part of the pleadings. However, the omission of "K" in Applicant's mark is evident from the pleadings, the inclusion of "ING" in Opposer's TRACKING marks is evident from the pleadings, and the use of

consonants versus vowels is also evident from the pleadings. The fact that the pronunciation of consonants involves a restriction of the breathing channel is part of the definition of consonants, of which the Board may take official notice.

Opposer's criticism that channels of trade and prospective purchasers are issues of material fact that should be more fully evaluated also misses the point of Applicant's argument that a single DuPont factor of dissimilarity of the marks is dispositive.

Finally, Opposer states that "not one of the cases [cited by Applicant] involves a motion for judgment on the pleadings." (Opp'n to Mot. 7) On the contrary, *Ava* clearly involves such a motion. *Ava*, 86 USPQ2d at 1661 ("applicant's motion for judgment on the pleadings pursuant to Fed. R. Civ. P. 12 (c) is granted").

For the reasons discussed in Applicant's motion and herein, Applicant is entitled to judgment as a matter of law based on the pleadings.

Dated: October 5, 2009

Respectfully submitted,

/Michael B. Pallay/

Michael B. Pallay

mike.pallay@steptoe-johnson.com

Michael T. Smith

mike.smith@steptoe-johnson.com

**Steptoe & Johnson PLLC**

P.O. Box 2190

Clarksburg, WV 26302-2190

(304) 624-8000

Attorneys for Applicant

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

TeleTracking Technologies, Inc.,

Opposer,

Opposition No. 91190326

v.

SecurLinx Holding Corporation,

Applicant.

**CERTIFICATE OF SERVICE**

I hereby certify that on the 5th day of October, 2009, I served the foregoing “Reply in Support of Applicant’s Motion for Partial Judgment on the Pleadings” upon the following counsel, by mailing a true and complete copy thereof via First Class Mail, postage prepaid, in an envelope addressed as follows:

Stanley D. Ference III  
Ference & Associates LLC  
409 Broad Street  
Pittsburgh, PA 15143

/Michael B. Pallay/  
Michael B. Pallay