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

Proceeding	91221779
Party	Plaintiff Speck Pumpen Verkaufsgesellschaft GmbH
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OBVIOUS BASIS FOR OPPOSER'S 2(a) CLAIM

Opposer's United States Trademark Registration 998,142 (the "'142 Registration") with use in US. Commerce, of 1970 vintage, and Respondent's United States Trademark and Service Mark 79/138,930 (the "'930 Application), of 2013 vintage, here being opposed, are each and both part of a record of the present Opposition Proceeding.

Each of the '142 Registration and the '930 Application prominently, accurately, and largely display a same GEAR MAN DESIGN, which is very, relevant. Simply looking at the two competing marks show that the Respondent, in '930 Application, is attempting to take and use a GEAR MAN DESIGN of the Opposer in violation of 2(a).

Most SPECK equipment contains operational instructions, testing instructions, repair instructions and the like in English. Yet sometimes the German language is used along with or without the English. So users operators, inspectors, purchasing agents, maintenance people and repair people and do/it/yourself heroes are very well aware of the Opposer's GEAR MAN DESIGN. Equipment and manuals and spare parts need the GEAR MAN DESIGN to assure American Consumers that the goods are indeed from Speck Pump, the Opposer.

LEGAL ARGUMENT IN OPPOSITION TO MOTION TO DISMISS

Citing the Board's decision in *Petroleos Mexicanos v. Intermix S.A.*, 97 USPQ2d 1403 (TTAB 2010), Respondent Winter takes a position that a Notice of Opposition must include allegations that specifically and clearly plead facts required to state a false suggestion of connection claim under Section 2(a). Winter contends that a false suggestion claim is properly pleaded by asserting that (a) the disputed trademark is a close approximation of a name or identity previously used by another person or institution, (b) the disputed mark would be

recognized as such, (c) the disputed mark uniquely and unmistakably points to the other person or institution, and (d) that the fame or reputation of the named person or institution is of such a nature that a connection with the disputed mark would be presumed. (Respondent's motion to dismiss at 2).

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. In order to withstand such a motion, a pleading need only allege such facts as would, if proved, establish that the pleader is entitled to the relief sought, that is, that (1) the opposer has standing to maintain the proceeding, and (2) a valid ground exists for cancellation of the subject registration. *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007) (denying motion to dismiss); *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998). *See also* TBMP §503.02 (2014 rev.) "The pleading must be examined in its entirety, construing the allegations liberally...to determine whether it contains any allegations which, if proved, would entitle plaintiff to the relief sought.", *citing, Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007) (retiring the pleading standard set forth in *Conley v. Gibson*, 355 U.S. 41 (1957) (dismissal for failure to state a claim is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts that could be proved in support of its claim); *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (plausibility standard applies to all federal civil claims); *Caymus Vineyards v. Caymus Medical Inc.*, 107 USPQ2d 1519, 1522 (TTAB 2013) (considering plausibility); *Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780, 1782 (TTAB 2012) (citing *Ashcroft v. Iqbal*, 556 U.S. 662 (2009)); *Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1874 (TTAB 2011) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007)).

To survive a motion to dismiss for failure to state a claim, a complaint must “state a claim to relief that is plausible on its face.” TBMP § 503.02.

There is no requirement, as Winter seems to contend, that all of the pertinent facts must be set forth in a complaint. Indeed, many facts necessary to prove a cause of action often are exclusively in the possession of an opposing party. This is why both the federal rules and the Board’s rules of procedure liberally provide an opportunity for fact discovery after an action has been commenced. Dismissal for insufficiency is appropriate *only if it appears certain* that an opposer is entitled to no relief under any set of facts that could be proved in support of its claim.” TBMP § 503.02.

As detailed below, Opposer clearly meets the Board’s requirements by alleging facts, which if accepted as true, would establish that Opposer (1) has standing to bring its Section 2(a) claim, and (2) has sufficiently pled the elements for that claim.

In paragraphs 2 through 5 of its opposition notice, Speck Pumps recites facts relating to its registered United States trademarks that include its GEAR MAN DESIGN as well as the value of that GEAR MAN DESIGN to its business. There should be no doubt that Speck Pumps has standing to contest Winter’s application to register a mark that includes a substantial, recognizable and prominent portion of Speck Pump’s GEAR MAN DESIGN. Winter does not contest Opposer’s standing to allege a Section 2(d) claim. Opposer’s pleaded registrations both include the GEAR MAN DESIGN in the drawing of the marks covered thereby.

In paragraph 4 of its Notice of Opposition, Speck Pumps alleges that, in the United States, it has long used, for several decades, its GEAR MAN DESIGN as a trademark and service mark prior to Winter’s use of its imitation GEAR MAN DESIGN. In paragraph 5 of its Notice, Speck Pumps alleges that its GEAR MAN DESIGN mark has become, through

continuous and extensive use, a valuable business and marketing asset of Speck Pumps and serves to indicate Opposer as the exclusive source to both the trade and consumers. In paragraph 7 of the Notice, Speck Pumps alleges that Winter’s mark falsely suggests a connection between the parties. As part of that allegation, Opposer explicitly cites Section 2(a) of the Lanham Act. Finally, in paragraph 8, Opposer alleges facts which provide an example of how Winter is falsely suggesting a connection between the parties by using its imitation GEAR MAN DESIGN in close proximity to Speck Pump’s “SPECK” word mark.

The screenshot of Winter’s web site displayed within paragraph 8 of the Notice of Opposition shows that Winter’s web site includes the word “TRADEMARK” immediately before the term “SPECK”. For ease of reference to the Board, the screen shot is reproduced below.



In the screen above a product designation next to the mark “SPECK” and in proximity to its imitation GEAR MAN DESIGN and an image of a commercial pump are visually perceivable facts that speak volumes about Winter’s intention to falsely suggest a connection in the United States between Respondent’s

products and Opposer's GEAR MAN DESIGN. The screen shot by itself is an allegation of facts sufficient to establish a false suggestion of connection in the United States between Respondent Winter and Opposer Speck Pumps. It is to be noted that in a now abandoned Application No. 79/138,718 filed by Winter on the same day as the '930 Application, Winter attempted to register Opposer's mark SPECK and GEAR MAN DESIGN. So there should be no doubt about Respondent's intentions to falsely suggest a connection between its imitation GEAR MAN and Opposer's GEAR MAN DESIGN.

It also should be observed that Section 2(a) prohibits registration of a mark *that consists of or comprises matter which may . . . falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols . . .* Section 2(a) does not expressly include any reference to "fame or reputation" of the offended persons, institutions, beliefs or national symbols. Opposer believes that the "fame or reputation" element traversed by the Board and the Federal Circuit in *Buffet, Notre Dame* and their progeny were merely judicial interpretations of the language of Section 2(a) intended to address particular types of controversies where a disputed name or mark covers goods and services for which an offended party previously had no prior connection. As the Federal Circuit observed in dictum in the *Notre Dame* case, the legislative history of Section 2(a) shows that the drafters intended to incorporate aspects of the "right of publicity". *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 217 USPQ 505, 509 (Fed. Cir. 1983). That is, an offended party with no particular connection to goods and services of an applicant or registrant should be sufficiently famous or reputed in order to create a presumption of connection between the parties otherwise Section 2(a) could be used to protect a name in gross.

For example, Section 2(a) likely would prohibit registration of “Frank Sinatra Hats” or “Elvis Eyewear” because both Sinatra and Elvis are world-famous entertainers even though neither performer had a particular connection to hats and/or eyewear. But the names Frank Sinatra and Elvis are well-known throughout the world and point uniquely each to a specific person. So it is well-known that a trier of fact would have no difficulty presuming a connection to a product that bears either name. Yet the language of Section 2(a) which, as noted in *Notre Dame*, has its origins in rights of privacy and publicity. *Id.* At 509. Section 2(a) makes no express reference to fame or reputation of the offended person or institution. This is understandable because the drafters of Section 2(a) likely understood that rights of privacy and publicity extend not only to famous persons and institutions, but also to an ordinary person who nevertheless could be offended by registration of a mark for goods or services with which such ordinary person actually is known to be associated. The drafters of Section 2(a) likely also intended to prevent registration of a mark by an applicant, like Respondent, who intentionally desires to trade upon the identity of another person or company, the Opposer.

In Opposer’s view, Section 2(a) also prohibits registration of a mark by an applicant who, like Respondent, Winter, purposefully attempts in the United States to draw a false suggestion of connection to a particular company that has no actual connection to the applicant’s goods or services. In the instant proceeding, Winter is attempting to register a mark that consists of or comprises matter [Speck Pump’s GEAR MAN DESIGN] which creates a false suggestion that Respondent’s pump products and related goods and services in the United States are somehow associated with or connected to Opposer and Opposer’s “Speck” pump GEAR MAN DESIGN products. The fact patterns of both *Buffett* and *Notre Dame* were different than the opposition proceeding here at bar because *Buffet* and *Notre Dame* covered only one particular species of

Section 2(a) claims. Proof of fame and reputation of Jimmy Buffett and the University of Notre Dame were required by the Board and Federal Circuit because Mr. Buffett did not have a reputation for operating restaurants and Notre Dame was not in the business of selling cheese. It is understandable that the Board added a requirement of fame or reputation in its application of Section 2(a) prohibitions to the facts of those controversies. Here, both parties are competing German companies that manufacture pumps for like uses. The parties are not strangers and there is evidence that Respondent has a predatory intent in using and attempting to register its imitation GEAR MAN DESIGN. Fame and well-known reputation of the Opposer need not be pleaded nor established to sustain an Opposition proceeding under Section 2(a) where it is clear that one party is inviting the public to mistakenly draw a connection to an offended party that offers the same types of goods and services. Nevertheless, *arguendo*, even if fame and/or reputation would have to be pleaded and established in all Section 2(a) claims, Speck Pumps has sufficiently alleged in paragraphs 4 and 5 of its Notice that it has a long reputation in the United States among the trade and consuming public and that Opposer of using its GEAR MAN DESIGN to identify Opposer's goods and services. The imitation GEAR MAN DESIGN that Respondent, Winter is attempting to register clearly and unmistakably points to Opposer, not to Winter.

In view of the foregoing facts, explanations, reasons and discussion, Opposer believes that it has pled all necessary elements of a Section 2(a) false suggestion of connection claim. Accordingly, Opposer respectfully requests that the Board deny Winter's motion to dismiss and promptly to resume cancellation proceedings.

**LEGAL ARGUMENT IN SUPPORT OF
OPPOSER'S FIRST AMENDED NOTICE OF OPPOSITION**

37 C.F.R. § 2.107 and TBMP §315 provide that pleadings in an opposition proceeding may be amended in the same manner and to the same extent as in a civil action in a United States district court, except that, after the close of the time period for filing an opposition including any extension of time for filing an opposition, an opposition may not be amended to add to the goods or services opposed. Rule 15(a)(1)(B) of the Federal Rules of Civil Procedure provides that a party may amend its pleading once as a matter of course within 21 days after service of the earlier of a responsive pleading or a motion under Rule 12(b), (e), or (f).

Although Opposer believes that the Section 2(a) claim in its Notice of Opposition was well-pleaded, Opposer simultaneously has filed herewith its First Amended Notice of Opposition to remove all doubt as to legal sufficiency of the pleaded claim.

CONCLUSION

Opposer respectfully requests that Respondent's motion to be dismissed be denied and that the proceeding be removed from suspension.

Respectfully submitted,

Dated: June 18, 2015

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CERTIFICATE OF SERVICE

I hereby certify that on June 18, 2015 that a true and exact copy of the foregoing document was served on Respondent by first-class mail, postage prepaid, in an envelope addressed as follows:

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