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

Proceeding	91223986
Party	Defendant Tree Of Life Organics Inc.
Correspondence Address	JASON R. LEE TREE OF LIFE ORGANICS INC. 5207 WALNUT ST PHILADELPHIA, PA 19139-4027  jason@llapc.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	IMRAN SHEIKH
Filer's e-mail	treeoflifeorganic@gmail.com
Signature	/imran sheikh/
Date	10/30/2015
Attachments	Motiontodismiss 2a 43c 2D.pdf(3130811 bytes )

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

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ANGEL HUNTINGTON-ORTEGA

Opposer

v.

Opposition No. 91223986  
Serial No. 86475142

TREE OF LIFE ORGANICS, INC.

Applicant.

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**APPLICANT'S MOTION TO DISMISS  
OPPOSER'S SECTION 2(a), 43(c), & 2(d)  
CLAIMS  
AND MOTION TO SUSPEND  
PROCEEDINGS PENDING DISPOSITION  
OF MOTION**

Applicant, TREE OF LIFE ORGANICS, INC. ("Applicant" or "TOLO ORGANICS") moves to dismiss those claims of the Notice of Opposition that rely upon Sections 2(a) (deceptiveness & false suggestion of connection), Section 43(c)(dilution), and Section 2(d) (priority and likelihood of confusion) of the Lanham Act on the grounds that the Notice of Opposition fails to states a claim under Sections 2(a), Section 2(d), and Section 43(c).

In addition, Applicant requests that the Trademark Trial and Appeal Board ("Board") suspend the proceedings pending disposition of this motion.

**ARGUMENT**

This case concerns a dispute regarding Applicant's mark TOLO for use connection with "cosmetic preparations for body care; cosmetic preparations for skin

care; cosmetic preparations for the hair and scalp; detergents for household use; hair conditioners; all made in part of organic materials.” Opposer objects to registration of the mark and alleges the following grounds – Section 2(d)(likelihood of confusion), 2(a)(false association), Section 43(c)(dilution), and Section 2(f) (acquired distinctiveness) of the Lanham Act.

The pleading requirements for a Notice of Opposition claim require a statement that (1) sets forth the element of the claim plainly and succinctly and (2) provides sufficient detail to give the registrant a clear idea of petitioner's complaint and the legal basis for recovery. *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45, 47 (TTAB 1985). The Notice of Opposition in this case does not satisfy the pleading requirements because it to plead all the essential elements of claims under Sections §2(a), 43(c), and 2(d). Moreover, it fails to allege the underlying facts necessary to support any of these claims.

**I. Section 2(a) Claims**

**A. Opposer Has Failed to Allege the Essential Elements of a § 2(a) Claim.**

Opposer asserts in Paragraph 12b of the Notice of Opposition that registration of Applicant's TOLO mark "would falsely suggest a connection with Opposer. Further, the Opposition cover sheet indicates that Opposer bases its Opposition in part on Section 2(a) of the Lanham Act.

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Section 2(a) of the Lanham Act prohibits registration of a mark that

Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501 (9) or title 19) enters into force with respect to the United States.

15 U.S.C. § 1052(a).

The Board has developed precise pleading rules for claims arising under §2(a) of the Lanham Act. In order to plead a legally sufficient claim, Opposer must allege (1) that the challenged mark is the same or a close approximation Opposer's previously used name, identity, or persona; (2) that Opposer's mark would be recognized as such; (3) that Applicant is not connected with Opposer or the goods that it provides under its registered mark; and (4) that Opposer's name, identity, or persona is sufficiently famous with respect to the relevant goods and services, so that the relevant public will assume that Applicant's goods are connected with Opposer. *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.* 228 USPQ 752, 754 (TTAB 1985); *Canovas v. Venezia*, 220 USPQ 660, 661-62 (TTAB 1983). In addition, the petition must allege that Opposer's name, identity, or persona achieved the required level of fame before the Registrant either filed for or began using the mark. The level of fame must be sufficient that the registered mark pointed solely and unmistakably to Petitioner as of those dates. *Consorzio de! Prosciutto di Parma v. Parma Sausage Products, Inc.*, 23 USPQ2d 1894, 1899 (TTAB 1992); *The Board of Trustees of the University of Alabama v. BAMA – Werke Curt Baumann*, 231 USPQ 408, 410 (TTAB 1986).

The Notice of Opposition in this case fails to allege elements necessary for pleading a §2(a) claim. It does not allege that Applicant is not connected with Opposer or the goods and services Opposer provides under its mark. It does not allege that the mark in question functioned as Opposer's name, identity, or persona before Applicant filed or began using the mark. More important, it does not allege that the mark solely and unmistakably points to Opposer -and did so prior to Applicant's first use or application to register the mark. In fact, the petition does not allege that Petitioner's marks are famous.

**B. Opposer Has Failed To Allege To Support a §2(a) Claim**

In addition to pleading the essential elements of a §2(a) claim, Opposer must allege facts, which if proven, would establish each of those elements. "More parroting of the requisite elements of a Section 2(a) false suggestion of a connection claim without sufficient factual support therefor is insufficient to meet the pleading requirements." *McDonnell Douglas Corp.* at 48 ("To establish a claim of the suggestion of false connection under Section 2(a), [plaintiff] must allege, and prove, a connection with it as an organization and not merely the use of confusingly similar marks.").

The petition does not provide any factual support for Petitioner's allegations with respect to its §2(a) claims. Paragraphs 1 of the Notice of Opposition contain the only allegations related to the Section 2(a). These paragraphs contain only legally conclusive language and fail to provide any facts upon which Opposer's Section 2(a) can rely.

Ownership of a mark by itself does not demonstrate that the mark serves as Petitioner's name, identity, or persona, that the mark is solely and unmistakably

associated with Petitioner, or that the mark is sufficiently famous to support a claim under §2(a). At most, Petitioner states a claim under §2(d) of the Lanham Act due to a likelihood of confusion. *See Miller Brewing Co. v. Anheuser Busch, Inc.*, 27 USPQ2d 1711, 1713 (TTAB 1993).

Accordingly, Opposer's claims under Section 2(a) should be dismissed.

## **II. Section 43(c) Claim**

### **A. Opposer Has Failed to Allege Essential Elements of Its Dilution Claim**

Section 43(c) of the Lanham Act provides as follows:

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

15 U.S.C. § 1125(c)

However, Opposer does not allege its mark is famous or that it became famous prior to either the filing date of the opposed application or applicant's first use of the mark in commerce. In view of this Opposer's dilution claim is insufficient. *See The Toro Co. v. Torohead, Inc.*, 61 USPQ2d 1164, 1174 n.9 (TTAB 2001). Further, Opposer has not alleged that Applicant's mark is likely to cause dilution of Opposer's mark by blurring or by tarnishment. Therefore, it does not provide adequate notice of Opposer's grounds for relief and fails to meet the pleading requirements of Rule 12 of the Federal Rules.

### **B. Opposer Has Failed Allege Any Facts to Support Its Dilution Claim**

As with its Section 2(a) Claim, Opposer has failed to assert any facts to support its claim under Section 43(c). Opposer merely alleges that registration of Applicant's TOLO mark "would tend to damage and interfere with and cause dilution of Opposer's valuable goodwill in its TODOS mark ...". The Notice of Opposition merely restates a legal

conclusion – it provides not facts that, even if true, would provide support for a claim of dilution.

As a result of the deficient pleading, Applicant is left without adequate notice of the specific dilution claim that Opposer is asserting and of any facts supporting the claim.

Accordingly, the claims of the Notice of Opposition based on Section 43(c) should be dismissed.

### **III. Section 2(d) claim**

#### **Section 2(d) of Trademark Act (Likelihood of Confusion)**

The search is necessary for the examining attorney to determine whether he or she should refuse registration under Section 2(d) of the Trademark Act, 15 USC §1052(d), which provides:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ---

(d) consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive

... .

If, after reviewing the application and conducting a search, the examining attorney finds any statutory basis why the mark should not be registered (including citing registration(s) under Section 2(d)) or any requirements are made regarding the application, the applicant is notified, generally through an Office Action. Section 12 of the Trademark Act, 15 USC §1062(b); 37 CFR §2.61(a); TMEP §705.

If the examining attorney determines on the initial examination or any subsequent examination of the application that applicant is entitled to registration of the mark, the examining attorney approves the application for publication in the USPTO *Official Gazette*. 37 CFR §2.80; TMEP §§704.01 and 1105. Here, the Applicant TOLO mark was approved and notice of allowance was issued. Regarding priority issue The exhibit 2 & 3 attached establish that Applicant has used the TOLO's mark in connection with soap

products and other products prior to Opposer file the application of their trademark. Please see the attached (exhibit 2 & 3).

#### **IV. Section 2(f) Does Not Provide a Basis for Opposition**

Finally, Opposer has alleged a violation of Section 2(f). Paragraph 10 of the Notice of Opposition states that registration of Applicant's TOLO mark would tend to damage and interfere with and cause dilution of Opposer's valuable goodwill in its VIEW ONE mark in violation of Section 2(f), 13(a), and 43(c) of the Lanham Act ..." Although the Opposition cover sheet does not reference Section 2(f), the cover sheet and attachment are considered a single, integrated filing - e.g., the Notice of Opposition. *See PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1927-1928 (TTAB 2005).

Section 2(f) of the Lanham Act provides:

Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark

by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before December 8, 1993.

15 U.S.C. § 1052(±).

This section concerns the registration of a mark based on its own acquired distinctiveness. It does not provide a basis for rejecting a trademark by a trademark-examining attorney or by an Opposer. Neither Applicant's mark nor the mark asserted by Opposer relies on Section 2(f) as a basis for registration. As such, to the extent Opposer seeks to base its opposition on Section 2(f), it fails to state a claim upon which relief may be based.



### Conclusion

With respect to its claims under § 2(a), 2(d), 43(c), and 2(f), Opposer has merely alleged the conclusion it hopes to establish in this proceeding without providing the facts necessary to prove the conclusion. *McDonnell Douglas Corp.* at 47-48. As such, the Notice of Opposition does not provide Applicant with fair notice of Opposer's claims, nor does it provide sufficient factual support for the elements necessary to prevail on those claims.

For the foregoing reasons, Applicant respectfully requests that the Board dismiss Opposer's Section 2(a), 2(d), 43(c), and 2(f) claim for failure to state claim and suspend proceedings pending disposition of this motion.

Respectfully Submitted,

Dated: October 30, 2015

*IMRAN SHEIKH*

Imran Sheikh (Applicant)  
Tree of Life Organics, Inc.  
5207 Walnut Street  
Philadelphia, Pennsylvania 19139  
Telephone: (267) 226-9788  
Email: [treeoflifeorganic@gmail.com](mailto:treeoflifeorganic@gmail.com)



**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that on this 30th day of October 2015, a true copy of the foregoing ANSWER TO NOTICE OF OPPOSITION was served in the following manner:

**VIA EMAIL AT: [trademark@fenwick.com](mailto:trademark@fenwick.com)**

**VIA FIRST CLASS MAIL**

<p>R.J. Heher Attorney of Record/California Bar Member Fenwick &amp; West LLP 801 California Street. Mountain View, CA 94041 UNITED STATES trademarks@fenwick.com Phone: 650-988-8500</p>
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**CERTIFICATE OF ELECTRONIC FILING**

The undersigned certifies that this submission (along with any paper referred to as being attached or enclosed) is being filed with the United States Patent and Trademark Office via the Electronic System for Trademark Trials and Appeals (ESTTA) on this 30th day of October 2015.

By: IMRAN SHEIKH Imran Sheikh

Imran Sheikh (Applicant)  
Tree of Life Organics, Inc.  
5207 Walnut Street  
Philadelphia, Pennsylvania 19139  
Telephone: (267) 226-9788  
Email: [treeoflifeorganic@gmail.com](mailto:treeoflifeorganic@gmail.com)

**EXHIBIT 1**


**Opposer Mark**

**TODOS ORGANICS**

**Applicant Mark**



**EXHIBIT 2**



**Tree of Life Organics Inc**  
 Natural and Organic Products  
 Soaps, Cosmetics & Health Care

**Sales Invoice**

5207 Walnut Street  
 Philadelphia. P.A. 19139  
 Phone (215) 476-3234 Fax (215) 476-2729  
 email: treeoflifeorganic@gmail.com

**DATE:** 3/14/2013  
**INVOICE No:** 008NJ

<b>Buyer's Contact Name</b> Mr. Wayne <i>company:</i> Africa Import Inc <i>Street:</i> 240 South Main Street unit A <i>City state zip:</i> South Hakensack NJ.07606 <i>Phone:</i> <i>Email:</i>	<b>Ship To:</b> Billing Address <i>company:</i> <i>Street:</i> <i>City state zip:</i> <i>Phone:</i>
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SALESPERSON	P.O. NUMBER	SHIP DATE	SHIP VIA	F.O.B. POIN	TERMS
	by Phone		Delivered		COD

QUANTITY	UNIT	DESCRIPTION	UNIT PRICE	AMOUNT	
30	cases	Tolo Brand Organic Soap. 72 bars case. 6 variant x 5	\$ 75.00	\$ 2,250.00	
		10 cases cocoa Butter Black seed with jasmin		\$ -	
		10 cases coconut & goats Milk soap with Tee Tree		\$ -	
		10 cases Dead Sea mud Shea butter soap		\$ -	
			\$ -	\$ -	
			\$ -	\$ -	
			\$ -	\$ -	
			\$ -	\$ -	
			\$ -	\$ -	
				<b>SUBTOTAL</b>	\$ 2,250.00
				<i>Courrier or land trasportation if applicable.</i>	\$ -
				<b>TOTAL INVOICE AMOUNT</b>	\$ 2,250.00

**Notes**

E&OE

Tree of Life Organics Inc

**THANK YOU. WE APPRECIATE YOUR BUSINESS.**

**EXHIBIT 3**

