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

Proceeding	91235601
Party	Defendant JHMJLL Inc.
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Submission	Motion to Dismiss - Rule 12(b)
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Attachments	APPLICANT MTD 08-23-18.pdf(119534 bytes)

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

In the Matter of Application Serial No. 86958449: NOW FIND GLUTEN FREE
in International Class 009

Gluten Free Classes, LLC	)	
	)	
Opposer,	)	
	)	Opposition No. 91235601
v.	)	
	)	
JHMJLL, Inc.	)	
	)	Tracking No: ESTTA802382
Applicant.	)	

APPLICANT'S MOTION TO DISMISS
AND MOTION TO SUSPEND PROCEEDINGS
PENDING DISPOSITION OF MOTION

Applicant, JHMJLL Inc. ("Applicant" or "JHMJLL") moves to dismiss the Notice of Opposition on the grounds that the Notice of Opposition fails to state a claim for which relief can be granted. In addition, Applicant requests that the Trademark Trial and Appeal Board ("Board") suspend the proceedings pending disposition of this motion.

ARGUMENT

In addition to U. S. Application #86958449 (The "449 Application") that is the subject of this Opposition, Applicant is the owner of U. S. Registration #5189310, registered April 25, 2017, for the mark NOWFINDGLUTENFREE in IC 044, used in connection with "Providing a web site that features information about gluten free living and food in the field of health and nutrition and the medical benefits of gluten free living and food." A printout of U. S. Registration #5189310 downloaded from the USPTO TSDR system is attached hereto as Exhibit A.

In addition to the "449 Application," Applicant is the owner of U. S. Application #87294026 (The "026 Application") for the mark NOW FIND GLUTEN FREE ("Gluten Free"

disclaimed) in IC 009, used in connection with "Downloadable software in the nature of a mobile application for operating systems on mobile devices that present food and other product information for products sold to customers."

Opposer is the owner of U.S. Trademark Registration Number 4,450,049, registered on December 17, 2013 for the mark "FIND ME GLUTEN FREE" ("Gluten Free" disclaimed) in IC 035, for, among other things, Advertising and directory services, namely, promoting the services of others by providing a web page featuring links to the websites of others; Online advertisements; etc. in International. Opposer admits that the services it offers under the mark are promotional in nature.

As grounds for its opposition, Opposer claims priority and likelihood of confusion under Section 2(d). Opposer's Notice of Opposition does not satisfy the pleading requirements because it fails to plead facts in support of all the essential elements of claims under Section 2(d).

To state a claim upon which relief can be granted, a plaintiff needs to allege sufficient facts that, if proved, would allow the Board to conclude, or to draw a reasonable inference, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark. *Doyle* v. *Al Johnson's Swed. Rest. & Butik Inc.*, 101 USPQ2d 1780, 1782 (TTAB 2012) (citing *Young* v. *AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998)); see also TBMP §503.02 (2015). Specifically, a complaint "must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Doyle*, 101 USPQ2d at 1782 (quoting *Ashcroft* v. *Iqbal*, 556 U.S. 662, 678 (2009)). In particular, the claimant must allege well-pleaded factual matter and more than "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements.". *Iqbal*, 556 U.S. at 678 (citing *Bell Atlantic Corp.* v. *Twombly*, 550 U.S. 544, 555 (2007)). The pleading requires a statement that (1) sets forth the elements of the claims plainly and succinctly and (2) provides the details of the legal basis for recovery. *McDonnell Douglas Corp.* v.

National Data Corp., 228 USPQ 45, 47 (TT AB 1985).

Here, Opposer has failed to allege any facts that demonstrate any likelihood of confusion, which is the legal basis of Opposer's challenge. The Notice of Opposition is nothing more than "threadbare recitals of the elements of a cause of action." Simply put, opposer fails to allege a single specific underlying facts necessary to support any of its claims.

Opposer Has Failed to Allege Any Facts That Support Priority & Likelihood of Confusion.

To allege a valid ground for opposition under Section 2(d), Opposer need only allege it has valid proprietary rights that are prior to those of Applicant, or that it owns a registration which Applicant has not counterclaimed to cancel, and that Applicant's mark so resembles Opposer's mark as to be likely to cause confusion. See Lanham Act § 2(d), 15 U.S.C. § 1052(d); Otto Roth & Co. v. Universal Foods Corp., 640 F.2d 1317, 209 USPQ 40 (CCPA 1981).

A. Opposer Has Failed to Allege Any Facts That Show Priority for the Relevant Use.

Applicant has three (3) trademarks for the phrase "NOW FIND GLUTEN FREE," including one registered mark. The 449 Application is for Computer application software for mobile phones, namely, software for providing information about food and other product information regarding Gluten Free certified or claimed Gluten Free products in Class 009. Opposer's mark "FIND ME GLUTEN FREE" in IC 035, for, among other things, Advertising and directory services. Opposer's mark establishes priority of use in, at best, Class 035 for advertising services, not Class 009 Computer application software.

Opposer has failed to allege a single fact to indicate any use of its mark in connection with any product or service related to Computer application software. Therefore, Opposer has failed to show proprietary rights that are prior to those of Applicant for the goods or services at issue in the 449 Application.

B. Opposer Has Failed to Allege Any Facts That Show Likelihood of Confusion.

Opposer has failed to allege a single fact to demonstrate that Applicant's mark so resembles Opposer's mark as to be likely to cause confusion. To determine whether a mark is likely to cause confusion , Courts analyze the Applicant respectfully submits that upon examination of the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), The E. I. du Pont de Nemours & Co. court discussed the factors relevant to a determination of likelihood of confusion which turns on similarity or dissimilarity of the marks and the relatedness of the goods or services. In a given case, not all factors may be relevant or of equal weight, and any one may be the deciding factor. The following factors should be examined on the issue of similarity:

(1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

(2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.

(3) The similarity or dissimilarity of established, likely-to-continue trade channels.

(4) The conditions under which and buyers to whom sales are made, i. e. "impulse" vs. careful, sophisticated purchasing.

(5) The fame of the prior mark (sales, advertising, length of use).

(6) The number and nature of similar marks in use on similar goods.

(7) The nature and extent of any actual confusion.

(8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

(9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).

(10) The market interface between applicant and the owner of a prior mark: (a) mere "consent" to register or use, (b) agreement provisions designed to preclude confusion, i. e.

limitations on continued use of the marks by each party, (c) assignment of mark, application, registration and good will of the related business, and/or (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.

(11) The extent to which applicant has a right to exclude others from use of its mark on its goods.

(12) The extent of potential confusion, i. e., whether *de minimis* or substantial.

(13) Any other established fact probative of the effect of use.

Courts have recognized that "likelihood of confusion" is a moving target and guidance from the Court of Appeals for the Federal Circuit is helpful in articulating the standard: "the basic principle … is that marks must be compared in their entireties and must be considered in connection with the particular goods or services." There is no mechanical test for determining likelihood of confusion. Each case must be decided on its own facts.

The lack of facts is precise why Opposer's Notice must be dismissed for failure to state a claim. Of the 13 types of facts that could have been alleged to show a likelihood of confusion, Opposer makes one conclusory statement in Paragraph 9 of the Notice: "The "NOW FIND GLUTEN FREE" in Applicant's mark has a confusingly similar auditory signature and appearance to Opposer's mark "FIND ME GLUTEN FREE,"" "GLUTEN FREE" disclaimed in both. Opposer fails to allege any factual basis for the comparison, other than singling out the disclaimed and unprotectable portions of the two marks. The allegations found in Paragraphs 10-13 in the Notice contain only bare legal conclusions without alleging a single "fact."

In short, Opposer has failed to allege any facts to enable the Board to apply the likelihood of confusion analysis. Moreover, Opposer's own pleadings are incorrect on their face. Both Paragraph 11 and Paragraph 13 of Opposer's Notice allege ownership of the wrong mark. Furthermore, Applicant is already the owner the registered NOWFINDGLUTENFREE - without any disclaimer

for the words "gluten free" - a mark that is identical to mark in the 449 Application. If anything, the existence of Applicant's registered trademark demonstrate the absence of any likelihood of confusion.

CONCLUSION

Opposer's Notice of Opposition fails to state a claim upon which relief can be granted. The Notice 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 Opposition No. 91235601 with prejudice.

Respectfully submitted,

[signed] /david m. adler/

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Dated: August 23, 2017

NOTICE OF FILING & CERTIFICATE OF SERVICE

David M. Adler, an attorney, certifies that pursuant to 28 U.S.C. 1746, under penalties of perjury, he caused a copy of the APPLICANT'S MOTION TO DISMISS AND REQUEST FOR SUSPENSION to be filed via ESTTA with a copy served via email to Opposer at the correspondence address listed in the opposition:

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Respectfully submitted,

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