

ESTTA Tracking number: **ESTTA880798**

Filing date: **03/02/2018**

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

Proceeding	91235909
Party	Plaintiff Intercontinental Exchange Holdings, Inc.
Correspondence Address	RICHARD L CRUZ DLA PIPER LLP (US) 1650 MARKET STREET, SUITE 4900 PHILADELPHIA, PA 19103 UNITED STATES Email: pto.phil@dlapiper.com, gina.durham@dlapiper.com
Submission	Opposition/Response to Motion
Filer's Name	Kerry A. O'Neill
Filer's email	kerry.oneill@dlapiper.com, gina.durham@dlapiper.com
Signature	/Kerry A. O'Neill/
Date	03/02/2018
Attachments	Opposition to Motion to Dismiss Amended Notice.pdf(54357 bytes)

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

Intercontinental Exchange Holdings, Inc.)	
)	
Opposer,)	
)	
v.)	Opposition No. 91235909
)	
New York Mercantile Exchange, Inc.)	
)	
Applicant.)	
)	

**INTERCONTINENTAL EXCHANGE HOLDINGS, INC. OPPOSITION TO
NEW YORK MERCANTILE EXCHANGE, INC.’S
MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM**

Opposer Intercontinental Exchange Holdings, Inc. (“Opposer”) opposes Applicant New York Mercantile Exchange, Inc.’s (“Applicant”) Motion to Dismiss for Failure to State a Claim (“Motion”). Opposer has properly alleged that Applicant’s mark creates a false suggestion of connection pursuant to Lanham Act Section 2(a), 15 U.S.C. § 1052(a), in its First Amended Notice of Opposition (“Notice”). For the reasons set forth below the Board should deny Applicant’s Motion to Dismiss.

I. INTRODUCTION

Applicant seeks to dismiss the Notice based on a claim that Opposer has failed to appropriately plead a claim of false suggestion of a connection pursuant to Lanham Act § 2(a), 15 U.S.C. § 1052(a). Applicant’s Motion, which is but a thinly disguised and premature argument for a judgment on the merits, must fail as it is both procedurally and substantively defective.

Indeed, Opposer has sufficiently pleaded the elements of its claim for violation of Lanham Act § 2(a) in its Notice. Opposer has alleged facts establishing that 1) Opposer has standing and 2) Opposer has valid grounds to block the registration. While Opposer's Notice is far more detailed, these allegations alone meet the pleading requirements under the TTAB and Federal Rules. Applicant's Motion should be denied.

II. SUMMARY OF FACTS ALLEGED IN THE NOTICE

Opposer has alleged the following facts in its Notice – which must all be presumed true for the purposes of Applicant's Motion – and which on their face demonstrate why Applicant's Motion must fail.

Opposer is the owner of valid and substantial common law rights in both the BRENT word mark (since at least as early as November 1, 1983) and the BRENT INDEX word mark (since at least as early as June 23, 1988) in connection with a financial benchmark for commodity trading and other related financial services such as futures contracts and financial exchanges (“Opposer's Goods/Services”) (collectively the “BRENT Marks”). (Notice ¶ 3.) Opposer owns exchanges for financial and commodity markets and operates regulated exchanges and marketplaces, including the New York Stock Exchange; future exchanges in the United States, Canada, and Europe; equity option exchanges; and certain energy, credit, and equity markets. (Notice ¶ 17.) The BRENT INDEX is a specified benchmark administered by Opposer's wholly owned affiliate, ICE Futures Europe, under the supervision of the FCA. The BRENT INDEX is perceived by the relevant public as the name of a financial institution or as an alternate entity name for Opposer, just as the New York Stock Exchange is. The “BRENT INDEX” is also commonly referred to by the shortened version, the BRENT. (Notice ¶ 18.)

Opposer is the sole administrator of the BRENT INDEX. There is and can only be one BRENT INDEX because “BRENT” identifies a specific financial benchmark that is based on a methodology calculated by Opposer and regulated by the key financial regulator in Europe, namely the Financial Conduct Authority (“FCA”), and it is Opposer who is held accountable to financial regulators for this benchmark and for maintaining the consistent standards associated therewith. (Notice ¶ 5.) Further, it is the BRENT INDEX that is used to create other financial offerings that also derive solely from Opposer. For instance, the BRENT NX Futures Contract is a financial instrument offered by Opposer at least as early as 2011. This is prior to Applicant’s launch of a NYMEX BRENT offering, and prior to filing of the application opposed herein. (Notice ¶ 6.) Opposer is the sole administrator of the BRENT INDEX pursuant to the financial regulation of the FCA, and thus the offering of financial exchange services under a BRENT name points uniquely and unmistakably to Opposer, as Opposer is the only regulated financial institution that is authorized to administer the BRENT INDEX. (Notice ¶ 21.) When investors see references to the BRENT Marks they know that these references relate back to Opposer. It is because of this familiarity that investors know what to expect and therefore trust the Goods / Services associated with the BRENT Marks. (Notice ¶ 7.) Reference to “BRENT,” when used to offer financial exchange services, does not have a meaning separate from Opposer. Applicant’s conduct in seeking registration of NYMEX BRENT, would be similar to Applicant seeking the USPTO’s endorsement of Applicant’s registration for NYMEX NEW YORK STOCK EXCHANGE. (Notice ¶ 22.)

Applicant’s Services and Opposer’s Goods / Services are identical, competitive, overlapping and/or closely related, and are of the type which could be offered in overlapping channels of trade and to the same prospective customers. (Notice ¶ 10.) Applicant’s utilization of

BRENT as the dominant portion of its mark, NYMEX BRENT, for financial exchange services makes Applicant's applied for mark a close approximation of BRENT and BRENT INDEX. (Notice ¶ 19.) By virtue of its trademark application for NYMEX BRENT, Applicant seeks the prima facie right to use NYMEX BRENT in connection with "financial exchange services." These are the identical services for which the BRENT INDEX and BRENT are already established as the regulated financial institution/entity for setting the benchmark upon which the relevant public relies. (Notice ¶ 20.) Applicant is not connected with the services provided by Opposer under the BRENT Marks, nor is Applicant approved by the FCA to administer the BRENT INDEX pursuant to applicable financial regulations. However, by allowing registration of NYMEX BRENT, the USPTO will be providing Applicant with the prima facie right to imply that it is associated with the financially regulated institution/entity that is the BRENT INDEX, also referred to as the BRENT. (Notice ¶ 23.)

If Applicant's Mark is registered, the public will reasonably believe that Applicant's services are connected with, provided, sponsored, or endorsed by Opposer, all to the detriment of consumers and Opposer. (Notice ¶ 25.) If Applicant is granted the registration herein opposed, Applicant would thereby obtain a prima facie right to Applicant's Mark. Such registration would be a source of damage and injury to Opposer as Applicant is attempting to appropriate the cache of Opposer's BRENT Marks to name its own products and create the imprimatur of a regulated financial offering. (Notice ¶ 26.)

In light of the foregoing, Opposer filed its Notice alleging, *inter alia*, a claim under Lanham Act § 2(a) for false suggestion of a connection.

III. ARGUMENT

A. Standard for Motion to Dismiss for Failure to State a Claim

To withstand Applicant's Motion, Opposer need only allege sufficient facts that, if proven, would allow the Board to conclude or 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 Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780 (TTAB 2012) (citing *Young v. AGB Corp.*, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998)); TBMP §503.02 (2014). This standard requires Opposer to plead "sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face . . . enough to raise a right to relief above the speculative level.'" *Ashcroft v. Iqbal*, 556 U.S. 662, 668, 678 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555, 570 (2007)). The Notice must be examined in its entirety, construing the allegations so as to do justice as required by Fed. R. Civ. P. 8(e). *IdeasOne Inc. v. Nationwide Better Health*, 89 USPQ2d 1952, 1953 (TTAB 2009). All of Opposer's well-pled allegations must be accepted as true, and the Notice must be construed in the light most favorable to Opposer. See *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 26 USPQ2d 1038 (Fed. Cir. 1993).

Ultimately, because Opposer has sufficiently pled its claims and has no duty to prove its case in its initial Notice of Opposition, the Board should deny Applicant's Motion to Dismiss. *Wise F&I, LLC; Financial Gap, Administrator LLC; Vehicle Service Administrator LLC; and Administration America LLC v. Allstate Insurance Company*, 120 USPQ2d 1103 (TTAB Sept. 23, 2016).

To satisfy standing, an Opposer need only plead sufficient facts to show "real interest" and a "reasonable basis" for its belief that it would suffer damages if the mark is registered. *Ritchie v. Simpson*, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). A "real interest" and "reasonable basis" can be adequately pleaded by showing 1) ownership of a current registration and 2)

possible damage to the registration, such as by a claim of likelihood of confusion—that is not wholly without merit. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Barbara’s Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1285 (TTAB 2007). For the reasons explained below, Opposer has pleaded both a “real interest” and a “reasonable basis” for its claims.

To adequately plead a valid ground for opposition an opposer must allege an appropriate statutory ground that negates an applicant’s right to registration. *Young*, 152 F.3d at 1380. While this requires more than simply referencing the specific section of the Trademark Act, *see Demon International LC v. Lynch*, 86 USPQ2d 1058, 1059–1060 (TTAB 2008), an opposer need only set forth the elements to a statutory ground with enough facts to constitute a plausible claim. *See Petroleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1405–1406 (TTAB 2010) (holding petitioner sufficiently pleaded the elements of Section 2(a) and 2(d) claims). Opposer in this instance has pleaded sufficient facts to constitute a plausible claim.

Whether Opposer has proven its allegations or not is irrelevant to determining whether it has sufficiently pleaded its allegation to survive a motion to dismiss. *Advanced Cardiovascular Systems*, 26 USPQ2d at 1041. For the reasons explained below, Opposer has clearly pleaded its claims sufficiently.

B. Opposer’s Count II is Sufficient to Avoid Dismissal Under Rule 12(b)(6).

Applicant bases its Motion solely on the sufficiency of Opposer’s pleaded claim under Lanham Act § 2(a); it does not appear to have argued that Opposer lacks standing or to have challenged Opposer’s well-pleaded claim under Lanham Act § 2(d) for likelihood of confusion. Regardless, Opposer has adequately pleaded standing, as it has alleged ownership of common law rights in the BRENT Marks as well as damage to these marks based upon possible registration of Applicant’s mark via two separate statutory grounds. *See Giersch v. Scripps*

Networks, Inc., 90 USPQ2d 1020, 1022 (TTAB 2009). By establishing standing with respect to one pleaded ground for opposition, Opposer has the right to assert any other ground that also has a reasonable basis in fact. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713, 1727-28 (Fed. Cir. 2012) (“[O]nce an opposer meets the requirements for standing, it can rely on any of the statutory grounds for opposition set forth in 15 U.S.C. § 1052.”); *Petróleos Mexicanos v. Intermix S.A.*, 97 USPQ2d 1403, 1405 (TTAB 2010). The only remaining issue is thus whether Opposer has sufficiently pleaded the allegations in its Notice, and here without question, it has.

C. Opposer’s Lanham Act § 2(a) (Count II) Claim is Legally Sufficient.

Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a) prohibits registration of a mark that... “(a) consists of or comprises ... matter which may.... falsely suggest a connection with persons living or dead.” A claim of false suggestion includes the following elements: 1) The mark sought to be registered is the same as, or a close approximation of, the name or identity previously used by another person or institution; 2) the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution; 3) the person or institution identified in the mark is not connected with the goods sold or services performed by applicant under the mark; and 4) the fame or reputation of the named person or institution is of such a nature that a connection with such person or institution would be presumed when applicant’s mark is used on its goods and/or services. *See Petróleos Mexicanos*, 97 USPQ2d at 1405; *see also, Buffet v. Chi-Chi’s, Inc.*, 226 USPQ 428, 429 (TTAB 1985) (in which the well-known singer Jimmy Buffet alleged false suggestion of a connection under Section 2(a) of the Lanham Act in connection with an application by the defendant to register “MARGARITAVILLE” for restaurant services).

Applicant argues that Opposer fails to allege that BRENT and/or BRENT INDEX is a “name or identity perceived by the relevant consumers.” Applicant’s motion ignores the following well-pled allegations:

- Opposer is the sole administrator of the BRENT INDEX pursuant to the financial regulation of the FCA, **and thus the offering of financial exchange services under a BRENT name points uniquely and unmistakably to Opposer**, as Opposer is the only regulated financial institution that is authorized to administer the BRENT INDEX. (Notice ¶ 21.) (Emph. added.)
- **Reference to “BRENT,” when used to offer financial exchange services, does not have a meaning separate from Opposer**. Applicant’s conduct in seeking registration of NYMEX BRENT, would be similar to Applicant seeking the USPTO’s endorsement of Applicant’s registration for NYMEX NEW YORK STOCK EXCHANGE. (Notice ¶ 22.) (Emph. added.)

Applicant apparently argues that in order for Opposer to state a claim under Lanham Act § 2(a), the terms BRENT and BRENT INDEX must themselves “[function] as a separate name or identity.” Applicant’s Motion, pp. 6-7. Applicant misstates the standard. To state a claim of false suggestion of a connection under § 2(a), an opposer must allege facts from which it may be inferred that the applicant’s mark points uniquely to opposer, as an entity – *i.e.*, that applicant’s mark is opposer’s identity or “persona” – and that purchasers would assume that goods bearing applicant’s mark are connected with opposer. *Miller Brewing Co.*, 27 USPQ2d 1711 (TTAB June 2, 1993) (citing *The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 217 USPQ 505 (Fed.Cir.1983)). Such a claim must assert that the mark applicant seeks to register points “uniquely and unmistakably” to opposer, as an identifier of its corporate persona,

rather than as an identifier of the source of particular goods. *Id.*, citing *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45 (TTAB1985). Indeed, a claim of “false suggestion of a connection” need not involve a name or likeness. It may involve “any equivalent.” *Miller Brewing Co.*, 27 USPQ2d 1711, n.3 (TTAB June 2, 1993); citing *U.S. Navy v. United States Mfg. Co.*, 2 USPQ2d 1254 (TTAB 1987); *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752 (TTAB 1985); and *Buffet*, 226 USPQ 428.

For example, in *In Re Nieves & Nieves LLC*, 113 USPQ2d 1629 (TTAB Jan. 30, 2015), the Board stated that “[a] term may be considered the identity of a person even if his or her name or likeness is not used. All that is required is that the mark sought to be registered clearly identifies a specific person...” 113 USPQ2d 1629 (TTAB Jan. 30, 2015); *see e.g., Pitts*, 107 USPQ2d at 2025 (“Because ‘houndstooth’ and ‘houndstooth mafia’ are not the ‘names’ of either opposer or Coach Bryant, we consider whether applicants’ mark [HOUNDSTOOTH MAFIA and design] is the same as or a close approximation of their ‘identity.’”).” *See also In re Urbano*, 51 USPQ2d 1776, 1779 (TTAB 1999) (“[W]hile the general public in the United States may or may not have seen the upcoming Olympic games referred to precisely as ‘Sydney 2000,’ we have no doubt that the general public in the United States would recognize this phrase as referring unambiguously to the upcoming Olympic Games in Sydney, Australia, in the year 2000.”); *Bd. of Trustees of the Univ. of Ala. v. BAMA-Werke Curt Baumann*, 231 USPQ 408 (TTAB 1986) (“BAMA” uniquely pointed to the identity of the University of Alabama even though the school had not adopted it as a trademark and had only sporadically referred to itself as BAMA, in large part due to the public’s association of the term with the school).

As noted above, Opposer has specifically pleaded that it is the actual institution with which consumers will presume a false suggestion of a connection when confronted with

Applicant's mark, and that Opposer itself is implicated by that false suggestion. *Petroleos Mexicanos*, 97 USPQ2d 1403 (TTAB Dec. 28, 2010) (denying motion to dismiss where petitioner specifically pleaded that it is the actual institution with which consumers will presume a false suggestion of a connection when confronted with respondent's mark, and which is allegedly implicated by that false suggestion).

Applicant also incorrectly argues that Opposer improperly relies upon "use and regulations outside of the United States that have no bearing on this opposition." Applicant's Motion, p. 7. First, Applicant ignores that Opposer has alleged that it owns and operates future exchanges in the United States. (Notice ¶ 17.) Second, Applicant's reliance on the so-called "Territoriality Doctrine" is misplaced here in the context of a § 2(a) claim, because an opposer need not assert a proprietary interest to assert a § 2(a) claim. *See Hornby v. TJX Companies Inc.*, 87 USPQ2d 1411 (TTAB 2008) (petitioner that had abandoned use in the United States of her personal name mark, was unable to prevail on either a likelihood of confusion or dilution claim, but was able to prevail on a claim of false suggestion of a connection with petitioner's persona, due to continuing fame and reputation of petitioner within the United States). *Cf. Fiat Grp. Automobiles S.p.A. v. ISM Inc.*, 94 USPQ2d 1111, 1113, 1115 (TTAB 2010) ("[T]o the extent the 'well known mark' doctrine is recognized at all, pleading only use of such a mark outside the United States, without any pleading of widespread recognition of mark within the United States as signifying a particular source of goods, even if such source is anonymous, is an insufficient basis for a claim of dilution. ... We must, however, at least recognize the possibility that, in an unusual case, activity outside the United States related to a mark could potentially result in the mark becoming well-known within the United States, even without any form of activity in the United States").

Finally, Applicant argues that “Opposer’s allegation that ‘BRENT’ is the dominant portion of NYMEX’s NYMEX BRENT Mark is disingenuous,” noting that Applicant “disclaimed the term ‘brent’ in its Application.” Applicant’s Motion, p. 8. Applicant’s argument fails because, at best, it attempts unsuccessfully to attack the merits of Opposer’s claims, not the sufficiency of its Notice. For the purposes of its claim under § 2(a), Opposer need only plead that (1) Applicant’s mark is the same or a “close approximation” of Opposer’s previously used name or identity; (2) Applicant’s mark would be recognized as such, in that it points uniquely and unmistakably to Opposer; (3) Opposer is not connected with the goods sold by Applicants under the mark; and (4) Opposer’s name or identity is of sufficient fame or reputation that when Applicant’s mark is used on its goods/services, a connection with Opposer would be presumed. *Fifty-Six Hope Rd. Music Ltd.*, Cancellation No. 9205705, 2014 WL 4896416, at *4 (Sept. 17, 2014) (“Although Petitioner refers to a ‘false association’ and some of its allegations focus on the ‘MARLEY’ portion of Respondent’s mark rather than the mark as a whole, the foregoing allegations are sufficient to put Respondent on notice that Petitioner is alleging a claim of false suggestion of a connection.”); *see also Deford Bailey LLC*, 91209857, 2014 WL 11032969, at *5 (Aug. 22, 2014); *Petróleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008).

IV. CONCLUSION

Accepting all well-pled allegations as true, Opposer has sufficiently alleged that Applicant’s mark creates a false suggestion of connection pursuant to Section 2(a) of the Lanham Act. For the foregoing reasons, Opposer respectfully requests that Applicant’s Motion to Dismiss be denied.

Dated: March 2, 2018

By: /s/ Gina Durham

Gina Durham
Richard L. Cruz
Kerry O'Neill
DLA Piper LLP (US)
Attorneys for Opposer
INTERCONTINENTAL EXCHANGE
HOLDINGS, INC.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **INTERCONTINENTAL EXCHANGE HOLDINGS, INC. OPPOSITION TO NEW YORK MERCANTILE EXCHANGE, INC.'S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM** was served electronically on this 2nd day of March, 2018, on counsel of record for Applicant New York Mercantile Exchange, Inc.

/s/ Kerry A. O'Neill _____

Kerry A. O'Neill