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

Proceeding	91235909
Party	Defendant New York Mercantile Exchange, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE
TRADEMARK TRIAL AND APPEAL BOARD**

In re Ser. No. 86/787,611

Mark: NYMEX BRENT

Filed: October 14, 2015

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

**APPLICANT’S REPLY IN SUPPORT OF APPLICANT’S MOTION TO DISMISS FOR
FAILURE TO STATE A CLAIM**

Opposer has now had multiple opportunities over a period of eight months to properly plead a plausible claim of false suggestion of a connection. Opposer has failed to do so. Instead, Opposer repeats the same meaningless allegations in a desperate attempt to salvage a claim that cannot be saved. The Board should not be fooled by Opposer’s flimsy attempt to conjure up a claim where the facts do not support such a claim.¹ As a result, the Board should grant Applicant’s Motion to Dismiss and allow the opposition to proceed on Opposer’s likelihood of confusion claim.

¹ Opposer’s 11-page Opposition Brief consists, *inter alia*, of a nearly 3-page “Summary of Facts Alleged in the Notice” consisting of a painful repetition of facts recited in Opposer’s Amended Notice of Opposition and thus already part of the record. Opposer’s imprudent use of the opportunity to substantiate and defend its claim speaks volumes.

While Applicant could dedicate this Reply Brief to meticulously exposing the countless insufficiencies in Opposer's Opposition Brief, in the interest of judicial efficiency, Applicant focuses on the following:

1. Most of Opposer's factual allegations are irrelevant to a claim for false suggestion of a connection and Opposer failed to substantiate why they are relevant;
2. Opposer applies the wrong standard and fails to allege that NYMEX's mark NYMEX BRENT points uniquely and unmistakably to Opposer;
3. Opposer does not and cannot allege that Brent is of such fame or reputation that, upon encountering NYMEX's mark NYMEX BRENT consumers will presume a connection with Opposer.

Therefore, rather than granting Opposer additional, undeserved leave to amend, thereby forcing Applicant to defend against this claim, the Board should dismiss with prejudice Opposer's claim of false suggestion of a connection.

I. OPPOSER'S REPEATED FACTUAL ALLEGATIONS ARE IRRELEVANT.

Opposer spent three pages regurgitating the factual allegations in its Amended Notice of Opposition, which only further highlights Opposer's deficient pleadings. Opposer places great emphasis on European (specifically United Kingdom) regulations, despite the fact that a regulatory dispute is properly heard by the relevant governmental regulatory authority, and not before the U.S. Patent and Trademark Office. See Opposer's Am. Notice of Opp'n ¶¶ 5, 9, 16-18, 20, 21, 23, 26; *see also*, Opp'n Br. at 2-4, 8, 10. Opposer also repeats the false allegation that its BRENT NX Future contract was offered prior to Applicant's launch of its NYMEX BRENT offering.² More importantly, a substantial number of Opposer's allegations should be disregarded as irrelevant, as they relate to Opposer (the New York Stock Exchange) and its operations in the United

² Applicant's NYMEX BRENT application claims a date of first use in U.S. commerce at least as early as July 2001, ten years prior to Opposer's alleged introduction of its BRENT NX Future contract. See Am. Notice of Opp'n ¶ 6, 12, 14; *see also*, Opp'n Br. at 3.

Kingdom and throughout the world, but these allegations have no relation to the term BRENT, the core focus of Opposer's § 2(a) claim.

II. OPPOSER'S OPPOSITION BRIEF FAILS TO SUBSTANTIVELY ADDRESS THE PLEADING DEFICIENCIES IN OPPOSER'S AMENDED NOTICE OF OPPOSITION.

As detailed below, Opposer still fails to properly plead its claim. Specifically, Opposer spends pages of its brief citing cases and recounting the elements of a Section 2(a) claim, but fails to establish how its Amended Notice of Opposition provides sufficient detail to support such a claim.

A. Opposer Fails to Allege Brent or Brent Index is a Name or Identity Perceived by the Relevant Consumers.

In an effort to support its allegations, Opposer relies upon foreign regulation of "Brent Index" and the following bald, unsupported allegation: "Reference to 'BRENT,' when used to offer financial exchange services, does not have a meaning separate from Opposer." See Opp'n Br. at 8. These allegations are insufficient to withstand a Motion to Dismiss and distinct from the required allegation that relevant consumers - i.e. consumers in the US and not the UK regulatory authority - would perceive "Brent" as the "name or identity" of Opposer. Unlike the cases relied upon by Opposer, this is not a situation involving commonly known identities such as MARGARITAVILLE or USMC. See *Buffett v. Chi-Chi's, Inc.*, 226 U.S.P.Q. 428 (T.T.A.B. 1985); see also, *U.S. Navy v. United States Manufacturing Co.*, 2 U.S.P.Q.2d 1254 (T.T.A.B. 1987). Therefore, Applicant should not be forced to defend such a claim without more allegations, thereby enduring the expense of discovery and delay in the registration of its NYMEX BRENT application.

B. Opposer's Allegations Apply the Wrong Standard and Fail to Allege that NYMEX's Mark NYMEX BRENT Would be Recognized as Pointing Uniquely and Unmistakably to Opposer.

The Board's Order dated January 2, 2018 states that Opposer must allege that Applicant's NYMEX BRENT mark points uniquely to Opposer. However, in conflating the proper elements of a § 2(a) claim, Opposer applies the wrong standard and alleges that its Brent name "uniquely and unmistakably" points to Opposer. See Am. Notice of Opp'n ¶ 21 and Opp'n Br. at 3, 8. In doing so, Opposer fails to allege that NYMEX's mark NYMEX BRENT would be recognized as "uniquely and unmistakably" pointing to the Opposer. A plain reading of the second element and Board precedent focus the analysis under this element on NYMEX's mark NYMEX BRENT, not "Brent" or "Brent Index" as Opposer would prefer. See *In re Kayser-Roth Corp.*, 29 U.S.P.Q.2d 1379, 1993 WL 562976 at * 7 (T.T.A.B. 1993) ("[t]he question is not whether the word 'Olympic' falsely suggests a connection with the persona or identity of the United States Olympic Committee's but whether *applicant's* mark OLYMPIC CHAMPION does") (emphasis added). As a result, Opposer failed to sufficiently allege any facts to support that "NYMEX BRENT" *uniquely and unmistakably* points to Opposer.

C. Opposer Does Not and Cannot Allege That Opposer is of Such Fame or Reputation That, Upon Encountering NYMEX's Mark NYMEX BRENT Consumers Will Presume a Connection with Opposer.

In essence, the fourth element of a claim of false suggestion of a connection is comprised of two sub-elements: (1) the Opposer's fame or reputation is of the requisite degree, and (2) when Applicant's mark is used with Applicant's goods or services consumers will presume a connection between the Opposer and the Applicant's mark.

As to the first sub-element, the words “famous,” “fame” or “reputation” do not appear substantively in Opposer’s Amended Notice of Opposition or Opposition Brief.³ Opposer also fails to allege any facts relevant to the second sub-element, which focuses on NYMEX’s mark NYMEX BRENT, not Opposer’s alleged marks “Brent” and “Brent Index.” Opposer simply ignores this undeniable truth. See Am. Notice of Opp’n ¶ 24 (“[w]hen investors see reference to **BRENT** and **BRENT INDEX** they know these references relate back to Opposer) (emphases added).”

Opposer’s argument is devoid of any allegations regarding Opposer’s fame or recognition, which requires the dismissal of Opposer’s claim. Therefore, Opposer’s claim must be dismissed because Opposer has not alleged that the relevant consumers *presume* a connection with the Opposer upon encountering NYMEX’s mark NYMEX BRENT.

III. CONCLUSION

Opposer’s Amended Notice of Opposition fails to state a claim upon which relief may be granted for false suggestion of a connection even when all well-pleaded allegations are accepted as true and Opposer’s Amended Notice of Opposition is construed in Opposer’s favor. Instead, Opposer attempts to disguise its likelihood of confusion claim as an additional claim of false suggestion of a connection. Opposer’s allegations are either simply irrelevant to this claim or Opposer applies the wrong standard. In doing so, Opposer fails to allege plausible facts to support its false suggestion of a connection claim. Despite multiple pleading opportunities, Opposer

³ The words “fame” and “reputation” only appear in Opposer’s Opposition Brief: (1) in merely reciting the elements of a claim for false suggestion of a connection, and (2) in a parenthetical unrelated to Opposer’s actual allegations.

continues to insufficiently plead its claim. Therefore, Applicant requests that the Board grant Applicant's motion and dismiss with prejudice Opposer's claim of false suggestion of a connection.

Respectfully submitted,

NEW YORK MERCANTILE
EXCHANGE, INC.

Dated: March 22, 2018

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Applicant's Reply in Support of Applicant's Motion to Dismiss for Failure to State a Claim has been served upon counsel for Intercontinental Exchange Holdings, Inc. by mailing said copy via U.S. First Class Mail, postage prepaid to:

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