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

Proceeding	91236352
Party	Defendant Poles, Inc.
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Submission	Motion to Dismiss - Rule 12(b)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Shawn D. Hesketh	)	
	)	
Opposer,	)	Opposition No.: 91236352
	)	
v.	)	Serial No.: 87350558
	)	
Poles, Inc.	)	Mark: WP101-PRO
	)	
Applicant.	)	

**APPLICANT’S MOTION TO DISMISS OPPOSITION  
AND BRIEF IN SUPPORT OF MOTION**

Pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure (Fed.R.Civ.P.) and Section 503 of the *Trademark Trial & Appeal Board Manual of Procedure* (TBMP), Applicant, Poles, Inc. (“Applicant”), by and through its undersigned counsel, moves the Trademark Trial & Appeal Board (the “Board”) for an Order dismissing the above captioned opposition for failure to state a claim upon which relief can be granted.<sup>1</sup>

Because Opposer, Shawn D. Hesketh (“Opposer”) has failed to allege any facts which could support any statutory grounds for opposing registration of Applicant’s mark, Opposer’s notice of opposition should be dismissed for failure to state a claim upon which relief can be granted. The grounds for this motion are as follows:

**1. Introduction**

Repeatedly, the United States Supreme Court has underscored its “concern about the proper – and properly limited – role of the courts in a democratic society.” *Summers v. Earth*

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<sup>1</sup> Applicant notes that pursuant to TBMP §503.01, the time for filing an answer to the notice of opposition is automatically tolled by the filing of this motion, and that the Board will reset the time for Applicant to file its answer if this motion is denied.

*Island Inst.*, 129 S.Ct. 1142.1148 (2009) (internal quotation and citation omitted). The Board should dismiss the opposition under Fed.R.Civ.P. §12(b)(6). It is a bedrock principle of judicial restraint that courts and quasi-judicial organizations will address only an actual case or controversy.

## **2. Statement of Facts**

On February 27, 2017, Applicant filed application Serial No. 87350558, pursuant to Section 1(b) of the Trademark Act (intent to use) for the mark WP101-PRO (“Applicant’s Mark”). The goods covered by Applicant’s application are:

- **Class 002** – Wood preservatives
- **Class 005** – Fungicides

Applicant’s Mark was published for opposition on August 1, 2017, and the opposition was instituted on August 28, 2017. Opposer filed Opposition No. 91236352 based on alleged ownership of WP101 (“Opposer’s Mark”).

## **3. Arguments**

To properly state a claim of likelihood of confusion, Opposer must plead (and later prove) that Applicant’s Mark, as applied to its goods, so resembles Opposer’s Mark as to be likely to cause confusion, mistake, or deception under Section 2(d) of the Trademark Act. Opposer has not pleaded (and it will be impossible to prove) that Applicant’s Mark is likely to cause confusion in the marketplace.

### **a. Standing**

Standing is a threshold issue that must be proved in every inter partes case. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). *See also Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185,

189 (CCPA 1982) (“The facts regarding standing . . . must be affirmatively proved. Accordingly, [plaintiff] is not entitled to standing solely because of the allegations in its [pleading].”) Opposer has not pleaded facts sufficient to show a personal interest in Applicant’s Mark beyond that of the general public. There should be no opposition where Opposer is no more than an intermeddler. As such, the opposition should be dismissed for failure to state a claim. *Id.*

**b. Section 2(d) Claim**

The only basis for the opposition cited by Opposer is that Applicant’s Mark “is identical or confusingly similar to” Opposer’s Mark. Opposer provides no proof or evidence of any way that Applicant’s Mark could or would be likely to cause consumer confusion.

To survive a motion to dismiss under Rule 12(b)(6), “. . . a complaint must ‘state a claim to relief that is plausible on its face.’” TBMP §503.02, citing *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007) and *Ashcroft v Iqbal*, 556 U.S. 662, 129 S.C. 1937 (2009). Opposer has identified only one ground for its opposition (Section 2(d) – likelihood of confusion), but has failed to plead any facts which would support any of Opposer’s claims for relief or provide a basis for standing. Because Opposer has failed to state a claim for relief that is plausible on its face, Opposer’s opposition must be dismissed.

Section 2(d) provides a basis for an opposition if Applicant’s Mark “. . . so resembles a mark previously registered in the 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 or services of the defendant*, to cause confusion, or to cause mistake, or to deceive.”

TBMP §309.03(c)(1) (emphasis added).

The requirements for asserting a claim under Section 2(d) are very specific. Not only must there be an allegation of prior registration or prior use of a trademark or trade name, there must be an allegation that applicant/defendant's mark also must be likely, when used in connection with the goods or services of the applicant/defendant, to cause confusion, or to cause mistake, or to deceive. In the notice of opposition, Opposer does nothing more than provide Opposer's allegation that Applicant's Mark "is identical or confusingly similar" to Opposer's Mark. The notice of opposition is simply not plausible on its face. *See Iqbal*, 556 U.S. 662, 129 S. Ct. at 1949 (*citing Twombly*, 550, U.S. at 555) (holding that a claimant must allege well-pleaded facts and "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice" and are not to be accepted as true when faced with a motion to dismiss).

In assessing "likelihood of confusion," a Section 2(d) claim necessarily involves a comparison of an opposer's mark as used for opposer's goods and services, with the applicant/defendant's mark as used for the applicant/defendant's goods and services. Asserting that one will suffer economic damage, without asserting a basis for likelihood of confusion based on prior use or registration of a name or mark, is not sufficient to support a claim for relief under Section 2(d). *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752 (Fed. Cir. 1998). Asserting prior use of a name or mark, without asserting likelihood of confusion, does not support a claim under Section 2(d). *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154 (TTAB 1985).

Similar and even identical marks do not immediately result in a likelihood of confusion under the Lanham Act. Rather, the Board must apply the enumerated factors cited in *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) to determine a

likelihood of confusion. Such factors include, without limitation, (1) the similarity or dissimilarity of the goods or services, (2) the similarity or dissimilarity of established, likely-to-continue trade channels, (3) the condition under which buyers to whom sales are made, *i.e.* “impulse” vs. careful, sophisticated purchasing, (4) the fame of the prior mark, (5) the nature and extent of any confusion, (6) the market interface between Applicant and Opposer, and (7) the extent of potential confusion. *Id.* At 1361, 177 USPQ at 567. Applicant does not list all the *duPont* factors, as “only factors of significance to the particular mark need be considered.” *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257,1259 (Fed. Cir. 2010). As will be shown below, Opposer has no reasonable expectation of producing any evidence that could establish a possibility, much less a likelihood, of confusion. There is simply no genuine issue as to any fact that would be material to the Board’s decision on the question of likelihood of confusion in the opposition.

**i.**      *The Goods and Services*

The Board must compare the parties’ respective goods and services as they are identified in the applications at issue. Opposer’s services encompass only “education services” related to blogging and web content management. Applicant’s goods include wood preservatives and fungicides. There is no likelihood of confusion between the services of Opposer and the goods of Applicant. In fact, Applicant was unable to find any record of a single entity both (1) producing wood preservatives or fungicides, and (2) providing educational services in the blogging and web content industries, let alone doing so under the same mark. There is no viable relationship between Applicant’s goods and Opposer’s services.

**ii.**     *The Established, Likely-to-Continue Trade Channels*

Because the goods of Applicant and the services of Opposer are not related, the channels of trade and classes of purchasers are vastly different for the goods and services. The Board must presume that Applicant's goods and Opposer's services travel in all normal channels of trade for their respective goods and services. Applicant knows of no trade channels that provide both Applicant's goods and Opposer's services. The third *duPont* factor favors a finding of no likelihood of confusion.

**iii.**     *Condition Under Which Buyers Make Purchasing Decisions*

Applicant is unaware of the purchasing decision process of Opposer's consumers. Applicant's customers, however, are mainly large utility companies and contractors in the utility business. These utilities and contractors are well-versed in the wood preservative and fungicide industries, and they spend a great deal of time researching and testing various products. The purchase of Applicant's goods is not an "impulse" buy, and is not routinely sold to the general public. Rather, Applicant's goods are purchased by customers making an informed purchasing decision. The likelihood of confusion seems, at best, remote. *See Fla. Int'l Univ. Bd. of Trustees v. Fla. Nat'l Univ., Inc.*, 91 F.Supp.3d 1265 (S.D. Fla. 2015), *aff'd*, 830 F.3d 1242 (11<sup>th</sup> Cir. 2016) (holding that the likelihood of confusion between two products or services seems "remote considering the level of sophistication and the amount of investigation one would expect from prospective [purchasers]").

**iv.**     *Fame of Opposer's Mark*

Opposer has not provided any allegation or evidence that Opposer's Mark is famous, either in general or in its industry. Although the Opposer claims in the opposition that Opposer's Mark is "internationally well-known," such an allegation offers no proof of such a claim, and

does not render Opposer's Mark famous, for likelihood of confusion purposes. Applicant found no evidence establishing that Opposer's Mark is strong, let alone famous. A recent search of the USPTO records shows more than 500 uses of the term "101" in marks across several international classes. *See Exhibit A.*

**v.**      *Nature and Extent of Any Confusion*

Opposer has not provided any allegation or evidence that there is, or will likely be, any confusion in the marketplace between Opposer's services and Applicant's goods.

**vi.**     *Market Interface*

Given the extreme differences between Applicant's goods and Opposer's services, it is highly unlikely that Applicant and Opposer will ever interface in the marketplace. The likely purchasers are not at all related or likely to purchase products and services from each party.

**vii.**    *Extent of Potential Confusion*

As stated above, the mere similarity between two marks does not equate to a likelihood of confusion. Opponent's Mark and Applicant's Mark are marketed to such vastly differing sets of consumers, that no confusion is even potential, let alone likely.

**4. Conclusion.**

With respect to its claims under §2(d) of the Lanham Act, Opposer has merely alleged the conclusion it hopes to establish without providing the facts necessary to prove the conclusion. *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45, 47-48 (TTAB 1985). 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.



**WHEREFORE**, for the reasons stated herein, Applicant respectfully requests that the Board:

- A. Dismiss Opposer's opposition against Applicant with prejudice for failure to state a claim pursuant to Fed.R.Civ.P §12(b)(6);
- B. Enter judgment in favor of Applicant and against Opposer;
- C. Provide such other and further relief as the Board deems just and proper.

Respectfully submitted this 6<sup>th</sup> day of September 2017.

By:  /s/ William J. Robers  
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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **Motion to Dismiss Opposition and Brief in Support of Motion** has been served on Shawn D. Hesketh, Opposer, by forwarding said copy on September 6, 2017, via email to shawn@wp101.com.

This the 6<sup>th</sup> day of September 2017.

/s/ William J. Robers  
William J. Robers  
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# **EXHIBIT A**



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	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	87594296		101 DREAM VACATIONS	TSDR	LIVE
2	87435624		WITNESSING: 101	TSDR	LIVE
3	87425227		101 FINANCIAL	TSDR	LIVE
4	87476048		101 ZHANG GUANG 101	TSDR	LIVE
5	87587755		AWARD TRAVEL 101	TSDR	LIVE
6	87419409		SUGAR 101	TSDR	LIVE
7	87416751		EBOUTIQUE 101	TSDR	LIVE
8	87390049		101 DREAM VACATIONS	TSDR	LIVE
9	87325656		BRAID 101	TSDR	LIVE
10	87574605		STREET COLLEGE 101	TSDR	LIVE
11	87049850		HORSE RACING 101	TSDR	LIVE
12	87425931		YARD TALK 101	TSDR	LIVE
13	87214943		THE SHED DISTILLERY OF PJ RIGNEY 1ST DISTILLERY IN CONNACHT FOR 101 YEARS DRUIM SEAN-BO	TSDR	LIVE
14	87562859		BUSINESSMINDSET101	TSDR	LIVE
15	87361688		B L 101	TSDR	LIVE
16	87361653		BASEBALL LIFESTYLE 101	TSDR	LIVE
17	87449424		PIZZA 101 SOUTH	TSDR	LIVE
18	87552855		COLLEGE GOLF CONSULTATION 101	TSDR	LIVE
19	87552817		COLLEGE ATHLETIC SCHOLARSHIPS 101	TSDR	LIVE
20	87552730		PROFESSIONAL TENNIS COLLEGE 101	TSDR	LIVE
21	87551828		PROFESSIONAL GOLF COLLEGE 101	TSDR	LIVE
22	87375233		FLIGHTANXIETY 101	TSDR	LIVE
23	87304926		MUSEUM OF SCIENCE RUTHENIUM 44 RU 101.07 NITROGEN 7 N 14.007	TSDR	LIVE
24	87304917		MUSEUM OF SCIENCE RUTHENIUM 44 RU 101.07 NITROGEN 7 N 14.007	TSDR	LIVE
25	87134213		BABY 101	TSDR	LIVE
26	87526857		US 101 COUNTRYFEST	TSDR	LIVE
27	87520832		101 BAIL BONDS	TSDR	LIVE

28	87520306		MY WELL-BEING 101	TSDR	LIVE
29	87334876		101 DINING LOUNGE AND BAR	TSDR	LIVE
30	87512381		ZEARN 101	TSDR	LIVE
31	87512321		AMERICA 101	TSDR	LIVE
32	87350640		NAME SCIENCE 101	TSDR	LIVE
33	87318775		LOUIS VUITTON TRUNKS & BAGS TOKYO ROME LONDON GENEVA SHANGHAI SAIPAN HONG KONG SYDNEY NEW YORK SAINT - TROPEZ PARIS_101, AVENUE DES CHAMPS - ELYSEES LOS ANGELES BANGKOK HONOLULU NICE MEXICO OSAKA LAS VEGAS MOSCOW MILANO FLORENCE	TSDR	LIVE
34	87318688		LOUIS VUITTON TRUNKS & BAGS TOKYO ROME LONDON GENEVA SHANGHAI SAIPAN HONG KONG SYDNEY NEW YORK SAINT - TROPEZ PARIS_101, AVENUE DES CHAMPS - ELYSEES LOS ANGELES BANGKOK HONOLULU NICE MEXICO OSAKA LAS VEGAS MOSCOW MILANO FLORENCE	TSDR	LIVE
35	87312773		SKILL DOC 101	TSDR	LIVE
36	87193229	5238336	101 BAIL BONDS	TSDR	LIVE
37	87055486	5235138	WORLD SCHOOL 101	TSDR	LIVE
38	87502925		DEAF REALITY 101	TSDR	LIVE
39	87349002		BRUSHMADE 101 PROOF	TSDR	LIVE
40	87335583		HANDBAG DESIGNER 101	TSDR	LIVE
41	87191376		CANNABIS TALK 101	TSDR	LIVE
42	87481791		ROOT 101	TSDR	LIVE
43	87383618		WEST BAY MUSCLE US 101 INTERSTATE 880 INTERSTATE 580 INTERSTATE 280 MOPAR FORD	TSDR	LIVE
44	87479968		ROOT 101 NURSERY	TSDR	LIVE
45	87297358		SAVINGS 101	TSDR	LIVE
46	87371626		BEAUTY & BARBELLS 101	TSDR	LIVE
47	87369833		PROBATE REAL ESTATE SALES 101	TSDR	LIVE
48	87105460	5216751	ESTIMATING 101 ELECTRICAL ESTIMATING & TRAINING SOLUTIONS	TSDR	LIVE
49	87378809		RADIO STATION COLLECTION RADIO STATION COLLECTION 88.1 88.5 88.7 88.9 89.5 89.7 89.9 90.9 91.3 92.3 92.7 92.9 93.1 93.5 93.9 94.1 94.3 94.7 95.1 95.3 95.5 95.7 95.9 96.1 96.2 96.5 96.7 96.9 97.1 97.3 97.5 97.7 98.1 98.3 98.7 98.9 99.1 99.3 99.7 99.9 100.3 100.5 100.7 100.9 101.1 101.3 101.5 101.9 102.2 102.3 102.5 102.7 102.9 103.7 104.1 104.5 104.7 104.9 105.1 105.3 105.7 105.0 106.1 106.5 106.7 106.9 107.1 107.3 107.7 107.9 108.0	TSDR	LIVE
50	87341999		FASTENERS 101	TSDR	LIVE