ESTTA Tracking number: **ESTTA862279**

Filing date: **12/04/2017**

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

| | |
|---|---|
| Proceeding | 91237053 |
| Party | Plaintiff<br>The Port Authority of New York and New Jersey |
| Correspondence Address | MICHAEL GELLER<br>DLA PIPER LLP<br>444 WEST LAKE STREET, SUITE 900<br>CHICAGO, IL 60606-0089<br>UNITED STATES<br>Email: michael.geller@dlapiper.com, keith.medansky@dlapiper.com, leon.medzhibovsky@dlapiper.com, ch.tm@dlapiper.com |
| Submission | Opposition/Response to Motion |
| Filer's Name | Michael Geller |
| Filer's email | michael.geller@dlapiper.com, keith.medansky@dlapiper.com, leon.medzhibovsky@dlapiper.com, ch.tm@dlapiper.com |
| Signature | /Michael Geller/ |
| Date | 12/04/2017 |
| Attachments | Response to Motion to Dismiss.pdf(41906 bytes ) |

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

In re Serial No. 87/078,651
Mark: WORLD TRADE CITY
Filed: June 21, 2016
Published: June 6, 2017

| | | |
|---|---|---|
| THE PORT AUTHORITY OF NEW YORK AND NEW JERSEY<br><br>Opposer,<br><br>v.<br><br>INTERNATIONAL EXPORT IMPORT ORGANIZATION, INC. and DAVID LEE<br><br>Applicants. | ) | Opposition No.: 91237053 |

**OPPOSER'S PROTECTIVE RESPONSE TO APPLICANTS' MOTION TO DISMISS**

The Port Authority Of New York And New Jersey ("Opposer"), by and through its counsel, hereby files a protective response to International Export Import Organization, Inc.'s and David Lee's (collectively, "Applicants") motion to dismiss (the "Motion to Dismiss"). Pursuant to Fed. R. Civ. P. Rule 15(a)(1)(B) and Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 503.03, Opposer has contemporaneously filed an amended notice of opposition ("Amended Notice of Opposition"). Therefore, pursuant to Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 503.03, the Opposer requests that the Applicants' Motion to Dismiss be deemed moot.

If, however, the Board does not deem the Motion to Dismiss to be moot, Opposer requests that the Trademark Trial and Appeal Board (the "Board") either: (i) suspend the proceeding pending the outcome of civil litigation which bears on the current opposition (the "Opposition") pursuant to the contemporaneously filed motion to suspend ("Motion to

Suspend"); or (ii) deny the Motion to Dismiss and subsequently suspend the proceeding pending the outcome of litigation which bears on the current opposition. In support thereof, Opposer states as follows.

## I. THE OPPOSITION SHOULD BE SUSPENDED.

Pursuant to 37 CFR § 2.117(a) and TBMP § 510.02(a), Opposer has contemporaneously filed a request for suspension of the Opposition pending the outcome of federal court litigation pending in the United States District Court for the Southern District of New York (Civil Case No. 1:15-cv-07411-LTS-RWL) between Opposer and World Trade Centers Association, Inc. regarding Opposer's use and ownership of the WORLD TRADE CENTER trademark (the "Litigation").

The outcome of the Litigation may substantially bear on the ultimate disposition of this Opposition. Indeed, the Motion to Dismiss concedes the same. *See* Motion to Dismiss, p. 4 - 5. Specifically, in its Amended Counterclaims in the Litigation, Opposer alleges that it has used the WORLD TRADE CENTER mark for more than 50 years, and that:

> [t]he Port Authority, not WTCA, owns the goodwill in, and right, title and interest to, the [WORLD TRADE CENTER and WTC marks] in connection with goods and services offered at or in connection with the World Trade Center site. . . . Accordingly, the Port Authority is the proper owner of the Marks . . . in connection with all of the activities it conducts at or in connection with the World Trade Center site.

Amended Counterclaims, *World Trade Centers Association Inc. v. The Port Authority of New York and New Jersey*, Case No. 1:15-cv-07411-LTS-RWL, p. 15 – 16. The Litigation bears substantially on the rights of Opposer to enforce its rights in the WORLD TRADE CENTER and WTC marks, and the outcome of the Litigation clearly has a substantial impact on this

proceeding, which is an effort by Opposer to enforce its rights in the WORLD TRADE CENTER mark.

Opposer, therefore, requests suspension of the Opposition until a final determination of the Litigation. Alternatively, if the Board chooses to rule on the Motion to Dismiss at this time, Opposer requests that it deny the Motion to Dismiss for the reasons stated herein and subsequently suspend the Opposition pending the outcome of the Litigation.

## II. OPPOSER'S NOTICE OF OPPOSITION STATES A PROPER CLAIM ON WHICH RELIEF MAY BE GRANTED AND THE MOTION SHOULD BE DENIED.

The Motion to Dismiss appears to set forth five separate reasons for why Opposer has failed to state a claim: (i) Opposer purportedly pleaded "labels and conclusions;" (ii) Opposer lacks standing; (iii) Opposer fails to allege a protectable right; (iv) Opposer fails to state a claim under Lanham Act § 1(a); and (v) Opposer fails to state a claim under Lanham Act § 2(d).

The Motion to Dismiss is a combination of mere unsupported legal conclusions and an attempt to litigate this case at the motion to dismiss stage. The Motion to Dismiss wholly fails to address the adequacy of Opposer's well-pleaded Notice of Opposition, and instead requests that the Board make legal and factual conclusions which are clearly improper on a motion to dismiss under Fed. R. Civ. P. Rule 12(b)(6).

### A. The Notice of Opposition Clearly States a Claim On Which Relief May Be Granted.

A motion to dismiss based on Fed. R. Civ. P. 12(b)(6) is "solely a test of the legal sufficiency of the notice of opposition." *DC Comics v. Onetech Computer Consulting Inc.*, 76 U.S.P.Q. 2d 1472, 2005 WL 2874745, at *1 (T.T.A.B. Aug. 5, 2005). On such a motion, the Board must accept all of the opposer's well-pleaded allegations as true and must draw reasonable

inferences in the opposer's favor. *Juniper Networks Inc. v. Shipley*, 643 F. 3d 1346, 1352 (Fed. Cir. 2011) (citing *Metzler Inv. GmbH v. Corinthian Colls., Inc.*, 540 F.3d 1049, 1064-65 (9th Cir. 2008)).

The Board will deny a motion to dismiss if the facts alleged in the notice of opposition "sufficiently demonstrate that petitioner has a facially plausible claim for relief." *Ashcroft v. Iqbal*, 556 U.S. 662 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). A facially plausible claim exists where factual claims are pleaded which, if proved, allow the Board to conclude or infer that a valid ground for the opposition exists. *Encore Seating, Inc.*, 2017 WL 3668671, at *3 (T.T.A.B. Aug. 18, 2017) [not precedential] (citing *Twombly*, 550 U.S. at 556). Again, the Board must accept the pleaded factual content as true. *Twombly* , 550 U.S. at 555.

The Motion to Dismiss claims that Opposer's Notice of Opposition simply pleads "labels and conclusions," but it does not provide any explanation or support for this conclusory assertion. *See Motion*, ¶ 3. Applicants' contention is plainly false.

The Notice of Opposition carefully details Opposer's history in establishing rights in the WORLD TRADE CENTER mark through actual use of the mark and under New York state and New Jersey state law. *Notice of Opposition*, ¶¶ 2- 4. The Notice of Opposition plainly pleads that Opposer owns the WORLD TRADE CENTER mark, which is nearly identical to Applicants' WORLD TRADE CITY mark, in connection with the same services as identified in the Application, or services similar thereto. *Notice of Opposition*, ¶¶ 2- 4. The Notice of Opposition furthermore pleads that granting registration of the WORLD TRADE CITY mark to Applicants will: (i) disrupt the Opposer's statutory right to exclusively use and control the WORLD TRADE CENTER mark; and (ii) deprive Opposer the right to use its mark exclusively

under statute. *Notice of Opposition*, ¶¶ 5- 6. Additionally, the Notice of Opposition pleads that the Application, which was filed under Lanham Act § 1(a) is not in use and was not in use as of the claimed first use date in the Application. *Notice of Opposition*, ¶¶ 7.

The Notice of Opposition plainly sets forth claims on which relief may be granted under Lanham Act §§ 1(a) and 2(d). It pleads specific facts regarding Opposer's ownership of the WORLD TRADE CENTER mark, and it does not merely list "labels and conclusions." Indeed, the Motion to Dismiss does not provide any explanation of what Applicants consider to be "labels and conclusions," and it does not attack the sufficiency of the pleading. The purpose of a pleading is merely "to give fair notice of the claims," *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999), and the Notice of Opposition clearly gives such fair notice.

Because Opposer's Notice of Opposition plainly states a claim on which relief may be granted, the Motion to Dismiss should be denied.

**B. <u>The Notice Of Opposition Clearly Demonstrates Opposer's Standing By Pleading Its Rights in the WORLD TRADE CENTER Mark.</u>**

To demonstrate standing, a party must simply allege facts that show that it has a "real interest" in the proceeding and a "reasonable basis" for its belief of damage. *Ritchie v. Simpson*, 170 F.3d 1092, 1096 (Fed. Cir. 1999); *see also Kiko S.p.A. v. Kokie Cosmetics, Inc.*, 2017 WL 3065263, at *2 (T.T.A.B. June 30, 2017) [non-precedential] (finding that the opposer had a real interest in the dispute and was not "a mere interloper"). Put differently, "the Board determines whether opposer's belief 'is not wholly without merit.'" *DC Comics,* 2005 WL 2874745, at *1 (quoting *Lipton Industries, Inc. v. Ralston Purina Co.* , 213 U.S.P.Q. 185, 187 (C.C.P.A. 1982)). Standing may be established by pleading prior ownership of a competing common law

trademark. *Benjamin J. Giersch v. Scripps Networks, Inc.*, 90 U.S.P.Q.2d 1020, 2009 WL 706673, at *2-3 (T.T.A.B. Mar. 16, 2009).

A "real interest in a proceeding" may be demonstrated by a pleading 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); Trademark Trial and Appeal Board Manual of Procedure § 309.03(b) (hereinafter "TMBP"). A motion to dismiss only challenges the legal theory of the complaint, not the sufficiency of the evidence. *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *see also* TBMP §§ 503.01 - 02.

Opposer pleaded that it has established and used the WORLD TRADE CENTER mark in connection with services offered relating to the "WORLD TRADE CENTER" buildings including, but not limited to, those services identified in the Application, or services similar thereto. Opposer is not required to submit evidence or proof regarding these services at this stage of the proceeding. Opposer has plainly alleged it has a stake in the outcome of this dispute, and that it is not a stranger or a mere interloper in this matter.

Given that Opposer pleaded ownership rights for a mark which is confusingly similar to the Applicants' mark which Opposer uses in connection with the same or similar services as the Applicant, Opposer has properly demonstrated its standing.

C. **Opposer Pleaded A Protected Trademark Right in the WORLD TRADE CENTER Mark.**

As stated above, Opposer clearly pleaded an ownership interest in the WORLD TRADE CENTER trademark. *See also* Notice of Opposition, ¶ 5. Applicants' Motion to Dismiss claims that "Oppposer [sic] does not possess a protectable interest in the [WORLD TRADE CENTER mark]." This is clearly false. Opposer's notice of opposition clearly pleaded Opposer's rights in

the WORLD TRADE CENTER trademark, as well as the harm that will result from registration of Applicants' WORLD TRADE CITY mark.

**D. Applicants' Unsubstantiated Claims of Use Are Irrelevant on a Motion to Dismiss.**

Applicants claim that the Notice of Opposition fails to state a claim under Lanham Act § 1(a) because Applicant has purportedly used its mark. However, as stated above, a motion to dismiss only challenges the legal theory of the complaint, not the sufficiency of the evidence. *Advanced Cardiovascular Systems*, 988 F.2d at 1164; *see also* TBMP §§ 503.01 and 503.02. Applicants' arguments appear to veer from a typical motion to dismiss in that they dispute what ultimately can be proven at trial rather than whether what was alleged is sufficient. This is clearly improper on a motion to dismiss.

Because Opposer properly pleaded that Applicants' mark is not, in fact, in use, it has properly asserted a claim under Lanham Act § 1(a), and the Motion to Dismiss should be denied.

**E. Applicants' Arguments Against Likelihood of Confusion Are Irrelevant on a Motion to Dismiss.**

Applicants submitted more than ten pages arguing that their mark is not confusingly similar to Opposer's WORLD TRADE CENTER mark. These arguments are irrelevant.

Whether a likelihood of confusion actually exists is not a matter to be decided on a motion to dismiss. *Advanced Cardiovascular Systems*, 988 F.2d at 1164. Indeed, the TBMP specifically instructs opposers facing a motion to dismiss under Fed. R. Civ. P. Rule 12(b)(6) to refrain from "submitting proofs in support of its complaint." TBMP § 503.02. Applicants' arguments are therefore clearly improper on a motion to dismiss.

Accordingly, Applicants' attempts to submit arguments that their mark does not create a likelihood of confusion with Opposer's mark are irrelevant on this motion, and the Motion to Dismiss should be denied.

## III. CONCLUSION

**WHEREFORE**, for the reasons stated herein, Opposer requests that the Board (i) suspend this proceeding prior to ruling on Applicants' Motion to Dismiss as requested in the accompanying Motion to Suspend, or (ii) alternatively deny Applicants' Motion to Dismiss and subsequently suspend this proceeding pending the conclusion of the litigation between Opposer and the World Trade Centers Association Inc.

Dated: December 4, 2017

Respectfully submitted,

**THE PORT AUTHORITY OF NEW YORK AND NEW JERSEY**

By: /s/ Michael A. Geller

DLA PIPER LLP (US)
Leon Medzhibovsky
Leon.Medzhibovsky@dlapiper.com
Keith W. Medansky
Keith.Medansky@dlapiper.com
Michael A. Geller
Michael.Geller@dlapiper.com
DLA Piper LLP (US)
444 West Lake Street, Suite 900
Chicago, Illinois 60606

*Attorneys for Opposer*

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of this correspondence is being emailed to the correspondent of record:

International Export Import Organization, Inc.
International Export Import Organization, Inc.
6606 Schurtz Street
ITO/EXIM
Alexandria, Virginia United States 22310
info@iexim.org
info@internationaltradeorganization.org

/s/ Michael A. Geller
Signature

Michael A. Geller
Name

December 4, 2017
Date of Signature