

ESTTA Tracking number: **ESTTA957018**

Filing date: **02/27/2019**

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

Proceeding	91245272
Party	Plaintiff Amer Group Inc.
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Date	02/27/2019
Attachments	Opposition No. 91245272 Opposition to Motion to Suspend.pdf(155614 bytes)

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

AMER GROUP INC.)
)
 Opposer,)
)
 v.)
)
 ALIBABA GROUP HOLDING LIMITED)
)
 Applicant.)
)

Opposition No. 91245272
Application Serial No. 87/628472

Attorney's Reference: 136134-492042

OPPOSER'S RESPONSE IN OPPOSITION TO APPLICANT'S MOTION TO SUSPEND

Opposer, Amer Group, Inc., respectfully submits its response in opposition to Applicant's Motion to Suspend, pursuant to 37 C.F.R. § 2.127(a).

ARGUMENT

Opposer does not consent to Applicant's Motion to Suspend and it should be denied. The decision to suspend a Board proceeding pending the outcome of another proceeding between the same parties is in the Board's discretion and is not required. 37 CFR § 2.117(a). The Board should deny Applicant's motion for the following reasons: (1) the outcome of the related opposition proceeding will not have a bearing on instant proceeding; and (2) judicial economy will not be served by suspending the instant proceeding.

I. The Outcome of Opposition No. 91233862 Will Not Have A Bearing on the Instant Opposition Proceeding

Applicant argues that the outcome of Opposition No. 91233862 "more than likely" have a bearing on the instant proceeding because the parties are the same, the marks at issue and the goods/services associated therewith are "substantially, if not exactly, the same" and the issue of likelihood of confusion is the same.

Applicant's characterization of the similarities between the proceedings is misleading. First, the goods/services associated with the marks are not substantially the same and are certainly not exactly the same. Application No. 87/628472 at issue here has substantially more goods and services than the registrations asserted in Opposition No. 91233862. Opposition No. 91233862 will not address a likelihood of confusion with respect to these additional goods and services.

Second, the issue of likelihood of confusion is not the same. Applicant asserts in Opposition No. 91233862 that Opposer's APAY mark will be confused with various of Applicant's ALIPAY registrations. The Board in its February 6 denial of Applicant's motion for summary judgment (attached as Exhibit A) stated there was a genuine issue of material fact regarding "the similarity or dissimilarity of the marks and the strength of, and scope of protection that should be given to, Opposer's marks" (February 6, 2019 Petition Motion for Summary Judgement Denied, pg. 6). Thus, while the Board must consider the similarity of the marks in Opposition No. 91233862, its ultimate decision will also be incumbent on the strength of Applicant's marks. The instant Opposition would not concern itself with the strength of Applicant's mark; rather, it would focus on the strength of Opposer's mark. Under these circumstances, the likelihood of confusion issue is not the same, and the outcome of this issue in Opposition No. 91233862 will not be determinative of the outcome here.

Finally, in addition to likelihood of confusion, Opposer alleged that Applicant lacked a bona fide intent to use the mark in connection with all the goods and services listed in Applicant's application. Opposition No. 91233862 will have no bearing on this claim.

Based on the foregoing, Opposition No. 91233862 will not have a bearing on the instant Opposition proceeding. However, even if it is possible that Opposition No. 91233862 will have a

bearing on this proceeding, at this point there is uncertainty regarding its impact because of the fact that Applicant has not submitted its Answer setting forth its position on Opposer's claims. Accordingly, Applicant's Motion to Suspend is premature, and the Board should not grant it.

II. Judicial Economy Will Not Be Served by Suspending the Instant Proceeding

Suspension may be favored in certain circumstances in light of the potential for civil actions to provide judicial economy by adjudicating broader issues than the right to registration. TBMP § 510.02(a). Although this is a reasonable policy in some circumstances, Opposer respectfully asserts that there is no judicial economy achieved by suspending the present case.

Opposition No. 91233862 is not a civil action and therefore does not adjudicate broader issues than the right to registration. Further, it will not have a bearing on the outcome of the present Opposition. Accordingly, there is no judicial economy in suspending this case to await the outcome of Opposition No. 91233862.

Based on the foregoing, the instant Opposition must proceed and should not be suspended.

CONCLUSION

Because Opposition No. 91233862 will not have a bearing on the instant Opposition, or is not certain to have a bearing in the absence of Applicant's Answer, and because judicial economy will not be served by suspending this proceeding, Applicant's Motion to Suspend should be denied and this Opposition should proceed as scheduled.

Respectfully submitted,

Date: February 27, 2019

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The undersigned, attorney for Opposer, hereby certifies that she served, by e-mail, a copy of the foregoing Opposer's Response in Opposition to Applicant's Motion to Suspend and Exhibits upon

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this 27th day of February, 2019

/Catherine Mitros/
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THIS OPINION IS NOT A
PRECEDENT OF THE
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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JMM/DUNN

February 6, 2019

Opposition No. 91233862

Alibaba Group Holding Limited

v.

Amer Group Inc.

**Before Cataldo, Taylor, and Greenbaum,
Administrative Trademark Judges.**

By the Board:

This proceeding now comes before the Board for consideration of Alibaba Group Holding Limited's ("Opposer") motion, filed October 2, 2018, for summary judgment on its claim of likelihood of confusion under Section 2(d) of the Trademark Act. The motion is fully briefed.

For purposes of this order, we presume the parties' familiarity with the pleadings and the parties' arguments and evidence submitted in connection with the motion.

I. RELEVANT FACTS

Amer Group Inc. ("Applicant") seeks to register the mark APAY in standard characters for numerous services, including the following:

Payment processing services, namely, credit card and debit card transaction processing services; Providing electronic processing of credit card transactions and electronic

payments via a global computer network; financial services, namely, processing and administration of mobile payments and contactless debit and credit card transactions, loyalty reward card transactions, and bill payment transactions with retailers, merchants, and vendors via mobile devices, in International Class 36; and

Providing user authentication of electronic funds transfer in the nature of mobile payments, contactless credit and debit card transactions, gift card transactions, loyalty reward card transactions, and bill payment transactions with retailers, merchants, and vendors via mobile devices, in International Class 45.¹

Opposer pleaded prior common law use² and registration of the mark ALIPAY in standard characters and stylized form, as set forth in the chart below:

Reg. No. (Issue Date)	Mark	Relevant Goods and Services ³
3761346 (3/16/10) [Section 8 declaration accepted]	ALIPAY (standard character)	authentication software for authenticating the identity of a payer; recorded computer programs for processing electronic payments and/or authenticating the identity of a payer (Int. Cl. 9) online banking services and financial services, namely, credit card or/and debit card processing services, and transmission and processing of bills and payments thereof, conducted via a global computer network (Int. Cl. 36)
4036742 (10/11/11) [Partial Section 8]	 (ALIPAY in stylized form) ⁴	credit card services; electronic payment, namely, electronic processing and transmission of bill payment data; electronic funds transfer services; financial services in the nature of credit card and

¹ Application Serial No. 86821204, filed November 16, 2015, based on an assertion of a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

² Opposer claims common law rights in the ALIPAY and ALIPAY & Design marks for use with numerous goods and services, including those cited in above-listed chart. 1 TTABVue 24.

³ Certain of the registrations include additional goods and/or services not at issue here.

⁴ The registration includes the following description of the mark: “The mark consists of the word ‘Alipay’ in stylized lettering with a diamond shape appearing as the dot on the letter ‘I’ and at the end of the word, and a curved line underneath, displayed above the word ‘ALIPAY’ in the same stylized lettering in black, with a diamond shape appearing as the dot on the

declaration accepted]		debit card payment processing services; credit card verification via global computer information network (Int. Cl. 36)
5071223 (11/01/16)	ALIPAY (standard character)	education, namely, providing live and online seminars and conferences in the field of business and e-commerce (Int. Cl. 41)

Applicant, in its answer, denied the salient allegations in the notice of opposition, and did not assert any affirmative defenses or counterclaims. Discovery closed September 21, 2018.

II. OPPOSER’S MOTION FOR SUMMARY JUDGMENT

Opposer moves for summary judgment and contends that it has established priority through its ownership of the pleaded ALIPAY registrations, and its testimony and exhibits establishing its common law use of ALIPAY marks since at least as early as 2013. Opposer further contends that the APAY and ALIPAY marks are confusingly similar in sight, sound, connotation, and commercial impression; that the parties’ respective services are confusingly similar to the extent that they are not identical; and that the parties’ goods and services are likely to have the same or similar trade channels. In support of its motion, Opposer relies on (1) status and title copies of its pleaded registrations, which were attached to the notice of opposition, (2) the declaration from counsel for Alipay.com Co., Ltd., a licensee of Opposer, regarding use of Opposer’s marks, and (3) the declaration of counsel accompanying Applicant’s discovery responses indicating how Applicant intends to use its mark in commerce, and examples of how the public encounters Opposer’s marks.

letter ‘I’ and at the end of the word, and a curved line underneath.” Color is not claimed as a feature of the mark.

In opposition to the motion, Applicant contends that Opposer's marks are relatively weak and should receive only narrow protection, pointing to a handful of third-party registrations for marks beginning with A and ending with PAY for various financial and bill payment services as support.⁵ Applicant also contends that Opposer's marks are not similar in sight, sound, meaning, or appearance to Applicant's mark.⁶ Opposer's reply brief essentially repeats the arguments in its motion, offering a corrected summary of its pleaded registrations.⁷

III. DECISION

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute with respect to any material fact, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(a). A party moving for summary judgment has the burden of demonstrating that there is no genuine dispute of material fact remaining for trial and that it is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(c); *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). In

⁵ The Board notes that one of the third-party registrations relied upon by Applicant, Registration No. 4138820, was cancelled for failure to file an acceptable declaration under Section 8 and thus was given no consideration. *See, e.g., UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1872 n.2 (TTAB 2011) (A cancelled registration "is evidence only of the fact that it previously existed.").

⁶ Applicant's argument regarding outstanding discovery on the topic of potential counterclaims is unpersuasive. Opposer's motion for summary judgment was timely filed, and Applicant's recourse for deficient discovery responses, if applicable, would be a properly filed motion to compel. Moreover, if Applicant believed that it was unable to effectively oppose the motion for summary judgment without first taking the necessary discovery, it could have filed a motion for discovery under Fed. R. Civ. P. 56(d).

⁷ Opposer notes (15 TTABVUE 9) that Applicant has also failed to submit the registration certificates for the cited third-party registrations. This is unnecessary. *See* Trademark Rule 2.122(e); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1070 n.11 (TTAB 2011) (not necessary to submit title and status copies of third-party registrations prepared by Office; plain copies from the USPTO's electronic database sufficient).

considering the propriety of summary judgment, all evidence must be viewed in the light most favorable to the nonmovant, and all justifiable inferences are to be drawn in the nonmovant's favor. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993). This burden is greater than the burden of proof at trial, which is a preponderance of the evidence and which permits appropriate inferences to be drawn from the evidence of record. *See Gasser Chair Co. v. Infanti Chair Mfg. Corp.*, 60 F.3d 770, 34 USPQ2d 1822, 1824 (Fed. Cir. 1995). The Board may not resolve genuine disputes of material fact; it may only ascertain whether they exist. *See Opryland USA Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992).

To prevail on summary judgment on its claim of likelihood of confusion, Opposer must establish that there is no genuine dispute that it has standing to maintain this proceeding; that it has priority of use or that priority is not at issue; and that contemporaneous use of the parties' marks in connection with their respective goods or services would be likely to cause confusion, mistake or to deceive consumers. *See* 15 U.S.C. § 1052(d); *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001). Likelihood of confusion depends on an analysis of all of the probative facts in evidence that are relevant to the thirteen factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) (*du Pont*). The Board must deny summary judgment if there are genuine disputes as to any of these *du Pont* factors which would be material to a decision on the merits.

Here, Opposer's pleaded registrations establish its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Research in Motion Ltd. v. Defining Presence Mktg. Grp., Inc.*, 102 USPQ2d 1187, 1190-91 (TTAB 2012). They also remove priority as an issue with respect to the registered marks and goods/services recited in the registrations. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110-111 (CCPA 1974); *Loreal S.A. and Loreal USA, Inc. v. Marcon*, 102 USPQ2d 1434, 1436 (TTAB 2012) ("there can be no priority dispute when an opposer properly introduces its registrations into the record, and the applicant fails to file a counterclaim to cancel them").

Turning to whether there is any genuine dispute regarding a likelihood of confusion, upon a careful review of the record, we find that there is a genuine dispute of material fact regarding, at a minimum, the similarity or dissimilarity of the marks and the strength of, and scope of protection that should be given to, Opposer's marks.⁸ Accordingly, Opposer's motion for summary judgment is DENIED.

In denying this motion, we again note that the standard of proof for summary judgment is more stringent than the preponderance of evidence standard for trial. Evidence that may be sufficient to raise a genuine dispute may not be sufficient to rebut a *prima facie* case. *See* Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 528.01 (2018).⁹ The Board finds that summary judgment is not appropriate

⁸ The fact that this order identifies only a few material facts that are genuinely in dispute should not be construed as a finding that these are necessarily the only issues that remain for trial.

⁹ The parties are reminded that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced during the appropriate trial

here and bars the parties from filing further motions for summary judgment.

IV. PROCEEDINGS RESUMED

Proceedings are resumed. Remaining dates are reset as follows:

Plaintiff's Pretrial Disclosures Due	3/11/2019
Plaintiff's 30-day Trial Period Ends	4/25/2019
Defendant's Pretrial Disclosures Due	5/10/2019
Defendant's 30-day Trial Period Ends	6/24/2019
Plaintiff's Rebuttal Disclosures Due	7/9/2019
Plaintiff's 15-day Rebuttal Period Ends	8/8/2019
Plaintiff's Opening Brief Due	10/7/2019
Defendant's Brief Due	11/6/2019
Plaintiff's Reply Brief Due	11/21/2019
Request for Oral Hearing (optional) Due	12/1/2019

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

period. *See, e.g., Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); TBMP § 528.05(a).