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

Proceeding	91246333
Party	Plaintiff Tally Weijl Holding AG
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Application Serial No. 87/922372
Published: October 16, 2018

Tally Weijl Holding AG)	
)	
Opposer,)	
)	
v.)	Opposition No. 91246333
)	
Fun 4 US Kids, Inc.)	
)	
Applicant.)	

OPPOSITION TO APPLICANT’S MOTION TO DISMISS

Tally Weijl Holding AG (hereinafter “Opposer”), through its counsel, hereby opposes the Motion to Dismiss filed by Fun 4 US Kids, Inc. (hereinafter “Applicant”).

Because Opposer has established standing and stated a valid ground for denying registration to trademark application Serial No. 87/922372 for the mark FUN4TALLYKIDS & Design (“Applicant’s Mark”), Applicant’s Motion must be denied. The Motion does not challenge the legal sufficiency of Opposer’s claims; rather, it argues that Opposer has not proven likelihood of confusion, i.e., that registration of Applicant’s Mark should be refused pursuant to Section 2(d) of the Trademark Act of 1946, as amended, 15 U.S.C. § 1052(d). These arguments are not appropriate for a motion to dismiss.

BACKGROUND

Opposer timely filed a Notice of Opposition on February 11, 2019. As grounds for the opposition, Opposer relies on its ownership of prior United States Registration No. 4,811,291, for the mark TALLY WEIJL, which registered on June 29, 2010, United States Registration No. 4,192,507, for the mark TALLY WEIJL, which registered on August 21, 2012, and United States Trademark Application Serial No. 87/860541, for the mark TALLY (collectively, “Opposer’s Marks”).

In its Notice of Opposition, Opposer states that registration of Applicant’s Serial No. 87/922372 should be refused pursuant to Section 2(d) of the Trademark Act on the grounds that Applicant’s Mark so resembles Opposer’s Marks as to cause confusion, mistake and/or deception, thereby damaging Opposer. Notice of Opposition ¶ 30.

ARGUMENT

A. Applicant Misapplies the Standard for a Motion to Dismiss

A motion to dismiss for failure to state a claim relates “solely [to] the legal sufficiency of a complaint.” TBMP § 503.02. An opposer need not prove its case; rather, it must (1) establish that it has standing to maintain the proceeding and (2) a valid ground exists for denying the registration. *Id.* (citing *Young v. AGB Corp.*, 152 F.3d 1377 (Fed. Cir. 1998)).

Applicant’s Motion does not contest Opposer’s standing, that is, whether Opposer has a real interest in the outcome of the proceeding. Nor does the Motion claim that Opposer has failed to *allege* sufficient facts that would constitute a ground for denying registration of Applicant’s Mark.

Instead, Applicant mistakenly argues substantive issues involved in determining the likelihood of confusion. In other words, Applicant contends that the opposition should be

dismissed because Opposer will not ultimately prove its case. “Whether a plaintiff can actually prove its allegations is a matter to be determined not upon a motion to dismiss, but rather at a final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence in support of their respective positions. TBMP § 503.02 (citing *Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157 (Fed. Cir. 1993); *Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1697 n.3 (TTAB 2014)). Accordingly, Applicant’s Motion must be denied.

B. Opposer Has Established Standing to Oppose Registration of Applicant’s Mark

Opposer meets the requirements to establish standing in this opposition proceeding.

Section 13 of the Trademark Act, 15 U.S.C. § 1063, explains:

Any person who believes that he would be damaged by the registration of a mark upon the principal register ... may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor ...

15 U.S.C. § 1063.

There are two judicially-created requirements for standing, namely (1) the opposer must have a “real interest” in the proceeding; and (2) the opposer must have a “reasonable” basis for its belief of damage. *Ritchie v. Simpson*, 170 F.3d 1092, 1095 (Fed. Cir. 1999).

In the Notice of Opposition, Opposer alleges its ownership of Opposer’s Marks, which cover a wide variety of goods and services. Notice of Opposition ¶¶ 3-8. As such, Opposer has a “direct and personal stake” in the outcome of this opposition. *Ritchie*, 170 F.3d at 1095; *see also Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1029 (CCPA 1982) (standing can be established by “prov[ing] a real commercial interest in its own marks”).

Opposer also has a reasonable basis for its belief of damage. Specifically, Opposer has alleged that consumers are likely to be confused, mistaken or deceived as to the source of

Opposer and Applicant's goods and services. Accordingly, "[a]ny such confusion in the trade would inevitably result in loss of sales to Opposer" and "any defect, objection or fault found with Applicant's services marketed under the fun4tallykids & Design mark would necessarily reflect badly upon and significantly injure the reputation which Opposer has established for its products and services." Notice of Opposition ¶¶ 26-27. On a motion to dismiss, these allegations must be construed in the light most favorable to Opposer. *Pro-Football Inc. v. Nocona Leather Goods Co.*, 48 USPQ2d 1543, 1544 (TTAB 1998).

C. Opposer Has Adequately Pled a Statutory Ground for Denial of Registration of Applicant's Mark

Having properly pled its standing to bring this opposition, Opposer is entitled to rely on any legal ground supporting denial of registration of Applicant's Mark. Opposer alleges that registration should be refused pursuant to Section 2(d) of the Trademark Act. Notice of Opposition ¶ 30.

Specifically, Opposer alleges that consumers are likely to be confused, mistaken or deceived as to the source of Opposer and Applicant's goods and services because (1) the parties' marks are highly similar in sound and appearance; (2) Applicant's Mark covers services that may be associated with the goods and services covered by Opposer's prior registrations; and (3) the conditions surrounding the marketing of Opposer's goods and services are such that they are likely to be encountered by Applicant's purchasers under the same or similar circumstances. *Id.* at ¶¶ 13-23. These allegations, when proven, will establish that registration of Applicant's Mark is prohibited pursuant to Section 2(d) of the Lanham Act.

CONCLUSION

As Applicant has failed to demonstrate that Opposer lacks standing or has failed to state a plausible basis for relief, Opposer should be afforded the opportunity to proceed with this opposition proceeding. Opposer respectfully requests that Applicant's Motion to Dismiss be denied.

Respectfully submitted,

SMITH, GAMBRELL & RUSSELL, LLP

/SW/

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Date: April 8th, 2019

CERTIFICATE OF SERVICE

I hereby certify that on this 8th day of April, 2019, a true and accurate copy of the foregoing OPPOSITION TO APPLICANT'S MOTION TO DISMISS has been served by email upon counsel for Applicant at sada@khalilsheldon.com.

/SW/

Scott D. Woldow