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

Proceeding	91246333
Party	Defendant Fun 4 US Kids, 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

In the Matter of Trademark Application Serial No. 87/922372



Mark:

Filing Date: May 15, 2018

TALLY WEIJL HOLDING AG)	
Opposer,)	
)	
)	OPPOSITION
v.)	
)	
FUN 4 US KIDS, INC.)	
Applicant.)	Opposition No. 91246333

REPLY IN SUPPORT OF APPLICANT’S MOTION TO DISMISS

Opposer claims in response to Applicant’s Motion to Dismiss that Applicant is not entitled to a Motion to Dismiss because Opposer has adequately pled an Opposition.

First, Opposer claims that Applicant misapplies the standard for a Motion to Dismiss and that Applicant’s motion fails to argue that Opposer’s opposition fails to allege facts that would constitute grounds for denying registration of the Applicant’s Mark.

We agree with Opposer that a motion to dismiss is appropriate where an opposer fails to allege sufficient facts, that (1) the plaintiff has standing to maintain the proceeding, and (2) a

valid ground exists for opposing or cancelling the mark. TBMP § 503.02; *Young v. AGB Corp.*, 152 F.3d 1377, 47 U.S.P.Q.2D 1752, 1754 (Fed. Cir. 1998).

We disagree, however, that Opposer has alleged that valid grounds exist for denying the registration. When assessing whether valid grounds exist, an Opposition "must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face." *Doyle v. Al Johnson's Swed. Rest. & Butik Inc.*, 101 U.S.P.Q.2D 1780, 1782 (TTAB 2012) (quoting *Ashcroft v. Iqbal*, 556 U.S. 662, 678, 556 U.S. 662, 678 (2009)).

The Opposition must allege well-pleaded factual matter and more than "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements." *Id.* Additionally, in order to sufficiently allege a valid claim under Section 2(d) of the Lanham Act, Opposer must allege that it "has valid proprietary rights that are prior to those of Applicant, or that it owns a registration which Applicant has not counterclaimed to cancel, and that Applicant's mark so resembles Opposer's mark as to be likely to cause confusion." *Nike, Inc. v. Palm Beach Crossfit, Inc.*, 116 U.S.P.Q.2D (BNA) 1025, 1030, (Trademark Trial & App. Bd. September 11, 2015).

It is appropriate, in ruling upon a Motion to Dismiss under Fed. R. Civ. P. 12(b)(6), for the Board to look to Office records for "facts not subject to proof," to "determine if a party's allegations are well-pleaded." *See Compagnie Gervais Danone v. Precision Formulations LLC*, 89 U.S.P.Q.2D 1251, 1256 (TTAB 2009). We contend that the marks themselves, as well as the description of services listed within the respective trademark applications, are not subject to proof.

Opposer's Response focuses on three key allegations to support a claim that Applicant should be denied registration.

First, Opposer argues, “[t]he parties’ marks are highly similar in sound and appearance.” 7 TTABVUE 4.

Here, the marks themselves are not in dispute and the allegation is merely a conclusory statement. The Board need only look to the marks themselves to determine that that they are not similar in sound or appearance. In *Kellogg Co. v. Pack'Em Enters.*, the denial of an Opposition was upheld where the Board determined that likelihood of confusion could not be found based on the difference in the marks alone. *Kellogg Co. v. Pack'Em Enters.*, 951 F.2d 330, 333 (Fed. Cir. 1991). The Board found that the mark FROOTEE ICE with an elephant was so substantially different from the mark FROOT LOOPS, “in appearance, sound, connotation and commercial impression that there is no likelihood that their contemporaneous use by different parties will result in confusion.” *Id.* “A single DuPont factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks.” *Oakville Hills Cellar, Inc. v. Georgallis Holdings, LLC*, 826 F.3d 1376, 1381-82 (2016) (citing *Odom's Tenn. Pride Sausage, Inc. v. FF Acquisition, L.L.C.*, 600 F.3d 1343, 1346-47 (2010)). The differences between Applicant’s and Opposer’s marks are so strikingly different that on this factor alone, confusion is unlikely.

Second, Opposer argues that “Applicant’s Mark covers services that may be associated with the goods and services covered by Opposer’s prior registrations.” 7 TTABVUE 4.

Here, the services covered by Applicant’s Mark and covered by Opposer’s prior registrations are facts not subject to proof. Therefore, it is entirely appropriate for the Board to consider whether the goods and services, a directory or website of third-party advertisements, on one hand, and clothing items, on the other hand, are so dissimilar that they are unrelated on their

face. *See, e.g., Nike, Inc. v. Palm Beach Crossfit, Inc.*, 116 U.S.P.Q.2D (BNA) 1025, 1030, (Trademark Trial & App. Bd. September 11, 2015).

Third, Opposer argues that “the conditions surrounding the marketing of Opposer’s good and services are such that they are likely to be encountered by Applicant’s purchases under the same or similar circumstances.” 7 TTABVUE 4.

This allegation, taken as true, does not adequately allege a claim for relief. Whether the marks and services are encountered by respective purchases is simply irrelevant and unable to establish confusion, specifically where the marks and services are so dissimilar. *See Kellogg Co. v. Pack'Em Enters.*, 951 F.2d 330, 333 (Fed. Cir. 1991) (finding that where the marks are substantially different, use by different parties will not result in confusion).

Therefore, Applicant requests that Opposer’s Opposition be dismissed because Applicant’s mark is not likely to cause confusion with “Tally Weijl” or “Tally” as a matter of law.

DATED: April 26, 2019
Virginia Beach, VA

Respectfully Submitted,
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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Applicant’s Reply to Opposer’s Opposition has been served on Tally Weijl Holding AG, by forwarding said copy on April 26, 2019 via email to:

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