

ESTTA Tracking number: **ESTTA1040377**

Filing date: **03/05/2020**

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

Proceeding	91251213
Party	Defendant Western States Business Management, LLC
Correspondence Address	TODD E. ZENGER DUREN IP PC 610 E. SOUTH TEMPLE STR., STE. 300 SALT LAKE CITY, UT 84102 tzenger@durenip.com no phone number provided
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Todd E Zenger
Filer's email	tzenger@durenip.com
Signature	/Todd E. Zenger/
Date	03/05/2020
Attachments	Applicant-Rule12MotionForPartialDismissal.pdf(166255 bytes)

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

Legacy Health,

Opposer,

v.

Western States Business Management, LLC,

Respondent-Applicant.

Opposition No. 91251213

In re Trademark Application for:

Logo Design and word legacy

Serial No: 88/008,123

Filing Date: June 20, 2018

**APPLICANT'S RULE 12 MOTION TO DISMISS THE OPPOSITION
BASED ON CLAIM PRECLUSION, RES JUDICATA AND FRAUD**

Respondent-Applicant, Western States Business Management, LLC, submits this Rule 12 motion to partially dismiss and strike. Pursuant to Federal Rule of Civil Procedure 12 (b)(1) and (6), Applicant seeks dismissal of the Opposition based upon claim preclusion, res judicata and fraud and to strike corresponding paragraphs 9, 10, 17 and 18 from the Notice of Opposition, as follows:

POINTS AND AUTHORITIES

Under governing trademark law and TBMP, Opposer's claim preclusion, res judicata and fraud grounds fail to state a claim upon which relief may be granted. Further, Opposer has not plead fraud with the required particularity.

In this Opposition, Opposer's bases for claim preclusion, res judicata and/or fraud appear to be set forth in ¶¶ 9, 10, 17 and 18 of the Notice of Opposition. Opposer has utterly failed to identify the required factual and legal elements, let alone plead fraud with the required particularity,¹ for properly grounding an opposition on claim preclusion, res judicata or fraud.

Allegations of ¶ 9 of Opposition. The marks recited and argued by Opposer in the allegations of ¶ 9 are different and not the subject matter of this Opposition. No logo design mark of Applicant of any kind was the subject of earlier Opposition No. 91199416. Applicant's pending, distinctive and combined logo design² and word mark is different and was not adjudicated in earlier Opposition No. 91199416.

The stated services corresponding to the marks recited and argued by Opposer in the allegations of ¶ 9 are different and not the subject matter of this Opposition. Applicant's pending and stated, distinctive services in this Opposition are different and were not adjudicated in earlier Opposition No. 91199416.

The allegations of ¶ 9 recite no factual or legal matters as to the required sameness of marks, services and issues for grounding an opposition on claim preclusion, res judicata or to

¹ E.g., *American Flange & Manufacturing Co. v. Rieke Corp.*, 80 USPQ2d 1397 (TTAB 2006) (fraud must be plead with particularity).

² United States Trademark Registration No. 5,810,569 for Applicant's distinctive mountain logo design.

meet the particularized pleading requirement for an opposition based upon fraud. Paragraph 9 fails to state a claim upon which relief may be granted for an opposition grounded on claim preclusion, res judicata or fraud.

Allegations of ¶ 10 of Opposition. In this Opposition, Opposer argues that “Applicant’s core business has not changed” so Applicant should somehow be precluded from seeking registration of a different LEGACY mark with different stated services as if the ruling in Opposition No. 91199416 concluded that Applicant could file no other LEGACY marks. The TTAB concluded quite the contrary; the TTAB limited what Opposer’s Marks may preclude.

In Opposition No. 91199416, the weakness of Opposer’s rights in Opposer’s Marks was addressed and established by the TTAB. In reviewing the Opposer’s claim to exclusivity in the term LEGACY in connection with health care services and services related to health care, the TTAB concluded that Opposer’s rights are weak and that there was room for registration of other LEGACY marks and services:

“third-party use is sufficient to show that the word ‘Legacy’ has been extensively adopted and used [by others] as a service mark and trade name in connection with healthcare services and services related to healthcare”

“a mark comprising, in whole or in part, the word ‘Legacy’ in connection with healthcare services should be given a restricted scope of protection”

“Opposer’s LEGACY marks are not entitled to such a broad scope of protection as to bar the registration of every mark comprising, in whole or in part, the word ‘Legacy’; it will only bar registration of marks ‘as to which the resemblance to Opposer’s marks is striking enough to cause one seeing it to assume that there is some connection, association or sponsorship between the two.’”³

³ Opposition No. 91199416, TTAB 77, page 33.

The TTAB made no conclusion as to other LEGACY marks of Applicant, but indicated that other LEGACY registrations may be sought.

“Applicant’s core business” is not the issue. The issue is that the TTAB’s jurisdiction in this Opposition is limited to and must focus on the registrability of Applicant’s pending application of a materially different, distinctive logo design mark combined with the term “legacy” in connection with different services. There is no basis in fact or law recited in Opposer’s ¶ 10 self-serving, self-defined “LEGACY’-formative marks” allegation/argument that the Board’s decision in Opposition No. 91199416 should preclude Applicant from seeking trademark registration for a distinctive mark used continuously by Applicant since at least as early as 1995 by distinguishing that distinctive mark from the marks of others, including Opposer.

The allegations of ¶ 10 recite no factual or legal matters as to sameness of marks, services and issues for grounding an opposition on claim preclusion, res judicata or to meet the particularized pleading requirement for an opposition based upon fraud. Paragraph 10 fails to state a claim upon which relief may be granted for an opposition grounded on claim preclusion, res judicata or fraud.

Allegations of ¶ 17 of Opposition. Opposer’s claim preclusion and/or res judicata basis is set forth in ¶ 17. Opposer asserts claim preclusion and/or res judicata because the “parties have previously litigated as part of Opposition Serial No. 91199414 the issue of whether *Applicant’s use of “LEGACY”* in connection with related services is likely to be confused with

the LEGACY Marks, and the Board has previously refused registration of the Previously Opposed Marks on the likelihood of confusion grounds.” This conclusory, factually insufficient shot misses the pleading mark.

The marks of Opposition No. 91199416 recited and argued by Opposer in the allegations of ¶ 17 are difference and are not the subject matter of this Opposition. No logo design mark of Applicant was litigated in earlier Opposition No. 91199416. Applicant's distinctive, combined logo design⁴ and word mark in this Opposition is different and was not adjudicated in earlier Opposition No. 91199416.

The stated services corresponding to the marks recited and argued by Opposer in the allegations of ¶ 17 are different and are not the subject matter of this Opposition. Applicant's stated, distinctive services in this Opposition are different and were not adjudicated in earlier Opposition No. 91199416.

Further, in Opposition No. 91199416, the weakness of Opposer's rights in Opposer's Marks was declared and should be law of the case in this Opposition as to Opposer's asserted registrations and should preclude Opposer from attempting to relitigate the found weakness of its LEGACY Marks. Opposer's rights and corresponding pleading in this Opposition are fatally weak because (1) third-party use is sufficient to show that the word 'Legacy' has been extensively adopted and used by others as a service mark and trade name in connection with healthcare services and services related to healthcare; (2) a mark comprising, in whole or in part, the word 'Legacy' in connection with healthcare services should be given a restricted scope of

⁴ United States Trademark Registration No. 5,810,569 for Applicant's distinctive mountain logo design.

protection; and (3) Opposer's LEGACY marks are not entitled to such a broad scope of protection as to bar the registration of every mark comprising, in whole or in part, the word 'Legacy' but will only bar registration of marks which so resemble Opposer's marks so as to be striking enough to cause one seeing it to assume that there is some connection, association or sponsorship between the two.⁵

Opposer has not and cannot sufficiently plead with particularity the broad exclusivity of rights, broad scope of protection and the required striking resemblance with a distinctive mountain logo in order to sustain an opposition based upon claim preclusion, res judicata or fraud.

The TTAB made no conclusion broadly as to "Applicant's use of 'LEGACY'" let alone as to other distinctive services. Instead, the TTAB held the door open for other LEGACY registrations. The matter before the TTAB in this Opposition addresses different issues, namely, Applicant's pending application of a materially different, distinctive logo design mark combined with the term "legacy" in connection with different, distinct services.

There is no basis in fact or law recited in Opposer's ¶ 17 that precludes Applicant from seeking trademark registration for a different, distinctive mark, used continuously by Applicant since at least as early as 1995, by distinguishing that different, distinctive mark from the marks of others, including from Opposer's Marks.

The allegations of ¶ 17 recite no sufficient factual or legal matters as to sameness of marks, sameness of services and sameness of issues for grounding an opposition on claim

⁵ Opposition No. 91199416, TTAB 77, page 33.

preclusion, res judicata or to meet the particularized pleading requirement for an opposition based upon fraud. Paragraph 17 fails to state a claim upon which relief may be granted for an opposition grounded on claim preclusion, res judicata or fraud.

Allegations of ¶ 18 of Opposition. The allegations of ¶ 18, even taken in combination with the allegations of ¶¶ 9, 10 and 17, clearly fail to plead with particularity the required and governing elements and standards for proving “fraud on the U.S. Patent and Trademark Office.” This failure is fatal to Opposer’s assertion of fraud.

The allegations of ¶ 18 recite no sufficient factual or legal matters as to sameness of marks, services and issues for grounding an opposition on claim preclusion or res judicata or to meet the particularized pleading requirement for an opposition based upon fraud. Paragraph 18 fails to state a claim upon which relief may be granted for an opposition grounded on claim preclusion, res judicata or fraud.

Relying upon ¶¶ 9, 10, 17 and 18 as the basis for claim preclusion, res judicata and fraud grounds, the Notice of Opposition fails to state a claim upon which relief may be granted based upon claim preclusion, res judicata or fraud, and fails to plead fraud with the required particularity.

CONCLUSION

The grounds for opposition based upon claim preclusion, res judicata and fraud should be dismissed. Paragraphs 9, 10, 17 and 18 should be stricken from the Notice of Opposition.

Dated this 5th day March, 2020.

Respectfully submitted,

By: /Todd E. Zenger/
Todd E. Zenger
Attorney for Respondent-Applicant

DUREN IP
610 E. South Temple Street, Suite 300
Salt Lake City, Utah 84102
Phone: (801) 869-8538
tzenger@durenip.com

CERTIFICATE OF FILING AND SERVICE

This Motion for Partial Dismissal and to strike was duly filed using ESSTA on March 5, 2020 and a copy of this Motion for Partial Dismissal and to strike was emailed to counsel for Opposer as indicated below:

MATTHEW R. WILMOT
STOEL RIVES LLP
760 SW NINTH AVENUE, SUITE 3000
PORTLAND OR UNITED STATES , 97205
matt.wilmot@stoel.com

/Todd E. Zenger/
Todd E. Zenger