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

Proceeding	91251530
Party	Defendant Bugsby Property LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Serial Number 88/279,118  
Trademark: CLUSTER OF CLUSTERS

Alexandria Real Estate Equities, Inc.,  Opposer,  v.  Bugsby Property LLC,  Applicant.	Opposition No.: 91251530  <b>APPLICANT’S REPLY TO OPPOSER’S OPPOSITION TO MOTION TO DISMISS</b>
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**APPLICANT’S REPLY TO OPPOSER’S OPPOSITION TO MOTION TO DISMISS**

**I.     INTRODUCTION**

On November 18, 2019, Applicant Bugsby Property LLC (“Applicant”) filed a Motion to Dismiss Opposition No. 91251530 for failing to state a claim upon which relief may be granted. Opposer Alexandria Real Estate Equities, Inc. (“Opposer”) filed an Opposition to Applicant’s Motion to Dismiss on December 9, 2019 (“Opposition”). Applicant submits the instant Reply to Opposer’s Opposition to address incorrect statements made by the Opposer with regards to Applicant’s arguments in its Motion to Dismiss.

Opposer falsely claims in its Opposition that Applicant’s Motion to Dismiss rests on the argument that Opposer did not provide adequate examples of third-party use of the mark CLUSTER OF CLUSTERS to identify Applicant’s specific services. *See* Opposer’s Memorandum of Law in Opposition to Motion to Dismiss (“Opp. Motion”) at 6. In fact, Applicant’s argument is that Opposer fails to plead that Applicant’s Mark is widely used

generically to identify the genus of goods or services identified in Applicant's application, or that consumers primarily understand CLUSTER OF CLUSTERS to be the generic name, identifier of or adjective for the genus of Applicant's services. See Applicant's Motion to Dismiss for Failure to State a Claim ("App. Motion") at 4-6. Opposer's Opposition does nothing to address these flaws, and the case law Opposer cites to support its arguments that its Notice of Opposition is properly pleaded are inapposite. Accordingly, Applicant submits that the Board should grant its Motion to Dismiss.

## **II. ARGUMENT**

As Opposer acknowledges, Opposer has the burden of properly alleging that Applicant's Mark is generic. In order to meet this burden, Opposer must allege that the mark at issue is used "to refer to the genus of goods or services" identified in the opposed application, and that "the term sought to be registered ...[is] understood by the relevant public primarily to refer to that genus of goods or services." See *In re Cordua Restaurants, Inc.*, 823 F.3d 594, 599 (Fed. Cir. 2016); see also *H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Opposer's Notice of Opposition fails to establish either of these two elements, and its arguments in its Opposition cannot cure these defects. See App. Motion at 4-6. Opposer spends an inordinate amount of time in its Opposition providing an account of the relationship between Applicant and Opposer. See Opp. Motion at 3-4. Applicant disputes Opposer's characterization of this relationship, but nevertheless, Opposer's allegations are irrelevant to whether the public consumer sees Applicant's Mark as generic.

Opposer claims its Notice of Opposition properly states a claim because it alleges that "use of the word 'cluster' is widespread throughout the life sciences and biotech industry" and provides "a number of illustrative examples showing that the term 'cluster' is used generically to

describe groupings of scientific and technological offices, laboratories, and workspaces, where services can be shared among participants in the industry and the effect caused by the clustering of such businesses, geographically or virtually.” *See* Opp. Motion at 4. The fact that the term “cluster” has a dictionary definition or meaning to certain consumers in particular industries does not demonstrate that Applicant’s Mark is either widely used generically to identify the genus of services identified in Applicant’s application, or that consumers primarily understand CLUSTER OF CLUSTERS to be the generic name for the genus of Applicant’s services. To wit, Applicant’s services are not described in its application as “services related to the clustering of computer and technological facilities” and have nothing to do with “clustering” whatsoever. *See* Opp. Motion at 4. Applicant’s services are rental and leasing of information technology (IT) computer hardware systems and computer services. The word “cluster” does not even appear in Applicant’s description of services. *See* App. Motion at 1-2. A proper genericness inquiry must “focus[] on the description of services [or goods] set forth in the [application or] certificate of registration.” *See Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991), and Applicant’s recitation of goods and services contain no such references to “clusters” or “clustering.”

The arguments Opposer offers to prove its genericism claim has been properly pled are inapposite in this case. Opposer states that it has provided “a number of illustrative examples showing that the term ‘cluster’ is used generically to describe groupings of scientific and technological offices, laboratories, and workspaces, where services can be shared among participants in the industry and the effect caused by the clustering of such businesses, geographically or virtually.” *See* Opp. Motion at 4. However, the examples provided by Opposer fail to provide support for the fact that Applicant’s Mark is generic as they neglect to

provide any evidence that the public understands the mark to refer to Applicant's specific services. *See* App. Motion at 4-6. Opposer's own briefing acknowledges that its illustrative examples do not provide evidence that the public understands Applicant's Mark as referring to Applicant's specific services, as Opposer states that its Notice of Opposition "explains that 'third parties [use] and continu[e] to use the term 'cluster' to refer to geographic or virtual locations, facilities and complementary services that support collaboration, innovation, research and development between various business entities.'" *See* Opp. Motion at 8. Opposer's characterization of its evidence and allegations notably omits any reference to specific instances in the Notice of Opposition where Opposer alleges that the public understands Applicant's Mark to refer to Applicant's specific rental and leasing of information technology (IT) computer hardware systems and computer services. Tellingly, the Notice of Opposition contains no such evidence.

The case law Opposer cites also does not support Opposer's claims that its Notice of Opposition is properly pleaded. Opposer first cites to the Board's non-precedential decision in *American Massage Therapy Assoc. v. Implus Footcare, LLC*, Opp. No. 91234785 2017 WL 5624668 (T.T.A.B. Nov. 11, 2017). *See* Opp. Motion at 8-9. The holding in *American Massage Therapy* actually provides support for the opposite conclusion, as there the Notice of Opposition contained detailed, specific allegations that stand in stark contrast to Opposer's. *See* 2017 WL 5624668 at \*3 – 4. For example, in *American Massage Therapy* the Board noted that the "Opposer allege[d] (i) that the relevant consuming public widely uses generically the wording 'trigger point' to identify or describe the subcategory of the genus of goods identified in the opposed application, i.e., massage therapy products and fitness-related instructional materials; and (ii) that consumers primarily understand the wording sought to be registered to be the generic

name or identifier of a subcategory of the genus of goods identified in the opposed application.” *See id.* Similar such references to Applicant’s genus or recognition by the public are nowhere to be found in Opposer’s Notice of Opposition. *See App. Motion at 3 – 6.* Accordingly, *American Massage Therapy* reaffirms that Opposer’s Notice of Opposition is deficient, given that it lacks the elements that the Board specifically referenced in order to reach its determination in that proceeding. *See 2017 WL 5624668 at \*3 – 4.*

Opposer’s argument that it has properly pled a claim that Applicant’s Mark is “generic for at least a subset of business services that Applicant offers” also misses the mark. *See Opp. Motion at 9.* Opposer’s comparison of the instant proceedings to *In re Northland Aluminum Prods. Inc.* is misplaced, given that in that case the court looked to evidence from newspaper articles, recipes and dictionaries that showed the mark at issue was used generically to refer to a specific identified genus of goods, that is, ring cake mix. *See In re Northland Aluminum Prod., Inc., 777 F.2d 1556, 1560 (Fed. Cir. 1985)* (Noting that evidence showed the mark BUNDT was used in “recent cookbooks of wide circulation” and that “various newspaper articles [did] not contradict the conclusion that BUNDT is known as the name of a type of cake).” To the contrary, Opposer has failed to properly identify the genus of Applicant’s services in its Notice of Opposition, let alone provide evidence that the public understands Applicant’s Mark as referring to that genus of services. Opposer’s reliance on *In re Central Sprinkler Co.* is also irrelevant, as the Board was presented with clear evidence that the relevant mark would only be encountered by consumers in a very particularized location. *See 49 U.S.P.Q.2d 1194, 1199 (T.T.A.B. 1998)* (“The only evidence of record (that is, the one page of product literature) relating to applicant's particular sprinklers indicates that the sprinklers at issue are for placement and use in one place, that is, in the attic.”). Opposer has not provided any allegations in its Notice of Opposition to

support the fact that consumers of Applicant's services will encounter Applicant's Mark in a similar manner, that is, only in the context of a narrower set of services. Consequently, Opposer's Opposition does not provide any additional support that its allegations regarding the genericism of Applicant's Mark are sufficient to state a claim for relief.

**III. CONCLUSION**

Based on all of the foregoing arguments, Applicant respectfully requests that the Board dismiss the Notice of Opposition with prejudice.

Respectfully submitted,

ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: December 27, 2019

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**CERTIFICATE OF SERVICE**

The undersigned certifies that a copy of the foregoing **APPLICANT'S REPLY TO OPPOSER'S OPPOSITION TO MOTION TO DISMISS** is being served upon counsel for Opposer on this 27th of December to the below email address:

pto-oc@gibsondunn.com

By:  /s/ chris civil  
Chris Civil