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

Proceeding no.	91273333
Party	Defendant Williams-Sonoma, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Serial No.: 90/592,171

Mark: THE ONE

Filing Date: March 21, 2021

Publication Date: August 10, 2021

ENTREPRENEURIAL VENTURES
CAPITAL CO., L.L.C.,

Opposer,

v.

WILLIAMS-SONOMA INC.,

Applicant.

Opposition No. 91273333

**APPLICANT’S MOTION TO DISMISS OPPOSER’S CLAIMS
UNDER 15 U.S.C. §§ 1052(a), 1064(3), 1125(a), AND 1125(c)**

Pursuant to Federal Rule of Civil Procedure 12(b)(6) and TBMP § 503, Applicant Williams-Sonoma, Inc. (“Williams-Sonoma”) moves the Board to dismiss the claims asserted by Opposer Entrepreneurial Ventures Capital Co., L.L.C. (“Opposer”) under 15 U.S.C. §§ 1052(a), 1064(3), 1125(a), and 1125(c), presumably for false suggestion of a connection, misrepresentation of source, false advertising, and dilution, respectively. 1 TTABVUE 3-5. Opposer cannot state or has not stated plausible claims for relief under any of these theories.

I. INTRODUCTION

On the sole basis of a Class 16 registration for the mark ONE for “bibles,” Opposer has opposed Williams-Sonoma’s Application Serial No. 90/592,171 (the “Application”) in Class 9 to register the THE ONE covering “downloadable software in the nature of a mobile application that

enables users to create, edit, organize, view, share and manage online gift registries, gift request lists and wish lists, and that allows users to purchase gifts from online gift registries, gift request lists and wish lists.” Opposer’s opposition rests on the mistaken assertion that Williams-Sonoma “seeks to register the Pending Mark for services that intersect with bibles,” 1 TTABVUE 2 (¶ 9). However, the recitation of services in the Application makes clear that none of Williams-Sonoma’s services under its THE ONE mark involves bibles.

Opposer’s legal claims, which are the subject of this motion to dismiss, are misplaced, as are its factual allegations (which, for purposes of this motion, Williams-Sonoma is constrained to accept). Specifically, it appears from Opposer’s Cover Sheet to the opposition and its citation of 15 U.S.C. §§ 1052(a) and 1125(c) that Opposer intends to claim false suggestion of a connection and dilution in addition to its claim for likely confusion under Section 2(d). *See* 1 TTABVUE 1-4. Moreover, Opposer claims likelihood-of-confusion on the basis that Williams-Sonoma “has used or intends to use the Pending Mark so as to misrepresent the source of its goods or services.” 1 TTABVUE 3. As shown below, with the exception of its Section 2(d) claim, Opposer’s claims are either insufficiently pled, unavailable in this Board proceeding, or both, and should be dismissed under Rule 12(b)(6).

II. FACTUAL AND PROCEDURAL BACKGROUND

Opposer commenced this opposition on December 8, 2021. The crux of Opposer’s Notice of Opposition (the “Notice”) is that Williams-Sonoma’s THE ONE mark is “confusingly similar to Registrant Opposer’s ‘ONE’ mark . . . and likely to cause confusion, mistake, and is likely to deceive and/or cause untrue association or sponsorship.” 1 TTABVUE 2. However, Opposer then lards its Notice with a number of additional, gratuitous claims – all of which are insufficiently pled. Specifically:

- The Notice includes a claim for false suggestion of a connection under Section 2(a) of the Lanham Act (1 TTABVUE 3-4);
- The Notice includes a dilution claim under Section 43(c) of the Lanham Act while lacking any allegations regarding the fame of Opposer’s mark other than a passing, unsupported reference to the mark’s “being famous” (*see id.* at 2);¹ and
- Paragraph 15 of the Notice asserts that “[Williams-Sonoma] has used or intends to use the Pending Mark so as to misrepresent the source of its goods or services.” *Id.* at 3.

As explained below, each of the above-referenced claims is fatally flawed, even accepting (for purposes of this motion) the truth of the factual allegations set out in the Notice. Accordingly, each of these claims should be dismissed without leave to re-plead.

III. ARGUMENT

“To survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). “A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Id.* In drawing those inferences, however, the Board need not accept the Opposer’s “conclusory statements” as true, nor do its “legal conclusion[s] couched as . . . factual allegation[s]” merit such deference. *Id.* The Board therefore should begin by excluding those “[t]hreadbare recitals” and “conclusory statements,” *Twombly*, 550 U.S. at 570, then determine whether Opposer has “nudged [its] claims across the line from conceivable to plausible.” If not, as here, those claims “must be dismissed.”

¹ The lack of any allegations supporting Opposer’s contention that its ONE mark is famous is perhaps the most understandable aspect of the Notice, because under no reasonable interpretation of fame can Opposer’s mark be said to have achieved that status.

A. Opposer Cannot State a Claim for False Suggestion of a Connection Under Section 2(a).

Section 2(a) of the Lanham Act provides, in relevant part,

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it . . . [c]onsists of or comprises . . . matter which may . . . falsely suggest a connection with persons . . . [or] institutions

15 U.S.C. § 1052(a). Congress intended this section to “protect[] the name of an individual or institution which was not a technical ‘trademark’ or ‘trade name’ upon which an objection could be made under § 2(d),” as with rights of publicity. *Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imps. Co.*, 217 U.S.P.Q. (BNA) 505, 508, 703 F.2d 1372, 1375 (Fed. Cir. 1983).

In light of this congressional purpose, to sufficiently plead a violation of Section 2(a), Opposer must allege facts sufficient to establish, *inter alia*, that Williams-Sonoma’s THE ONE mark is “the same as or a close proximation [of] [Opposer’s] previously-used corporate name, i.e., [Opposer’s] corporate identity,” along with the factual basis for Opposer’s “reasonable belief that the mark would be recognized as such,” such that “a connection with [Opposer] would be presumed.” *Springs Indus. v. Bumblebee Di Stefano Ottina & C.S.A.S.*, 222 U.S.P.Q. 512, 515 (T.T.A.B. 1984); *see also Consorzio Del Prosciutto Di Parma v. Parma Sausage Prods., Inc.*, 23 U.S.P.Q.2d 1894, 1899 (T.T.A.B. 1992) (“[T]o prevail on the ground of false suggestion, [the petitioner] had to demonstrate that, at least at the time of issuance of the registration sought to be cancelled . . . , the term had to have pointed uniquely to petitioner.”).

Opposer has failed to satisfy this requirement. Paragraph 21(a) of Opposer’s Notice alleges that Williams-Sonoma’s THE ONE mark “is exactly the same or a close approximation of the *Registered Mark*, which has priority and is senior as used in federal commerce between or among the states in these United States.” 1 TTABVUE 3-4 (¶ 21(a)) (emphasis added). That is not the issue. The proper question for the purposes of Section 2(a) is whether Williams-Sonoma’s THE

ONE mark is the same as or a close approximation of Opposer's *corporate name*—Entrepreneurial Ventures Capital Co., L.L.C. It obviously is not. Equally obvious is that “[t]he essence of [Opposer’s] allegation . . . is that confusion as to source would be likely to result” under Section 2(d), notwithstanding Opposer’s reliance on Section 2(a). *See Springs Indus.*, 222 U.S.P.Q. at 514. Opposer’s Section 2(a) claim is duplicative as well as insufficient. The Board should dismiss that claim with prejudice, as amendment would be futile.

B. Opposer Has Not Stated a Claim for Dilution Under Section 43(c).

Section 43(c) of the Lanham Act provides owners of famous marks with a civil remedy against other persons “who, at any time after the owner’s mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark.” 15 U.S.C. § 1125(c). Congress also made this remedy available in opposition and cancellation proceedings. *See* 15 U.S.C. §§ 1063(a), 1064.

To sufficiently plead dilution, Opposer must allege that: (1) its ONE mark is famous; (2) its ONE mark became famous prior to Williams-Sonoma’s constructive use date; and (3) Williams-Sonoma’s THE ONE mark is likely to impair the distinctiveness of Opposer’s ONE mark. *Nat’l Pork Bd. v. Supreme Lobster & Seafood Co.*, 96 U.S.P.Q.2d 1479, 1497 (T.T.A.B. 2010). Where, as here, the Application alleges a *bona fide* intent to use the mark in commerce under Section 1(b), Opposer “must plead that its mark became famous prior to [Williams-Sonoma’s] filing date”—*i.e.*, March 21, 2021. *Omega SA v. Alpha Phi Omega*, 118 U.S.P.Q.2d 1289, 1292 n.10 (T.T.A.B. 2016) (citing, *inter alia*, *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d 1164, 1174 (T.T.A.B. 2001)).

Paragraphs 7, 21, and 26 of Opposer’s Notice contain formulaic recitations of fame and dilution, *see* 1 TTABVue 1, 4, 5, but Opposer has nowhere alleged that its ONE mark became famous prior to the date on which Williams-Sonoma applied to register its THE ONE mark.

Opposer's dilution claim therefore is legally insufficient, and the Board should dismiss it from the case.

C. Opposer Has Not Stated a Claim for Misrepresentation of Source Under Section 14(3).

As part of a putative cause of action under Section 2(d), Paragraph 14 of the Notice asserts that “[Williams-Sonoma] has used or intends to use the Pending Mark so as to misrepresent the source of its goods or services” To the extent this language is meant to assert a claim of misrepresentation of source, it fails because a claim of misrepresentation of source is not sustainable in an opposition proceeding. *See U.S. Marine Corps v. Healy*, No. 91215087, 2017 WL 2297909, at *16 (T.T.A.B. Apr. 25, 2017) (nonprecedential) (misrepresentation of source claims “can only be entertained in the context of a cancellation proceeding or counterclaim to cancel a pleaded registration.”).

Moreover, even if such a claim were available in an opposition (which it is not), the Notice is wholly lacking any allegations that Williams-Sonoma has deliberately misused Opposer's the ONE mark to pass off any of its goods or services as Opposer's. *See McDonnell Douglas Corp. v. Nat'l Data Corp.*, 228 U.S.P.Q. 45, 47 (T.T.A.B. 1985) (“Petitioner here has alleged no specific acts by respondent in the use of its registered mark that, if proved, would amount to an attempt to create the impression that petitioner is the source of respondent's services”). Here, as in *McDonnell Douglas*, Opposer's allegations in Paragraph 10 through 14 of the Notice support, if anything, “only a claim of likelihood of confusion under Section 2(d) . . . , not misrepresentation of the source of the services under Section [14(3)].” *Id.* In addition, Opposer could not plausibly plead any such allegations.

IV. CONCLUSION

For the foregoing reasons, Williams-Sonoma respectfully requests the Board to grant this motion and dismiss all of Opposer's claims with the exception of Opposer's claim for likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

Dated: January 18, 2022

Respectfully submitted,

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CERTIFICATE OF TRANSMITTAL

I certify that a true and correct copy of the foregoing APPLICANT'S MOTION TO DISMISS OPPOSER'S CLAIMS UNDER 15 U.S.C. §§ 1052(a), 1064(3), AND 1125(c) is being filed electronically with the Trademark Trial and Appeal Board via ESTTA on this, the 18th day of January, 2022.

/Danielle Vargas /
Danielle Vargas

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CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing APPLICANT'S MOTION TO DISMISS OPPOSER'S CLAIMS UNDER 15 U.S.C. §§ 1052(a), 1064(3), AND 1125(c) has been served on Opposer's counsel, Gregg R. Zegarelli, Esquire, Technology & Entrepreneurial Ventures Law Group, PC, 2585 Washington Road, Suite 134, Pittsburgh, Pennsylvania 15241, by electronic mail to the following email address:

mailroom.grz@zegarelli.com

This 18th day of January, 2022.

/Danielle Vargas/

Danielle Vargas