ESTTA Tracking number: **ESTTA1351755**
Filing date: **04/11/2024**

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

Proceeding no.	91289331
Party	Defendant Lindsay, James
Correspondence address	WILLIAM A. WOOTEN WOOTEN LAW OFFICE 120 COURT SQUARE EAST COVINGTON, TN 38019 UNITED STATES Primary email: wawooten@gmail.com Secondary email(s): wailindanieley@gmail.com, trey.gerrell@gmail.com, blair.chunn@gmail.com, wawooten@hotmail.com 901-475-1050
Submission	Motion to Dismiss - Rule 12(b)
Filer's name	William A. Wooten
Filer's email	wawooten@gmail.com, trey.gerrell@gmail.com
Signature	/William A. Wooten/
Date	04/11/2024
Attachments	RACKS Memo in Support of Motion to Dismiss.pdf(209673 bytes) RACKS Motion to Dismiss.pdf(114022 bytes) RACKS Motion to Set Aside Notice of Default.pdf(112257 bytes)

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

IN THE MATTER OF:	)	
	)	
NIHC, INC.,	)	
OPPOSER,	)	**OPPOSITION NUMBER: 91289331**
	)	
V.	)	
	)	
JAMES LINDSAY,	)	
APPLICANT	)	

APPLICANT'S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED AND SUPPORTING MEMORANDUM OF LAW

Under Federal Rules of Civil Procedure 9(b) and 12(b)(6) Applicant James Lindsay (hereinafter, "Applicant") hereby moves for the entry of an order dismissing Opposer's Notice of Opposition (Dkt. 1).

- Opposer's claims of a likelihood of confusion with Opposer's trademark are nothing more than an assertion of confusion with no factual basis.
- Opposer's claims of a likelihood of confusion are without merit as the Examining Attorney found no likelihood of confusion between the marks.
- Finally, Opposer's Opposition is overall based on pure assertion with no factual basis.

For these reasons, as explained in greater detail below, Applicant respectfully requests that the Court dismiss Opposer's Notice of Opposition with prejudice.

FACTUAL BACKGROUND

This is a case involving trademark opposition against Applicant's trademark application. Opposer filed this action on December 22, 2023 (Notice of Opposition, Dkt. 1) seeking cancellation of Trademark Application No. 97660324 for "RACKS" in Class 003.

Opposer is a corporation organized and existing under the laws of the State of Colorado, who allegedly produces products and services in IC 025 and 035 bearing the marks "RACK", "THE RACK", and "NORDSTROM RACK" (*Id.* at ¶ 5). Opposer alleges that it is or would be damaged by issuance of registration for Applicant's mark in IC 003 due to a likelihood of confusion between Applicant's mark and the cited marks. (*Id.*). Opposer provides no factual basis for these claims, presenting them as mere conclusions of fact.

STANDARD OF LAW

For purposes of a motion to dismiss, the Court must take all the factual allegations in the complaint as true. *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). 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. *Id.* A claim has facial plausibility when the Opposer pleads factual content that allows the court to draw the reasonable inference that the Applicant is liable for the misconduct alleged. *Id.* Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice, and allegations of fraud must be pled with particularity. *Id.;* Fed. R. Civ. P. 9(b). When there are well-pleaded factual allegations, a court should assume their veracity and then determine whether they plausibly give rise to an entitlement to relief. *Id.* at 679. A legal conclusion, including one couched as a factual allegation, need not be accepted as true on a motion to dismiss, nor are mere recitations of the elements of a cause of action sufficient. *Id. at 678*; *Fritz v. Charter Township of Comstock*, 592 F.3d 718, 722 (6th Cir. 2010).

ARGUMENT

1. **Opposer's claims for likelihood of confusion are without merit due to a lack of overlap in the associated goods and services and a lack of factual basis.**

Opposer's primary cause of action against Applicant is that Applicant's mark creates a likelihood of confusion with Opposer's mark within the meaning of Section 2(d) of The

Trademark (Lanham) Act of 1946,15 U.S.C. § 1052(d). Likelihood of confusion between two marks at the USPTO is determined by a review of all the relevant factors under the du Pont test. *In re E.I. du Pont de Nemours & Co*., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Although the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services, "there is no mechanical test for determining likelihood of confusion and 'each case must be decided on its own facts.'" TMEP § 1207.01 (citing du Pont, 476 F.2d at 1361, 177 USPQ at 567). Each of the thirteen du Pont factors may be considered in weighing likelihood of confusion, if raised, and any one factor may be dispositive. See TMEP § 1207.01. In some cases, a determination that there is no likelihood of confusion may be appropriate, even where the marks share common terms and the goods/services relate to a common industry, because these factors are outweighed by other factors, such as differences in the relevant trade channels of the goods/services, the presence in the marketplace of a significant number of similar marks in use on similar goods/services, the existence of a valid consent agreement between the parties, or another established fact probative of the effect of use. Id.

Further, the likelihood of confusion refusal cannot be based on the dissection of a mark or only part of a mark. *In re National Data Corp*., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). A consumer's general impression of trademarks is influenced by the actual use of the marks in their entireties, and as such, all components of the marks in question must be given appropriate weight. See *Joseph Phelps Vineyards, LLC v. Fairmont Holdings LLC*, No. 16-1089, slip op. at 4 (Fed. Cir. May 24, 2017) (Newman, J., concurring); *In re Hearst Corporation*, 982 F.2d 493, 494 (Fed. Cir. 1992). When a mark's unique components are given fair weight, confusion may become less likely. See *In re Hearst Corporation*, 982 F.2d 493, 494 (Fed. Cir. 1992) (finding that when GIRL is given fair weight, along with VARGA, confusion between VARGA GIRL and VARGAS, for

similar goods, becomes less likely); *In re Kose Corporation*, Serial No. 77519214 (TTAB April 26, 2010).

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), aff'd per curiam, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

In this case, Applicant is unable to respond to specific factual allegations from Opposer as none are made in the Notice of Opposition. Opposer's marks are "RACK", "THE RACK", "NORDSTROM RACK", and "NORDSTROM RACK NR" in IC 025 for clothing related goods and IC 035 for retail stores. Applicant's mark is "RACKS" in IC 003 for hair care related products. Even in cases where marks may appear similar, additional terms as seemingly inconsequential as an additional "S" have been considered different enough to allow granting of a competing trademark as in the Varga Girl vs. Vargas trademark case. *See In re Hearst Corporation*, 982 F.2d 493, 494 (Fed. Cir. 1992) (finding that when GIRL is given fair weight, along with VARGA, confusion between VARGA GIRL and VARGAS, for similar goods, becomes less likely). Therefore, the additional "S" in "RACKS" should prove sufficient to differentiate the marks in question, particularly when considered alongside the lack of overlap in the goods and services for each mark. Additionally, as the Examining Attorney in this case found no likelihood of confusion with any of the cited marks, Applicant's mark poses no inherent risk to

Opposer's trademark interests.

CONCLUSION

For the reasons set forth above, Applicant respectfully requests the Court enter an Order:

1. Dismissing Opposer's claims for likelihood of confusion; and

2. Dismissing any additional related claims stemming from Opposer's Notice of Opposition.

Respectfully submitted,
s/William A. Wooten___
William A. Wooten, Esq.
Charles Gerrell, Esq.
WOOTEN LAW OFFICE
120 Court Square East
Covington, Tennessee 38019
Office: (901) 475-1050
Fax: (901) 234-0028
Attorneys for Applicant

Certificate of Service

In accordance with Trademark Rule 2.119, I certify that a copy of this Answer was served on the following on April 11th, 2024, via email at the email address indicated below and via posting through ESTTA:

KENT E. BALDAUF, JR.
THE WEBB LAW FIRM
420 FT. DUQUESNE BLVD., SUITE 1200, ONE GATEWAY CENTER
PITTSBURGH, PA 15222
UNITED STATES
trademarks@webblaw.com, kbaldaufjr@webblaw.com, gvadala@webblaw.com
Phone: 412-471-8815

Respectfully submitted,

s/William A. Wooten___
William A. Wooten, Esq.
WOOTEN LAW OFFICE
120 Court Square East
Covington, Tennessee 38019
Office: (901) 475-1050
Fax: (901) 234-0028
William@WootenLawOffice.com
Attorney for Applicant

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

IN THE MATTER OF:	)	
	)	
NIHC, INC.,	)	
OPPOSER,	)	**OPPOSITION NUMBER: 91289331**
	)	
V.	)	
	)	
JAMES LINDSAY,	)	
APPLICANT	)	

APPLICANT'S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED

Applicant, James Lindsay ("Applicant"), pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure and Trademark Rule 503, hereby moves the Board for dismissal of Opposer's Opposition, against Applicant, as Opposer has failed to state a claim upon which relief can be granted. Specifically, Opposer has provided no factual basis with respect to the allegations giving rise to Opposer's Opposition. Additionally, Opposer's claims against Applicant are barred to the extent that Applicant's mark was found to not have a likelihood of confusion with Opposer's mark by a USPTO Examining Attorney.

WHEREFORE, Applicant respectfully requests that the Court issue an Order dismissing Opposer's Opposition against Applicant in its entirety, with prejudice.

This 11th day of April, 2024.

Respectfully submitted,
s/William A. Wooten___
William A. Wooten, Esq.
Charles Gerrell, Esq.
WOOTEN LAW OFFICE
120 Court Square East
Covington, Tennessee 38019
Office: (901) 475-1050
Fax: (901) 234-0028
Attorneys for Applicant

Certificate of Service

In accordance with Trademark Rule 2.119, I certify that a copy of this Motion was served on the following on April 11th, 2024, via email at the email address indicated below and via posting through ESTTA:

KENT E. BALDAUF, JR.
THE WEBB LAW FIRM
420 FT. DUQUESNE BLVD., SUITE 1200, ONE GATEWAY CENTER
PITTSBURGH, PA 15222
UNITED STATES
trademarks@webblaw.com, kbaldaufjr@webblaw.com, gvadala@webblaw.com
Phone: 412-471-8815

Respectfully submitted,

s/William A. Wooten___
William A. Wooten, Esq.
WOOTEN LAW OFFICE
120 Court Square East
Covington, Tennessee 38019
Office: (901) 475-1050
Fax: (901) 234-0028
William@WootenLawOffice.com
Attorney for Applicant

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

IN THE MATTER OF:	)	
	)	
NIHC, INC.,	)	
OPPOSER,	)	**OPPOSITION NUMBER: 91289331**
	)	
V.	)	
	)	
JAMES LINDSAY,	)	
APPLICANT	)	

APPLICANT'S RESPONSE TO NOTICE OF DEFAULT

Applicant, James Lindsay ("Applicant"), pursuant to Rule 55(b)(2) of the Federal Rules of Civil Procedure and Trademark Rule Trademark Rule 2.106(a), hereby moves the Board to set aside the Notice of Default against Applicant, as the delay in filing an answer was not the result of willful conduct or gross neglect on the part of the Applicant, the Opposer will not be substantially prejudiced by the delay, and Applicant possesses a meritorious defense in the matter. Specifically, Applicant believes that Opposer has failed to state a claim upon which relief can be granted.

WHEREFORE, Applicant respectfully requests that the Court issue an Order setting aside the prior Notice of Default.

This 11th day of April 2024.

Respectfully submitted,
s/William A. Wooten___
William A. Wooten, Esq.
Charles Gerrell, Esq.
WOOTEN LAW OFFICE
120 Court Square East
Covington, Tennessee 38019
Office: (901) 475-1050
Fax: (901) 234-0028
Attorneys for Applicant

Certificate of Service

In accordance with Trademark Rule 2.119, I certify that a copy of this Motion was served on the following on April 11th, 2024, via email at the email address indicated below and via posting through ESTTA:

KENT E. BALDAUF, JR.
THE WEBB LAW FIRM
420 FT. DUQUESNE BLVD., SUITE 1200, ONE GATEWAY CENTER
PITTSBURGH, PA 15222
UNITED STATES
trademarks@webblaw.com, kbaldaufjr@webblaw.com, gvadala@webblaw.com
Phone: 412-471-8815

Respectfully submitted,

s/William A. Wooten___
William A. Wooten, Esq.
WOOTEN LAW OFFICE
120 Court Square East
Covington, Tennessee 38019
Office: (901) 475-1050
Fax: (901) 234-0028
William@WootenLawOffice.com
Attorney for Applicant