

ESTTA Tracking number: **ESTTA1380406**

Filing date: **08/29/2024**

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

Proceeding no.	92085186
Party	Plaintiff Telefonica, S.A.
Correspondence address	TODD A SULLIVAN HAYES SOLOWAY PC 175 CANAL STREET MANCHESTER, NH 03101 UNITED STATES Primary email: tsullivan@hayes-soloway.com Secondary email(s): cmorton@hayes-soloway.com 603-668-1400
Submission	Opposition/Response to Motion
Filer's name	Todd A. Sullivan
Filer's email	tsullivan@hayes-soloway.com, cmorton@hayes-soloway.com, cpommer@hayes-soloway.com
Signature	/Todd A. Sullivan/
Date	08/29/2024
Attachments	2024 08 29 Opposition to Motion to Dismiss.pdf(634028 bytes)

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

Telefonica, S.A.)	
)	
Petitioner,)	Cancellation No. 92085186
)	
v.)	Registration No.: 6839586
)	
Deutsche Telekom AG)	Mark: T
)	
Registrant.)	
_____)	

OPPOSITION TO MOTION TO DISMISS UNDER RULE 12(B)

Petitioner Telefonica, S.A. (“Petitioner”) hereby opposes Registrant Deutsche Telekom AG (“Registrant” or “DTAG”) Partial Motion to Dismiss Petitioner’s Amended Petition for Cancellation. Petitioner has adequately stated its claims and has a legitimate interest in the outcomes of the proceedings at least based on Registrant’s Opposition, based on Section 2(d) likelihood of confusion, to Petitioner’s Applications with Serial No. 79317156 for the T TELEFONICA wordmark and Petitioner’s pursuit of Application No. 79975637 for a stylized T Telefonica mark and Petitioner’s prior ownership of Registrations featuring TELEFONICA-formative marks. Additionally, Petitioner has adequately stated a claim for Cancellation on the basis of Section 2(e) descriptiveness because Petitioner adequately asserted the descriptive nature of the “T” mark to describe a feature, quality, purpose, or characteristic of the goods or services covered under the mark, i.e. telecommunications, and Petitioner’s interest in using “T” for Telecommunications, and that is all that is required. *Callaway Vineyard & Winery v. Endsley Capital Group, Inc.*, 2002 TTAB LEXIS 296, 63 U.S.P.Q.2d (BNA) 1919, 1920 (TTAB 2002).

Registrant is trying to lay exclusive ownership of a single letter, which use of this letter is a right held in common with all others in the telecommunications industry, including Petitioner. Registrant is abusing its registration for the single letter “T” to preclude marks from multiple competitors across many industries, and so Registration 6839586 should be cancelled. Petitioner has adequately stated its claims on these two grounds and the two other grounds on which Registrant has again implicitly conceded by failing to address in its partial dismissal motion – Registrant’s failure to actually use the mark in commerce before making its statement of use under Trademark Act Sections 14(1) and 1(a), (c), and (d), and Mutilation, under 37 C.F.R. Sec. 2.51(a).

I. **The Section 2(d) Likelihood of Confusion Count Should Not Be Dismissed Because Petitioner Pleaded Its Own Legitimate Interest in Its Own Tradename and Marks With Priority Over Registrant’s Mark and Pleaded Facts to Show the Single Letter “T” Mark’s Weakness Through Third Party Uses.**

Even after *Iqbal* and *Twombly*, only minimal pleading is required to survive a motion to dismiss, and this Petition clearly meets those standards. *Diedrich v. Ocwen Loan Servicing, LLC*, 839 F.3d 583, 589 (7th Cir. 2016) ("even with the heightened pleading requirements of *Iqbal* and *Twombly*, the pleading requirements to survive a challenge to a motion to dismiss remain low," citing *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) and *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 556 (2007)).

Petitioner only needs to allege sufficient factual content that, if proved, would allow the Board to conclude or draw a reasonable inference that Petitioner has standing and that a valid ground for cancelling the registration exists. *Dragon Bleu v. VENM, LLC*, 2014 TTAB LEXIS 352, *4 (Trademark Trial & App. Bd. December 1, 2014). All well-pleaded facts and inferences from such facts are to be deemed true and in favor of the Petitioner. *Iqbal*, 556 U.S. at 679. The

claim survives if based on the well-pleaded facts there is at least one plausible legal theory upon which relief can be granted. *Id.*

Petitioner notes that Registrant has again opted to not request dismissal of all counts of the Petition for cancellation, including the grounds of Non-Use under the Trademark Act Sections 14(1) and 1(a) (c), and (d) and Mutilation under 37 C.F.R. Sec. 2.51(a), either one of which could alone be sufficient grounds to cancel its Registration. “If a plaintiff can show an entitlement to a statutory cause of action on one ground, it has the right to assert any other grounds in an opposition or cancellation proceeding.” TMBP 309.03(b) (citing *Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017)). Thus, based on the apparent concession of adequate pleadings for the grounds of non-use under Sections 1(a), (c), and (d) and mutilation under 37 C.F.R. 2.51(a), Petitioner has the right to assert cancellation on the grounds of priority and likelihood of confusion under Section 2(d) and descriptiveness under Section 2(e), so Plaintiff has a statutory cause of action to assert the claims on this basis alone.

Additionally, a party has a statutory cause of action to request cancellation of a registration that has been asserted against it. TMBP 309.03(b) (citing *Tonka Corp. v. Tonka Tools, Inc.*, 229 USPQ 857, 859 (TTAB 1986) for the proposition that petitioner has standing to cancel registration that has been asserted, even defensively, in a civil action). Here, Petitioner is entitled to a statutory cause of action under Section 2(d) because Registrant has relied on its ownership of its registration No. 6839586 in Opposition Proceeding 91287659 between the parties, initiated by Registrant against Petitioner, and Registrant has asserted a likelihood of confusion under Section 2(d) as grounds for Opposition to Petitioner’s Application 79317156.

A. Petitioner Pleaded Legitimate Interest In Its Own Marks Forming the Basis Of Its Likelihood Of Confusion Claim.

For a cancellation, Petitioner is required “assert, and then prove at trial, that [Registrant’s] mark, as applied to its goods or services, so resembles [Petitioner’s] previously used or registered mark or its previously used trade name as to be likely to cause confusion, mistake, or deception.” *See* 15 U.S.C. § 1052(d); TMBP 309.03(c)(2). Among the many marks that Petitioner has identified in its Petition for cancellation are the TELEFONICA mark, Reg. No. 2613642 and Petitioner’s trade name, TELEFONICA. *See* 9 TTABVUE 9–10, ¶ 53. The TELEFONICA mark was filed on February 11, 1999, and has priority over the DTAG mark at issue. Petitioner’s trade name has been used in commerce in the United States since 1983. 9 TTABVUE 9, ¶ 52. Registrant’s alleged first use was in January 2006 and its filing date was May 7, 2001. 9 TTABVUE Ex. A. Both Petitioner’s trademark and trade name have priority.

The Registrant’s belief in the likelihood of confusion of these marks is evident from Registrant’s own actions. Registrant has filed Opposition No. 91287659 to block Petitioner’s registrations of further TELEFONICA-formative marks, thereby demonstrating Registrant’s conviction that consumers will be confused as to the source of these marks. 9 TTABVUE 3, ¶ 5. Thus, for at least these reasons, Petitioner has sufficiently pleaded it has a legitimate interest within the zone of interests protected by statute, and the Cancellation filed by Petitioner forms the reasonable basis for Petitioner’s belief that Petitioner would be damaged by registration 6839586. Registrant DTAG has asserted a likelihood of confusion in the opposition, and it cannot deny the same in this cancellation based on the same marks, nor can it deny the legitimate interest Petitioner has in TELEFONICA and TELEFONICA-formative marks.

B. Third-Party Uses Show Weakness of the Single Letter “T” Mark In a Likelihood of Confusion Analysis, And Are Not For Establishing Petitioner’s Legitimate Interest.

Evidence of the overwhelming number of third-party uses falls under the sixth *du Pont* factor for likelihood of confusion – the "number and nature of similar marks in use on similar goods." *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Evidence of third-party uses may bear on the commercial strength or weakness of a mark. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-39, 115 U.S.P.Q.2d 1671, 1674 (Fed. Cir. 2015); *Primrose Retirement Communities, LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1040 (TTAB 2016) (finding evidence of third-party uses and registrations “powerful on its face” and according the factor significant weight in the likelihood of confusion analysis). In *Juice Generation*, for example, the Federal Circuit found the Board’s discounting of evidence of a fair number of third-party uses of marks containing the mark at issue in combination with other product-identifying terms did not adequately account for the apparent force of that third-party evidence. *See Juice Generation*, 794 F.3d at 1339. Significant evidence of third-party use of similar marks on similar goods or services can show that consumers have become conditioned by encountering so many similar marks that they distinguish between them based on minute distinctions. TMEP 1207.01(d)(iii) (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005)).

Here, Petitioner cited a large number of third-party uses and registrations in telecommunications, similar services, and the other classes of goods and services in Registrant’s registration as powerful evidence to show the weakness of a mark in the single letter “T.” Registrant has misplaced its assertion that Petitioner does not have legitimate interest based on

lack of privity in third-party T and T-formative marks that Petitioner listed in its Petition for Cancellation because Petitioner was not using the third-party marks to establish its legitimate interest. Petitioner asserts its legitimate interest in its own pleaded marks. See 9 TTABVUE 3 & 10, ¶¶ 3 & 54. The plethora of T marks shows how relatively small in scope Registrant DTAG's mark should be treated. Like the third-party evidence that was "powerful on its face" in *Juice Generation* and in *Primrose*, here, Petitioner is providing evidence of third-party marks that is powerful on its face to show weakness of the single letter "T" mark and this evidence should be accorded significant weight under the sixth *DuPont* factor in the likelihood of confusion analysis. Petitioner is not required to assert ownership over these marks to cite this evidence of third-party use of the single letter "T" as part of a likelihood of confusion argument.

Additionally, though Registrant asserted their application date was over twenty years ago, Registrant fails to mention the reason the registration was so delayed was that the registration was held up by challenges from holders of other T marks, including proceedings 182339 and 182241, which is additional evidence that Registrant's mark is likely to be confused with other single letter "T" and T-formative marks held by Petitioner and by third parties. See 9 TTABVUE Ex. A at 6 (showing Oppositions [9]182241 and [9]182339 by the Texas Rangers Baseball team and Trend Micro Kabushiki Kaisha delaying Registrant's application). The scope with which Registrant wields the single letter "T" mark against other marks, pleaded in ¶¶ 8–51, including the opposition of the pending T TELEFONICA-formative application, also suggests it is likely to be confused with T TELEFONICA, which Petitioner has used in the United States as a trade name and trademark in multiple T-formative marks since 1983.

The fact that so many third-party uses and registrations exist, in different fonts and stylizations and as formative with other marks without particular fonts or stylizations, bears

significant weight on the commercial weakness and likelihood of confusion of the single letter “T” mark of the registration. Registrant’s reliance on *Jewelers Vigilance Comm. v. Luxenberg Corp.*, 853 F.2d 888, 7 U.S.P.Q.2d 1628 (Fed. Cir. 1988) and *Holmes Prods. Corp. v. Duracraft Corp.*, 30 U.S.P.Q.2d 1549 (T.T.A.B. 1994)) is irrelevant because in addition to Petitioner’s use of the third-party marks to show weakness and narrowness of the single letter “T” mark, Petitioner is also relying on Petitioner’s pleaded own legitimate interest in preventing confusion of Registrant’s weak single-letter “T” mark with Petitioner’s own T-formative marks.

C. Petitioner Has Adequately Pleaded Its Priority Use of the Single Letter “T” Over Registrant.

Pursuant to Trademark Act § 2(d), Petitioner must assert, and then prove at trial, that Registrant DTAG’s mark, as applied to its goods or services, so resembles Petitioner’s previously used or registered mark or its previously used trade name as to be likely to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). Petitioner asserted earlier use of TELEFONICA and other TELEFONICA-formative marks before Registrant’s application date, including use of Petitioner’s tradename in United States commerce since 1983, and other trademarks. 9 TTABVUE 9–10, ¶¶ 52–54. Registrant DTAG has asserted that its single letter “T” is confusingly similar to Petitioner’s TELEFONICA-formative mark in Opposition No. 91287659. 9 TTABVUE 3, ¶ 5. Ergo, based on Registrant’s assertions of likelihood of confusion against Petitioner’s application, it is reasonable for Petitioner to assert that DTAG’s single letter “T” is confusingly similar to Petitioner’s prior use of TELEFONICA and other TELEFONICA-formative marks, and thus the petition meets the pleading requirements to allege priority and likelihood of confusion.

Petitioner has priority over Registrant to use of the single letter “T.” Registrant asserts that Petitioner does not have priority because DTAG’s application for a trademark on the single letter “T” was filed “nearly 20 years ago;” however, Petitioner has alleged priority of use of TELEFONICA-formative marks, including some incorporating the single letter “T” because it is the first letter of Petitioner’s name, Petitioner has been in business since before any US adoption of the T-Mobile brand, and Petitioner has had and continues to own multiple marks containing “T” and TELEFONICA-formatives starting well before the Registration at issue. *See* 9 TTABVUE 9–10, ¶¶52–54. In addition to Petitioner’s ownership of Application Serial No. 79317156, Petitioner notes that the letter “T” is the initial letter of the Applicant’s company name, and it cannot be prevented from using it under common law. Registrant’s present application was allowed over Petitioner’s then-registered T TELEFONICA marks (Ser. Nos. 74389042, 74389043, and 74389455). Petitioner has held multiple US registrations that utilize the letter “T” as a standalone element or part of a word mark or literal element of a design mark, including Petitioner’s marks under Serial Nos.: 73509912 (for T CTNE, registration date 1986-02-04), 73509910, 73509911, 73767856, 73767855, 73767853, 73767854, 73767856, 73692895, 73692886, 75460262, 75458138, 75458139, 73692885, 74437310, 73692893, 75229887, 75230691, 75230692, 86848106, 75230693, 77891572, 75918556, 75918558, 76329090, 76384617, 85806805, 75638601, 74412397, 97310310, 77394927, 75638602, 76164768, 76384853, 77394943, 85367978, 76164767, 76097757, 76384853, 88049951, 73692884, 75322111, 85901232, 75322110, 76106604, and 76106607 and also owned registrations in Spain dating as far back as 1983 including but not limited to N0099837, M1040907, and M1137293. Registrant falsely asserts that Petitioner has no “legitimate interest” in registrations Petitioner owns and pleaded, including active marks composed of a “T” such as

Registration No. 2613642 (filed Feb. 11, 1999, well before the filing date of the registration at issue), which was asserted in Petitioner's Amended Petition, and thus support Petitioner's priority. *See* 9 TTABVue 9–10 ¶¶ 52–54 (stating “The T Registrations provide the respective owners of these trademark registrations, *including Petitioner* with rights to the letter “T”. . . .”) (emphasis added). Petitioner's pleadings asserted that this mark is likely to cause confusion and Registrant failed to challenge that allegation in its Motion to Dismiss.

Petitioner has asserted clear priority based on Petitioner's marks and trade name that were in use prior to Registrant's application and are likely to cause confusion, mistake or deception with respect to Registrant's mark. As Registrant's sole challenge to the likelihood of confusion pleading is the lack of legitimate interest in any of the asserted trademarks and Petitioner unquestionably owns Registration No. 2613642 (filed Feb. 11, 1999) the Petition should not be dismissed.

II. The Section 2(e) Descriptiveness Count Should Not Be Dismissed Because Petitioner Has Adequately Pleaded It Has An Interest In Using T For Telecommunications, The Descriptive Nature of the Single Letter “T,” and a Large Number of Other Marks Use the Single Letter “T” related to Telecommunications.

A. Petitioner's Section 2(e) Pleadings Are Adequate Because Petitioner Listed the Same or Similar Services As Registrant In the Goods/Services Listed in the Marks Cited As a Basis For the Cancellation.

At the pleading stage, Petitioner is not required to show that each product the Registrant is using with its registration is descriptive, only that a product or service in the registration is within the normal scope of Petitioner's business. *See* TMBP 309.03(b).

[W]hen descriptiveness ... of the mark is in issue, [petitioner] may plead (and later prove) its entitlement to a statutory cause of action by alleging that it is engaged in the sale of the same or related products or services (or that the product or service in question is within the normal expansion of [petitioner]'s business) and that the [petitioner] has an interest in using the term descriptively in its business.

Id. (citing, e.g., *Poly-America, L.P. v. Illinois Tool Works Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017)).

In its pleadings, Petitioner asserted as the basis for Cancellation its Application No. 79317156 for T TELEFONICA in class 038, for Telecommunications services (among others), and Application No. 79975637 for a stylized T TELEFONICA for Class 009 including, among others, “telecommunication instruments in the nature of ... cellular telephones”; for Class 035, among others, “advertising services and data management service for use in telecommunications”; for Class 041, among others, “organization of award ceremonies in the field of telecommunications technology, IT, telecommunications, esports, economics”; and for Class 042, among others, “design and development of computer equipment, namely computer hardware and software for telecommunications and technology.” 9 TTABVUE Exs. B & C. Petitioner included Registrant’s list of goods and services in its pleading. 9 TTABVUE Ex. A. The registration at issue lists goods and services in Class 009 including, among others, “telephones; telephone transmitters, telephone networks;” and “[e]lectric, electronic, apparatus and instruments, all for use with telecommunications....” 9 TTABVUE Ex. A. Thus, the same goods are in the same Class 009 in both Registrant’s registration and Petitioner’s application and Petitioner has an interest in using the term descriptively in its normal course of business.

Similarly, in Class 035, the registration at issue lists, among others, “[a]dvertising services.” 9 TTABVUE Ex. A. As in Class 009, the same services are listed in the same class in both Registrant’s registration and Petitioner’s application and Petitioner has an interest in using the term descriptively in its normal course of business.

Again, in Class 042, the registration at issue lists, “[c]omputer programming services for others; consulting in the field of telecommunication.” 9 TTABVUE Ex. A. For this class, as for the others, Petitioner has also pleaded that, as a competitor, the same or related telecommunications goods and services are within the normal scope of petitioner’s business. *See, e.g.*, 9 TTABVUE 3 ¶ 4.

Additionally, in Class 038, the registration at issue lists, among others, “Telecommunication services, namely, electric, digital, cellular and wireless transmission of voice, data, information, images, signals and messages; providing telecommunications connections over a global communications network.” 9 TTABVUE Ex. A. For Registrant to claim that “many of the goods and services in DTAG’s T registrations are not related to telecommunications” misdirects the Board from the fact that many of the goods and services in DTAG’s registration are related to telecommunications in multiple covered classes. *See* 12 TTABVUE 16. Petitioner has thus pleaded that Registrant is using the single letter “T” mark in connection with telecommunications goods and services.

Finally, Registrant’s assertion that “T” is not a descriptive abbreviation for “Telecommunications” goods and services is belied by the fact that the “T” in Registrant’s name, Deutsche Telekom AG (i.e., DTAG, the parent company of T-Mobile), stands for

“Telekom,” which is German for “Telecom,” which is short for “Telecommunications.” Thus, Registrant itself uses the “T” letter to stand for “Telecommunications” in its own name.

Petitioner has adequately pleaded that the product or services associated with Registration 6839586 for the single letter “T” is within the normal operation of Registrant’s business, and that is all that is required at the pleadings stage.

B. The Single Letter “T” is the Descriptive for Telecommunications and Cannot Be Commandeered By Registrant To Lock Out An Entire Industry.

"A mark is merely descriptive if it immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought." *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1373 (Fed. Cir. 2018) (quoting *N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017)). The mark is considered in the context of the goods and services at issue. *City of London Distillery, Ltd. v. Hayman Grp., Ltd.*, 2020 TTAB LEXIS 501, *33, 2020 USPQ2d 11487 (TTAB 2020). "Whether consumers could guess what the product is from consideration of the mark alone is not the test." *Id.* (citing *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985)). The question instead, is “whether someone who knows what the goods and services are will understand the mark to convey information about them.” *City of London*, 2020 USPQ 2d 11487 (citing *DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 695 F.3d 1247, 1254 (Fed. Cir. 2012)).

In its pleadings, Petitioner asserted that the “T” mark conveys information concerning at least telecommunications and telephones, which are goods and services associated with the registration at issue. Additionally, customers do not associate the use of “T” with regard to any

one particular provider of telecommunications services (including Registrant) because the T is symbolic of telecommunications-related goods and services in general. 9 TTABVUE 14. As an example of telecommunications company that is not Registrant but is closely related to the single letter “T,” the petition asserted that the ticker symbol "T" is used by the telecommunications company AT&T (previously known as American Telephone & Telegraph) to represent itself. 9 TTABVUE 13 ¶ 79. Therefore, Petitioner asserted the general public, or at least large number of people who are familiar with telecommunications stock exchanges, would use the symbol "T" as descriptive of a telecommunications company which is *not* Registrant. This, in addition to the fact that Registrant itself uses the “T” letter to stand for “Telecommunications” in its own name, suggest a person familiar with the goods and services offered by Registrant will understand the mark to stand as an abbreviation for “Telephone” and “Telecommunication” and will understand the mark to convey information about telephones and telecommunications services. Registrant suggested it would require ‘some good luck to recognize the meaning of ‘T,’ but, as recognized in *City of London*, that is not the test. As demonstrated above, when viewed by a relevant consumer, the consumer who knows about telecommunications goods and services will recognize the letter “T” as an initialism or acronym of the merely descriptive wording that it represents. If “good luck” was the standard, it would also take such luck for the entire telecommunications industry to operate without the use of the letter “T.”

Thus, Petitioner has adequately pleaded the letter “T” is descriptive of telecommunications goods and services related to the registration and the Petition should not be dismissed.

C. Petitioner Pled A Large Number Of Marks With The Same Composition To Show Descriptiveness Under Section 2(e), and Registrant's Own Actions Show Their Relevance and How Outsized Registrant Wishes Its Entitlement To Be.

The use of a large number of third-party marks with the same composition or forming a part thereof may be used to show descriptiveness. See, e.g., *Spireon, Inc. v. Flex Ltd.*, 71 F.4th 1355, 1363, 2023 USPQ2d 737, at *4-5 (Fed. Cir. 2023)).

[A] large number of active third-party registrations including the same or similar term or mark component for the same or similar goods or services may be given some weight to show, in the same way that dictionaries are used, that a mark or a portion of a mark has a normally understood descriptive or suggestive connotation, leading to the conclusion that the term or mark component is relatively weak.

TMEP 1207.01(d)(iii) (citing *e.g., Spireon*, 71 F.4th at 1363.)

The Petition asserts a large number of active third-party registrations and third-party applications with the same composition or forming a part thereof to show descriptiveness. In Registrant's motion, Registrant admitted that "ten live registrations for marks containing a standalone "T" element." 12 TTABVUE 15. At least US Reg. Nos. 3232651; 4588082; 4737305; 5505291; 5712639; 5915480; and 7190181 that Registrant cites in its motion are single "T" letters *and* are registered for telecommunications goods and services. In fact, Registrant filed a cancellation proceeding No. 92078102 against one of the marks it cited in its motion, Reg. No. 5915480, on the grounds of likelihood of confusion and dilution by blurring. 12 TTABVUE 15; 9 TTABVUE 6, Ex. AW. As another example, Registrant wielded its

registration against application Ser. No. 88866044 to force abandonment of the application for a single letter “T” for telecommunications services in class 038, and application service provider services in class 042. 9 TTABVUE 6. Thus, the petition adequately cited multiple third-party marks comprising a single letter “T” and for telecommunications-related goods and services.

Additionally, the petition cites third-party mark applications or registrations containing a standalone single letter “T” elements which were attacked by registrant wielding its blunt instrument “T” registration to eliminate marks sought in all manner of goods and services outside Registrant’s claimed classes, such as in Serial Nos. 88405013, 87738573, 79270169, 79272465, 79263000, 97053233, 97365379, 97014190, 97362057, 97144075, and 97642886. 9 TTABVUE 3–9 ¶¶ 13–14, 19–20, 23–24, 32–33, 34–35, 40–51. Petitioner’s pleading asserts Registrant has used US Registration No. 6839586 to challenge all manner of trademark applications that utilize the letter T alone or as a formative with little consideration for the goods or services offered by the applicants under the auspices of dilution. 9 TTABVUE 3 ¶ 8. Registrant attacked marks in classes 010, 012, 016, 028, 037, 039, 041, 044, 045 in addition to marks in Classes 009, 035, 036, 038, and 042. *See* 9 TTABVUE 3–9. In addition to goods and services related to telecommunications, the applications and registrations Registrant forced abandonment of or sought cancellation of include goods and services such as artificial limbs, medical services, emergency response software, provision of traffic information, bags for cameras, media players, amusement machines, video games, flash drives, and online social networking in addition to telecommunications services. 9 TTABVUE 3–9. Registrant completed its registration only on Sep. 06, 2022. 9 TTABVUE 3, Ex. A. The plethora of oppositions and cancelations Registrant has already filed shows how outsized the Registrant believes their rights to be over the letter T.

Registrant has demonstrated through its own proceedings that marks that contain a “T” element, such as Petitioner’s “T TELEFONICA,” are at risk of attack by Registrant, and as such its arguments relating to marks that are “not a single letter ‘T’ alone, but instead are word marks or composite marks in which the letter ‘t’ (sic) is included in the text of a longer word” are of no substance. *See* 12 TTABVUE 14. Registrant has used the registration as issue to attack word marks or composite marks in which the single letter “T” is included in the text of a longer word such as “T-SUITE,” “T-MEDIA,” “T-CARBON,” “TC MOBILE,” “TSCOPE,” “T TASKA,” “TBOX,” “T TRIHOS,” and “T++” in addition to attacks on marks that are a single letter “T.” *See* 9 TTABVUE 3–9. Thus, Registrant’s assertion that the third-party marks listed in the petition are not limited to single “T” marks is of no value because Registrant does not limit itself to using its Registration to attack registrations comprised only of single letter “T” marks, including the Serial No. 79317156 at issue for “T TELEFONICA.” Each of the large number of third-party registrations and third-party applications cited in the petition is relevant to the Section 2(e) analysis to show the mark has a “normally understood descriptive or suggestive connotation.” *Spireon*, 71 F.4th at 1363.

The marks cited in the Cancellation are all either the same composition (as admitted by Registrant) or form a part thereof (like Petitioner’s application that Registrant has opposed and other applications and registrations cited in the petition), and thus are sufficient to plead facts supporting cancellation based on Section 2(e) descriptiveness.

For all of the above reasons, Petitioner has standing to Petition for Cancellation and Registrant’s partial motion to dismiss Petitioner’s Section 2(d) and 2(e) counts should be denied.

Dated: August 29, 2024

Respectfully Submitted,

/Todd A. Sullivan/
Todd A. Sullivan, Esq.
HAYES SOLOWAY P.C.
175 Canal Street
Manchester, NH 03101
Tel: (603) 668-1400
Fax: (603) 668-8567
Email: TSullivan@hayes-soloway.com

Attorney for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of the foregoing Opposition to Motion to Dismiss has been served via email on August 29, 2024, on ROSS Q. PANKO, counsel for Opposer, at the following address:

ROSS Q. PANKO
ARENTFOX SCHIFF LLP
1717 K STREET NW
WASHINGTON, DC 20006
tmdocket@afslaw.com; craig.horak@afslaw.com; ross.panko@afslaw.com

Dated: August 29, 2024

/Crystal Morton/
Crystal Morton