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

Proceeding no.	92085186
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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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 Petition for Cancellation and submits an amended Petition for Cancellation. Petitioner has adequately stated its claims pursuant to the Federal Rule of Civil Procedure 12(b)(6) and the Trademark Trial and Appeal Board Rule 503. Petitioner 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. 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 and Petitioner’s interest in using “T” for Telecommunications. 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. Registration 6839586 should be cancelled, and Petitioner has adequately stated its claim for these grounds.

As an initial matter, Petitioner notes that Registrant has not moved to dismiss the Petition for cancellation on the grounds of non-use under the Trademark Act Sections 14(1) and 1(a) (c), and (d) or mutilation under 37 C.F.R. Sec. However, with this Opposition, Petitioner is also filing an Amended Petition for Cancellation as a matter of right,¹ in which the pleadings are clarified and expanded. The Amended Petition for Cancellation repeats all original allegations and adds paragraphs relating to Section 2(d) priority and likelihood of confusion, especially regarding third party uses of the single letter “T” mark, Section 2(e) descriptiveness, and 37 C.F.R. Sec. 2.51(a).

I. The Petition on the Grounds of Section 2(d) Likelihood of Confusion Should Not Be Dismissed Because Petitioner Pleaded Its Own Legitimate Interest in Its Own Marks and Presented Evidence of the Likelihood of Confusion Through Third Party Uses of the Single Letter “T.”

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

¹ Petitioner’s time to file an Amended Petition for Cancellation was extended to July 22, 2024, by stipulated Order entered July 15, 2024.

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 not asserted Petitioner moved to dismiss the Petition for cancellation on the grounds of Non-use under the Trademark Act Sections 14(1) and 1(a) (c), and (d) or Mutilation under 37 C.F.R. Sec. 2.51(a). “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 the claims should survive on that basis alone.

A. Petitioner Pleaded Its Own Legitimate Interest In Its Own Marks, and That Is All That Is Required At the Pleading Stage.

For a cancellation, Petitioner is required only to allege that it has a legitimate interest at stake and will be damaged by the registration. See TMBP 309.03, citing *Empresa Cubana del Tabaco v. General Cigar Co.*, 753 F.3d 1270, 1275, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). “At the pleading stage, all that is required is that a [petitioner] allege facts sufficient to show it has an interest within the zone of interests protected by statute, i.e., a ‘real interest’ and damage proximately caused by registration.” TMBP 309.03(b) citing *Empresa Cubana*, 753 F.3d at 1275 (finding a legitimate interest in the cancellation of Registrations that are causing Plaintiff damage by blocking its application). Petitioner is not required to plead prior proprietary rights in a conflicting mark to avoid a motion to dismiss. See *Major League Soccer, L.L.C. v. F.C.*

Internazionale Milano S.p.A., 2020 TTAB LEXIS 502, at *12 (Trademark Trial & App. Bd. December 9, 2020).

[T]he Board has also recognized that a plaintiff's "proprietary interest" need not be present if the plaintiff alleges some other "legitimate interest" in preventing a likelihood of confusion between the pleaded mark on which it predicates the Section 2(d) claim. This legitimate interest, if pleaded, could serve as part of a proper ground for likelihood of confusion in lieu of a claim of one's own prior proprietary rights in a conflicting mark.

Id.

Here, like legitimate interest in *Empresa Cubana*, Petitioner has pleaded its ownership of the pending application for "T TELEFONICA" with US serial number 79317156, against which Registrant has filed Opposition No. 91287659 to block Petitioner's registrations, thereby demonstrating Petitioner's legitimate interest. 1 TTABVUE 7 ¶¶1-4. Petitioner has also cited application No. 79975637 for a stylized "T" composed of five dots, the "T" being left of the term "TELEFONICA" as grounds for this cancellation. 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.

Additionally, 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 another proceeding between the parties, and Registrant has asserted a likelihood of confusion in that proceeding between the parties involving Petitioner's Application 79317156. 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). In Proceeding 91287659 initiated by Registrant against Petitioner, Registrant cites likelihood of confusion under Section 2(d) as its ground for Opposition.

B. Privity With Third Parties Is Not Required Because the Third-Party Uses Were In a Likelihood of Confusion Analysis, Not For Establishing Petitioner's Legitimate Interest.

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. Instead, Petitioner is citing this evidence of third-party use of the single letter "T" as part of its likelihood of confusion argument. 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 use 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) (dismissing opposition; third party evidence demonstrates weakness of mark). 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 on similar and other goods and services to show the weakness of a mark in the single letter “T.” The fact that so many third-party uses, in different fonts and stylizations and as formative with other marks without particular fonts or stylizations, bears weight on the commercial weakness and likelihood of confusion of the single letter “T” mark of the registration. Registrant’s reliance on *Jeweler’s Vigilance* is irrelevant because Petitioner is relying on Petitioner’s own legitimate interest in its own marks, and not a position as a trade organization.

C. Though not required to prove priority, Petitioner has priority use of the single letter “T” over Registrant.

Though not required to assert priority, Petitioner does have 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, 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” marks.

Additionally, Petitioner has priority of use of the single letter “T” because it is the first letter of Petitioner’s name, Petitioner has been in business longer than Registrant has owned the T-Mobile brand, and Petitioner has had and continues to own multiple marks containing “T” and “T”-formatives starting well before the Registration at issue. In addition to 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. Petitioner has been in business since 1924, has been active in commerce in the United States since 1983, well before T-Mobile, the brand asserting the single letter “T” as a mark, was an entity and well before Registrant purchased T-Mobile. 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 serial Nos.: 73509912 (for T CTNE, registration date 1986-02-04), 73509910, 73509911, 73767856, 73767855, 73767853, 73767854, 73767856, 74389042, 74389043, 73692895, 73692886, 75460262, 75458138, 75458139, 73692885, 74437310, 73692893, 75229887, 75230691, 75230692, 86848106, 75230693, 74389455, 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. Petitioner has active marks composed of a “T” including Registration Nos. 2613642 (filed Feb. 11, 1999), 3000950, 4091502, 5574678, 6236145, and 7394829.

So, even if priority to use a single letter “T” is required to sustain a cause of action, Petitioner has clear priority over the single letter “T” registration based on prior, current, and common law rights.

II. **Petitioner’s Petition on the Grounds of Section 2(e) Descriptiveness Should Not Be Dismissed Because Petitioner Has Adequately Pleaded “T” is Descriptive of Telecommunications Companies, It Has An Interest In Using T For Telecommunications, and a Large Number of Other Marks Use the Single Letter “T” related to Telecommunications.**

A. Petitioner Adequately Pleaded the Letter “T” Is Descriptive of Telecommunications Companies.

In its pleadings, Petitioner asserted that customers do not associate the use of “T” with regard to any particular provider of telecommunications services because the T is symbolic of telecommunications-related goods and services. 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, stands for “Telekom,” which is German for “Telecom,” which is short for “Telecommunications.” Petitioner additionally notes that the ticker symbol "T" is used by the telecommunications company AT&T (previously known as American Telephone & Telegraph) as additional evidence of descriptiveness, or at least the use of the symbol "T" by the general public as descriptive of a telecommunications company which is *not* Registrant and the use of “T” as a known abbreviation of Telephone. Thus, when viewed by a relevant consumer, the consumer will recognize the letter “T” as an initialism or acronym of the merely descriptive wording that it represents. The “T” is similarly an abbreviation for Telekom, as in DTAG or T-Mobile.

B. 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 the product or service is within the normal scope of Petitioner’s business.

[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.

TMBP 309.03(b) (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; Class 035 including, among others, advertising services and data management service for use in telecommunications; Class 041 for, among others, organization of award ceremonies in the field of telecommunications technology, IT, telecommunications, esports, economics; and Class 042 for, among others, design and development of computer equipment, namely computer hardware and software for telecommunications and technology. Petitioner has pleaded that Registrant is using the single letter "T" mark in connection with telecommunications goods.

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

C. Petitioner Pled A Large Number Of Marks With The Same Composition To Show Descriptiveness under Section 2(e).

The use of a large number of 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.)

In Registrant's motion, Registrant admits that at least nine of the Marks in the pleading are standalone "T" letters. 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. However, Registrant is not limiting its attack on other registrations to single "T" marks alone, including the Serial No. 79317156 at issue for "T TELEFONICA" so Registrant's assertion that the 195 third-party marks listed in the petition are not limited to single "T" marks is of no value. 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 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 motion to dismiss based on 12(b) should be denied.

Dated: July 19, 2024

Respectfully Submitted,

/Todd A. Sullivan/

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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 July 19, 2024, on ROSS Q. PANKO, counsel for Opposer, at the following address:

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Dated: July 19, 2024

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