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

Proceeding	91234318
Party	Defendant Smithsonian Institution
Correspondence Address	LAURYN H GUTTENPLAN SMITHSONIAN INSTITUTION PO BOX 37012 SIB 302 MRC 012 WASHINGTON, DC 20013-7012 UNITED STATES Email: guttenplanl@si.edu
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Lauryn Guttenplan
Filer's email	guttenplanl@si.edu
Signature	/Lauryn Guttenplan/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Before the Trademark Trial and Appeal Board**

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CARL RAYMOND AMOS,	)	
	)	
	)	
Plaintiff-Opposer,	)	Opposition No. 91234318
	)	
v.	)	
	)	
SMITHSONIAN INSTITUTION,	)	
	)	
Defendant-Applicant.	)	
	)	
	)	

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**APPLICANT’S MOTION TO DISMISS FOR LACK OF  
SUBJECT MATTER JURISDICTION AND FOR FAILURE TO STATE A CLAIM**

Defendant-Applicant, The Smithsonian Institution, (hereinafter Applicant), moves pursuant to Fed. R. Civ. P. 12(b)(1) and 12(b)(6) to dismiss each and every ground for opposition pled by Plaintiff-Opposer (hereinafter Opposer) in this matter in the Opposer’s amended notice of opposition (hereinafter, “Am. Not.”), which was accepted by the Board as Opposer’s operative pleading in this proceeding on June 1, 2017.

**STATEMENT OF THE ISSUES**

1. Whether Opposer’s alleged ground of opposition of “Copyright Infringement” should be dismissed because this Board lacks jurisdiction. *See* Am. Not. at ¶¶ 6-8.
  
2. Whether Opposer has failed to state a claim for likelihood of confusion under § 1052(d) because Applicant’s first use defeats this ground as a matter of law where Opposer’s allegations are founded on applications for registration, the filing basis of which were both amended to become “intent to use” applications under 15 U.S.C. § 1051(b) and to delete 15 U.S.C. § 1051(a)

as an alleged filing basis. *See* Am. Not. at ¶¶ 9-12.

3. Whether Opposer has failed to properly plead dilution as a ground for opposition given that Opposer’s pleading conspicuously omits any allegation that Opposer’s marks are famous. *See* Am. Not. at ¶¶ 13-15.

4. Whether Opposer has failed to properly plead deception as a ground for opposition given that Opposer’s pleading conspicuously omits (1) any allegation relating to the character, quality, function, composition or use of Applicant’s listed services, omits (2) any allegation relating to whether prospective users of Applicant’s services are likely to believe that an alleged misdescription actually describes the Applicant’s listed services, and omits (3) any allegation relating to whether the misdescription is likely to affect the decision to purchase Applicant’s goods or services. *See* Am. Not. at ¶¶ 16-17.

5. Whether Opposer’s “Differing Classification” statements fail to state a claim for relief in support of a valid ground of opposition. *See* Am. Not. at ¶¶ 18-19.

#### **STATEMENT OF THE CASE**

“The Smithsonian Institution is the world’s largest museum, education, and research complex, with 19 museums, 9 research institutions and the National Zoo—shaping the future by preserving our heritage, discovering new knowledge, and sharing our resources with the world.” *See* <https://www.si.edu/about> (last visited June 29, 2017). The Smithsonian Institution was

established as a trust instrumentality of the United States by act of Congress.

The National Museum of African American History and Culture (“NMAAHC”) was established in 2003 by an act of Congress, making it the 19th Smithsonian Institution museum. It is the only national museum devoted exclusively to the documentation of African American life, art, history and culture. The Smithsonian Board of Regents, the governing body of the Institution, voted in January 2006 to build the museum on a five-acre site on the National Mall. *See* Serial Number 87081623, Response to Office Action filed February 1, 2017 (News Release dated October 3, 2008, page 2).

On June 23, 2016, the Smithsonian Institution filed an application for registration of a service mark pursuant to § 1051(a) of the Lanham Act in international class 041 for museum services for NMAAHC. *See* Serial Number 87081623. “The mark consists of a representation of a silhouette of the exterior tiered design of the museum building with the following words stacked on top of each other inside the silhouette: ‘NATIONAL, MUSEUM OF, AFRICAN, AMERICAN, HISTORY &, CULTURE,’ with ‘OF’ and ‘&’ underlined.” *Id.* As required by 15 U.S.C. § 1051(a)(2) the application provided “the date of the applicant’s first use of the mark in commerce[,]” which was identified as October 28, 2015. *See* Serial Number 87081623, Service Mark application filed June 23, 2016 (indicating a “first use in commerce” date of “at least as early as 10/28/2015”).

Opposer filed an opposition with this Board contesting the registration of Applicant’s mark. Opposer’s amended notice of opposition was accepted by this Board as Opposer’s operative pleading in this proceeding on June 1, 2017. As the pleaded basis for priority over Applicant’s mark, Opposer wrote as follows: “The Opposer had filed his JWAHMOSE

trademarks 01-18-2016 and 12-07-2015, see Appendix B, nearly a year and a half ago. The Applicant’s ‘mark’ on the other hand has a filing date of 06-23-2016 not quite a year ago, see Appendix C.” Am Not. at ¶ 11. Appendix B to Opposer’s pleading references two applications for registration, namely Serial Number 86878041, filed January 18, 2016, and Serial Number 86840684, filed December 7, 2015. Am Not., Appendix B. In both of these applications, following refusal by the PTO, Opposer amended the filing basis to delete “actual use” under 15 U.S.C. § 1051(a) as the alleged filing basis, and replaced them with “intent to use” applications under 15 U.S.C. § 1051(b).<sup>1</sup>

## ARGUMENT

### I. THE PERTINENT LEGAL STANDARDS

The government is filing this motion in lieu of an answer, in accordance with Fed. R. Civ. P. 12(a)(4).<sup>2</sup> “The filing of a motion to dismiss for failure to state a claim upon which relief can

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<sup>1</sup> This is not the only proceeding Opposer has brought relating to Applicant’s mark. On September 1, 2016, Opposer sued the Smithsonian in the U.S. Court of Federal Claims, asserting claims for copyright infringement (28 U.S.C. § 1498), as well as violations of the Digital Millennium Copyright Act (17 U.S.C. §§ 1203, 1204), the Lanham Act (15 U.S.C. § 1125), and the Racketeer Influenced and Corrupt Organizations Act (18 U.S.C. § 1962). Complaint, *Amos v. United States*, No. 16-cv-01094-EJF (Fed. Cl. Sept. 1, 2016), ECF No. 1. The court dismissed Opposer’s complaint. *Id.* at ECF No. 38. Mr. Amos filed an untimely appeal which was dismissed on June 28, 2017. *See Amos v. United States*, No. 2017-2036, ECF No. 12 (Fed. Cir. June 28, 2017) (Order dismissing Appeal). Opposer also filed a Complaint in the District Court of the Eastern District of Virginia against the Smithsonian alleging, *inter alia*, “violation of US Trademark, US Copyright and US Patent Infringement Laws . . . .” *Amos v. Smithsonian Institution*, No. 1:16-CV-01191, (E.D. Va. Sept. 19, 2016), ECF. No. 1 (Complaint) at 1. The court dismissed Opposer’s complaint in that matter on February 27, 2017. *Id.* at ECF. No. 38 (order dismissing case)).

<sup>2</sup> These proceedings are governed by the Federal Rules of Evidence and Federal Rules of Civil Procedure. 37 C.F.R. §§ 2.116(a), 2.122(a).

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