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

Proceeding	92072806
Party	Plaintiff Sparks Law, LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of United States Reg. Nos. 5668170 & 5672233

For the mark SPARKS LAW

Sparks Law, LLC,

Petitioner,

v.

Sparks Law, LLC,

Respondent.

Opposition No. 92072806

PETITIONER’S MOTION FOR JUDGMENT ON THE PLEADINGS

Petitioner, Sparks Law, LLC (“Petitioner” or “New England Sparks Law”), hereby moves, pursuant to Rule 12(c) of the Federal Rules of Civil Procedure and Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 504, for a judgment on the pleadings with respect to the claims set forth in Petitioner’s Petition For Cancellation. Petitioner moves for judgment on the pleadings because Respondent, Sparks Law, LLC (“Respondent” or “Georgia Sparks Law”), is unable to show that it has priority of rights in the SPARKS LAW mark, and also has not used the mark in interstate commerce, as it only provides services within the state of Georgia.

STATEMENT OF UNDISPUTED FACTS

Respondent is the owner of two federal registrations, Registration No. 5672233 (“SPARKS LAW” standard characters) and Registration No. 5668170 (“SPARKS LAW” design plus words,

letters, and/or numbers) (collectively, the “Respondent’s Registrations”). *See* Declaration of Ryan S. Luft (“Luft Decl.”), dated January 31, 2020, ¶ 2. Both of Respondent’s Registrations claim a date of First Use in Commerce of March 29, 2016. *See id.*

The principal of New England Sparks Law, Thomas E. Sparks, has been a licensed attorney in Rhode Island since May 21, 1993, and in Massachusetts since December 17, 1993. *See* Declaration of Thomas E. Sparks (“Sparks Decl.”), dated January 31, 2020, ¶ 1. His firm, Sparks Law, LLC, the Petitioner in this matter, has been registered with the Rhode Island Secretary of State since June 19, 2012. Sparks Decl., ¶ 2. New England Sparks Law provides legal services in at least two states – Rhode Island and Massachusetts. Sparks Decl., ¶ 3. Since at least September 1, 2012, New England Sparks Law has advertised its legal services and continuously used the “SPARKS LAW” mark in interstate commerce. Sparks Decl., ¶ 4. The URL, 1800sparkslaw.com, was registered in 2009, and has been used in firm advertising since at least 2012. Sparks Decl., ¶ 5. It has not abandoned its use of the mark. *Id.*

On December 6, 2017, New England Sparks Law filed an application for SPARKS LAW (standard character mark). Luft Decl., ¶ 3. New England Sparks Law claims a date of first use of September 1, 2012, *see id.*, as that marked its first use of the “SPARKS LAW” mark in Interstate commerce. *See id.*; *see also* Sparks Decl., ¶ 4.

Respondent, Georgia Sparks Law, claims a first use of its marks that are subsequent to New England Sparks Law’s first use in commerce. Georgia Sparks Law was formed in Georgia on January 11, 2016. Luft Decl., ¶ 4. As evidenced on its website, none of the attorneys in the Georgia Sparks Law firm are licensed in jurisdictions outside of Georgia, and the legal services provided by that firm are confined to Georgia. Luft Decl., ¶ 6.

Nonetheless, despite the above undisputed facts, the Examining Attorney responsible for Petitioner's application cited Respondent's marks as a bar to registration. Petitioner filed the present Petition for Cancellation against Respondent on November 11, 2019.¹ Respondent filed an Answer on December 31, 2019.

ARGUMENT

I. Standing

In order for Petitioner to establish standing, Petitioner must show that it possesses a real interest in the proceeding beyond that of a mere intermeddler, and that it has a reasonable basis for its belief of damage resulting from the registration, or continued registration, or the subject mark. *Marco Industries, Inc. v. Mark White*, Cancellation No. 92065963 (T.T.A.B. 2019) [not precedential] (citing *Ritchie v. Simpson*, 170 F.3d. 1092, 50 U.S.P.Q.2d 1023, 1025-26 (Fed. Cir. 1999)).

Trademark Rule 2.122(d) specifies that a party may make a pleaded registration of record in an *inter partes* proceeding by submitting a copy of the registration, or a printout of information from the USPTO database records, showing current status and title of the registration. The Board does not take judicial notice of applications or registrations residing in the USPTO records. *See UMG Recordings Inc. v. O'Rourke*, 92 U.S.P.Q.2d 1042, 1046 (T.T.A.B. 2009).

Petitioner has alleged in its Petition for Cancellation that its use in commerce of SPARKS LAW predates the purported use in commerce by Respondent. In connection therewith, Petitioner

¹ Although unusual in form, Petitioner cited both of Respondent's Registrations in Petitioner's Petition for Cancellation. Petitioner separated its Petition into two parts, each of which addressed one of Respondent's Registrations.

has submitted the Declarations of Ryan S. Luft and Thomas E. Sparks, and also has submitted a copy of Respondent's registrations and a printout of Petitioner's trademark application from the USPTO database records.

The United States Patent and Trademark Office refused registration of Petitioner's application on the basis of Respondent's marks. Petitioner has standing in this matter pursuant to the citation of Respondent's registration against Petitioner's application. *See, e.g., WeaponX Performance Prods. v. Weapon X Motorsports, Inc.*, 126 U.S.P.Q.2d 1034, 1040 (T.T.A.B. 2018).

II. Legal Standard

A motion for judgment on the pleadings is a test solely of the undisputed facts on the pleadings, supplemented by any facts of which the Board will take judicial notice. TBMP § 504.02. A judgment on the pleadings should be granted where, as here, the facts admitted establish that the moving party is entitled to judgment on the claim as a matter of law. *Id.* "A judgment on the pleadings may be granted where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved, and the moving party is entitled to judgment, on the substantive merits of the controversy, as a matter of law." *Id.* Judgment on the pleadings is appropriate where the nonmoving party's pleading does not raise issues of fact, which if proved, would establish its entitlement to judgment. *See id.* Judgment on the pleadings is particularly appropriate where, as in this case, judgment on the merits can be achieved by focusing on the pleadings.

There is no dispute in this instance that the marks are confusingly similar – identical – and that the services provided by the parties are related (even though only Petitioner provides such services in interstate commerce). Therefore, the sole issues in this case involve priority and whether Respondent is an actual user of its mark in interstate commerce as required by the Lanham

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