ESTTA Tracking number: **ESTTA302157**
Filing date: **08/20/2009**

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

Proceeding	91181975
Party	Defendant Goldstar Holdings Corp
Correspondence Address	Carl Oppedahl Oppedahl Patent Law Firm LLC P O Box 4850 Frisco, CO 80443-4850 UNITED STATES carl2@oppedahl.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Carl Oppedahl
Filer's e-mail	docket-oppedahl@oppedahl.com
Signature	/s/
Date	08/20/2009
Attachments	20090820-motion.pdf (6 pages)(104392 bytes)

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

----------X

Joanna Villeneuve

and

Mélanie Villeneuve

Opposers

versus

Goldstar Holdings Corp.

Applicant

Proceeding number 91181975

Application Number 79030057

International Registration No. 0901438

----------X

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

Applicant Goldstar Holdings Corp. previously moved to dismiss the Notice of Opposition in this proceeding for failure to state a claim upon which relief can be granted. Fed. R. Civ. P. 12(b)(6), TTAB Manual of Procedure chapter 503. The Board granted that motion to dismiss, but allowed the Opposers to try again by filing an Amended Notice of Opposition. The Amended Notice of Opposition is likewise defective and likewise fails to state a claim upon which relief can be granted, and does not contain even a good-faith effort to overcome the defects of the first Notice. Applicant Goldstar Holdings Corp. is thus now forced to spend the time and the money to prepare and file another Motion to Dismiss, and this Board is forced to spend more time. The proceeding should be dismissed with prejudice.

Legal standard to be applied. The Opposition must be dismissed unless the Notice alleges such facts as would, if proved, establish that (each of) the Opposers is entitled to the relief sought, that is, that:

1. (each of) the Opposers has standing to maintain the proceeding, *and*
2. a valid ground exists for denying the registration sought.

(TBMP section 503.02.) Thus a failure to plead enough to support a valid ground for denying registration would suffice to mandate dismissal.

False suggestion of a connection? The Opposers had previously attempted to put forth grounds for opposition under Section 2(d) and Section 2(a) of the Lanham Act. This failed. Now the Opposers have shifted ground and are now saying their ground for opposition is solely under Section 2(a) of the Lanham Act.

An essential element of a cause of action under Section 2(a) is as follows:

> A refusal on this basis requires, by implication, that the person ... with which a connection is falsely suggested must be the prior ***user*** [in the United States]. *In re Nuclear Research Corp.*, 16 USPQ2d at 1317; *In re Mohawk Air Services Inc.*, 196 USPQ 851, 854-55 (TTAB 1977).

(TMEP section 1203.03(e), emphasis added.) Nowhere in the Amended Notice is there any allegation that the Opposers are "the prior user" in the United States as would be required for a successful pleading of such a Section 2(a) cause of action. Indeed nowhere in the Amended Notice is there any allegation at all that either of the Opposers is a "user" in the United States at all. For this reason alone, the Amended Notice fails and must be dismissed.

To state a claim of false suggestion of a connection under Section 2(a), the Opposers would have to allege facts from which it may be inferred that:

1. applicant's mark is the same as, or a close approximation of, the Opposers' ***previously used (in the United States)*** name or identity;
2. the mark would be recognized as such, in that it points uniquely and unmistakably to the identity or persona of the Opposers;
3. the would-be opposer is not connected with the activities of applicant under the mark; and
4. the Opposers' name or identity is of sufficient fame or reputation that when applicant's mark is used on its goods or services, a connection with opposer would be presumed.

See *The Internet, Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435, 1437 (TTAB

1996); see also, *Buffett v. Chi Chi's Inc*., 226 USPQ 428 (TTAB 1985).

The Opposers have not, however, pled any "previous use" in the United States as would be required to satisfy the first of the four requirements stated in that case.

Also, a properly pleaded claim of false suggestion of a connection clearly must assert either:

- would-be opposer's ***prior use (in the United States)*** of applicant's mark, or the equivalent thereof, as a designation of its identity or "persona", or
- an association of the same (in the United States) with the Opposers prior in time to the defendant's use or constructive date of use.

See, e.g. *Alabama Board of Trustees v. BAMA-Werke Curt Baumann*, 231 USPQ 408 (TTAB 1986).

The Opposers have not, however, pled the "prior use" in the United States as would be required to satisfy the first of the two requirements stated in that case.

The Opposers have not pled any "association of the same" in the United States as would be required to satisfy the second of the two requirements stated in that case.

Conspicuous by its absence in the Amended Notice is any allegation whatsoever of ***any*** connection with the United States on the part of either of the Opposers.

Paragraph 3, for example, carefully avoids claiming any trademark or publicity rights ***in the United States***. Paragraph 9 likewise carefully avoids claiming any publicity rights ***in the United States.*** (One assumes that it is Rule 11 that prompts the Opposers to refrain from making such a claim regarding rights in the United States.)

To the extent that any paragraph of the Amended Notice purports to allege violation of Section 2(a), it is apparently paragraph 8. Paragraph 8, quoted in its entirety, is:

> The registration and/or use of the mark GILLES VILLENEUVE by the Applicant would therefore falsely suggest a connection with the Opposers' late husband and father, Gilles Villeneuve, in violation of Section 2(a) of the Act, 37 U.S.C. § 1052(a).

This paragraph does no more than cite the Section, but contains no actual factual allegation. The paragraph is merely a conclusory statement of a legal conclusion, a supposed "violation of Section 2(a)".

Dismissal with prejudice. The Opposers have already had a "do-over". Should they be given yet another "do-over"? Did Opposers learn from the detailed opinion dated September 20, 2008 in which this Board explained in detail how to write a Notice of Opposition that would state a claim? These questions prompt a comparison of the second Notice of Opposition with the first Notice of Opposition, and the comparison suggests that the answer to each question should be "no".

So far as the undersigned can discern, what changed in the second Notice is that a new Paragraph 8 has been added. This is presumably the paragraph that is meant to overcome the deficiency in the first Notice. Yet this paragraph (quoted above in its entirety) does nothing whatsoever to overcome any deficiency in factual allegations.

Had there been even a good-faith but unsuccessful effort in the Amended Notice to overcome the pleading deficiency, this Board might choose to exercise its discretion to allow a second "do-over". The Amended Notice, however, does not show (to the eye of the undersigned, at least) even a good-faith effort to remedy the deficiency. It is respectfully suggested that the grant of a second "do-over" would only waste the time of this Board and of the applicant. It is respectfully suggested that the proceeding be dismissed with prejudice.

Conclusion. Applicant prays that the Opposition be dismissed with prejudice and that the Board grant to Applicant such other and further relief as the Board deems just and proper.

Respectfully submitted,

Goldstar Holdings Corp.
By its attorney

/s/

Carl Oppedahl
PTO Reg. No. 32746
Oppedahl Patent Law Firm LLC

Certificate of Service

The undersigned certifies that the attached paper is being served upon Opposers, by their attorney:

Robert M. O'Connell, Jr.
Goodwin Procter LLP
53 State Street
Boston, MA 02109-2881

this 20th day of August, 2009, by first-class mail.

/s/

Carl Oppedahl
USPTO Reg. No. 32746