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

Proceeding	91181975
Party	Defendant Goldstar Holdings Corp
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Submission	Motion to Dismiss - Rule 12(b)
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Joanna Villeneuve

and

Mélanie Villeneuve

Opposers

versus

Goldstar Holdings Corp.

Applicant

----------X

Proceeding number 91181975

Application Number 79030057

International Registration No. 0901438

MOTION TO DISMISS
FOR LACK OF STANDING
AND
FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED

Applicant Goldstar Holdings Corp. moves to dismiss this Opposition for lack of standing and 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.

Applicant has diligently scrutinized the Notice of Opposition in this proceeding to attempt to discern any cognizable claim upon which relief can be granted. Having found none, Applicant moves for dismissal.

As the Notice is devoid of any coherent statement of the actual legal theory (cause of action) upon which the application is being opposed, applicant (and this Board) is put in the awkward position of having to try to guess what cause of action is being asserted, and "testing" each such candidate cause of action to see if the pled allegations suffice to support the cause of action. In the paragraphs which

follow, the applicant will describe each of the "tested" candidate causes of action and will identify allegations which would need to be pled, but which are missing, thus leaving the Notice in the position of having failed to plead any cause of action.

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 either defect (failure to plead enough to show that each Opposer has standing, or failure to plead enough to support a valid ground for denying registration) would suffice to mandate dismissal. As will be discussed below, the present Notice suffers from both defects. The lack-of-valid-ground-for-denying-registration defect will be discussed first, and the other defect in turn.

Likelihood of confusion? At paragraph 8, the Notice puts forth the unsupported claim that:

> there is a very high likelihood that purchasers and potential purchasers of Applicant's goods will be confused or deceived into believing that the goods have been authorized or endorsed by the Villeneuve family, all to the great detriment of the goodwill which Opposers hold in the GILLES VILLENEUVE name.

The mention of a concern that purchasers might "be confused or deceived" brings to mind Section 2(d) of the Lanham Act (15 USC section 1052(d)) and prompts a guess that the claim upon which Opposers hope that relief could be granted might be a Section 2(d) claim.

But Section 2(d) only works if the would-be opposer is able to point to "a mark or trade name previously used in the United States [by the opposer] and not abandoned." (15 USC section 1052(d).)

Nowhere in the Notice, however, has applicant been able to find a place where Opposers (presumably, each of them) allege having used ***any*** mark or trade name "in the United States". The lack of such an allegation in the Notice means that no cause of action under Section 2(d) has been pled.

Furthermore nowhere in the Notice has applicant been able to find a place where Opposers (again, presumably, each of them) allege that such mark or trade name has not been abandoned. The lack of such an allegation in the Notice likewise means that no cause of action under Section 2(d) has been pled.

The "use" of a mark or trade name under Section 2(d) means "use in commerce" with respect to goods or services (or both). Nowhere in the Notice has the applicant been able to find any place where Opposers (again, presumably, each of them) alleges ***ever having sold any goods or services in commerce in the United States at all.***

For there to be confusion or deception or mistake of the type embraced by Section 2(d) the parties on the two sides of the proceeding need each to be selling something, and the things have to conflict in some way. Here, the trademark application being opposed identifies some ***six hundred and thirteen*** words of goods. (Opposers acknowledge at paragraph 6 that the application claims "a long list of goods in Classes 9, 16, 20, 25 and 28.) Not one of those words is mentioned by Opposers as being goods that the Opposers allege that they have sold in the US. Indeed conspicuous by its absence is any mention by Opposers of any use of any mark (this or any other) in commerce in the United States with any goods or services at all, let alone with any of the six hundred and thirteen words of goods set forth in the trademark application.

It goes without saying that given the lack of any pled allegation of any trademark use in the US by (either of) the Opposers, it is also the case that there is no pled allegation of a *priority of use* in the US. Thus any cause of action relying upon priority of use must fail as pled.

Applicant needs someone's authorization to use a name of a living individual? The Notice mentions at paragraph 7 an allegation that the applicant supposedly has no right to use "the name, likeness, image or personality of Gilles Villeneuve".

The mention of a concern about "the name, likeness, image or personality" of an individual brings to mind Section 2(c) of the Lanham Act (15 USC section 1052(c)) and prompts a guess that the claim upon which Opposers hope that relief could be granted might be a Section 2(c) claim.

But to work, a Section 2(c) claim requires that the individual be either "a deceased President of the United States during the life of his widow [sic]" (15 USC section 1052(c)) or that the individual be "living" (Id.). Applicant has scrutinized the Notice and is unable to find an allegation that the individual is a deceased President (and that the President's widow remains alive). Likewise applicant is unable to find an allegation that the individual is "living". Indeed applicant admits (Notice, paragraphs 1, 4 and 5) that the individual is deceased.

Thus it appears that no cause of action under Section 2(c) has been pled.

False suggestion of a connection? Nowhere in the Notice is there any allegation directed to Section 2(a) of the Lanham Act (e.g. false suggestion of a connection with dead persons). But the ESTTA cover sheet does mention Section 2(a) and refers to a "false suggestion of a connection". The ESTTA cover sheet is not part of the Notice, and a Notice that is defective with respect to Rule 12(b)(6) is not rendered non-defective by the content of the ESTTA cover sheet. Nonetheless, out of an abundance of caution, applicant points out that even if one were to attempt to find a Section 2(a) cause of action in the Notice, an essential element of that cause of action is missing from the Notice:

> A refusal on this basis requires, by implication, that the person ... with which a connection is falsely suggested must be the prior user. *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).) Nowhere in the Notice is there any allegation that the Opposers are "the prior user" as would be required for a successful pleading of such a Section 2(a) cause of action.

Other causes of action? In an effort to be thorough, Applicant has also considered each of the other statutory grounds for refusing registration (e.g. immoral subject matter, geographic indications, coats of arms, descriptiveness, surname) and has been unable to find any place in the Notice where such a ground was alluded to, let alone pled.

No standing has been shown. To show standing, the Opposers (and each of them) would have to set forth some valid ground for refusing registration, and *would then have to show some nexus to that*

ground. As discussed above, no valid ground for refusal to register has been pled, thus there is nothing to which to show a nexus. But more fundamentally, a would-be Opposer must allege (and plead facts to support an allegation) that the would-be opposer has standing by virtue of supposed "damage" that would flow from such a registration.

While a conclusory statement appears at paragraph 9, parroting the language of the statute (that "Opposers believe they will be damaged by the registration"), nowhere in the Notice do Opposers explain what the "damage" might be. In particular it should be understood that the constitutional authority of this Board stems from the Commerce Clause of the US Constitution, and thus that such damage, if any be feared, would have to be (pled to be) damage arising out of commerce which Congress may govern. Nowhere in the Notice, however, does either Opposer point to ***anything*** that she has done or is doing or plans to do in the United States, which would give rise to any risk of damage in the United States. Neither Opposer has pled anything at all that could or does give rise to any standing to seek a remedy from this Board.

The in rem *nature of the present proceeding.* Yet another perspective from which to view the absence of standing in the present case is to appreciate that the present proceeding is essentially an *in rem* action against a pending trademark application. The present proceeding is not, for example, an *in personam* proceeding against the applicant. There is no ancillary or pendant jurisdiction by which this forum can "pick up" other causes of action or other aspects of the relationships between the named parties. If there were some dispute between the named parties relating to events in (say) Canada (Notice, paragraph 1) or the Bahamas (Id. at paragraph 2) or "overseas" (Id. at paragraph 4), such dispute would have no business being aired in the present forum. The only question properly before this forum is whether a registration ought to be refused, and the only source of standing available to a would-be opposer in this type of proceeding is standing arising out of supposed "damage" connected with the prospect of such a registration.

The jurisdiction of this Board is limited to the trademark application *in rem* and if a named opposer is to establish standing, such standing must necessarily have some nexus to the trademark application itself. To show standing the opposer must allege damage from the grant of a US registration (TBMP section 303.03). Such damage is (by definition) limited to the United States. Someone who never sets

foot in the US, and never engages in commerce in the US which Congress may govern, is not damaged by a grant of a US registration. Such a person lacks standing before this forum.

Thus no standing has been shown, and the Opposition should be dismissed therefor.

It should be appreciated that even if Opposers, in response to this Motion, were to make out a supposedly sufficiently-pled ground for refusal to register (which for the reasons discussed above it appears they cannot), it would still be necessary to dismiss this Opposition due to lack of standing.

There are two would-be Opposers. So far as the applicant is able to discern, the pleading defects discussed above apply identically to each of the two would-be Opposers. Thus it appears that the Opposition should be dismissed as to ***each*** of the Opposers.

Conclusion. Wherefore Applicant prays that the Opposition be dismissed 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
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Certificate of Service

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

Robert M. O'Connell, Jr.
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this 27th day of February, 2008, by first-class mail.

/s/

Carl Oppedahl
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