

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Lykos

Mailed: September 20, 2008

Opposition No. 91181975

Joanna Villeneuve and Melanie
Villeneuve

v.

Goldstar Holdings Corp

Before Walters, Walsh and Ritchie de Larena, Administrative
Trademark Judges.

By the Board:

This case now comes up for consideration of
applicant's motion (filed February 27, 2008) to dismiss
the opposition under Fed. R. Civ. P. 12(b)(6).

Opposers have filed a brief in opposition thereto.

On January 16, 2008, opposers filed a notice of
opposition against applicant's application to register the
mark GILLES VILLENEUVE for a variety of items in
International Classes 9, 16, 20, 25, and 28.¹ Applicant
contends that opposers have failed to plead their standing
to bring this case because opposers did not identify any
past, present or future activities in the United States that

¹ Application Serial No. 79030057, filed December 14, 2005, A
pursuant to Section 66a. The application contains the statement
that "[t]he name(s), portrait(s), and/or signature(s) shown in
the mark does not identify a particular living individual."

would give rise to any purported "damage" from the registration of applicant's mark.² Applicant also contends that opposers have not properly pleaded any discernible claim under either Sections 2(d) or 2(a) of the Trademark Act. Opposers, however, maintain that they have the requisite standing, and have adequately pleaded claims under Sections 2(d) and 2(a).³

In order to withstand a motion to dismiss for failure to state a claim, a plaintiff need only allege such facts as would, if proved, establish that (1) the plaintiff has standing to maintain the proceedings, and (2) a valid ground exists for opposing the mark. The pleading must be examined in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(f), to determine whether it contains any allegations, which, if proved, would entitle plaintiff to the relief, sought. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213

² In the context of discussing the issue of standing, applicant has also challenged the Board's jurisdiction to entertain this matter on the grounds that opposers lack a connection with the United States. The Board does, however, have subject matter in this case by virtue of Trademark Act Section 13.

³ Opposers do not contend that they have asserted a claim under Section 2(c) of the Trademark Act. Nonetheless we agree with applicant's contention that Section 2(c) does not afford a basis for a claim for opposers since this provision only applies to marks identifying either a living individual or a deceased President of the United States during the life of his or her widow.

USPQ 185 (CCPA 1982); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460 (TTAB 1992); and TBMP § 503.02 (2d ed. rev. 2004). Moreover, to establish standing, it must be shown that a plaintiff has a "real interest" in the outcome of a proceeding; that is, plaintiff must have a direct and personal stake in the outcome of the proceeding and must have a "'reasonable' basis for its belief of damage." *See Ritchie v. Simpson*, 50 USPQ2d 1023 (Fed. Cir. 1999).

After careful consideration of the arguments of both parties, and a review of the pleading, the Board is of the opinion that opposers have adequately pleaded their standing. Opposers have alleged in their complaint that they are the heirs and beneficiaries to the estate of Mr. Gilles Villeneuve and own trademark rights in his name. Paragraph No. 3, Notice of Opposition. It is well established that the heirs of the person whose name comprises in whole or in part the mark contained in an application has standing to bring an opposition proceeding. *See Association Pour La Defense et la Promotion de L'Oeuvre de Marc Chagall dite Comite March Chagall v. Bondarchuk*, 82 UPPQ2d 1838 (TTAB 2007). As such, opposers have pleaded the requisite standing to challenge applicant's registration of Mr. Villeneuve's name.

However, we find that opposers have failed to state proper 2(d) and 2(a) claims.

In order to properly state a claim of likelihood of confusion under Section 2(d), opposers must plead that (1) applicant's mark, as applied to its goods or services, so resembles opposer's mark as to be likely to cause confusion, mistake, or deception; and (2) priority of use. See Fed. R. Civ. P. 8; *see also, King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

After a careful review of the notice of opposition, we find that opposers have clearly failed to allege facts which sufficiently plead a Section 2(d) claim. Specifically, opposers have failed to allege prior rights in a mark similar to applicant's mark for the same or similar goods or services. The notice of opposition is completely devoid of allegations regarding opposers date of use of its asserted GILLES VILLENEUVE mark or the goods or services used in connection therewith. See *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). Instead the complaint merely alleges that that opposers as "the heirs and beneficiaries of the estate of Gilles Villeneuve" own all trademark rights in his name, and that "Gilles Villeneuve was a highly successful and world famous Formula One race car driver who won numerous races in the United States, Canada and overseas from 1975 until his death

in a racing accident in 1972." Paragraph Nos. 3 and 4, Notice of Opposition. Allegations concerning Mr. Gilles Villeneuve's fame and the dates of his career as a race car driver are not synonymous with allegations regarding use of the mark GILLES VILLENEUVE in connection with goods or services in U.S. interstate commerce.

In addition, we find that opposers have failed to allege facts to properly plead a claim of false suggestion of a connection with applicant under Section 2(a) of the Trademark Act. To state a claim of false suggestion of a connection under Section 2(a), opposers must allege facts from which it may be inferred that (1) applicant's mark is the same as, or a close approximation of, opposers' previously used name or identity; (2) the mark would be recognized as such, in that it points uniquely and unmistakably to the identity or persona of opposers; (3) opposer is not connected with the activities of applicant under the mark; and (4) 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). Also, a properly pleaded claim of false suggestion of a connection clearly must assert either

opposer's prior use of applicant's mark, or the equivalent thereof, as a designation of its identity or "persona", or an association of the same with the plaintiff 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).

According to opposers in their response brief, the portions of the notice of opposition that set forth this "claim" of false association are in Paragraph Nos. 4, 5, 7 and 8. However, opposers also rely on Paragraph Nos. 7 and 8 as setting forth a proper pleading of likelihood of confusion under Section 2(d). Paragraph Nos. 4 and 5, standing alone, do not allege all the requisite elements of a Section 2(a) claim. To plead false association properly under Section 2(a), opposers must do more than rely on the

same pleaded language for a Section 2(d) claim.⁴

The Board freely grants leave to amend pleadings found, upon challenge under Fed. R. Civ. P. 12(b)(6), to be insufficient, particularly where the challenged pleading is the initial pleading. In view thereof, opposers are allowed until twenty (20) days from the mailing date of this order to file an amended pleading stating a proper claim of false suggestion of a connection under Section 2(a) and/or a proper claim under Section 2(d) of the Trademark Act, failing which, the opposition will be dismissed.

The case otherwise remains suspended.

NEWS FROM THE TTAB:

⁴ Although not argued by opposers, the allegations contained in Paragraph No. 7 of the notice of opposition that "the statements in the declaration submitted by Applicant in connection with this application -- that Applicant is entitled to use the mark in U.S. commerce and that no other person, firm, corporation, association or other legal entity has the right to use the mark in commerce -- were false" suggest an attempt to assert a claim of fraud. See e.g., *Medinol Ltd. v. Neuro Vasx Inc.*, 67 USPQ2d 1205 (TTAB 2003); *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917 (TTAB 2006) (fraud in procuring or maintaining a trademark registration occurs when an applicant for registration or a registrant in a declaration of use or renewal application knowingly makes false, material representations of fact in connection with an application to register or post registration document). As currently pleaded, any purported claim of fraud would fail, however, insofar as opposers did not allege particular facts sufficient to establish that applicant knowingly made false statements when filing its application. See Fed. R. Civ. P. 9(b).

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>