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

Proceeding	91217708
Party	Defendant da Vinci Kunstlerpinsidefabrik Defet GMBH
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Submission	Motion to Dismiss - Rule 12(b)
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Date	09/15/2014
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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J.B. Marketing International, Inc.	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91217708
	)	
da Vinci Kunstlerpinsidefabrik Defet	)	Ser. No. 77/555,704
GMBH	)	Mark: DA VINCI (Stylized)
	)	
Applicant.	)	
	)	

**APPLICANT’S MOTION TO DISMISS FOR FAILURE TO  
STATE A CLAIM UNDER FED R. CIV. P. 12(b)(6); IN THE ALTERNATIVE, MOTION  
FOR MORE DEFINITE STATEMENT**

In response to the Notice of Opposition filed by J.B. Marketing International, Inc. (“Opposer”) on August 6, 2014 (the “ Notice”) against application serial number 77/555,704 (the “Application”) for the mark DA VINCI (stylized) (“Applicant’s Mark”), Applicant da Vinci Kunstlerpinsidefabrik Defet GMBH (“Applicant”), by and through its undersigned counsel and in accordance with the Trademark Rules of Practice and the Federal Rules of Civil Procedure, hereby respectfully moves the Board to dismiss the Notice for failure to state a claim, pursuant to TBMP Rule 503 and Fed. R. Civ. P. 12(b)(6). In the alternative, Applicant requests that Opposer be ordered to provide a more definite statement of the allegations on which it bases its opposition.

**I. Background and Factual Allegations**

The Application seeks registration of Applicant’s Stylized Mark, as follows:

*da Vinci*

The goods identified in the Application are “cosmetic and shaving brushes” in International Class 21. In the Application, Applicant claimed ownership of two incontestable registrations, i.e., Reg. No. 1,770,018; for DA VINCI for use with “artists’ brushes”, which issued on May 11, 1993, based on use in commerce since 1987, and Reg. No. 1,852,360 for the mark LEONARDO DA VINCI for “artists’ brushes”, which issued on September 6, 1994, also based on use in commerce since 1987.

When Applicant filed the Application on August 26, 2008, its filing basis was Section 1(b) of the Trademark Act. It thereafter filed an Amendment to Allege Use on January 16, 2014, correctly indicating that the mark had been in use with the applied-for goods in US commerce since 1988. The Amendment to Allege Use was accepted by the Trademark Office. The mark was then published for opposition.

Opposer filed a Notice of Opposition against the Application. In its Notice, Opposer asserts one count for Fraud and one count for Likelihood of Confusion. The allegations in the Notice of Opposition are so conclusory, speculative and minimal as to be an insufficient legal basis to sustain an Opposition. Accordingly, the Opposition should be dismissed under Rule 12(b)(6).

## **II. Applicable Standard of Review**

To survive Applicant’s Motion to Dismiss for Failure to State a Claim under Fed. R. Civ. P. 12(b)(6), Opposer’s complaint must allege facts which would, if proved, establish that: (1) Opposer has standing to maintain the proceeding; and (2) there is a valid ground for refusing registration of the Application. *See Young v. AGB Corp.*, 152 F.3d 1377, 1378 (Fed. Cir. 1998); TBMP § 503.02 (3d ed. 2011). With respect to standing, Opposer must allege facts which, if ultimately proven, would establish that Opposer has a “real interest,” i.e., a “personal stake,” in the proceeding. *Ritchie v. Simpson*, 170 F.3d 1092, 1095-96 (Fed. Cir. 1999); *Lipton Industries*,

*Inc. v. Ralston Purina Co.*, 213 U.S.P.Q. 185, 189 (C.C.P.A. 1982). Opposer’s allegations that it would be damaged by the Registration “must have a ‘reasonable basis in fact.’” *Ritchie*, 170 F.3d at 1098 (quoting *Universal Oil Prod. Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 1124 (C.C.P.A. 1972)).

To show a valid basis for opposing registration, the opposition also “must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). See also *Doyle v. Al John’s Swedish Restaurant & Butik Inc.*, 101 U.S.P.Q.2d 1780, 1783 (T.T.A.B. 2012) (dismissing petition to cancel based on deficient factual pleadings). “Determining whether a complaint states a plausible claim for relief is a context-specific task that requires the reviewing court to draw on its judicial experience and common sense.” *Ashcraft*, 556 U.S. at 679. “While the court assumes that the facts in a complaint are true, it is not required to indulge in unwarranted inferences in order to save a complaint from dismissal.” *Juniper Networks Inc. v. Shipley*, 98 U.S.P.Q.2d 1491, 1493-94 (Fed. Cir. 2011) (quoting *Metzler Inv. GmbH v. Corinthian Colls., Inc.*, 540 F.3d 1049, 1064-65 (9th Cir. 2008). Furthermore, because notice pleading requirements are designed to give a defendant a fair idea of the plaintiff’s complaint and the legal basis for recovery, bald conclusory allegations, unsupported by factual averments, are insufficient to state a valid claim for relief. *McConnell Douglas Corp. v. National Data Corporation*, 228 U.S.P.Q. 45, 47 (T.T.A.B. 1985) (granting motion to dismiss).

### **III. Opposer Has Failed to Allege a Valid Claim Based on Fraud**

Federal Rule 9(b) provides that “[i]n alleging fraud or mistake, a party must state with particularity the circumstances constituting fraud or mistake.” Fed R. Civ. P. 9(b). According to one court addressing the rule’s requirements in the context of a challenge to a registration:

Rule 9(b) has four purposes: (1) to ensure that the defendant has sufficient information to formulate a defense by putting it on notice of the conduct complained of; (2) to protect defendants from frivolous suits; (3) to eliminate fraud actions where all facts are learned after discovery, and (4) to protect defendants from harm to their goodwill and reputation.

*ZAO Odessky Konjatschnyi Zawood v. SIA "Baltmark Invest,"* 109 U.S.P.Q.2d 1680, 1683-84 (E.D. Va. 2013). The reasons articulated above for enforcing Rule 9(b) are particularly appropriate here, as the Opposer has alleged a plainly baseless fraud claim with the apparent purpose of trying to harm Applicant's goodwill and reputation and to force defendant to have to engage in burdensome discovery to defend its right to register Applicant's Mark.

To prove fraud on the USPTO the following four elements must be shown:

- (1) applicant/registrant made a false representation to the USPTO;
- (2) the false representation is material to the registrability of a mark;
- (3) applicant/registrant had knowledge of the falsity of the representation; and
- (4) applicant/registrant made the representation with intent to deceive the USPTO.

*ShutEmDown Sports Inc. v. Lacy*, 102 U.S.P.Q.2d 1036, 1044 (T.T.A.B. 2012). See also *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938,1941 (Fed. Cir. 2009).

In *In re Bose Corp.*, 580 F.3d 1240, 1244-45 (Fed. Cir. 2009) the Federal Circuit stated that "an allegation of fraud in a trademark case, as in any other case, should not be taken lightly. Thus, we hold that a trademark [registration] is obtained fraudulently under the Lanham Act **only if the applicant or registrant knowingly makes a false, material representation with the intent to deceive the PTO.** (highlighting added). The Federal Circuit further held in *Bose*:

"Subjective intent to deceive, however difficult it may be to prove, is an indispensable element in the analysis. Of course, "because direct evidence of deceptive intent is rarely available, such intent can be inferred from indirect and circumstantial evidence. But such evidence must still be clear and convincing, and inferences drawn from lesser evidence cannot satisfy the deceptive intent requirement."

580 F.3d 1240, 1244-45.

The allegations made in the Notice are insufficient as a matter of law, under *Bose*, to support a fraud claim. Even assuming Opposer has alleged, and could prove, that Applicant made a false statement (elements (1), above) -- which Applicant denies -- Opposer has not, as a matter of law alleged the necessary scienter (element (3) and (4), above) to establish a fraud claim.

In essence, Opposer's entire fraud claim devolves to mere speculation that Applicant intentionally submitted a first use date that was false, because, when Opposer filed an Amendment to Allege Use, it claimed first use of the mark on a date that predated the filing date of the application, with the intention of deceiving the Trademark Office. However, speculation and conclusory statements are not enough to satisfy fraud pleading standards. Fed. R. Civ. P. 9(b). *See King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801 (CCPA 1981) (“[t]he pleadings [must] contain explicit rather than implied expressions of the circumstances constituting fraud”). That is, the time, place and contents of the false representations, the facts misrepresented, and identification of what has been obtained, shall be stated with specificity. *See Saks, Inc. v. Saks & Co.*, 141 USPQ 307 (TTAB 1964). Further, the allegations that any false statements were made intentionally to deceive are so lacking in substance and explanation that they cannot, as a matter of law, constitute the level of particularity required when allegations of fraud are made.

Further, Opposer has not alleged element (2), that is, the alleged false statement was **material** to the registrability of the mark. And even if Opposer had alleged materiality, as a matter of law, the alleged false statement would not be considered material as a matter of law to substantiate a fraud claim. *See Lewis v. Microsoft Corp.*, 410 F. Supp. 2d 432, 438-439 (E.D.N.C. 2006) (“an incorrect statement of the date of first use is not material, and therefore not fraudulent, as long as the actual first use occurred prior to the application filing date.”). As the Board has explained in granting a motion to dismiss for failure to state a claim in a fraud case,

“the dates of first use alleged by an applicant in a use-based application or statement of use filed in an intent-to-use application, even if false, do not constitute fraud, as long as there was technical trademark use on or before the filing date of the application or statement of use.” *Willis v. Can’t Stop Prods., Inc.*, No. 92051212, 2011 WL 4871875, at \*3 (T.T.A.B. Sept. 21, 2011) (nonprecedential); *see also Diak v. Crafts Americana Grp.*, 2013 WL 5946236, at \*7 (T.T.A.B. Oct. 22, 2013) (nonprecedential) (“[A]s long as the date of use asserted is prior to the filing date of the application, it does not affect the prosecution of the application.”); *Bio-One, Inc. v. A.L.E.G., Inc.*, No. 92052195, 2012 WL 893483, at \*2 (T.T.A.B. Mar. 7, 2012) (“Petitioner does not allege, nor has it proven, that respondent did not make use of its mark as of the filing date of the application in 2007. Thus, petitioner’s claim of fraud, even if the allegations were taken as true, does not state a ground of fraud because it fails to allege that the supposed false statement was material.”); *Slaska Wytwarznia Wodek Gatunkowtch “Polmos” SA v. Stawski Distrib. Co.*, No. 92044806, 2010 WL 3164751, at \*5 (T.T.A.B. July 26, 2010) (nonprecedential) (rejecting claim of fraud after trial on ground that “because petitioner has not challenged the fact that respondent used the registered mark prior to the filing date of the underlying application, petitioner’s claim of fraud based on an allegedly false date of first use is untenable”).

Based on the above law, it is clear that Opposer cannot succeed in a fraud claim, even if it had properly alleged with particularity all of the elements of fraud, as required. The claim therefore should be dismissed.

#### **IV. Opposed Has Failed to Allege a Valid Claim Based on Likelihood of Confusion**

In order to allege a claim under Section 2(d) of the Trademark Act, Opposer must plead and then prove priority of use. *Herbko International Inc. v. Kapa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002). The basis for priority must be alleged by facts, and not conclusory statements, as otherwise the Applicant is not put on fair notice of the claims. *See*

Fed. R. Civ. Pro. 8(e) (1) (“The elements of each claim should be stated concisely and directly, and include enough detail to give the defendant fair notice.”). See also *McConnell Douglas*, 228 U.S.P.Q. at 47 ([t]hese “bald allegations...neither give [applicant] fair notice of the basis for [opposer’s] claim nor set forth sufficient facts to establish the elements necessary for recovery, if proven.”); *Otto International Inc. v. Otto Kerm GmbH*, 83 U.S.P.Q.2d 1861,1863 (T.T.A.B. 2007) (finding pleading legally insufficient for failing to cite specific facts).

Here, the only allegation made is that “opposer is the senior user of DA VINCI in connection with cosmetic brushes in the United States.” Notice of Opp. ¶ 1. No allegation as to when Opposer’s alleged use began, nor any facts alleging that Opposer’s use of the mark has **been continuous** since prior to the time of Applicant’s priority date, have been made. Without such specificity, Applicant cannot know, for example, whether Opposer’s alleged first use date is prior to Applicant’s first use date in 1988, or if Opposer is alleging priority only based on the 2008 filing date of the Application. Opposer’s conclusory claim that it is the “senior user” does not put Applicant on fair notice of the basis of Opposer’s claimed seniority, and therefore is legally insufficient.

Because Opposer has failed to sufficiently allege the foundational facts necessary to establish a likelihood of confusion, its claim under 15 U.S.C. §1052(d) is legally deficient and must fail as a matter of law.<sup>1</sup>

**V. In the Alternative, Applicant’s Motion for a More Definite Statement Should Be Granted**

In the event the Board should find that the claim for likelihood of confusion made in the Notice is sufficient to withstand a Motion to Dismiss, Applicant respectfully requests that the Board grant Applicant’s Alternative Motion for a More Definite Statement. Fed. Rule Civ. Pro. 12(e). Given the vagueness of the allegations, Applicant cannot make a proper, responsive

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<sup>1</sup> Due to deficiencies in both of the alleged claims, Applicant also asserts that Opposer has not properly alleged standing.

pleading without further details of the Opposer's alleged basis for claiming it is the senior user of the DA VINCI mark.

**VI. Conclusion**

For the reasons stated above, Applicant respectfully requests that the Board grant this Motion and dismiss with prejudice the Notice for failure to state a claim.

DATED: September 15, 2014

Respectfully submitted,

/Margaret C. McHugh/

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Applicant.	)	
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**CERTIFICATE OF SERVICE**

A true and correct copy of the attached document has been served on counsel for Opposer via first class mail addressed as follows:

Tal Grinblat  
Lewitt, Hackman, Shapiro, Marshall & Harlan  
16633 Ventura Boulevard, 11th Floor  
Encino, CA 91436

Dated: September 15, 2014

/Margaret C. McHugh/  
Margaret C. McHugh  
Attorney for Applicant