

ESTTA Tracking number: **ESTTA630610**

Filing date: **10/02/2014**

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

Proceeding	91217708
Party	Plaintiff J.B. Marketing International, Inc.
Correspondence Address	TAL GRINBLAT LEWITT HACKMAN SHAPIRO MARSHALL & HARLAN 16633 VENTURA BLVD SUITE 1100 ENCINO, CA 91436 UNITED STATES tgrinblat@lewitthackman.com, nkanter@lewitthackman.com
Submission	Other Motions/Papers
Filer's Name	Nicholas Kanter
Filer's e-mail	nkanter@lewitthackman.com
Signature	/s/ Nicholas Kanter
Date	10/02/2014
Attachments	Opposition to Notice to Dismiss.pdf(26078 bytes )

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

In the matter of:	)	<b>Opposition No. 91217708</b>
	)	
J.B. MARKETING INTERNATIONAL, INC.,	)	<b>OPPOSITION TO APPLICANT'S MOTION TO DISMISS</b>
	)	
Opposer	)	
	)	
v.	)	
	)	
DA VINCI KUNSTLERPINSELFABRIK DEFET, GMBH	)	
	)	
Applicant	)	
_____	)	

**I. THE NOTICE OF OPPOSITION STATES A CLAIM FOR RELIEF BASED ON  
LIKELIHOOD OF CONFUSION**

“Federal Rule of Civil Procedure 8(a)(2) requires only a short and plain statement of the claim showing that the pleader is entitled to relief, in order to give the defendant fair notice of what the ... claim is and the grounds upon which it rests.” *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 545 (2007). Here, Opposer alleged a short and plain statement showing that it is entitled to relief under Section 2(d) of the Lanham Act: (1) Opposer is the senior user of the subject mark; and (2) there is a likelihood of confusion between the parties’ virtually identical marks. (Notice of Opposition ¶¶ 1, 12-16)<sup>1</sup>. While Applicant erroneously argues the Notice of Opposition is not detailed enough, Applicant clearly acknowledges knowing the Notice of Opposition is based on

---

<sup>1</sup> The “standing” requirement is met where the circumstances are such that it would be reasonable for a party to believe that there is a likelihood of confusion between the marks. *Anosh Tough v. Persona Parfum, Inc.* 95 U.S.P.Q. 1872 \*2 (T.T.A.B. 2010). Because Opposer alleges the marks are virtually identical and there is a likelihood of confusion between the marks, Opposer’s allegation satisfies the standing requirement.

likelihood of confusion. Accordingly, the likelihood of confusion claim meets the requirements of Fed. R. Civ. P. 8.

Applicant relies on *McDonnell Douglas Corp. v. National Data Corporation*, 228 U.S.P.Q. 45 (T.T.A.B. 1985) and *Otto Int'l Inc. v. Otto Kerm GmbH*, 83 U.S.P.Q.2d 1861 (T.T.A.B. 2007) to claim the Notice of Opposition is not detailed enough because it does not allege a first use date. These cases do not support Applicant's argument.

*McDonnell* did not involve a claim based on Section 2(d). Rather, the petitioner in *McDonnell* alleged claims for cancellation based on misrepresentation under section 14(c) and false suggestion of a connection under Section 2(a). *McDonnell* at \*2. *McDonnell* is inapplicable to the instant case. Similarly, *Otto Int'l* did not find the pleading failed to allege a 2(d) claim with sufficient detail. Instead, *Otto Int'l* held the 2(d) claim was time-barred under Section 14(3). *Otto Int'l* at \*2.

The likelihood of confusion claim meets the requirements of Fed. R. Civ. P. 8. Accordingly, the Motion to Dismiss based on Fed. R. Civ. P. 12(b)(6) and 12(e) should be denied as to the second claim for relief.

## **II. THE CLAIM FOR RELIEF BASED ON FRAUD**

Applicant agrees to withdraw its claim for fraud without prejudice.

## **III. LEAVE TO AMEND SHOULD BE GRANTED**

This tribunal follows the Federal Rules of Civil Procedure. In *Foman v. Davis*, 371 U.S. 18, 182 (1962), the Supreme Court reinforced the mandate under such rules that litigants be freely granted leave to amend their pleadings. The Court ruled:

[Fed. R. Civ. P. ] Rule 15(a) declares that **leave to amend 'shall be freely given** when justice so requires'; **this mandate is to be heeded...**If the underlying facts or circumstances relied upon by a plaintiff may be a proper subject of relief, he **ought to be afforded an opportunity to test his claim on the merits.** In the absence of any apparent or declared reason-such as undue delay, bad faith or dilatory motive on the part of the movant, repeated failure to cure deficiencies by amendments previously allowed,



**CERTIFICATE OF SERVICE**

It is hereby certified that on October 2, 2014, a copy of the foregoing OPPOSITION TO APPLICANT'S MOTION TO DISMISS has been sent by First Class, prepaid, United States Postal Service to Applicant's attorney of record, at the address below:

Margaret Mchugh, Esq.  
Kilpatrick Townsend & Stockton LLP  
Two Embarcadero Center, 8th Floor  
San Francisco, California 94111-3833

/s/ Nicholas Kanter  
Nicholas Kanter