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

Lykos

Mailed: November 24, 2004

Cancellation No. 92040583

Rickson Gracie, LLC

V.

Rorion Gracie d/b/a Gracie Jiu-Jitsu

Before Hohein, Hairston and Bottorff, Administrative Trademark Judges.

By the Board:

This case now comes up for consideration of respondent's motion (filed August 4, 2003)[1] to dismiss petitioner's amended petition for cancellation for failure to state a claim pursuant to Fed. R. Civ. P. 12(b)(6). The motion is fully briefed.[2]

Background

By way of relevant background, petitioner seeks to cancel the registration for the mark GRACIE JIU-JITSU ACADEMY for "school for instruction in the art of Jiu-Jitsu"

[1] The Board regrets the delay in acting on this motion.

[2] Respondent has submitted a reply brief which the Board has considered because it clarifies the issues herein. Consideration of a reply brief is discretionary on the part of the Board. *See* Trademark Rule 2.127(a).

in International Class 41.[3] In the original petition filed on February 11, 2002, the sole ground pleaded as the basis for cancellation was the allegation that respondent's mark is primarily merely a surname in violation of Section 2(e)(4) of the Trademark Act.

On June 20, 2003, the Board granted respondent's motion for judgment on the pleadings under Fed. R. Civ. P. 12(c), finding that while the original petition for cancellation set forth a sufficient pleading of petitioner's standing, it failed to include a proper statutory basis for cancellation because a registration that has been in existence for five years may not be challenged under Section 2(e)(4). Nonetheless, because petitioner had referred in its response brief to grounds which could be available under Section 14(3) (i.e., Section 2(a) false suggestion of a connection and misrepresentation of source), the Board allowed petitioner time to file an amended petition for cancellation setting forth at least one proper ground under Section 14(3), failing which the petition would be dismissed with prejudice.

On July 23, 2003, petitioner filed and served on respondent an amended petition for cancellation which

[3] Registration No. 1929719, issued on October 24, 1995, asserting January 2, 1990 as the date of first use anywhere and in commerce; Section 8 affidavit accepted; with a disclaimer of Jui-Jitsu Academy.

includes the following relevant allegations:

> 2. Petitioner is the owner of United States Trademark Registration No. 2,317,538 for the mark RICKSON & Design for teaching classes and seminars on jiu-jitsu in International Class 41.
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> 3. Petitioner is also the owner of United States Pending Trademark Application Serial Number 75/834187 for the mark RICKSON GRACIE for teaching classes and seminars on jiu-jitsu in International Class 41 and clothing, namely, T-shirts, shorts, sweatsuit and headwear, in International Class 25.[4]
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> 9. RICKSON GRACIE is not connected with any of the services sold by Rorion Gracie under its mark GRACIE JIU-JITSU ACADEMY.
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> 11. As internationally renowned and current World Jiu-Jitsu Champion, petitioner's name RICKSON GRACIE, LLC is clearly of sufficient fame that when Registrant's mark is used in connection with the school for instruction in jiu-jitsu, a connection with Petitioner would be presumed.
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> 12. The surname "GRACIE" in connection with the term "JIU-JITSU ACADEMY" points uniquely and unmistakably to Petitioner since Petitioner has adopted the name of its founder Rickson Gracie whose surname is "GRACIE" and who is the current World Jiu-Jitsu champion.
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> 14. The mark GRACIE JIU-JITSU ACADEMY falsely suggests a connection with Rickson Gracie and Petitioner, RICKSON GRACIE, LLC.

Respondent then moved to dismiss the amended petition for cancellation for failure to state a claim.

Respondent's Motion to Dismiss the Amended Petition

Turning now to respondent's motion to dismiss, respondent argues that the amended petition for cancellation

[4] This application was filed under Section 1(b). Petitioner has appealed the Examining Attorney's final refusal of its application. The Board suspended action on that appeal on July 19, 2002.

fails to state a claim of false suggestion of a connection under Sections 2(a) and 14(3) of the Lanham Act because respondent's mark GRACIE JIU JISTSU ACADEMY is not the same as or a close approximation of petitioner's marks RICKSON GRACIE, or RICKSON GRACIE, LLC; respondent's mark does not point uniquely and unmistakably to petitioner's pleaded marks; and petitioner failed to allege prior use of its marks.

In response, petitioner argues that while both petitioner and respondent are famous jiu-jitsu champions, petitioner is the more famous of the two; that consequently, respondent's mark points uniquely to petitioner; and that contrary to respondent's assertion, respondent's mark is indeed a close approximation of petitioner's mark. In response to respondent's assertion that petitioner failed to allege use prior use of its marks, petitioner has made the following allegation in its brief:

> Rickson Gracie alleges common law use of GRACIE JIU-JITSU ACADEMY and RICKSON GRACIE prior to Rorion Gracie's stated first use of January 2, 1990 of GRACIE JIU JITSU ACADEMY.

In reply, respondent asserts that a petition for cancellation may not be amended by brief in opposition to a motion to dismiss.

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 proceeding, 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 USPQ 185 (CCPA 1982); *Kelly Services Inc. v. Greene's Temporaries Inc.,* 25 USPQ2d 1460 (TTAB 1992); and TBMP § 503.02.

In order to properly state a claim of false suggestion of a connection under Section 2(a), petitioner must allege facts that set out the elements of such a claim, i.e., (1) the mark (or part of it) must be shown to be the same as or a close approximation of the person's previously used name or identity; (2) it must be established that the mark would be recognized as such (that is, the mark points uniquely to that person); (3) it must be shown that the person in question is not connected with the goods or services of the respondent, and (4) the person's name or identity must be of sufficient fame that when it is used as part or all of the mark on respondent's goods/services, a connection would be presumed by someone considering purchasing the goods/services. *See University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.,* 703 F.2d

1372, 217 USPQ 505 (Fed. Cir. 1983; *see also In re Sloppy Joe's International Inc.,* 43 USPQ2d 1350 (TTAB 1997); *Buffett v. Chi-Chi's, Inc.,* 226 USPQ 428 (TTAB 1985). The critical requirement in a Section 2(a) false suggestion of a connection case is that the name or identity embodied in a mark, and uniquely associated with a particular person or institution, be appropriated by another and used in a manner so as to indicate that the mark represents the name or identity of the plaintiff. *Notre Dame, supra.*

Based on a review of the amended pleading, we find that but for the lack of an allegation of prior use, petitioner has pleaded facts which, if proven, would establish the necessary elements of a claim of false suggestion of a connection under Section 2(a). Respondent's arguments contesting the accuracy of the allegations made in petitioner's amended pleading are misplaced. For purposes of determining a motion to dismiss for failure to state a claim, all of the plaintiff's well-pleaded allegations must be accepted as true. *See* TBMP § 503.02 and cases cited therein. Whether a plaintiff can actually prove its allegations is a matter to be determined not upon a motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence. *See id.*

The Board freely grants leave to amend pleadings found, upon challenge under Fed. R. Civ. P. 12(b)(6), to be insufficient. In this case, it appears that petitioner made a good faith effort to assert a proper claim of false suggestion under Section 2(a). In view thereof, petitioner is allowed until **twenty (20) days** from the mailing date of this order to file a second amended pleading which includes an allegation (as set forth in its brief) of prior common law rights in its name, failing which the cancellation will be dismissed with prejudice. Respondent is allowed until **twenty (20) days** from the date of service thereof to file an answer to the amended petition.

Proceedings herein are resumed and trial dates, including the close of discovery, are reset as follows:

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| THE PERIOD FOR DISCOVERY TO CLOSE: | February 10, 2005 |
| 30-day testimony period for party in position of plaintiff to close: | May 11, 2005 |
| 30-day testimony period for party in position of defendant to close: | July 10, 2005 |
| 15-day rebuttal testimony period for plaintiff to close: | August 24, 2005 |

In each instance, a transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b).

An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.