

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

In the matter of Registration Nos. 2,793,533, 2,634,215 and 2,735,848
Issued on December 16, 2003, October 12, 2002 and April 22, 2003, respectively

<p>GLENN DANZIG, Petitioner, v. CYCLOPIAN MUSIC, INC., Registrant.</p>	<p>Cancellation No. 92045173 76138226 Mark: MISFITS 76167459 76152924 Our File No.: 64162-0002</p>
--	--

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

CERTIFICATE OF MAILING

I hereby certify that this correspondence and the identified enclosures are being deposited with the U.S. Postal Service overnight Express Mail, postage prepaid, in an envelope addressed to: Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on January 18, 2006.

By: _____

Simone Robinson

OPPOSITION TO MOTION TO DISMISS

Petitioner Glenn Danzig (hereinafter "Petitioner") hereby files this Opposition to the Motion to Dismiss filed by Registrant Cyclopien Music, Inc. (hereinafter "Registrant").

INTRODUCTION

Registrant seeks to dismiss Petitioner's Petition for Cancellation ("Petition") on the grounds that Petitioner has failed to allege the elements of fraud or state a claim for lack of exclusive ownership. Neither of these purported grounds for dismissal has merit.

As to fraud, the Petition on its face contains factual allegations which, if proven, would establish that Registrant knowingly made false, material representations of fact in connection with its applications. In particular, Petitioner has alleged the time, place and content of the fraudulent statement, the fact misrepresented, and the benefit (i.e., registrations) obtained by



01-18-2006

Registrant as a consequence of the fraud. Petitioner has further alleged facts demonstrating his own rights in the **MISFITS** marks and Registrant's knowledge of these rights. These allegations, which, for purposes of a motion to dismiss, must be taken as true and must be viewed in the light most favorable to Petitioner, are more than sufficient to support Petitioner's claim of fraudulent registration.

The Petition also alleges sufficient facts to state a claim that Registrant is not the exclusive owner of the **MISFITS** marks. Petitioner has alleged a 1994 Settlement Agreement between the Petitioner and Messers. Gerard Caiafa and Paul Caiafa, who appear to be the principals of Registrant Cycloplan Music. The Settlement Agreement provides for Petitioner's co-ownership and use of the **MISFITS** marks with Messers. Gerard Caiafa and Paul Caiafa.¹ Such co-ownership, in and of itself, completely bars Registrant from claiming exclusive rights to use the **MISFITS** marks. Moreover, nothing in the Settlement Agreement prevents Petitioner from using the marks in connection with any but a small portion of the goods and services recited in the registrations at issue.

The Petition for Cancellation contains allegations sufficient to state claims for fraudulent registration and lack of exclusive rights. Accordingly, Registrant's Motion to Dismiss should be denied. However, in the event that the Board finds the allegations insufficient, leave to amend should be granted.

ARGUMENT

I. PETITIONER HAS PLED SUFFICIENT FACTS TO ALLEGE A CLAIM FOR FRAUDULENT REGISTRATION.

Registrant argues that, in order to plead fraud, Petitioner must allege the following: 1) the time, place and content of the false representation, 2) the fact misrepresented, and 3) what was

¹ An issue not yet raised in this action is whether Registrant Cycloplan Music, which, under the terms of the Settlement Agreement, had no ownership rights in the **MISFITS** marks, even had the right to apply for registrations of those marks. Petitioner notes that if discovery in the action reveals that Cycloplan Music owned no rights to the marks at issue at the time the applications for registration were filed, Petitioner intends to seek amendment of its Petition to seek cancellation on that ground as well.

obtained or given up as a consequence of the fraud. Each of these elements is included in the Petition.

Time, place and content. Petitioner alleged in the Petition for Cancellation that "[i]n the registrations that are the subject of this proceeding, Registrant has claimed ownership of the exclusive rights in the marks." (See Petition, ¶ 4) This statement, especially when read in the light most favorable to Petitioner, establishes both the place of the false representation (i.e., the underlying applications for registration) as well as the time (i.e., the time the applications for registration were filed). The content of the false representation is similarly established by Petitioner's allegations that "Registrant has claimed ownership of the exclusive rights in the marks the MISFITS and the MISFITS (Stylized) for the various goods and services set forth in those registrations" and "Registrant . . . falsely represented that it was the exclusive owner of the subject marks for the various goods and services contained therein." (Id. at ¶¶ 4, 5)

The fact misrepresented. The Petition for Cancellation clearly states that Registrant misrepresented "that it was the exclusive owner of the subject marks for the various goods and services contained [in the registrations]." (Id. at ¶ 5) The Petition also expressly states why Registrant's representation is false: because Petitioner is a co-owner of the marks. (Id. At ¶ 3)

What was obtained as a consequence of the fraud. The Petition expressly states that "the registrations that are the subject of this proceeding . . . were fraudulently obtained by Registrant" as a consequence of Registrant's false representations. (Id. at ¶ 5)

Accordingly, the Petition, on its face, alleges all the facts necessary to meet the elements of a claim of fraud in obtaining the subject registrations. On this basis, the Registrant's motion to dismiss should be denied.

As a separate argument, Registrant also claims that Petitioner has failed to allege the elements of fraudulent registration based on the existence of another legitimate use. This argument, however, is a red herring, as Petitioner is not seeking cancellation of Registrant's registrations based on Petitioner's, or any other person's, superior rights in the marks. Petitioner alleges that Registrant is not the exclusive owner of the MISFITS marks, as Petitioner is co-

owner of those marks. Petitioner alleges co-equal rights, not superior rights, and thus does not seek to state a claim for fraudulent registration based on the existence of another legitimate, and superior, use.

In short, the Petition alleges facts which, if proven, would establish that Registrant fraudulently obtained the registrations at issue through false claims that Registrant was the exclusive owner of the rights to those marks. Thus, Petitioner has stated a claim for fraudulent registration and Registrant's Motion to Dismiss should be denied.

II. PETITIONER HAS PLED SUFFICIENT FACTS TO STATE A CLAIM THAT REGISTRANT IS NOT THE EXCLUSIVE OWNER OF THE MARKS.

Registrant contends that Petitioner's claim fails because the Petition does not include allegations that the Settlement Agreement granted Petitioner the right to use the mark *for the goods and services* recited in the registrations. This argument is irrelevant, as the Settlement Agreement does not place any limits on co-ownership of the **MISFITS** marks in terms of particular goods and services. To the contrary, the Settlement Agreement grants Petitioner co-ownership "of the name and trademarks of the Misfits and all logo(s) and artwork . . . previously associated therewith," and makes no mention of any restrictions on that ownership in connection with any particular goods or services.²

Registrant also argues that Petitioner has neglected to allege that the marks in which Petitioner claims ownership are the same as the registered marks. Under the Federal Rules of Civil Procedure, "[t]he primary purpose of the pleadings . . . is to give fair notice of the claims or defenses asserted." Ohio State Univ. v. Ohio Univ., 51 U.S.P.Q.2d 1289, 1293 (T.T.A.B. 1999), citing McDonnell Douglas Corp. v. National Data Corp., 228 U.S.P.Q. 45 (T.T.A.B. 1985).

Even if the Petition does not contain an explicit allegation that the marks discussed in the

² The Settlement Agreement states that Messers. Gerard Caiafa and Paul Caiafa have the "exclusive right to publicly perform and record as the 'Misfits'." But this exclusive right is separate from, and has no impact on, the trademark co-ownership rights of Petitioner. Accordingly, it also has no bearing on the issue of whether Petitioner has properly stated his claim that Registrant is not the exclusive owner of the **MISFITS** marks.

Settlement Agreement are the same as those registered, Registrant is put on notice that Petitioner seeks cancellation of the registered marks based on Petitioner's co-ownership of these marks. Because this ownership right arises out of the Settlement Agreement, Registrant is on notice that Petitioner alleges that the marks registered are the same as those co-owned by Petitioner.

Registrant next argues that the Petition does not include allegations of use sufficient to allege ownership of the marks. While Registrant is correct in stating that trademark rights arise out of use, the parties here have reached a contractual agreement dividing ownership of marks, which ownership was itself created through joint use. Petitioner has a contractual right to co-ownership of the **MISFITS** marks, separate and apart from his rights arising from use of the marks. In any event, Petitioner has been using the **MISFITS** marks on t-shirts, apparel and other merchandise, which are included in the goods and services recited in the registrations. Accordingly, Petitioner's use in accordance with the parties' Settlement Agreement, as well as his rights under that contract, suffice to maintain Petitioner's rights in the **MISFITS** marks.

Finally, Registrant contends that, based on other terms in the Settlement Agreement, Petitioner will be unable to establish any ownership interest in the marks at issue. Registrant's argument is based on its quarrel with the facts as stated in the Petition for Cancellation. This contention, however, is outside the scope of the pleadings and is thus legally irrelevant in the context of a motion to dismiss. As acknowledged by Registrant in its Memorandum of Law, a motion to dismiss tests only the sufficiency of the allegations in a pleading. (See Registrant's Motion to Dismiss Memorandum of Law, p.2) In deciding the motion to dismiss, factual allegations in the petition are accepted as true and viewed in the light most favorable to the non-moving party. Intellimedia Sports, Inc. v. Intellimedia Corp., 43 U.S.P.Q.2d 1203, 1205 (T.T.A.B. 1997). For the purposes of deciding this Motion, the Board must accept Petitioner's allegation of co-ownership of the marks as true. Intellimedia, 43 U.S.P.Q.2d at 1205. Viewed in the light most favorable to Petitioner, the non-moving party, the allegations of Paragraph 3 of the Petition establish Petitioner's ownership interest in the marks. This allegation, if proven, would establish that Registrant is not the exclusive owner of the **MISFITS** marks.

However, even if the Board considers Registrant's contention that Petitioner is prohibited by the 1994 Settlement Agreement from using the **MISFITS** marks in connection with certain goods or services, this would not prevent Petitioner from claiming an ownership interest in the marks with respect to the classes of goods claimed by Registrant. Even if Petitioner were prohibited from publicly performing and recording as the Misfits for the past decade, this would not prevent Petitioner from using the mark in connection with, *inter alia*, prerecorded audio tapes and videotapes featuring musical performances recorded prior to 1994 (International Class 9), costume jewelry (International Class 14), musical group fan magazines (International Class 16), or rock music fan club services (International Class 41). These are the very types of goods as to which Registrant has obtained registrations, based on the false claim that it has exclusive rights to the marks in connection with those goods.

The Petition sufficiently alleges Petitioner's ownership interest in the **MISFITS** marks and Registrant's lack of exclusive ownership. Accordingly, Petitioner has stated a claim that Registrant is not the exclusive owner of the marks and Registrant's Motion to Dismiss should be denied.

///

///

///

///

///

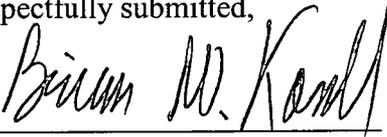
///

CONCLUSION

For all the foregoing reasons, Petitioner respectfully requests that the Board deny Registrant's Motion to Dismiss the Petition for Cancellation. However, in the event the Board does not find that Petitioner has alleged facts sufficient to state a claim, Petitioner respectfully requests that he be granted leave to amend the Petition.

Respectfully submitted,

Dated: January 18, 2006

By: 

Rod S. Berman
Brian W. Kasell
Zoey Kohn

JEFFER, MANGELS, BUTLER & MARMARO, LLP

1900 Avenue of the Stars, 7th Floor
Los Angeles, CA 90067

Tel: (310) 203-8080

Fax: (310) 203-0567

Attorneys for Petitioner, Glenn Danzig

CERTIFICATE OF SERVICE

It is hereby certified that on **January 18, 2006**, a copy of the foregoing **OPPOSITION TO MOTION TO DISMISS** has been sent by first class mail, postage prepared to the attorney of record for Registrant:

Curtis B. Krasik
Sabrina J. Hudson
KIRKPATRICK & LOCKHART NICHOLSON GRAHAM LLP
535 Smithfield Street
Pittsburg, Pennsylvania 15222
Telephone: (412) 355-6500
Facsimile: (412) 355-6501



Simone Robinson