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

Proceeding	92055800
Party	Defendant Susoix LLC
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Submission	Motion to Dismiss - Rule 12(b)
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Attachments	Motion to Dismiss City's Claims re Skateboarder Mark, Final.pdf (20 pages) (111594 bytes)

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

**City of New York, By And Through Its
Department of Parks & Recreation,**

Opposer,

v.

Cancellation No. 92055800

Susoix LLC,

Applicant.

Susoix’s Partial Motion to Dismiss

The City of New York, By and Through Its Department of Parks & Recreation, (the “City”) filed a Petition to Cancel (“Petition”) Susoix’s application for the mark Central Park Skateboarder Global Rolling (the “Skateboarder Mark”) (Serial No. 85255147). In total, the City alleges six claims for opposing registration of the Skateboarder Mark. *See* Petition, ¶¶ 26-61. At issue in this partial motion to dismiss are the City’s claims that (1) the Skateboarder Mark falsely suggests a connection with an institution under Section 2(a) of the Lanham Act, 11 U.S.C. § 1052(a); (2) Susoix made a fraudulent statement to the USPTO in the application for the Skateboarder Mark; (3) the Skateboarder Mark is geographically descriptive of Susoix’s online retail services; and (4) the personal coaching services are purely intrastate in nature. As explained in the accompanying memorandum of law, all four of these claims should be dismissed pursuant to Fed. R. Civ. P. 12(b)(6) for failure state a claim upon which relief can be granted.

Dated: 7/30/2012

Respectfully submitted,

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

**City of New York, By And Through Its
Department of Parks & Recreation,**

Opposer,

v.

Cancellation No. 92055800879

Susoix LLC,

Applicant.

**Susoix’s Memorandum
In Support Partial Motion to Dismiss**

The City of New York, By and Through Its Department of Parks & Recreation, (the “City”) filed a Petition to Cancel (“Petition”) Susoix’s application for the mark Central Park Skateboarder Global Rolling (the “Skateboarder Mark”) (Serial No. 85255147). Pursuant to Fed. R. Civ. Pro. 12(b)(6), Susoix, LLC moves to dismiss the following four claims for failure to state a claim upon which relief can be granted.

First, Susoix moves to dismiss the City’s claim that the Skateboarder Mark falsely suggests a connection with an institution – in this case, Central Park. *See* Petition, ¶¶ 27-28. Section 2(a) prohibits registration of marks that falsely suggest a connection with institutions. 15 U.S.C. § 1052(a). The Federal Circuit has defined the term “institution” as “[a]n established organization,” and defined “organization” as a “body of persons . . . formed for a common purpose.” *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1173 (Fed. Cir. 2009) (quoting Black’s Law Dictionary 813, 1133 (8th ed. 2004)). Central Park does not fit within the boundaries of this definition. According to the Petition, Central Park is a “tourist attraction,” “the first public park built in America” and “a well

known geographic location.” Petition, ¶¶ 1, 44. It is not an organization. It is not a body of persons formed for a common purpose. It is not an “institution” within the meaning of Section 2(a). Therefore, there is no basis for the City’s claim that the Skateboarder Mark falsely suggests a connection with an institution.

Second, the City alleges that Susoix made fraudulent statements to the USPTO in its application for the Skateboarder Mark. The City, however, fails to plead an essential element of a fraud claim – intent to deceive the USPTO. *See In re Bose Corp.*, 580 F.3d 1240, 1245 (Fed. Cir. 2009). This failure warrants dismissal. Equally problematic, the Petition fails to plead facts upon which a claim of fraud could be reasonably based. *See Asian and Western Classics B.V. v. Selkow*, 2009 WL 4081699, at * 1 (TTAB Oct. 22, 2009) (“Pleadings of fraud made ‘on information and belief,’ where there is no allegation of ‘specific facts upon which the belief is reasonably based’ is insufficient.”) (quotations omitted). This second failure further warrants dismissal of the fraud claim.

Third, there is no basis for the claim that the Skateboarder Mark is geographically descriptive of online wholesale and retail services. *See* Petition, ¶¶ 44-46. The Petition alleges that the services are provided online through a website. *See id.* at ¶ 21 (stating that services are registered in Class 41 for “*on-line* wholesale and retail services”) (emphasis added); Ex. B (providing specimens from www.centralparkskateboarder.com). Yet, the Petition does not allege that the primary significance of the Skateboarder Mark is the Internet. It thus cannot be said that the Skateboarder Mark is primarily geographically descriptive. *See* TMEP § 1210.01(a) (requiring that the goods or services originate in the place identified in the mark); *see also* TMEP §1210.03.

Finally, Susoix respectfully requests that this Board dismiss the City's claim that Susoix has failed to establish the element of interstate commerce because its personal coaching services are allegedly local in nature. *See* Petition, ¶¶ 60-61. As part of its Petition, the City has submitted specimens from Susoix's website, www.centralparkskateboarder.com. *See id.* at Ex. B. These exhibits demonstrate that the personal coaching services are advertised to customers online and across interstate lines, thereby satisfying the interstate commerce element of the Lanham Act. *See* TMEP § 901.03; *Futuristic Fences, Inc. v. Illusion Fences Corp.*, 558 F. Supp. 2d 1270, 1276-78 (S.D. Fla. 2008); *Cf. Shatel Corp. v. Mao Ta Lumber & Yacht Corp.*, 697 F.2d 1352, 1356 (11th Cir. 1983). Based on the allegations in the Petition, then, it cannot be said that the services are purely intrastate in nature.

I. Background

Susoix LLC is a small business dedicated to endurance sports that provide a sustainable means of transportation, namely, cycling, skateboarding, and longboarding. On March 1, 2011, Susoix filed an application with the United States Patent and Trademark Office ("USPTO") to register the Skateboarder Mark (Serial No. 85255147).¹ As described in the application, the literal element of the mark includes the phrase "Central Park Skateboarder Global Rolling." *See* Petition, Ex. B. The mark is also playfully designed so as to depict a skateboard "rolling" in a horizontal plane. That is, the mark is "skateboard shaped," has a curved nose and tail, lies in a horizontal plane,

¹ Given Susoix's focus on longboarding, it also filed an application to register the mark Central Park Longboarder Global Rolling (Serial No. 85393670) (hereinafter the "Longboarder Mark").

and even includes details such as the “screw holes for the trucks [where the wheels attach] on a typical skateboard deck.” *Id.*

Susoix registered the Skateboarder Mark in two services classes: (1) On-line wholesale and retail store services featuring products related to skateboarding, longboarding, cycling, and other endurance sports [IC 35], and (2) Personal coaching services in the field of skateboarding, longboarding, cycling, and other endurance sports [IC 41].

The Skateboarder Mark was published in the Official Gazette on June 21, 2011. No opposition was filed within thirty days of publication. *See* TMEP § 202.01. Instead, the City filed the instant Petition to Cancel the Skateboarder Mark. *See* Cancellation No. 92055800.²

The City’s Petition sets forth six grounds for cancellation. At issue in this partial motion to dismiss are the City’s claims that (1) the Skateboarder Mark falsely suggests a connection with an institution under Section 2(a) of the Lanham Act, 11 U.S.C. § 1052(a); (2) Susoix made a fraudulent statement to the USPTO in the application for the Skateboarder Mark; (3) the Skateboarder Mark is geographically descriptive of Susoix’s online retail services; and (4) the personal coaching services are purely intrastate in nature.³

Four days after the City filed its Petition, the Central Park Conservancy (the “Conservancy”) filed its own petition to cancel the Skateboarder Mark. *See* Cancellation

² The City has also filed a notice of opposition to the Longboarder Mark. *See* Opposition No. 91205879. The City raises the same six grounds as a basis for cancellation of the Longboarder Mark. Susoix has moved to dismiss four of those six claims. *Id.*

³ Susoix is not moving to dismiss the City’s claim that the Skateboarder Mark is geographically deceptively misdescriptive, a claim based on the notion that Central Park is a well-known geographic location.

No. 92055812. The Conservancy asserts three grounds for cancellation, including a claim that the Skateboarder Mark falsely suggests a connection with an institution, namely, the Conservancy.⁴ Notably, the Conservancy has not asserted a claim of fraud on the USPTO. Nor has the Conservancy argued that the Skateboarder Mark is geographically descriptive or that Susoix’s personal coaching services are purely intrastate in nature.

II. Standard of Review

A motion to dismiss invokes a form of legal triage, a paring of viable claims from those doomed by law. In this way, a Rule 12(b) motion to dismiss may be used to challenge the sufficiency of part of a pleading such as a single claim for relief. *See* Wright & Miller, Federal Practice and Procedure, Section 1358; *Drewett v. Aetna Cas. & Sur. Co.*, 405 F. Supp. 877, 878 (W.D. La. 1975). A Rule 12(b)(6) motion thus serves a useful purpose: “to allow the court to eliminate actions [or claims] that are fatally flawed in their legal premises and destined to fail, and thus spare litigants the burdens of unnecessary pretrial and trial activity.” *Advanced Cardiovascular Sys., Inc. v. Scimed Life Sys.*, 988 F.2d 1157, 1160 (Fed. Cir. 1993).

A motion to dismiss test the legal sufficiency of the Petition, not facts that support it. When considering and addressing a rule 12(b)(6) motion, the Board must accept as true all well-pleaded factual allegations, view those allegations in the light most favorable to the non-moving party, and draw all reasonable inferences in the opposer’s favor. *See Tellabs, Inc. v. Makor Issues & Rights, Ltd.*, 551 U.S. 308, 322 (2007). Yet, the Board is

⁴ The Conservancy’s principal claim appears to be that the Skateboarder Mark is geographically deceptively misdescriptive under section 2(e)(3), 15 U.S.C. § 1052(e)(3). This claim is based on the allegation that the words “Central Park” primarily refer to Central Park, a public park located in New York City.

“not bound to accept as true a legal conclusion couched as a factual allegation.” *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007).

To survive a motion to dismiss, the Petition must contain sufficient factual matter, accepted as true, to “state a claim to relief that is plausible on its face.” *Id.* at 570. “A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). Ultimately, only a petition that states a plausible claim for relief survives a motion to dismiss. *Id.* at 556. Determining whether the Petition in this case satisfies this standard is “a context-specific task that requires the reviewing court to draw on its judicial experience and common sense.” *Iqbal*, 556 U.S. at 679.

III. Discussion

A. Central Park is not an “Institution” within the meaning of Section 2(a)

Section 2(a) of the Lanham Act protects against marks that falsely suggest a connection with institutions. 15 U.S.C. § 1052(a).⁵ The threshold question here is whether Central Park is an “institution” within the meaning of Section 2(a). The Federal Circuit’s decision in *Shinnecock Smoke Shop, supra*, 571 F.3d at 1173, provides a useful analysis of the term “institution.”

To construe the term “institution,” the Federal Circuit first looked to the word’s plain meaning. *Id.* Citing Black’s Law Dictionary, the court defined the term “institution” as “[a]n established organization” and, in turn, defined “organization” as “a

⁵ This Board applies a four-part test to determine whether a mark falsely suggests a connection with an institution. See TMEP § 1203.03(e); *In re Peter S. Herrick, P.A.*, 91 USPQ2d 1505, 1507 (TTAB 2009).

body of persons . . . formed for a common purpose.” *Id.* (quoting *Black’s Law Dictionary*, 813, 133 (8th ed. 2004)).⁶ The Federal Circuit then proceeded to note that this dictionary definition tracks the Board’s prior precedents, *id.* (collecting cases), and is in line with the “Board’s general practice of construing the statute in question as broadly applicable.” *Id.*; *see also* TMEP § 1203.03(e); *In re. N. Am. Free Trade Assoc.*, 43 USPQ2d 1282, 1285 (TTAB 1997) (“the reference to an ‘institution’ in Section 2(a) was designed to have an expansive scope”). Based on this definition, the Federal Circuit concluded that the Shinnecock Indian Nation, a self-governing Indian tribe, fit within the definition of an institution under section 2(a). *Id.*

Indeed, it is difficult, if not impossible, to talk about an “institution” without mentioning the term “organization” and its respective members. *See, e.g., In re Urbano*, 51 USPQ2d 1776, 1779 (TTAB 1999) (“the entire *organization* which comprises the Olympic Games, as a whole, qualifies as an ‘institution’ within the meaning of Section 2(a) of the Trademark Act”) (emphasis added); *Hearings on H.R. 4744 Before the SubComm. on Trademarks of the House Comm. On Patents*, 76th Cong., 1st Sess., (1939) (discussing an “institution” in terms of “fraternal societies and organizations” like the New York Athletic Club);⁷ *In re White*, 73 USPQ.2d 1713, 2004 WL 2202268, at *5 (T.T.A.B. 2004) (“there is sufficient information to indicate that federally-recognized tribes are entities or juristic *persons*”) (emphasis added); *Frederick Gash, Inc. v. Mayo Clinic*, 461 F.2d 1395, 1399 (C.C.P.A. 1972) (treating the Mayo Clinic as an institution within the meaning of Section 2(a) because it is “a voluntary *association of individuals*

⁶ The Board may take judicial notice of dictionary definitions. *See Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852 (T.T.A.B. 1981).

⁷ The hearings before the subcommittee are attached as an Appendix to *University of Notre Dame v. J.C. Food Imports*, 703 F.2d 1372 (Fed. Cir. 1983).

engaged in the group practice of medicine in Rochester, Minnesota”) (emphasis added). The Board and courts have thus consistently equated an institution with an organization – that is, a body of persons organized for a common purpose.

Central Park is not, however, an “organization” let alone a “body of persons.” According to the Petition, Central Park is “one of the most popular and frequent tourist attractions in the world.” Petition, ¶1. It is also “a scenic landmark,” “the first public park built in America” and “has been designated as a National Historic Landmark.” *Id.* The allegations in the Petition thus emphasize one point and only one point: Central Park is “a well known geographic location.” *Id.* at ¶44. It thus cannot be said that Central Park is an organization, let alone a body of persons. It is not therefore an “institution” as that term has been consistently defined by this Board and the Federal Circuits.

Indeed, it would stretch the term “institution” beyond its boundaries to suggest that a geographic location is an institution. If that were the case, every landmark, public space, and tourist attraction would qualify as an institution. Such an expansive definition would arguably “prohibit[] the registration of nearly any word that anybody can think of” – precisely what the drafters of Section 2(a) *avoided* by selecting the specific term “institution.” *Norte Dame*, 703 F.2d at 1379 (quoting *Hearings on H.R. 4744 Before the SubComm. on Trademarks of the House Comm. On Patents*, 76th Cong., 1st Sess., (1939)). Indeed, while the Federal Circuit noted that the term “institution” is to be broadly construed, it then proceeded to provide the broadest definition of that term it could think of – the term’s dictionary definition. *See Shinnecock Smoke Shop*, 571 F.3d at 1173. That definition, the Federal Circuit explained, was broad enough to effectuate the purpose of Section 2(a). Extending the term to include geographic locations like

Central Park would run contrary to the Federal Circuit, this Board's precedent, and the clear intent of Section 2(a).

That said, the Central Park Conservancy may be an institution within the meaning of Section 2(a). It is an organization, a body of persons organized to preserve the park. *See* Petition, ¶10. Notably, however, the City does not allege that the Skateboarder Mark falsely suggests a connection with the Conservancy. The City omits such a claim wisely. First, the Petition clearly alleges that Central Park is the "institution" with which the Skateboarder Mark falsely suggests a connection. *Id.*, ¶27. The City cannot suddenly claim that the Conservancy, not the park, is actually the institution with which the Skateboarder Mark falsely suggests a connection. Understandably the Board looks down upon such attempts to save a claim. *See Internet Inc.*, 38 U.S.P.Q.2d 1435, 1996 WL 218762, at *2 n.6 (TTAB Jan. 4, 1996).

The City wisely omits a claim regarding the Conservancy for another reason: the Skateboarder Mark does not include the name of the Conservancy. *See Notre Dame*, 703 F.2d at 1377 ("the initial critical requirement is that the name (or an equivalent thereof) claimed to be appropriated by another must be unmistakably associated with a particular personality or persona"). Nor does the Skateboarder Mark contain a close approximation of the Conservancy's name. *See United States Olympic Committee v. Olymp-Herrenwaschefabriken Bezner GmbH & Co.*, 224 USPQ 497, 1984 TTAB Lexis 79 at *6, (TTAB 1984); *American Speech-Language-Hearing Association*, 224 USPQ 798 (TTAB 1984). It is thus highly questionable whether any connection between the Conservancy and the Skateboarder Mark could be alleged under Section 2(a). *See*

McDonnell Douglas Corp. v. Nat'l Data Corp., 228 USPQ 45, 1985 TTAB Lexis 144 at 13-14 (TTAB 1985).

The only basis for any such connection would be the fact that the Skateboarder Mark and the Central Park Conservancy share two words: Central Park. That similarity, however, has no bearing on whether there is a false connection under Section 2(a). As the Petition alleges, Central Park is a geographic location, not the protectable name of the Conservancy. *See* Petition, ¶44. It thus cannot be said that the Skateboarder r Mark uses the name of the Conservancy or an equivalent thereof such that the Skateboarder Mark would point “uniquely or unmistakably” to the Conservancy. This defeats any claim that the Skateboarder Mark suggests a false connection with the Conservancy. *See Notre Dame*, 703 F.3d at 1377 (emphasizing that a mark must point “uniquely” to the institution); TMEP § 1203.03(e).

Finally, the City lacks standing to raise a claim on behalf of the Conservancy, a separate organization. “[T]o raise a claim that a mark falsely suggests a connection with an institution under Section 2(a), the challenger must be the institution itself.” *Heroes, Inc. v. Boomer Esiason Hero’s Found., Inc.*, 1997 WL 335807 (D.D.C. June 6, 1997) amended, 1997 WL 350097 (D.D.C. June 16, 1997). Here, the Petition states that the Conservancy is its own not-for-profit corporation. Petition, ¶10. To the extent the Conservancy is an institution, then, it must bring its own section 2(a) claim.

The City is thus left to allege that the Skateboarder Mark falsely suggests a connection with Central Park. Central Park is not, however, an institution; thus, the claim must be dismissed for failure to state a claim upon which relief can be granted.

B. The City Fails to Allege Fraud on the USPTO

1. The City Fails To Allege Intent To Deceive the USPTO

Intent to deceive the USPTO is an essential element of a claim for fraud on the USPTO. As the Federal Circuit stated in *In re Bose*, “a trademark is obtained fraudulently under the Lanham Act *only if* the applicant or registrant knowingly makes a false, material representation *with intent to deceive the PTO.*” *In re Bose Corp., supra*, 580 F.3d at 1245 (emphasis added). The alleged deception must be willful to constitute fraud. *Id.* Merely pleading that a registrant “knew or should have known” a statement to the USPTO was false is insufficient to allege fraud on the USPTO. *Id.*; *see also* TBMP § 309.03(c), note 32.

Based on this standard, the Board has not hesitated to dismiss fraud claims that fail to allege a specific intent to deceive the USPTO. For example, the Board readily dismissed a claim of fraud where a petition to cancel alleged that the registrant “submitted false statements to the trademark office when registrant knew or should have known that the statements were false” *See Selkow, supra*, 2009 WL 4081699, at * 1 n.1. As the Board explained in that case, “intent is a specific element of a fraud claim and an allegation that a declarant ‘should have known’ a material statement was false does not make out a proper pleading.” *Id.* at * 2; *see also Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1287 (TTAB 2008).

Despite this well-established standard, the City’s Petition fails to allege any intent to deceive the USPTO. The Petition alleges a number of “false” statements on the part of Susoix. *See* Petition, ¶¶ 31, 35, 38. Yet, at no point does the Petition allege that these false representations were made “with intent to deceive the PTO” as required by *In re*

Bose, 580 F.3d at 1245. Due to the failure to plead this essential element, the fraud claim should be dismissed. *Selkow*, 2009 WL 4081699, at *3.

2. The Petition Fails to Even Allege a Reasonable Basis for a Fraud Claim

“Pleadings of fraud made ‘on information and belief,’ where there is no allegation of ‘specific facts upon which the belief is reasonably based’ is insufficient.” *See Selkow*, 2009 WL 4081699 at *1 (quoting *Exergen Corp. v. Wal-Mart Stores Inc.*, 91 USPQ2d 1656, 1670 (Fed. Cir. 2009)). Based “upon information and belief,” the City sets forth three allegedly false statements, none of which is sufficient to support a claim of fraud. *See* Petition, ¶¶ 30-42.

First, the City alleges that Susoix falsely stated that no other corporation had the right to use the Skateboarder Mark in commerce. *See* Petition, ¶31. According to the Petition, this statement was untrue because Susoix should have disclosed the City’s Central Park Mark to the USPTO. *Id.* at ¶33. However, “this Board has held that the failure of a party filing an application to disclose the existence of a prior registration to the USPTO is not fraud.” *Maids to Order of Ohio, Inc.*, 78 U.S.P.Q.2d 1899, 2006 WL 936993, at * 10 (TTAB Mar. 31, 2006); *see also William Grant & Sons, Inc. v. National Distillers and Chemical Corporation*, 173 USPQ 813 (TTAB 1972). As a matter of law, then, this alleged failure to disclose cannot be a basis for a claim of fraud.

As its second basis for fraud, the City repackages its claim that Susoix designed the Skateboarder Mark to falsely suggest a connection with an institution, namely, Central Park. *See* Petition, ¶ 35.⁸ This allegation, however, has no bearing on whether

⁸ This claim is premised on the notion that Susoix “knew that Central Park was an institution.” *Id.* at ¶ 34. As noted in Section A, *supra*, however, Central Park is not an institution within the meaning of Section 2(a) of the Lanham Act. There is therefore no

Susoix intended to deceive the USPTO. It is thus irrelevant to a claim of fraud on the USPTO.⁹ *See In re Bose*, 580 F.3d at 1243 (explaining that the relevant inquiry is whether the applicant had an “intent to deceive *the PTO*”) (emphasis added). Again then, the City has failed to allege a reasonable basis to support its claim of fraud on the USPTO.

Finally, the City alleges that Susoix “falsely and fraudulently” claimed that the Skateboarder Mark was used in commerce at least as early as March 1, 2011. *See* Petition, ¶38. According to the Petition, this statement was fraudulent because Susoix had “not rendered any meaningful services . . . as of the date of the application.” *Id.* at ¶ 40. There are, however, no facts supporting a belief of intent to deceive the USPTO. At best then, the City has merely alleged a claim of non-use. *See Grant Canyon West Ranch, LLC v. Hualapai Tribe*, 78 USPQ2d 1696, 2006 WL 802407, at * 2 (T.T.A.B. 2006) (noting the “obvious distinctions between a claim of fraud and a claim of nonuse of a mark for certain goods or services identified in the application” – namely, intent to deceive the USPTO).

Yet, the Petition fails to even state a claim of non-use. As the Federal Circuit carefully explained in *Aycock Engineering, Inc. v. Airflite, Inc.*, 560 F.3d 1350 (Fed. Cir. 2009), there are two requirements for use in commerce of a service mark: that the mark was (1) “used or displayed in the sale or advertising of services, and (2) “rendered in

false suggestion of connection with an institution, let alone a claim of fraud on the USPTO.

⁹ Even more odd, the City alleges that Susoix designed the Skateboarder Mark to “take advantage of Opposer’s goodwill and reputation.” Petition, ¶35. This allegation has nothing to do with a claim of fraudulent statement on the USPTO. It is thus unclear why the City has included these allegations, especially where there are no facts to support them.

interstate commerce or rendered in more than one state or in this and a foreign country by a person engaged in commerce.” *Id.* at 1358. Here, the Petition alleges that the Mark was not rendered in commerce because Susoix failed to “render any meaningful services.” Petition, ¶40. There is, however, no requirement that Susoix actually sell a skateboard through its online website or provide a coaching lesson. The crucial inquiry is whether Susoix “made an open and notorious public offering of the services to those for whom the services are intended.” *Id.* at 1358 (quotations omitted). This requirement has been met based on the allegations in the Petition. Specifically, Exhibit B of the Petition demonstrates that Susoix openly and notoriously offered its online retail and personal coaching services to customers on the world wide web. This is sufficient to satisfy the use in commerce requirement as set forth in *Airflite, Inc.*, thereby undermining any allegation of non-use, let alone fraud.

Ultimately, there is no basis for the City’s allegation of fraud on the USPTO. Not only does the Petition fail to allege intent to deceive, it does not even raise a possibility that Susoix intended to deceive the PTO. *See Smith Int’l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981) (“the very nature of the charge of fraud requires that it be proven ‘to the hilt’ with clear and convincing evidence. There is no room for speculation, inference, surmise and, obviously, any doubt must be resolved against the charging party”). Susoix thus respectfully requests that this Board dismiss the City’s fraud claim. *See Selkow*, 2009 WL 4081699 at * 1 (noting that Fed. R. Civ. P. 9(b)’s heightened pleading standards serve to weed out baseless claims, to prevent fishing expeditions and fraud actions in which all facts are learned after discovery, and to serve

the goals of Fed. R. Civ. P. 11) (citing Wright & Miller, Federal Practice & Procedure: 5A § 1296 n.11 (2004) (collecting cases)).

C. The Skateboarder Mark is Not Primarily Geographically Descriptive of Online Wholesale and Retail Services

Section 2(e)(2) permits a party to bring a claim alleging that a mark is primarily geographically descriptive. 15 U.S.C. § 1052(e)(2); *see also* TMEP §1210.01(a).

Section 2(e)(3), in turn, permits a party to bring a claim alleging that a mark is primarily geographically deceptively misdescriptive. 15 U.S.C. § 1052(e)(3); *see also* TMEP

§1210.01(b). Here, the City pleads both claims in the alternative. *See* Petition, ¶¶ 43-51.

Yet, there is no basis for the claim that the Skateboarder Mark is primarily geographically descriptive with respect to online wholesale and retail services.

To establish a prima facie case for refusal to register the Skateboarder Mark as primarily geographically descriptive, the City must show that:

- (1) the primary significance of the mark is a generally known geographic location (see TMEP §§1210.02–1210.02(b)(iv));
- (2) the goods or services originate in the place identified in the mark (see TMEP §1210.03); and
- (3) purchasers would be likely to believe that the goods or services originate in the geographic place identified in the mark (see TMEP §§1210.04–1210.04(d)).

TMEP §1210.01(a). The second element of a prima facie case thus requires a showing that the services originate in the place identified in the mark.

Here, the Petition correctly states that the Skateboarder Mark was registered in International Class 35 for online wholesale and retail store services. Petition, at ¶21. It goes without saying that these services are provided online. However, there is no allegation that the primary significance of the Skateboarder Mark is the Internet.

Accordingly, it cannot be said that the online wholesale and retail services originate in a place identified in the Skateboarder Mark. TMEP § 1210.01(a). The Petition thus fails to establish the second element of a section 2(e)(2) claim, thereby warranting dismissal as a matter of law.

D. The Personal Coaching Services Are Provided Online, and Thus in Interstate Commerce

Offering services via online websites clearly constitute use in interstate commerce for the purposes of the Lanham Act. Indeed, the TMEP provides the following black-letter rule regarding interstate commerce:

Offering services via the Internet has been held to constitute use in commerce, since the services are available to a national and international audience who must use interstate telephone lines to access a website.

TMEP § 901.03 (citing *Planned Parenthood Federation of America, Inc. v. Bucci*, 42 USPQ2d 1430 (S.D.N.Y. 1997), *aff'd*, 152 F.3d 920 (2d Cir. 1998) (Table), *cert. denied*, 525 U.S. 834 (1998)).

The pleadings in this case confirm that Susoix's personal coaching services are provided online and thus in interstate commerce. As an exhibit to its Petition, the City submitted a screenshot from www.centralparkskateboarder.com. *See* Petition, Exhibit B. The screenshot clearly depicts the personal coaching services being offered online; indeed, the website page provides online visitors with a telephone number for reserving private and/or group coaching lessons. *Id.* Based on the City's own exhibit, then, Susoix's personal coaching services were offered online via the internet; thus, they were undisputedly used in interstate commerce within the meaning of TMEP § 901.03.

Nonetheless, the Petition alleges that the personal coaching services are purely local in nature – an allegation that must be accepted as true for the purposes of a motion

to dismiss. *See Twombly, supra*, 550 U.S. at 572. Yet, it is actually irrelevant whether or not the personal coaching services are local in nature given that they were offered to customers via the internet. *See Futuristic Fences, Inc. v. Illusion Fences Corp.*, 558 F. Supp. 2d 1270, 1277 (advertising products “in electronic yellow page listings on the internet” satisfies the jurisdictional requirement of interstate commerce); *Susan’s Inc. v. Thomas*, 1993 WL 93333, at *4 (D. Kan. Mar. 19, 1993) (“even without any evidence that defendant has sold his products and services to a citizen of another state, he has caused his products and services to enter interstate commerce by advertising them in media forms that do cross state lines”); *C.f. Shatel Corp. v. Mao Ta Lumber & Yacht Corp.*, 697 F.2d 1352, 1356 (11th Cir. 1983) (“Advertising that affects interstate commerce and solicitation of sales across state lines . . . is therefore commerce within the meaning of the Lanham Act.”). Because the personal coaching services were advertised online, a media form that crosses state lines, the services entered interstate commerce. It thus cannot be said that the personal coaching services are purely intrastate in nature.

WHEREFORE, Susoix respectfully prays that the Board dismiss the City’s above identified claims pursuant to Fed. R. Civ. P. 12(b)(6).

Dated: 7/30/2012

Respectfully submitted,

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Certificate of Service

I hereby certify that a true and complete copy of the foregoing motion to dismiss and memorandum in support thereof has been served on the City by electronic transmission mutually agreed upon by the parties to:

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