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

Proceeding	92058893
Party	Plaintiff Mayweather Promotions, LLC
Correspondence Address	LAURI S THOMPSON GREENBERG TRAURIG LLP 3773 HOWARD HUGHES PARKWAY, SUITE 400N LAS VEGAS, NV 89169 UNITED STATES thompsonl@gtlaw.com, welshs@gtlaw.com, lvpto@gtlaw.com
Submission	Other Motions/Papers
Filer's Name	Peter H. Ajemian
Filer's e-mail	lvlitdock@gtlaw.com, thompsonl@gtlaw.com, neyc@gtlaw.com, ajemi-anp@gtlaw.com
Signature	/s/ Peter H. Ajemian
Date	08/22/2014
Attachments	Mayweathers Opposition.pdf(213513 bytes )

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

In the matter of trademark Registration No. 3565960  
For the mark MONEY POWER RESPECT ENTERTAINMENT in Class 35  
Date registered January 20, 2009.

Mayweather Promotions, LLC,

Petitioner,

v.

Branch, Cahleb, Jeremiah, LLC,

Registrant.

Cancellation No.: 92058893

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

**PETITIONER'S OPPOSITION TO REGISTRANT'S MOTION TO DISMISS  
PURSUANT TO FED. R. CIV. P. 12(b)(6) FOR FAILURE TO STATE A CLAIM**

Petitioner, Mayweather Promotions, LLC ("Mayweather" or "Petitioner"), by and through its counsel, the law firm of Greenberg Traurig, LLP, files its Opposition to Registrant Branch, Cahleb, Jeremiah, LLC's ("Branch" or "Registrant") Motion to Dismiss Pursuant to Fed. R. Civ. P. 12(b)(6) for failure to state a claim (the "Opposition"). This Opposition is made pursuant to the following memorandum of points and authorities, the pleadings and papers on file in this action, and any oral argument permitted by the Trademark Trial and Appeal Board ("TTAB").

Dated this 22<sup>nd</sup> day of August, 2014.

By: /s/ Peter H. Ajemian  
Peter H. Ajemian  
Lauri S. Thompson  
GREENBERG TRAURIG, LLP  
3773 Howard Hughes Parkway, Ste. 400N  
Las Vegas, Nevada 89169  
(702) 792-3773  
*Attorneys for Petitioner*

## MEMORANDUM OF POINTS AND AUTHORITIES

### I. INTRODUCTION

Registrant's Motion to Dismiss ("Motion") argues that Petitioner's has failed to state a claim upon which relief can be granted in seeking cancellation of Registrant's mark MONEY POWER RESPECT ENTERTAINMENT (U.S. Reg. No. 3565960) in Class 35. However, Registrant's Motion has no basis in law or fact and must be denied. Indeed, Registrant's factual assertions as well as its interpretation of the standard required to demonstrate the legal sufficiency of the complaint are incorrect. Further, Registrant has attached exhibits to its Motion, including a self-serving affidavit and other evidence that is irrelevant<sup>1</sup> at this stage in the proceeding and should not be considered by the Board in deciding the Motion<sup>2</sup>.

Petitioner's complaint has properly alleged facts that, if proved, clearly establish that Petitioner is entitled to the relief sought; specifically, that Petitioner has standing to maintain the proceeding, and multiple valid grounds exist for canceling the subject registration. As such, Petitioner has stated a claim to relief that is plausible on its face, and this case must proceed into the discovery phase to ensure that the parties have a full opportunity to develop and present their respective cases. Therefore, Registrant's Motion must be denied.

If, however, the Board finds that Petitioner did not properly allege facts to support the legal sufficiency of the complaint, Petitioner respectfully requests leave to amend. Because leave to amend should be freely given, this request should be granted, if necessary.

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<sup>1</sup> Pursuant to TBMP §704.05(a), "exhibits attached to a pleading are not evidence on behalf of the party to whose pleading they are attached unless they are thereafter, during the time for taking testimony, properly identified and introduced in evidence as exhibits." 37 C.F.R. § 2.122(c). Additionally, "[s]tatements made in pleadings cannot be considered as evidence on behalf of the party making them; such statements must be established by competent evidence during the time for taking testimony." TBMP §704.06(a).

<sup>2</sup> Registrant has also served its initial disclosures on Petitioner early in this case, likely in an attempt convince the Board to convert the Motion to Dismiss the Abandonment Claim into a Motion for Summary Judgment on the issue of abandonment. However, as set forth in TBMP § 503.04 it is rare for the Board to treat a motion to dismiss that relies on matters outside the pleadings as a motion for summary judgment, and Petitioner urges the Board not to consider the evidence prematurely submitted by Registrant, but rather "to examine the complaint in its entirety, construing the allegations therein so as to do justice, as required by Fed. R. Civ. P. 8(e), to determine whether it contains any allegations, which, if proved, would entitle the plaintiff to the relief sought." TBMP § 503.02.

## II. FACTUAL BACKGROUND

1. On or about January 10, 2006, Registrant filed an application to register the mark MONEY POWER RESPECT ENTERTAINMENT, and was assigned Application Serial No. 78788752. This application matured into Registration No. 3565960 (the “Registrant’s Mark”).

2. Registrant filed a statement of use, on or about November 25, 2008, claiming use in commerce of the mark MONEY POWER RESPECT ENTERTAINMENT for “management of performing artists and entertainers; advertising, marketing and promotion services; and online retail store services in the field of clothing,” incorporating a flyer advertising its services and a photograph of a t-shirt with the words MONEY POWER RESPECT ENTERTAINMENT on the front and a link to a Myspace page located at <[myspace.com/moneypowerrespectent.com](http://myspace.com/moneypowerrespectent.com)> on the back. This specimen was accepted by the USPTO, and the mark registered in Class 35 on January 20, 2009.

3. Petitioner filed an application under Trademark Act Section 1(a) for the mark MONEY POWER RESPECT on June 24, 2013, and was assigned Application Serial No. 85968214 in International Class 25 for “t-shirts and hats.”

4. Petitioner’s MONEY POWER RESPECT Application Serial No. 85968214 was refused registration in International Class 25 by the USPTO trademark examining attorney under Trademark Act Section 2(d), 15 U.S.C. §1052(d), as likely to be confused with Registrant’s MONEY POWER RESPECT ENTERTAINMENT Registration No. 3565960 in International Class 35.

5. Because Petitioner’s application for MONEY POWER RESPECT Serial No. 85968214 has been refused registration in International Class 25 due to Registrant’s MONEY POWER RESPECT ENTERTAINMENT Registration No. 3565960, Petitioner will be damaged by the continued registration of Registrant’s Mark in Class 35, and thus, has standing for this Cancellation.

6. Further, there was no actual use of Registrant’s Mark in commerce in the United States in connection with “online retail store services in the field of clothing” in Class 35 when

Registrant filed its Statement of Use, and Registrant's specimen filed with its Statement of Use is inadequate to support a registration for the mark for "online retail store services in the field of clothing" in Class 35.

7. There has been no legitimate use of the mark in commerce in connection with "online retail store services in the field of clothing" for more than three consecutive years prior to Petitioner's filing the instant Petition for Cancellation; therefore, Registrant's Mark has been abandoned due to nonuse.

8. Registrant has committed fraud on the USPTO by knowingly, with the intent to deceive the USPTO, making a material misrepresentation that it was using its mark in commerce in the United States on the all of the identified goods in Class 35 as of the time it filed its Statement of Use, when no such use on all the listed goods had been made. Specifically, Registrant only had use of its mark in connection with its management, advertising and promotion services and did not actually provide online retail sales of clothing under its mark at that the time Registrant filed its Statement of Use.

9. Therefore, Registrant knowingly, with the intent to deceive the USPTO, made a material misrepresentation that it was using its mark in United States commerce in connection with all the goods listed in its registration in Class 35 when it was not, and this willful misrepresentation enabled Registrant to obtain a federal registration for Registrant's Mark to which it was not entitled.

10. Petitioner, thus, has a reasonable and good faith belief that it will suffer damage by the continued registration of Registrant's Mark.

## **II. LEGAL ARGUMENT**

### **A. REGISTRANT'S MOTION SHOULD BE DENIED BECAUSE PETITIONER HAS STANDING TO MAINTAIN THE PROCEEDING AND VALID GROUNDS EXIST FOR CANCELLING REGISTRANT'S MARK.**

"A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint." *Advanced Cardiovascular Systems, Inc. v. SciMed Life Systems, Inc.*, 988 F.2d 1157, 26 U.S.P.Q.2d 1038, 1041 (Fed. Cir. 1993);

*Corporacion Habanos SA v. Rodriguez*, 99 U.S.P.Q.2d 1873, 1874 (TTAB 2011); Trademark Trial and Appeal Board Manual of Procedure (June 2014) (hereinafter, “TBMP”) at § 503.02. “In order to withstand such a motion, a complaint need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought (in the case of an opposition), or for canceling the subject registration (in the case of a cancellation proceeding).” TBMP § 503.02 (see *Young v. AGB Corp.* 152 F.3d 1377, 47 U.S.P.Q.2d 1752, 1754 (Fed. Cir. 1998); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 U.S.P.Q. 185 (CCPA 1982); *Rodriguez*, 99 U.S.P.Q.2d at 1874).

As set forth in TBMP § 503.02, “[t]o survive a motion to dismiss, a complaint must ‘state a claim to relief that is plausible on its face.’” *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007) (retiring the pleading standard set forth in *Conley v. Gibson*, 355 U.S. 41 (1957) that dismissal for failure to state a claim is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts that could be proved in support of its claim); see also *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S. Ct. 1937 (2009) (plausibility standard applies to all federal civil claims); *Doyle v. Al Johnson’s Swedish Restaurant & Butik Inc.*, 101 U.S.P.Q.2d 1780, 1782 (TTAB 2012); *Rodriguez*, 99 U.S.P.Q.2d at 1874. “Therefore, a plaintiff served with a motion to dismiss for failure to state a claim upon which relief can be granted need not, and should not respond by submitting proofs in support of its complaint. Whether a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence in support of their respective positions.” TBMP § 503.02 (see *Advanced Cardiovascular Systems, Inc.*, 988 F.2d 1157, 26 U.S.P.Q.2d at 1041).

Here, Petitioner has alleged facts on the face of the pleadings to demonstrate that it has standing and that will establish that Petitioner is entitled to the relief sought. Therefore, its Petition withstands Registrant’s Motion to Dismiss.

“In determining whether or not a litigant before the Board has stated a claim upon which relief can be granted, ‘we must assume that the facts alleged in the petition are true.’” *Young*, 47 U.S.P.Q.2d at 1754 (citing *Stanspec Co. v. American Chain & Cable Co.*, 531 F.2d 563, 566, 189 U.S.P.Q. 420, 422 (CCPA 1976) (petition for cancellation of a registered mark)). “Dismissal is appropriate ‘if it is clear that no relief could be granted under any set of facts that could be proved consistent with the allegations.’” *Young*, 47 U.S.P.Q.2d at 1754 (citing *Abbott Labs. v. Brennan*, 952 F.2d 1346, 1353, 21 U.S.P.Q.2d 1192, 1198 (Fed. Cir. 1991) (citations and internal quotations omitted)). As such, when ruling on a motion to dismiss for failure to state a claim, the Board must construe the petition to cancel in the light most favorable to the petitioner, and must also presume that the petitioner’s well-pleaded allegations are true. *See e.g., Petroleos Mexicanos v. Intermix S.A.*, 97 U.S.P.Q. 2d 1403 (TTAB. 2010); *see also Advanced Cardiovascular Sys., Inc. v. SciMed Life Syst., Inc.*, 988 F.2d 1157, 26 U.S.P.Q.2d 1038 (Fed. Cir. 1993).

Any person who believes it is or will be damaged by registration of a mark has standing to file a complaint. *See* TBMP § 503. At the pleading stage, all that is required is that a plaintiff allege facts sufficient to show a “real interest” in the proceeding, and a “reasonable basis” for its belief that it would suffer some kind of damage if the mark is registered. *Ritchie v. Simpson*, 170 F.3d 1092, 50 U.S.P.Q.2d 1023, 1025 (Fed. Cir. 1999). To plead a “real interest,” a plaintiff must allege a “direct and personal stake” in the outcome of the proceeding. *Id.*, 50 U.S.P.Q.2d at 1026. There is no requirement that actual damage be pleaded or proved, or that plaintiff show a personal interest in the proceeding different or “beyond that of the general public”, in order to establish standing or to prevail in an opposition or cancellation proceeding. *Id.*, 50 U.S.P.Q.2d at 1027 (“The crux of the matter is not how many others share one’s belief that one will be damaged by the registration, but whether that belief is reasonable and reflects a real interest in the issue.”); *see also* TBMP § 303.03.

Examples of a “real interest” in the proceeding and a “reasonable belief” of damage are where the petitioner has prior use of a confusingly similar mark, *see Hunt Control Systems Inc. v.*

*Koninklijke Philips Electronics N.V.*, 98 U.S.P.Q.2d 1558, 1565) (TTAB 2011), where petitioner has been refused registration of its mark because of defendant's registration, see *Saddlesprings Inc. v. Mad Croc Brands Inc.*, 104 U.S.P.Q.2d 1948, 1950 (TTAB 2012), or where petitioner has a bona fide intent to use the same mark for related goods, is about to file an intent-to-use application to register the mark, and believes registration of the mark will be refused in view of defendant's registration. See *American Vitamin Products Inc. v. Dow Brands Inc.*, 22 U.S.P.Q.2d 1313, 1314 (TTAB 1992).

Here, Petitioner has easily demonstrated that it has standing and that its Petition is legally sufficient on its face. Indeed, Petitioner has alleged facts showing that it has a real interest in the Cancellation proceeding and a reasonable basis for its belief of damage by alleging that its application for MONEY POWER RESPECT (Serial No. 85968214) has been refused registration in Class 25 based on a likelihood of confusion with Registrant's Mark. Further, Petitioner has alleged facts to show it has a direct stake in the outcome of the Cancellation because it intends to use its MONEY POWER RESPECT mark for clothing and to seek registration of its mark in Class 25. Given this, if Registrant is allowed to maintain its registration of the mark MONEY POWER RESPECT ENTERTAINMENT in Class 35, it will commercially harm Petitioner by limiting or preventing its rightful use and registration of its MONEY POWER RESPECT mark for clothing. Pleading facts that have shown that Petitioner's application has been refused in view of Registrant's mark, is a sufficient and clear basis for standing.

Further, valid grounds exist for canceling the subject registration. Petitioner has properly alleged facts supporting both its abandonment and fraud claims. Regarding its abandonment claim, a cancellation petitioner must merely allege facts that support its claim, setting forth a prima facie case of abandonment by pleading at least three consecutive years of non-use in order to survive a motion to dismiss. See *Otto Int'l, Inc. v. Otto Kern GmbH*, 83 U.S.P.Q.2d 1861 (T.T.A.B. 2007). Petitioner has met this standard in its Petition for Cancellation by clearly alleging facts that there was never any use of the Registrant's Mark for "online retail store services in the field of clothing" from the time the Registrant filed its Statement of Use in 2008,

and at least up until the time the instant Petition for Cancellation was filed in March 2014. In fact, while the Registrant's specimen of record may arguably support its identified services of "Management of performing artists and entertainers; Advertising, marketing and promotion services," it certainly does not support Registrant's alleged use of its mark in connection with "online retail store services in the field of clothing."

Additionally, Petitioner has alleged facts that at the time the Petition for Cancellation was filed, Registrant's website and online activities did not show any use of Registrant's Mark in connection with "online retail store services in the field of clothing," nor had there been any such use of Registrant's Mark from the time the Statement of Use was filed. Regardless of any changes that Registrant has made to its website and online activities after the instant Petition for Cancellation was filed<sup>3</sup>, the simple fact is that Registrant has not used its mark in connection with "online retail store services in the field of clothing" from 2009 until at least March of 2014, well over the three years of nonuse needed to support prima facie claim of abandonment. Petitioner has properly pleaded its claim of abandonment, and the facts set forth in the Petition for Cancellation, if proved, will result in the cancellation of the subject registration.

With regard to the fraud claim, Petitioner has pleaded this claim with particularity including specific allegations of the Registrant's intent to deceive the USPTO. *See DaimlerChrysler Corp. v. American Motors Corp.*, 94 U.S.P.Q.2d 1086 (TTAB 2010). Further, the Board has found fraud to be actionable in the willful filing of a false assertion concerning the use of the mark in commerce. *See Sinclair Oil Corp. v. Kendrick*, 85 U.S.P.Q.2d 1032 (TTAB 2007) (finding fraud in the procurement of a registration where the applicant could not have reasonably believed that a giveaway of 25 product samples was sufficient to constitute use in commerce); *see also Medinol Ltd. v. Neuro Vasx, Inc.*, 67 U.S.P.Q.2d 1205 (TTAB 2003) (finding fraud where respondent submitted admittedly erroneous statement of use).

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<sup>3</sup> While Petitioner maintains that Registrant's declaration and supporting evidence filed with its Motion are irrelevant at this stage in the proceeding and should not be considered by the Board, if the Board does consider these extraneous materials, it is important to note that Registrant admits to altering relevant portions of its website relating to its "online retail store services in the field of clothing" in May 2014, after the filing date of the instant Petition for Cancellation. See Decl. of Branch, ¶16.

Here, Petitioner has properly pleaded its fraud claim by alleging facts that the Registrant knowingly, with the intent to deceive the USPTO, made a material misrepresentation that it was using its mark in United States commerce in connection with all the goods listed in its registration in Class 35 when it was not, and this willful misrepresentation enabled Registrant to obtain a federal registration for Registrant's Mark to which it was not entitled. Again, the Registrant's specimen of record simply does not support any use of the Registrant's Mark in connection with "online retail store services in the field of clothing." Registrant could not have reasonably believed that its specimen supported this alleged use of the mark; therefore, at the time Registrant filed its Statement of Use, it willfully made a material misrepresentation to the USPTO with the intent to deceive. As such, Petitioner has alleged facts that, if proved, will show that the registration for Registrant's mark was obtained fraudulently and should be cancelled.

Registrant is attempting to dispose of this case in its very early stages without giving Petitioner a chance to meaningfully engage in discovery to develop the evidence supporting the proper factual allegations made in the Petition for Cancellation. Discovery in this case is necessary, especially with regard to taking the depositions of the Registrant's representatives to further develop the proof for Petitioner's claims. Therefore, Registrant's Motion should be denied.

**B. IN THE ALTERNATIVE, PETITIONER SHOULD BE ENTITLED TO AMEND ITS PETITION.**

If the Board finds the instant Petition to be defective, Petitioner respectfully requests that the Board grant it leave to amend its Petition, which is freely given when justice so requires. Pursuant to TBMP § 503.03, "[a] plaintiff may amend its complaint within 21 days after service of a motion under Fed. R. Civ. P. 12(b)(6) or with the written consent of every adverse party or by leave of the Board, which is freely given when justice so requires." *See* Fed. R. Civ. P. 15(a)(1)(B); *see also* TBMP § 507.02. "If no amended complaint is submitted in response to a motion to dismiss for failure to state a claim upon which relief can be granted and the Board

finds, upon determination of the motion, that the complaint fails to state a claim upon which relief can be granted, the Board generally will allow the plaintiff an opportunity to file an amended pleading.” *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 U.S.P.Q.2d 1203, 1208 (TTAB 1997) (allowed time to perfect fraud claim); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 U.S.P.Q.2d 1711, 1714 (TTAB 1993) (“the Board freely grants leave to amend pleadings found, upon challenge under Fed. R. Civ. P. 12(b)(6), to be insufficient, particularly where challenged pleading is the initial pleading”); and *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 U.S.P.Q. 154, 156 (TTAB 1985) (allowed time to file an amended opposition setting forth a statutory ground).

Here, Petitioner maintains that its Petition for Cancellation is sufficient on its face as properly showing standing and grounds; therefore, this case should go forward into the discovery phase to ensure that the parties have a full opportunity to present their respective cases. However, in the alternative, if the Board finds its Petition to be defective, Petitioner respectfully requests that the Board grant it leave to amend its Petition, which is freely given when justice so requires.

### **III. CONCLUSION**

Based on the foregoing, Petitioner respectfully requests that the Board deny Registrant’s Motion to Dismiss in its entirety.

Dated this 22<sup>nd</sup> day of August, 2014.

#### **GREENBERG TRAUIG, LLP**

By: /s/ Peter H. Ajemian  
Peter Ajemian, Esq.  
Lauri S. Thompson, Esq.  
3773 Howard Hughes Parkway  
Suite 400 North  
Las Vegas, Nevada 89169  
(702) 792-3773  
*Attorneys for Petitioner*

**CERTIFICATE OF SERVICE**

I hereby certify that on August 22, 2014, I served the foregoing **PETITIONER'S OPPOSITION TO REGISTRANT'S MOTION TO DISMISS PURSUANT TO FED. R. CIV. P. 12(b)(6) FOR FAILURE TO STATE A CLAIM** on:

FRANK G. LONG  
DICKINSON WRIGHT PLLC  
1850 N CENTRAL AVENUE, SUITE 1400  
PHOENIX, AZ 85004

by causing a full, true, and correct copy thereof to be sent by the following indicated method or methods, on the date set forth below:

**X** by mailing in a sealed, first-Class postage-prepaid envelope, addressed to the last-known office address of the attorney, and deposited with the United States Postal Service at Las Vegas, Nevada.

/s/ Cynthia Ney