

ESTTA Tracking number: **ESTTA777584**

Filing date: **10/18/2016**

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

Proceeding	92064185
Party	Defendant I. M. Wilson, Inc.
Correspondence Address	I M WILSON INC 241 KING MANOR DRIVE SUITE D KING OF PRUSSIA, PA 19406 UNITED STATES tmlitdocket@dbr.com, tore.debella@dbr.com, jennifer.dean@dbr.com, brian.coleman@dbr.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Tore T. DeBella
Filer's e-mail	tmlitdocket@dbr.com, tore.debella@dbr.com, brian.coleman@dbr.com, jennifer.dean@dbr.com
Signature	/tore t. debella/
Date	10/18/2016
Attachments	GRISHKO MTD.pdf(424228 bytes)

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

<u>NICOLAY GRISHKO,</u>	:	
Petitioner,	:	
v.	:	Cancellation No. 92-064,185
I.M. WILSON, INC.,	:	
<u> Respondent.</u>	:	

RESPONDENT’S MOTION TO DISMISS

I.M. Wilson, Inc. (“Respondent” and “IMW”), through its attorneys and pursuant to Fed. R. Civ. P. 12(b)(6), hereby requests that the Trademark Trial and Appeal Board (the “Board”) dismiss the Petition to Cancel filed by Nicolay Grishko (“Petitioner”) for failure to state a claim. In support thereof, Respondent states as follows.

INTRODUCTION

Petitioner’s Petition to Cancel is based on a legally nonexistent basis for cancelling a trademark registration. Petitioner posits that where a mark consists of or comprises the name of a particular living individual, and the registrant obtains, pursuant to Section 14(c) of the Lanham Act, the requisite “written consent” of that person, the resulting registration may be cancelled anytime thereafter, merely upon the living person’s announcement that it unilaterally “revokes” that consent. Specifically, Petitioner alleges that IMW applied for and obtained the registration of several GRISHKO trademarks, each time providing the Patent and Trademark Office (“PTO”) with the written consent of Petitioner (Nicolay Grishko, a living person), but that Mr. Grishko has now changed his mind – and wants these registrations cancelled on that basis alone.

No such basis for cancellation exists. Petitioner’s theory is foreclosed by the language of Section 14, which admits of no such exception. It is foreclosed by binding precedent, the reasoning

of which is incompatible with Petitioner's theory. It is wholly without support. Accordingly, the Petition to Cancel must be dismissed, as it does not state a claim on which relief may be granted.

BACKGROUND

The Petition to Cancel alleges that Respondent owns seven registrations that consist of or incorporate the GRISHKO mark for various goods and services, largely in the dancewear industry. *See* Pet. at p.2.¹ Of the seven registrations, which Petitioner identifies as the "Challenged Registrations," four are over five years old; the others were issued in 2013 (2) and 2015. *See id.*²

Petitioner alleges that he is a dual citizen of Russian and Macedonia, and "for nearly three (3) decades has enjoyed, worldwide fame (including in the United States) in the ballet and dancewear industry." *See* Pet. at ¶¶ 2-3. Petitioner further states that he operates certain companies, including Grishko, Inc., that sell "ballet products." *Id.* at ¶¶ 3, 10.

According to Petitioner, Grishko, Inc. entered into an agreement with Respondent in 1992 pursuant to which products branded with the GRISHKO mark would be sold. *Id.* at ¶ 11. Petitioner states Respondent sought registration of the GRISHKO mark in the United States, Application Ser. No. 74/299,660 (the "660 Application"), and as "part of the prosecution" of that application, Respondent "represented to Mr. Grishko that the U.S. Patent and Trademark Office required him to sign a document stating that he consented to [IMW] using his name in the trademark GRISHKO." Petitioner then admits: "On or around August 5, 1992, Mr. Grishko provided [IMW] with the document as requested." *Id.* at ¶ 12.

¹ According to the Petition, five of the registrations are standard character marks consisting of the GRISHKO work mark, see Reg. Nos. 4,303,496; 4,303,495; 3,915,742; 3,915,733; and 3,568, 809, one is stylized, see Reg. No. 3,915,946, and one consists of the characters 2007 GRISHKO, see Reg. Nos. 4,746,900.

² Section 8 and 15 affidavits were filed for these four registrations prior to the date of filing the Petition to Cancel.

Petitioner then states that IMW “subsequently submitted each of the applications to register each of the Challenged Registrations,”³ and for each “submitted the same documents that Mr. Grishko had earlier signed during the prosecution of the ‘660 Application.” *Id.* at ¶ 14. Petitioner states that this was “[u]nbeknownst to Mr. Grishko” but does not allege any fraud or intent to mislead. *Id.* Petitioner then alleges as follows:

15. On August 5, 2016, Mr. Grishko formally revoked any and all consent to I.M. Wilson, Inc.’s use and registration of the GRISHKO trademark, including, without limitation, each of the documents that I.M. Wilson, Inc. submitted during the prosecution of each of the applications underlying the Challenged Registrations.

16. The name Grishko in the Challenged Marks represents and identifies a particular living individual, namely Mr. Grishko. Having revoked consent, each of the Challenged Registrations is in violation of §2(c) of the Lanham Act (15 U.S.C. § 1052(c)) and in violation of the long-standing procedures and rules of the United States Patent and Trademark Office as Set forth in the Trademark Manual of Examining Procedure, Section 1206.

Id. at ¶¶ 15-16. Based on the foregoing, Petitioner alleges that he is “damaged” by the Challenged Registrations because “each creates a false perception that Mr. Grishko is currently affiliated with, sponsored by, or endorsed by I.M. Wilson, Inc. when that is no longer the case.” *Id.* at ¶ 17.

The ESTTA form accompanying the Petition to Cancel identifies no substantive statutory basis for cancellation of the Challenged Registrations besides Section 2(c).⁴

STANDARD OF REVIEW

The Board must dismiss a petition to cancel under Fed. Rule 12(b)(6) if it fails to state a claim that is “plausible on its face.” T.B.M.P. § 503.02, citing *Twombly*, 550 U.S. 544, 570 (2007); *see also Advanced Cardiovascular Sys Inc. v. SciMed Life Sys. Inc.*, 26 U.S.P.Q.2d 1038, 1041 (Fed.

³ Petitioner states that this took place after the registration resulting from the ‘660 Application, Reg. No. 1,807,637, was cancelled in 2004 for failure to file a declaration of continued use and renewal. *Id.* at ¶ 13.

⁴ The ESTTA form also identifies Section 14(1), which states only that a petition to cancel may be filed “[w]ithin five years from the date of the registration of the mark under this chapter.”

Cir. 1993). The purpose of Fed. Rule 12(b)(6) “is to allow the court to eliminate actions that are fatally flawed in their legal premises and destined to fail, and thus to spare litigants the burdens of unnecessary pretrial and trial activity.” *Advanced Cardiovascular Sys.*, 26 U.S.P.Q.2d at 1041, citing *Neitzke v. Williams*, 490 U.S. 319, 326-27 (1989). When ruling on a motion to dismiss, the Board must accept the factual allegations pleaded in the complaint as true, but “[c]onclusory allegations of law and unwarranted inferences of fact do not suffice to support a claim.” *Bradley v. Chiron Corp.*, 45 U.S.P.Q.2d 1819, 1822 (Fed. Cir. 1998).

ARGUMENT

The Petition to Cancel must be dismissed because even if Petitioner can prove the allegations in that Petition, cancellation is not warranted. That is, even if Petitioner can prove that (a) 24 years ago, he granted IMW consent to use his surname, Grishko, to obtain a U.S. trademark registration; (b) that the Challenged Registrations were obtained based on that consent; and (c) that on August 5, 2016, the date of filing its Petition to Cancel, Petitioner “formally revoked any and all consent,” that would not require cancellation of the Challenged Registrations.

To start with, Petitioner does not identify any provision of the Lanham Act that was violated.

Section 2 of the Lanham Act states in relevant part:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

.....

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

15 U.S.C. § 1052(c). Petitioner does not dispute that any of the Challenged Registrations were issued without the submission of the written consent of Mr. Grishko. While the Petition can be read

to suggest that Petitioner was unaware of which specific GRISHKO registrations were obtained by virtue of that written consent, he does not claim that such consent was not obtained and provided. Petitioner also does not allege any actionable fraud or malfeasance in connection with the prosecution and issuance of the Challenged Registration.

Petitioner's theory appears to be that consent – once “revoked” – invalidates the registrations that were issued on the basis of that consent. But no such statement can be found in Section 2 or elsewhere in the Lanham Act. To the contrary, Section 2(c) specifically discusses such “written consent” only in connection the initial refusal of an application for registration. Revocation of consent is not identified as a basis for cancellation of a registration in Section 14 of the Lanham Act, or anywhere else.

Petitioner makes reference in Paragraph 16 of its Petition to T.M.E.P. § 2106. However, that section makes no mention of cancellation of a registration based on a purported revocation of consent. That section does address the circumstances in which the written consent of a living person is needed, but again, there is no dispute that such consent was obtained.⁵ The Petition to Cancel is based solely on the alleged August 2016 revocation.

Further, Board precedent and other judicial decisions concerning Section 2(c) make clear that Petitioner's theory of cancellation does not hold water. There are several cases brought by the “living person” from whom consent was allegedly obtained seeking cancellation of the registration incorporating his or her name, but all such cases turn on whether the consent given at the time of

⁵ In fact, Section 2106 supports the use of Mr. Grishko's consent in the manner in which it is alleged to have been used here, on subsequent GRISHKO applications. See T.M.E.P. § 1206.04(c) (“An applicant does not have to submit a new consent if a consent to register is already part of the record in the file of a valid registration for a mark comprised in whole or in part of the same name, portrait, or signature for the same goods and/or services, or such goods and/or services as would encompass those in the subsequent application”), citing *In re McKee Baking Co.*, 218 USPQ 287, 288 (TTAB 1983). In any event, Petitioner does not challenge the initial grant of the Challenged Registrations.

issuance was valid, e.g. whether it extended only to use, or registration as well. None suggest that a present-day repudiation of a previously-given written consent is in any way relevant, much less dispositive. Indeed, were it possible to simply “formally revoke” consent, unilaterally, and then seek cancellation, this case law would be meaningless, and wrongly decided. Why would a “living person” challenge the validity of the original written consent, and why would the Board entertain such a discussion, if that living person’s present-day refusal to consent were sufficient by itself to permit voiding the registration? It would not. The Board has long recognized a registration cannot be cancelled simply because the living person no longer consents; rather, only if the original written consent was invalid is the registration subject to cancellation.

For example, in *In re D.B. Kaplan*, 225 USPQ 342 (TTAB 1985), Donald Kaplan sought cancellation of the mark D.B. KAPLAN'S DELICATESSEN – not because he no longer consented to registration, but because the original consent was invalid in his view. The Board noted that Mr. Kaplan had entered into a “buy out” agreement that specifically provided that the mark D.B. KAPLAN'S DELICATESSEN and any mark confusingly similar thereto was the property of D.B. Kaplan's Delicatessen, Inc., and held that the record supported a finding that Donald Kaplan consented to applicant’s use *and registration* of the mark D.B. KAPLAN'S DELICATESSEN. Citing the contractual terms, “[w]e think,” the Board stated, “that these provisions are beyond a mere consent to use situation and that a reasonable reading of this provision clearly implies that consent to applicant's registration of the mark was contemplated.” *Id.* at 344.

A contrary result was reached in *Krause v. Krause Publications, Inc.*, 76 U.S.P.Q.2D 1904 (TTAB. 2005), but again based only on the original registration. Chester L. Krause petitioned to cancel a registration issued to Krause Publications, Inc. for the mark KRAUSE PUBLICATIONS. Discussion centered on whether the original consent granted by Mr. Krause for use also extended to

consent to registration. There was no suggestion that Mr. Krause's *present* desire that his name no longer be included in a registration was in any way relevant or determinative. Ultimately, the Board found no implied consent in the *original* consent. 76 U.S.P.Q.2D at 1912-13; *see also In re O'Neill Beverage Co., Ltd.*, 2013 TTAB LEXIS 454 (unpublished).

Numerous federal court decisions are to the same effect, in limiting inquiry to whether the *original* written consent given was valid, effectively foreclosing any argument that present-day lack of consent is material in any way. *See, e.g., Zuppardi's Apizza, Inc. v. Tony Zuppardi's Apizza, LLC*, 2014 U.S. Dist. LEXIS 136763 (D. Conn. Sept. 29, 2014); *Equibrand Corp. v. Reinsman Equestrian Products, Inc.*, 2007 U.S. Dist. LEXIS 36229 (N.D. Tex. May 17, 2007); *see also Gilbert/Robinson, Inc. v. Carrie Beverage-Missouri, Inc.*, 989 F.2d 985 (8th Cir. 1995).

While the plain language of Section 2(c) and its associated precedent is dispositive, it also bears mention that it makes good sense that a living person would not be permitted to invalidate a registration merely by changing his or her mind post-registration – here, 24 years after. Once consent is granted, the trademark registrant acquires goodwill through use, and the name becomes associated in commerce with the rightful trademark owner. To permit invalidation of that properly-procured registration, merely by the living person's unilateral whim, would undermine that accumulated goodwill and cause consumer confusion, and further risks destabilization of otherwise established trademark rights that include a living person's name. As was recognized long ago, "a man has no absolute right to use his own name, even honestly, as the name of his merchandise or business. As such it becomes a trade name or service mark subject to the rule of priority in order to prevent deception of the public." *John R. Thompson Co. v. Holloway*, 366 F.2d 108, 113 (5th Cir. 1966), *quoted in Anderson v. Baker*, 2014 U.S. Dist. LEXIS 73059, at *18 (S.D. Tex. May 28, 2014). Thus while Mr. Grishko may have had a change of heart nearly a quarter-century after

granting written consent, IMW has acquired a quarter-century's worth of goodwill in reliance on the validity of that trademark, and the public has a quarter-century's worth of association of that mark with IMW. Mr. Grishko's sudden announcement that he no longer consents cannot, and ought not, result in the invalidation of IMW registrations, the proper procurement of which is not in dispute.

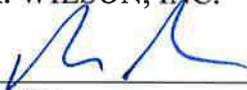
CONCLUSION

For the foregoing reasons, Respondent respectfully requests that the Board dismiss the Petition to Cancel with prejudice.

Respectfully Submitted,

Dated: October 18, 2016

I.M. WILSON, INC.



Jennifer L. Dean
Brian A. Coleman
Drinker Biddle & Reath LLP
1500 K Street, NW, Suite 1100
Washington, D.C. 20005
(202) 842-8800 (phone)
(202) 842-8465 (fax)
Counsel for Respondent

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing RESPONDENT'S MOTION TO DISMISS was served on Petitioner's counsel of record at the following address of record, by first-class mail this 18th day of October, 2016 to:

Brian P. Kinder, Esq.
The Kinder Law Group
19200 Van Karman Ave
Fourth Floor
Irvine, CA 92612