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

Proceeding	91210563
Party	Plaintiff Gregory A Lewis
Correspondence Address	JEFFREY SONNABEND SONNABENDLAW 600 PROSPECT AVENUE BROOKLYN, NY 11215 UNITED STATES jsonnabend@sonnabendlaw.com
Submission	Opposition/Response to Motion
Filer's Name	Jeffrey Sonnabend
Filer's e-mail	jsonnabend@sonnabendlaw.com
Signature	/JS/
Date	12/17/2013
Attachments	Lewis opposition motion to dismiss (consolidated).pdf(143951 bytes)

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

IN THE MATTER OF TRADEMARK APPLICATION SERIAL NOS. 85/540559, 85/671115,
85/671118, 85/659514 AND 85/730110
FOR THE MARKS BRITANNICA, BRITANNIC, BRITANNIA, BRITANNICA CAPITAL
AND BRITANNICA

Gregory A. Lewis,

Opposer,

v.

Kingsley Ventures Corporation,

Applicant.

Opposition No. 91207552

Opposition No. 91209887

Opposition No. 91210104

Opposition No. 91210136

Opposition No. 91210563

**OPPOSER’S OPPOSITION TO APPLICANT’S
THIRD MOTION TO DISMISS AND/OR STRIKE
AND/OR FOR SUMMARY JUDGMENT**

Applicant moves the Board for a third time to dismiss and/or strike the instant opposition. Applicant’s resubmitted motion fails for the same reason it failed the first time, namely because it seeks to argue the merits of the action in a motion to dismiss. Furthermore, to the extent that the instant motion is a motion for summary judgment, it is premature, as discovery has not yet been taken.¹

**I Applicant (Yet Again) Argues The Merits Of The Action Under The Rubric Of A
“Motion To Dismiss”**

For the third time in these proceedings (not counting the motions made in each consolidated proceeding), Applicant argues the merits of the case under the rubric of a “motion

¹ Opposer’s response to the motion for summary judgment is not yet due under the Rules and will be submitted separately.

to dismiss. Worse still, the Board has already considered and rejected many of the very same arguments made here. Applicant's motion to dismiss is thus not only predestined to fail, but Applicant's conduct in bringing the same, previously denied motion is sanctionable.²

A As The Board Made Clear In Its September 23, 2013 Ruling, The Purpose Of A Motion To Dismiss Is To Test The Sufficiency Of The Pleadings, Not To Determine The Merits Of The Action

In its September 23, 2013 ruling, the Board correctly stated and applied the standard for motions to dismiss. The Board correctly recognized that it is the sufficiency of the pleadings that is tested on a motion to dismiss, not the truth or falsity of assertions contained in the pleadings nor the weight of the evidence which might be adduced during the proceeding. The Board held that

[t]o withstand a motion to dismiss for failure to state a claim upon which relief can be granted, a plaintiff need only allege sufficient factual content that, if proved, would allow the Board to conclude, or to draw a reasonable inference, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark. *Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780 (TTAB 2012), citing *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); and TBMP § 503.02 (3d ed. rev.2 2013).

Order of September 23, 2013 at 9. This statement of law is, of course, correct. *Meckatzer Lowenbrau Benedikt Weib Kg v. White Gold, LLC*, 2010 WL 1946273 at *2 (TTAB May 13, 2010) ("The purpose of a Rule 12(b)(6) motion is to challenge the legal theory of the complaint, not the sufficiency of any evidence that might be adduced" (internal quotation omitted)).

Despite the clear and correct ruling by the Board in its September 23 order, Applicant nonetheless takes the same tack here it has taken before: Applicant argues not the sufficiency of

² Opposer will be filing a separate motion for sanctions based on the described conduct.

the pleadings in its motion to dismiss, but the weight of the evidence which might be adduced. In other words, Applicant yet again argues the merits of the case in the guise of a motion to dismiss.

B Points D And E Of Applicant's Papers, Which Improperly Address The Merits Of The Case, Have Already Been Argued By Applicant And Rejected By The Board

In points D and E of its papers, Applicant argues that Opposer's lack of use in commerce and priority claims, respectively, should be dismissed. Its arguments are based not on the sufficiency of the pleadings on these bases, but instead on the merits of them. For this reason alone the motion should be denied. Worse, however, is the fact that both of these arguments have been made previously, and the Board ruled against Applicant on both. See Order of September 23, 2013 (Docket Entry No. 30).

First, point D of Applicant's motion, beginning on page 14 of Applicant's motion papers, is entitled "Opposer's Non-Use Claims Should Be Dismissed Because The Undisputed Evidence Proves Applicant's Use In U.S. Commerce." The title tells the Board all it needs to know: Applicant is arguing, yet again, that the non-use in commerce basis for the opposition should be "dismissed" based on the "undisputed evidence" (which is, of course, disputed). The basis for the "dismissal" is not insufficiency of the pleading, but the alleged merits (i.e., on the "evidence").

Importantly, Applicant makes clear that its motion is based on the alleged "fals[ity]" of a factual assertion contained in the Notice of Opposition. Applicant states:

Opposer's allegations rest entirely on a single false assertion, that "FINRA has responsibility for certifying and registering every financial services firm in the United States, and therefore has record of the name of every such firm"

Applicant's Motion to Dismiss at 14 (Docket Entry No. 39). Applicant then goes on to discuss at length certain purported "evidence" of Applicant's purported use in commerce.³

Likewise, in point E of its motion, Applicant argues that "Opposer's Claims Should Be Dismissed for Opposer's Conceded Lack of Priority". Applicant's Motion to Dismiss at 17. As with the previously discussed point D, Applicant goes to great length in point E to argue the merits of the matter (i.e., whether or not Opposer will be able to show priority). What is more, Applicant apparently recognizes that it is re-arguing its previous argument-on-the-merits, stating:

Applicant respectfully submits that the Board erred in its September 23, 2013, Order when it concluded on page 12 that Opposer had correctly alleged analogous use.

Applicant's Motion to Dismiss at 17.

Applicant's argument on the merit in points D and E are legally improper. Even more improper is Applicant's attempt to re-argue positions previously presented and rejected by the Board. The Board considered and rejected the very same arguments made here when Applicant presented them in its previous motion to dismiss. See Order of September 23, 2013, points A and D, at 11 and 19. Applicant's motion to dismiss, points D and E, must be denied for this reason.

C Point A Of Applicant's Papers Argues The Merits And Must Be Denied Accordingly

Like points D and E of its papers, Applicant's point A is styled as a motion to dismiss but actually presents an argument going to the merits of the case. It must be denied for this reason.

Point A is entitled, "Opposer's Fraud Claims Should Be Dismissed Because The Evidence Is Undisputed That Applicant's Applications And Specimens Were Truthful." Applicant's Motion

³ Much of this so-called "evidence" is misleading at best and outright false at worst. The falsity of the "evidence" will be addressed in a separate motion for sanctions.

to Dismiss at 6. Again, this title tells the Board all it needs to know about the sum and substance of Applicant's ensuing argument: Applicant admits that it is arguing the "evidence", not the sufficiency of the pleadings. More specifically, Applicant argues that

the undisputed evidence establishes that Applicant's trademark applications and the declarations and specimens submitted therewith were truthful, bona fide and accurate.

Applicant's Motion to Dismiss at 6. Applicant continues that

Opposer has not and cannot rebut this undisputed evidence, and Opposer's notice of opposition should be dismissed on this basis alone.

Id.

An opposer is not required to "rebut" any evidence in its initiating pleadings, nor is it required to "rebut" evidence in connection with a motion to dismiss. The opposer

need only allege sufficient factual content that, if proved, would allow the Board to conclude, or to draw a reasonable inference, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark.

Order of September 23, 2013 at 9, citing *Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780 (TTAB 2012). In other words, the motion to dismiss is not a vehicle for presenting evidence which the other party must then "rebut," it is a vehicle for testing the sufficiency of pleadings.⁴ Applicant's motion to dismiss, point A, must be denied accordingly.

D Point C Of Applicant's Papers Argues The Merits And Must Be Denied Accordingly

As with the argument contained in point A of Applicant's papers, Applicant argues in Point C not the sufficiency of the pleadings of fraudulent specimen, but instead the merits of

⁴ Applicant is aware of this legal tenet because the Board has already instructed Applicant on this point *in this case*.

fraudulent specimen case. Applicant argues at length that the claims of fraudulent specimen are “contradicted by the undisputed evidence and should be dismissed.” Applicant’s Motion to Dismiss at 12. More specifically, Applicant argues that “Opposer has [not] introduced any allegations that would lead to the *inevitable conclusion* that Applicant intended to deceive the USPTO.” Id. at 13 (emphasis in original).

To determine whether a conclusion is “inevitable” requires weighing the evidence, however. The “inevitability” *vel non* of any substantive conclusion in the proceeding is an issue not of sufficiency of the pleadings *per se*, but of the evidence of the case. The to-the-merits nature of Applicant’s argument is highlighted by Applicant’s own statements, which baldly address the merits. For example, in one illuminating passage, Applicant argues:

Applicant's specimens are truthful proprietary marketing materials of Applicant, have been used by Applicant for marketing, advertising, sales, and rendering of its services under the mark, have been distributed by Applicant, and demonstrate to the USPTO how the mark was and is being used in commerce by Applicant.

Applicant’s Motion to Dismiss at 13. Clearly, this passage goes to the very heart of the substantive issues of the case, namely, whether or not the specimen were fraudulent (and Applicant effectively says, “take my word for it, they were not”). A motion to dismiss, however, is not the place to make such a statement, nor do initiating pleadings need to conclusively contradict such statements; instead, the pleadings need only to state a claim, taking all pleaded allegations as true. Order of September 23, 2013 at 9, citing *Doyle v. Al Johnson’s Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780 (TTAB 2012)

What is more, Applicant chooses to focus on the merits rather than the sufficiency of the pleadings because the pleadings are sufficiently pleaded. Specifically, Opposer alleges the

following specific facts, which if true, would support a finding that the submitted specimens were fraudulent⁵:

36. In connection with the instant application, Applicant has submitted specimen which is or are fabrications.

37. The specimen purports to be portions of a brochure (or similar publication); however, no such brochure was ever created nor distributed by Applicant. Instead, Applicant created the alleged brochure (or similar publication) portions solely for the purpose of submission with the instant application. The entirety of the specimen is therefore a fabrication as it never formed a part of any brochure (or similar publication) as alleged by Applicant.

38. In connection with the instant application, the submission of the fabricated specimen to the Trademark Office was material because the application would not be allowed without such submission.

39. In connection with the instant application, Applicant made the foregoing submission to the Trademark Office knowing of its falsity.

40. Applicant knew of the falsity because it created a document purporting to be a portion of a brochure (or similar publication) knowing that no such brochure (or similar publication) ever existed.

41. In connection with the instant application, Applicant made the foregoing submission to the Trademark Office with the specific intent to deceive the Trademark Office and obtain registration of the applied-for mark.

42. Applicant must have intended to deceive the Trademark Office because is submitted a document purporting to be a portion of a brochure (or similar publication) knowing that no such brochure (or similar publication) ever existed.

⁵ Under Rule 9(b), intent need only be alleged generally. *Daimlerchrysler Corp. & Chrysler, LLC v. American Motors Corp.*, 2010 WL 1146943 at * 3 (TTAB Mar. 25, 2010) (“intent, as a condition of mind of a person, may be averred generally. Fed. R. Civ. P. 9(b).”). Opposer made such an allegation at paragraph 41 of the Second Amended Notice of Opposition.

43. For the foregoing reasons, Applicant has committed fraud in connection with the present application.

Second Amended Notice of Opposition at 8-9. Clearly, these allegations – which must be taken as true for purposes of a motion to dismiss – state a substantive, non-conclusory basis for finding that Applicant committed fraud. The allegations detail Applicant’s knowing submission of a knowingly false, knowingly fabricated specimen for purposes of deceiving the Trademark Office in order to obtain registration. The allegations in the pleadings are complete and proper, and Applicant’s motion to dismiss the fraudulent specimen claim must be denied.

E Applicant Does Not Argue The Sufficiency Of The Fraudulent Declaration Pleadings, But Instead Argues (Once Again) The Merits Of The Action

In point B of its motion papers, Applicant moves to dismiss the claim of fraudulent declaration. Applicant does so by arguing an array of substantive factual issues, not by addressing at all the sufficiency of the pleadings.

Specifically, Applicant provides in the several paragraphs spanning pages 9 and 10 its view of the facts surrounding the fraudulent declaration. For example, Applicant discusses at length the FINRA communications, stating:

On the one hand, Opposer alleges that "Applicant has *at no time* sought registration with FINRA" (§ 14, emphasis added). On the other hand, Opposer alleges that "Applicant was informed of Opposer's pending FINRA application by a party or parties within FINRA" (§ 15). These are inconsistent allegations. If Applicant allegedly never sought FINRA registration, then no communication would have occurred between anyone at FINRA and Applicant.

Applicant's Motion to Dismiss at 9. These views of the facts are irrelevant to the instant motion. They address the substance of the evidence, not the sufficiency of the pleadings, and Applicant's motion must be denied accordingly.⁶

Finally, Applicant cites *E.&J. Gallo Winery v. Quala S.A.*, Opposition No. 91186763 (TTAB Dec. 7, 2009) and *Ayush Herbs, Inc. v. Hindustan Lever Ltd Co.*, Opposition No. 91172885, at 13, 15 (TT AB Nov. 19, 2009), for the proposition that Opposer must state a "separate indication of actual knowledge of the facts" when making allegations "upon information and belief." Applicant's Motion to Dismiss at 10. These cases say no such thing (nor could they: how could one state direct knowledge of facts which needed to be alleged upon information and belief? There would be no need for an allegation upon information and belief if the facts were directly known). Instead, these cases both state the holding of *Exergen Corp., v. Wal-Mart Stores, Inc.*, which held that

[p]leading on "information and belief" is permitted under Rule 9(b) when essential information lies uniquely within another party's control, but only if the pleading sets forth the specific facts upon which the belief is reasonably based.

575 F.3d 1312, 1330 (Fed. Cir. 2009).

In the present case, Opposer has pleaded exactly as required by *Exergen Corp.* Specifically, Applicant details the basis for its information and belief, stating:

11. The registration process through FINRA (and accordingly through the SEC) under the name BRITANNICA CAPITAL PARTNERS, LLC and/or BRITANNICA CAPITAL, has continued

⁶ Applicant's views, while irrelevant to the instant motion, are nonetheless wrong. There would be nothing – and indeed there was nothing – to stop a person working at FINRA from contacting Applicant upon learning of Opposer's FINRA application, regardless of whether Applicant had applied to FINRA. The evidence will show this to be the case.

to date, and Opposer anticipates final approval and registration by late October or early November of this year.

12. Based in part upon Opposer's review of the FINRA registration process and the timing and nature of Applicant's activities detailed below, Opposer understands that Applicant learned of Opposer's 2011 and early 2012 efforts to establish a financial services business under the marks BRITANNICA, BRITANNICA CAPITAL PARTNERS LLC and/or BRITANNICA CAPITAL and has undertaken to frustrate Opposer's ability to use and register those marks.

13. Specifically, Applicant has been aware at all times that FINRA registration is a necessary prerequisite for providing the services identified in the both parties' applications. As a result, the filing of an application for a FINRA registration under a particular mark (i.e., for a registration of a business operating under the mark) demonstrates *ipso facto* a right to operate FINRA regulated services under the mark senior to all parties who have not yet sought registration with FINRA under the same or similar mark.

14. Applicant has at no time sought registration with FINRA for services under its instant mark. Applicant therefore cannot have provided the services identified in its instant application.

15. Upon information and belief, such belief being based in part on the timing of the activities described herein and Opposer's understanding of the FINRA registration process, Applicant was informed of Opposer's pending FINRA application by a party or parties within FINRA.

16. As a result, by virtue of its knowledge of Opposer's FINRA application, and further by virtue of its lack of FINRA registration and resulting inability to provide the services as identified in the instant application, Applicant knew at the time it filed the aforementioned declaration that Opposer had senior rights to Applicant in mark at issue.

17. Applicant filed the present application for registration on February 12, 2012. The application claimed a date of first use of February 12, 2012, the same day as the application filing.

18. According to whois records, Applicant obtained the domain <britannicapital.com> on February 24, 2012, twelve days after

its stated date of first use. At some time thereafter, Applicant began operating a website at <britannicapital.com> advertising and promoting investment related services.

19. Applicant's website states that "Britannica is an investment advisory firm founded in 2012." Applicant's website bears a copyright notice of 2012.

20. On September 7, 2012, an attorney for Applicant wrote to Opposer demanding that Opposer cease use of the mark BRITANNICA and that Opposer abandon his pending application for registration of that mark. In that letter, the attorney for Applicant represented that Applicant "began using the trademark BRITANNICA at least as early as 2004 in the United States."

21. Subsequent to the September 7, 2012 letter, Opposer's attorney responded to the Opposer's attorney requesting (a) explanation for the discrepancy between the date of first use stated in the letter and the claims made on Applicant's website regarding date of formation; (b) explanation for the discrepancy between the date of first use stated in the letter and the date of registration of the domain <britannicapital.com>; (c) explanation for the discrepancy between the date of first use stated in the letter and the date of first use stated in the instant application; and (d) documentation of Opposer's alleged use dating to 2004.

22. Applicant's counsel did not provide any explanation for foregoing requests (a), (b) and (c), supporting the aforementioned allegations concerning Applicant's knowledge and intent underlying its activities.

23. Applicant's counsel provided purported documentation of Applicant's use dating to 2004, such documentation appearing to be fabricated, supporting the aforementioned allegations concerning Applicant's knowledge and intent underlying its activities.

Second Amended Notice of Opposition at 3-5. Clearly, this lengthy, substantive statement of the facts that give rise to Opposer's "information and belief" allegations "sets forth the specific facts upon which the belief is reasonably based" as required by *Exigen Corp.* Applicant's reliance on

the cases citing *Exigen Corp.* is thus misplaced, and its motion to dismiss must be denied accordingly.

II Applicant's Motion To Strike Must Be Denied

At point F of its papers, Applicant moves to strike certain paragraphs of the Second Amended Notice of Opposition. See Applicant's Motion to Dismiss at 22. Under Rule 12(f),

the Board may order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. *However, motions to strike are not favored, and matter will not be stricken unless such matter clearly has no bearing upon the issues in the case.*

Ohio State Univ. v. Ohio Univ., 1999 WL 517202 at * 4 (TTAB Mar. 18, 1999) (emphasis added).

What is more, the Board will not strike well pleaded allegations of fraud simply because they are “objectionable” to one or another party. *Id.*

In the present case, the allegations at issue go directly to the well-pleaded allegations of fraud. They thus have “bearing on the issues in the case” and cannot be struck as a result.

III Applicant's Motion To Dismiss Based On “Lack Of Standing, Fraud, Intent To Deceive The USPTO, Unclean Hands, And Bad Faith” Must Be Denied

Finally, at point G of its papers, Applicant makes a motion to dismiss based on an assortment of theories. The sundry theories include lack of standing, fraud, “intent to deceive the USPTO”, unclean hands and “bad faith.” Applicant has already made lack of standing and unclean hands arguments, and the Board has rejected them. See Applicant's Motion to Dismiss of February 25, 2013 (Docket Entry No. 10) and Order of September 23, 2013. The new “bad faith” theory for dismissal appears to have no basis in law, and the “fraud” and “intent to deceive the USPTO” are no more than recastings of the unclean hands theory. Thus, Applicant's final, catch-all basis for dismissal must be disregarded.

CONCLUSION

For the foregoing reasons, Applicant's motion to dismiss must be denied in its entirety.

Dated: December 17, 2013

Respectfully submitted,

A handwritten signature in blue ink, appearing to read "Jeffrey Sonnabend", is written over a horizontal line.

Jeffrey Sonnabend
SonnabendLaw
600 Prospect Avenue
Brooklyn, NY 11215

Attorney for Opposer
Gregory A. Lewis

CERTIFICATE OF SERVICE

I certify that on the date indicated below, a copy of the foregoing papers were served by
United States postal mail on the following:

Amy J Everhart
Everhart Law Firm PLC
1400 5th Avenue North
Nashville, TN 37208

Dated: December 17, 2013



Jeffrey Sonnabend