

ESTTA Tracking number: **ESTTA1013381**

Filing date: **11/04/2019**

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

Proceeding	91246161
Party	Plaintiff The Executors of the Estate of Les Paul
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Attachments	11.04.2019 Executors of the Estate of Les Paul Response to Motion to Dismiss.pdf(77656 bytes )

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

THE EXECUTORS OF THE	)	
ESTATE OF LES PAUL,	)	
	)	
<i>Opposer,</i>	)	Opposition No. 91246161
	)	App. No. 87/978,388
v.	)	
	)	
GIBSON BRANDS, INC.,	)	
	)	
<i>Applicant.</i>	)	

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**THE ESTATE OF LES PAUL'S RESPONSE TO GIBSON BRANDS, INC.'S  
MOTION TO DISMISS**

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Gibson's Motion to Dismiss is nothing more than a thinly veiled attempt to burden the Estate of Les Paul with proving its claims at the pleading stage and to delay this proceeding to distract from its lack of evidence supporting its Application. The Estate of Les Paul's Amended Notice of Opposition states valid claims for relief and addresses several of Gibson's arguments. The remaining arguments fail as a matter of law. As such, the Board should deny the Motion to Dismiss and allow the parties to proceed with discovery.

**I. Procedural Background**

On January 30, 2019, the Executors of the Estate of Les Paul ("Estate of Les Paul") filed a notice of opposition against Gibson Brands, Inc.'s ("Gibson") trademark application Serial No. 87978388 for LES PAUL for "Organizing and conducting charity auctions for charitable fundraising purposes" (the "Applied For Services") (the "Notice of Opposition").

Gibson filed an initial consent motion for suspension for settlement on February 19, 2019. 4 TTABVUE \*1. Gibson then filed two subsequent consent motions for suspension, including a consent motion to suspend filed on July 8, 2019 (the "July 8 Consent Motion"). 8 TTABVUE

\*1. In an order granting the July 8 Consent Motion, the Board instructed that "[i]n the event that there is no word from either party, proceedings shall resume on 9/7/2019 without further notice or order from the Board, upon the schedule set forth in the [July 8 Consent Motion]". 9 TTABVUE \*1. Neither party submitted additional filings before September 9, 2019, and proceedings resumed.

Under the schedule set forth in the July 8 Consent Motion, Gibson's time to answer the Notice of Opposition expired on Saturday, October 12, 2019. Instead of answering the Notice of Opposition, Gibson filed a Motion to Dismiss the Notice of Opposition on October 14, 2019. The Estate of Les Paul filed its Motion to Amend its Notice of Opposition within twenty-one days of receipt of service of Gibson's Motion to Dismiss as required by Fed. R. Civ. P. 15 and T.B.M.P. 503.03.

**II. The Estate of Les Paul's Amended Notice of Opposition Is the Operative Pleading for Evaluating Gibson's Motion to Dismiss**

The Estate of Les Paul has filed a motion to amend the Notice of Opposition (the "Motion to Amend") concurrently with this response to Gibson's Motion to Dismiss. As explained in more detail in the Motion to Amend, an opposer may amend its complaint within twenty-one days after the service of Rule 12(b) motion, including a Rule 12(b)(6) motion to dismiss. Fed. R. Civ. P. 15; T.B.M.P. 503.03. When a party timely files an amended pleading within twenty-one days of service of a Rule 12(b)(6) motion to dismiss, the Trademark Trial and Appeal Board (the "Board" or "TTAB") accepts the amended pleading as the operative pleading for considering the motion to dismiss. *Caymus Vineyards v. Caymus Medical Inc.*, 107 U.S.P.Q.2d 1519, 1521 (T.T.A.B. 2013)(accepting applicant's amended counterclaim as the applicant's operative pleading when applicant filed the amended counterclaim within twenty-one days of opposer's motion to dismiss, as the applicant's); see also *Fair Indigo LLC v. Style*

Conscience, 85 U.S.P.Q.2d 1536 (T.T.A.B. 2007) ("we accept the amended notice as the operative pleading, and now consider the motion to dismiss with respect to the amended notice of opposition, and determine whether the amended complaint asserts a proper claim").

The Estate of Les Paul has timely filed its Motion to Amend within twenty-one days after service of Gibson's Motion to Dismiss. Therefore, the Estate of Les Paul's amended Notice of Opposition is the operative pleading for assessing Gibson's Motion to Dismiss. When considered in light of the Estate of Les Paul's Amended Notice of Opposition, Gibson's Motion to Dismiss is moot.

### **III. Legal Standard – Motion to Dismiss**

A motion to dismiss under Rule 12(b)(6) tests a singular issue: whether or not the claims in the complaint are legally sufficient. The opposer's duty to plead legally sufficient claims is separate and distinguishable from opposer's duty to prove its claims during the trial phase of an opposition proceeding. *Young v. AGB Corp.*, 152 F.3d 1377, 47 U.S.P.Q.2d 1752, 1754 (Fed. Cir. 1998) ("[Defendant's] arguments appear to confuse the sufficient pleading of a claim with the obligation of proving that claim.").

To withstand a motion to dismiss, Petitioner need only allege such facts which, if proved, would establish that: (1) Petitioner has standing to bring the proceeding; and (2) a valid statutory ground exists for [denying the application]. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 U.S.P.Q.2d 1212, 1212 (T.T.A.B. 2006), *aff'd unpub'd*, 240 Fed. Appx. 865 (Fed. Cir. July 11, 2007), *cert. denied*, 552 U.S. 1109 (2008); *Young v. AGB Corp.*, 47 U.S.P.Q.2d at 1753. There is no requirement for the opposer to "prove its case at the pleading stage." *Lewis Silkin LLP v. Firebrand LLC*, (T.T.A.B. 2018) (Canc. No. 92067378) (citing *Lifetime Indus., Inc. v. Trim-Lok, Inc.*, 869 F.3d 1372, 124 U.S.P.Q.2d 1061, 1064 (Fed. Cir. 2017)). Whether the

plaintiff or oppose will be able to prove its trademark claims is a matter for trial or summary judgment after the pleadings have closed, and is irrelevant to assessment of the legal sufficiency of the complaint. *Guess? IP Holder LP v. Knowluxe LLC*, 116 U.S.P.Q.2d 2018, 2019 (T.T.A.B. 2015).

In examining the pleading, the Board must consider the pleading in its entirety and construe the complaint in the light most favorable to the plaintiff or opposer. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 U.S.P.Q. 185 (C.C.P.A. 1982); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 U.S.P.Q.2d 1460 (T.T.A.B. 1992); *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 U.S.P.Q.2d 1038 (Fed. Cir. 1993). "Determination of whether a complaint states a claim for relief will ... be a context specific task that requires the [Board] to draw on its judicial experience and common sense." *Ashcroft v. Iqbal*, 556 U.S. 662, 679 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). Unless it appears certain that the plaintiff or opposer is not entitled to relief under any set of facts that could be proved in support of its claim, dismissal for insufficiently plead claims is inappropriate. *Stanspec Co. v. American Chain & Cable Company, Inc.*, 531 F.2d 563, 189 U.S.P.Q. 420 (C.C.P.A. 1976).

#### **IV. Argument**

##### **a. The Estate of Les Paul Has Properly Pled a Claim for Non-Use**

The Estate of Les Paul has properly pled a claim of non-use. However, in addition to this response to Gibson's Motion to Dismiss, the Estate of Les Paul has also filed a timely amended Notice of Opposition, which makes minor clarifications and additions to the original Notice of Opposition. And, as discussed above, the Amended Notice of Opposition is the operative pleading for the purposes of assessing Gibson's Motion to Dismiss.

The Board should deny Gibson's Motion to Dismiss because the Amended Notice of Opposition pleads factual allegations that, if proven, would establish that the Application should be refused based on non-use. In order to file an application based on use in commerce under Section 1(a) of the Trademark Act, the applicant must have used the trademark in commerce in connection with the goods or services identified in the application as of the application filing date. "It is clear that an applicant cannot obtain a registration under Section 1 of the Trademark Act for goods or services upon which it has not used the mark. 15 U.S.C. § 1051." *Grand Canyon West Ranch, LLC v. Hualapai Tribe*, 78 U.S.P.Q.2d 1696, 1698 (T.T.A.B. 2006). If the applicant has not used the mark on any of the goods or services, then the application is void *ab initio*. See Trademark Rule 2.34(a)(1)(i); *United Global Media Grp., Inc. v. Tseng*, 112 U.S.P.Q.2d 1039, 1044 (T.T.A.B. 2014); *Shut 'Em Down Sports Inc. v. Lacy*, 102 U.S.P.Q.2d 1036, 1045 (T.T.A.B. 2012) ("Because we find that respondent's allegation of use of his mark in commerce for the identified goods, at the time of filing of his application was false, we hold that the application was void *ab initio*, and we need not decide the fraud claim.").

In its Motion to Dismiss, Gibson makes sweeping, conclusory statements about its alleged use of LES PAUL. For example, Gibson claims that "Opposer has failed to satisfy [the burden of pleading a sufficient non-use claim] because Applicant clearly used the mark in connection with Applicant's Services" and that "it is plainly evident that the specimens show Applicant's LES PAUL mark used in commerce." 11 TTABVUE \*4. These claims are unsupported and inappropriate because they infer legal and factual conclusions about Gibson's alleged use LES PAUL, and whether such alleged use meets the standards for trademark use in commerce set forth by the Trademark Act. The Estate of Les Paul has properly plead a claim for

refusing the Application based on non-use. The proper time for assessing whether the Estate of Les Paul can prove this claim is at summary judgment or trial, not through a motion to dismiss.

Additionally, it is not "plainly evident," as Gibson argues, that the Specimens demonstrate that Gibson has used LES PAUL as a trademark in commerce for the goods identified in the Application. 10 TTABVUE \*4. As discussed further in the Amended Notice of Opposition, the Specimens of Use consist of three articles, two of which do not even reference organizing or conducting charity auctions. *Amended Notice of Opposition* ¶¶ 33-46. One of the three article references a charity auction, but it appears that the particular auction was organized and conducted by Mecum Auction Company, not Applicant. *Amended Notice of Opposition* ¶¶ 37-40. Applicant appears to have donated a guitar to the auction conducted and operated by Mecum Auction Company. *Id.* These factual allegations demonstrate that there is a real disputed issue of whether there is a Specimen in the prosecution file to support Section 1(a), use in commerce basis of the Application, or whether Gibson has ever used LES PAUL as a trademark at all. Accordingly, the Amended Notice of Complaint provides factual content that allows the Board to draw the reasonable inference that Gibson has not satisfied the use in commerce requirement.

Further, Gibson argues that the Estate of Les Paul cannot state a claim for relief because the Trademark Office approved the Application for publication, and "[t]hus the use requirement for registering a trademark is satisfied." 10 TTABVUE \*4. Gibson's emphasis on the Trademark Office's approval of the Application for publication is misplaced. The Application's approval for publication has no bearing on this opposition proceeding or whether the Estate of Les Paul can adequately plead non-use. As the scholar Thomas McCarthy explained, "[o]f course, the ex parte decision of a USPTO examining attorney does not 'bind' the Trademark Board," and "the Board

is not bound by the decision of examining attorneys to approve proposed marks for publication." 6 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 32:103 (4th ed. 2017). The Court of Appeals for the Federal Circuit has also repeatedly emphasized that the Board's independent review of examination decisions is a crucial and necessary component of inter partes proceedings to review and remedy potential issues in the examination process. *In re Viterra Inc.*, 671 F.3d 1358, 1365, 101 U.S.P.Q.2d 1905 (Fed. Cir. 2012) ("[I]nter partes proceedings are intended to be a backstop for the examination process."); *In re Shell Oil Co.*, 992 F.2d 1204, 1206 (Fed. Cir. 1993) ("[t]he opposition procedure is intended to remedy oversight or error").

Given the Amended Notice of Opposition and Gibson's lack of support in the law, the Board should deny Gibson's Motion to Dismiss as it relates to non-use. The Estate of Les Paul has properly alleged facts, which, if proven, would establish the Application is void *ab initio* due to non-use, and the Estate of Les Paul is entitled to the Board's independent review on these issues after the Estate of Les Paul has had a full and fair opportunity to conduct discovery on these matters.

**b. The Estate of Les Paul Has Properly Pled a Claim for Non-Ownership**

Similarly to its argument on non-use, Gibson's arguments related to non-ownership also fail. Gibson alleges that "Opposer cannot allege any set of factual circumstances under which Applicant is not an owner of LES PAUL used with Applicant's Services." 10 TTABVUE \*5. This is categorically false. As discussed above, the Estate of Les Paul has plead factual content that supports a reasonable inference that Gibson has not used LES PAUL as a trademark in commerce in connection with the Applicant's Services. Trademark rights are use-based. If Gibson has not used use LES PAUL as a trademark in connection with Applicant's Services, then



Gibson does not own rights to the LES PAUL trademark for the Applicant's Services and the Application should be denied registration.

Even if Gibson has used LES PAUL as a trademark for Applicant's Services, the Estate of Les Paul has argued in the alternative that the Estate of Les Paul has priority of use. The Estate of Les Paul alleges:

26. Opposer currently uses, and has used prior to the Application filing date or any priority date on which the Applicant can rely, the LES PAUL trademark for music education and programming, museum and educational services, charitable services; charitable foundation services, namely, providing fundraising activities, supplemental funding, scholarships and financial assistance for programs and services of others; charitable fund raising; accepting and administering monetary charitable contributions; organizing charitable events and programs; donation of goods and services to charitable organizations and third parties conducting charitable auctions; Promotional sponsorship of musical benefit concerts; Charitable services, namely, promoting public awareness of arts and music through the creation and development of benefit concerts and music outreach programs and music education programs, and licensing intellectual property acquired by Les Paul during his lifetime.

27. Upon information and belief, Applicant is unable to establish, with respect to Applicant's alleged use of the Alleged Mark for Applicant's Services, priority of rights in the United States.

*Amended Notice of Opposition* ¶¶ 26-27.

As Applicant admits in its Motion, trademark ownership belongs to the party that can establish earliest continuous use of a mark. 10 TTABVUE \* 5 ("It is priority of trademark use, in commerce, that confers ownership upon the user.") (citing *g., Gen. Bus. Servs., Inc. v. Rouse*, 495 F. Supp. 526, 533 (E.D. Pa. 1980)). As more fully set forth in the Amended Notice of Opposition, the Estate of Les Paul has plead that its use of LES PAUL as a trademark for organizing charitable events and programs, charitable fundraising, charitable giving and partnership, and other services predates the filing date of the Applicant and any alleged use of LES PAUL by Gibson. *Amended Notice of Opposition* ¶¶ 26-27. The Estate of Les Paul has also

plead that it is the owner of the Les Paul trademark by virtue of its priority in and to this mark for these services. *Id.*

The Estate of Les Paul has plead facts that, if proven, would support two claims of non-ownership against Applicant: (1) Applicant does not own LES PAUL as a trademark because it has never used LES PAUL as a trademark for Applicant's Services; and (2) Applicant does not own LES PAUL as a trademark because Opposer is the senior user of LES PAUL for charitable services. To the extent that Gibson disagrees with these claims or questions the Estate's ability to substantiate them, the onus is on Gibson to prove its claims at trial, and not at the pleading stage.

**c. The Estate of Les Paul Has Plead an Adequate Claim for Likelihood of Confusion**

The Estate of Les Paul has set forth a sufficient claim for likelihood of confusion, in both the original Notice of Opposition and the Amended Notice of Opposition. Gibson argues that the Notice of Opposition does not specifically identify the trade channels or customers for the Estate of Les Paul's services, and therefore fails to provide adequate notice to Gibson. 10 TTABVUE \*7-8. As an initial matter, the allegations in the Estate of Les Paul's original Notice of Opposition provided sufficient notice to Opposer. 1 TTABVUE ¶¶ 47-51.

A notice of opposition must contain a "short and plain" statement of the grounds for opposition, and the elements of the claim should be stated simply, concisely, and directly, so that, taken together, they "state a claim to relief that is plausible on its face." 37 C.F.R. § 2.104(a); *Lewis Silkin LLP v. Firebrand LLC*, 129 U.S.P.Q.2d 1015, 1016 (T.T.A.B. 2018) (Board follows federal notice pleading standard which includes the requirement that the complaint "state a claim to relief that is plausible on its face"); 5 C. WRIGHT, A. MILLER & M. KANE, *FEDERAL PRACTICE AND PROCEDURE* Civil § 1219 (3d ed. 2019) ("The federal

rules effectively abolish the restrictive theory of the pleadings doctrine, making it clear that it is unnecessary to set out a legal theory for the plaintiff's claim for relief.").

To plead a likelihood of confusion claim, the Estate of Les Paul need only plead that it has senior trademark rights, and that the applied-for mark, when used in connection with the goods or services identified in the application, it likely to cause confusion with the its mark. The Estate of Les Paul has set forth adequate claims for likelihood of confusion:

26. Opposer currently uses, and has used prior to the Application filing date or any priority date on which the Applicant can rely, the LES PAUL trademark for music education and programming, museum and educational services, charitable fundraising, charitable giving and partnerships, organizing charitable events and programs, promoting, sponsoring, and funding scholarships and awards, and licensing intellectual property acquired by Les Paul during his lifetime

61. The Alleged Mark so closely resembles Opposer's Les Paul Logo and LES PAUL trademark as to be likely to cause confusion, or to cause mistake, or to deceive with respect to the source or origin of Applicant's Services, and/or with respect as to whether Opposer is associated with, approves, sponsors, or is otherwise connected to Applicant or Applicant's Services

*Amended Notice of Opposition*, ¶¶ 26; 61.

These claims, in themselves, are sufficient to establish a claim for likelihood of confusion. The original Notice of Opposition included allegations regarding the similarities of trade channels and target customers, which are du Pont factors considered in the likelihood of confusion analysis. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A. 1973). The Estate of Les Paul included these claims to provide further notice of the Estate of Les Paul's likelihood of confusion claims. Ironically, Gibson claims that these additional allegations fail to provide fair notice. 10 TTABVUE \*8. However, there are short and plain statements that provide further notice, and the Board has frequently allowed pleadings that contained similar allegations regarding trade channels and customers. Here, too, the Estate of Les Paul's claims provide further notice of the *du Pont* factors that will be addressed at trial.

Additionally, the Estate of Les Paul has amended its Notice of Opposition to provide even more detail on the grounds for its claim of likelihood of confusion. The Amended Notice of Opposition addresses the alleged issues Gibson raised in its Motion to Dismiss, namely, the specificity of the claims regarding the respective parties' trade channels and customers. *Amended Notice of Opposition* ¶¶ 61-62. Therefore, Gibson's Motion to Dismiss the Estate of Les Paul's likelihood of confusion claim should be dismissed as moot.

**d. The Estate of Les Paul Has Adequately Pled a Claim for Abandonment**

The Estate of Les Paul has sufficiently pled a claim for abandonment in its Amended Notice of Opposition. Abandonment occurs when "[w]hen its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for three consecutive years shall be prima facie evidence of abandonment." 15 U.S.C. § 1127. The opposer may set forth a prima facie case for abandonment by either: (1) pleading at least three consecutive years of non-use; or (2) setting forth facts that show a period of non-use for less than three years coupled with an intent not to resume. *Otto Int'l Inc. v. Otto Kern GmbH*, 83 U.S.P.Q.2d 1861, 1863 (T.T.A.B. 2007).

In its Motion to Dismiss, Gibson incorrectly argues that a plaintiff must plead both three consecutive years of non-use *and* intent not to resume in order to properly plead a claim for abandonment. However, proving either non-use for three consecutive years *or* intent not to resume use gives rise to abandonment. Three continuous years of non-use by itself creates a prima facie case for abandonment, which establishes "a rebuttable presumption that the [applicant] has abandoned the mark without intent to resume use." *ShutEmDown Sports, Inc. v. Carl Dean Lacy*, 102 U.S.P.Q.2d 1036 (T.T.A.B. 2012); *SaddleSprings Inc. v. Mad Croc Brands Inc.*, 104 U.S.P.Q.2d at 1950 ("petitioner has alleged that respondent has either never used the

registered mark in commerce or completely ceased using the mark in commerce, in connection with the goods identified in the registration, for at least a period of three consecutive years. ... The facts alleged by petitioner set forth a prima facie claim of abandonment."); *see also Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 U.S.P.Q.2d 1175, 1180 (T.T.A.B. 2017)("nonuse of a mark for three consecutive years constitutes a prima facie showing of abandonment and triggers a rebuttable presumption that a mark was abandoned without intent to resume use") (citations omitted). The Estate of Les Paul has alleged that Gibson has not used the LES PAUL trademark for three continuous years, and thereby has adequately pled a prima facie case for abandonment, i.e., that Gibson has discontinued any trademark use without an intent to resume. *Amended Notice of Opposition* ¶¶ 55-58.

Gibson also objects to the condense nature of the Estate of Les Paul's abandonment claims, but there is nothing improper about a short, plain set of pleading that adequately set forth the elements of a claim. 11 TTABVUE \*6-7. Indeed, the Estate of Les Paul need only plead "a short and plain statement of the claim showing that the pleader is entitled to relief". Fed. R. Civ. P. 8(a)(2). The Board's recent precedential decision, *Lewis Silkin LLP v. Firebrand LLC*, affirmed that concise claims are often sufficient for pleading abandonment. 129 U.S.P.Q.2d 1015 (T.T.A.B. 2018). In *Lewis Silkin*, the Board found the following to be a sufficient pleading for abandonment: "On information and belief, Respondent is not using Respondent's Mark on or in connection with Respondent's Goods and Services with no intent t [sic] to resume such use." *Id.* The Board determined that that "no more is necessary for a legally sufficient abandonment claim" because the allegation "worked double duty" to both describe the claim and provide the necessary facts to support the claim. *Id.* at 1026. *Lewis Silkin* also confirmed that short and plain claims for abandonment are appropriate because the plaintiff is not required to conduct an

exhaustive factual investigation before submitting a complaint, and the intricacies of determining use in commerce appropriately addressed during trial, the pleading stage. *Id.* at 1027 ("The Board is reluctant to see pleadings devolve into wrangling over whether specific factual allegations offered to demonstrate nonuse and intent not to resume use are sufficient to support the abandonment claim.").

Likewise, the Estate of Les Paul's concise abandonment claim both describe the claim and set forth the necessary facts to supports a prima facie case for abandonment, namely, that Gibson has not used LES PAUL as a trademark for a period of more than three years. To the extent that Gibson claims that it has not abandoned any alleged trademark rights and that Gibson is using LES PAUL as a trademark for Applicant's Services, "matters addressing what activities constitute use in commerce under the Trademark Act are best, and traditionally, left to trial." *Id.*

**e. The Estate of Les Paul's Fraud Claims Are Pled with Particularity and Are Legally Sufficient**

Gibson alleges that the Estate of Les Paul has plead an insufficient claim for fraud. The Estate of Les Paul disagrees and has set forth herein more detail why its original claim is sufficiently plead. However, the Estate of Les Paul has also filed the Amended Notice of Opposition to further clarify and expand on its fraud claim.

Federal Rule of Civil Procedure 9(b) governs the standards for sufficiently pleading a fraud claim: "a party must state with particularity the circumstances constituting fraud or mistake. Malice, intent, knowledge, and other conditions of a person's mind may be alleged generally." Fraud occurs during trademark prosecution when the applicant or its representatives knowingly make false, material representations with the intent to deceive the Trademark Office. *In re Bose Corp.*, 91 U.S.P.Q.2d 1938 (Fed. Cir. 2009). Deceptive intent may be established by either direct evidence or inferred from indirect or circumstantial evidence. *Id.* at 1940;

*DaierChrysler Corp. v. American Motors Corp.*, 94 U.S.P.Q.2d, 1086, 1089 (T.T.A.B. 2010). For example, deliberately omitting relevant information may show the necessary element of deceptive intent. *Caymus Vineyards v. Caymus Medical, Inc.*, 107 U.S.P.Q.2d 1519 (T.T.A.B. 2013); *General Electro Music Corp. v. Samick Music Corp.*, 19 F.3d 1405, 30 U.S.P.Q.2d 1149, 1154 (Fed. Cir. 1994) ("[the submission of false or misleading statements] usually will support the conclusion ... of an intentional scheme to deceive the PTO") (internal citation omitted).

In this case, Gibson falsely claimed in its Application that Les Paul, the individual, had consented to Gibson's registration of LES PAUL for its Services. The false consent statement is more than a simple mistake or act of confusion: Gibson acted deliberately to submit a false statement to obtain a registration based on false information. An applicant is not required to enter a consent statement to file an application. In fact, the electronic application form makes clear that "You [the applicant] are not required to enter any other statement(s) at the time of filing". If the applicant chooses to add an additional statement, the applicant must click a box and select from a list of additional statements, and complete the statement.

Gibson had no obligation to include a consent statement with the Application, but took affirmative steps to include a false and misleading consent statement anyways. Gibson's own evidence fails to support its claim that Les Paul the individual consented to Gibson's registration of LES PAUL. The agreement Gibson provided with the consent statement does not consent to Gibson's (or any alleged predecessors) registration for LES PAUL for its Services, or for any charitable services.<sup>1</sup> Gibson's affirmative steps to submit false statement to the USPTO, combined with the deceptive intent to have the USPTO rely on these misstatements, constitutes

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<sup>1</sup> Gibson attached an agreement with its consent statement, which Gibson entitled "Gibson – Agreement – Les Paul Consent". In fact, the agreement is between Les Paul and Norlin Music Industries, Inc. and provides that "Paul hereby grants to and confirms NM's ownership of and exclusive right to use in perpetuity the name and trademark "Les Paul" or any variation thereof in connection with musical instruments and any parts or accessories thereof or products related thereto." See *Application file*.

fraud in the procurement. The Estate of Les Paul has plead these facts in its *Amended Notice of Opposition*, ¶¶ 68-79.

The Amended Notice of Opposition set forth facts that, if proven, would infer intent to deceive the trademark office. The Estate of Les Paul has plead a sufficient claim for fraud. To the extent that Gibson takes issue with the Estate of Les Paul's ability to prove its fraud claim, that is a matter to be addressed at summary judgment or trial after the parties have had a chance to conduct discovery on the issue.

**V. Conclusion**

For the reasons discussed above, the Estate Les Paul's Amended Notice of Opposition states legally sufficient causes of action. Gibson has based its Motion to Dismiss on unsupported factual and legal conclusions, and the Motion to Dismiss is little more than an inappropriate attempt burden the Estate of Les Paul with proving its claims at the pleading stage. The Board has routinely held that a motion to dismiss may only test the legally sufficiency of a complaint. The Estate of Les Paul's ability to prove is claims is a matter for trial and is irrelevant to the legally sufficiency of its pleadings. Accordingly, the Estate of Les Paul respectfully requests that the Board deny Gibson Brands, Inc.'s Motion to Dismiss in full.

Date: November 4, 2019

**Respectfully Submitted,**

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