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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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**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
)	Serial No.: 87978388
v.)	
)	
GIBSON BRANDS, INC.,)	
)	
<i>Applicant.</i>)	

OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO DISMISS¹

Gibson's renewed request for this Board to dismiss the Estate of Les Paul's Amended Complaint fails because the Estate's Amended Complaint pleaded legally sufficient claims. Gibson's motion repeatedly attempts to hold the Estate to a higher standard than is required at the pleading stage. Because the Amended Complaint sufficiently states claims for non-use, non-ownership, abandonment, likelihood of confusion, and fraud, the Board should deny Gibson's motion in its entirety. In the event that the Board determines that any of the claims in the Amended Complaint are deficient, the Estate requests that the Board grant it leave to amend any alleged deficiencies. In support of its position, the Estate of Les Paul respectfully requests that the Board consider the following:

I. Procedural Background

Gibson Brands, Inc. ("Gibson") filed trademark application Serial No. 87978388 for the trademark LES PAUL for "organizing and conducting charity auctions for charitable fundraising purposes") ("Applicant's Services") (" '388 Application"). On January 30, 2019, the Executors of

¹ As discussed in Section II herein, Gibson's November 25, 2019 "Response to Opposer's Motion to Amend its Notice of Opposition" is functionally a motion to dismiss. This submission will therefore serve as the Estate's response to Gibson's motion to dismiss.

the Estate of Les Paul ("the Estate") timely filed a notice of opposition against the '388 Application. Shortly thereafter, the Board instituted Opposition No. 91246161 (the "Opposition"), 2 *TTABVUE* *1. In its Notice of Opposition, the Estate asserted that the Gibson LES PAUL Application should be denied registration due to non-use, non-ownership, abandonment, likelihood of confusion, and fraud. 1 *TTABVUE* *5-9. After several suspensions, the Opposition returned to active status on September 7, 2019, with Gibson's answer due on October 12, 2019. 9 *TTABVUE* *1. Gibson filed a motion to dismiss the Estate's Opposition on October 14, 2019. 10 *TTABVUE* *2.

On November 04, 2019, the Estate simultaneously filed a motion to amend and an amended complaint (the "Amended Complaint")² with a response to Gibson's October 14, 2019 motion to dismiss. The Estate timely filed its Amended Complaint within 21 days after Gibson filed its motion to dismiss. Fed. R. Civ. P. 15(a); TBMP 503.03. Gibson responded to the Estate's Amended Complaint on November 25, 2019.

II. Gibson's November 25, 2019 Filing ("Gibson's Motion") Is Operatively a Motion to Dismiss the Estate of Les Paul's Amended Complaint.

In essence, Gibson's November 25, 2019 filing³ is a motion to dismiss the Estate's Amended Complaint. Accordingly, it should be treated as a second motion to dismiss, and the Estate is entitled to present a response to Gibson's argument. When the opposer files an amended notice of opposition within the time allowed under Rule 15(a)(1), it becomes the operative pleading and renders the opposer's motion to dismiss moot insofar as it applies to the initial notice of opposition. *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925, 1926 (TTAB 2014) (motion to dismiss moot in view of amended pleading filed in response thereto); *Frito-Lay North America, Inc. v. Chef's Touch Sales and Marketing, LLC*, 2018 WL 1417994. As such, any subsequently

² The "Amended Complaint" refers to the Estate's Amended Notice of Opposition filed November 4, 2019.

³ Gibson's November 25, 2019 filing is referred to herein as "Gibson's Motion."

filed motion to dismiss is considered a second motion to dismiss and the operative pleading, rather than a reply in support of the original motion to dismiss.

For example, in *Frito-Lay North America, Inc. v. Chef's Touch Sales and Marketing, LLC*, the opposer filed an amended notice of opposition, and the applicant then filed a response on November 15, 2017. In *Frito-Lay*, the opposer filed a response on November 21, 2017, and the parties disagreed about the nature of the opposer's November 21, 2017 filing. *Id.* In *Frito-Lay* the Board found that because the applicant's November 15, 2017 filing addressed the amended notice of opposition, the filing was functionally a motion to dismiss the amended notice of opposition and the operative motion, rather than a reply in support of the original motion to dismiss. *Id.* Therefore, the Board found that the opposer's November 21, 2017 filing in *Frito-Lay* was a response in opposition to the applicant's November 15, 2017 motion to dismiss the amended notice of opposition, rather than a surreply to the applicant's motion to dismiss the original notice of opposition. *Id.*

Following this line of cases, Gibson's November 25, 2019 filing is a motion to dismiss the Estate's Amended Complaint. Although Gibson's titled its November 25, 2019 filing "Applicant's Response to Opposer's Motion to Amend Its Notice of Opposition," the filing did not, in fact, respond to the Estate's Motion to Amend. The filing did not allege that the Estate was not entitled to file the Amended Complaint, or that the motion and Amended Complaint were untimely. Rather, Gibson's November 25, 2019 filing asks that the Board dismiss the Amended Complaint pursuant to Federal Rule of Civil Procedure 12(b)(6) and Section 503.01 of the TBMP, which both concern failure to state a claim upon which relief can be granted. 14 *TTABVUE* *2. Likewise, the conclusion of Gibson's November 25, 2019 filing requests that "the Board dismiss the entirety of Opposer's claims (and therefore the ***Amended Opposition***) for failing to state a claim upon which

relief can be granted." 14 *TTABVUE* *10 (emphasis added). Accordingly, Gibson's November 25, 2019 filing should be treated as a new motion to dismiss the Amended Complaint and the operative motion, rather than a reply brief in support of Gibson's original motion to dismiss.

Further, Gibson's November 25, 2019 Motion addresses new claims that the Estate added in its Amended Complaint. For example, Gibson's Motion addresses paragraphs 37-40 of the Amended Complaint, which the Estate added to provide further specificity to its non-use claims. 14 *TTABVUE* *4-5. Gibson's Motion also addresses the amended fraud claim in the Amended Complaint, which provides additional factual assertions to support the claim. 14 *TTABVUE* *7-10. As Gibson's Motion addresses the substance of the Amended Complaint and requests dispositive relief, the filing is functionally a motion to dismiss the Amended Complaint and the Estate is entitled to respond to the filing.

III. Standard of Law for a Motion to Dismiss

A motion to dismiss under Rule 12(b)(6) is only appropriate when the claims in the complaint are legally insufficient. 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 opposer 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. Knowlux 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 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 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. GIBSON'S MOTION SHOULD BE DENIED IN FULL.

Each of Gibson's arguments seek to impose a greater burden on the Estate than is required at the motion to dismiss stage. Because the Estate has adequately pleaded facts that are legally sufficient to support its claims of non-use, non-ownership, abandonment, likelihood of confusion, and fraud, the Board should deny Gibson's Motion and allow the parties to proceed to discovery.

a. The Estate of Les Paul Has Stated a Non-Use Claim on Which Relief Can Be Granted

The Estate has stated a non-use claim for which relief can be granted, and the Board should deny Gibson's Motion to Dismiss this claim. A motion to dismiss is only appropriate "to test the legal theory of the complaint, *not the sufficiency of any evidence that might be adduced.*" See *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993) (emphasis added); *see also* 5A Wright & Miller, *Federal Practice And Procedure: Civil 2d* § 1357 (1990). To test the legal sufficiency of the complaint, the Board must accept all of the Estate's well-pleaded allegations as true, and construe the Amended Complaint in the light most favorable to the Estate. *Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2d (T.T.A.B. 2007); 5A Wright & Miller, *Federal Practice And Procedure: Civil 2d* § 1357 (1990). As a threshold matter, the actual issue of use in commerce is an issue of fact which is not properly resolved on a motion to dismiss: "[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 plaintiff can actually prove its allegations is matter to be determined not upon motion to dismiss, but rather at final hearing or upon summary judgment.*" TBMP 503.02. See also *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1874 (TTAB 2011).

In this case, the Estate objected to the '388 Application on the grounds that Gibson has not used LES PAUL as a trademark in connection with the services identified in the '388 Application. Because Gibson filed the '388 Application under Section 1(a) of the Trademark Act, Gibson must have actually used the trademark in commerce in connection with the services identified in the '388 Application as of the application filing date. *Grand Canyon West Ranch, LLC v. Hualapai Tribe*, 78 U.S.P.Q.2d 1696, 1698 (T.T.A.B. 2006) ("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."'). If Gibson has not used the mark on any of the services identified in the '388 Application, 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."').

The Estate alleged sufficient facts to support its non-use claim. For example, the Estate asserts in the Amended Complaint that the Mecum Auction Company organized and conducted the auction (the "Curing Kids Cancer Auction") referenced in the specimen of use submitted with the '388 Application (the "Specimens of Use"). 12 *TTABVUE* *12. The Amended Complaint also states that Gibson did not organize or conduct the Curing Kids Cancer Auction. *Id.* The Specimens of Use refers to Curing Kids Cancer Auction as the "Mecum Auctions on May 17" and the "stunning Mecum Auction." The Specimens of Use goes on to say that "Curing Kids Cancer raises money through partnerships with [...] the powerhouse Mecum Auction company," but does not mention any partnership between Gibson and Curing Kids Cancer. Therefore, the Specimens of Use actually show that Mecum Auction Company, not Gibson, organized and conducted the Curing Kids Cancer Auction. And, for the purposes of evaluating a motion to dismiss and the legal sufficiency of a complaint, the Board must accept these allegations as true. *Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2d (T.T.A.B. 2007); 5A Wright & Miller, *Federal Practice And Procedure: Civil 2d* § 1357 (1990).

The dispute over who has trademark rights to the Curing Kids Cancer Auction in itself is enough to defeat Gibson's Motion. Despite this clear factual dispute, Gibson continues to argue that its mark is "clearly" in use. Gibson's Motion states that it organized and conducted the charity auction and that "it is abundantly clear that the specimens show Applicant's LES PAUL mark used in commerce." 14 TTABVUE *5. However, these claims in Gibson's Motion rely on factual allegations and information outside of the Specimen of Use, including dictionary definitions that Gibson asks the Board to accept as dispositive. Gibson's allegations test whether the Estate can ultimately succeed on this claim, rather than focusing on whether it is legally sufficient, which is the appropriate analysis for a motion to dismiss. *Id.* And, there is a dispute regarding whether Gibson's mark is "clearly" in use as it alleges. Gibson does not deny that other parties were involved in the alleged auction, and there is evidence to suggest that Gibson did not actually organize the auction. The Estate is entitled to discovery to assess the factual allegations included in Gibson's Motion, determine the role of Mecum Auction in the Curing Kids Cancer Auction, and evaluate whether Gibson was, as it alleges, in control of the use of LES PAUL as a trademark at the Curing Kids Cancer Auction. As it stands, Gibson's argument would lead to the absurd result that any sponsor, donor, or party advertising at an event could claim trademark rights to the event itself. Not only that, but accepting Gibson's argument would mean that an opposer could not litigate past the pleadings stage to challenge such an assertion. However, those are all issues for trial after a full and fair opportunity for discovery.

Following the applicable law on a motion to dismiss, the Board should deny Gibson's Motion on the non-use claim because the Estate has indeed alleged sufficient allegations to withstand the Motion. Here, the Estate alleged that as of the date of filing the Application, Gibson had not used LES PAUL as a trademark in connection with Gibson's services and that Gibson is

not and has not used LES PAUL in connection with Gibson's Services. 12 TTABVUE ¶¶47-48. The Estate also detailed why Gibson's Specimen of Use did not show use in commerce as required for trademark registration. 12 TTABVUE ¶¶31-49. These allegations are enough to show that the Estate believes Gibson has not used LES PAUL as a trademark in commerce in connection with the goods identified in the '388 Application, which is the relevant analysis for the Board at this stage. The parties have not been able to conduct discovery on this issue, and a Motion to Dismiss is not the proper format to dispute factual issues raised in the Amended Complaint. Accordingly, the Board should deny Gibson's Motion to Dismiss the non-use claim.

b. The Estate Has Stated a Non-Ownership Claim for Which Relief Can Be Granted.

Gibson's arguments related to its non-ownership claim fail for the same reasons outlined above for the non-use claim. As discussed above, the Estate has pleaded 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 LES PAUL as a trademark in connection with Applicant's Services, or Gibson cannot show priority of use, then Gibson does not own rights to the LES PAUL trademark for the Applicant's Services and the Board should deny registration for that Application.

In addition to Gibson's non-use of the LES PAUL mark, the Estate properly pleaded priority. As Gibson admits in its Motion, it is priority of trademark use that confers ownership upon the user. 14 TTABVUE *4. The Estate may and did rely on a registration as a basis for priority: Section 2(d) of the Trademark Act provides that an applicant can register a mark unless it: "consists of or comprises a mark which so resembles a mark **registered in the Patent and Trademark Office**, or a mark or trade name previously used in the United States by another and not abandoned." 15 U.S.C. § 1052(d); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d

1400, 182 USPQ 108, 110 (CCPA 1974) (explaining that applicant is not entitled to registration if the applied for mark is likely to cause confusion with either: (1) a previously registered mark; or (2) a previously-used-but-unregistered mark); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1436 n.7 (TTAB 2012) ("In view of opposer's ownership of valid and subsisting registrations [...]", opposer's priority is not in issue with respect to the goods identified in those registrations). In this case, the Estate properly pleaded its valid and subsisting trademark Registration No. 5193825 for LES PAUL and Design, which predates the '388 Application.

The Estate has also properly pleaded priority based on common law rights. In its Amended Complaint, the Estate alleged that "Opposer's use of LES PAUL for Opposer's Services predates any of Applicant's alleged use of LES PAUL as a trademark in connection with Applicant's Services." 12 *TTABVUE* ¶ 28. This is a plainly stated claim which, if proven, would establish that the Estate owns the LES PAUL trademark and that Gibson is not entitled to trademark registration for its Application.

Gibson's arguments regarding the Estate's alleged failure to plead a specific date of first use also fails. The Trademark Trial and Appeal Board has held that priority may be sufficiently pleaded, even if the opposer does not list a specific priority date. For example, in *5M USA, Inc. v. Her Second Act LLC*, the Board found that the opposer had properly pleaded priority by asserting in its complaint that: "Applicant cannot claim a priority date for the goods and services covered in the application[s] that precedes that of Opposer." *5M USA, Inc. v. Her Second Act LLC*, 2019 WL 3852811, Opposition No. 91245484 (T.T.A.B. 2019). In *5M*, the Board emphasized that "whether [o]pposer can prove prior common law rights as pleaded in the notice of opposition is an issue for trial," rather than an issue for consideration on a motion to dismiss. *See also IRUN & Company, LLC v. Jamie Mastroianni*, 2016 WL 6833522, Cancellation No. 92062734 (T.T.A.B. 2016)

("Inasmuch as Petitioner alleges that its mark was in use 'prior to the filing of the application for Respondent's registration and prior to Respondent's adoption of the mark' and that use of Respondent's mark 'is likely to cause confusion or mistake in the market,' the ground is properly pleaded").

Just as the opposer sufficiently pleaded priority in *5M USA* without a specific date of first use for its common law rights, so too the Estate has established a plausible claim for priority that would entitle it to relief. Gibson complains that it does not have fair notice without a certain date of first use,⁴ but the Board's prior decisions have established that similar priority claims are sufficient for pleading. Further, Gibson has the full and fair opportunity to discover issues related to first use and continuous use during discovery. As such, the Board should deny Gibson's Motion to Dismiss this claim and allow the parties to proceed to discovery.

c. The Estate's Abandonment Claim Is Sufficiently Pleaded.

Gibson also objects to the condense nature of the Estate's abandonment claims, but there is nothing improper about a short, plain set of pleading that adequately set forth the elements of a claim. 14 *TTABVUE* *7. Indeed, the Estate 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

⁴The Estate notes that many notices of opposition claim priority without indicating specific dates of first use. In addition to the *5M USA* case, which the Board found to be an acceptable priority claim, Gibson itself has previously alleged priority and first use without indicating the specific date of first use, including its Opp. No. 91235405 against the Estate.

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 are appropriately addressed during trial, not 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."); *see also SaddleSprings Inc. v. Mad Croc Brands Inc.*, 104 USPQ2d 1948, 1950 (TTAB 2012) ("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."); *Toufigh v. Persona Parfum Inc.*, 95 USPQ2d 1872, 1875 (TTAB 2010) ("There are two elements to an abandonment claim: nonuse and an intent not to resume use.")

Likewise, the Estate'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." *Lewis Silkin*, 129 U.S.P.Q.2d at 1027. Therefore, the Board should deny Gibson's Motion to Dismiss for the abandonment claim.

d. The Estate has Adequately Pleaded a Claim for Likelihood of Confusion.

For the same reasons stated in response to the non-ownership claim, Gibson's argument against the Estate's likelihood of confusion claim fails because the Estate does not have to allege a specific date of first use to proceed past a motion to dismiss stage. In both the original Complaint and Amended Complaint, the Estate has pleaded sufficient facts to support a claim for likelihood of confusion. As such, Gibson's Motion to Dismiss this claim should be denied.

Gibson's only argument against the likelihood of confusion claim is that the Estate "has not alleged a date (or window of time more narrow than 94 years), on which it establishes its priority of use." 14 *TTABVUE* *7. However, the Estate need only plead that it has a valid and subsisting registration, and/or senior trademark rights, and that the applied-for mark, when used in connection with the goods or services identified in the application, it is likely to cause confusion with its mark. Here, the Amended Complaint sets forth facts sufficient to establish a claim for likelihood of confusion. 12 *TTABVUE* ¶¶ 26, 61. For example, the Estate claims:

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.

Id.

And, as addressed in its priority arguments, the Estate does not need to plead an exact date of first use to sufficiently allege likelihood of confusion. *5M USA, Inc. v. Her Second Act LLC*, 2019 WL 3852811, Opposition No. 91245484 (T.T.A.B. 2019).

Because the Estate sets forth sufficient facts to establish a claim for likelihood of confusion, the Board should deny Gibson's Motion to Dismiss the likelihood of confusion claim.

e. The Estate's Fraud Claim Survives the Amended Motion to Dismiss.

Gibson's Motion to Dismiss the fraud claim fails because the Estate properly pleaded its claim with particularity, alleged that Gibson made a knowingly false material representation, and alleged that Gibson intended to deceive the USPTO.

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).

i. The Estate specifically pleaded that Gibson made a knowingly false material representation or statement to the USPTO.

Gibson's argument that the Estate failed to plead that Gibson made a knowingly false material representation or statement to the USPTO is fatally flawed for one major reason – the

Estate literally pleaded that Gibson made a knowingly false material representation to the USPTO.

For example, the Estate alleged in the Amended Complaint that:

77. Applicant made false statements as to its ownership of the mark and Applicant's use of the LES PAUL mark for Applicant's Services, as well as the first use dates of that mark, with intent to procure a registration to which Applicant was not entitled.

78. Applicant falsely stated that Les Paul, the individual, had consented to Applicant's registration of LES PAUL for the Applicant's Services (the "False Consent Allegation").

81. Applicant's false statements were made knowingly and with intent to deceive the Trademark Office.

82. Applicant made knowing, false statements as to the ownership and use of the mark "LES PAUL" for the services identified in the Application, with the intent to procure a registration to which the Applicant was not entitled.

12 *TTABVUE* ¶¶ 77-82.

These allegations establish a legally sufficient claim for fraud by themselves. The Estate identified the material false representations, that the material false representations were knowingly made, and that they was made to the USPTO. Not only were the false representations made and appropriately alleged, but there is evidence Gibson went out of its way to take affirmative steps to defraud the office. Gibson had no obligation to include a consent statement with the Application. And, the 1977 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.⁵ Instead, the Agreement clearly defines the rights Les Paul granted to Gibson, which notably do not include the services outlined in Gibson's Application. Gibson's improper, misleading, and overreaching interpretation of the Agreement cannot form the basis for a

⁵ 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*.

successful motion to dismiss. As such, the Board should deny Gibson's Motion to Dismiss the fraud claim.

ii. The Estate specifically pleaded that Gibson intended to deceive the USPTO.

Similarly, the Estate specifically pleaded that Gibson intended to deceive the USPTO in its Amended Complaint. In addition to the allegations listed above, the Estate alleged:

77. Applicant made false statements as to its ownership of the mark and Applicant's use of the LES PAUL mark for Applicant's Services, as well as the first use dates of that mark, with intent to procure a registration to which Applicant was not entitled.

78. Applicant falsely stated that Les Paul, the individual, had consented to Applicant's registration of LES PAUL for the Applicant's Services (the "False Consent Allegation").

79. Applicant submitted the False Consent Allegation with intent to deceive the examiner and procure a registration to which Applicant was not entitled.

81. Applicant's false statements were made knowingly and with intent to deceive the Trademark Office.

82. Applicant made knowing, false statements as to the ownership and use of the mark "LES PAUL" for the services identified in the Application, with the intent to procure a registration to which the Applicant was not entitled.

12 *TTABVUE* ¶¶ 79-82.

These allegations, accepted as true, are sufficient to establish a claim for fraud. And, as stated above, Gibson affirmatively made these false statements to the USPTO when it was not required. These allegations are also adequate to establish deceptive intent, especially given Gibson's deliberate attempt to misrepresent material facts to the USPTO. *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). Because the Estate has clearly

pleaded both that Gibson made a knowingly false material representation and intended to deceive the USPTO, the Board should deny Gibson's Motion to Dismiss the fraud claim.

V. Conclusion

For the reasons discussed above, the Estate's Amended Complaint 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 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's ability to prove its 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 the Amended Complaint in full. In the event that the Board finds any of the claims in the Amended Complaint to be deficient, the Estate of Les Paul respectfully requests that the Board grant leave to amend and address any alleged deficiencies.

Date: December 16, 2019

Respectfully Submitted,

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**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
)	Serial No.: 87978388
v.)	
)	
GIBSON BRANDS, INC.,)	
)	
<i>Applicant.</i>)	
_____)	

CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of the Estate of Les Paul's Response Gibson's November 25, 2019 filing was served by e-mail this 16th day of December, 2019:

On the following:

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Respectfully Submitted,

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