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

Proceeding	91246161
Party	Defendant Gibson Brands, Inc.
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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 *Opposer,* *v.* GIBSON BRANDS, INC., *Applicant.*	Opposition No.: 91246161 App. No.: 87/978,388

APPLICANT'S REPLY IN SUPPORT OF MOTION TO DISMISS

Pursuant to Rule 502.02(b) of the Trademark Trial and Appeal Board Manual of Procedure ("TBMP"), Gibson Brands, Inc. ("Gibson" or "Applicant") submits this reply in support of its Motion to Dismiss ("Motion") filed on November 25, 2019.

I. INTRODUCTION

On January 3, 2020, the Board accepted as the operative pleading Opposer's Amended Notice of Opposition (the "Opposition") against Application No. 87/978,388 (the "Application") filed on November 4, 2019. On November 25, 2019, Applicant filed a Motion to Dismiss the Opposition (the "Motion to Dismiss"). On December 16, 2019, Opposer filed a Response to Applicant's Motion to Dismiss (the "Response"). Applicant hereby submits this Reply in Support of its Motion to Dismiss filed on November 25, 2019.

II. ARGUMENT

Applicant maintains the arguments submitted in the Motion to Dismiss. Opposer's non-use, non-ownership, fraud, likelihood of confusion, and abandonment claims are insufficiently pled and should be dismissed. By this Reply, Applicant addresses the alleged deficiencies raised in Opposer's Response.

A. Opposer's Non-Use Claim Fails

The Board should dismiss Opposer's non-use claim because it fails to state a claim for which relief can be granted. The use in commerce requirement is met for service marks when a mark is "used or displayed in the sale or advertising of services" and the services are "rendered in commerce." Trademark Act Sec. 45, 15 U.S.C. § 1127; *Aycock Eng'g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 90 USPQ2d 1301, 1305 (Fed. Cir. 2009).

The Opposition is marginally improved over Opposer's initial attempt; however, it is still insufficient regarding its non-use claim. To bolster its claim, Opposer names a third-party partner as the actual organizer and conductor of the auction shown in Applicant's specimen. Opposer then asserts that because an article submitted with the Specimen did not mention Applicant, then the conclusion follows that Applicant did not use its trademark. Opposer even goes so far as to call into question the plain dictionary meaning of the commonly-used word "organize." Gibson shows that under the commonly accepted definitions of "organize" it has used its mark as shown in the specimen.

Curiously, Opposer asserts that "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." 16 *TTABVUE* *8. Were the Board to allow Opposer's non-use allegation to stand, this proposed absurd result would happen – Gibson would not be able to assert trademark rights in its own event.

B. Opposer's Fraud Claim Fails

As Gibson stated in its Motion, courts generally disfavor claims of fraud, and that to prevail on a fraud claim, "Petitioner must show, by clear and convincing evidence, that Registrant: 1) knowingly made a false, material representation; and 2) made such statement with the intent to deceive the USPTO. In re Bose Corp., 580 F.3d 1240, 1243-44 (Fed. Cir. 2009); see also 15 U.S.C. § 1064(3) (stating a registered mark can be cancelled if the registration was obtained fraudulently).

To meet its burden to support its fraud allegation, Opposer wrongly alleges Applicant knowingly made false statements to the USPTO. The fact that a statement may be false will not constitute a fraud unless it can be shown that the applicant or registrant had the requisite willful intent to deceive. *Bose*, 580 F.3d at 1246. Regrettably for Opposer, the statements submitted by Gibson were not false. Further, Gibson's statements in prosecuting the Application were made in good faith to show its mark used with the services stated in its registration. Opposer's allegations to the contrary are weak and do not state a claim upon which relief can be granted. As stated above, and in Gibson's Motion, Opposer fails to meet the burden of proving Gibson submitted a false statement to the USPTO, with the requisite intent to deceive, and therefore its claim for fraud on the USPTO should be dismissed.

C. The Board Should Not Grant Leave to Amend

TBMP 503.03 indicates that there are indeed limits to when the Board may grant leave to amend a pleading. Specifically, where justice does not require that leave to amend be given, the Board, in its discretion, may refuse to allow an opportunity for amendment. "In deciding whether to grant leave to amend, the Board may consider undue delay, prejudice to the opposing party, bad faith or dilatory motive, futility of the amendment, and whether the party has previously amended its pleadings." *Embarcadero Technologies, Inc. v. Delphix Corp.,* 117 USPQ2d 1518, 1523 (TTAB 2016). "In determining whether the other party would be prejudiced by allowance of the proposed amendment, the timing of the motion for leave to amend plays a large role." *Id.* (citing *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1486 (TTAB 2007)). The Opposition falls short of pleading requirements as set forth in Gibson's Motion as well as this Reply in support thereof. To allow Opposer leave to amend would be highly prejudicial to Gibson and should thus be denied.

III. CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the Board grant the Motion to Dismiss for failing to state a claim upon which relief can be granted. Respectfully submitted this 6th day of January 2020.

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CERTIFICATE OF SERVICE

The undersigned attorney hereby certifies that a true and correct copy of the foregoing Reply in Support of Motion to Dismiss has been served, via email, on the 6th day of January 2020 to:

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