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

Proceeding	91251946
Party	Defendant JOHN GEIGER COLLECTION LLC
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Submission	Motion to Dismiss - Rule 12(b)
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Attachments	TTAB Motion to Dismiss-John Geiger.pdf(150056 bytes )

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

Re: Application Serial No. 88330617  
Published on October 1, 2019

Opposition No. 91251946

Kurt Geiger Limited

Opposer

v.

John Geiger Collection LLC

Applicant.

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**NOTICE OF APPEARANCE AND  
APPLICANT’S MOTION TO DISMISS OPPOSER’S NOTICE OF OPPOSITION**

**PLEASE TAKE NOTICE** that HEITNER LEGAL, P.L.L.C., hereby provides Notice of Appearance as counsel for Applicant, John Geiger Collection LLC, (“Applicant”), and requests that all notices and papers be served upon the following: (i) [darren@heitnerlegal.com](mailto:darren@heitnerlegal.com); and (ii) [alan@heitnerlegal.com](mailto:alan@heitnerlegal.com).

Furthermore, Applicant, by and through undersigned counsel and pursuant to Fed. R. Civ. P. 12(b)(6), hereby files this Motion to Dismiss Opposer’s, Kurt Geiger Limited (“Opposer”), Notice of Opposition (“Motion to Dismiss”), and, in support thereof, states as follows:

**OVERVIEW**

1. On October 30, 2019, Opposer filed a Notice of Opposition regarding Applicant’s application for the mark JOHN GEIGER regarding the following goods and services: IC 025 – (Based on Use in Commerce) Shirts; Shoes; Socks; Sweat shirts; Hooded sweat shirts; Leather shoes (Based on Intent to Use) Jeans; Pants; Ankle socks; Denim jeans; Jogging pants; Sports pants.

2. Opposer's Notice of Opposition alleges likelihood of confusion with Opposer's registered mark KURT GEIGER for, *inter alia*, the following goods and services: (i) IC 009 – Magnetically encoded credit cards, debit cards, reward cards, and payment cards; blank magnetic cards; blank smart cards; magnetically encoded bank cards; [blank magnetic data carriers; blank record discs; pre-recorded cd's, cd-rom's, audio tapes and video discs featuring music;] sunglasses; spectacles; sunglasses and spectacles cases and frames; [contact lenses and contact lens containers; protective footwear]; (ii) IC 018 – Leather and imitations of leather; goods made of leather and imitations of leather, namely, [attache cases, leather trunks, suitcases, briefcases, briefcase-type portfolios, key cases,] credit card holders, shoulder bags, rucksacks, back packs, [garment bags for travel, vanity cases sold empty;] cosmetic cases sold empty; [carry on bags;] handbags, purses and wallets; [leather jewelry rolls and pouches;] and bags made of fabric, namely, shoulder bags, rucksacks, back packs, [garment bags for travel, carry on bags] and handbags [; umbrellas, parasols and walking sticks]; (iii) IC 025 – Clothing, namely, [dresses, suits, coats, jackets, pants, skirts, shirts, blouses, sweaters, belts, hosiery, nightwear, bathrobes, dressing gowns, shorts,] scarves, [gloves, t-shirts, rugby shirts, cardigans, clothing for sport and gymnastics, namely, leotards, unitards, sweatsuits, jogging suits, tracksuits, headbands, sports bras and tops; shawls and pashminas;] headwear, namely, hats and caps; footwear; shoes, boots, slippers and sandals; and (iv) IC 035 – Retail services, namely, retail store services, mail-order catalog retail services and on-line retail store services, featuring [cosmetics, toiletries, perfumery products and essential oils, hair care and hair coloring products, dentifrices, shoe care products, jewellery, clocks and watches,] sunglasses, spectacles, [contact lenses and containers and cases for sunglasses, spectacles and contact lenses,] leather goods, handbags, purses and wallets, [luggage and travelling bags, umbrellas, clothing, footwear, headgear and belts; advice and

assistance in the selection of goods of others, namely, comparison shopping services; advertising and promotional services; customer loyalty services for commercial, promotional and advertising purposes;] the bringing together, for the benefit of others, of a variety of goods, namely, [cosmetics, toiletries, perfumery products and essential oils, hair care and hair colouring products, dentrices, shoe care products, jewellery, clocks and watches,] sunglasses, spectacles, [contact lenses and containers and cases for sunglasses, spectacles and contact lenses,] leather goods, handbags, purses and wallets, [luggage and travelling bags, umbrellas, clothing,] footwear, [headgear and belts,] enabling customers to conveniently view and purchase those goods in a retail store environment, by mail-order or via a global communications system.

3. For the reasons set forth below, Applicant requests that Opposer's Notice of Opposition be dismissed with prejudice.

## ARGUMENT

### **A. Legal Standard (Motion to Dismiss)**

Under Fed. R. Civ. P. 12(b)(6), a motion to dismiss is a test of the sufficiency of the complaint. *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993); *Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1697 (TTAB 2014). To survive a motion to dismiss, the opposer must allege sufficient factual content that, if proved, would allow the Board to conclude, or to draw a reasonable inference, that (1) the opposer has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought or for cancelling the involved registration. *See Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780, 1782 (TTAB 2012) (citing *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998)); *see also Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). In other

words, the complaint must be sufficient in order to allow the Board to determine whether the opposer's belief "is not wholly without merit." See *Lipton*, 213 USPQ at 189.

The complaint "must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). In particular, the opposer must allege well-pleaded factual matter and more than "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements," to state a claim plausible on its face. *Id.* (citing *Twombly*, 550 U.S. at 555).

**B. Opposer Does Not Have Sufficient Legal Grounds to Oppose Applicant's Trademark Based On Likelihood of Confusion.**

Applicant's Motion to Dismiss is a test solely of the legal sufficiency of Opposer's Notice of Opposition. See *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992). In order to adequately plead likelihood of confusion, Opposer must allege (i) it has priority of use and (ii) that Applicant's mark so resembles Opposer's mark as to be likely to cause confusion. See Lanham Act Section 2(d), 15 U.S.C. § 1052(d); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). In considering likelihood of confusion, "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). As noted in previous decisions rendered by the TTAB, similarity of marks is incapable of being premised solely on a surname for the purpose of refusing registration of a trademark.

In *Nina Ricci S.A.R.L. v. E.T.F. Enterprises, Inc.*, 1988 WL 252320, 9 USPQ2d 1061 (TTAB 1988), the Board reviewed opposition of an application to register the mark VITTORIO

RICCI based on the opposer's prior registration of the mark NINA RICCI. As grounds for opposition, the opposer asserted, *inter alia*,: (i) its use of NINA RICCI predates applicant's use of VITTORIO RICCI; (ii) opposer has also used the marks MADEMOISELLE RICCI, SIGNORICCI and CAPRICCI for the sale of goods and services and RICCI is the single unifying name and the dominant and most significant name identifying and characterizing all of opposer's marks; and (iii) the mark NINA RICCI has acquired goodwill and fame. In dismissing the opposition based on declaring no likelihood of confusion, the Board noted that even though some of the parties' goods and services were identical or highly related (and therefore substantially similar), the marks were substantially different. Specifically, the Board stated:

... both parties use the surname Ricci, a relatively common Italian surname, with different first names. **These names, NINA and VITTORIO, have obvious differences in sound, appearance and connotation**, opposer's mark being the name of a woman while applicant's mark is of the masculine gender. **Moreover, we note that, despite contemporaneous use of the respective marks on similar if not identical products for at least ten years, there have been no reported instances of actual confusion.** Finally...if charged with considering equitable factors, [the court] would find that applicant adopted its mark in good faith and without intent to capitalize on opposer's marks. Accordingly, we believe that confusion is unlikely.

(emphasis added). *Id.* at \*5. This matter is substantially similar. While Applicant and Opposer's respective mark share the same surname (GEIGER), such right does not give Opposer carte blanche to exclusively utilize the term GEIGER in commerce, especially when taking into account: (i) Applicant's Notice of Opposition does not state or imply that GEIGER is an uncommon surname, and (ii) Applicant's application expressly states, "The name(s), portrait(s), and/or signature(s) shown in the mark identifies 'John Geiger', whose consent(s) to register is made of record." As such, the primary term of each mark – KURT for Opposer and JOHN for Applicant – must be analyzed to determine if any legal similarity exists between it in order to allege likelihood of confusion. As in *Nina*, these names are substantially different in sound,

appearance, and connotation; specifically: (i) these marks are phonetically dissimilar, (ii) do not contain any similar lettering, and (iii) do not share any possibility of being pronounced the same or viewed in the light by a reasonable consumer as constituting the same source of goods and services. This substantial dissimilarity is already made known based on the fact that the Examining Attorney did not find a likelihood of confusion between the marks, despite being obligated to render any doubt in review in favor of Opposer.

For the reasons set forth in *Nina*, Opposer's Notice of Opposition should be dismissed with prejudice. While *Nina* was subsequently overturned by the United States Courts of Appeals, Federal Circuit, the reasons set forth in the subsequent court decision is not applicable to the matter at hand. Therein, the court stated the **"Board failed to consider the other marks of opposer and their effect on the similarity or dissimilarity of ETF's mark. These marks, MADEMOISELLE RICCI, SIGNORICCI and CAPRICCI, according to Nina Ricci, indicate that the RICCI surname is a unifying name in opposer's marks and is the dominant and significant part of opposer's marks in identifying its goods."** See *Nina Ricci, S.A.R.L. v. E.T.F. Enterprises, Inc.*, 12 USPQ2d 1901, 889 F. 2d 1070, 1073 (Fed. Cir. 1989).

Opposer does not have any additional marks in order to assert that a "unifying name" exists in identifying its goods. Opposer is the registrant of one mark for its goods and services, and therefore does not fall under the umbrella of the federal ruling.

Another case of similar import is *Elizabeth Arden Sales Corporation v. Kinney Shoe Corporation*, 1969 WL 9062, 161 USPQ 543 (TTAB 1969), wherein the Board dismissed a proceeding alleging likelihood of confusion between ELIZABETH ARDEN and NANCY ARDEN. Specifically, the Board stated:

It is apparent that the marks "NANCY ARDEN" and "ELIZABETH ARDEN" are both fanciful names bearing the same surname "ARDEN". This is a

commonplace surname which, as the record shows, others engaged in the manufacture and/or sale of wearing apparel have utilized in association with different baptismal names to create fanciful names as trademarks for their products. **Under these circumstances and considering that people are accustomed to distinguish between persons having identical surnames by their baptismal names, it is reasonable to assume...that the purchasing public would be likely to rely upon the marks herein involved in their entirety in identifying the respective goods as to source. When the marks “NANCY ARDEN” and “ELIZABETH ARDEN” are so viewed, it is our opinion that the distinctly different baptismal names are sufficient to render the marks as a whole registrably distinguishable and to avoid confusion or mistake in trade as to the producer of the goods sold thereunder.**

(emphasis added). *Id.* at \*3. Based upon the above, the substantial dissimilarities between the parties’ primary names – KURT and JOHN – are sufficient to defeat any notion of likelihood of confusion. Moreover, the USPTO currently shows multiple registrations for marks including the surname “GEIGER” for use with substantially similar goods as those provided by the parties – specifically (excluding Opposer and Applicant):

- WILLIS & GEIGER – Registration No. 1394814 (registered May 27, 1986) (there exists two pending applications as well);
- GEIGER – Registration No. 1059359 (registered February 15, 1977); and
- GEIGER – Registration No. 2511506 (registered November 27, 2011).

Such existing, multiple registrations further lend to Opposer’s inability to legally preclude Applicant from seeking registration of its mark. *Id.* (discussing multiple registrations including the surname “ARDEN” and stating, “These registrations [show] that a registration of a name containing the surname ‘ARDEN’ was no bar to the subsequent registration of other marks in the same field consisting of the surname ‘ARDEN’ in association with different baptismal names.”). Thus, the dissimilarity between KURT and JOHN and the inability to allege or show likelihood of confusion based solely on a surname renders Opposer’s Notice of Opposition legally insufficient for the purpose of opposing Applicant’s mark and is therefore wholly without merit.



**CONCLUSION**

Based on the foregoing, Applicant respectfully requests that the Board grant Applicant's Motion to Dismiss, and grants such other relief as the Board deems just and appropriate.

December 9, 2019

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that on this 9th day of December, 2019, a copy of the foregoing was sent via email to Applicant's Attorney of Record, addressed as follows:

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