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

Proceeding no.	91265679
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Gavrieli Brands LLC, Opposer, v. Camilla Gabrieli, Inc., Applicant.	Opposition No.: 91265679 Marks: CAMILLA GABRIELI Ser. No.: 88/824,973
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MOTION TO DISMISS COUNTERCLAIM

Pursuant to TBMP § 506.01 and Federal Rules of Civil Procedure 12(b)(6), Gavrieli Brands LLC (“Opposer” or “Gavrieli”), hereby moves to dismiss Camilla Gabrieli, Inc.’s (“Applicant”) counterclaim for cancellation based on fraud and mere surname use, as set out in Applicant’s Amended Answer and Affirmative Defenses to Notice of Opposition and Counterclaim to Cancel Opposer’s Registered Marks (Applicant’s Amended Counterclaim) (Dkt. 23).

I. Introduction

In response to the Opposition filed to protect Opposer’s well-known GAVRIELI mark, Applicant filed a counterclaim for cancellation based on alleged abandonment, fraud, and that the GAVRIELI mark was allegedly primarily merely a surname (Dkt. 17). After Opposer filed a motion to dismiss for failure to plausibly plead any of these causes of action (Dkt. 19), the Board dismissed Opposer’s counterclaim (Dkt. 22). Applicant has filed its Amended Counterclaim for cancellation based on fraud or that the GAVRIELI mark is a mere surname, but once again fails to allege facts sufficient to support the required elements or to provide a plausible claim. With

respect to the fraud claim, Applicant has also failed to meet the heightened pleading standards. As set out more fully below, Applicant's counterclaim based on fraud and mere surname allegations should be dismissed.

II. Background

Opposer is a well-known fashion company that, since at least as early as December 2009, has marketed and sold footwear bearing the GAVRIELI mark, and since that time has expanded its offerings under the GAVRIELI mark to include bags, and other goods and services. Shoes bearing the GAVRIELI mark have been immensely popular, with sales across the country as well as around the world. Opposer's rights in and to the GAVRIELI trademark are embodied, in part, in its incontestable United States Trademark Registration, Reg. No. 3,947,480 in connection with "footwear." Opposer also owns United States Trademark Reg. No. 5,880,321 for GAVRIELI in connection with "online retail store services featuring handbags and footwear" and United States Trademark Reg. No. 6,205,921 for GAVRIELI in connection with "apparel, namely, shirts." On March 6, 2020, Applicant filed an application for CAMILLA GABRIELI in connection with "footwear, shoes." Opposer timely filed this Notice of Opposition against registration of Applicant's mark.

Applicant's counterclaim for cancellation should be dismissed for failure to state a claim (fraud and mere surname claims) and failure to meet the heightened pleading standards set forth in Rule 9(b) of the Federal Rules of Civil Procedure (fraud claim).

III. Argument

Applicant's counterclaim to cancel Gavrieli's marks in Class 25 at Reg. No. 3,947,480 and Reg. No. 6,205,921 and in Class 35 at Reg. No. 5,880,321 (collectively, "Opposer's Registered Marks") should be dismissed because Applicant has failed to adequately plead fraud

in registering or prosecuting the application for Reg. No. 3,947,480 or that the Opposer's GAVRIELI mark as registered under Reg. Nos. 5,880,321 and 6,205,921 operates primarily as a mere surname.¹

A Fed. R. Civ. P. 12(b)(6) motion to dismiss for failure to state a claim upon which relief can be granted tests the legal sufficiency of the allegations in a complaint. *Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1697 (TTAB 2014); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 503.02 (June 2021). Fed. R. Civ. P. 8(a)(2) requires that a pleading contain a "short and plain statement of the claim showing that the pleader is entitled to relief." The Rule does not require detailed factual allegations, but requires more than labels, conclusions, formulaic recitations of the elements of a cause of action, and naked assertions. *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). Indeed, "a complaint must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Id.* (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)); TBMP § 309.03(a)(2). In the context of Board *inter partes* proceedings, a party asserting a claim or counterclaim must allege enough factual matter to suggest that its claim is plausible and to "raise a right to relief above the speculative level." *Bell Atlantic Corp. v. Twombly*, 550 U.S. at 555.

A. Applicant Has Failed to Adequately Allege a Viable Claim for Fraud.

Applicant has failed to allege a viable and plausible claim for fraud in the procurement of Reg. No. 3,947,480 because the conduct alleged by Applicant categorically and unequivocally is not and cannot be deemed fraudulent conduct. Specifically, the alleged acts that Applicant argues constitute "fraud" are "failing to identify that the mark contained the name, portrait, or signature

¹ Reg. No. 3,947,480 for the mark GAVRIELI for "footwear" in Class 25 is incontestable and therefore cannot be challenged for allegedly operating as primarily merely a surname.

that could reasonably be perceived as identifying a particular living individual . . . [and failing to] provide a written consent of Kfir Gavrieli.” Counterclaim at ¶ 9. Simply put, even if true, neither of these actions are fraudulent.

Fraud claims are subject to a higher standard of pleading, requiring fraud allegations to be stated with particularity. Fed. R. Civ. P. 9(b). To set forth a claim of fraud in the procurement of a registration, a plaintiff must allege with particularity that 1) the defendant made a false representation to the USPTO; 2) the false representation which was made is or was material to determining the registrability of the mark; 3) the defendant had knowledge of the falsity of the material representation; and 4) the defendant made the material representation with the intent to deceive the USPTO so as to obtain the registration. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009); *see also* TBMP § 503.02 (explaining that to survive a motion to dismiss, “a complaint must ‘state a claim to relief that is plausible on its face.’”) (citation omitted).

With respect to the conduct alleged in Applicant’s Amended Counterclaim, even if true, none of it satisfies the criteria for a plausible claim of fraud. First and foremost, there is no obligation for a trademark applicant to disclose anything related to surnames, as the onus is on the USPTO to raise and establish a prima facie case that the word is primarily merely a surname. *Application of Standard Elektrik Lorenz Aktiengesellschaft*, 54 C.C.P.A. 1043, 371 F.2d 870, 873, 152 U.S.P.Q. 563 (CCPA 1967); *see also In re Hutchinson Technology, Inc.*, 852 F.2d 552, 7 U.S.P.Q.2d 1490 (Fed. Cir. 1988) (“It is clear that the PTO has the initial burden of going forward in establishing that an applicant's mark is primarily merely a surname.”). Only after the USPTO has raised and established a prima facie case does the burden switch to the applicant to

rebut that presumption. *In Re Adrian Giger and Thomas Giger*, 78 U.S.P.Q.2d 1405 (T.T.A.B. 2006). This burden is on the USPTO because “[w]hether or not a term is considered to be primarily merely a surname and unregistrable under Section 2(e)(3) depends upon what is perceived to be the primary significance of that term to the relevant purchasing public.” *Societe Civile Des Domaines Dourthe Freres v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde*, 6 U.S.P.Q.2d 1205 (T.T.A.B. 1988). Accordingly, failure to disclose that a mark could also be a surname cannot constitute fraud. *Id.* (rejecting a claim for fraud that was based on an alleged failure “to advise the Examining Attorney that DOURTHE is a surname”).

Additionally, the claim is made all the more implausible by the fact that it was Kfir Gavrieli—the person Applicant alleges was failed to be disclosed—who filed and signed the application for Reg. No. 3,947,480. Thus, as the named applicant for the mark at issue, his name was clearly disclosed to the USPTO at the time of filing, defeating the premise of Applicant’s claims.

As to alleged failure to provide consent of the person, even if true, this alleged failure is not and cannot be considered fraud. As the Board indicated in its ruling dismissing Applicant’s original counterclaims, “[t]he Board has previously held that an entity seeking to invoke Section 2(c) must assert that it has a ‘cognizable or proprietary right’ in the name, image, likeness or signature, such as through a ‘linkage or relationship’ with that particular individual sufficient to assert the third party’s rights.” Dkt. 22 (citing *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192, 1195 (TTAB 1994)). Likewise, to have a cognizable claim for fraud based on failure to provide consent, there must also be a “linkage or relationship” which Applicant does not assert and does not have. *See* 2 McCarthy on Trademarks and Unfair

Competition § 13:37 (5th ed.) (June 2021) (“Failure to disclose that a mark is the name of a particular living person cannot be used as a ground for a third party to recover damages because of fraud in the application.”); see also *Gilbert/Robinson, Inc. v. Carrie Beverage-Missouri, Inc.*, 989 F.2d 985, 990, 26 U.S.P.Q.2d 1378 (8th Cir. 1993) (abrogated on other grounds by, *Lexmark Intern., Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 134 S. Ct. 1377, 109 U.S.P.Q.2d 2061 (2014)) (noting that the consent requirement “exists to protect the privacy and property interest of the person whom the public will associate with a mark. [Plaintiff] is not in privity with [the same-name person] and has no standing to vindicate his rights.”). Regardless, as discussed above, Kfir Gavrieli himself signed the application as the applicant, so to the extent any consent was required, Mr. Gavrieli clearly consented to the use of his name. Therefore, it is simply impossible for the conduct Applicant alleges to be a fraudulent conduct.

Further, for a claim that a representation (or lack thereof) is allegedly false to be material, the alleged misrepresentation must be “vital to overcoming the ground of rejection.” *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 56 C.C.P.A. 946, 407 F.2d 881, 886, 160 U.S.P.Q. 715 (C.C.P.A. 1969). Here, Reg. No. 3,947,480 had no rejections based on alleged surname usage, and therefore any alleged failure to disclose it cannot be material.

Based on the above, there was clearly no “false representation” and no materiality, which means the remaining fraud elements necessarily fall. Nevertheless, Applicant still has failed to allege fraud with the particularity required. Indeed, the vast majority of the allegations are either based on “information and belief,” “infer[ence],” and/or events that occurred during the prosecution of trademark applications filed years after this initial registration. Dkt. 23, at ¶¶ 9, 13-19. Such pleadings are insufficient for an allegation of fraud.

Accordingly, Applicant has failed to allege a plausible fraud claim with particularity in accordance with Fed. R. Civ. P. 9(b).

B. Applicant Has Failed to Plausibly Allege Opposer's Registered Marks Operate Primarily as a Surname.

Applicant's claim that GAVRIELI is primarily merely surname fails to satisfy the plausibility standard and should be dismissed.

First and foremost, Applicant directs this claim at Reg. Nos. 5,880,321 and 6,205,921, yet it is precluded from challenging Reg. No. 3,947,480 for GAVRIELI in connection with "footwear," because that registration is incontestable. Opposer owns Reg. No. 5,880,321 for the same GAVRIELI mark for "online retail store services featuring handbags and footwear" and Reg. No. 6,205,921 for the same GAVRIELI mark for "apparel." The registrations that Applicant challenges as being primarily merely a surname, Reg. Nos. 5,880,321 and 6,205,921, are for the exact same GAVRIELI mark as incontestable Reg. No. 3,947,480, and they are for goods or services (handbags, footwear, or apparel) that are the same or related to the goods claimed for incontestable Reg. No. 3,947,480.

To maintain a viable counterclaim, Applicant must plausibly allege (and eventually prove) that the primary significance of the mark GAVRIELI to the purchasing public is that of a surname. *See In re Piano Factory Group Inc.*, 85 USPQ2d 1522, 1523 (TTAB 2006) (citing *In re Hamilton Pharms. Ltd.*, 27 USPQ2d 1939, 1940 (TTAB 1993)). However, in view of incontestable Reg. No. 3,947,480, GAVRIELI undisputedly is a distinctive mark for "footwear" and is *not* primarily merely a surname.

In other words, Applicant must concede that the purchasing public does *not* recognize the GAVRIELI mark as primarily a surname for footwear, yet somehow allege that the exact same

GAVRIELI mark, when viewed by the same purchasing public, would function as primarily a surname for apparel and online retail store services featuring handbags and footwear, which are highly related to footwear. Applicant's claim is simply implausible on its face.

Moreover, Applicant has failed to allege any actual facts to support its conclusory claim that GAVRIELI functions as a mere surname in connection with Opposer's goods. Applicant, like the Patent and Trademark Office during the trademark registration process, has the initial burden of establishing that an applicant's mark is primarily merely a surname. *In re Hutchinson Technology, Inc.*, 852 F.2d 552, 7 U.S.P.Q.2d 1490 (Fed. Cir. 1988). In determining whether a mark functions primarily as a surname, the TTAB considers "(i) whether the surname is rare; (ii) whether anyone connected with applicant has the involved term as a surname; (iii) whether the term has any other recognized meaning; and (iv) whether the term has the 'look and feel' of a surname." *In re United Distillers plc*, 56 U.S.P.Q.2D (BNA) 1220, 1221 (TTAB Jul. 18, 2000). Further, if there are doubts about whether a term functions as a surname, TTAB precedent favors allowing the mark. *See In re Isabella Fiore, LLC*, 75 U.S.P.Q.2d 1564, 1570 (TTAB Jul. 13, 2005) ("Our case law holds that if we have doubts about whether the term is a surname, we resolve them in favor of the applicant and for publication of the mark.")

Apart from Applicant's bare conclusions, Applicant fails to allege actual facts to make a plausible claim that the GAVRIELI mark operates primarily as a surname. The only "facts" alleged by Applicant are that GAVRIELI "appears over 100 times in the Lexis Nexis nationwide directory" and that "[r]esults from 411.com reverse phone number directory show 466 occurrences" (Dkt. 23, at ¶¶ 22-23). These allegations, however, fall far short of making this claim plausible, as Applicant has failed to specify how many results were obtained in relation to

the total names in the database. For instance, in *In re Sava Research Corp.*, 32 USPQ2d 1380 (TTAB 1994), a panel found that 100 individuals out of 90,000,000 total listings was rare, as it would “represent about only one ten-thousandth of one percent of the surnames in this data base.” *Id.*; see also *In re United Distillers plc*, 56 USPQ2d 1220, 1221 (TTAB 2000) (HACKLER held to be a rare surname despite 1295 listings in phone directories); *In re Eximius Coffee, LLC*, 120 USPQ2d 1276 (TTAB 2106) (finding ALDECOA to be rare in spite of a 2000 U.S. Census showing 233 people with the surname ALDECOA and search results of public records from the Lexis public records database show approximately 950 listings for the surname ALDECOA).

Here, Applicant has merely thrown out numbers of individuals that purportedly have Gavrieli as a surname but provided no context for even this relatively small number of results. Even taking the larger number, 466 occurrences, given that there are over 300,000,000 people living in the United States, this would represent only approximately only 0.000155% of surnames in the United States, which would be an indication of rarity.

The remainder of Applicant’s allegations consist of conclusory statements with no actual facts alleged in support or are clearly based on faulty premises. For instance, Applicant baldly claims “Opposer’s ‘GAVRIELI’ mark has no readily recognizable meaning outside of its surname significance,” but provides nothing to support this contention. Similarly, a substantial portion of Applicant’s arguments regarding the mere surname rely on its claim that the Reg. No. 3,947,480 was obtained by fraud. *See* Dkt. 23, at ¶¶ 37-38. Given that Applicant’s fraud claim is clearly unsupportable and implausible, Applicant’s claim that the GAVRIELI mark functions

primarily merely as a surname that relies on the underlying claim for fraud is also unsupportable and implausible.

For these reasons, Applicant's claim that the GAVRIELI mark operates primarily as a mere surname is both implausible and inadequately plead.

IV. Conclusion

In its Amended Answer, Applicant has once again failed to allege a plausible claim for fraud with the requisite plausibility and particularity. Unsupported surmise and conjecture are simply insufficient. Although Applicant has included more information in its allegations, it has still failed to plausibly allege either a misrepresentation or materiality with the heightened pleading standards. Similarly, Applicant has failed to plead a plausible claim that the GAVRIELI mark functions primarily merely as a surname.

Accordingly, Applicant's counterclaim for cancellation based on fraud and primarily merely a surname should again be dismissed.

December 28, 2021

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing MOTION TO DISMISS COUNTERCLAIM was served via email to counsel of record, listed below:

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