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

Proceeding	92057330
Party	Plaintiff David McLane Enterprises, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark Registration No. 3701971
For the mark WOWGIRLS in Class 25
Date registered October 27, 2009.

David McLane Enterprises, Inc.

Petitioner,

v.

Golden Song Productions, Inc.

Registrant.

Cancellation No.: 92057330

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

**PETITIONER'S OPPOSITION TO REGISTRANT'S MOTION TO DISMISS
PURSUANT TO FED. R. CIV. P. 12(b)(6) FOR FAILURE TO STATE A CLAIM**

Petitioner, David McLane Enterprises, Inc. ("DME" or "Petitioner"), by and through its counsel, the law firm of Greenberg Traurig, LLP, files its Opposition to Registrant's Motion to Dismiss Pursuant to Fed. R. Civ. P. 12(b)(6) for failure to state a claim (the "Opposition"). This Opposition is made pursuant to the following memorandum of points and authorities, the pleadings and papers on file in this action, and any oral argument permitted by the Trademark Trial and Appeal Board ("TTAB").

Dated this 13th day of August, 2013.

By: /s/ Lauri S. Thompson
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MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

Registrant's Motion to Dismiss ("Motion") argues that Petitioner lacks standing to seek cancellation of Registrant's mark WOWGIRLS (U.S. Reg. No. 3701971) in Class 25. However, Registrant's Motion has no basis in law or fact and must be denied. Indeed, Registrant's factual assertions as well as its interpretation of the standard required to demonstrate standing are incorrect. Petitioner did file an intent-to-use application for the mark WOW GIRLS (U.S. Ser. No. 85353454)¹ in Class 25 for clothing and was refused registration based on a likelihood of confusion with Registrant's mark WOWGIRLS (U.S. Reg. No. 3701971). In addition, standing to bring a cancellation proceeding is present when the petitioner can demonstrate that it has a good faith belief that it will be damaged by the continued of registration of the subject mark. Ways to demonstrate the belief of damage include alleging (i) that petitioner has been refused registration because of registrant's registration, or (ii) that the petitioner has filed or is about to file an intent-to-use application for its mark and believes that registration will be refused in light of the registrant's registration.

As is the case here, Petitioner has properly alleged facts to show that it has standing to bring the petition. Specifically, Petitioner did in fact seek registration of its mark in Class 25 for clothing, and was already refused registration based on a likelihood of confusion with Registrant's mark. Because Petitioner has easily met the standard for standing, Registrant's motion must be denied.

If, however, the Board finds that Petitioner did not accurately allege facts to support a showing of standing, Petitioner respectfully requests leave to amend. Because leave to amend should be freely given, this request should be granted.

¹ Petitioner's Petition for Cancellation contains a typographical error and inadvertently references Serial Number 85353422, which identifies the application for its WOW mark. *See* Petition at ¶ 6. The correct Serial Number for its WOW GIRLS application, which was filed on June 22, 2011 in Class 25, is 85353454.

II. FACTUAL BACKGROUND

1. On or about January 25, 2007, Registrant filed an application to register the Mark WOWGIRLS, and was assigned Application Serial No. 77088445. This application matured into Registration No. 3701971 (the “WOWGIRLS Mark”).

2. Registrant filed a statement of use, on or about August 19, 2009, claiming use in commerce of the WOWGIRLS Mark for “clothing for girls and women, namely western-style pants and slacks, skirts, blouses, jackets and coats, neckerchiefs and bandanas, socks, hats, belts, and boots,” providing a specimen of a shirt with “Wow Girls” incorporating rhinestones and a whip, in a design decoratively placed on the front, which was accepted by the USPTO, and the mark registered for both Class 25 and 41 on October 27, 2009.

3. Petitioner has a good faith belief that Registrant did not in fact have use of its mark on all of the goods listed in its Class 25 description, and thereby carried out a fraud on the USPTO by claiming use of the mark for every item of clothing, namely, “western-style pants and slacks, skirts, blouses, jackets and coats, neckerchiefs and bandanas, socks, hats, belts, and boots.”

4. Registrant submitted a specimen to the USPTO to show use of the WOWGIRLS Mark on a shirt, where the mark was merely ornamental, and did not show use of the mark as a trademark, thus the mark failed to function as a trademark.

5. Upon information and belief, Registrant either never did have use of its mark for all of the clothing items listed, or its use of the mark was merely a token use in order to support its registration, rather than use its mark in commerce in the normal course of business. Petitioner believes this was done by Registrant with the intent to deceive the USPTO into believing the Registrant had use of all the goods listed in its application.

6. On June 22, 2011, Petitioner filed its intent-to-use application for WOW GIRLS, Serial No. 85353454 in Class 25 and Class 41.

7. On October 3, 2011, Petitioner received an office action from the Trademark Examiner, which refused registration in Class 25 based on a likelihood of confusion with Registrant's mark. On December 11, 2012, the refusal was made final.

8. On June 11, 2013, a request to divide out a child application for the mark in Class 41 was submitted to the USPTO.

9. Petitioner intends to use its WOW GIRLS mark for clothing and to seek registration of its WOW GIRLS mark in Class 25.

10. Petitioner, thus, has a reasonable and good faith belief that it will suffer damage by the continued registration of Registrant's WOWGIRLS Mark.

II. LEGAL ARGUMENT

A. REGISTRANT'S MOTION SHOULD BE DENIED BECAUSE PETITIONER HAS SUFFICIENT STANDING TO BRING THE INSTANT CANCELLATION PROCEEDING.

"A motion to dismiss for failure to state a claim upon which relief can granted is a test solely of the legal sufficiency of a complaint." *Advanced Cardiovascular Systems, Inc. v. SciMed Life Systems, Inc.*, 988 F.2d 1157, 26 U.S.P.Q.2d 1038, 1041 (Fed. Cir. 1993); *Corporacion Habanos SA v. Rodriguez*, 99 U.S.P.Q.2d 1873, 1874 (TTAB 2011); Trademark Trial and Appeal Board Manual of Procedure Third Edition, Revision 1 (June 2012) (hereinafter, "TBMP") at § 503.02. "In order to withstand such a motion, a complaint need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought (in the case of an opposition), or for canceling the subject registration (in the case of a cancellation proceeding)." TBMP § 503.02 (*see Young v. AGB Corp.* 152 F.3d 1377, 47 U.S.P.Q.2d 1752, 1754 (Fed. Cir. 1998); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 U.S.P.Q. 185 (CCPA 1982); *Rodriguez*, 99 U.S.P.Q.2d at 1874).

As set forth in TBMP § 503.02, "[t]o survive a motion to dismiss, a complaint must 'state a claim to relief that is plausible on its face.'" *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007) (retiring the pleading standard set forth in *Conley v. Gibson*, 355 U.S. 41 (1957) that

dismissal for failure to state a claim is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts that could be proved in support of its claim); *see also Ashcroft v. Iqbal*, 556 U.S. 662, 129 S. Ct. 1937 (2009) (plausibility standard applies to all federal civil claims); *Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 U.S.P.Q.2d 1780, 1782 (TTAB 2012); *Rodriguez*, 99 U.S.P.Q.2d at 1874. "Therefore, 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 a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence in support of their respective positions." TBMP § 503.02 (*see Advanced Cardiovascular Systems, Inc.*, 988 F.2d 1157, 26 U.S.P.Q.2d at 1041).

Here, Petitioner has alleged facts on the face of the pleadings to demonstrate that it has standing and that will establish that Petitioner is entitled to the relief sought. Therefore, its Petition withstands Registrant's Motion to Dismiss.

"In determining whether or not a litigant before the Board has stated a claim upon which relief can be granted, 'we must assume that the facts alleged in the petition are true.'" *Young*, 47 U.S.P.Q.2d at 1754 (citing *Stanspec Co. v. American Chain & Cable Co.*, 531 F.2d 563, 566, 189 U.S.P.Q. 420, 422 (CCPA 1976) (petition for cancellation of a registered mark)). "Dismissal is appropriate 'if it is clear that no relief could be granted under any set of facts that could be proved consistent with the allegations.'" *Young*, 47 U.S.P.Q.2d at 1754 (citing *Abbott Labs. v. Brennan*, 952 F.2d 1346, 1353, 21 U.S.P.Q.2d 1192, 1198 (Fed. Cir. 1991) (citations and internal quotations omitted)).

Any person who believes it is or will be damaged by registration of a mark has standing to file a complaint. *See* TBMP § 503. At the pleading stage, all that is required is that a plaintiff allege facts sufficient to show a "real interest" in the proceeding, and a "reasonable basis" for its belief that it would suffer some kind of damage if the mark is registered. *Ritchie v. Simpson*, 170 F.3d 1092, 50 U.S.P.Q.2d 1023, 1025 (Fed. Cir. 1999). To plead a "real interest," a plaintiff

must allege a “direct and personal stake” in the outcome of the proceeding. *Id.*, 50 U.S.P.Q.2d at 1026. There is no requirement that actual damage be pleaded or proved, or that plaintiff show a personal interest in the proceeding different or “beyond that of the general public”, in order to establish standing or to prevail in an opposition or cancellation proceeding. *Id.*, 50 U.S.P.Q.2d at 1027 (“The crux of the matter is not how many others share one’s belief that one will be damaged by the registration, but whether that belief is reasonable and reflects a real interest in the issue.”); *see also* TBMP § 303.03.

Examples of a “real interest” in the proceeding and a “reasonable belief” of damage are where the petitioner has prior use of a confusingly similar mark, *see Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 U.S.P.Q.2d 1558, 1565 (TTAB 2011), where petitioner has been refused registration of its mark because of defendant’s registration, *see Saddlesprings Inc. v. Mad Croc Brands Inc.*, 104 U.S.P.Q.2d 1948, 1950 (TTAB 2012), or where petitioner has a bona fide intent to use the same mark for related goods, is about to file an intent-to-use application to register the mark, and believes registration of the mark will be refused in view of defendant’s registration. *See American Vitamin Products Inc. v. Dow Brands Inc.*, 22 U.S.P.Q.2d 1313, 1314 (TTAB 1992).

Petitioner has easily demonstrated that it has standing. Indeed, Petitioner has alleged facts showing that it has a real interest in the Cancellation proceeding and a reasonable basis for its belief of damage by alleging that its application for WOW GIRLS (Ser. No. 85353454) has been refused registration in Class 25 based on a likelihood of confusion with Registrant’s mark. Further, Petitioner has alleged facts to show it has a direct stake in the outcome of the Cancellation because it intends to use its WOW GIRLS mark for clothing and to seek registration of its mark in Class 25. Given this, if Registrant is allowed to maintain its registration of the WOW GIRLS mark in Class 25, it will commercially harm Petitioner by limiting or preventing its rightful use and registration of its WOW GIRLS mark for clothing. Pleading facts that have shown that Petitioner’s application has been refused in view of

Registrant's mark, is a sufficient and clear basis for standing. Accordingly, Registrant's Motion should be denied.

B. IN THE ALTERNATIVE, PETITIONER SHOULD BE ENTITLED TO AMEND ITS PETITION.

If the Board feels that Petitioner's inadvertent reference to the incorrect Serial Number in its Petition warrants dismissal of the Petition, Petitioner should be granted leave to amend to correct this typographical error. Pursuant to TBMP § 503.03, "[a] plaintiff may amend its complaint within 21 days after service of a motion under Fed. R. Civ. P. 12(b)(6) or with the written consent of every adverse party or by leave of the Board, which is freely given when justice so requires." See Fed. R. Civ. P. 15(a)(1)(B); see also TBMP § 507.02. "If no amended complaint is submitted in response to a motion to dismiss for failure to state a claim upon which relief can be granted and the Board finds, upon determination of the motion, that the complaint fails to state a claim upon which relief can be granted, the Board generally will allow the plaintiff an opportunity to file an amended pleading." *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 U.S.P.Q.2d 1203, 1208 (TTAB 1997) (allowed time to perfect fraud claim); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 U.S.P.Q.2d 1711, 1714 (TTAB 1993) ("the Board freely grants leave to amend pleadings found, upon challenge under Fed. R. Civ. P. 12(b)(6), to be insufficient, particularly where challenged pleading is the initial pleading"); and *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 U.S.P.Q. 154, 156 (TTAB 1985) (allowed time to file an amended opposition setting forth a statutory ground).

Here, Petitioner maintains that its Petition for Cancellation is sufficient on its face as properly showing standing and grounds; therefore, this case should go forward. However, in the alternative, if the Board finds its Petition to be defective, Petitioner respectfully requests that the Board grant it leave to amend its Petition, which is freely given when justice so requires.

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III. CONCLUSION

Based on the foregoing, Petitioner respectfully requests that the Board deny Registrant's Motion to Dismiss in its entirety.

Dated this 13th day of August, 2013.

GREENBERG TRAURIG, LLP

By: /s/ Lauri S. Thompson

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CERTIFICATE OF SERVICE

I hereby certify that on Tue, Aug 13, 2013, I served the foregoing **PETITIONER'S OPPOSITION TO REGISTRANT'S MOTION TO DISMISS PURSUANT TO FED. R. CIV. P. 12(b)(6) FOR FAILURE TO STATE A CLAIM** on:

Golden Song Productions, Inc.
7545 Bermuda Road
Las Vegas, NV, 89123

Philip A. Kantor
Law Office of Philip A. Kantor, P.C.
8440 W. Lake Mead Blvd., Suite 202
Las Vegas, NV 89128

by causing a full, true, and correct copy thereof to be sent by the following indicated method or methods, on the date set forth below:

X by mailing in a sealed, first-Class postage-prepaid envelope, addressed to the last-known office address of the attorney, and deposited with the United States Postal Service at Las Vegas, Nevada.

/s/ Ingrid L. Hinde
