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Filing date: **03/30/2021**

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

Proceeding	92075530
Party	Defendant Gerber Childrenswear LLC
Correspondence Address	RA COHEN HENKEL & COHEN PA 7480 SW 40TH ST STE 450 MIAMI, FL 33155 UNITED STATES Primary Email: ic@miamibusinesslitigators.com 305-971-9474
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	IRA COHEN, ESQ.
Filer's email	ic@miamibusinesslitigators.com
Signature	/Ira Cohen/
Date	03/30/2021
Attachments	REPLY IN SUPPORT OF MOTION TO DISMISS.pdf(732241 bytes)

aspect of the motion has been rendered moot by reason of the Board's suspension of proceedings herein on March 9, 2021 (*see* TTAB VUE, Doc. No. 12).

REPLY ARGUMENT/ MOTION TO DISMISS FOR LACK OF STANDING

Registrant maintains that, as a threshold jurisdictional issue, the Petitioner in this Cancellation Proceeding has failed to demonstrate her standing in order to contest the Registration here at issue. We commence our consideration by noting that the Petitioner seems to be going to an awful lot of trouble to keep the corporate entity out of this case. Registrant continues to reasonably inquire why that is?

Petitioner states, at page 8 of the Amended Response (filed March 12, 2021) that the Petition sufficiently demonstrates that Petitioner is in privity with the corporate entity. Respondent disagrees. The first 8 factual allegations of the Petition make zero mention of the entity. Rather, they all allege that Petitioner (*i.e.*, Ms. Dawson) did this, or did that, or received this, or sent that, etc.

The principal problem for Ms. Dawson remains the fact that the exhibits attached to the Petition show only the involvement of the entity. They make no mention of Ms. Dawson. Further, Para. 5 of the Petition falsely states that Plaintiff (*sic*) received an Etsy infringement notice; the Notice clearly was sent not to her, but rather to the entity. (*See* Petitioner's Exhibit B.) To be sure, that Notice is directed to the entity, "BundledandCompany," and only to the entity. It bears repetition that Ms. Dawson's name does not appear anywhere at all in Exhibit B.

Petitioner seeks here to rely not on her own pleading, which falls short of the mark, but on Registrant's work and efforts. Petitioner goes on to mention something about "EXHIBITS A-B; 11 TTABVUE, at 25 (corporate records for the Corporate Entity," at page 8 of her Response. This appears to be a reference not to any of her allegations, or exhibits, but rather to Registrant's Motion to Dismiss. That is because Dawson's Petition neither cites, nor proves any privity between the individual, Dawson, and the entity. It is as if there is no entity. Besides, the exhibit shown by Registrant shows only Dawson to have been a "MGR" (Manager)(*N.B.* - not a Manager-Member or Member) and the Registered Agent of the entity at the time the information was provided to the state. We have no proof of her current status, if any? Where is the evidence of privity? Moreover, a lawyer's argument is *not* evidence. No, the pleading should be judged to stand or fall on its own account and, in the matter at hand, it obviously cannot.

The Federal Circuit Court of Appeals has made it clear that a petitioner in a cancellation proceeding need not show proprietary rights in its own mark to demonstrate a real interest in the proceeding, in *Australian Therapeutic Supplies PTY. V. Naked TM, LLC*, 965 F. 3d 1370, 1374 (CAFC, 2020). However, the inquiry does not end when it is apparent, as it is in this case, that the petitioner has no such proprietary rights. In short, the Petitioner still must show a real interest and it is here, once again, that Ms. Dawson falls short of the bullseye.

She has not had a registration refused because of Registrant's mark. She has not shown she has been selling merchandise which the attacked mark impinges

upon. Though she alleges those things, her own exhibits to the initial pleading flatly undermine that. Registrant, and the Board, simply should not accept Petitioner's allegations in a vacuum whilst turning a blind eye to the contradictory exhibits annexed to the pleading.

That is to say, Dawson may have alleged she is selling certain goods but, here, her own exhibits filed with the Board undercut her allegations. Thus, it is not a case merely of accepting her well-pleaded allegation as true. Significant doubt has been cast on the veracity of her allegations, by her own exhibits. That does not make for a well-pleaded petition. More crucially, perhaps, the Registrant cannot be expected to properly and fully answer and defend itself when the allegations confronting it -- coupled with the allegedly supportive exhibits thereunto -- are in direct and utter conflict.

In the *Australian* case, *supra*, the petitioner had been refused registration on one or more trademark applications based on a likelihood of confusion with the registered mark. The dissenting opinion in that case is more instructive here.

As Judge Wallach stated, the petitioner must have a legitimate interest and a reasonable basis for its belief in damages. That can be shown in several ways, but it is essential to "prevent litigation where there is no real controversy between the parties..." *Australian, supra*, 965 F.3d at 1378. Judge Wallach also noted the need for a legitimate commercial interest to be "rooted in fact" and "affirmatively proved." *Id.*

While a petitioner does not have to prove the entitlement to a cause of action at the pleading stage (but must prove same at trial or on summary judgment), the problem in this case is that, because of Petitioner's inartful, or false, pleading, Registrant now severely is prejudiced by the facial inconsistencies of Dawson's allegations (and particularly Nos. 1-8 of the Petition) vis-a-vis the exhibits which supposedly support same. Why should Registrant be burdened with spending time and money dealing with a pleading which, we all can see, does not have its facts straight or its ducks in a row? The pleading either shows Dawson has no legitimate interest or, in a less severe analysis, requires some major overhauling before it is susceptible of answer. Thus, an alternative for the Board is to dismiss the Petition, without prejudice, granting leave to Petitioner to clean up and rectify the petition.

**REPLY ARGUMENT/MOTION TO DISMISS FOR FAILURE TO JOIN A
REQUIRED PARTY**

In the alternative, Registrant has posited that the Petition ought to be dismissed for failure to join a required party. Petitioner, as alluded to above, seems to be unduly straining to keep the entity out of the proceeding at hand. One could reasonably ask, why all the legal dodging and procedural panegyrics on the part of Petitioner? As the immortal Bard might have observed "The lady doth protest too much, methinks." Shakespeare, *Hamlet*, Act III, Scene II, lines 210-219.

The case of *Escamilla v. M2 Technology, Inc.*, 536 Fed. Appx. 417 (5th Cir. 2013) is instructive on this issue. In that case, a software engineer brought multiple trademark and unfair competition claims against a corporate distributor of information technology equipment over the use of the "M2" trademark. *Escamilla*

was the sole shareholder of a company, M2 Software. In that case, the court below granted a Rule 12(b)(7) motion. On review, the Court of Appeals held the company was a required party and, further, that dismissal for failure to join that company, a required party, was warranted.

If a court finds a party necessary to the litigation under Rule 19(a), the party must be joined if possible. In the matter at hand, there appears to be no good reason why the entity cannot be joined. In the event that a party cannot be joined under Rule 19(a), the court next turns to Rule 19(b) to determine whether the action should proceed amongst the existing parties or should be dismissed.

Using Rule 19(a)(1)(B)(ii), in the *Escamilla* case, the court found the company, M2 Software, to be a required party. In order to reach that conclusion, the court reasoned that the absence of M2 Software as the owner potentially exposed the defendant, M2 Technology, to another identical lawsuit by M2 Software. *Id.*, 536 Fed. Appx at 420. In that case, unlike here, the company could not be joined; thus, the action was dismissed. In so doing, the court noted that “the possibility of a duplicative lawsuit is very real and could be quite costly and inconvenient.” The court further noted that Escamilla’s personal assurance (similar to the Petitioner’s statements here about lack of future harm) amounted to a “non-binding commitment that does not suffice to alleviate the potential prejudice to M2 Technology.” *Id.*, at 423. Again, lawyers’ arguments are not evidence. Counsel’s statements regarding Dawson’s alleged privity and/or the lack of potential future

prejudice and harm of duplicative proceedings are not evidence and not binding on Dawson, and certainly not binding on the entity, a non-party.

In the case at bar, the Board need not be so Draconian as to dismiss; it can order joinder of the entity and, then, all required parties will be before the TTAB. Of course, Petitioner can consent or stipulate to same saving everyone the trouble.

Service Issues of Both Registrant and Applicant:

On these issues, it appears that the parties are *in pari delicto*. Surprisingly, this was the lead argument in the Response papers and much hay was made by Petitioner's counsel of this. That fact alone should serve to cast harsh, bright light on the overall weakness of Petitioner's other positions. In any event, the argument on this issue fails to pass muster after close and fair scrutiny, as discussed, *infra*.

Petitioner's counsel, for the first time, late in the afternoon of March 12, 2021, wrote that Registrant's counsel filed the motion with the TTAB, but did not serve the Motion to Dismiss by e-mail on the date specified. As soon as the issue was brought to Registrant's attention, it was checked; finding Applicant to be technically correct, Registrant's counsel immediately (within a very short span of time, on March 12th) was transparent and took responsibility; he also served the document in question by e-mail a short time after on March 12th and, also, sent an appropriate apology e-mail to Applicant's counsel (though no response ever was received). (*See Exhibit A hereto.*) (An extension consent also was offered, if needed; again, there was no reply.) The Board may rest assured that the error was inadvertent (due to an internal miscommunication) and will not be repeated.

Indeed, out of an abundance of caution, this Reply document is being served by first class mail, facsimile, and FedEx.

Fortunately, Petitioner was not prejudiced in any way; counsel obviously knew of the Motion to Dismiss and timely responded. Therefore, no harm was done and Registrant, going forward, will exercise all due care.

This situation reminds us of the old adage admonishing that “people who live in glass houses should not throw stones.” Why? Well, it was the Petitioner’s counsel, who talk of sanctions, yet, for their own part, sat on the issue, lying in wait, for almost 3 weeks from the filing date of the motion until March 12th. Then, they spent almost three (3) pages on this in their Amended Response. Can there be any doubt, however, the right thing for them to have done would have been to alert Registrant’s counsel, immediately, (on February 26, 2021) so that the problem could be rectified with all due haste? Moreover, hypocrisy is afoot, as the Certificate of Service of Petitioner’s Reply likewise is defective and does not comply with the Rules (including Rule 2.119, which the Petitioner cited):

“A statement signed by the attorney or other authorized representative, attached to or appearing on the original submission when filed, clearly stating the date and manner in which service was made will be accepted as prima facie proof of service.” (Emphasis added.)

In short, there is no date in the Petitioner’s Certificate of Service. (See page 18 of the Response; *see also* Exhibits B and C hereto and TTAB Vue Doc. Nos. 13 and 14). To add insult to injury, this was the case in both Petitioner’s Response and Amended Response; there are no dates in either of those Certificates of Service.

Registrant's faux-pas was unintentional. Was the Petitioner's maneuvering a studied effort? The 18th page of the Petitioner's original Response (Exhibit B hereto) may be telling. The top of the page indicates the paper was dated March 3, 2021. It certainly was not served on March 3rd, so that would be false. In any case, it clearly shows that, by at least as early as March 3rd, Petitioner knew about the service issue, but chose not to file and serve the Reply and, what is worse, decided to remain mute until the last possible minute (on March 12, 2021).

Additionally, if one goes back to the Petition for Cancellation filed with the TTAB, one will see that Petitioner likewise had a defective Certificate of Service. Once again, no date is provided in the Certificate of Service. (*See* TTAB Vue Doc. No. 2.; *see also* Exhibit D hereto.)

Finally, Petitioner's counsel, most curiously, asked the Board, at page 4 of its original Response, to "dismiss the petition." (Emphasis added.) (This later was corrected in the Revised (Amended) Response, TTAB Vue. Doc. No. 14.) Registrant, of course, would have no objection to the Board dismissing the Petition to Cancel.

What this all really boils down to, however, is the undeniable fact that anyone can make a mistake and, what is more, that Petitioner, and none of us, should be too quick to point fingers and condemn others. Fortunately, no party was harmed or prejudiced in any manner. We should all be more diligent – and

Registrant will be -- but the case should proceed on the merits (or lack thereof).

WHEREFORE, Registrant respectfully urges the Board to grant the Motion to Dismiss), or the above-described alternative motion, together with such other, further, and different relief as to the Board may seem just and proper.

Dated: Miami, FL
March 29, 2021

Respectfully submitted,

/Ira Cohen/
IRA COHEN, ESQ.

Counsel of Record for Registrant
Gerber Childrenswear LLC

CERTIFICATE OF SERVICE

On March 29, 2021, a copy of this Reply Argument on the Motion to Dismiss was sent by email, first class mail (cost prepaid), facsimile (with transmission receipt) and Federal Express (cost pre-paid)(with tracking receipt) to the following counsel of record for Petitioner:

Counsel of Record for Petitioner, Madelyne Dawson:

Mark C. Johnson, Esq. and Veronika Balbuzanova, Esq.

Attorneys of Record, FL Bar Members
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/Ira Cohen/

IRA COHEN

EXHIBIT "A"

Ira Cohen

From: Ira Cohen
Sent: Friday, March 12, 2021 4:45 PM
To: Mark Johnson; Veronika Balbuzanova
Subject: DAWSON v. GCW, TTAB, Cancellation Proceeding
Attachments: SKM_C450i21031306220.pdf

Miami, FL
Mar. 12, 2021

Dear Mr. Johnson and Ms. Balbuzanova:
Good afternoon.

It appears an apology is in order and I am not one to shirk my obligations to opposing counsel. I am in receipt of your opposition papers on the Dawson matter. I have not yet studied same at length and all of our Reply comments and points are reserved, of course.

However, in the interim, I am quite troubled by a revelation to me which I first learned in your paper sent a short while ago (on even date) regarding a computer service issue. That is simply not the way we practice law around here and it should not happen. I cannot explain what happened here, but rest assured that any human and/or computer error which resulted in your office not receiving our motion was absolutely unintentional and inadvertent.

Still, the responsibility ultimately is mine to make sure you get such papers, and you say you did not, so I do apologize profusely.

Rest assured, going forward, I will ensure that this will not happen again to you. For now, I am attaching a fresh copy of the motion, with a C/S for today.

That does not change the past.

And, obviously you had knowledge of and received the motion from the TTAB, in any case, and you have responded already.

Still, if you needed additional time (as I do not know when you actually learned of it), you should have asked and we would have acquiesced.

More crucially, perhaps, if you feel you need additional time (for an amended Response), because you were pressed for time, I would not oppose any such request.

Again, any inconvenience to you or your office sincerely is regretted.

We will file and serve our Reply on your office in a timely manner.

Thank you.

Very truly yours,

Ira

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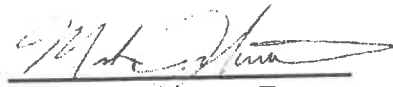
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EXHIBIT "B"

Dated: March 3, 2021

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing has been served via email to counsel for Registrant at ic@miamibusinesslitigators.com pursuant to 37 C.F.R. § 2.119.


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EXHIBIT "C"

For the foregoing reasons, Petitioner has successfully met her burden in pleading sufficient factual and legal allegations to withstand a Rule 12(b)(1) and 12(b)(7) challenge. Accordingly, Petitioner respectfully requests the Board **DENY** Registrant's Motion to Dismiss the Cancellation.

Dated: March 12, 2021

Respectfully submitted,

JOHNSON | DALAL

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I hereby certify that a true and complete copy of the foregoing has been served via email to counsel for Registrant at ic@miamibusinesslitigators.com pursuant to 37 C.F.R. § 2.119.


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EXHIBIT "D"

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing pleading will be served via email to Defendant at pursuant to 37 C.F.R. § 2.119.

By:


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