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

Proceeding no.	92078340
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

FESTIVALS OF SPEED, LLC,

Petitioner,

-against-

THE GOODWOOD ESTATE COMPANY LIMITED,

Registrant.

Cancellation No. 92078340

**REGISTRANT’S MOTION TO DISMISS THE FIRST AMENDED
PETITION FOR CANCELLATION OF REGISTERED TRADEMARKS**

On its second attempt to file a proper pleading, Petitioner Festivals of Speed, LLC (“Petitioner”) files an Amended Petition that suffers from the same type of ill-pleaded claims and conclusory allegations as its first iteration. These repeated deficiencies are fatal to almost all of Petitioner’s claims.

On January 27, 2022, rather than respond to Registrant Goodwood Estate Company Limited’s (“Goodwood’s”) motion to dismiss the initial Petition, Petitioner filed a First Amended Petition for Cancellation of Registered Trademarks (9 TTABVUE, the “Amended Petition”), seeking to cancel the same two federal registrations owned by Goodwood : U.S. Trademark Registration No. 5557758 for the word mark GOODWOOD FESTIVAL OF SPEED (“Goodwood’s Word Mark”), shown here:

GOODWOOD FESTIVAL OF SPEED

and U.S. Trademark Registration No. 6132392 for the mark FESTIVAL OF SPEED & Design (“Goodwood’s Logo Mark”), shown here:



Pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure and Section 503 of the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”), Goodwood moves to dismiss Counts One, Two, Three, and part of Count Four (the part concerning Goodwood’s Word Mark) of the Amended Petition *with prejudice*. In support of its motion, Goodwood states the following:

INTRODUCTION

Petitioner acknowledges that Goodwood is the organizer of an annual event held in England for nearly three decades “featuring vehicles and other events” known as the “Goodwood Festival of Speed.” (9 TTABVUE ¶ 17.) Nevertheless, Petitioner commenced this proceeding to cancel the U.S. registrations for Goodwood’s Word Mark and Goodwood’s Logo Mark because—despite a lack of any action by Goodwood against Petitioner at any time—Petitioner speculates that Goodwood may “attempt to enforce its marks” against Petitioner at some point in the future. (9 TTABVUE ¶¶ 27, 26-30.)

In many ways, the Amended Petition resembles a Russian nesting doll with conclusory allegations supporting vaguely pleaded claims nested within titular but amorphous and undifferentiated “Counts.” As detailed below, the purported support for Petitioner’s claims consists mainly of barebones, tangentially-related, and sometimes wholly irrelevant and/or untenable allegations. As in its initial Petition, Petitioner again fails to adequately plead essential elements of asserted causes of action and includes contradictory allegations.

Admittedly, references to a completely inapplicable Lanham Act provision (15 U.S.C. § 1054 concerning *certification marks*) and an inapposite international agreement (the Paris Convention, which is *not* the basis for either of Goodwood’s registrations at issue) that muddied Petitioner’s first pleading have been removed from the Amended Petition. (*See generally* 1 TTABVUE.) However, the Amended Petition, like the initial Petition, falls far short of providing

a “short and plain statement of the claim[s]” as required under the Federal Rules of Civil Procedure, Fed. R. Civ. P. 8(a)(2), and repeatedly fails to state cognizable legal claims.

In light of the foregoing—and because this is Petitioner’s second failed attempt to proffer an adequate pleading—Goodwood moves to dismiss Counts One, Two, Three, and part of Count Four of the Amended Petition *with prejudice*.

PROCEDURAL HISTORY

The U.K. and International Trademark Registrations for Goodwood’s Word Mark and Goodwood’s Logo Mark¹

On February 3, 2017, Goodwood filed U.K. Trademark No. UK00003210621 seeking to register Goodwood’s Word Mark in the United Kingdom. The mark matured to registration in the U.K. on May 19, 2017 (the “U.K. Word Mark Registration”).² The U.K. Word Mark Registration is valid, subsisting, and in full force and effect, and Petitioner has not alleged that this U.K. registration has been cancelled or abandoned. On April 20, 2017, based on its U.K. filing for Goodwood’s Word Mark, Goodwood was issued International Registration No. 1370233³ for Goodwood’s Word Mark (the “International Word Mark Registration”). The International Word Mark Registration is valid, subsisting, and in full force and effect, and Petitioner has not alleged that the registration has been cancelled or abandoned.

On April 3, 2018, Goodwood filed U.K. Trademark No. UK00003301170 seeking to register Goodwood’s Logo Mark in the United Kingdom. The mark matured to registration in the

¹ Facts concerning Goodwood’s U.K. and International Registrations are found in the Amended Petition ¶¶ 8-13 and in the USPTO records for Goodwood’s corresponding U.S. registrations. (See Application for U.S. Reg. No. 5557758, filed October 19, 2017, and Application for U.S. Reg. No. 6132392, filed February 14, 2019.)

² Goodwood first registered GOODWOOD FESTIVAL OF SPEED in the U.K. on November 25, 1994 in Classes 16, 21, 25, 41, and 42 (UK00002003531, and also owns a March 2019 U.K. registration in those same classes (UK00811370233). These are not at issue in this proceeding.

³ Petitioner incorrectly identifies the International Registration number associated with Goodwood’s Word Mark as “International Trade Mark No. 1131370233” instead of International Reg. No. 1370233. (See 9 TTABVUE ¶ 12.)

U.K. on June 22, 2018 (the “U.K. Logo Mark Registration”). The U.K. Logo Mark Registration is valid, subsisting, and in full force and effect, and Petitioner has not alleged that the registration has been cancelled or abandoned. On October 3, 2018, based on its U.K. filing for Goodwood’s Logo Mark, Goodwood was issued International Registration No. 1449837 for Goodwood’s Logo Mark (the “International Logo Mark Registration”). The International Logo Mark Registration is valid, subsisting, and in full force and effect, and Petitioner has not alleged that the registration has been cancelled or abandoned.

Goodwood’s U.S. Trademark Registrations at Issue in this Proceeding

On September 11, 2018, the U.S. Patent and Trademark Office (“USPTO”) issued to Goodwood U.S. Trademark Registration No. 5557758 (the “U.S. Word Mark Registration”) for Goodwood’s Word Mark in International Classes 9, 25, 35, and 41. (9 TTABVUE ¶ 7.) The U.S. Word Mark Registration was issued pursuant to Section 66(a) of the Lanham Act, 15 U.S.C. § 1141f(a), and is based on an extension of protection of the International Word Mark Registration under the Madrid Protocol. (9 TTABVUE ¶¶ 8, 12.)

On August 25, 2020, the USPTO issued to Goodwood U.S. Trademark Registration No. 6132392 (the “U.S. Logo Mark Registration”) for Goodwood’s Logo Mark in International Classes 9, 25, and 35. (9 TTABVUE ¶ 7.) The U.S. Logo Mark Registration was issued pursuant to Section 66(a) of the Lanham Act, 15 U.S.C. § 1141f(a), and is based on an extension of protection of the International Logo Mark Registration. (9 TTABVUE ¶¶ 8, 13.)

Commencement of this Cancellation Proceeding and Filing of Amended Petition

On October 28, 2021, Petitioner filed its Petition for Cancellation seeking to cancel Goodwood’s U.S. Word Mark Registration and U.S. Logo Mark Registration. (1 TTABVUE.)

On January 7, 2022, Goodwood filed its Motion to Dismiss Petition for Cancellation pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure. (7 TTABVUE.)

On January 27, 2022, rather than try to oppose the dismissal motion, Petitioner filed its Amended Petition “as of right” pursuant to Rule 15(a) of the Federal Rules of Civil Procedure and TBMP § 507.02. (9 TTABVUE.)

The Amended Petition contains four different numbered “Counts,” listing a wide variety of purported claims, including: (1) cancellation of the U.S. Word Mark Registration on grounds of misclassification of goods, likelihood of confusion, fraud, non-use, and abandonment (9 TTABVUE ¶ 39); (2) cancellation of the U.S. Logo Mark Registration on grounds of misclassification of goods, likelihood of confusion, fraud, and abandonment (9 TTABVUE ¶ 43); (3) cancellation of the U.S. Logo Mark Registration on grounds that the U.K. Logo Mark Registration was obtained fraudulently (9 TTABVUE ¶¶ 55, 58-59); and (4) cancellation of the U.S. Word Mark Registration and the U.S. Logo Mark Registration on grounds of likelihood of confusion (9 TTABVUE ¶¶ 60-71).

ARGUMENT

Counts One, Two, and (in part) Four of the Amended Petition either fail to allege essential elements of the asserted claims or rely on threadbare and wholly conclusory allegations that, like those in the initial Petition, fall far short of the pleading requirements established by the U.S. Supreme Court and the Board. In Count Three, which addresses Goodwood’s U.K. Logo Mark Registration, the Amended Petition fails to assert factual allegations that, if proven, would establish a valid ground for cancelling Goodwood’s U.S. Logo Mark Registration, as the allegations concern Goodwood’s *U.K.* registration. Accordingly, the Board should dismiss Counts One, Two, Three, and part of Count Four of the Amended Petition with prejudice.

I. Standard for Motion to Dismiss.

A motion to dismiss for “failure to state a claim upon which relief can be granted” under Federal Rule of Civil Procedure 12(b)(6) is a test of “the legal sufficiency of [the] complaint.”

Tapmaster Inc. v. Perfect Water Techs., Inc., Opp. No. 91199561, 2012 WL 8254589, at *5 (T.T.A.B. Dec. 26, 2012); *see also* TBMP § 503. To survive such a motion, a 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) (citation omitted).

In the context of a Board proceeding, for a claim to be “plausible on its face,” the petitioner must “plead[] factual content that if proved, would allow the Board to conclude, or draw a reasonable inference that, the petitioner has standing and that a valid ground for cancellation exists.” *Corporacion Habanos, S.A. v. Rodriguez*, Canc. No. 92052146, 2011 WL 3871952, at *1 (T.T.A.B. Aug. 1, 2011); *see also* TBMP § 503.02. Factual allegations must not only be well-pleaded, but they also must be more than “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements.” *Doyle v. Al Johnson’s Swedish Rest. & Butik, Inc.*, 101 U.S.P.Q.2d 1780, 1782 (T.T.A.B. 2012) (quoting *Iqbal*, 556 U.S. at 678). Such threadbare statements “do not suffice and are not accepted as true.” *Id.*; *see also* *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007) (“[C]ourts are not bound to accept as true a legal conclusion couched as a factual allegation” (citation and internal quotation marks omitted)).

As detailed below, Petitioner has, for the second time, failed to meet the core pleading requirements, and its Amended Petition cannot survive a Motion to Dismiss.

II. The Board Should Dismiss Count One of the Amended Petition.

Count One of the Amended Petition (9 TTABVUE ¶¶ 36-39) seeks cancellation of the U.S. Word Mark Registration by haphazardly proffering five entirely unrelated grounds, namely: (a) misclassification of goods, (b) likelihood of confusion, (c) fraud, (d) non-use (specifically, no use after three years of registration under 15 U.S.C. § 1064(6)), and (e) abandonment. (9 TTABVUE ¶ 39.) Count One should be dismissed in its entirety because, with respect to each of the aforementioned grounds, the Amended Petition either fails to state a claim (even accepting

the pleaded allegations as true); fails to plead essential elements of the asserted causes of action; and/or relies solely upon conclusory and threadbare allegations that are not legally entitled to any presumption of truth.

A. *Misclassification of Goods/Services Is Not Grounds for Cancellation.*

Petitioner asserts that the U.S. Word Mark Registration should be partially cancelled because the International Class 9 goods identified in the registration are misclassified. (*See* 9 TTABVUE ¶ 39(A)(1)(i) (“This registration under Class 9 is designed to appropriate fields of entertainment and events as opposed to the apparatus itself and is not registrable on the Principal Register and should be cancelled.”); *see also* 9 TTABVUE ¶¶ 39(A)(3), 39(A)(4).) This is a strange assertion, given that Goodwood’s identification of goods fits well within the normal boundaries of International Class 9 filings under U.S. practice.

But even if Petitioner’s assertion were true—which plainly it is not—the claim fails as a matter of law, because the Lanham Act does not permit cancellation of a registered trademark based on grounds of a purported misclassification of goods. *See* 15 U.S.C. § 1064; TBMP § 309.03(c)(1). Indeed, the Board has held that “the classification of goods and services is a purely administrative matter within the sole discretion of the USPTO. . . . [A]ny ‘examiner error’ that may have occurred by allowing the goods to remain in International Class 032 does not amount to a ground for cancellation of the pleaded registration.” *21st Century Brands LLC v. LXR Biotech, LLC*, Opp. No. 91205970, 2013 WL 11247296, at *5 (T.T.A.B. Aug. 12, 2013) (striking counterclaim for cancellation based on alleged misclassification of goods).

Moreover, even if the International Class 9 goods identified in the U.S. Word Mark Registration were misclassified (which, again, they are not), it would be improper for the Board to amend the identification—let alone cancel the entire registration—since the U.S. Word Mark Registration was issued pursuant to Section 66(a) of the Lanham Act. *See* Trademark Manual of

Examining Procedure (“TMEP”) § 1402.01(c) (“When the original identification of goods and/or services in a §66(a) application is definite, but misclassified under United States standards, the examining attorney must accept the identification. The international classification of goods and/or services in a §66(a) application may not be changed from the classification assigned by the IB.”). Petitioner’s claim therefore fails as a matter of law.

B. Likelihood of Confusion is Pleaded in Conclusory Fashion.

Petitioner asserts in Count One that the U.S. Word Mark Registration should be cancelled entirely because the goods and services listed in each of the identified classes (9, 25, 35, and 41) “will cause damage to [] Petitioner as there is a likelihood of confusion and Goodwood’s use will damage, dilute, and impair Petitioner’s use of its mark.” (9 TTABVue ¶¶ 39(A)(1)(ii), 39(A)(3)(i), 39(A)(4), 39(B)(i), 39(C), 39(D)(iv).)

However, the Petitioner fails to allege any supporting facts for its conclusion. There is no discussion of any of the likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563 (C.C.P.A. 1973), nor does the claim assert any facts or other probative allegations as to why a likelihood of confusion exists. *See Doyle*, 101 U.S.P.Q.2d at 1782 (“[T]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice and are not accepted as true”). Thus, this claim should be dismissed.

C. Petitioner Again Fails to Meet the Requirements for Pleading Fraud.

The allegation of fraud in the initial Petition failed to meet the heightened pleading standards for fraud claims. Petitioner has failed again in the Amended Petition to meet these standards. Thus, this claim too should be dismissed with prejudice.

“A party alleging fraud in the procurement or maintenance of a registration bears the heavy burden of proving fraud with clear and convincing evidence.” *Chutter, Inc. v. Great Mgmt. Grp., LLC*, Opp. No. 91223018, 2021 WL 4494251, at *5 (T.T.A.B. Sept. 30, 2021)

(precedential) (*citing In re Bose Corp.*, 91 U.S.P.Q.2d 1938, 1939-40 (Fed. Cir. 2009)). Also, fraud must be pleaded with “particularity.” Fed. R. Civ. P. 9(b). After having an opportunity to rectify its first pleading, Petitioner has again failed to properly plead the required elements of fraud in the Amended Petition to meet these standards. This is fatal to Petitioner’s fraud claim.

Petitioner asserts that the U.S. Word Mark Registration should be cancelled entirely for fraud with respect to all of the identified classes (9, 25, 35, and 41) because Goodwood purportedly “had no bona fide intention” to use the U.S. Word Mark Registration for these goods “at the time of Goodwood’s § 66(a) Declaration,” and “further made such claim through actual fraud” because

Goodwood (a) knew that the representations were false when made and said false representations were material to the application and (b) made the representations for the purpose of obtaining [the U.S. Word Mark Registration] for this class of Goods and knew that it was not entitled to said registration.

(9 TTABVUE ¶¶ 39(A)(2)(ii), 39(B)(ii), 39(C), 39(D)(i).)

This assertion is baseless, and Goodwood denies any suggestion that its declarant’s representations were inaccurate.⁴ More importantly for purposes of this dismissal motion, Petitioner’s fraud claim is deficient as a matter of law for failure to adequately plead essential elements with the requisite particularity.

Under the Board’s jurisprudence, “[f]raud in procuring or maintaining a trademark registration occurs when an applicant [1] knowingly makes a [2] specific false, [3] material representation of fact in connection with an application or registration [4] with the intent of obtaining or maintaining a registration to which it is otherwise not entitled.” *Basic Sports*

⁴ This assertion is also undermined by Petitioner’s own (admittedly confusing) allegation that Goodwood intends to enforce its registered rights against Petitioner once Goodwood’s registrations become incontestable (*see* 9 TTABVUE ¶ 27). This presupposes that Petitioner will be able to prove continuous use of the marks in the U.S. for five consecutive years, which could hardly be the case if Petitioner never intended to use the marks in the U.S. *See* 15 U.S.C. § 1065.

Apparel, Inc. v. Spiral Direct Ltd., Opp. No. 91242798, 2019 WL 1306914, at *5 (T.T.A.B. Mar. 20, 2019) (citing *Bose*, 91 U.S.P.Q.2d at 1939).

Petitioner recites only three of the four elements—*i.e.*, that the statements were “knowing,” “false,” and “material”—and does so in a threadbare, conclusory fashion that falls far short of the particularity needed to support a fraud claim. For example, the Petition states that Goodwood had no *bona fide* intent to use Goodwood’s Word Mark, but Petitioner alleges no facts that would, if proven, establish such a lack of *bona fide* intent. For instance, Petitioner does not allege—and cannot allege—that Goodwood has no capability to produce U.S. automobile events under its registered mark; that Goodwood has taken no steps to organize U.S. automobile events under its registered mark; that Goodwood has taken no steps to publicize its offerings and intended offerings under that mark in the U.S.; or that Goodwood’s personnel have not consulted potential sponsors of its U.S. events.

Instead, Petitioner makes rote, unsupported conclusory allegations that Goodwood has no *bona fide* intent to use its registered marks in the U.S.—a meager basis for alleging something as serious as fraud on the USPTO. As the Board held in *Basic Sports Apparel*, “[a] fraud claim must set forth all elements of the claim with a heightened degree of particularity in compliance with Fed. R. Civ. P. 9(b).” 2019 WL 1306914, at *5; accord Fed. R. Civ. P. 9(b) (“In alleging fraud or mistake, a party must state with particularity the circumstances constituting fraud or mistake”). And as the Federal Circuit held in *Bose*: “A party seeking cancellation of a trademark registration for fraudulent procurement bears a heavy burden of proof. . . . There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.” 91 U.S.P.Q.2d at 1939 (internal quotation marks omitted).

Finally, Petitioner does not even try to allege one of the required elements for fraud, an intent to deceive the USPTO. As the Federal Circuit held in *Bose*, “[s]ubjective intent to deceive,

however difficult it may be to prove, is an indispensable element in the [fraud] analysis.” 91 U.S.P.Q.2d at 1941. In *STK, LLC v. Backrack Inc.*, Canc. No. 92049332, 2010 WL 9924827 (T.T.A.B. Feb. 25, 2010), the Board held: “[i]ntent is a required element to be pleaded for a claim of fraud.” *Id.* at *3; *accord Basic Sports Apparel*, 2019 WL 1306914, at *5 (dismissing fraud claim because “Opposer has failed to plead the indispensable element of intent.”). Even in *Chutter*, in which the Board held that “reckless disregard [] is the legal equivalent of . . . intent to deceive the USPTO,” the Board—citing *Bose*—stated that “evidence of deceptive intent must be clear and convincing.” *Chutter*, 2021 WL 4494251, at *13. Here, Petitioner’s claim makes no reference to an intent to deceive and asserts no facts upon which the Board could determine—let alone find by clear and convincing evidence—that Goodwood acted with reckless disregard.⁵

D. Petitioner Has Not Adequately Pleaded the New Non-Use Ground for Cancellation of the U.S. Word Mark Registration.

Petitioner asserts that the U.S. Word Mark Registration should be cancelled entirely and with respect to all the identified classes (9, 25, 35, and 41) under the recently enacted Trademark Modernization Act of 2020 (“TMA”). Petitioner’s TMA claim, however, fails as a matter of law, because Petitioner has done nothing more than track the language of the new statute.

The TMA introduced new means to clear “dead wood” from the Federal Register. For example, it established a new *ex parte* procedure to petition for expungement of existing registrations more than three years old by conducting a “reasonable investigation” and submitting to the Director of the USPTO resulting evidence sufficient to establish a *prima facie* case that the mark in the registration has never been used for some or all identified goods or services. 37 C.F.R. § 2.91. In addition, the TMA added Section 14(6) to the Lanham Act,

⁵ The registrant in *Chutter*, unlike Goodwood, admitted that its sworn Section 15 statement was false yet it knowingly chose not to correct the statement or withdraw the Section 15 incontestability filing. Unlike the Goodwood declaration, the statement in the *Chutter* registrant’s declaration was objectively and provably false, and its falsity did not depend on the declarant’s state of mind. *See Chutter*, 2021 WL 4494251, at *12-13.

providing a new ground for cancellation in an *inter partes* proceeding “[a]t any time after the 3-year period following the date of registration, if the registered mark has never been used in commerce on or in connection with some or all of the goods or services recited in the registration.” 15 U.S.C. § 1064(6). However, the new ground for cancellation cannot be established in the case of registrations (like Goodwood’s) secured under Section 66 or 44(e) (where use is not required to register, *see* 15 U.S.C. § 1141f(a)) if the registrant shows “special circumstances that excuse such nonuse.” 15 U.S.C. § 1064.

In its Amended Petition, Petitioner invokes the new Section 14(6). However, the claim suffers from a fatal flaw. While Petitioner may feel it avoided the need to conduct a reasonable investigation by asserting its claim under Section 14(6) instead of using the *ex parte* expungement procedure, its Petition fails to aver facts that would form a basis for its conclusory allegations, which state only that:

Goodwood has never used Goodwood’s First Registration, “Goodwood Festival of Speed,” in commerce for this description of goods anywhere including but not limited to the United States, and has not used said Registration in commerce in the United States for more than three years following registration on September 11, 2018 and cancellation is appropriate pursuant to 15 U.S.C. § 1064 (6)

(9 TTABVUE 21 with respect to certain Class 9 goods, and repeated at pp. 22-25 for other goods and services in Classes 9, 25, and 35, and at pp. 26-27 for Class 41 services “other than Goodwood’s historic event in the United Kingdom.”) As the Board has held, such “threadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice” to survive a dismissal motion on the pleadings. *Doyle*, 101 U.S.P.Q.2d at 1782.

E. Abandonment Is Pleaded in a Contradictory and Conclusory Fashion.

Petitioner asserts that the U.S. Word Mark Registration should be cancelled entirely and with respect to all the identified classes (9, 25, 35, and 41) because, allegedly, “any use has been abandoned and Goodwood has no intention to use [the U.S. Word Mark Registration] for said

goods in the future.” (9 TTABVUE ¶¶ 39(A)(2)(iv); 39(A)(3)(iii), 39(B)(iv), 39(C)(ii), 39(D)(iii).) However, this claim lacks any allegations of facts that might support Petitioner’s conclusion. Because these allegations are conclusory, they “are not accepted as true” and this claim should be dismissed. *Doyle*, 101 U.S.P.Q.2d at 1782.

In addition, these allegations are undermined by Petitioner’s own statements within the Amended Petition. Indeed, how can it possibly be true that Goodwood “has no intention to use” or resume use of the U.S. Word Mark Registration and also be true that Petitioner fears that “Goodwood intends to enforce the registered trademarks.” (9 TTABVUE ¶ 26; *see also* 9 TTABVUE ¶ 25 (Petitioner “suffers injury . . . because *Goodwood has begun enforcement* of both [its registrations] as to third parties.” (Emphasis added.)) Petitioner’s statement that it fears Goodwood’s future enforcement efforts undermines its claim of abandonment, because the admission (which appears within the Amended Petition) contradicts any assertion that Goodwood lacks an intent to use or resume use of the U.S. Word Mark Registration. *See Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 U.S.P.Q.2d 1413, 1417 (T.T.A.B. 2016) (“There are two elements to an abandonment claim: non-use of the mark and intent not to resume use”).

Moreover, while proof of three consecutive years of nonuse creates a rebuttable presumption of abandonment, Petitioner has failed to make any such allegation. The closest that Petitioner comes is an allegation that Goodwood “has not used [the U.S. Word Mark Registration] in commerce in the United States for more than three years following registration on September 11, 2018.” (9 TTABVUE ¶¶ 39(A)(2)(iii); 39(A)(3)(ii), 39(B)(iii), 39(C)(i), 39(D)(ii).) But this elusive allegation allows for the possibility that Goodwood began using the U.S. Word Mark Registration two years after registration (*i.e.*, on September 11, 2020) and has continuously used the mark since that time—which would be for a period of time less than three

years. Such a scenario *would not* trigger the presumption. Because Petitioner’s allegation fails to allege nonuse for *at least three consecutive years*, it fails to trigger the rebuttable presumption of abandonment. This is an additional, independent basis for dismissing the abandonment claim in Count One of the Petition as a matter of law.

III. The Board Should Dismiss Count Two of the Amended Petition.

Count Two of the Amended Petition is virtually identical to the Count One, but instead seeks cancellation of the U.S. Logo Mark Registration and asserts only four grounds for cancellation: (a) misclassification of goods, (b) likelihood of confusion, (c) fraud, and (d) abandonment. (9 TTABVUE ¶ 43.) (There is, and can be, no claim of non-use under the new Section 14(6) of the Lanham Act, as this registration has not been in effect for three years.) These purported claims should be dismissed in their entirety for the same reasons as the analogous claims in Count One.

A. Misclassification of Goods/Services Is Not Grounds for Cancellation.

Petitioner asserts that the U.S. Logo Mark Registration should be partially cancelled because the International Class 9 goods identified in the registration are misclassified. (*See* 9 TTABVUE ¶ 43(A).) As discussed above, the Lanham Act does not permit cancellation of a registration based on grounds of misclassification. (*See supra* at Point II-A.) Accordingly, this claim must be dismissed.

B. Likelihood of Confusion Is Pleaded in Conclusory Fashion.

In Count Two, Petitioner asserts that the U.S. Logo Mark Registration should be cancelled entirely because the goods and services listed in each of the identified classes (9, 25, and 35) “will cause damage to [] Petitioner as there is a likelihood of confusion and Goodwood’s use will damage, dilute, and impair Petitioner’s use of its mark.” (9 TTABVUE ¶¶ 43(A), 43(B)(iii), 43(C)(iii).) The claim fails for all the same reasons as the corresponding cause of

action in Count One—namely, it relies on conclusory and threadbare allegations not entitled to a presumption of truth. (*See supra* at Point II-B.)

C. Petitioner Fails to Meet the Requirements for Pleading Fraud.

Petitioner asserts that the U.S. Logo Mark Registration should be partially cancelled with respect to the International Class 25 and 35 goods and services because Goodwood purportedly “had no bona fide intention to use [the U.S. Logo Mark Registration] at the time of Goodwood’s § 66(a) Declaration, and engaged in fraud.” (9 TTABVUE ¶¶ 43(B)(i), 43(C)(i).) This claim should be dismissed for the same reason as the corresponding claim in Count One—including failure to plead the elements of fraud with the heightened degree of particularity required by Fed. R. Civ. P. 9(b). (*See supra* at Point II-C.)

D. Abandonment Is Pleaded in a Contradictory and Conclusory Fashion.

Petitioner asserts that the U.S. Logo Mark Registration should be partially cancelled with respect to the International Class 25 and 35 goods and services identified in the registration because, allegedly, “any use has been abandoned and Goodwood has no intention to use [the U.S. Logo Mark Registration] for said goods in the future.” (9 TTABVUE ¶¶ 43(B)(ii), 43(C)(ii).) This abandonment claim fails as a matter of law for precisely the same reasons as the abandonment claim in Count One with respect to the U.S. Word Mark Registration, including the contradictory and conclusory nature of the allegations. (*See supra* at Point II-E.)

IV. The Board Should Dismiss Count Three of the Amended Petition.

Count Three of the Amended Petition, like a number of claims in the initial Petition, fails because it asserts violations of U.K trademark law, not U.S. trademark law.

Petitioner asserts a litany of fraud-related allegations solely against the *U.K.* Logo Mark Registration—not the *U.S.* Logo Mark Registration. Petitioner makes allegations as to the

operations of trademark law under the Trade Mark Act of 1994 of the United Kingdom (9 TTABVUE ¶¶ 46-48), and proceeds to allege:

- that “Goodwood falsely represented in the application filed in the United Kingdom that Goodwood was either using or had the bona fide intention to use the mark in the United Kingdom,” meaning that the U.K. Logo Mark Registration was obtained “in bad faith and in contravention of public policy and accepted principles of morality in violation of the provisions of the UK TMA” (9 TTABVUE ¶ 50);
- that the U.K. Logo Mark Registration “is deceptive because it omits the word ‘Goodwood’ from its historic design mark solely to create a registered UK mark . . . and is [] not the actual trademark under which Goodwood has developed common law rights in the United Kingdom” (9 TTABVUE ¶ 51);
- that “Goodwood had no intention when registering [the U.K. Logo Mark Registration] to use [Goodwood’s Logo Mark] in the United Kingdom” (9 TTABVUE ¶ 52);
- that “Goodwood has never used [Goodwood’s Logo Mark] in the United Kingdom” (9 TTABVUE ¶ 53); and
- that the U.K. Logo Mark Registration “is not a qualifying international trademark under Section 66(a)” (9 TTABVUE ¶ 59).

The crux of Count Three is summarized in Paragraph 58 of the Amended Petition, which states: “The USPTO has jurisdiction to determine . . . whether [the U.S. Logo Mark Registration] was based on a fraudulently obtained UK registration that shall [sic] not be registered under the UK TMA and is therefore not entitled to an extension of protection under § 66 (a).” (9 TTABVUE ¶ 58; emphasis added.)

Count Three of the Amended Petition fails to state a claim for relief because the U.S. Logo Mark Registration was secured pursuant to Section 66(a) of the Lanham Act, 15 U.S.C.

§1141f(a)—a provision implementing U.S. obligations under the Madrid Protocol—and, as explained at length in Petitioner’s first Motion to Dismiss, such a registration cannot be invalidated by a collateral attack against a foreign or International Registration in a Board proceeding.

The owner of a Section 66(a) registration “has the same rights and remedies as the owner of a national registration issued on the Principal Register by the USPTO,” TMEP § 1904.07, *accord* 15 U.S.C. § 1141i. Thus, “the cancellation procedures . . . that result in an invalidation of a registered extension of protection are governed by the substantive and procedural law of the United States, and are the same as for national marks registered by the USPTO.” TMEP § 1904.07. Indeed, Section 14 of the Lanham Act does not include grounds for cancelling a U.S. registration by collaterally attacking a foreign or international registration. *See* 15 U.S.C. § 1064; *see also* TBMP § 309.03(c)(1).

Moreover, it would be improper for the Board to adjudicate the validity of the U.K. Logo Mark Registration⁶ based on Petitioner’s allegations of purported fraud on the U.K. Trademark Office, because the Board’s jurisdiction is limited to the U.S. In *Johnson & Johnson v. Salve S.A.*, in the context of a discovery dispute in a cancellation proceeding, the Board held:

[T]here is no provision in the [Lanham] Act of 1946 for challenging the validity of a foreign registration which serves as the basis of a United States application pursuant to the provisions of Section 44(e). That is to say, the only requirement is that such foreign registration be subsisting, *i.e.*, in force, at the time of the filing and registration in the United States.

183 U.S.P.Q. 375, 377 (T.T.A.B. 1974).

In any event, because Count Three asserts that the U.S. Logo Mark Registration should be cancelled based on purported fraud committed in connection with the prosecution of the U.K.

⁶ Petitioner again incorrectly suggests that the U.S. Logo Mark Registration is based on the U.K. Logo Mark Registration. (9 TTABVUE ¶ 58.) Rather, the registration is based on an extension of protection of the International Logo Mark Registration.

Logo Mark Registration (or International Logo Mark Registration)—which cannot be adjudicated by the Board in a cancellation proceeding—Petitioner has failed to state a valid claim for relief. Thus, Count Three should be dismissed with prejudice. *See also* TMEP §§ 1901, 1904.08 (explaining that the International Bureau manages the cancellation of international registrations).

V. **The Board Should Dismiss Count Four With Respect to the U.S. Word Mark Registration.**

Count Four of the Amended Petition purports to assert a claim on grounds of priority and likelihood of confusion against both the U.S. Word Mark Registration and U.S. Logo Mark Registration. (9 TTABVue ¶¶ 60-71.) However, Petitioner’s allegations concerning likelihood of confusion with respect to the U.S. Word Mark Registration (for GOODWOOD FESTIVAL OF SPEED) are too conclusory to withstand a dismissal motion.

It is understandable that Petitioner has difficulty alleging facts to support the suggestion that Goodwood’s Word Mark—which features Goodwood’s name and flagship mark, GOODWOOD, as its dominant element—is confusingly similar to Petitioner’s mark. Indeed, Petitioner twice admits in Count Four that there exists no likelihood of confusion between its own FESTIVALS OF SPEED mark and Goodwood’s Word Mark, which is the subject of Goodwood’s U.S. Word Mark Registration, when Goodwood’s use is in connection with Goodwood’s U.K. events. Petitioner admits:

As applied to Goodwood’s historic event at Goodwood House in the United Kingdom, Petitioner does not contend that [the U.S. Word Mark Registration] causes confusion as Petitioner does not promote events in the United Kingdom and as long as Goodwood’s continued use of Goodwood’s First Registration, ‘Goodwood Festival of Speed’ is in conjunction with its historic event geographically located in Goodwood, Sussex, United Kingdom.” (9 TTABVue ¶ 63 (emphasis added).)

Petitioner further avers that in the U.S. Word Mark Registration, the term

“Goodwood,” means and refers to Goodwood House, Sussex. Accordingly, the consuming public is aware that [the U.K. Word Mark Registration], and [the U.S. Word Mark Registration] relate[] only to the event at Goodwood, Sussex, in the United Kingdom.” (9 TTABVUE ¶ 68 (emphasis added).)

Petitioner also repeats its theory from the initial Petition that registration of Goodwood’s Word Mark in the U.S. is part of a plot to use the mark Petitioner is actually concerned about, FESTIVAL OF SPEED: “All these filings were for the purpose of ultimately registering a ‘festival of speed’ mark” to impair Petitioner’s rights in its FESTIVALS OF SPEED mark. (9 TTABVUE ¶ 67.)

Indeed, Count Four primarily focuses on Goodwood’s U.S. Logo Mark Registration, alleging that “Goodwood intends on head-to-head competition with Petitioner by use of Goodwood’s Second Registration, ‘Festival of Speed’ in the area of events relating to automobiles, motorcycles, yachts, aircraft, and equestrian events” (9 TTABVUE ¶ 66). Petitioner also alleges that registration of Goodwood’s Logo Mark “is confusingly similar as it only varies by one letter” from Petitioner’s FESTIVALS OF SPEED mark (9 TTABVUE ¶ 64) and will be used for “promotion of events of the same depiction and category of” Petitioner’s events under the FESTIVALS OF SPEED mark. (9 TTABVUE ¶ 65.)

In contrast, Petitioner characterizes Goodwood’s U.S. Word Mark Registration as merely “a precursor to filing Goodwood’s [U.S. Logo Mark Registration]” for FESTIVAL OF SPEED (which “in turn was filed as a precursor” to an abandoned Class 41 application for FESTIVAL OF SPEED). (9 TTABVUE ¶ 67.) While Petitioner asserts that Goodwood’s use of the Goodwood’s Word Mark in the U.S. will create a likelihood of confusion, it provides nothing more than conclusory allegations, namely:

- “However, to the extent the mark is to events in the United Kingdom, the mark will result in a likelihood of confusion and damage to Petitioner” (9 TTABVUE ¶ 63);

- “Any use within the United States for events promoted by Goodwood through the use of both Goodwood Registrations create [sic] a likelihood of confusion (9 TTABVUE ¶ 68);
- “Based on the foregoing, there is a likelihood of confusion between Goodwood’s Registrations and the FOS Registration of ‘Festivals of Speed’ requiring cancellation of Goodwood’s registrations with the exception only of the limitation of Goodwood’s First Registration, ‘Goodwood Festival of Speed’ to use with reference to Goodwood’s historic event in the United Kingdom.”

Accordingly, Count Four should be dismissed with respect to the U.S. Word Mark Registration. *See Iqbal*, 556 U.S. at 678 (allegations must be more than “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements”); *Doyle*, 101 U.S.P.Q.2d at 1782 (same).

CONCLUSION

For the foregoing reasons, Goodwood respectfully requests that the Board dismiss with prejudice Counts One, Two, and Three of the Amended Petition, and the claim in Count Four with respect to Goodwood’s U.S. Word Mark Registration.

Dated: New York, New York
February 25, 2022

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CERTIFICATE OF SERVICE

I hereby certify that on this 25th day of February 2022, a copy of the foregoing
**REGISTRANT'S MOTION TO DISMISS THE FIRST AMENDED PETITION FOR
CANCELLATION OF REGISTERED TRADEMARKS** was sent by e-mail to Petitioner's
counsel of record at *don@lawus.com* and *donschutz@netscape.net*.

/Craig S. Mende/
Craig S. Mende