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

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| Proceeding no.         | 92078340   |
| Party                  | Plaintiff<br>Festivals of Speed, LLC   |
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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

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

Petitioner, Festivals of Speed, LLC (“FOS” or “Petitioner”) by and through undersigned counsel, now respectfully opposes the Registrant’s (“Goodwood” or “Registrant”) February 25, 2022 Motion to Dismiss the First Amended Petition (the “Motion”). This Amended Opposition is timely filed through the courtesy of Goodwood’s agreement to a seven-day extension through March 24, 2022 and Petitioner’s timely filing of an agreed motion for extension. This March 22, 2022 amended filing corrects and supersedes Petitioner’s March 21, 2022 filing.

**INTRODUCTION**

Goodwood acknowledges the doctrine that, at the stage of a motion to dismiss, Petitioner’s factual allegations must be accepted as true, yet the Motion commingles inapplicable claims that Petitioner’s allegations are not true<sup>1</sup> with affirmative assertions that either misstate or disregard the actual allegations of the First Amended Petition (the “Petition”) to essentially rely on the premise that Petitioner’s 37 page Petition that pleads facts in specific detail is “conclusory” and “threadbare,” citing *Ashcroft v. Iqbal*, 556 U.S. 662 (2009) (“*Ashcroft v. Iqbal*”) (“Threadbare recitals of the

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<sup>1</sup> As examples, see, Motion, P. 7, “[b]ut even if Petitioner’s assertion were true—which plainly it is not,”; Motion, P. 13, “how can it possibly be true that Goodwood “has no intention to use”.

elements of a cause of action, supported by mere conclusory statements, do not suffice,” and “[a] claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Id.*, at 556 U.S. 678). The Petition plainly puts Goodwood on notice of the factual basis for Petitioner’s claims, pleads fraud with the requisite specificity, and if the alleged facts are ultimately accepted by a trier of fact, Petitioner is entitled to the requested relief. As will be discussed hereinafter, the Petition meets the *Ashcroft v. Iqbal* pleading standards and the Motion must be denied.

As set forth in the Petition, FOS and Goodwood host similar events featuring automobiles, motorcycles, equestrian, yachts, and aircraft, advertising to the same customers and seeking the same sponsors, with FOS operating in the United States since 2005 under its U.S. registered trademark, “Festivals of Speed,” and Goodwood operating in the United Kingdom since at least 1993 under Goodwood’s “Goodwood Festival of Speed” trademark. FOS does not contest Goodwood’s right to continue to promote in the United States Goodwood’s geographically identified event at Goodwood House, Sussex, England, under the internationally protected trademark, “Goodwood Festival of Speed,” that falls within Goodwood’s first Section 66 (a) registration. However, Petitioner contests and seeks cancellation of Goodwood’s right to use Goodwood’s First Registration, “Goodwood Festival of Speed” in the United States for any goods and services other than Goodwood’s historical geographically identified event at Goodwood House, Sussex, England, named “Goodwood Festival of Speed,” and Petitioner contests Goodwood’s right to use Goodwood’s Second Registration, “Festival of Speed” in the United States for any reason. The Petitioner alleges that Goodwood is attempting to enter the U.S. market with the mark “Festival of Speed” by first obtaining an extension for protection under the Madrid Protocol for Goodwood’s First Registration, “Goodwood Festival of Speed,” without any intention of using “Goodwood Festival of Speed” in the United States for anything other than Goodwood’s U.K. event, then obtaining an extension of protection under the

Madrid Protocol for Goodwood's U.K. Registration, "Festival of Speed" as a logo mark, which is the basis of Goodwood's Second Registration "Festival of Speed," a mark it has never used anywhere. The Petition alleges that Goodwood never had any bona fide intention to use "Festival of Speed" in the U.K. and intends to enforce both marks in the United States through the Madrid Protocol without any use of "Festival of Speed" in the U.S and without a bona fide intention to use "Goodwood Festival of Speed" for anything other than its U.K. event. Goodwood's intention, which is not "bona fide," is to usurp Petitioner's "Festivals of Speed" mark by reserving broad classes of goods and services to itself on an intent-to-use basis in I.C. classes 9 ("appliances"), 25 ("clothing"), 35 "business management") and Class 41 (Class 41 only for its First Registration, Goodwood Festivals of Speed, as Goodwood's Class 41 Registration for its Second Registration, "Festivals of Speed" has been rejected and terminated) without either actual use or a bona fide intention to use its mark for those goods and services, but instead, to enter the U.S. market, to drop the geographic identifier, "Goodwood," from its "Goodwood Festival of Speed" mark, and compete head to head in the United States with the Petitioner, FOS, using Petitioner's own name and trademark. Goodwood has been unsuccessful in obtaining a Class 41 registration for "Festival of Speed," and the Petition alleges that Goodwood will use registrations in Classes 9, 25, and 35 for Goodwood's Second Registration, "Festival of Speed" to promote what is, in actuality, goods and services coming within Class 41 for this head-to-head competition in the United States using Petitioner's name and trademark.

The Petition pleads the requisite factual allegations supporting each Count for cancellation. However, responding to the Registrant's claim that the Petition should be dismissed with prejudice and without leave to amend, to the extent that any of Registrant's assertions are accepted and to the extent that any of Petitioner's claims are dismissed, such dismissal should be without prejudice and with leave to amend, *Foman v. Davis*, 371 U.S. 178, 182, 83 S. Ct. 227, 230 (1962) ("[i]n the

absence of any apparent or declared reason -- such as undue delay, bad faith or dilatory motive on the part of the movant, repeated failure to cure deficiencies by amendments previously allowed, undue prejudice to the opposing party by virtue of allowance of the amendment, futility of amendment, etc. -- the leave sought should, as the rules require, be "freely given.""). Petitioner has filed only one amended petition and did so in response to Petitioner's first amended complaint and not in response to an order of dismissal. Accordingly, any dismissal should be with leave to amend and Petitioner so requests.

As alleged in the Petition, FOS is the holder of the Festivals of Speed mark in Class 41, U. S. Registration No. 3665425 with filing date of October 26, 2006, and registration date of August 11, 2009, with Section 8 and Section 10 issued September 29, 2018, and promotes events in the United States featuring automobiles, motorcycles, aircraft, equestrian, and yachts, Petition ¶¶ 1- 6.

#### **I. STANDARD FOR MOTION TO DISMISS**

On review of a motion to dismiss, the Petitioner, "need only allege such facts as would, if proved, establish that (1) [petitioner] has standing to maintain the proceedings, and (2) a valid ground exists for opposing the mark." *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007). The Motion does not contest standing. Petitioner has pled that Petitioner has priority and the Registrant's marks create a likelihood of confusion with sufficient facts to satisfy this pleading requirement:

A "plaintiff is not required to prove the likelihood of confusion at the pleading stage." (citations omitted). Instead, "[t]he likelihood of confusion is a fact-specific inquiry best left for decision after discovery." (citation omitted); see *Government Employees Ins. Co. v. Google, Inc.*, 330 F. Supp. 2d 700, 704 (E.D.Va. 2004) ("Whether defendants' uses are legitimate fair uses of the trademarks in competition, and whether they create a likelihood of confusion, are fact specific issues not properly resolved through a motion to dismiss.") *Mastro's Rests. LLC v. Dominick Grp. LLC*, No. CV 11-1996-PHX-PGR, 2012 U.S. Dist. LEXIS 80200, at \*13-14 (D. Ariz. June 11, 2012).

Goodwood does not contest Petitioner's priority. Goodwood's overall critique is that the Petition is "conclusory" and Goodwood asserts that the Petition fails to allege facts with sufficient specificity. The Petition alleges that Goodwood obtained two U.K. registrations for the purpose of using Petitioner's registered trademark to engage in Petitioner FOS's business in Petitioner's country, the United States. To implement this plan, Goodwood conceived of and has thus far implemented a way to abuse the benefits of the Madrid Protocol to gain all benefits of registration on the principal register for five years, thus far without use for U.S. events, knowing that the lapse of five years will eliminate the ability of FOS to thereafter challenge the marks based on a likelihood of confusion.

As stated hereinafter, FOS states a cause of action in each count and the Motion should be denied. The Petition pleads that Goodwood made false representations in Goodwood's application, which are actionable, *Bart Schwartz International Textiles, Ltd. v. The Federal Trade Commission*, 289 F.2d 665, 129 USPQ 258, 260 (CCPA 1961) ("[T]he obligation which the Lanham Act imposes on an applicant is that he will not make knowingly inaccurate or knowingly misleading statements in the verified declaration forming a part of the application for registration."). Petitioner alleges fraud that is a basis to cancel registrations in any classes relying on fraud, *G&W Laboratories Inc. v. GW Pharma Ltd.*, 89 USPQ2d 1571, 1574 (TTAB 2009) (a finding of fraud as to one class in a multiple-class registration does not require cancellation of all classes in a registration), and in multi-class registrations, the likelihood of confusion may be based on evidence relevant to some classes but not others, *Research in Motion Limited v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1194 (TTAB 2012). Also, cancellation can be based on bad faith in adopting the mark, *DC Comics v. Pan American Grain Manufacturing Co.*, 77 USPQ2d 1220, 1228 (TTAB 2005). Other than in conjunction with Goodwood's historical use of its Goodwood Festival of Speed mark to identify Goodwood's historical U.K. event, Goodwood has not used its marks in the United States. While Goodwood claims that any future use and resulting likelihood of confusion is speculative,

Goodwood cannot have it both ways. Goodwood has claimed in both the U.K. and the U.S., in its applications, that Goodwood intends to use the Mark, and while any such use is currently hypothetical, “[a] plaintiff may plead likelihood of confusion directly or hypothetically,” TBMP 309.03 (c).

**THE PETITION ESTABLISHES A VALID GROUND FOR CANCELLATION**

As set forth in the opening 35 paragraphs of the Petition that are thereafter incorporated by reference in the following Counts, Registrant Goodwood is a Private Limited Company formed in the United Kingdom, and has promoted its “Goodwood Festival of Speed” in the United Kingdom since at least the early 1990s. Goodwood registered two trademarks in the United Kingdom that Goodwood has used for Section 66 (a) extension of protection. Goodwood’s first U.S. mark is Registration No. 5557758 “Goodwood Festival of Speed” in block text letters(Goodwood’s First Registration “Goodwood Festival of Speed”), Petition, ¶ 20

**GOODWOOD FESTIVAL OF SPEED**

Goodwood’s second U.S. registration is Registration No. 6132392 that is a logo mark that deletes the word “Goodwood,” from Goodwood’s traditional logo and uses only “Festival of Speed” in a logo (“Goodwood’s Second Registration “Festival of Speed,”



In comparison, Goodwood’s historical mark as used in the United Kingdom is:



The United Kingdom registers trademarks under the United Kingdom Trade Marks Act of 1994 with only the statement by the applicant “that the trade mark is being used . . . or that he has a bona fide intention that [the mark] should be so used,” Petition ¶ 48. Actual use is not required.

The Petition alleges that Goodwood registered these two marks in the United Kingdom for the purpose of filing the Section 66 (a) registrations under the Madrid Protocol, and as set forth in the Petition, ¶ 9, Goodwood had no bona fide intention of using Goodwood’s First Registration, “Goodwood Festival of Speed” either in the U.K., or the United States, for any events other than Goodwood’s historical event held at Goodwood House, Sussex, United Kingdom, and had no intention at all of using Goodwood’s Second Registration, “Festival of Speed” in the United Kingdom. The Petition alleges that these U.K. registrations therefore did not constitute a “proper filing” as required by 11 U.S.C. § 1141f (b), Petition, ¶ 9(a) (v) when Goodwood filed in the U.S. for



extension of protection under the Madrid Protocol. The Petition alleges that Goodwood knew that under the Madrid Protocol the USPTO would not refuse extension of protection on the ground that the marks had not been used, Goodwood knew that it had no obligation to actually use the marks for five years, Goodwood could claim “constructive use” without any use at all, Goodwood knew that the extension of protection has the same validity as registration on the Principal Register, and Goodwood knew that it would have the same rights and remedies as the owner of a registration on the Principal Register for five years without any use, Petition, ¶ 9, and intended to enforce those rights.

The Petition sets out verbatim Goodwood’s descriptions of goods and services as part of Petitioner’s claim that Goodwood’s declarations of a bona fide intention to use the marks are false. Goodwood has been in business for decades and has never used the phrase “Festival of Speed” as a stand-alone trademark on any goods or services. Further, Goodwood has used its Goodwood Festival of Speed mark only in connection with its event in the United Kingdom. Goodwood’s UK registrations for which it obtained Section 66 (a) extension of protection are an overbroad claim of “intent to use” classifications and the Petitioner asserts that Goodwood has no such bona fide intention. Petitioner has properly pled that Goodwood has no bona fide intention to use the marks. “Because a bona fide intent to use the mark in commerce is a statutory requirement of a valid intent-to-use trademark application under Section 1(b), the lack of such intent is a basis on which an opposer may challenge an applicant's mark.” *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 1375 (Fed. Cir. 2015), and:

There is no statutory definition of the term "bona fide," but the language is clear on its face that an applicant's intent must be "under circumstances showing the good faith of such person." *Id.* The reference to "circumstances showing the good faith" strongly suggests that the applicant's intent must be demonstrable and more than a mere subjective belief. Both the PTO and the leading treatise on trademark law have arrived at this same understanding. See Lane, 33 U.S.P.Q.2d at 1355; 3 McCarthy on Trademarks § 19.14, at 19.48 ("Congress did not intend the issue to be resolved simply by an officer of the applicant later testifying, 'Yes,

indeed, at the time we filed that application, I did truly intend to use the mark at some time in the future."").

*M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 1375 (Fed. Cir. 2015)

The Court in *M.Z. Berger & Co. v. Swatch AG* held that “whether an applicant had a “bona fide intent” to use the mark in commerce at the time of the application requires objective evidence of intent,” *Id.*, 787 F.3d at 1376. Citing *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 1375 (Fed. Cir. 2015), the Court in *Kelly Servs. v. Creative Harbor, LLC*, 846 F.3d 857 (6th Cir. 2017) stated:

As a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment.” *Honda Motor Co., Ltd. v. Winkelmann*, 90 U.S.P.Q.2d 1660, 2009 WL 962810, at \*2 (T.T.A.B. 2009); see also *Smith v. Hudson*, 600 F.2d 60, 66 (6th Cir. 1979) (“[C]ases involving questions of motive or intent are normally not suited to disposition on summary judgment.”). *Id.*, at 864.

Since “intent” is not resolved at the summary judgment stage, it is also not appropriate for resolution at the stage of a motion to dismiss, *Am. Honda Motor Co. v. Motorcycle Info. Network, Inc.*, 390 F. Supp. 2d 1170, 1177 (M.D. Fla. 2005) (“[t]he intent of the parties is a factual matter that cannot be resolved on a motion to dismiss.”).

Also, the Court in *Kelly Servs. v. Creative Harbor, LLC*, 846 F.3d 857 (6th Cir. 2017) identified factors that, if proven, “may cast doubt on the bona fide nature of the intent or even disprove it entirely,” *Id.*, at 864, including several factors Petitioner has pled and that are applicable to Goodwood, such as “numerous intent-to-use applications to register the same mark for many more new products than are contemplated, . . . an excessive number of intent-to-use applications to register marks which ultimately were not actually used, an excessive number of intent-to-use applications in relation to the number of products the applicant is likely to introduce under the applied-for marks during the pendency of the applications, or applications unreasonably lacking in specificity in describing the proposed goods,” *Id.*, 864-865.

Goodwood’s classifications are all essentially “intent-to-use” registrations for any purpose other than the mark “Goodwood Festival of Speed” to describe its U.K. event and cast doubt on Goodwood’s bona fide intention because no other use has been made. For example, Goodwood’s registration for “Goodwood Festival of Speed” in the U.S. for Class 9 includes eight different types of publications for six different fields, fourteen different types of storage media, “software and programs” for “entertainment, training, and education” in motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings,” training simulators, downloadable publications and on-line data bases for motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings, “virtual reality systems,” headsets, glasses, “computer chips,” “time and date stamping machines,” and “parts and fittings for all the aforesaid goods.” The Petition alleges that Goodwood has made no such use, and the Petition alleges that Goodwood has never used “Festival of Speed” for any goods and services in any of the classes Goodwood has registered.

The Petition, at pages 5-9, sets out the registrations verbatim, and they exactly fit the criteria for cancellation of *Kelly Servs. v. Creative Harbor, LLC*, 846 F.3d 857 (6th Cir. 2017) that, if proven, “may cast doubt on the bona fide nature of the intent or even disprove it entirely,” *Id.*, at 864, including “numerous intent-to-use applications to register the same mark for many more new products than are contemplated,” *Id.*, at 864.

After pleading that Goodwood filed its U.K. registrations only to obtain the Section 66 (a) registration, Petitioner pleads that Goodwood had no intent to use Goodwood’s Second Registration, “Festival of Speed” in the U.K., and Goodwood had no intent to use Goodwood’s First Registration, “Goodwood Festival of Speed” for any events other than its historical event in the U.K., the Petitioner alleges:

¶ 13-16, Goodwood unsuccessfully attempted to obtain Class 41 registration for Goodwood’s Second Registration, Festival of Speed;

¶ 17-19; Goodwood hosts its Goodwood Festival of Speed with the geographic identifier “Goodwood” at Goodwood House, U.K.;

¶ 19 Goodwood has never hosted an event outside of the geographical location of Goodwood House, West Sussex, England, named either “Goodwood Festival of Speed” or “Festival of Speed”;

¶19-21, Goodwood uses the “Goodwood Festival of Speed” logo, not the “Festival of Speed” logo depicted in Goodwood’s Second Registration, “Festival of Speed,” with examples:



¶22-25, Goodwood’s descriptions are broad and encompassing, the Petitioner will be damaged as a result of likelihood of confusion, blurring, or dilution, Petitioner has senior use because Goodwood is using the exact verbiage with the only difference between the singular “festival” instead of Petitioner’s plural, “festivals.”

¶ 26 clearly alleges that Goodwood filed both registrations “with no bona fide intention of using both marks in the United States for the five-year period of incontestability without use, and

thereafter, Goodwood intends to enforce the registered trademarks as incontestable marks even though Goodwood has made no use for the full five year period . . .”

¶¶27-28, Goodwood will have the right to enforce its marks as incontestable marks after five years, and during that period Petitioner will be impaired in utilizing FOS’s mark for such common activities as online webpages in the form of magazines, labeling promotional flash drives, broadcasting television and internet video content, selling clothing with the FOS mark, and related common business practices. FOS is open to the specter of infringement litigation for FOS using FOS’s senior mark.

¶¶29-31 alleges that FOS is sustaining injury in fact, FOS will face infringement litigation for using its own mark, and with the deletion of the geographic reference “Goodwood” there is a likelihood-of-confusion because both companies engage in the same business featuring automobiles, motorcycles, aircraft, and yachts, for the same customers, and the same sponsors.

¶¶ 32-35 allege that Goodwood unsuccessfully attempted to register its “festival of speed” logo, the Second Registration, in Class 41, and Goodwood’s intent is to engage in goods and services that are in reality defined within Class 41 and will compete with Petitioner under the guise of Class 9, 25, and 35 registrations.

II. Count One States a Cause of Action for Cancellation of Goodwood’s First Registration, “Goodwood Festival of Speed.”

Count One is for cancellation of Goodwood’s First Registration, “Goodwood Festival of Speed.” The Motion complains about Petitioner pleading “entirely unrelated grounds,” but to the contrary, separate counts are properly pled as to the relief requested, not the factual grounds for relief, *Anderson v. Dist. Bd. of Trustees of Centr. Fla. Cmty. Coll.*, 77 F.3d 364, 366 (11th Cir. 1996) (a properly drawn complaint "will present each claim for relief in a separate count, as required by Rule 10(b)"). There is no requirement to separate each discrete factual basis for cancellation of the

same trademark into separate counts, however, if so required Petitioner asks for leave to amend and plead multiple separate counts for the same relief as needed.

A. Registrations may be Cancelled in Whole or in Part.

Count One pleads that Madrid Protocol extension of protection “shall be refused to any mark not registrable on the Principal Register,” 15 U.S.C. § 1141h (a) (4), and thereafter pleads with specificity the factual basis to cancel this trademark in separate paragraphs for Class 9, Class 25, Class 35, and Class 41. Contrary to the assertion of the Motion, the Petition pleads all factors articulated by *In re E. I. Du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973) applicable to this dispute as follows:

(1) Regarding the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression, the Petition pleads that the only difference in the marks is that Petitioner’s mark is the plural, “festivals” and Goodwood’s mark is the singular, “festival” and Goodwood’s mark begins with the word, “Goodwood” that refers to Goodwood House, Sussex, United Kingdom.

(2) Regarding the similarity or dissimilarity and nature of the goods or services the Petition pleads that FOS and Goodwood host events featuring automobiles, motorcycles, aircraft, equestrian, and yachts in different countries, FOS in the United States, Goodwood in the U.K., while pursuing the same customers and sponsors.

(3) Regarding the similarity or dissimilarity of established, likely-to-continue trade channels, the Petition pleads that FOS and Goodwood seek the same customers and sponsors.

(5) Regarding the fame and length of use of Petitioner’s mark, the Petition pleads use of Petitioner’s senior mark since 2006 in the United States, with Goodwood using its “Goodwood Festival of Speed” mark in the United Kingdom since at least 1993.

(6) As to actual confusion, because Goodwood has not used Goodwood's First Registration, "Goodwood Festival of Speed" mark for any events other than its U.K. event, and because Goodwood has not used Goodwood's Second Registration, "Festival of Speed" at all, again, due to the fact that the Madrid Protocol allows "intent to use" registrations under U.K. law to have the same rights as all trademarks on the Principal Register, and due to the fact that Goodwood has exploited that extension of protection without any bona fide intent to use the marks in the U.S., there is, as of yet, no use. However, the Petition reasonably pleads that there is a likelihood of confusion in the hypothetical context of future use, and "[a] plaintiff may plead likelihood of confusion directly or hypothetically," TBMP 309.03 (c).

Goodwood cites the non-precedential opinion of *21st Century Brands LLC v. LXR Biotech, LLC*, Opp. No. 91205970, 2013 WL 11247296, at \*5 (T.T.A.B. Aug. 12, 2013) asserting that this opinion struck a counterclaim on the alleged misclassification of goods). The opinion states on its face, "This Opinion is Not a Precedent of the TTAB," the opinion was on the opposer's motion for summary judgment not a motion to dismiss. *21st Century Brands LLC v. LXR Biotech, LLC*, Opp. No. 91205970, at \*7 (T.T.A.B. Aug. 12, 2013). If anything, this opinion stands for the proposition that these issues should not be disposed of on a motion to dismiss. Petitioner here asserts that registration "includes goods and services that are not properly included under Class 9 . . . have never been used and/or have been abandoned . . . and are "therefore not registerable on the Principal Register per 15 U.S.C. § 1141h (a) (4)." "A party with standing can oppose the request for extension under § 68, 15 U.S.C. § 1141h, or they can petition to cancel the registration under § 69, 15 U.S.C. § 1141i," *Sandro Andy, S.A. v. Light Inc.*, 2012 U.S. Dist. LEXIS 182401, at \*9 (S.D.N.Y. Dec. 27, 2012), in which the Court states:

There can be a period of time during which a holder of a registration based on § 66(a) has not actually used the mark in commerce but still asserts a bona fide intention to do so. It is in this liminal state that a petition to cancel a registration on the ground of a lack of bona fide intent

to use the mark can be heard. It makes no difference that Sandro Andy has progressed from the initial request for an extension to the actual grant of the registration. What matters is whether Sandro Andy used the mark and then abandoned it, or, as here, where Sandro Andy allegedly never intended to use it in the first place.

*Sandro Andy, S.A. v. Light Inc.*, 2012 U.S. Dist. LEXIS 182401, at \*9 (S.D.N.Y. Dec. 27, 2012).

The overall approach in the Motion to dismiss is to claim that all Goodwood must do is claim an intent to use, which *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 1375 (Fed. Cir. 2015), states is not sufficient to avoid cancellation. Goodwood also claims that Petitioner FOS cannot seek to cancel Goodwood's registration for a lack of bona fide intent to use the mark, which is exactly what *Sandro Andy, S.A. v. Light Inc.*, 2012 U.S. Dist. LEXIS 182401, at \*9 (S.D.N.Y. Dec. 27, 2012) states that Petitioner may do<sup>2</sup>. The Motion is baseless. Further, Goodwood misstates TMEP § 1402.01(c) providing that examining attorneys must accept the identification of goods and the identification may not be changed because that does not mean that extension for protection must be granted. To the contrary, per 15 U.S.C. § 1141h (a) (4), extension of protection "shall be refused to any mark not registrable on the Principal Register," and a registered extension of protection may be invalidated or revoked in whole or in part, TMEP § 1904.07, and "[i]n the case of partial invalidation, the USPTO will not cancel the registered extension of protection but, instead, delete the relevant goods/services from the USPTO's electronic records for registration," and "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.<sup>3</sup> Cancellation can be of the extension for protection in whole or in part. Misclassified goods and services may be cancelled.

B. Likelihood of Confusion is Not Pled in a Conclusory Fashion.

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<sup>2</sup> The opinion in *Sandro Andy, S.A. v. Light Inc.*, 2012 U.S. Dist. LEXIS 182401 (S.D.N.Y. Dec. 27, 2012) is cited in the First Amended Complaint, FN 2, Page 10.

<sup>3</sup> TMEP § 1904.07 and these excerpts are cited verbatim in the First Amended Complaint, Page 10.



Petitioner FOS and Respondent Goodwood put on similar automobile and related events, advertising to the same customers, seeking the same sponsors, with FOS in the United States, Goodwood in the U.K. Now Goodwood seeks to come to the United States and use the FOS trademark, only in the singular “festival” instead of the plural “festivals” to put on motorsport events. Goodwood’s First Registration, “Goodwood Festival of Speed” does not create a likelihood of confusion as long as Goodwood uses its trademark to refer to the geographically based Goodwood Festival of Speed at Goodwood House, Sussex, United Kingdom. But if Goodwood, for example, comes to Miami to host a “Festival of Speed” using Goodwood’s Festival of Speed mark, or promotes a “Goodwood Festival of Speed,” in Orlando, there will be a likelihood of confusion. The Petitioner has clearly pled a factual basis for the claim that there will be a likelihood of confusion. Again, “[a] plaintiff may plead likelihood of confusion directly or hypothetically,” TBMP 309.03 (c). Since the Madrid Protocol does not require use, likelihood of confusion has to be pled as a hypothetical because there is no actual use.

C. Fraud is Pled with Specificity.

Goodwood’s authority for the requisite pleading standards when pleading fraud, *Chutter, Inc. v. Great Mgmt. Grp., LLC*, Opp. No. 91223018, \*5 (T.T.A.B. Sept. 30, 2021) supports FOS, not Goodwood. First of all, Goodwood relies not on a pleading requirement referenced in the opinion, but upon the “heavy burden of proving fraud with clear and convincing evidence,” Motion, P. 8. Here, on a motion to dismiss, the clear and convincing standard of proof is inapplicable since all Petitioner’s allegations of facts are deemed true, *Nielsen v. Rabin*, 746 F.3d 58, 62 (2d Cir. 2014) (a district court must accept the factual allegations set forth in the complaint as true, and draw all reasonable inferences in favor of the plaintiff). Further, in *Chutter, Inc. v. Great Mgmt. Grp., LLC*, Opp. No. 91223018, (T.T.A.B. Sept. 30, 2021) a party unsuccessfully attempted to amend a Petition to add allegations of fraud, and after the motion to amend was denied, attempted to argue those facts.

The argument was not considered due to the denial of the motion to amend, *Id.*, at 7, but nevertheless, even though the Board did not consider the “unpleaded fraud claim,” *Id.*, at 7, the Board did consider the same facts on the issue of an intent to deceive the USPTO when the registrant’s attorney filed a declaration and the Board applied the “reckless disregard” standard and the “willful blindness” standard to satisfy the “intent to deceive” requirement, *Id.* at 18- 23 and granted the Petition to Cancel, “on the ground of fraud,” *Id.*, at 26.

FOS has alleged that Goodwood made a knowingly false statement in obtaining the extension of protection under the Madrid Protocol, Paragraph 39 A (2) (ii) (“Goodwood had no bona fide intention to use Goodwood’s First Registration, “Goodwood Festival of Speed at the time of Goodwood’s § 66 (a) Declaration and knew the representations were false when made . . .”). This is exactly what the Board ruled in *Chutter, Inc. v. Great Mgmt. Grp., LLC*, Opp. No. 91223018, (T.T.A.B. Sept. 30, 2021) constitutes fraud justifying cancellation by saying that a false declaration, “allows a registrant to obtain a new right which it would not otherwise have,” *Id.*, at 14, and, “[t]he agency . . . must be able to rely on declarations and the truth of their contents. . . The benefits of registration are [too] substantial,” *Id.*, at 25, citing *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. CT. 1293, 113 USPQ2d 2045, 2056 (2015). Goodwood disregards the pleading standards on a motion to dismiss and resorts to claiming, “[t]his assertion is baseless, and Goodwood denies any suggestion that its declarant’s representations were inaccurate,” which is contrary to the pleading standard requiring Petitioner’s allegations to be accepted as true, *Nielsen v. Rabin*, 746 F.3d 58, 62, *supra*. Goodwood asserts that the Petitioner failed to allege “intent,” disregarding Petitioner’s allegations in Paragraph 9, incorporated by reference into this Court, that Goodwood made representations “with actual knowledge” that Goodwood’s registrations would cause confusion, mistake, or to deceive, because the registration was confusingly similar to Petitioner’s, Goodwood knew that Petitioner had superior rights, Goodwood had no reasonable belief that there was no

likelihood of confusion, and had actual knowledge that Goodwood's registrations did not constitute a "proper filing" due to the fact that there was no intent to use the trademarks, but instead, Goodwood's intent was to enforce the trademarks without any bona fide intent to use the marks, in violation of 15 U.S.C. § 1141f (b) *Fujisawa Pharm. Co. v. Kapoor*, 814 F. Supp. 720, 728 (N.D. Ill. 1993) ("Rule 9(b) provides that questions of intent may be averred generally, Fed. R. Civ. P. 9(b), and the scienter requirement may be satisfied by pleading reckless conduct . . . [and] [m]otive and opportunity to commit the charged fraud will give rise to a strong inference of scienter." *Id.*, at 728.

Petitioner pleads the motive to usurp Petitioner's trademark rights through the extension of protection under the Madrid Protocol to marks Goodwood has never used and affirmatively alleged that Goodwood made false statements to the USPTO to implement that plan. This satisfactorily pleads intent.

#### D. The Petition Pleads Non-Use for Three Years.

The Petitioner not only contends that Goodwood never had any bona fide intention to use Goodwood's First Registration, "Goodwood Festival of Speed," the Petitioner asserts that Goodwood has never used and has abandoned the use of this trademark for any products or services other than Goodwood's historical event at Goodwood House, Sussex, England, ¶ 39. Goodwood's claim that this is a "threadbare" allegation disregards the definition of the word, "never." "The word never is a humble Anglo-Saxon word, but it is emphatic. See Oxford English Dictionary (Draft rev. ed. June 2010) ("At no time or moment; on no occasion; not ever."). *United States v. Whitten*, 610 F.3d 168, 200 n.24 (2d Cir. 2010). This is not a "threadbare" allegation, but instead, is a very emphatic statement of exclusionary fact that is accepted as true at this pleading stage. Never means never. Goodwood never used the Goodwood Festival of Speed mark for three years.

#### E. Abandonment is Properly Pled.

Finally, as to Count One, Goodwood asserts that “abandonment” is not properly pled arguing that, because Goodwood has begun enforcement, that conflicts with abandonment. To the contrary, the unique power offered under the Madrid Protocol, and why fidelity to truth is required in pursuing extensions of protection under the Madrid Protocol, is that Goodwood has the right to enforce a trademark without any use of the trademark. Goodwood has all of the power of the holder of a trademark on the principal register without ever having used the mark. Goodwood also quibbles about the theoretical possibility that Goodwood could have started using the mark and failed to trigger the rebuttable presumption, disregarding the fact that Petitioner did not, and is not required to, attempt to extinguish any theoretical fact patterns relating to presumptions. The Petition properly pleads abandonment.

III. Count Two States a Cause of Action for Goodwood’s Second Registration, “Festival of Speed.”

Count Two is for cancellation of Goodwood’s Second Registration, “Festival of Speed.” The primary difference in the facts Petitioner alleges as to Goodwood’s First Registration, “Goodwood Festival of Speed,” and Goodwood’s Second Registration, “Festival of Speed,” is that Goodwood used and intends to use Goodwood’s First Registration, “Goodwood Festival of Speed,” in relation to Goodwood’s historic use of the term in relation to Goodwood’s geographically identified event at Goodwood House, Sussex, England, but did not have a bona fide intention to use that trademark in the United States and has not used that trademark in the United States for more than three years since the registration. As to Goodwood’s Second Registration, “Festival of Speed,” Goodwood obtained its U.K. registration fraudulently by falsely claiming an intent to use “Festival of Speed” in the U.K., which was false, and after obtaining a U.K. registration based on false representations, obtained an extension of protection under the Madrid Protocol with the intention of enforcing the mark in the United States, without using the mark, for five calendar years and thereby obtain the benefits of

incontestability before use. In the Motion, Goodwood adopts its arguments in Paragraphs A, B, C, and D for Count One, without restating the same, so in opposition, the Petitioner adopts Petitioner's above responses for Paragraphs A, B, C, and D and will not restate the same.

IV. Count Three States a Cause of Action for Cancellation due to Fraud as to Goodwood's Second Registration, "Festival of Speed."

Count Three is for cancellation of Goodwood's Second Registration, "Festival of Speed," based on fraud. This Count is premised on the original filing in the United Kingdom under the U.K. Trade Marks Act of 1994 (the "UK TMA") which provides, in pertinent part, that "[a] trademark shall not be registered if it is (a) contrary to public policy or accepted principles of morality," *Id.*, Sec. 3 (3) (a), and "[a] trade mark shall not be registered if or to the extent that the application is made in bad faith," *Id.*, Sec. 3 (6). The Petition, in ¶¶ 46 – 49, states that Goodwood filed its U.K. application that would become the basis for Goodwood's Second Registration, "Festival of Speed," under the Madrid Protocol in the United States, by falsely representing that Goodwood had the bona fide intention to use the mark in the United Kingdom and thereby obtained the U.K. registration in bad faith and contrary to the principles of morality. Because Goodwood had actual knowledge that Goodwood was not entitled to U.K. registration, Goodwood knew that Goodwood was not entitled to an extension of protection under § 66 (a). Although the Motion asserts that, "a registration cannot be invalidated by a collateral attack against a foreign or International Registration in a Board proceeding," Goodwood cites no direct authority and Goodwood disregards the fact that the Petition is not a collateral attack on the foreign petition. Goodwood cites no authority stating this affirmative claim. The Petition clearly alleges in Count Three, at ¶ 54, that when Goodwood filed with the USPTO its application for extension of protection, Goodwood had obtained the U.K. mark with no intent to use the mark in the U.K., but intended only to apply for an extension of protection in the United States and thereby obtain the benefits of registration on the Principal Register without

ever using the mark in the United States. ¶ 55 alleges that Goodwood knew that it had obtained its U.K. mark in bad faith and in contravention of the application requirements of the UK TMA and knew that the mark was not validly subsisting within the United Kingdom, but “knowingly falsely represented to the USPTO within the United States that is UK Trade Mark No. UK00003301170 was valid and subsisting and therefore knowingly falsely represented that said mark was not obtained in bad faith, was not contrary to public policy, and was not subject to absolute cancellation and made the false representations for the purpose of obtaining the § 66(a) registration for which it was not otherwise entitled.” While Goodwood acknowledges at Motion, P. 17, that “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,” Goodwood then claims that 15 U.S.C. § 1064 does not include collaterally attacking a foreign registration but disregards 15 U.S.C. § 1064 (3) stating, in pertinent part, that a petition to cancel may be filed at any time if “its registration was obtained fraudulently.” Since 15 U.S.C. § 1064 explicitly provides for cancellation for obtaining registrations fraudulently, and since “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,” then fraudulently obtaining extension of protection is explicitly identified as a legitimate ground for cancellation of extension of protection under the Madrid Protocol. Goodwood relies on *Johnson & Johnson v. Salve S.A.* , 183 U.S.P.Q. (BNA) 375 (Trademark Trial & App. Bd. September 3, 1974), a discovery case under Section 44 (e) that is not based on claims of fraud.

There is nothing under the Madrid Protocol that permits holders of foreign trademarks to commit fraud on the USPTO in applying for extensions of protection. The earlier cited reference to *Chutter, Inc. v. Great Mgmt. Grp., LLC*, Opp. No. 91223018, \*5 (T.T.A.B. Sept. 30, 2021), *supra.*, is on point, where a trademark was cancelled due to a fraudulent representation as to use. There is

nothing in the applicable statutes to suggest that some types of fraudulent declarations are not actionable, while others are, and that a fraudulently obtained foreign trademark is entitled to an extension of protection and granted all rights of the holder of a trademark on the Principal Register. Moreover, the Petition alleges that Goodwood's representation to the USPTO that Goodwood intended to use the mark was false.

Fraud in procuring or maintaining a trademark registration occurs when an applicant for registration, or a registrant in a post registration setting, knowingly makes a false, material representation of fact in connection with an application to register, or a post registration document, with the intent of obtaining or maintaining a registration to which it is otherwise not entitled. *Id.*, at 12.

In incorrectly stating that 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. Logo Mark Registration . . . which cannot be adjudicated by the Board in a cancellation proceeding," Goodwood conflates fraud on the USPTO in the application for the extension of protection with the prosecution of the foreign application. In *Melodrama Publ'g, LLC v. Santiago*, 2013 U.S. Dist. LEXIS 56988 (S.D.N.Y. Apr. 10, 2013), the Court states:

Finally, Melodrama also seeks cancellation of Santiago's registration on grounds of fraud. See 15 U.S.C. § 1064(3). To prevail on this claim, Melodrama "must establish misstatements that 'indicate a deliberate attempt to mislead the [PTO]' and were 'with respect to a material fact -- one that would have affected the PTO's action on the application.'" *Melodrama Publ'g, LLC v. Santiago*, 2013 U.S. Dist. LEXIS 56988, at \*15-16 (S.D.N.Y. Apr. 10, 2013).

Goodwood does not, indeed cannot, cite to any authority for Goodwood's proposition that a foreign trademark holder may commit fraud in obtaining an extension of protection in the United States under the Madrid Protocol. Here, Goodwood filed applications for U.K. trademarks that Goodwood knew were false, and then made false statements of fact to the USPTO to gain the registrations that Petitioner seeks to cancel. As stated in 15 U.S.C. § 1064 (3), fraud is a basis to cancel any registration and the Petitioner has properly alleged fraud by Goodwood.

V. Count Five States a Cause of Action for Likelihood of Confusion as to Goodwood's First Registration, "Goodwood Festivals of Speed."

Count Five seeks cancellation of both of Goodwood's U.S. Registrations, Goodwood's First Registration, "Goodwood Festival of Speed," and Goodwood's Second Registration, "Festival of Speed," for likelihood of confusion. Goodwood seeks dismissal of this Count only as to Goodwood's First Registration, "Goodwood Festival of Speed." Goodwood's sole premise is that the word, "Goodwood," precludes confusion. As long as the trademark "Goodwood Festival of Speed" refers to Goodwood's historic event at Goodwood House, Sussex, England, Petitioner agrees. However, this is a word mark that Goodwood has not used in the United States for any purpose other than its U.K. event. As a word mark, Goodwood is not restricted to how prominently it may choose to display the differentiating word, "Goodwood," in actual use. Goodwood is not restricted as to font size, colors, or other presentation criteria. FOS and Goodwood, for all practical purposes, promote similar events on the same subject matter and advertise to the same customers and sponsors. There is a presumption that similar or the same goods move through trade channels to all usual classes of consumers of such goods, *Schieffelin & Co. v. Molson Companies Ltd.*, 9 USPQ2d 2069, 2073(TTAB 1989). Further:

"[i]f the registrant . . . obtains a standard character mark without claim to any particular font, style, size or color, the registrant is entitled to depictions of the standard character mark regardless of font style, size, or color." *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 1353 (Fed. Cir. 2011). In other words, if the registration does not limit the appearance of the mark to certain trade dress, stylization, trade channels of distribution, the markholder can change such uses at any time. Accordingly, a district court in a § 1071(b) action should not determine that an applied-for mark is not likely to cause confusion based on how the mark is currently used in the marketplace unless the registration application limits the markholder to such usage. Instead, the district court, like the TTAB, must base its likelihood of confusion analysis on the description of the applied-for mark and any limitations on usage that are included in the application. *Combe Inc. v. August Wolff GMBH & Co. KG Arzneimittel*, 382 F. Supp. 3d 429, 445-46 (E.D. Va. 2019).



Because Goodwood has not used its Goodwood Festival of Speed mark in the United States, and because it is a word mark and therefore not restricted in its presentation, the additional word “Goodwood” cannot be held as a matter of law to eliminate likelihood of confusion. “Likelihood of confusion is a question of fact.” *Dorpan, S.L. v. Hotel Meliá, Inc.*, 728 F.3d 55, 64 (1st Cir. 2013). Further, “[s]imilarity of the marks in particular can be highly influential when the products bearing those marks “directly compete.” *Oriental Fin. Grp., Inc. v. Cooperativa De Ahorro Y Crédito Oriental*, 832 F.3d 15, 26 (1st Cir. 2016). A difference in verbiage does not eliminate a likelihood of confusion as a matter of law, *Block Drug Co. v. Den-Mat Inc.*, 1989 TTAB LEXIS 67 (Trademark Trial & App. Bd. April 25, 1989) (denying registration of POWER DENT for denture stain remover and cleanser on the ground that applicant's mark so resembles the mark "POLIDENT"). Also, the word, “Goodwood” is a geographic identifier referring to Goodwood House, Sussex, England. “For “distinctiveness” purposes, geographic based names can never be considered inherently distinctive; instead they are considered merely descriptive in nature.” *Miller's Ale House, Inc. v. Boynton Carolina Ale House, LLC*, No. 09-80918-CIV-MARRA/JOHNSON, 2009 U.S. Dist. LEXIS 129789, at \*29-30 (S.D. Fla. Oct. 13, 2009). Further, “the likelihood of confusion is an “inherently factual issue.” *Swatch AG v. Beehive Wholesale, LLC*, 739 F.3d 150, 155 (4th Cir. 2014) (quoting *Petro Stopping Centers, L.P. v. James River Petroleum, Inc.*, 130 F.3d 88, 92 (4th Cir. 1997)). It is invariably a question for the jury to decide. *Anheuser-Busch, Inc. v. L. & L. Wings, Inc.*, 962 F.2d 316, 318 (4th Cir. 1992). *Hyperheal Hyperbarics, Inc. v. Shapiro*, 404 F. Supp. 3d 953, 971 (D. Md. 2019). At this stage of pleadings on a motion to dismiss, the addition of Goodwood’s “Goodwood” geographic identifier to Petitioner’s “Festivals of Speed” trademark, as a word mark, to result in Goodwood’s First Registration, “Goodwood Festival of Speed,” wherein Goodwood is not limited in any presentation of how prominent the word “Goodwood” is used, does not establish as a matter of

law that no likelihood of confusion can be alleged or proven.

### CONCLUSION

In conclusion, the Petitioner has properly pled all counts. Goodwood conceived and implemented a plan to file U.K. registrations based on fraudulent claims of intent to use, made fraudulent representations to the USPTO in order to induce the extension of protection under the Madrid Protocol and thereby obtain the rights of a holder of a trademark on the Principal Register without use, and to ultimately wait five years to gain incontestability and then compete head-to-head with Petitioner in the United States. For the reasons stated herein, the Motion should be denied. To the extent that any aspect of the Motion is granted, for the reasons stated above, Petitioner seeks leave to amend.

Dated: March 22, 2022 at St. Petersburg, Florida

Certificate of Service: I hereby certify that on this 22st day of March 2022, the foregoing PETITIONER'S OPPOSITIOREGISTRANT'S MOTION TO DISMISS THE FIRST AMENDED PETITION FOR CANCELLATION OF REGISTERED TRADEMARKS was sent by e-mail to Respondent's counsel of record Craig Mende, Esq., at [cmende@fzlj.com](mailto:cmende@fzlj.com), and Daniel Nuzzaci at [dnuzzaci@fzlj.com](mailto:dnuzzaci@fzlj.com).

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