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

Proceeding no.	92078340
Party	Plaintiff Festivals of Speed, LLC
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Date	08/30/2022
Attachments	Second Amended Petition.pdf(1190773 bytes)

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

In re:

Registrations of The Goodwood Estate Company
Private Limited Company United Kingdom
Goodwood, Chichester, West Sussex PO 18 0PX United Kingdom

First Mark: GOODWOOD FESTIVAL OF SPEED

Registration Number 5557758
International Registration Number 1370233
Registration Date September 11, 2018

Second Mark: FESTIVAL OF SPEED

Registration Number 6132392
International Registration Number 1449837
Registration Date August 25, 2020

FESTIVALS OF SPEED, LLC, A Florida
Limited Liability Company,
Petitioner,

CANCELLATION NO. 92078340

:

v.

THE GOODWOOD ESTATE COMPANY
PRIVATE LIMITED COMPANY UNITED KINGDOM,
Registrant.

**SECOND AMENDED PETITION FOR CANCELLATION OF REGISTERED
TRADEMARKS**

Festivals of Speed, LLC, a Florida limited liability company, Petitioner, with an address of 1217 Overlook Road, Eustis, FL 32726, and principal business address of 3501 West Old Highway 441, Mount Dora, Florida, 32757, originally formed on November 7, 2005 (“FOS” or “Petitioner”), now Petitions the United States Patent and Trademark Office (“USPTO”) to cancel the registration and registered trademarks, “GOODWOOD FESTIVAL OF SPEED,” USPTO Registration No. 5557758 (“Registration No. 5557758” or “Goodwood’s First Registration, “Goodwood Festival of Speed””) and “FESTIVAL OF SPEED,” USPTO Registration No. 6132392 (“Registration No. 6132392” or “Goodwood’s Second Registration, “Festival of Speed””) (collectively, the “Goodwood Registrations”) and states:

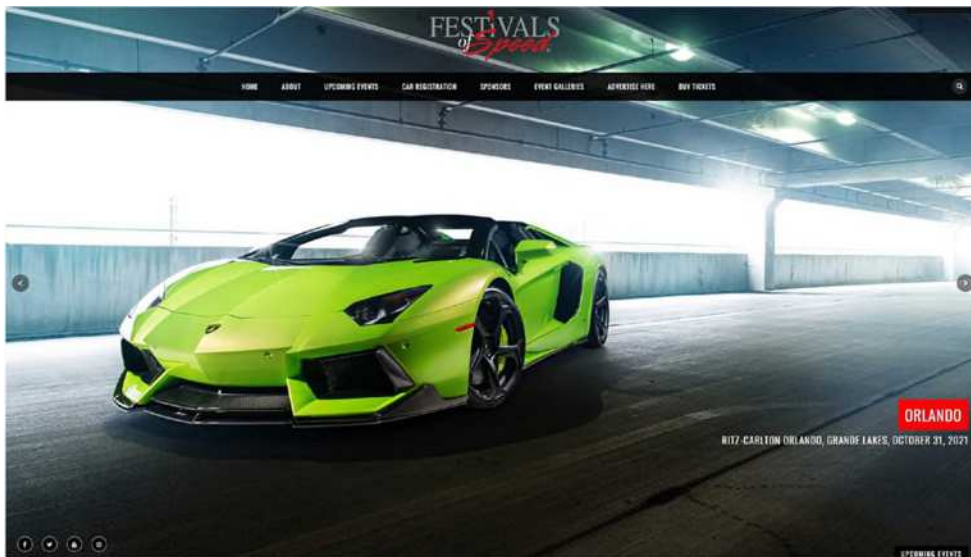
DESCRIPTION OF THE PETITIONER: FESTIVALS OF SPEED, LLC, A FLORIDA LIMITED LIABILITY COMPANY:

1. Petitioner is a Florida limited liability company and is listed in the records of the USPTO as the registrant of U.S. Registration No. 3665425 (the “FOS Registration”) “FESTIVALS OF SPEED” (the “FOS Festivals of Speed Registration”), filing date of October 26, 2006, registration date of August 11, 2009, Sec. 15 and Sect. 8 (6-YR) and Section 8 (10-YR) issued September 29, 2018, in International Class 41, for:

Conducting entertainment exhibitions in the nature of shows and events featuring automobiles, motorcycles, aircraft, and watercraft

2. FOS was founded in 2004 and at inception held multiple events each year primarily in Florida, California, New York and other venues. The FOS events focused on, and currently focus on, events featuring automobiles, motorcycles, aircraft, equestrian and yachts. FOS events were and are held at such luxury venues as the Ritz-Carlton in Orlando, the Omni Amelia Island Plantation in Amelia Island, Florida, and the Renaissance Vinoy Hotel in St. Petersburg, Florida. The FOS events have not been, and are not, tied to any specific geographic location within the United States.

3. FOS published its website at www.festivalsofspeed.com and its design incorporating its word mark FOS Festivals of Speed Registration is shown on its current website (10/26/2021) as:

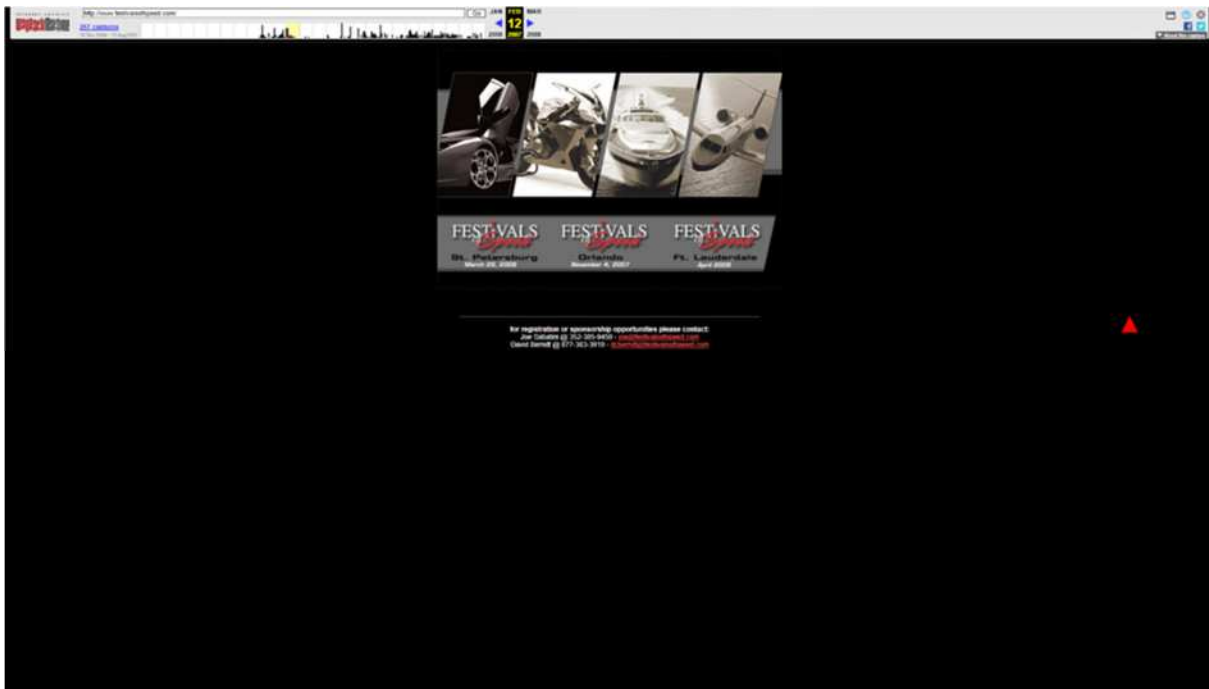


4. Since inception, FOS has used its FOS Festivals of Speed Registration in the United States for events featuring Equestrian and Horse events, Air Craft Displays (Vintage And Contemporary), Wine And Spirit Dinners, High End Food Events, Yacht Displays, Auto Displays, Motorcycles, Truck Displays, Event Magazine Printing And Design, E Newsletters, Apparel, Car Rally events and related and similar events.

5. FOS used its FOS Festivals of Speed Registration for automobiles, motorcycles, yachts, and airplanes, for example, the FOS website for February 12, 2007 as depicted on the Wayback Machine at:

<https://web.archive.org/web/20070212080851/http://www.festivalsofspeed.com/> featured luxury automobiles, motorcycles, yachts, and aircraft and featured three events for 2008 at St. Petersburg, Orlando, and Ft. Lauderdale, Florida:

<https://web.archive.org/web/20070212080851/http://www.festivalsofspeed.com/>



6. Since 2004, FOS has continually published its website, produced its events, and developed and exploited its FOS Festivals of Speed Registration within the United States. FOS has senior and priority use of the mark, “Festivals of Speed” as against the Respondent.

DESCRIPTION OF THE RESPONDENT: THE GOODWOOD ESTATE COMPANY PRIVATE LIMITED COMPANY UNITED KINGDOM

7. Respondent, THE GOODWOOD ESTATE COMPANY PRIVATE LIMITED COMPANY UNITED KINGDOM, is an entity organized in the United Kingdom, with an address of Goodwood, Chichester, West Sussex PO18 0PX UNITED KINGDOM (“Goodwood” or “Respondent”), and is listed in the records of the USPTO as the registrant of:

- (a) U.S. Registration No. 5557758 of “GOODWOOD FESTIVAL OF SPEED” (“Goodwood’s First Registration, “Goodwood Festival of Speed”):

GOODWOOD FESTIVAL OF SPEED

- (b) in the following classes:
 - i) **International Class 9 for:**

Downloadable electronic publications in the nature of magazines, brochures, newsletters provided on-line from databases, from the internet, or from any other communications network including wireless, cable, or satellite in the fields of motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings; apparatus for recording, transmission or reproduction of sound or images; blank magnetic data carriers, blank recording discs; blank carriers and storage media, namely, records, circuits, discs, wires, tapes, film, cassettes, cartridges, fibres, and cards, bearing or for use in bearing sound, video, data, images, recordings, games, graphics, text, programs, or information; software and programs and downloadable programs and computer programs for use in entertainment, training, and education, in the nature of online classes in the fields of motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings; electronic sports training and activity simulators; vehicle drive training and flight simulators; downloadable publications in the nature of magazines, brochures, newsletters provided on-line from databases, from the Internet, or from any other communications network including wireless, cable, or satellite in the fields of motorsports, golfing, horse-racing, country estate leisure

pursuits, and historic buildings; virtual reality systems, comprising virtual reality software for playing computer games, virtual reality headsets, virtual reality glasses; computer chips; time and date stamping machines; parts and fittings for all the aforesaid goods;

ii) International Class 25 for:

Clothing, namely, robes, coats, gloves, shoes, headbands, neckties, overalls, overcoats, pants, scarves, shirts, skirts, sweaters; footwear; headwear, namely, hats and caps all for use in sports and leisure pursuits; ear muffs; mountaineering boot liners

iii) International Class 35 for:

Advertising and promotion of educational, cultural, and entertainment events, namely, motorsports events, golfing events, horse-racing events, country estate leisure pursuits events, and historic buildings events

iv) International Class 41 for:

Education services, namely, providing classes and seminars in the fields of social, political, and economic interest; providing of training in the field of motorsports; entertainment services in the nature of horse shows and racing, motor vehicle driving exhibitions, motor racing exhibitions, air shows, flying competitions; organizing sporting and cultural activities for education or entertainment purposes, namely, motorsports, horse-racing, country estate leisure pursuits, and historic buildings events; training in the field of motorsports; providing facilities for holding sports events, festivals, and concerts; movie and film production services and television production services; provision of recreational and sporting facilities; publishing of books and magazines; entertainment services in the nature of personal appearances by movie stars and sports celebrities; organization and arrangement of events for entertainment purposes, namely, sporting events, races, sports competitions, shows, game shows, award ceremonies, sports tournaments, awards ceremonies, photography, motor racing and flying contests, art festivals, art galas, parties, dances, balls, sports meets, concerts, recitals, roadshows, displays for entertainment, art and food fairs, musical performances; organizing cultural, entertainment, and recreation services in the nature of horse shows and racing, motor vehicle driving exhibitions, motor racing exhibitions, air shows, flying competitions; organizing entertainment, cultural, and educational club services in the nature of horse shows and racing, motor vehicle driving exhibitions, air shows, flying competitions; holiday camp services in the nature of sports or entertainment services, namely, horse shows and racing, motor vehicle driving exhibitions, motor racing exhibitions, air shows, flying competitions; operating lotteries and raffles; booking seats for entertainment events and shows; providing games via the Internet and computer networks; news syndication reporting; educational services in the nature of classes in outdoor education in the fields of horse shows and racing, motor vehicle driving and racing, air shows, flying competitions; offering racing circuits and race tracks for lease, hire, or rent; provision of race, racing, and show facilities; arranging the rental, hire, and leasing of educational, training, cultural, entertainment and sporting equipment, services and facilities for use in education, training, cultural, entertainment and sporting events and activities, namely, motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings; information, advice, and consultancy relating to the aforesaid

(c) U.S. Registration No. 6132392 of “FESTIVAL OF SPEED” (“Goodwood’s Second Registration, “Festival of Speed”), which is the following design mark:



Goodwood derived this design by deleting the word “Good” and “Wood” from the black bars, and deleting the phrase “Goodwood Road Racing Company” from the oval space around the checkered center, which is the trademark it historically has used in the United Kingdom as described hereinafter but that it has not sought an extension of protection for in the U.S.:



Goodwood’s Second Registration “Festival of Speed” (without the words “Good” or “Wood” or the phrase in the circle under the crown, “Goodwood Road Racing Company”) is in the following classes:

i) **International Class 9 for:**

Downloadable electronic publications in the nature of magazines, brochures, newsletters provided on-line from databases, from the internet, or from any other communications network including wireless, cable, or satellite in the fields of motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings; storage media, namely, discs in the nature DVDs, audio and audiovisual tapes, exposed cinematographic film, audio and audiovisual cassettes, cartridges in the nature of audio and audiovisual cassettes, all bearing or for use in bearing sound, video, data, images, recordings, games, graphics, text, programs, and information featuring motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings

ii) **International Class 25 for:**

Clothing, namely, robes, coats, gloves, shoes, headbands, neckties, overalls, overcoats, pants, scarves, shirts, skirts, sweaters; footwear; headwear, namely, hats and caps all for use in sports and leisure pursuits

iii) **International Class 35 for:**

Advertising and promotion of educational, cultural, and entertainment events, namely, motorsports events, golfing events, horse-racing events, country estate leisure pursuits events and historic buildings events

8. Goodwood's First Registration, "Goodwood Festival of Speed" and Goodwood's Second Registration, "Festival of Speed" were both applications for the extension of protection of an international registration per the Madrid Protocol under Section 66(a) of the United States Trademark Act, 15 U.S.C. § 1141- 1141n ("§ 66 (a)"). Per 15 U.S.C. § 1141(5) (A)-(C), an application under Section 66 (a) required Goodwood to file a declaration (the "§ 66 (a) Declaration") that:

- (A) the applicant or holder has a bona fide intention to use the mark in commerce;
- (B) the person making the declaration believes himself or herself, or the firm, corporation, or association in whose behalf he or she makes the declaration, to be entitled to use the mark in commerce; and
- (C) no other person, firm, corporation, or association, to the best of his or her knowledge and belief, has the right to use such mark in commerce either in the identical form of the mark or in such near resemblance to the mark as to be likely, when used on or in connection with the goods of such other person, firm, corporation, or association, to cause confusion, mistake, or deception.

9. Goodwood filed and made the required § 66 (a) Declaration to the United States Patent and Trademark Office ("USPTO"), in a communication made and transmitted to and within the United

States to the USPTO, for both Goodwood's First Registration, "Goodwood Festival of Speed" and Goodwood's Second Registration, "Festival of Speed" with actual knowledge that:

(a) FOS was using its Festivals of Speed trademark and that the use of Goodwood's First Registration, "Goodwood Festival of Speed" for any events other than its historical event held at Goodwood House, Sussex, in the United Kingdom, and Goodwood's Second Registration, "Festival of Speed" were in such near resemblance to FOS' Festivals of Speed Trademark or the near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive, because:

i) Goodwood knew that FOS was using the FOS Registration, "Festivals of Speed" that was confusingly similar to Goodwood's Registrations;

ii) Goodwood knew that FOS had superior rights to Goodwood in the use of the mark, "Festivals of Speed" or "Festival of Speed" by virtue of FOS' use and FOS' Registration;

iii) Goodwood had no reasonable belief that there was no likelihood of confusion that would result from Goodwood's use of the Goodwood Registrations;

iv) Goodwood knew that Goodwood could obtain an extension of protection under § 66(a) without use that would be the equivalent of registration on the Principal Register, knew that it was not entitled to the registrations due to the likelihood of confusion with the FOS' marks, and made the § 66(a) Declarations with the knowledge and intent of the foregoing; and

v) Goodwood's Registrations did not constitute a "proper filing" as required by 11 U.S.C. § 1141f (b);

(b) "[e]xtension of protection [under § 66 (a)] shall not be refused on the ground that the mark has not been used in commerce," per 15 U.S.C. § 1141h (a) (3), and as a result thereof, Goodwood knew that it had no obligation to actually use marks to obtain an extension of protection under § 66(a);

(c) Per 11 U.S.C. § 1141f (b), the "proper filing" of the request for extension of protection

constitutes constructive use of the mark as of the earliest of the date of recordal of the request for extension of protection or the date of priority claimed by Goodwood, and as a result thereof, Goodwood would be entitled to claim constructive use without any use;

(d) Per 15 USCS § 1141i, extension of protection shall have the same effect and validity as registration on the Principal Register and “the holder of the international registration shall have the same rights and remedies as the owner of a registration on the Principal Register”;

(e) The holder of an extension of protection is required to file an affidavit stating that the mark is in use in commerce during the one year period immediately preceding the expiration of 6 years following the issuance of certificate of extension, per 15 USCS § 1141k; and

(f) The period for continuous use for incontestability begins on the date of the issuance of the certificate of extension of protection.

10. As of the filing of this First Amended Petition, the five-year period for the filing of an affidavit of use per 15 USCS § 1141k has not lapsed for the Goodwood Registrations and Goodwood has not yet filed an affidavit alleging use for either Goodwood’s First Registration, “Goodwood Festival of Speed” or Goodwood’s Second Registration, “Festival of Speed.”

11. However, per 15 U.S.C. § 1141h (a) (4), extension of protection “shall be refused to any mark not registrable on the Principal Register.” A § 66(a) registration is subject to the same grounds for cancellation as those registrations issued under Section 1 or Section 44(e).¹ The U.S. registration may be subject to cancellation even if the international registration remains valid and subsisting.² A registered extension of protection may be invalidated or revoked in whole or in part.³ “In the case of partial invalidation, the USPTO will not cancel the registered extension of protection but, instead,

¹ *Saddlesprings, Inc. v. Mad Croc Brands, Inc.*, 2012 TTAB LEXIS 378, at *9 (T.T.A.B. Sept. 25, 2012).

² *Sandro Andy, S.A. v. Light Inc.*, 2012 U.S. Dist. LEXIS 182401, at *5-6 (S.D.N.Y. Dec. 27, 2012).

³ TMEP § 1904.07.

delete the relevant goods/services from the USPTO's electronic records for the registration. An updated registration certificate will not issue," 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."⁴

12. The application for Goodwood's First Registration, "Goodwood Festival of Speed" identifies International Trade Mark No. 1370233 (EUIPO) for "Goodwood Festival of Speed," registered as a "word" mark, as the international registration upon which its Section 66 (a) application relies.

13. The application for Goodwood's Second Registration, "Festival of Speed" lists UK Trade Mark No. UK00003301170 as the international mark upon which its Section 66(a) application relies, which is the design mark omitting the words "Good" and "Wood" in the black bars and the phrase "Goodwood Road Racing Company, as shown above in Paragraph 7 (c), Page 6, *supra*.

14. When Goodwood filed its application for Goodwood's Second Registration, "Festival of Speed," Goodwood originally applied for but subsequently voluntarily deleted International Class 41 during the registration process in response to a USPTO office action.

15. After obtaining registration of Goodwood's Second Registration, "Festival of Speed" excepting IC Class 41, Goodwood unsuccessfully attempted a third registration with the same design as in Goodwood's Second Registration, "Festival of Speed" above, also deleting the word "Goodwood," USPTO Serial Number 79291294 ("Goodwood's Refused IC 41 Attempt"), in which the USPTO issued a final refusal based on the conflict with Petitioner's FOS Festivals of Speed Registration. Goodwood's Refused IC 41 Attempt was for the same design mark above as Goodwood's Second Festival of Speed Registration in International Class 41 as follows:

Education services, namely, providing classes and seminars in the fields of social, political, and economic interest; providing of training in the field of motorsports; entertainment services in

⁴ TMEP § 1904.07

the nature of horse shows and racing, motor vehicle driving exhibitions, motor racing exhibitions, air shows, flying competitions; organizing sporting and cultural activities for education or entertainment purposes, namely, motorsports, horse-racing, country estate leisure pursuits, and historic building events; providing facilities for holding sports events, cultural festivals, and music concerts; movie and film production services and television show production services; provision of recreational and sporting facilities; publishing of books and magazines; entertainment services in the nature of personal appearances by movie stars and sports celebrities; organization and arrangement of events for entertainment purposes, namely, sporting events, races, sports competitions, art shows, game shows, sports tournaments, sports awards ceremonies, photography exhibitions, motor racing and flying contests, art festivals, art galas, parties, dances, balls, sports meets, music concerts, music recitals, roadshows, displays for entertainment, art and food fairs, musical performances; organizing cultural, entertainment, and recreation services in the nature of horse shows and racing, motor vehicle driving exhibitions, motor racing exhibitions, air shows, flying competitions; organizing entertainment, cultural, and educational club services in the nature of horse shows and racing, motor vehicle driving exhibitions, air shows, flying competitions; holiday camp services in the nature of sports and entertainment services, namely, horse shows and racing, motor vehicle driving exhibitions, motor racing exhibitions, air shows, flying competitions; operating lotteries and raffles; booking seats for entertainment events and shows; entertainment services, namely, providing an on-line computer game via the internet and computer networks; news syndication reporting; educational services in the nature of classes in outdoor education in the fields of horse shows and racing, motor vehicle driving and racing, air shows, flying competitions; providing facilities for horse and motorsports racing circuits and race tracks for lease or rent; provision of horse and motorsports race, racing, and show facilities; rental of and leasing of educational, training, cultural, entertainment and sporting equipment and facilities for use in education, training, cultural, entertainment and sporting events and activities, namely, motorsports, golfing, horse-racing, country estate leisure pursuits, and historic building events; information, advice, and consultancy relating to the aforesaid

16. The design mark used for Goodwood’s Second Registration, “Festival of Speed” was created and registered by Goodwood in the United Kingdom, for the purpose of filing the application for extension of protection for Goodwood’s Second Registration, “Festival of Speed” under § 66 (a) and not for the purpose of using or developing the design mark in the United Kingdom.

17. Since 1993, and possibly longer, Goodwood has held at Goodwood House, West Sussex, England an annual event featuring vehicles and other events on the grounds of Goodwood House, West Sussex, England, known as “Goodwood Festival of Speed.” The Goodwood Festival of Speed is named after, located in, and known by its geographical designation, “Goodwood,” referring to the physical structure, “Goodwood House,” which is a geographically based destination in the UK see, e.g., <https://www.goodwood.com/> and Wikipedia article at

https://en.wikipedia.org/wiki/Goodwood_Festival_of_Speed The location, “Goodwood House,” is located in a geographical area shown on Google Maps with multiple locations bearing the “Goodwood” geographic designation:



The location of Goodwood Festival of Speed is Goodwood House depicted below as located on the above map (photo at shutterstock_1260663826 shutterstock.com):



18. Goodwood’s use of its trademark “Goodwood Festival of Speed” prominently depicts the geographic identifier, “Goodwood,” as shown below (photo is shutterstock_1610561002 shutterstock.com):



19. On information and belief, 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.” As published on the internet archiver Wayback Machine at

[https://web.archive.org/web/20120525033948/http://www.goodwood.co.uk/festival-of-](https://web.archive.org/web/20120525033948/http://www.goodwood.co.uk/festival-of-speed/welcome.aspx)

[speed/welcome.aspx](https://web.archive.org/web/20120525033948/http://www.goodwood.co.uk/festival-of-speed/welcome.aspx) as of May of 2012, Goodwood’s use of the Goodwood Festival of Speed Trademark in the United Kingdom always included the term, “Goodwood,” as shown below:



20. Although Goodwood’s First Goodwood Festival of Speed Registration with the USPTO is block letters shown below, Goodwood’s use of Goodwood’s First Registration, “Goodwood Festival of Speed” is in the above design and not the block letter registration of:

GOODWOOD FESTIVAL OF SPEED

21. Goodwood’s Second Registration, “Festival of Speed” is Goodwood’s UK design mark copied from its UK design in historical use but deleting reference to the word “Goodwood” from the above design mark. As of October 25, 2021, Goodwood continues to use the word “Goodwood” on the design mark from which Goodwood’s Second Registration, “Festival of Speed” is derived as published at <https://www.goodwood.com/motorsport/festival-of-speed/>:



22. Goodwood initially omitted the IC Class 41 filing from Goodwood’s Second Registration, “Festival of Speed” and Goodwood first registered its design mark omitting the word, “Goodwood,” in the United States only in classes 9, 25, and 35:



However, the international descriptions used by Goodwood to obtain its UK trademark are broad and encompassing, and the same are included in Goodwood’s Second Registration, “Festival of Speed” logo, including:

A) In International Class 9 for:

Downloadable electronic publications in the nature of magazines, brochures, newsletters provided on-line from databases, from the internet, or from any other communications network including wireless, cable, or satellite in the fields of motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings; storage media, namely, discs in the nature DVDs, audio and audiovisual tapes, exposed cinematographic film, audio and audiovisual cassettes, cartridges in the nature of audio and audiovisual cassettes, all bearing or for use in bearing sound, video, data, images, recordings, games, graphics, text, programs, and information featuring motorsports, golfing, horse-racing, country estate leisure pursuits, and historic buildings

B) International Class 25 for:

Clothing, namely, robes, coats, gloves, shoes, headbands, neckties, overalls, overcoats, pants, scarves, shirts, skirts, sweaters; footwear; headwear, namely, hats and caps all for use in sports and leisure pursuits

C) International Class 35 for:

Advertising and promotion of educational, cultural, and entertainment events, namely, motorsports events, golfing events, horse-racing events, country estate leisure pursuits events and historic buildings events.

23. Petitioner believes that Petitioner will be damaged by any use of Goodwood of Goodwood's First Registration, "Goodwood Festival of Speed" and Goodwood's Second Registration, "Festival of Speed" including as a result of a likelihood of confusion therefore Petitions for the cancellation thereof.

24. Petitioner has prior and senior use of the mark "Festivals of Speed" in the United States, and Goodwood's Registrations are utilizing the exact verbiage of Petitioner's registered mark with the singular "festival" instead of the plural "festivals. This distinction is insufficient to avoid the likelihood of confusion.

25. Petitioner suffers injury in fact due to both Goodwood's First Registration, "Goodwood Festival of Speed" and Goodwood's Second Registration, "Festival of Speed" that is (a) concrete and particularized and (b) actual or imminent because Goodwood has begun enforcement of both Goodwood's Registrations as to third parties. Goodwood has not attempted to enforce trademarks against FOS.

26. Goodwood has filed both Goodwood's First Registration, "Goodwood Festival of Speed" and Goodwood's Second Registration "Festival of Speed" 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 of the marks in the United States for the full five year period other than in connection with Goodwood's historical events held in the United Kingdom.

27. Upon the lapsing of the five-year time period to cancel Goodwood's Registrations, Goodwood will have the right to attempt to enforce its marks as incontestable marks. This Petition is filed within the five year period relating to both Goodwood Registrations.

28. Should the Goodwood Registrations not be cancelled or limited as requested herein, Petitioner FOS will be impaired in utilizing FOS' mark for such common activities as online webpages in the form of magazines, labeling promotional flash drives with its design, broadcasting television and internet video content, selling clothing with the FOS designs, and related common advertising and expansion of the use of the FOS trademark. The specter of Goodwood's declaration of intent to use coupled with its Class 9, 25, 35, and 41 filings opens FOS to the specter of infringement litigation with Goodwood in broad categories of use by FOS of the FOS registered mark, "Festivals of Speed."

29. The impairment of FOS' right to freely utilize the FOS Festivals of Speed Registration without the specter of enforcement action by Goodwood is injury in fact that is concrete and particularized.

30. Should the Goodwood Registrations not be cancelled or limited as requested herein, Petitioner FOS is engaged in, or will likely engage in, activity that will give rise to a possible infringement claims by Goodwood. Goodwood's Registrations create the risk of interference with the rights that flow to FOS from registration of FOS' own mark. FOS will face the risk of potential trademark infringement liability for using FOS' own mark. In addition, if the Goodwood

Registrations are not cancelled or limited, the very registration and use of the Goodwood Registrations will cause FOS harm.

31. Since Goodwood has deleted the geographic reference of “Goodwood” from Goodwood’s Second Registration, “Festival of Speed” there is likelihood-of-confusion with the FOS Registration because Goodwood and FOS engage in the same line of business relating to events featuring automobiles, motorcycles, aircraft, and yachts, advertise to the same customers for events, engage the same or similar sponsors, and the failure to cancel Goodwood’s Registrations will cause FOS competitive injury.

32. Goodwood first registered Goodwood’s Second Registration, “Festival of Speed” trademark without the word, “Goodwood” and omitted Class 41, and only after that registration was issued filed its third application to attempt to register Goodwood’s design mark in Goodwood’s Second Registration in International Class 41. As stated, the USPTO refused the third application.

33. Goodwood’s intent is to engage in activity with Goodwood’s Second Registration, “Festival of Speed” for goods and services that are, in reality, defined within Class 41 even though Goodwood cannot achieve trademark registration within class 41 and intends to compete with FOS under the guise of its Class 9, 25, and 35 registrations in Goodwood’s Second Registration, “Festival of Speed.”

34. This Petition is filed within five years of the registration of both marks this Petition seeks to cancel and all conditions precedent have occurred or been waived.

35. Petitioner FOS has been and will be damaged by the continued registration of the Respondent Goodwood’s Marks, as there is a likelihood of confusion by Goodwood’s use of Goodwood’s First Registration, “Goodwood Festival of Speed” and Goodwood’s Second Registration, “Festival of Speed” in the United States.

**COUNT ONE: CANCELLATION OF GOODWOOD’S FIRST REGISTRATION,
“GOODWOOD FESTIVAL OF SPEED” REGISTRATION NO. 5557758**

36. This is a Petition for cancellation of Goodwood's First Registration, "Goodwood Festival of Speed," Registration No. 55577598.

37. Petitioner realleges and incorporates herein Paragraph's 1-35.

38. Goodwood's Registration 5557758 is subject to cancellation pursuant to 15 U.S.C. § 1141h (a) (4), which provides that an extension of protection per § 66 (a) "shall be refused to any mark not registrable on the Principal Register" and Registration No. 55577598 is subject to cancellation as set forth herein.

39. Goodwood's First Registration, "Goodwood Festival of Speed" is not registrable on the Principal Register and should be cancelled as follows:

A. Cancellation Ground 1: Abandonment.

(1) Trademark Act Section 45, 15 U.S.C. § 1127, provides, in pertinent part, that "[a] mark shall be deemed to be 'abandoned' ... [w]hen its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment."

(2) Pursuant to 15 U.S.C. § 1127 and § 1141f(a) the extension of protection of an international registration pursuant to § 66(a) may be deemed abandoned where there are three or more consecutive years of nonuse commencing no earlier than the date on which the registration was issued.

(3) With respect to Registration No. 5557758, the Registration date was September 11, 2018, and Goodwood has never used Registration No. 5557758 in commerce in the United States following registration on September 11, 2018, for any goods or services other than Goodwood's historic event at Goodwood House, West Sussex, England. Goodwood has never used Registration No. 5557758 in commerce in the United States following registration on September 11, 2018, for any goods or services other than Goodwood's historic event at Goodwood House, United Kingdom

at any time during the 3-year period following the date of extension of protection and registration thereof.

(4) Goodwood has abandoned Registration No. 5557758 in all respects and uses other than Goodwood's historic event at Goodwood House in the United Kingdom.

(5) For the foregoing reasons, Goodwood's First Registration, "Goodwood Festival of Speed," No. 5557758 for all goods and services in the United States in reference to any goods and services other than Goodwood's historical event in the United Kingdom should be cancelled.

B. Cancellation Ground 2: No Bona Fide Intent.

(1) As alleged with specificity in Paragraphs 1-35, incorporated herein, at the time of the Goodwood's application for the extension of protection pursuant to § 66(a) and the filing of the Declaration required by § 66(a), Goodwood had no bona fide intention to use Registration No. 5557758, in commerce in the United States for any goods or services other than Goodwood's historic event at Goodwood House, Sussex England.

(2) Goodwood has never hosted an event outside of the geographical location of Goodwood House, West Sussex England using Goodwood's First Registration, "Goodwood Festival of Speed," and Goodwood has made no use of the marks in the United States other than in connection with its historic event at Goodwood House, Sussex England.

(3) Goodwood has never used Registration No. 5557758 in commerce with any goods and services other than in connection with its historic event at Goodwood House, West Sussex England.

(4) Goodwood's use of Registration No. 5557758 in the United States has been used solely and exclusively to refer to Goodwood's geographically identified event at Goodwood House, Sussex, England.

(5) Goodwood has never used, and has never had any bona fide intention to use, Registration No. 5557758 other than for events at its historic location in the United Kingdom. This is including as of the date of Goodwood's filing of the application for extension of protection that ultimately resulted in Registration No. 5557758.

(6) At the time of the § 66 (a) application for Registration No. 5557758 Goodwood did not have the bona fide intention of using said mark for any use other than for events at its historic location at Goodwood House, West Sussex, United Kingdom.

(7) For the foregoing reasons, Registration No. 5557758 should be cancelled in all respects other than Goodwood's historic event at Goodwood House, West Sussex, United Kingdom.

C. Cancellation Ground 3: Likelihood of Confusion.

(1) Petitioner incorporates Paragraphs 1-35 by reference.

(2) Petitioner is the prior and senior user in the United States of the mark "Festivals of Speed" to the Respondent Goodwood.

(3) Goodwood's First Registration, "Goodwood Festival of Speed" prominently depicts the phrase "festival of speed" as a significant constituent component of the mark.

(4) As applied to Goodwood's historic event at Goodwood House in the United Kingdom, Petitioner does not contend that the 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 Petitioner does not contend that there is a likelihood of confusion. However, to the extent that the mark is not limited to Goodwood's historic event at Goodwood House, West Sussex, England, United Kingdom, the mark will result in a likelihood of confusion and damage to the Petitioner.

(5) To the extent that Goodwood uses Registration No. 5557758 in United States

disconnected from the historic use of the mark only as to Goodwood's event promoted solely within the United Kingdom, the mark would be confusingly similar to Petitioner's mark as it only varies by one letter, that is, "festival," singular, instead of Petitioner's use of the plural, "festivals," together with the geographic identifier, "Goodwood," and the use of the exact name for competing events results in a likelihood of confusion that will damage the Petitioner.

(6) Goodwood's Registration No. 5557758 is a word mark and Goodwood is not restricted as to font size, colors, or other presentation criteria in the presentation of the word "Goodwood" in conjunction with the remaining mark elements "Festival of Speed."

(7) Petitioner FOS and Respondent Goodwood promote similar events on the same subject matter and advertise to the same customers and sponsors.

(8) The products and events of FOS and Goodwood move through the same trade channels to all usual classes of consumers of such goods.

(9) Goodwood, as registrant of a word mark, is entitled to depictions of the standard character mark regardless of font style, size or color.

(10) The word "Goodwood" is a geographic identifier referring to Goodwood House, West Sussex, England, and as a geographic identifier the word "Goodwood" is not inherently distinctive and is merely descriptive.

(11) The Petitioner's mark and the Respondent's marks are virtually identical, and the goods and services of both marks are virtually identical.

(12) Goodwood's mark contains the whole FOS mark with the only exception of the use of the singular "festival" instead of FOS' "festivals" and the geographic identifier "Goodwood." Since the Goodwood mark subsumes the FOS mark, the similarity between the two marks is increased.

(13) The event consumers could not be expected to exercise a heightened degree of care when selecting an event to attend. FOS ticket prices are typically \$20.00- \$130 U.S, and Goodwood

ticket prices in the U.K. are in the same general price range as the ticket prices for the FOS events in the U.S. The prices of tickets for the FOS events in the United States and the Goodwood events in the UK are essentially equivalent and are sufficiently nominal that consumers would not be expected to exercise a heightened degree of care when choosing an event.

(14) Goodwood's promotion of events of the same depiction and category of Petitioner FOS' events, including automobile, equestrian, yachts, aircraft, and motorcycle events, creates the likelihood of confusion in mind of purchasing public as to whether the event is being promoted by Petitioner FOS or Respondent Goodwood due to the confusingly similar marks that will be sold through similar channels to same class of purchasers.

(15) The goods and services described in Goodwood's Registrations explicitly show that Goodwood intends on head-to-head competition with the 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, and by Goodwood's third Refused IC 41 Attempt.

(16) Goodwood filed Goodwood's First Goodwood Festival of Speed Registration as a precursor to filing Goodwood's Second Festival of Speed Registration, which in turn was filed as a precursor to the filing of Goodwood's Refused IC 41 Attempt. All of these filings were for the purpose of ultimately registering a "festival of speed" mark to impair and limit FOS' use and expansion of the FOS Festivals of Speed Registration.

(17) In Goodwood's First Goodwood Festival of Speed Registration the word "Goodwood," means and refers to Goodwood House, Sussex. Accordingly, the consuming public is aware that Goodwood's UK registration, and Goodwood's First Registration, "Goodwood Festival of Speed," relates only to the event at Goodwood, Sussex, in the United Kingdom. Any use within the United States for events promoted by Goodwood through the use of the Goodwood Registration will create a likelihood of confusion.

(18) FOS has developed its trademark and intends to naturally expand the use of the FOS mark into areas encompassed within Goodwood’s descriptions of its use in International Classes 9, 25, and 35, and Goodwood should not be allowed to register its international mark in the United States without any use in either the United Kingdom or the United States and obtain the benefits of registration on the principal register for any use other than the use of Goodwood’s First Registration, “Goodwood Festival of Speed,” for events in the United Kingdom.

(19) Likelihood of confusion is a basis for both cancellation and limitation of registered trademarks.⁵

(20) 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.

D. Cancellation Ground 4: Fraud

(1) Goodwood’s First Registration, “Goodwood Festival of Speed” Registrations No. 5557758 has been used in the United States to date by Goodwood solely and exclusively for the use of referring to Goodwood’s geographically identified event at Goodwood House, West Sussex, United Kingdom. Goodwood has never used, and has no intention to use, Goodwood’s First Registration, “Goodwood Festival of Speed” other than for events at its historic location in the United Kingdom. To the extent that Goodwood claims to have a Section 66(a) right to utilize its international mark to hold events within the United States under the “Goodwood Festival of Speed” brand, the Registration should be cancelled.

⁵ *Fred W. Amend Co. v. Am. Character Doll Co.*, 42 C.C.P.A. 983, 223 F.2d 277 (C.C.P.A. 1955); *Monster Energy Co. v. BeastUp Ltd. Liab. Co.*, 395 F. Supp. 3d 1334 (E.D. Cal. 2019)

(2) Goodwood's Registration No. 5557758 is a word mark.

(3) Goodwood's intention in registering UK Trade Mark No. UK00003210621 was to file a Section 66 (a) application for extension of protection in the United States.

(4) Pursuant to Trademark Act Section 60(5), 15 U.S.C. § 1141(5), a party who requests an extension of protection of an international registration to the United States must include "a [verified] declaration of bona fide intention to use the mark in commerce." Trademark Act Section 66(a) (the "§ 66 (a) Declaration"). This declaration must "contain a statement that—

(A) the applicant or holder [of the international registration] has a bona fide intention to use the mark in commerce;

(B) the person making the declaration believes himself or herself, or the firm, corporation, or association in whose behalf he or she makes the declaration, to be entitled to use the mark in commerce; and

(C) no other person, firm, corporation, or association, to the best of his or her knowledge and belief, has the right to use such mark in commerce either in the identical form of the mark or in such near resemblance to the mark as to be likely, when used on or in connection with the goods of such other person, firm, corporation, or association, to cause confusion, mistake, or deception.

(5) Goodwood filed a § 66 (a) Declaration that contain[ed] knowingly false statements of material facts with the intention to deceive the USPTO as follows:

a. In Goodwood's § 66 (a) Declaration, Goodwood, as the applicant and holder of the international registration, falsely represented to the USPTO with the intent to deceive the USPTO that Goodwood had a bona fide intention to use the mark in commerce in the United States. This statement was knowingly false when made because:

(i) Goodwood had no bona fide intention to use the mark in commerce in the United States during the five year period beginning on the constructive use date of the § 66 (a) extension of protection and made the false statement to gain the advantages of registration on the Principal Register of the USPTO from the constructive use date afforded by § 66 (a) without any use or any

bona fide intention to use said mark in the United States during said five year constructive use period so that Goodwood could begin using the mark after five years without facing challenges from the Petitioner FOS based on likelihood of confusion and allow Respondent to claim incontestability.

(ii) Goodwood has never used Goodwood's Second Registration "Festival of Speed" except in the UK and then only in conjunction with the use of Goodwood's First Registration, "Goodwood Festival of Speed" and only referring to Goodwood's historical event held at Goodwood House, Sussex, in the United Kingdom.

(b) In Goodwood's § 66 (a) Declaration, the person making the declaration falsely represented the material fact to the USPTO with the intent to deceive the USPTO that the person making the declaration believed himself or herself, or the firm, corporation, or association in whose behalf he or she makes the declaration, to be entitled to use the mark in commerce. This representation was knowingly false when made because the person making the declaration knew of the existence of FOS and the use by FOS of the FOS trademark "Festivals of Speed" and knew that the intention Goodwood was to obtain an extension of protection under § 66 (a) with no bona fide intention to use the mark for the five year period following the constructive use date afforded by § 66 (a) and then compete head to head with Petitioner using Petitioner's own trademark while claiming that the five year period following the § 66 (a) constructive use date eliminated the ability of FOS to challenge Goodwood's registration on the basis of likelihood of confusion and Registrant would claim incontestability.

(c) In Goodwood's § 66 (a) Declaration Goodwood falsely represented the material fact to the USPTO with the intent to deceive the USPTO that no other person, firm, corporation, or association, to the best of his or her knowledge and belief, has the right to use such mark in commerce either in the identical form of the mark or in such near resemblance to the mark as to be likely, when used on or in connection with the goods of such other person, firm, corporation, or

association, to cause confusion, mistake, or deception. This representation was false because, as more specifically set forth in Paragraphs 9-11 hereof incorporated by reference herein, Goodwood and all persons associated with Goodwood's Second Registration, "Festival of Speed" had actual knowledge of Petitioner FOS and the use of Petitioner's registered trademark, "Festivals of Speed," and Goodwood was implementing the § 66 (a) Declaration and request for extension of protection pursuant to § 66 (a) specifically for the purpose of obtaining an extension of protection under § 66 (a) with no bona fide intention to use the mark for the five year period following the constructive use date afforded by § 66 (a) and then compete head to head with Petitioner using Petitioner's own trademark while claiming that the five year period following the § 66 (a) constructive use date eliminated the ability of FOS to challenge Goodwood's registration on the basis of likelihood of confusion.

(6) For the foregoing reason, Goodwood obtained Registration No. 5557758 through fraud and the same should be cancelled.

E. Cancellation Ground 5: Non-use.

(1) Goodwood has never used Goodwood's First Registration, "Goodwood Festival of Speed," in commerce for any goods and services other than Goodwood's historic event in the United Kingdom, in conjunction with goods and services, 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 for any goods and services other than Goodwood's historic event in the United Kingdom, and cancellation is appropriate pursuant to 15 U.S.C. § 1064 (6) for all goods and services other than Goodwood's historic event in the United Kingdom.

(2) Goodwood's First Registration, "Goodwood Festival of Speed," has never been used in the United States in reference to any goods and services other than Goodwood's historical event in

the United Kingdom or in the alternative, any use has been abandoned and Goodwood has no intention to use said Registration for said goods in the future.

(3) For the foregoing reasons, Goodwood's Registration No. 5557758 should be cancelled for non-use.

**COUNT TWO: CANCELLATION OF GOODWOOD'S SECOND REGISTRATION,
"FESTIVAL OF SPEED" REGISTRATION NO. 6132392**

40. This is a Petition to cancel Goodwood's Second Registration, "Festival of Speed" Registration No. 6132392 on the basis that the § 66 (a) extension of protection registration is subject to cancellation as hereinafter stated.

41. Petitioner incorporates paragraphs 1-35 by reference.

A. Cancellation Ground 1: Abandonment.

(1) Trademark Act Section 45, 15 U.S.C. § 1127, provides, in pertinent part, that "[a] mark shall be deemed to be 'abandoned' ... [w]hen its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment."

(2) Registration No. 6132392 was registered August 25, 2020, so three years had not lapsed as of the date of this Petition. Accordingly, there is not prima facie evidence of abandonment as to this Registration.

(3) Goodwood has never used the mark "Festival of Speed" for any reason other than in connection with the use of Registration No. 5557758 and Goodwood's other international trademarks in connection with Goodwood's historic event at Goodwood House, United Kingdom.

(6) Goodwood has never used the mark "Festival of Speed" as a stand alone trademark in the over three decades it has promoted the historic Goodwood Festival of Speed.

(7) For the foregoing reasons, Goodwood's Second Registration, "Festival of Speed," No. 6132392 has been abandoned for all goods and services in the United States in reference to any

goods and services other than Goodwood's historical event in the United Kingdom should be cancelled.

B. Cancellation Ground 2: No Bona Fide Intent.

(1) As alleged with specificity in Paragraphs 1-35, incorporated herein, at the time of the Goodwood's application for the extension of protection pursuant to § 66(a) and the filing of the Declaration required by § 66(a), Goodwood had no bona fide intention to use Registration No. 6132392, in commerce in the United States for any goods or services other than Goodwood's historic event at Goodwood House, Sussex England.

(2) Goodwood has never hosted an event outside of the geographical location of Goodwood House, West Sussex England using Goodwood's Second Registration, "Festival of Speed," and Goodwood has made no use of the marks in the United States other than in connection with its historic event at Goodwood House, Sussex England.

(3) Goodwood has never used Registration No. 6132392 in commerce with any goods and services other than in connection with its historic event at Goodwood House, West Sussex England.

(4) Goodwood's use of Registration No. 6132392 in the United States has been used solely and exclusively to refer to Goodwood's geographically identified event at Goodwood House, Sussex, England.

(5) Goodwood has never used, and has never had any bona fide intention to use, Registration No. 6132392 other than for events at its historic location in the United Kingdom. This is including as of the date of Goodwood's filing of the application for extension of protection that ultimately resulted in Registration No. 6132392.\

(6) At the time of the § 66 (a) application for Registration No. 6132392 Goodwood did not have the bona fide intention of using said mark for any use other than for events at its historic location at Goodwood House, West Sussex, United Kingdom.

(7) For the foregoing reasons, Registration No. 6132392 should be cancelled in all respects.

C. Cancellation Ground 3: Likelihood of Confusion.

(1) Petitioner incorporates Paragraphs 1-35 by reference.

(2) Petitioner is the prior and senior user in the United States of the mark “Festivals of Speed” to the Respondent Goodwood.

(3) Goodwood’s Second Registration, “Festival of Speed” prominently depicts the phrase “festival of speed” as the only constituent component of the mark.

(4) Goodwood’s use of Registration 6132392 will result in a likelihood of confusion and damage to the Petitioner.

(5) To the extent that Goodwood uses Registration No. 6132392 in United States, the mark would be confusingly similar to Petitioner’s mark as it only varies by one letter, that is, “festival,” singular, instead of Petitioner’s use of the plural, “festivals.” This results in a likelihood of confusion that will damage the Petitioner.

(6) Goodwood’s Registration No. 5 6132392 is a logo mark with the only verbiage “festival of speed.” There is nothing in the artwork of the logo that would distinguish the title of an event named “festival of speed” from Petitioner’s Festivals of Speed events.

(7) Petitioner FOS and Respondent Goodwood promote similar events on the same subject matter and advertise to the same customers and sponsors.

(8) The products and events of FOS and Goodwood move through the same trade channels to all usual classes of consumers of such goods.

(9) The Petitioner’s mark and the Respondent’s marks are virtually identical, and the goods and services of both marks are virtually identical.

(10) Goodwood's mark contains the whole FOS mark with the only exception of the use of the singular "festival" instead of FOS' "festivals." Since the Goodwood mark effectively subsumes the FOS mark, the similarity between the two marks is increased.

(11) The event consumers could not be expected to exercise a heightened degree of care when selecting an event to attend. FOS ticket prices are typically \$20.00- \$130 U.S, and Goodwood ticket prices in the U.K. are in the same general price range as the ticket prices for the FOS events in the U.S. The prices of tickets for the FOS events in the United States and the Goodwood events in the UK are essentially equivalent and are sufficiently nominal that consumers would not be expected to exercise a heightened degree of care when choosing an event.

(12) Goodwood's promotion of events of the same depiction and category of Petitioner FOS' events, including automobile, equestrian, yachts, aircraft, and motorcycle events, creates the likelihood of confusion in mind of purchasing public as to whether the event is being promoted by Petitioner FOS or Respondent Goodwood due to the confusingly similar marks that will be sold through similar channels to same class of purchasers.

(13) The goods and services described in Goodwood's Registrations explicitly show that Goodwood intends on head-to-head competition with the 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, and by Goodwood's third Refused IC 41 Attempt.

(14) Goodwood filed Goodwood's First Goodwood Festival of Speed Registration as a precursor to filing Goodwood's Second Festival of Speed Registration, which in turn was filed as a precursor to the filing of Goodwood's Refused IC 41 Attempt. All of these filings were for the purpose of ultimately registering a "festival of speed" mark to impair and limit FOS' use and expansion of the FOS Festivals of Speed Registration.

(15) FOS has developed its trademark and intends to naturally expand the use of the FOS mark into areas encompassed within Goodwood’s descriptions of its use in International Classes 9, 25, and 35, and Goodwood should not be allowed to register its international mark in the United States without any use in either the United Kingdom or the United States and obtain the benefits of registration on the principal register for any use other than the use of Goodwood’s First Registration, “Goodwood Festival of Speed,” for events in the United Kingdom.

(16) Likelihood of confusion is a basis for both cancellation and limitation of registered trademarks.⁶

(17) 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.

(18) For the foregoing reason, Goodwood’s Second Registration 6132392 should be cancelled.

D. Cancellation Ground 4: Fraud

(1) Trademark applications in the United Kingdom are governed by the Trade Marks Act of 1994 of the United Kingdom, (“UK TMA”) which provides, in pertinent part, that “[a] trade mark shall not be registered if it is (a) contrary to public policy or to 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).

(2) The registration of a trade mark under the UK TMA may be declared invalid on the ground that the trade mark was registered in breach of Section 3, *Id.*, Sec. 47.

⁶ *Fred W. Amend Co. v. Am. Character Doll Co.*, 42 C.C.P.A. 983, 223 F.2d 277 (C.C.P.A. 1955); *Monster Energy Co. v. BeastUp Ltd. Liab. Co.*, 395 F. Supp. 3d 1334 (E.D. Cal. 2019)

(3) As provided by Section 32, *Id.*, to register a trademark in the United Kingdom:

The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be so used.

(4) Goodwood filed its application for UK Trade Mark No. UK00003301170, which would later become the basis for Goodwood's Second Registration, "Festival of Speed" under which its Section 66(a) application relies, which is the design mark omitting the word "Good" on the left black bar, omitting the word "Wood" on the right black bar, and omitting the phrase, "Goodwood Road Racing Company as shown above and as shown below:



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



(5) At the time of filing its application for UK Trade Mark No. UK00003301170, upon which it based Goodwood's Second Registration, "Festival of Speed," Goodwood 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. Goodwood's intention in registering UK Trade Mark No. UK00003301170 was to file a Section 66 (a) application for extension of protection in the United States.

(6) Pursuant to Trademark Act Section 60(5), 15 U.S.C. § 1141(5), a party who requests an extension of protection of an international registration to the United States must include "a [verified] declaration of bona fide intention to use the mark in commerce." Trademark Act Section 66(a) (the "§ 66 (a) Declaration"). This declaration must "contain a statement that—

- A. the applicant or holder [of the international registration] has a bona fide intention to use the mark in commerce;
- B. the person making the declaration believes himself or herself, or the firm, corporation, or association in whose behalf he or she makes the declaration, to be entitled to use the mark in commerce; and
- C. no other person, firm, corporation, or association, to the best of his or her knowledge and belief, has the right to use such mark in commerce either in the identical form of the mark or in such near resemblance to the mark as to be likely, when used on or in connection with the goods of such other person, firm, corporation, or association, to cause confusion, mistake, or deception.

(7) Goodwood filed a § 66 (a) Declaration that contain[ed] knowingly false statements of material facts with the intention to deceive the USPTO as follows:

a. In Goodwood's § 66 (a) Declaration, Goodwood, as the applicant and holder of the international registration, falsely represented to the USPTO with the intent to deceive the USPTO that Goodwood had a bona fide intention to use the mark in commerce in the United States. This statement was knowingly false when made because:

(i) Goodwood had no bona fide intention to use the mark in commerce in the United States during the five year period beginning on the constructive use date of the § 66 (a) extension of

protection and made the false statement to gain the advantages of registration on the Principal Register of the USPTO from the constructive use date afforded by § 66 (a) without any use or any bona fide intention to use said mark in the United States during said five year constructive use period so that Goodwood could begin using the mark after five years without facing challenges from the Petitioner FOS based on likelihood of confusion.

(ii) Goodwood has never used Goodwood's Second Registration "Festival of Speed" except in the UK and then only in conjunction with the use of Goodwood's First Registration, "Goodwood Festival of Speed" and only referring to Goodwood's historical event held at Goodwood House, Sussex, in the United Kingdom.

(b) In Goodwood's § 66 (a) Declaration, the person making the declaration falsely represented the material fact to the USPTO with the intent to deceive the USPTO that the person making the declaration believed himself or herself, or the firm, corporation, or association in whose behalf he or she makes the declaration, to be entitled to use the mark in commerce. This representation was knowingly false when made because the person making the declaration knew of the existence of FOS and the use by FOS of the FOS trademark "Festivals of Speed" and knew that the intention Goodwood was to obtain an extension of protection under § 66 (a) with no bona fide intention to use the mark for the five year period following the constructive use date afforded by § 66 (a) and then compete head to head with Petitioner using Petitioner's own trademark while claiming that the five year period following the § 66 (a) constructive use date eliminated the ability of FOS to challenge Goodwood's registration on the basis of likelihood of confusion.

(c) In Goodwood's § 66 (a) Declaration Goodwood falsely represented the material fact to the USPTO with the intent to deceive the USPTO that no other person, firm, corporation, or association, to the best of his or her knowledge and belief, has the right to use such mark in commerce either in the identical form of the mark or in such near resemblance to the mark as to be

likely, when used on or in connection with the goods of such other person, firm, corporation, or association, to cause confusion, mistake, or deception. This representation was false because, as more specifically set forth in Paragraphs 9-11 hereof incorporated by reference herein, Goodwood and all persons associated with Goodwood's Second Registration, "Festival of Speed" had actual knowledge of Petitioner FOS and the use of Petitioner's registered trademark, "Festivals of Speed," and were implementing the § 66 (a) Declaration and request for extension of protection pursuant to § 66 (a) specifically for the purpose of obtaining an extension of protection under § 66 (a) with no bona fide intention to use the mark for the five year period following the constructive use date afforded by § 66 (a) and then compete head to head with Petitioner using Petitioner's own trademark while claiming that the five year period following the § 66 (a) constructive use date eliminated the ability of FOS to challenge Goodwood's registration on the basis of likelihood of confusion.

E. Cancellation Ground 5: Non-use.

(1) Goodwood has never used Goodwood's Second Registration, "Festival of Speed," Registration 6132392 in commerce for any goods and services other than in conjunction with Goodwood's First Registration and Goodwood's other international trademarks in conjunction with Goodwood's historic event at Goodwood House, West Sussex, England, United Kingdom. Goodwood has never used Registration No. 6132392 in conjunction with goods and services in the United States.

(2) Goodwood has never used the mark "Festival of Speed" as a stand alone trademark anywhere in the world.

(3) For the foregoing reasons, Goodwood's Registration No. 5557758 should be cancelled for non-use.

**COUNT THREE
CANCELLATION OF GOODWOOD'S REGISTRATIONS AS CAUSING A
LIKELIHOOD OF CONFUSION**

- (1) Petitioner incorporates Paragraphs 1-35 by reference.
- (2) Petitioner is the prior and senior user in the United States of the mark “Festivals of Speed” to the Respondent Goodwood.
- (3) Goodwood’s First Registration, “Goodwood Festival of Speed” prominently depicts the phrase “festival of speed” as a significant constituent component of the mark.
- (4) As applied to Goodwood’s historic event at Goodwood House in the United Kingdom, Petitioner does not contend that the 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. However, to the extent that the mark is not limited to events in the United Kingdom, the mark will result in a likelihood of confusion and damage to the Petitioner.
- (5) Goodwood’s Second Registration, “Festival of Speed” as a logo mark, was registered for the purpose of promoting the “festival of speed” mark in the United States disconnected from the historic use of the mark only as to Goodwood’s event promoted solely within the United Kingdom. The mark is confusingly similar as it only varies by one letter, that is, “festival,” singular, instead of Petitioner’s use of the plural, “festivals,” and the use of the exact name for competing events results in a likelihood of confusion that will damage the Petitioner.
- (6) Goodwood’s promotion of events of the same depiction and category of Petitioner FOS’ events, including automobile, equestrian, yachts, aircraft, and motorcycle events, creates the likelihood of confusion in mind of purchasing public as to whether the event is being promoted by Petitioner FOS or Respondent Goodwood due to the confusingly similar marks that will be sold through similar channels to same class of purchasers.
- (7) The goods and services described in Goodwood’s Registrations explicitly show that

Goodwood intends on head-to-head competition with the 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, and by Goodwood's third Refused IC 411 Attempt.

- (8) Goodwood filed Goodwood's First Goodwood Festival of Speed Registration as a precursor to filing Goodwood's Second Festival of Speed Registration, which in turn was filed as a precursor to the filing of Goodwood's Refused IC 41 Attempt. All of these filings were for the purpose of ultimately registering a "festival of speed" mark to impair and limit FOS' use and expansion of the FOS Festivals of Speed Registration.
- (9) In Goodwood's First Goodwood Festival of Speed Registration the word "Goodwood," means and refers to Goodwood House, Sussex. Accordingly, the consuming public is aware that Goodwood's UK registration, and Goodwood's First Registration, "Goodwood Festival of Speed," relates only to the event at Goodwood, Sussex, in the United Kingdom. Any use within the United States for events promoted by Goodwood through the use of both Goodwood Registrations create a likelihood of confusion.
- (10) FOS has developed its trademark and intends to naturally expand the use of the FOS mark into areas encompassed within Goodwood's descriptions of its use in International Classes 9, 25, and 35, and Goodwood should not be allowed to register its international mark in the United States without any use in either the United Kingdom or the United States and obtain the benefits of registration on the principal register for any use other than the use of Goodwood's First Registration, "Goodwood Festival of Speed," for events in the United Kingdom.
- (11) Likelihood of confusion is a basis for both cancellation and limitation of registered

trademarks.⁷

- (12) 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.

Wherefore; Petitioner requests that Goodwood's Registrations be cancelled and or limited as set forth herein and for such other relief as deemed appropriate.

Dated: August 30, 2022

Respectfully submitted,
/s/Donald J. Schutz
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Certificate of Service: I hereby certify that the foregoing was served via email to Respondent's counsel of record, Craig S. Mende, cmende@fzlz.com, and Daniel M. Nuzzaci, dnuzzaci@fzlz.com, this 30 day of August, 2022.

/s/Donald J. Schutz

⁷ *Fred W. Amend Co. v. Am. Character Doll Co.*, 42 C.C.P.A. 983, 223 F.2d 277 (C.C.P.A. 1955); *Monster Energy Co. v. BeastUp Ltd. Liab. Co.*, 395 F. Supp. 3d 1334 (E.D. Cal. 2019)