

ESTTA Tracking number: **ESTTA1183373**

Filing date: **01/07/2022**

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

Proceeding no.	92078340
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Date	01/07/2022
Attachments	Motion to Dismiss Petition to Cancel FESTIVAL OF SPEED.PDF(69285 bytes)

**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

GOODWOOD’S MOTION TO DISMISS PETITION FOR CANCELLATION

As detailed below, Petitioner Festivals of Speed, LLC’s (“Petitioner”) claims in this proceeding suffer from pervasive flaws and a misunderstanding of basic tenets of U.S. trademark practice, and are devoid of any possible basis in law.

On October 28, 2021, Petitioner filed a Petition for Cancellation of two federal registrations owned by Registrant Goodwood Estate Company Limited (“Goodwood”): U.S. Trademark Reg. No. 5557758 for the word mark GOODWOOD FESTIVAL OF SPEED (“Goodwood’s Word Mark”), shown below:

GOODWOOD FESTIVAL OF SPEED

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



Goodwood moves pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure and Section 503 of the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) to dismiss the Petition for Cancellation (1 TTABVUE) *in its entirety with prejudice*.

In support of its motion, Goodwood states the following:

INTRODUCTION

Petitioner has acknowledged that Goodwood is the organizer of an annual event held in England for nearly three decades “featuring vehicles and other events” known as the “Goodwood Festival of Speed.” (1 TTABVUE ¶ 13.) However, Petitioner commenced this proceeding to cancel the U.S. registrations for Goodwood’s Word Mark and Goodwood’s Logo Mark because—despite a lack of any action by Goodwood against Petitioner at any time—Petitioner speculates that “Goodwood will in all likelihood attempt to enforce [its] Registrations against Petitioner” (1 TTABVUE ¶ 22-23.)

The Petition for Cancellation asserts multiple claims based on random, tangentially-related, and sometimes wholly irrelevant and/or untenable allegations, and includes references to an inapplicable Lanham Act provision (indeed, three references on one page to 15 U.S.C. § 1054 concerning *certification marks*, even though Goodwood’s marks are *not* certification marks) and an inapposite international agreement (the Paris Convention, which is *not* the basis for either of Goodwood’s registrations at issue). The resulting pleading is a smorgasbord of ill-pleaded causes of action, internally inconsistent statements, and conclusory allegations that fall far short of providing a “short and plain statement of the claim[s]” as required under the Federal Rules of Civil Procedure. Fed. R. Civ. P. 8(a)(2).

Even more important, Petitioner has failed to assert legally cognizable claims. Its primary contention is that Goodwood’s *non-U.S. registrations*, which indirectly (via International Registrations) provided the filing bases for its U.S. registrations, are invalid for one purported reason or another. Even if the non-U.S. registrations were invalid—which, as discussed below, they are not—this is simply not a permitted basis for cancellation of a U.S. registration in a Board proceeding. Likewise, Petitioner has failed to adequately plead essential elements of its

other causes of action. Accordingly, Goodwood moves to dismiss with prejudice the fundamentally misguided Petition for Cancellation.

PROCEDURAL HISTORY

Goodwood's U.K. and International Trademark Registrations for Word Mark and Logo Mark

On February 3, 2017, Goodwood filed U.K. Trademark No. UK00003210621 seeking to register Goodwood's Word Mark in the United Kingdom. The mark matured to registration in the U.K. on May 19, 2017 (the "U.K. Word Mark Registration").¹ The U.K. Word Mark Registration is valid, subsisting, and in full force and effect, and Petitioner has not alleged that this U.K. registration has been cancelled or invalidated for any reason. On April 20, 2017, based on its U.K. filing for Goodwood's Word Mark, Goodwood was issued International Registration No. 1370233² for the mark (the "International Word Mark Registration"). (1 TTABVUE ¶ 9.) The International Word Mark Registration is valid, subsisting, and in full force and effect, and Petitioner has not alleged that the registration has been cancelled or invalidated for any reason.

On April 3, 2018, Goodwood filed U.K. Trademark No. UK00003301170 seeking to register Goodwood's Logo Mark in the United Kingdom. The mark matured to registration in the U.K. on June 22, 2018 (the "U.K. Logo Mark Registration"). (1 TTABVUE ¶ 10.) The U.K. Logo Mark Registration is valid, subsisting, and in full force and effect, and Petitioner has not alleged that the registration has been cancelled or invalidated for any reason. On October 3, 2018, based on its U.K. filing for Goodwood's Logo Mark, Goodwood was issued International Registration No. 1449837 for the mark (the "International Logo Mark Registration"). The

¹ Facts concerning Goodwood's U.K. and International Registrations are found in Petitioner's allegations and in the USPTO records for Goodwood's corresponding U.S. registrations. (*See* Application, filed October 19, 2017, for U.S. Reg. No. 5557758 and Application, filed February 14, 2019, for U.S. Reg. No. 6132392.)

² Petitioner incorrectly identifies the International Registration number associated with Goodwood's Word Mark as "International Trade Mark No. 11320233" instead of International Reg. No. 1370233. (*See* 1 TTABVUE ¶ 9.)

International Logo Mark Registration is valid, subsisting, and in full force and effect, and Petitioner has not alleged that the registration has been cancelled or invalidated for any reason.

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

On September 11, 2018, the U.S. Patent and Trademark Office (“USPTO”) issued to Goodwood U.S. Trademark Registration No. 5557758 (the “U.S. Word Mark Registration”) for Goodwood’s Word Mark in International Classes 9, 25, 35, and 41. (1 TTABVUE ¶ 7.) The U.S. Word Mark Registration was issued pursuant to Section 66(a) of the Lanham Act, 15 U.S.C. § 1141f(a), and is based on an extension of protection of the International Word Mark Registration under the Madrid Protocol. (1 TTABVUE ¶¶ 8-9.)

On August 25, 2020, the USPTO issued to Goodwood U.S. Trademark Registration No. 6132392 (the “U.S. Logo Mark Registration”) for Goodwood’s Logo Mark in International Classes 9, 25, and 35. (1 TTABVUE ¶ 7.) The U.S. Logo Mark Registration was issued pursuant to Section 66(a) of the Lanham Act, 15 U.S.C. § 1141f(a), and is based on an extension of protection of the International Logo Mark Registration under the Madrid Protocol.³ (1 TTABVUE ¶¶ 8, 10.)

Petitioner’s Five Claims in the Petition for Cancellation

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

The Petition for Cancellation contains five different counts, alleging that: (1) the U.S. Logo Mark Registration should be cancelled because the U.K. Logo Mark Registration allegedly “does not qualify under the Paris Convention” (1 TTABVUE ¶¶ 29-38); (2) the U.S. Logo Mark Registration should be cancelled because Goodwood purportedly has abandoned the U.K. Logo

³ While Par. 10 of the Petition correctly notes that the U.S. Logo Mark Registration was obtained pursuant to Section 66(a) of the Lanham Act, 15 U.S.C. § 1141(f), Petitioner incorrectly states that the registration is based on the U.K. Logo Mark Registration. Rather, it is based on an extension of protection of the International Logo Mark Registration. (See 1 TTABVUE ¶ 10.)

Mark Registration (1 TTABVue ¶¶ 39-43); (3) the U.S. Word Mark Registration for GOODWOOD FESTIVAL OF SPEED should be cancelled as being “obtained fraudulently” under the *certification mark* provision of the Lanham Act, 15 U.S.C. § 1054, and because Goodwood has “intent to misrepresent its international mark as appropriating the term ‘festival of speed’ to the exclusion of” Petitioner and others (1 TTABVue ¶¶ 44-51); (4) the U.S. Word Mark Registration and U.S. Logo Mark Registration should be cancelled because, purportedly, Goodwood has abandoned any trademark rights it had *in the United Kingdom* (1 TTABVue ¶¶ 52-53); and (5) the U.S. Word Mark Registration and U.S. Logo Mark Registration should be cancelled due to fraud, because Goodwood was allegedly aware at the time of filing that “it had never used the trademarks *in the United Kingdom*” (1 TTABVue ¶¶ 54-59, emphasis added).

ARGUMENT

I. Standard for Motion to Dismiss.

A motion to dismiss for “failure to state a claim upon which relief can be granted” under Federal Rule of Civil Procedure 12(b)(6) is a test of “the legal sufficiency of [the] complaint.” *Tapmaster Inc. v. Perfect Water Techs., Inc.*, Opp. No. 91199561, 2012 WL 8254589, at *5 (T.T.A.B. Dec. 26, 2012); *see also* TBMP § 503. To survive such a motion, a complaint must contain sufficient factual matter, accepted as true, to “state a claim to relief that is plausible on its face.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (citation omitted).

In the context of a Board proceeding, for a claim to be “plausible on its face,” the petitioner must “plead[] factual content that if proved, would allow the Board to conclude, or draw a reasonable inference that, the petitioner has standing and that a valid ground for cancellation exists.” *Corporacion Habanos, S.A. v. Rodriguez*, Canc. No. 92052146, 2011 WL 3871952, at *1 (T.T.A.B. Aug. 1, 2011); *see also* TBMP § 503.02. Factual allegations must not only be well-pleaded, but they also must be more than “[t]hreadbare recitals of the elements of a

cause of action, supported by mere conclusory statements.” *Doyle v. Al Johnson’s Swedish Rest. & Butik, Inc.*, 101 U.S.P.Q.2d 1780, 1782 (T.T.A.B. 2012) (quoting *Iqbal*, 556 U.S. at 678). Such threadbare statements “do not suffice and are not accepted as true.” *Id.*; *see also Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007) (“courts are not bound to accept as true a legal conclusion couched as a factual allegation” (citation and internal quotation marks omitted)).

As to three of the asserted claims (the first, second, and fourth), the Petition for Cancellation fails to assert factual allegations that, if proven, would demonstrate that a valid ground for cancellation exists. As to the remaining two claims (the third and fifth), Petitioner either fails to allege essential elements of the cause of action or asserts allegations that are threadbare and wholly conclusory in nature. Accordingly, the Board should dismiss the Petition for Cancellation in its entirety.

II. The Board Should Dismiss Petitioner’s First, Second, and Fourth Causes of Action for Failure to State a Valid Ground for Cancellation.

Petitioner’s first, second, and fourth causes of action asserted in the Petition for Cancellation should be dismissed because, even accepting the allegations contained therein as true for purposes of this motion, the claims fail to assert a valid legal basis for cancellation of the U.S. Word Mark Registration or the U.S. Logo Mark Registration. Instead, the allegations allude to alleged deficiencies in Goodwood’s foreign and international registrations (deficiencies which in fact do not exist).

A. The First Cause of Action is Legally Deficient.

In its first cause of action, Petitioner asserts a litany of allegations against the *U.K.* Logo Mark Registration—not the *U.S.* Logo Mark Registration—including that: the *U.K.* Logo Mark Registration “was applied for in the United Kingdom in bad faith” (1 TTABVUE ¶ 30.a; *see id.* ¶¶ 33-34, 36); it “is deceptive . . . and is [] not the actual trademark under which [Goodwood] has developed common law rights in the United Kingdom” (1 TTABVUE ¶ 30.b; *see id.* ¶ 35); and

Goodwood “had no intent . . . to use [Goodwood’s Logo Mark] in the United Kingdom” (1 TTABVUE ¶ 30.c; *see id.* ¶ 32). Based on these allegations, Petitioner asserts that the U.K. Logo Mark Registration “is not qualified for registration in the United States under Section 66(a) of the Trademark Act” and “does not qualify under the Paris Convention [sic] . . . and should be declared void.”⁴ (1 TTABVUE ¶¶ 37-38.) Then, in one sentence at the end of its first claim, Petitioner asserts in conclusory fashion that the U.S. Logo Mark Registration should “be declared void and cancelled.”

Petitioner fails to state a claim for relief because the U.S. Word Mark Registration and U.S. Logo Mark Registration were both secured pursuant to Section 66(a) of the Lanham Act, 15 U.S.C. § 1141f(a)—a provision implementing U.S. obligations under the Madrid Protocol—and such registrations cannot be invalidated by a collateral attack against an International Registration in a Board proceeding. The owner of a Section 66(a) registration “has the same rights and remedies as the owner of a national registration issued on the Principal Register by the USPTO.” TMEP § 1904.07; *accord* 15 U.S.C. § 1141i. Accordingly, “the cancellation procedures . . . that result in an invalidation of a registered extension of protection are governed by the substantive and procedural law of the United States, and are the same as for national marks registered by the USPTO.” TMEP § 1904.07. Indeed, Section 14 of the Lanham Act does not include grounds for cancelling a U.S. registration by collaterally attacking a foreign or international registration. *See* 15 U.S.C. § 1064; *see also* TBMP § 309.03(c)(1). Thus, it would

⁴ In Paragraph 38 (1 TTABVUE ¶ 38) and elsewhere in the Petition, Petitioner exhibits confusion as to the basis upon which Goodwood secured its U.S. Logo Mark Registration. It was secured under Section 66(a) of the Lanham Act, 15 U.S.C. § 1141f(a), enacted pursuant to the *Madrid Protocol*. Thus, the registration was secured based on an extension of protection of the International Logo Mark Registration—not based on the U.K. Logo Mark Registration under provisions of Section 44 of the Lanham Act, 15 U.S.C. § 1126, enacted to implement U.S. obligations under the *Paris Convention*.

be improper for the Board to adjudicate the validity of the U.K. Logo Mark Registration or International Logo Mark Registration since the Board's jurisdiction is limited to the United States. *See* TBMP § 102.1.

As noted, Petitioner suggests in Paragraph 38 of the Petition for Cancellation that the U.S. Logo Mark Registration was secured “under the Paris Convention.” (1 TTABVue ¶ 38.) That is incorrect. However, the result here would be no different if Goodwood's U.S. registration had been secured under the provisions of Section 44 implementing the Paris Convention (*see* 15 U.S.C. § 1126), rather than Section 66 implementing relevant provisions of the Madrid Protocol (*see* 15 U.S.C. § 1141f). In *Johnson & Johnson v. Salve S.A.*, in the context of a discovery dispute in a cancellation proceeding, the Board held:

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

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

In any event, because Petitioner's first cause of action asserts that the U.S. Logo Mark Registration should be cancelled based on purported deficiencies alleged solely with respect to Goodwood's U.K. Logo Mark Registration or International Logo Mark Registration—neither of which can be adjudicated by the Board in a cancellation proceeding—Petitioner has failed to state a valid claim for relief. Thus, the first cause of action should be dismissed. *See also* TMEP §§ 1901, 1904.08 (explaining that the International Bureau manages the cancellation of international registrations).

B. The Second and Fourth Cause of Action Are Legally Deficient.

In its second and fourth causes of action, Petitioner asserts allegations in support of a claim of abandonment of the U.K. Word Mark Registration and U.K. Logo Mark Registration. In

particular, Petitioner asserts in its second cause of action that Goodwood “has never used and has never intended to use [Goodwood’s Logo Mark] in the United Kingdom without the word ‘Goodwood’ in the design” (1 TTABVUE ¶ 41), and that “[b]y failing to use [Goodwood’s Logo Mark] in the United Kingdom . . . for more than three years from registration, Goodwood has implicitly or explicitly abandoned [the U.K. Logo Mark Registration]” (1 TTABVUE ¶ 42). Petitioner argues that, as a result, the U.K. Logo Mark Registration “does not qualify under the Paris Convention” (1 TTABVUE ¶ 43), and the U.S. Logo Mark Registration “should be declared void due to abandonment of the underlying UK registration.” (1 TTABVUE ¶ 43.)

Similarly, Petitioner asserts in its fourth cause of action that Goodwood “has *not engaged in any activity in the United Kingdom* that is qualified for trademark protection under Classes 9, 25, or 35,” and thus “any trademark claims under those classes have been abandoned in the United Kingdom.” (1 TTABVUE ¶ 53; emphasis added.) Thus, Petitioner asserts, “Goodwood’s Registrations do not qualify as Section 66(a) Registrations” and that “Goodwood’s Registrations [should] be declared void and/or cancelled.” (1 TTABVUE ¶¶ 53-54.)

Petitioner’s second and fourth causes of action should be dismissed for the same reason that its first cause of action should be dismissed—namely, the claims assert allegations relating to possible abandonment solely with respect to the *U.K. Logo Mark Registration* (Count II and IV) and *U.K. Word Mark Registration* (Count IV). Neither cause of action asserts factual allegations with respect to the *U.S. Word Mark Registration* or the *U.S. Logo Mark Registration*. Because the Board cannot adjudicate Petitioner’s statements regarding the alleged abandonment with respect to the *U.K. Word Mark Registration* and the *U.K. Logo Mark Registration*,

Petitioner has failed to state a valid claim for relief against Goodwood’s U.S. registrations. *See* TMEP § 1904.08.⁵

III. The Board Should Dismiss Petitioner’s Third Cause of Action for Failure to Plead Essential Elements of the Claim.

Petitioner’s third cause of action appears to plead a claim solely with respect to Goodwood’s U.S. Word Mark Registration for the mark GOODWOOD FESTIVAL OF SPEED (*see* 1 TTABVUE Count III (“Goodwood’s First Goodwood Festival of Speed Registration Should Be Cancelled”). Petitioner alleges that the U.S. Word Mark Registration “contains an indication of regional origin” and was “obtained fraudulently in contravention of 15 U.S. Code § 1054.” (1 TTABVUE ¶¶ 46-47.)

Section 4 of the Lanham Act, 15 U.S.C. § 1054, concerns the registration of *certification marks*, which are a special type of mark intended to “certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person’s goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.” 15 U.S.C. § 1127. However, while Goodwood’s Word Mark does in fact indicate the source of Goodwood’s offerings—namely registrant, the Goodwood Estate Company Limited—it is not a certification mark and was not registered pursuant to Section 4 of

⁵ Petitioner also appears to suggest, incorrectly, that Goodwood’s non-US filings suffer from misclassifications of goods and services and similar issues. For example, Petitioner makes the surprising suggestion that certain “downloadable electronic publications” and “software and programs” in Goodwood filings do not properly fall within Class 9 because they are “not an ‘apparatus.’” (1 TTABVUE ¶ 21(A)(i).) Although it is unnecessary to separately address such allegations, as they appear to be aimed at non-U.S. filings (*see id.* at ¶ 21(A)(iii) (Class 35 “is abandoned and is not a proper international filing to support a Section 66(a) registration with the USPTO”)), such allegations reveal a failure to learn the basics of trademark practice before Petitioner launched its (unfounded) broadside attack on Goodwood’s rights.

the Lanham Act. Petitioner's reliance on Section 4 of the Lanham Act is entirely misplaced. Accordingly, Petitioner's claim under 15 U.S.C. § 1054 should be dismissed.⁶

Count III of the Petition for Cancellation also is deficient as a matter of law because Petitioner alleges that "Goodwood's use of the phrase, 'festival of speed' is likely to cause confusion in the market place," even though the mark at issue is GOODWOOD FESTIVAL OF SPEED (not the phrase "festival of speed" alone), and even though Petitioner does not allege it owns prior trademark rights in any mark. (1 TTABVUE ¶¶ 48-51.) In fact, in its cover sheet, while Petitioner listed alleged deficiencies in Goodwood's *foreign* filing as a basis for cancellation of Goodwood's U.S. Word Mark Registration, Petitioner did not list U.S. priority and likelihood of confusion as a basis.⁷

Petitioner's failure to adequately plead the indispensable element of priority with respect to the relevant goods is fatal to any likelihood of confusion claim. *See Altadis U.S.A. Inc. v. Bacardi & Co.*, Opp. No. 91161729, 2006 WL 3307016, at *4 (T.T.A.B. Nov. 7, 2006) ("[S]uch allegations fail to state a claim of priority of use and likelihood of confusion inasmuch as opposer has failed to include an alternative pleading that it has prior (*i.e.*, equal or superior) proprietary rights in the term 'CAZADORES.' . . . The notice of opposition accordingly fails to state any claim upon which relief can be granted and therefore, on this basis alone, must be dismissed.").

Likewise, Petitioner alleges only in conclusory fashion that there is a likelihood of confusion between "Petitioner's Registration" in International Class 41 and Goodwood's U.S. Word Mark Registration in International Classes 9, 25, and 35 because Petitioner "intends to

⁶ The allegations also fail to plead the alleged fraud in obtaining the (supposed) certification mark registration with the required particularity. *See Fed. R. Civ. P. 9.*

⁷ An earlier paragraph of the Petition, before Counts I through V, makes a reference to "likelihood-of-confusion" with respect to Goodwood's U.S. Logo Mark Registration (*see* 1 TTABVUE ¶ 25), but again fails to allege priority. Moreover, the cover sheet to the Petition for Cancellation leaves blank the space where a prior registration or mark is called for.

naturally expand the use of the [FESTIVALS OF SPEED] mark into areas encompassed within Goodwood's descriptions of its use in International Classes 9, 25, and 35." (1 TTABVUE ¶ 50; *see also id.* ¶ 49.)

In addition to being conclusory and not entitled to a presumption of truth, this type of allegation fails to plead the required priority element as a matter of law. In *Exel Oyj v. D'Ascoli*, the opposer argued that it had priority because "applicant's goods [were] within the natural zone of expansion of its registered goods." Opp. No. 91160397, 2008 WL 4354180, at *9 (T.T.A.B. Sept. 19, 2008). The Board held that "opposer cannot be awarded common law priority as to applicant's goods because it has not been established that the bags recited in the application are within the zone of expansion of ski poles and parts therefor, or of ski pole bags." *Id.* Similarly, here, Petitioner has failed to establish priority because there are no factual allegations supporting the claim that Goodwood's goods and services in International Classes 9 (downloadable electronic publications), 25 (apparel), and 35 (advertising and promotional services) are within the zone of expansion of Petitioner's International Class 41 services (exhibitions). Accordingly, the third cause of action should be dismissed in its entirety.

IV. The Board Should Dismiss Petitioner's Fifth Cause of Action Because it Fails to Plead Necessary Elements and Is Based Solely on Conclusory Allegations.

Petitioner attempts to plead a claim for fraud as its fifth cause of action, but its pleading is legally deficient. Petitioner alleges that when Goodwood applied for its U.S. registrations pursuant to Section 66(a) of the Lanham Act, it declared: "[1] that it has the [sic] a bona fide intention to use the mark in commerce that can be controlled by the United States Congress, [2] that it . . . is entitled to use the mark in commerce; and [3] that to the best of [its] knowledge and belief, no other person, firm, corporation, or association has the right to use the mark in commerce." (1 TTABVUE ¶ 56.)

Petitioner does not challenge Goodwood’s bona fide intention to use its marks in the U.S.⁸ Rather, Petitioner alleges that when Goodwood made this declaration, it “was aware” that Petitioner owned a registration for FESTIVALS OF SPEED (1 TTABVUE ¶ 57), and thus the second and third statements (entitlement to use the mark, and no knowledge of another party with prior conflicting rights) were “knowingly false.” (TTABVUE ¶ 59.)

Under the Board’s jurisprudence, “[f]raud in procuring or maintaining a trademark registration occurs when an applicant [1] knowingly makes a [2] specific false, [3] material representation of fact in connection with an application or registration [4] with the intent of obtaining or maintaining a registration to which it is otherwise not entitled.” *Basic Sports Apparel, Inc. v. Spiral Direct Ltd.*, Opp. No. 91242798, 2019 WL 1306914, at *5 (T.T.A.B. Mar. 20, 2019) (citing *In re Bose Corp.*, 91 U.S.P.Q.2d 1938, 1939 (Fed. Cir. 2009)).⁹

Petitioner’s claim for fraud must be dismissed as a matter of law because it fails even to plead two of these four indispensable elements required to establish a *prima facie* claim for fraud: materiality and intent to deceive. *See Bose*, 91 U.S.P.Q.2d at 1941 (“Subjective intent to deceive, however difficult it may be to prove, is an indispensable element in the analysis.”); *STK, LLC v. Backrack Inc.*, Canc. No. 92049332, 2010 WL 9924827, at *3 (T.T.A.B. Feb. 25, 2010) (“Intent is a required element to be pleaded for a claim of fraud.”). Petitioner has failed to plead either of these elements, let alone plead them with the requisite specificity needed to sustain a claim for fraud. *See Fed. R. Civ. P. 9(b)*. Accordingly, Petitioner’s failure to plead these elements

⁸ Indeed, Petitioner claims injury based on anticipated activity and enforcement of registrations by Goodwood in the U.S., where it alleges Goodwood is already “attempting to gain entry.” (*See* 1 TTABVUE ¶¶ 19, 22.)

⁹ The fifth claim also re-hashes Petitioner’s untenable abandonment claims, alleging that “any trademark claims under [Classes 9, 25, or 35] have been abandoned in the United Kingdom, and therefore, Goodwood’s Registrations do not qualify as Section 66(a) Registrations” (1 TTABVUE ¶ 55), and that “Goodwood had the actual knowledge” of its purported U.K. abandonment when it filed the U.S. applications (1 TTABVUE ¶ 58). Such allegations are legally deficient for the same reasons as Petitioner’s abandonment claims in Counts II and IV.

is fatal to its fraud claim. *See Basic Sports Apparel*, 2019 WL 1306914, at *5 (dismissing fraud claim because “Opposer has failed to plead the indispensable element of intent.”). Moreover, any allegation of materiality (*i.e.*, that a registration would not have issued but for the allegedly false statement) would be undermined with respect to Goodwood’s U.S. Logo Mark Registration by Petitioner’s acknowledgement that the USPTO examiner was aware of Petitioner’s registration. (*See* 1 TTABVUE ¶ 58.)

In addition, even the two elements Petitioner does recite—that the statements were “knowing[]” and “false”—are pleaded in a threadbare, conclusory fashion that falls far short of the particularity needed to support a fraud claim. “A party seeking cancellation of a trademark registration for fraudulent procurement bears a heavy burden of proof. . . . There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.” *Bose*, 91 U.S.P.Q.2d at 1939 (citations and internal quotation marks omitted); *see also Basic Sports Apparel*, 2019 WL 1306914, at *5 (“A fraud claim must set forth all elements of the claim with a heightened degree of particularity in compliance with Fed. R. Civ. P. 9(b).”); Fed. R. Civ. P. 9(b) (“In alleging fraud or mistake, a party must state with particularity the circumstances constituting fraud or mistake.”).

Petitioner’s statements in support of its fraud claim are unsupported by specific factual allegations detailing the nature of the purported fraud. Indeed, Petitioner’s entire claim for fraud rests on its barebones assertion that Goodwood was “aware” of Petitioner and, therefore, the statements in Goodwood’s declaration were “knowingly false.” (*See* 1 TTABVUE ¶¶ 57-59.) These statements are insufficient as a matter of law to support a *prima facie* claim for fraud. *See Intellimedia Sports, Inc. v. Intellimedia Corp.*, 43 U.S.P.Q.2d 1203, 1207 (T.T.A.B. 1997) (fraud claim requires “more than a mere conclusory allegation that the defendant ‘knew’ about a third party’s superior rights in the mark.”).

Lastly, even if Petitioner’s allegations in support of its fraud claim contained all of the required elements of a fraud claim, and even if they had not been pleaded in a conclusory fashion, the fifth cause of action would still be subject to dismissal as a matter of law. Petitioner alleges that Goodwood knowingly propagated a falsehood by making the following statements in its declarations for its Section 66(a) registrations: that it “is entitled to use the mark in commerce” and that “no other person, firm, corporation, or association has the right to use the mark in commerce.” (1 TTABVUE ¶ 59.)

It is well settled that “when an applicant avers that it has the exclusive right to use the mark, a fraud claim against the applicant will not lie unless the applicant knew that another person ‘possess[ed] a superior or clearly established right to use the same or substantially identical mark’ for the same or substantially the same goods or services.” *ZAO Odessky Konjatschnyi Zawod v. SIA “Baltmark Inv.”*, 109 U.S.P.Q.2d 1680, 1686 (E.D. Va. 2013) (quoting *Intellimedia Sports*, 43 U.S.P.Q.2d at 1207). As the Board held in *MedBox, LLC v. PVM International, Inc.*, Opp. No. 91199915, 2013 WL 5820846 (T.T.A.B. Oct. 10, 2013):

[T]o the extent that the fraud claim is based on the allegation that applicant [] knew about opposer or opposer’s use of [an allegedly confusingly similar mark] prior to filing the involved application, that is not enough to establish fraud.

Id. at *11. And in *Qualcomm Inc. v. FLO Corp.*, the Board held that

A plaintiff claiming that the declaration or oath in a defendant’s application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed, must *allege particular facts* which, if proven, would establish that: (1) there was in fact another use of the same or a confusingly similar mark at the time the oath was signed; (2) the other user had legal rights superior to applicant’s; (3) applicant knew that the other user had rights in the mark superior to applicant’s, and either believed that a likelihood of confusion would result from applicant’s use of its mark or had no reasonable basis for believing otherwise; and that (4) applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

93 U.S.P.Q.2d 1768, 1768 (T.T.A.B. 2010) (emphasis added). As discussed above, Petitioner has failed to plead any of the foregoing elements of its fraud claim with particularity and has failed to plead the second, third, and fourth elements recited in *Qualcomm* entirely. In light of the foregoing, Petitioner's fifth cause of action must be dismissed as a matter of law.

CONCLUSION

For the foregoing reasons, Goodwood respectfully requests that the Board dismiss the Petition for Cancellation in its entirety with prejudice.

Dated: New York, New York
January 7, 2022

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By:  _____

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CERTIFICATE OF SERVICE

I hereby certify that on this 7th day of January 2022, a copy of the foregoing
GOODWOOD'S MOTION TO DISMISS PETITION FOR CANCELLATION was sent by
e-mail to Petitioner's counsel of record at *don@lawus.com* and *donschutz@netscape.net*.



Daniel M. Nuzzaci