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

Proceeding no.	92080484
Party	Defendant Mirjam Poterbin
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Luka99, Inc..
Petitioner,

v.

Cancellation No.: 92080484
Reg. No. 5953034
Mark: LUKA DONCIC 7

Mirjam Poterbin,
Respondent.

**RESPONDENT’S MOTION IN SUPPORT TO HER MOTION TO DISMISS FOR
FAILURE TO STATE A CLAIM**

Respondent, Mirjam Poterbin (“Respondent”), has filed a Motion to Dismiss (“Motion to Dismiss”) to dismiss the Petition for Cancellation (“Petition”) filed by Petitioner, Luka99, Inc. (“Petitioner”), under Fed. R. Civ. P. 12(b)(6) for failure to state a claim on October 13, 2022. On October 31, 2022 Petitioner filed an Opposition to Respondent’s Motion to Dismiss (“Motion in Opposition to MTD”). Respondent files this Motion in Support of its Motion to Dismiss to address several points raised in Motion in Opposition to MTD and set the record straight.

Lack of Consent of a Living Individual

Petitioner alleges in the Petition to Cancel that Mr. Doncic provided written consent to Respondent for the use and registration of his name in 2018 (*TTABVUE #1* at 14, ¶22), based on which Respondent obtained Reg. No. 5953034 on January 7, 2020. Further, Petitioner alleges that in 2021 he revoked that consent *Id.* ¶22. The choux of the basis of cancellation based on Trademark Act Sections 14(1) and 2(c) is Petitioner’s allegation that an “express revocation of consent necessarily means that the registration currently exists without the consent of the

identified living individual. (*See* Motion in Opposition to MTD *at* 4). However, even to assume – solely for the argument’s sake - that all allegations in the Petition are true, claim under Section 2(c) is simply not plausible on its face.

15 U.S.C. §1052 states:

No trademark by which the goods of the applicant may be distinguished from the goods of others **shall be refused registration on the principal register** on account of its nature **unless it ... (c) Consists of or comprises a name**, portrait, or signature **identifying a particular living individual except by his written consent**, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

(citation omitted, bold font and underlining added)

TMEP §813 also states:

When a name, portrait, or signature in a mark identifies a particular living individual, or a deceased president of the United States during the life of his widow, **the mark can be registered only with the written consent of the individual**, or of the president’s widow, respectively.

(citation omitted, bold font and underlining added)

Plain reading of Section 2(c) and supporting TMEP §813 leaves no doubt that the purpose of this section is to preclude registration of a living individual’s name without a written consent. Therefore, in order for Petitioner to demonstrate claim under Section 2(c) is plausible on its face, it must allege that USPTO should have refused registration of Respondent’s trademark application because she did not have a written consent from Mr. Luka Doncic. Clearly, Petitioner did not (and cannot) do so because Petitioner conceded that Mr. Luka Doncic provided an effective written consent to register his name at the time of the application. Therefore, USPTO had no legal grounds to refuse or preclude Respondent’s registration in accordance with Section 2(c) of 15 U.S.C. §1052.

Petitioner claims that “resolution of that claim cannot be resolved at the pleadings stage but only after full discovery and consideration by the Board.” See Motion in Opposition to MTD at 7.

At this point the Board must determine if a valid ground exists for contesting the registration of the mark and, even to assume that Mr. Luka Doncic attempted to “withdraw” his consent after registration ¹, it is unclear how conducting discovery would affect the issue at hand.

Finally, it is worth noting that in the Motion in Opposition to MTD, Petitioner argues that “Respondent cites no cases – nor could she – in which the Board or the Federal Circuit considered a rejection or cancellation of a registration in which there was initial consent that was later withdrawn.” See Motion in Opposition to MTD *at* 6. There is a great number of precedents in connection with “rejection” (or most commonly called “refusal”) of registration of marks based on 15 U.S.C. §1052 or cancellation of registrations², however, none of them are relevant to the issue at hand because they all deal with the situations when a mark was registered or attempted to be registered without a written consent on record. Indeed, Registrant – just like Petitioner - did not cite any cases, when consent was withdrawn **after** registration. However, a simple explanation of it is 15 U.S.C. §1052 clearly refers to a basis for refusal of registration when a written consent was never obtained and simply does not allow valid ground for contesting the registration with a valid consent on the record based on the facts alleged in the Petition.

¹ For the record, Respondent disputes any allegations about the “withdrawal” of the consent, including its legality and effectiveness/, however, this is irrelevant for the purposes of the Motion to Dismiss.

² For example, *See In re Hoefflin*, 97 USPQ2d 1174, 1177-78 (TTAB 2010) (holding registration of the marks OBAMA PAJAMA, OBAMA BAHAMA PAJAMAS, and BARACK’S JOCKS DRESS TO THE LEFT barred under §2(c) in the absence of consent to register, because they create a direct association with President Barack Obama); *In re Sauer*, 27 USPQ2d 1073, 1074-75 (TTAB 1993) (holding registration of a mark containing BO, used in connection with a sports ball, barred under §2(c) in the absence of consent to register, because BO is the nickname of a well-known athlete and thus use of the mark would lead to the assumption that he was associated with the goods), *aff’d per curiam*, 26 F.3d 140 (Fed. Cir. 1994); *In re Steak & Ale Rests. of Am., Inc.*, 185 USPQ 447, 448 (TTAB 1975) (affirming a §2(c) refusal of the mark PRINCE CHARLES because the wording identifies a particular well-known living individual whose consent was not of record); *Laub v. Indus. Dev. Labs., Inc.*, 121 USPQ 595 (TTAB 1959) (sustaining a §2(c)-based opposition to registration of opposer’s surname, LAUB, for use on goods that opposer was associated with, because applicant had not obtained opposer’s written consent); *Reed v. Bakers Eng’g & Equip. Co.*, 100 USPQ 196 (PTO 1954) (holding registration of REED REEL OVEN barred by §2(c) in the absence of written consent to register from the designer and builder of the ovens, Paul N. Reed)

False Suggestion of a Connection

In her Motion to Dismiss Respondent argued that Petitioner failed to allege that Mr. Luka Doncic named by the mark is not connected with the activities performed by the Respondent under the mark. In its Motion in Opposition to MTD Petitioner ignored this point merely stating that Petitioner alleges that Mr. Doncic is not commercially affiliated or associated with Respondent or any of her goods and services. (*TTABVUE #1* at 14, ¶18).

Petitioner cannot mechanically recite parts of the test in hopes of surviving the Motion to Dismiss while Petitioner's remaining allegations clearly contradict the test. Specifically, Petitioner admitted that Registrant provided long-term assistance in her son's Luka Doncic's business affairs (see *TTABVUE #1* at 5). In addition, Mr. Luka Doncic granted a written consent to use and registration of his name as a trademark to Respondent so she can continue handling his business affairs associated with a vast line of goods and services listed in the registration. (*Id.* at 8, ¶ 4).

As a general guidelines, of what may or may not constitute "connection" see *In re Sloppy Joe's International Inc.*, 43 USPQ2d 1350, 1353-54 (TTAB 1997), wherein the Trademark Trial and Appeal Board held that Ernest Hemingway's friendship with the original owner of applicant's bar, his frequenting the bar, and his use of the back room as an office did not establish the kind of "connection" that entitled applicant to register a mark consisting in part of a portrait of Hemingway. Rather, a commercial connection, such as an ownership interest or commercial endorsement or sponsorship of applicant's services would be necessary to entitle the applicant to registration. *Id.*

The current situation strikingly different from the one described in *In re Sloppy Joe's International*. No amount of arguments or evidence would change Petitioner's allegations that Registrant provided long-term assistance in her son's Luka Doncic's business affairs and Luka

Doncic granted a written consent to his mother to use and register his name as a trademark. This demonstrates indisputable evidence of connection between Registrant and Mr. Luka Doncic with regard to the activities performed by Registrant under the mark. Therefore, Petitioner failed to demonstrate that the third element of Section 2(a) and Petition must be dismissed in part of such claim.

Abandonment claim

A pleading should include enough detail to give the defendant fair notice of the basis for each claim. See TBMP § 309.03(a)(2). In particular, the claimant must allege well-pleaded factual matter and more than "[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements." See TBMP §503.02. Also see *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (citing *Twombly*, 550 U.S. at 555). See, e.g., *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925, 1926 (TTAB 2014) (motion to dismiss applicant's non-use and abandonment counterclaims granted); *Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1697 (TTAB 2014).

In part of the abandonment claim, Petitioner alleged the following:

27. Upon information and belief, neither Registrant nor any licensees are currently using the LUKA DONCIC 7 (Stylized) mark on any of the goods and services identified in the LUKA DONCIC 7 (Stylized) Registration in U.S. commerce.

28. Upon information and belief, Registrant lacks the intent to resume use of the LUKA DONCIC 7 (Stylized) mark and therefore has abandoned any and all rights to it.

See TTABVUE #1 at 15, ¶¶ 27, 28.

Registrant is actively using its mark in US, which by default demonstrates that she has maintained her intent to resume use. To make it clear – Registrant is not requesting to provide detailed facts or supporting evidence on how Petitioner reached a conclusion that the mark was

abandoned. However, a mere phrase “upon information and belief” can hardly provide any fair notice of the basis of the claim that Petitioner’s allegations are formed after reasonable inquiry or abandonment claim is reasonably based. The way abandonment “allegations” are presented, they look like a threadbare recitals of the elements of the claim supported by mere conclusory statements.

Moreover, Respondent’s mark was registered less than three years before the Petition. Therefore, Petitioner’s allegation of Respondent’s lack of intent to “resume use” of the mark is an improper claim of abandonment. *See Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d at 1931 (“[B]ecause both of Opposer’s registrations were less than three years old when Applicant’s abandonment counterclaim was filed, the presumption of intent to abandon pursuant to Trademark Act Section 45 arising from nonuse for three consecutive years does not apply, and the counterclaim is insufficient absent an allegation of Opposer’s intent not to commence use of its registered marks”). Petitioner’s allegation that Registrant abandoned her intent to “resume use” of the mark does not clarify Petitioner’s abandonment claim because Registrant is not required to prove her intent to resume use, but only her intent to commerce use of the mark.

Petitioner’s Petition should be dismissed in its entirety on that basis.

Respectfully submitted,

Date: November 11, 2022

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CERTIFICATE OF SERVICE

I hereby certify that I served the foregoing *Motion* upon Respondent by causing a true and correct copy thereof to be to Petitioner's Attorney at trademarks@brownrudnick.com, pwillsey@brownrudnick.com, vbadolato@brownrudnick.com, doakes@brownrudnick.com on November 11, 2022.

/alazouski/
Alex Lazouski