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

Proceeding	92076572
Party	Plaintiff BSA Sales LLC
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Registration No. 6094421
Date of Issuance: July 7, 2020

)	
)	
BSA Sales LLC)	
)	
Petitioner,)	
)	
Vs.)	Cancellation No.: 92076572
)	
Jewel Farazi)	
)	
Registrant.)	
)	

**RESPONSE OF PETITIONER IN OPPOSITION TO
REGISTRANT’S MOTION TO DISMISS**

BSA Sales LLC (“Petitioner”), through its undersigned counsel, hereby responds to Jewel Farazi’s (“Registrant”) Motion to Dismiss under Federal Rule of Civil Procedure 12(b)(6).

1. Registrant argues that Petitioner lacks standing. Both the opposition statute and the cancellation statute speak in terms of “belief” in “damage” by the Opposer or Petitioner. Lanham Act §§ 13, 14, 15 U.S.C.A. §§ 1063, 1064. Standing to cancel is based on the same general criteria as standing to oppose. As in opposition proceedings, a petitioner asking for cancellation need not plead or prove actual damage. Traditionally, all petitioner need plead are facts supporting a reasonable belief that there is a likelihood of damage caused by the continuing registration of the mark. *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 U.S.P.Q.

641 (Fed. Cir. 1983) (“[P]leading and proof of damage or belief in damage are not necessary to establish standing [in either an Opposition or Cancellation].”); T.B.M.P. § 309.03(b) (“At the pleading stage, all that is required is that a plaintiff allege facts sufficient to show a ‘real interest’ in the proceeding, and a ‘reasonable basis for its belief of damage.’”).

The purpose of the standing requirement in opposition and cancellation proceedings is to prevent a “mere intermeddler” from initiating such a proceeding. *Ritchie v. Simpson*, 170 F.3d 1092, 1095, 50 U.S.P.Q.2d 1023 (Fed. Cir. 1999). This means that to establish standing to petition to cancel, the petitioner need only be something more than a gratuitous interloper or a vicarious enforcer of someone else's rights. “Since ‘mere intermeddlers’ only rarely bring such challenges, few proceedings are ever dismissed for lack of standing ***and a challenge to standing is usually just a futile procedural gesture.***” 3 McCarthy on Trademarks and Unfair Competition § 20:46 (5th ed.).

Contrary to Registrant’s assertions, “to have standing to petition to cancel registration of a mark as being deceptive . . . , petitioner need not have a pending application for the mark, does not have to be using the designation as a mark or even use the designation at all. For example, the Cuban government's cigar exporter had standing to cancel a registration for PINAR DEL RIO (name of a Cuban Province) for non-Cuban cigars as being either deceptive or primarily geographically deceptively mis-descriptive even though Cuban cigars could not be sold in the U.S.” To have standing to petition to cancel registration of a mark as being either deceptive or primarily geographically deceptively mis-descriptive, petitioner need not have a pending application for the mark, does not have to be using the designation as a mark or even use the designation at all. For example, the Cuban government's cigar exporter had standing to cancel a registration for PINAR DEL RIO (name of a Cuban Province) for non-Cuban cigars as being

either deceptive or primarily geographically deceptively mis-descriptive even though Cuban cigars could not be sold in the U.S.” 2 McCarthy on Trademarks and Unfair Competition § 14:30 (5th ed.) citing *Corporacion Habanos, S.A. and Empresa Cubana del Tabaco, d.b.a. Cubatabaco v. Juan E. Rodriguez*, 2011 WL 3871952 (T.T.A.B. 2011).

In any event, as Petitioner has alleged in its Cancellation Petition, Registrant has misused (and continues to misuse) its registration against Petitioner on third party Online platforms in a manner that causes direct injury to Petitioner. Petitioner certainly has a “real interest” in the outcome of the proceeding and more than a mere “reasonable basis” for its belief that it will suffer damage by the continued registration. Petitioner need not “believe” that it will suffer damage; it has already experienced it, and it has so alleged.

2. Registrant argues that its mark is not deceptive and is not misdescriptive, though admittedly Petitioner doesn’t quite follow Registrant’s logic. The Federal Circuit and the Trademark Board use a three-part test of deceptiveness under Lanham Act § 2(a), 15 U.S.C.A. § 1052(a):

- (1) Is the term misdescriptive of the character, quality, function, composition or use of the goods?
- (2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods or their quality, character or feature?
- (3) If so, is the misdescription “material” in the sense it would be likely to affect the decision to purchase?

Applying this test, the Federal Circuit held that the mark LOVEE LAMB for auto seat covers made of synthetic fiber was deceptive and unregistrable as falsely implying that the product was made from natural lamb or sheep skins. *In re Budge Mfg. Co., Inc.*, 857 F.2d 773,

776, 8 U.S.P.Q.2d 1259 (Fed. Cir. 1988). Similarly, applying the three-part test, the Trademark Board found that SUPER SILK for shirts not made from silk was deceptive under § 2(a). The term SUPER was found to connote a superior grade of silk and SUPER SILK was material to purchasing decisions given the desirable attributes of silk for garments. *In re Phillips-Van Heusen Corp.*, 63 U.S.P.Q.2d 1047, 2002 WL 523343 (T.T.A.B. 2002).

Applying the three-part test to Dr. Joel's, Petitioner alleges that (1) the term "Dr." included in the registration is misdescriptive, in that no doctor is in any way associated with Registrant's product; (2) because the product is a pain relief and health product, consumers are likely to believe that the misdescription ("Doctor") actually describes a quality, character or feature of the goods; and (3) the misdescription is "material" in the sense that it would be likely to affect the decision to purchase a pain relief product. Certainly one would be more inclined to purchase such a product if he believed that the product was developed by a doctor rather than a lay person having no expertise in medicine or health.

For the reasons above, Petitioner respectfully requests that the Board deny Registrant's Motion to Dismiss.

Respectfully submitted,



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