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

Proceeding	91252460
Party	Plaintiff Valley Boyz, LLC
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VALLEY BOYZ'S CORRECTED RESPONSE TO MOTION TO DISMISS
(88/374,358 and 88/374,356)

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

VALLEY BOYZ, LLC

Opposer,

v.

Kelly Oubre, Jr.,

Applicant.

Opposition No. 91252460
Serial Nos. 88/374,358 and 88/374,356
Mark: VALLEY BOYZ
Filing Date: April 6, 2019
Publication Date: July 23, 2019

VALLEY BOYZ, LLC'S CORRECTED RESPONSE TO MOTION TO DISMISS

Pursuant to 37 C.F.R. § 2.127(a), Opposer Valley Boyz, LLC ("Valley Boyz") hereby files its Response to Applicant Kelly Oubre Jr.'s ("Applicant") Motion to Dismiss for lack of standing. As set forth below, Valley Boyz pleaded facts, which have not been disputed by Applicant, sufficient to establish standing to oppose Applicant's Applications Serial Nos. 88/374,358 and 88/374,356 ("ITU Applications") for the mark VALLEY BOYZ ("Mark"). As alleged, Valley Boyz is the senior user of the Mark. Nothing in Applicant's motion contests that fact. Instead, Applicant attempts to improperly argue the merits of the case to contest standing. Applicant's arguments fail to establish prior use of the Mark in commerce. With Valley Boyz uncontested factual allegations properly considered, Applicant's motion to dismiss should be denied, so that the matter can proceed to a decision on the merits.

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

What this case boils down to is a term that was mentioned in public with no intention for that term to be used to designate a source of goods and services. That is until Opposer Valley Boyz began offering clothing and accessories for sale in March 2019 under the Mark. While certain National Basketball Association Phoenix Suns

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players may have coined the term, VALLEY BOYZ, Opposer Valley Boyz was the first to actually use the Mark *in commerce* as a source designator for goods, thus establishing senior user common law rights over the Mark. People associate purchasing t-shirts with the VALLEY BOYZ mark with Opposer Valley Boyz at <https://valleyboyz.com/>. At bottom, with Opposer Valley Boyz's undisputed allegations properly considered here, it has established sufficient interest and shown a concrete belief it will be damaged if Applicant registers the Mark. Nothing in Applicant's Motion contests this. Consequently, Applicant's motion to dismiss should be denied.

II. RELEVANT FACTS

When reviewing standing, "the legitimacy of the petitioner's activity from which its interest arises will be presumed in the absence of evidence to the contrary." *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1029 (C.C.P.A. 1982). And since this is a motion to dismiss, Valley Boyz's facts as alleged are to be presumed true and all reasonable inferences from the Notice of Opposition shall be resolved in its favor. Fed. R. Civ. P. Rule 12(b)(6); *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235 (9th Cir. 2013).¹

Here Opposer Valley Boyz's uncontested allegations in the Notice of Opposition allege as follows. Since March of 2019, Valley Boyz has continuously engaged in and is presently engaged in selling clothing and related goods in connection with the Mark. (Notice of Opposition ¶¶ 3 and 4, and Ex. A.)² Specifically, Valley Boyz engages in the manufacture, distribution, sale, advertising, and promotion in commerce of clothing and related accessories, including t-shirts, sweatshirts, zip-up sweatshirts, hats, stickers,

¹ 37 C.F.R. § 2.116(a) adopts the Federal Rules of Civil Procedure.

² On April 2, 2019, Valley Boyz acquired the rights to the VALLEY BOYZ Mark from its previous owner Robert Ferguson. By virtue of this sale, Valley Boyz acquired the date of first use for the Mark, and also including all claims and rights to all intellectual property (including the trade name, trademarks, patents, web address, email address, designs and patterns related to "Valley Boyz"). To the extent the Board has any concern with respect to this issue, Valley Boyz attaches a true and correct copy of Bill of Sale and Purchase Agreement as **Exhibit 1**.

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socks, mugs, technology cases, dog-tag necklaces, bags, towels and related products. (*Id.* at ¶ 3.) Valley Boyz began offering these goods for sale in March 2019 and indeed made sales of goods. (*Id.* at ¶ 5.) Valley Boyz has made substantial investments by extensively advertising, promoting, and offering goods bearing the VALLEY BOYZ Mark. (*Id.* at ¶ 6.) Valley Boyz has promoted this brand to the public through various channels of trade in commerce, with the result that Valley Boyz customers and the public in general have come to know and recognize Valley Boyz's VALLEY BOYZ Mark and associate the same with its goods. (*Id.*) As a result, Valley Boyz has developed goodwill and distinctiveness as it relates to the goods it offered prior to Applicant even the filing his ITU Applications, and certainly before Applicant's intended use of the applied-for-mark. (*Id.* at ¶ 8.)

In early March 2019, Valley Boyz reached out to Applicant and proposed a business relationship for Applicant to become a part of Valley Boyz and help promote the VALLEY BOYZ brand.³ (*Id.* at ¶ 9.) Applicant rejected the proposed business offer. (*Id.*) Despite Valley Boyz's rights to the Mark, Applicant filed an intent-to-use based applications for the exact goods Valley Boyz sells on its website and for the exact word mark, VALLEY BOYZ. (*Id.* at ¶¶ 10-15.) Indeed, the applied for goods in Applicant's ITU Applications and the goods of Valley Boyz are closely related, in that they are the exact same types of goods covering clothing and related accessories in International Classes 25 and 14. (*Id.* at ¶¶ 10-15.) The wordmark in the ITU Applications is the exact same as Valley Boyz's VALLEY BOYZ Mark. (*Id.* at ¶ 16.) Thus, customers and the general public are likely to be confused, or mistaken, or deceived as to the origin and

³ Applicant's Exhibit F is an email from Valley Boyz where it (via its owner Gil Negrete) proposed a business venture with Mr. Oubre regarding the Valley Boyz business. Indeed, this occurred; however the initial offer was made on March 7, 2019, not May 6. Valley Boyz provides the full email communication attached hereto as **Exhibit 2**. Thus, prior to Applicant filing for its ITU Applications, Valley Boyz provided details as to its intentions for the business. (*Id.*)

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sponsorship of Applicant's proposed goods in the ITU Applications and that of Valley Boyz. (*Id.*)

Because of the foregoing, Valley Boyz has an interest in protecting its intellectual property and priority date of the use for the Mark.

III. ARGUMENT

Applicant puts forth two flawed arguments to claim Valley Boyz lacks standing to oppose Applicant's ITU Applications. First, Applicant contends that Valley Boyz does not own rights to the Mark because it did not own the business when it first began selling clothing. That is incorrect. Valley Boyz acquired the rights via a purchase of assets on April 1, 2019 from Mr. Ferguson. Therefore, Valley Boyz acquired the right to protect any and all intellectual property, including the first use date of the Mark. Second, Applicant attempts to argue that it has superior rights in the Mark by virtue of hand-picked, self-serving social media and blog posts that describe Applicant as coining the phrase Valley Boyz. Applicant would like to believe that the first use of a mark in the world for any purpose means that Applicant is the only one that can use the phrase for all time; but this is not the law. Applicant has never used the Mark in commerce, let alone before Valley Boyz in March 2019. Notably, most of this so-called evidence of prior use (notably not "use in commerce") occurred after Opposer first used VALLEY BOYZ in commerce. Applicant also contends that Valley Boyz, when used by Applicant, has acquired secondary meaning in the Mark or that somehow Valley Boyz (which is plural) is somehow a nickname for Applicant Kelly Oubre (a single person). This ludicrous argument is inappropriate for a motion to dismiss and, regardless, it falls flat as there is no evidence of established secondary meaning here.

A. Valley Boyz Has Standing to Oppose the Applications.

Applicant's argument that Valley Boyz lacks standing because it does not own the Mark fails right out of the gates. And indeed, the requirements for standing to oppose a trademark is "[a]ny person who believes that he would be damaged by the registration of

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