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

Proceeding no.	91277190
Party	Plaintiff 1661, Inc.
Correspondence address	JENNIFER L. BARRY LATHAM & WATKINS LLP 650 TOWN CENTER DRIVE, SUITE 2000 COSTA MESA, CA 92626 UNITED STATES Primary email: ipdocket@lw.com Secondary email(s): ipdocket2@lw.com, tara.villegas@lw.com, alethia.corneil@lw.com 7145401235
Submission	Motion to Dismiss 2.132
Filer's name	Jennifer L. Barry
Filer's email	Jennifer.Barry@lw.com
Signature	/s/ Jennifer L. Barry
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**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

1661, Inc. d/b/a GOAT,

Opposer,

v.

Goatpix, LLC,

Applicant.

Opposition No. 91277190

Trademark: GOATPIX GALLERY

Serial No. 90/724856

**OPPOSER’S MOTION TO DISMISS APPLICANT’S AMENDED
COUNTERCLAIMS FOR ABANDONMENT AND FRAUD AND MOTION TO
STRIKE AFFIRMATIVE DEFENSES**

Pursuant to Federal Rule of Civil Procedure 12(b)(6) and the Trademark Trial and Appeal Board Manual of Practice (“TBMP”) § 503, Opposer 1661, Inc. d/b/a GOAT (“GOAT”) requests that the Board dismiss Applicant Goatpix, LLC’s (“Goatpix”) counterclaims for abandonment and fraud in its First Amended Answer, Affirmative Defenses, and Counterclaims (“Amended Counterclaims”). Further, pursuant to Federal Rule of Civil Procedure 12(f) and TBMP § 506, GOAT requests that the Board strike Goatpix’s affirmative defenses.

I. INTRODUCTION

In the face of GOAT’s superior trademark rights and registrations, Goatpix brings counterclaims against GOAT to try to buy leverage in this opposition proceeding. Specifically, Goatpix seeks to cancel several of GOAT’s registrations for the GOAT[®] mark on the grounds of abandonment and fraud. These counterclaims, however, are meritless and legally defective. Goatpix also raises several baseless affirmative defenses to needlessly multiple the issues in this proceeding. Despite GOAT’s attempts to meet and confer on these improper claims, Goatpix has

refused to withdraw either its counterclaims or affirmative defenses. Thus, the Board should dismiss Goatpix's counterclaims for abandonment and fraud and strike its affirmative defenses.

First, Goatpix claims that three of GOAT's trademark registrations have been abandoned. But Goatpix does not (and cannot) allege a prima facie case of abandonment based on three consecutive years of nonuse. Goatpix also fails to allege specific facts that show GOAT has discontinued use of its marks with intent not to resume such use. Goatpix acknowledges that GOAT acquired its trademark registrations from its predecessor, Goat Fashion Limited ("GFL") on November 29, 2021, and, fixating on this fact, Goatpix claims that GOAT did not use its acquired marks since that date. Even if this allegation were true, Goatpix has alleged at most one year of nonuse (and not three consecutive years). This leaves Goatpix with only one other way to state an abandonment claim: Goatpix must allege that (1) GOAT has discontinued use of its marks and (2) GOAT does not have intent to resume such use. Goatpix fails to properly allege such facts, particularly as to GOAT's intent. Indeed, Goatpix's only allegation about GOAT's intent is that "[u]pon information and belief," GOAT does not have an intent to resume use of its marks. *See* 9 TTABVUE 12, ¶¶ 52, 55. As Goatpix's conclusory allegations made "upon information and belief" cannot state an abandonment claim, this claim should be dismissed.

Second, Goatpix claims that one of GOAT's registrations should be cancelled because it was allegedly procured by fraud. Specifically, Goatpix alleges that GOAT's predecessor, GFL, committed fraud on the U.S. Patent and Trademark Office ("USPTO") by claiming that its mark was in use for all goods and services covered by its registration, which Goatpix claims was not the case. Goatpix makes its fraud allegations almost exclusively "upon information and belief," which is simply insufficient to meet the heightened pleading standard to state a fraud claim.

Indeed, Goatpix even tries to cite to deposition testimony in a separate lawsuit, despite not being

a party to the suit or even having access to the deposition transcript. *See id.* at 7-8, ¶ 29.

Because Goatpix does not even have firsthand knowledge of the allegations that it makes, Goatpix has no basis to bring its fraud claim. Thus, the counterclaim should be dismissed.

Finally, the Board should strike nearly all of Goatpix’s affirmative defenses. Goatpix’s defenses are either redundant and mirror Goatpix’s counterclaims (abandonment, lack of secondary meaning, and fraud), lack a scintilla of factual support (unclean hands), or not cognizable in a TTAB proceeding (a reservation of rights). Thus, the Board should strike these affirmative defenses.

II. STATEMENT OF FACTS

A. GOAT’S Trademark Rights And Registrations

For many years, GOAT has offered its wildly successful e-commerce platform GOAT, available on both a mobile app and website (www.goat.com). 1 TTABVUE 6. On July 24, 2015, GOAT applied to register the GOAT mark (Serial No. 86/703347), which later matured into U.S. Reg. No. 5,357,448 (“448 Registration”). 9 TTABVUE 10, ¶ 40. The ‘448 Registration covers “*Providing an online marketplace for buyers and sellers of collectible consumer goods namely, athletic and sporting footwear; database management services; providing a website featuring evaluative feedback in the form of ratings, reviews, recommendations and other consumer information regarding the value and prices of sellers’ goods, buyers’ and sellers’ performance, delivery, and transaction experience for commercial purposes; providing a searchable advertising guide featuring the goods and services of sellers; advertising and advertising services*” in Class 35. *Id.*, ¶ 39.

Since then, GOAT has continued to expand the scope of its trademark protections and registrations. GOAT acquired U.S. Reg. Nos. 3,506,834 (“834 Registration”) for the mark

GOAT; 4,103,419 (“419 Registration”) for the mark GOAT; and 5,066,855 (“855 Registration”) for the mark KID BY GOAT. *See id.* at 4-9. These registrations were previously owned by Goat Fashion Limited (“GFL”), a fashion company in the business of selling clothing through its website and various retailers in the U.S. and abroad. *Id.* at 4-6. Indeed, GFL used the marks GOAT and KID BY GOAT on its clothing items and online retail store since as early as 2004. *Id.* GFL filed a combined Sections 8 and 15 statement for the ‘834 Registration on November 12, 2013, and a combined Declaration of Use for Renewal on October 1, 2018. *Id.* at 4-5, ¶¶ 8-9. Similarly, GFL filed a Combined Declaration of Use and Incontestability for the ‘419 Registration on September 26, 2017. *Id.* at 6-7, ¶ 23.

In December 2019, GFL sued GOAT in the U.S. District Court for the Southern District of New York. *Id.* at 7, ¶ 25. In response, GOAT filed a Petition to Cancel GFL’s ‘419 Registration for fraud, asserting that GFL did not offer all the claimed services listed in the ‘419 Registration. *Id.* at 8, ¶ 30. GOAT later withdrew this petition, and on March 5, 2021, GFL filed a Section 7 Request deleting the services that GOAT previously asserted GFL did not offer. *Id.* at 8, ¶¶ 32-33. On November 29, 2021, GFL assigned the ‘834 Registration, the ‘419 Registration, and the ‘855 Registration to GOAT. *Id.* at 5, 8.

B. Goatpix’s Counterclaims And Affirmative Defenses

In May 2021, Goatpix applied to register the mark GOATPIX GALLERY in connection with “[a]rts gallery services, namely, retail store services featuring works of art, photographs, and pictures of sports figures” in Class 35. 9 TTABVUE 3, ¶ 1. GOAT opposed this application on July 6, 2022, citing a likelihood of confusion between the GOATPIX GALLERY mark and GOAT’s trademarks. *See* 1 TTABVUE 6-8.

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