

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

GULLIVER’S TAVERN, INC.,

Plaintiff,

v.

FRANK’S OF BROCKTON, INC.,

Defendant.

Civil Action No. 22-CV-10653

**REPLY IN SUPPORT OF PLAINTIFF’S
MOTION TO DISMISS COUNTERCLAIM**

Nothing in Frank’s of Brockton’s Opposition to Gulliver’s Tavern, Inc.’s Motion to Dismiss Counterclaim, Doc. No. 25, is sufficient to permit the alleged counterclaims to proceed. Gulliver’s Tavern, Inc.’s Motion to Dismiss Counterclaim, Doc. No. 21, should be allowed.

1.0 There is No Naked License

Contrary to the assertions of Frank’s, Gulliver’s did not abandon its mark by granting a naked license. The Complaint, Doc. No. 1 at ¶ 11, laid out the primary terms of the 1999 agreement, but nowhere is it suggested that these are the entirety of the terms.¹ It is improper for Frank’s to suggest otherwise in its motion, knowing full well (and having admitted in litigation) this was not the case. In actuality, and as admitted by Frank’s in prior litigation, Gulliver’s licensed the mark to Frank’s, and agents of Gulliver’s, Thomas Tsoumas and Jimmy DeRentis, “outlined from day one on the operation of the business”, made Frank’s “aware” of legal and industry changes, “suppl[ied]” Frank’s with entertainers, and instructed Frank’s in “[h]ow to hire the

¹ For example, the original license fee (\$10,000 per week) was actually several times the \$3,000/week pleaded in the Complaint, Doc. No. 1, but what was claimed in the Complaint was the current amount, following agreements by the parties to reduce that amount. Gulliver’s reserves the right to amend the complaint to recover the full contract amount.

dancers”.² Thus, per the *Boathouse Grp., Inc. v. TigerLogic Corp.* matter relied upon by Frank’s, Gulliver’s exercised the necessary actual control over the license to avoid abandonment. 777 F. Supp. 2d 243, 250 (D. Mass. 2011). As a result, the naked license claim should be dismissed.

2.0 Gulliver’s Did Not Fail to Police

Frank’s relegates to a footnote its erroneous argument that pleading failure to police upon “information and belief” is somehow sufficient. Frank’s makes no assertion that any of the alleged facts are peculiarly within the possession of Gulliver’s or set forth the factual information in the counterclaim, Doc No. 15, that makes the inference plausible. Links to Yelp and other webpages in the opposition, without any basis for judicial notice, are not a substitute for pleading facts. *See, e.g. Haley v. City of Boston*, 657 F.3d 39, 46 (1st Cir. 2011) (when evaluating Rule 12(b)(6) motion, court may not look beyond facts alleged in complaint, documents incorporated by reference, and facts susceptible to judicial notice).

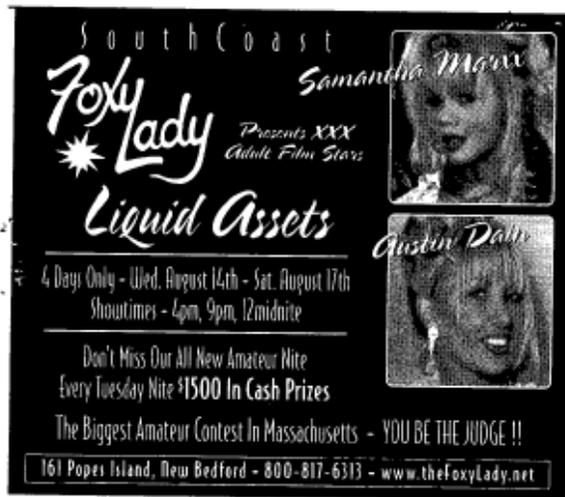
Frank’s of Brockton, Inc.’s Answer and Counterclaims, Doc. No. 15, rests solely on an apparent failure to sue. As noted in the Motion to Dismiss, Doc. No. 21, mere failure to sue is not sufficient, as it would “undermine the well-settled rule that a trademark owner’s failure to sue potential infringers does not constitute abandonment.” *Neo4j, Inc. v. Purethink, LLC*, 480 F. Supp. 3d 1071, 1078 (N.D. Cal. 2020)(citing *San Diego Comic Convention v. Dan Farr Prods.*, No. 14-CV-1865 AJB (JMA), 2017 U.S. Dist. LEXIS 155681, 2017 WL 4227000, at *12 (S.D. Cal. Sept.

² *See Exhibit A*, Transcript of Deposition of Frank Caswell, February 28, 2012, at 27:8-10 & 29:4-32:10 in *Erwin v. McDermott, et al.*, Case No. 1:11-cv-11328 (D. Mass.) (Doc. No. 60-4 therein). “[A] court may take judicial notice of its own records[.]” *Chiang v. MBNA*, No. 06-CV-12258-PBS, 2007 U.S. Dist. LEXIS 61787, at *6 (D. Mass. Aug. 22, 2007). Gulliver’s requests the Court take judicial notice of this document. “If a party requests a court to take judicial notice of such a fact and provides it with all of the necessary information, judicial notice must be taken, Fed. R. Evid. 201(c), and the rule is applicable even at the motion to dismiss stage. *In re Colonial Mortgage Bankers Copr.*, 324 F.3d 12, 20 (1st Cir. 2003) (noting that judicially noticed facts may be considered in deciding a motion to dismiss).” *Piper v. Talbots, Inc.*, 507 F. Supp. 3d 339, 343 (D. Mass. 2020). Of course, Mr. Caswell’s testimony in the cited transcript as to trademarks, licenses, and intellectual property rights are legal conclusions and should not be considered and are not being offered.

22, 2017). As the allegations are improper and wholly conclusory, the counterclaim must be dismissed.

3.0 There Was No Fraud on the PTO

Contrary to the repeated assertion of Frank's, there was no fraud on the PTO, and this allegation is disproven by a simple review of the trademark application itself. On August 22, 2002, Gulliver's filed its specimens:



SPECIMEN FOR CLASS 41



SPECIMEN FOR CLASS 42

Exhibit B, at p. 56.⁴ Neither of these specimens were for Frank's location in Brockton.

⁴ “[T]he Court may properly take judicial notice of [a trademark application] under Rule 201(b)(2), Fed. R. Evid. See *Rockland Exposition, Inc. v. All. of Auto. Serv. Providers of New Jersey*, 894 F. Supp. 2d 288, 301 & n.6 (S.D.N.Y. 2012) (taking judicial notice of trademark application).” *Kid Car NY, LLC v. Kidmoto Techs. LLC*, 518 F. Supp. 3d 740, 752 (S.D.N.Y. 2021). Gulliver's requests that the Court take such judicial notice of the exhibits cited in this paragraph. Notably, this is the very application referred to by Frank's in its counterclaim, Doc. No. 15, and it is otherwise part of the pleading under Fed. R. Civ. P. 10(c). The page citations for this exhibit are based on which page it is following the exhibit cover page.

The February 20, 2010, specimen included a full page featuring Gulliver's location in Providence:

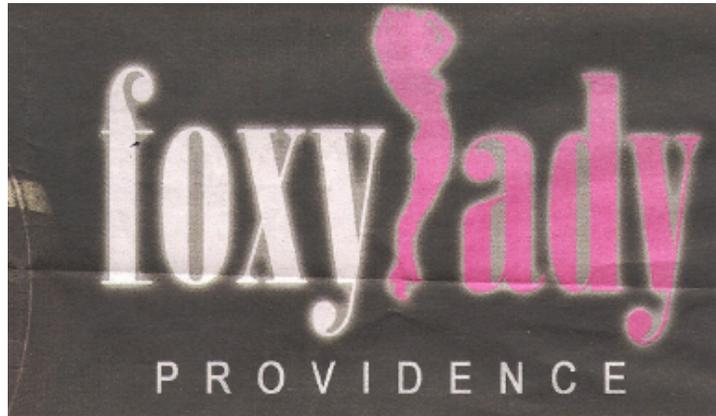


Exhibit B, at p. 26 (cropped). The first page of that submission shows that Frank's location in Brockton actually was using the stylized logo that had previously been used by Gulliver's—Frank's did not have its own logo. And, the third page of the January 30, 2014, specimen submission was for the menu at Gulliver's location in Providence. **Exhibit B**, at p. 18. And, to the extent that Gulliver's submitted uses of the mark by Frank's, it was immaterial and otherwise permissible, without rising to fraud, as, for the reasons set forth above, Gulliver's did, in fact, exercise control, as evidenced by Frank Caswell's own sworn testimony, and the use inured to Gulliver's benefit, with weekly payments by Frank's for such license.

Frank's also overstates the significance of the application stating that no one else had a right to use the mark by pointing to its own use. But, as noted in the motion, "[a] license is not a right". *Johnston v. Tampa Sports Auth.*, 530 F.3d 1320, 1326 n.7 (11th Cir. 2008). Mere permission to use the mark did not grant Frank's any part of the trademark rights. Simply put, the Court cannot simply look at the cherry-picked allegations, but rather to the entirety of the records to which the Court make take notice. These show that there was no fraud on the Patent and Trademark Office in the application and the mark cannot be canceled.

4.0 The Agreement is Valid and Enforceable

Frank's cannot invalidate the contract. It argues that because a naked license is improper, the contract, wherein Gulliver's permitted the use of the name and had Mr. Tsoumas provide

services directing how Frank's would operate while using that name, in exchange for weekly payments, that contract is somehow invalid. This is false.

First, there was no naked license, rendering the license agreement fully enforceable.

Second, even if the mark were invalid, it would not dispense with the rest of the agreement—that so long as it used the name, it would pay (and receive the directions and services of Mr. Tsoumas that Mr. Caswell testified were part of the agreement).

Third, there is no valid estoppel argument (which is not even pleaded)—Mr. Caswell testified that Mr. Tsoumas (at least as of 2012, so for at least 13 years at that point) “serves” as a consultant (in the present tense). See Exhibit A at 30:15-16. In fact, Caswell testified that Mr. Tsoumas “to this day...makes me aware of” legal and industry changes as part of the agreement. *Id.* at 29:10-12. This stands in opposition to the cases cited by Frank's as to failure to exercise supervision or not have communication over years. Thus, there is no basis to invalidate the agreement.

In light of the foregoing, the motion to dismiss, Doc. No. 21, should be granted and the counterclaims, Doc. No. 15, should be dismissed.

Dated: August 9, 2022

Respectfully Submitted,

/s/ Marc J. Randazza

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Civil Action No. 22-CV-10653

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing document was served on all parties this day by the Court's CM/ECF system.

Dated: August 11, 2022.

/s/ Marc J. Randazza

Marc J. Randazza

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

GULLIVER’S TAVERN, INC.,
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v.

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AFFIDAVIT OF JAY M. WOLMAN

I, Jay M. Wolman, an attorney duly admitted to practice law before the United States District Court for the District of Massachusetts, hereby affirm the following to be true under penalty of perjury:

1. I am over 18 years of age and have never been convicted of a crime involving fraud or dishonesty. I have first-hand knowledge of the facts set forth herein, and if called as a witness could and would testify competently thereto.

2. I am counsel of record for Plaintiff, Gulliver’s Tavern, Inc. (“Gulliver’s”) in the above-captioned matter.

3. I provide this affidavit in support of Plaintiff’s Reply in Support of Plaintiff’s Motion to Dismiss Counterclaim.

4. ~~Attached hereto as **Exhibit A** is a true and correct copy of excerpts of the Transcript of Deposition of Frank Caswell, February 28, 2012, at 27:8-10 & 29:4-32:10 as filed in *Erwin v. McDermott, et al.*, Case No. 1:11-cv-11328 (D. Mass.) (Doc. No. 60-4 therein).~~ **Exhibit omitted per court order**

5. Attached hereto as **Exhibit B** are true and correct copies of Gulliver’s trademark application, trademark registration and specimens on file with the United States Patent and Trademark Office, U.S. Registration Number: 2809938, as downloaded from the Trademark Status and Document Retrieval system on August 8, 2022.¹

¹ At https://tsdr.uspto.gov/#caseNumber=76442533&caseType=SERIAL_NO&searchType=statusSearch.