UNITED STATES DISTRICT COURT
DISTRICT OF NEW JERSEY

DAVID GORDON OPPENHEIMER, Plaintiff, - against - THE TRUSTEES OF THE STEVENS INSTIUTE OF TECHNOLOGY; STEVENS INSTITUTE OF TECHNOLOGY INTERNATIONAL, INC., RUSSELL ROGERS, and DOES 1-10, Defendants.	Case No.: 23-cv-553 (MCA-MAH) **NOTICE OF MOTION**

PLEASE TAKE NOTICE that on Monday, June 5, 2023 at 9:00 a.m. or as soon thereafter as counsel may be heard, plaintiff DAVID GORDON OPPENHEIMER (the "Plaintiff") will apply to the United States District Court for the District of New Jersey, Martin Luther King Building and United States Courthouse, 50 Walnut Street, Newark, New Jersey 07102 for an Order: (1) Dismissing counterclaimant/ defendant STEVENS INSTITUTE OF TECHNOLOGY INTERNATIONAL, INC.'s (the "Defendant") counterclaims for failure to state a claim upon which relief may be granted, pursuant to Fed. R. Civ. P. 12(b)(6), and (2) for such other and further relief as this Court may deem just and proper.

PLEASE TAKE FURTHER NOTICE that in support of this motion, Plaintiff will rely upon the accompanying Memorandum of Law.

PLEASE TAKE FURTHER NOTICE that at the time and place aforesaid, Plaintiff will request that the proposed Order submitted herewith be entered by the Court.

Dated: Tenafly, New Jersey
April 28, 2023

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/s/ Paul S. Haberman

By: _____

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UNITED STATES DISTRICT COURT
DISTRICT OF NEW JERSEY

DAVID GORDON OPPENHEIMER, Plaintiff, - against - THE TRUSTEES OF THE STEVENS INSTIUTE OF TECHNOLOGY; STEVENS INSTITUTE OF TECHNOLOGY INTERNATIONAL, INC., RUSSELL ROGERS, and DOES 1-10, Defendants.	Case No.: 23-cv-553 (MCA-MAH) **Motion Day**: Monday, June 5, 2023

PLAINTIFF DAVID GORDON OPPENHEIMER'S MEMORANDUM OF LAW IN SUPPORT OF HIS MOTION TO DISMISS COUNTERCLAIMS

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Plaintiff and Counterclaim Defendant David Gordon Oppenheimer ("Oppenheimer" or "Plaintiff") submits this Memorandum of Law in support of his Motion to Dismiss Counterclaimant/ Defendant Stevens Institute of Technology International, Inc.'s ("Stevens" or "Defendant") counterclaims for failure to state a claim upon which relief may be granted, pursuant to Fed. R. Civ. P. 12(b)(6).

I.
INTRODUCTION

Stevens filed counterclaims against Oppenheimer for both trademark infringement and unfair competition under the Lanham Act, New Jersey law and common law (the "Counterclaims"). The Counterclaims do not: (1) specify which, if any, trademarks Oppenheimer supposedly infringed, or (2) allege that Stevens owns a protectable trademark that Oppenheimer misused. Therefore, Stevens does not state even a single claim upon which relief could be granted. Oppenheimer asks the Court to dismiss the Counterclaims accordingly.

II.
FACTUAL AND PROCEDCURAL BACKGROUND

In March 2022, Oppenheimer discovered that the defendants in this case were infringing one of his original photographs by displaying it on various webpages and social media accounts they control. After Oppenheimer notified Stevens of its infringement, Stevens responded by: (1) refusing to take down Oppenheimer's photograph and (2) accusing Oppenheimer of trademark infringement. Oppenheimer later reminded Stevens that it was still infringing his copyright, and, as Stevens continued its infringement, he filed his complaint for copyright infringement and violations of the Digital Millennium Copyright Act on January 31st 2023 (Dkt. No. 1).

In response, Stevens filed counterclaims for: (1) trademark infringement under the Lanham

Act, (2) trademark infringement under New Jersey law, N.J.S.A. § 56:4-1, et seq., (3) common law trademark infringement, (4) unfair competition under the Lanham Act, (5) unfair competition under N.J.S.A. § 56:4-1, and (6) and common law unfair competition. Stevens' Counterclaims do not reference a federal trademark registration, and Stevens has not filed Form AO120, which is required when claiming infringement of a registered trademark. As Stevens continues to display Oppenheimer's copyrighted work as of the date of this filing, its Counterclaims are a transparent ploy to retaliate against Oppenheimer for protecting his copyright. As set forth below, the Counterclaims fall short of pleading the necessary elements of Stevens' alleged claims.

III.
LEGAL STANDARD

On a motion to dismiss pursuant to Federal Rule of Procedure 12(b)(6), "[c]ourts are required to accept all well-pleaded allegations in the complaint as true and to draw all reasonable inferences in favor of the non-moving party." *Phillips v. County of Allegheny*, 515 F.3d 224, 234 (3d Cir. 2008). However, "[f]actual allegations must be enough to raise a right to relief above the speculative level." *Bell. Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007). Courts are not required to credit bald assertions or legal conclusions draped in the guise of factual allegations. *See In re Burlington Coat Factory Sec. Litig.*, 114 F.3d 1410, 1429 (3d Cir. 1997). "A pleading that offers 'labels and conclusions' or a 'formulaic recitation of the elements of a cause of action will not do.'" *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (*quoting Twombly*, 550 U.S. at 555). Thus, a complaint cannot survive a motion to dismiss unless it "contain[s] sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Iqbal*, 556 U.S. at 678 (*quoting Twombly*, 550 U.S. at 570).

"A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged." *Id.* (*citing Twombly*, 550 U.S. at 556). The movant on a 12(b)(6) motion "bears the burden of showing that no claim has been presented." *Hedges v. U.S.*, 404 F.3d 744, 750 (3d Cir. 2005)(citation omitted). Stevens' Counterclaims do not set forth the necessary elements of any of the causes of action it pleads.

IV.
ARGUMENT

Stevens' Counterclaims focus on Oppenheimer's alleged infringement of its trademarks and corresponding unfair competition. The Counterclaims consist of three (3) pairs of corresponding claims: both (1) trademark infringement and (2) unfair competition under each of federal, New Jersey and common law. Stevens' allegations regarding Oppenheimer's supposedly infringing acts are impermissibly vague. The Counterclaims do not specify which trademarks Oppenheimer infringed. Similarly, Stevens does not allege what Oppenheimer supposedly did, what specific goods he sold or offered for sale, or, most importantly, how he violated Stevens' rights. These failures, combined with Stevens' failure to allege essential elements of any of its causes of action, doom the Counterclaims.

A. Stevens' First (Trademark Infringement) and Fourth (Unfair Competition) Claims for Violation of the Lanham Act Fail to State Claims.

Stevens alleges counterclaims for trademark infringement and unfair competition under the Lanham Act. Neither claim references a federal registered trademark, nor do they specify what trademark Oppenheimer supposedly violated. Further, neither claim even specifies what provision of the Lanham Act Oppenheimer allegedly transgressed.

To state a cause of action for both trademark infringement and unfair competition under the Lanham Act, the claimant must allege that "(1) the marks are valid and legally protectable; (2) [Stevens] own the marks; and (3) [Oppenheimer's] use of the mark to identify its goods and services is likely to create confusion concerning the origin of those goods or services." *Com. Nat. Ins. Servs., Inc. v. Com. Ins. Agency, Inc.*, 214 F.3d 432, 437 (3d Cir. 2000). *See also A&H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 210 (3rd Cir. 2000). The same standard applies to both trademark infringement and unfair competition claims under the Lanham Act. *Harlem Wizards Entertainment Basketball, Inc. v. NBA Properties, Inc.*, 952 F.Supp. 1084, 1091 (D.N.J. 1997); *Shirley May Int'l US Inc. v. Marina Grp. LLC*, 2022 U.S. Dist. LEXIS 224261, at *15 (D.N.J. Dec. 13, 2022).

Where, as here, the claimant alleges rights in unregistered marks, Stevens must demonstrate the marks' validity and ownership thereof in order to state a claim for trademark infringement or unfair competition under the Lanham Act. *MNI Mgmt., Inc. v. Wine King, LLC*, 542 F. Supp. 2d 389, 404-05 (D.N.J. 2008). Indeed, "[u]nregistered marks have no presumption of validity," but are only "valid and legally protectable where the mark is inherently distinctive or has secondary meaning." *Id.* at 404 (internal citations omitted); *Duffy v. Charles Schwab & Co., Inc.*, 97 F.Supp.2d, 592, 598 (D.N.J. 2000)(same); *Fisons Horticulture, Inc. v. Vigoro Indus., Inc.*, 30 F.3d 466, 472 (3d Cir. 1994)("validity depends on proof of secondary meaning, unless the unregistered mark is inherently distinctive"); *Buying For The Home, LLC v. Humble Abode, LLC*, 459 F.Supp. 2d 310, 318 (D.N.J. 2006)(same). A trademark "has secondary meaning where a [claimant] demonstrates consumer recognition of the mark as the source of a service or product." *Shirley May Int'l US Inc.*, 2022 U.S. Dist. LEXIS 224261, at *16.

Stevens' Lanham Act infringement claim alleges only that it owns "the University Marks" (Counterclaims, ¶ 20), and that Oppenheimer engaged in some vague "Infringing Acts" without any further specificity. (*Id.*, ¶ 21). Stevens' does not allege infringement of a trademark registered in the United States, failing to meet even the first prong of the standard set forth above.

The Counterclaims likewise fail to allege any facts that could even support an *inference* of secondary meaning for any of Stevens' marks, much less to assert concrete allegations of distinctiveness or secondary meaning. Instead, the "University Marks" are indistinguishably lumped together in Paragraphs 1 and 6 of the Counterclaims. Accordingly, Stevens sparse and vague allegations fail to meet the threshold requirement to establish ownership of a valid unregistered mark and fall far short of the standards to state a claim for federal trademark infringement or unfair competition. The Court should dismiss Stevens' First and Fourth counterclaims.

B. Stevens' Second (Trademark Infringement) and Fifth (Unfair Competition) Causes of Action Fail to State Claims Under New Jersey Law.

Stevens' claims for state trademark infringement (Count II) and state unfair competition (Count V) mirror the Lanham Act claims that respectively precede them. For the same reasons that the Lanham Act counterclaims fail to state causes of action, Stevens fails to adequately plead corresponding offenses under New Jersey law.

N.J.S.A. 56:4–1 is the New Jersey statutory equivalent of Section 43(a)(1) of the Lanham Act. *Harlem Wizards,* 952 F.Supp. at 1091. It is undisputed that "the elements for a claim for trademark infringement under the Lanham Act are the same as the elements for a claim of unfair competition under New Jersey statutory and common law." *J&J Snack Foods, Corp. v. Earthgrains Co.*, 230 F.Supp.2d 358, 374 (D.N.J. 2002). *See also Humble Abode*, 459 F.Supp. 2d

at 317-318 (same). Thus, the test to prove unfair competition under N.J.S.A. 56:4–1 is the same as under the Lanham Act, namely, a claimant must show that "(1) it owns a trademark that is valid and legally protectable, (2) that the defendant used the mark in commerce on or in connection with any goods or services or container for goods, and (3) that this "use" was in a manner likely to create confusion concerning the origin of the goods or services." *Humble Abode*, 459 F.Supp. 2d at 318.

Stevens' state law trademark infringement claim (Counterclaims, ¶¶ 25-30) merely repeats its Lanham Act infringement allegations. (*Id.*, ¶¶ 19-24). As Stevens does not allege infringement of a registered trademark, it must demonstrate that it owns a valid mark. *Id.* at 318. Stevens does not allege the validity of its marks because, as discussed above, it omits any allegation that any of its unspecified, unregistered common law trademarks are inherently distinctive or have acquired secondary meaning. Further, Stevens does not specify which trademark(s) Oppenheimer allegedly infringed, merely concluding that he has engaged in some vague "Infringing Acts" with some "University Marks." Therefore, Stevens fails to state a claim for trademark infringement under New Jersey law.

Turning to the state law unfair competition counterclaim, New Jersey federal courts generally follow federal standards when evaluating the sufficiency of state unfair competition claims. *G&W Labs., Inc. v. Laser Pharm., LLC,* 2018 U.S. Dist. LEXIS 102132, at *20 (D.N.J. June 19, 2018) ('the elements of unfair competition under N.J.S.A. 56:4-1 and New Jersey common law are the same as those required under the Lanham Act").

As demonstrated in Section IV-A, above, federal law requires a party claiming ownership of an unregistered mark to prove ownership and the validity of that mark by showing either

secondary meaning or distinctiveness. As Stevens has not alleged either distinctiveness or secondary meaning, the Counterclaims do not support even an inference of ownership of the necessary trademark, much less allege what trademark is at issue. Its vague reference to the "University Marks" is insufficient to put Oppenheimer on notice of Stevens' claim. Thus, Stevens fails to state a claim for unfair competition under N.J.S.A. 56:4–1.

Stevens' state law trademark infringement and unfair competition claims suffer the same deficiencies as its corresponding federal claims. Thus, the Court should dismiss the Second and Fifth Counterclaims.

C. Stevens' Third (Trademark Infringement) and Sixth (Unfair Competition) Claims for Violation of Common Law Fail to State Claims.

Stevens' repetitive claims for common law trademark infringement and unfair competition fail for the same reasons as their Lanham Act and New Jersey statutory claims.

"[B]ecause the elements for a claim for trademark infringement under the Lanham Act are the same as the elements for a claim of unfair competition under the Lanham Act and for claims of trademark infringement and unfair competition under New Jersey statutory and common law", the Court should apply the same analysis. *J&J Snack Foods, Corp. v. Earthgrains Co.*, 220 F.Supp.2d 358, 374 (D.N.J. 2002); *Juul Labs, Inc. v. Zoey Trading LLC*, 2022 U.S. Dist. LEXIS 59803 (D.N.J. Mar. 31, 2022)(same).

Stevens' Defendant's common law trademark infringement claim (Counterclaims, ¶¶ 31-36) merely restates the allegations in its Lanham Act and New Jersey infringement claims. Similarly, the common law unfair competition claim (*id.*, ¶¶ 47-51) repeats the language from the corresponding Lanham Act and state law causes of action. As Stevens has failed to allege ownership of a valid trademark, or to even specify which of the "University Marks" is at issue, it

has not stated claims for common law trademark infringement or unfair competition. The Court should also dismiss the Third and Sixth Counterclaims.

CONCLUSION

Stevens' retaliatory Counterclaims fail to state any causes of action. Stevens does not allege what unregistered trademark is at issue, nor does it set forth any facts that show inherent distinctiveness or secondary meaning. Thus, Stevens has not even alleged ownership of a valid trademark. Without this key element, its infringement and unfair competition claims fail to state causes of action under the Lanham Act, New Jersey law or common the law. The Court should dismiss the Counterclaims accordingly.

Dated: April 28, 2023

Respectfully submitted:

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/s/ Paul S. Haberman

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I, Paul S. Haberman, counsel for plaintiff DAVID GORDON OPPENHEIMER (the "Plaintiff") do hereby certify that on the 28th day of April 2023, a copy of:

1. Plaintiff's Notice of Motion to Dismiss Counterclaimant/Defendant STEVENS INSTITUTE OF TECHNOLOGY INTERNATIONAL, INC.'s Counterclaims pursuant to Fed. R. Civ. P. 12(b)(6);

2. Plaintiff's Memorandum in Support of the Motion to Dismiss Counterclaimant/ Defendant STEVENS INSTITUTE OF TECHNOLOGY INTERNATIONAL, INC.'s Counterclaims pursuant to Fed. R. Civ. P. 12(b)(6); and

3. Plaintiff's proposed Order granting his Motion to Dismiss Counterclaimant/ Defendant STEVENS INSTITUTE OF TECHNOLOGY INTERNATIONAL, INC.'s Counterclaims pursuant to Fed. R. Civ. P. 12(b)(6).

were served by use of the United States District Court for the District of New Jersey ECF to:

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Dated: Tenafly, New Jersey
April 28, 2023

/s/ Paul S. Haberman

PAUL S. HABERMAN

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DAVID GORDON OPPENHEIMER, Plaintiff, - against - THE TRUSTEES OF THE STEVENS INSTIUTE OF TECHNOLOGY; STEVENS INSTITUTE OF TECHNOLOGY INTERNATIONAL, INC., RUSSELL ROGERS, and DOES 1-10, Defendants.	Case No.: 23-cv-553 (MCA-MAH) **ORDER**

COX ARLEO, District Judge.

This matter comes before the Court on plaintiff DAVID GORDON OPPENHEIMER's ("Plaintiff") motion for an Order: (1) Dismissing counterclaimant/ defendant STEVENS INSTITUTE OF TECHNOLOGY INTERNATIONAL, INC.'s (the "Defendant") counterclaims pursuant to Fed. R. Civ. P. 12(b)(6), and (2) for such other and further relief as this Court may deem just and proper. ECF No. ___. The Court has considered the submissions made in support of and in opposition to the instant motion. ECF Nos. _____. Pursuant to Fed. R. Civ. P. 78, _____ oral argument was heard. For the reasons set forth in the accompanying Opinion,

IT IS on this ___ day of _____, 202__,

ORDERED that Plaintiff's motion for an Order: (1) Dismissing Defendant's counterclaims pursuant to Fed. R. Civ. P. 12(b)(6) is **GRANTED**, together with _____.

SO ORDERED.

_____
MADELINE COX ARLEO, U.S.D.J.