

The Nicolosi Trust
17835 Ventura Blvd. #207
Encino, CA 91316

BY EMAIL AND OVERNIGHT COURIER

November 5, 2019

Office of the City Clerk
Marilyn Sanders, City Clerk
414 E 12th Street
25th Floor
Kansas City, MO 64106
Phone: 816/513-6401
Fax: 816/513-3353
Email: Marilyn.Sanders@kcmo.org

**Re: *Trademark Infringement, Dilution, Unfair Competition and
Defamation — Cease and Desist Demand***

Dear Ms. Sanders and the Kansas City Representatives

We are writing on behalf of The Nicolosi Trust (the "Trust") in connection with your unauthorized and continued infringement and dilution of the Trust's intellectual property rights and publication of defamatory falsehoods regarding the nature of "Reparative Therapy," a groundbreaking, voluntary set of psychological treatment protocols first developed more than 25 years ago by the undersigned's late father.

In addition to its common law rights, the Trust owns U.S. Trademark Registration No. 5,512,452 (the "Registration"). The applicable certificate of registration, which remains in full force and effect, is attached as Exhibit A, serving as conclusive evidence of our ownership and exclusive right to use the Reparative Therapy® mark in U.S. commerce. As a service mark that has acquired distinctiveness based on decades of use by the Trust and associated practitioners, Reparative Therapy® is entitled to strong legal protection under the Lanham Act (15 U.S.C. § 1051 *et seq.*) against infringement, dilution and unfair or misleading competition

It has come to our attention that you are making unauthorized, false, misleading and unfair use of the Trust's registered trademark. Your most recent statements about "reparative therapy" conflates this term with so-called "conversion therapy," a generic phrase connoting psychotherapy treatment which may be based on a moral or religious belief that an individual "should change" or be "cured," or is evidence of some moral

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“sin,” or that treatment is based on the premise that homosexuality constitutes a mental disorder. Reparative Therapy® makes none of these claims, and in particular its treatment protocols have never asserted that same sex attraction or homosexuality is an emotional or mental health disease or disorder. Several Kansas City representatives also falsely state that Reparative Therapy® is somehow related to harm of clients. No such evidence exists about Reparative Therapy®. Your conflation of these very different terms and false statement of harm dangerously misleads the public into thinking Reparative Therapy® makes such prescriptions or has been shown to result in such harm. Further, banning or in any way interfering with Reparative Therapy in Kansas City will likely result in a federal lawsuit.

Under federal law, the Association’s unauthorized and false use of the “Reparative Therapy” mark violates the Lanham Act’s prohibition against any “false or misleading description of fact, or false or misleading representation of fact,” which is “likely to cause confusion” of “goods, services or commercial activities” in connection with sale and advertising of psychotherapy services. 15 U.S.C. §§ 1114(A), 1125(a). In addition, your conduct contravenes the Act’s related prohibition against “misrepresent[ing] the nature, characteristics, qualities, or geographic origin of...another person’s goods, services or commercial activities.” *Id.* § 1125(a)(1)(B). Moreover, under the Trademark Dilution Revision Act, your unauthorized and misleading use of Reparative Therapy® constitutes unlawful blurring of the Trust’s registered mark, as it is “is likely to cause dilution” by “impair[ing] the distinctiveness” of the “Reparative Therapy” brand. 15 U.S.C. § 1125(c); *Nabisco, Inc. v. PF Brands, Inc.*, 191 F.3d 208 (2d Cir. 1999). Such a dilution violation does not require any likelihood of confusion, nor is direct competition between the services involved needed. E.g., *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 633 F.3d 1158, 1172 (9th Cir. 2011) (dilution does not require that the challenged mark be “identical, nearly identical or substantially similar” to a registered trademark).

For at least the foregoing reasons, we believe that you are infringing, diluting and unfairly misrepresenting the Trust’s trademark rights. We hereby demand that the Association cease and desist in any further use of our mark in relation to distribution, advertising, promotion and sale of psychotherapy services. **We additionally demand that you promptly retract your false and misleading statements about Reparative Therapy®.**

This letter is sent without waiving any of the Trust’s rights or remedies, all of which are expressly reserved. Be advised to govern yourself accordingly. Kindly have your attorneys, if you are represented by outside counsel, contact the undersigned at their earliest possible convenience should you desire to resolve this dispute without escalation. We must insist upon the Association’s response no later than 20 days from today, March 31, 2019.

cc: Kansas City representatives
Glenn B. Manishin, Esq.

United States of America

United States Patent and Trademark Office

Reparative Therapy

Reg. No. 5,512,452

Registered Jul. 10, 2018

Int. Cl.: 44

Service Mark

Principal Register

The Nicolosi Trust (CALIFORNIA TRUST)
17835 Ventura Blvd.
Encino, CALIFORNIA 91316

Dr. Joseph J. Nicolosi Ph.D. (UNITED STATES INDIVIDUAL)
17835 Ventura Blvd.
Encino, CALIFORNIA 91316

CLASS 44: Mental health therapy services, namely, voluntary psychotherapy for individuals seeking to explore underlying psychodynamic factors which may have led to the development of unwanted same-sex attractions, in which treatment interventions are directed toward resolution of underlying gender-related traumas reported by the client using evidence-based treatment interventions

FIRST USE 8-1-1992; IN COMMERCE 8-1-1992

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STYLE, SIZE OR COLOR

No claim is made to the exclusive right to use the following apart from the mark as shown: "THERAPY"

SEC.2(F)

SER. NO. 87-699,798, FILED 11-28-2017



Andrew Kuren

Director of the United States
Patent and Trademark Office

REQUIREMENTS TO MAINTAIN YOUR FEDERAL TRADEMARK REGISTRATION

WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.

Requirements in the First Ten Years*

What and When to File:

- **First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.
- **Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between the 9th and 10th years after the registration date.* See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*

What and When to File:

- You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at <http://www.uspto.gov>.

November 5, 2019

Ms. Sanders,

Please immediately distribute this letter to Mayor Quinton Lucas and the other Kansas City Representatives who are voting on the "Reparative therapy"/"Conversion therapy" bill that was heard on November 6th, 2019.

Joseph Nicolosi Jr., Ph.D.