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

Proceeding	91211908
Party	Defendant OFFICIUM S.r.l.
Correspondence Address	MARK LEBOW LADAS & PARRY 1727 KING STREET , SUITE 105 ALEXANDRIA, VA 22314 UNITED STATES mlebow@ladas.com, avmail@ladas.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Mark Lebow
Filer's e-mail	mlebow@ladas.com, cdow@ladas.com
Signature	/ml/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

P Swiss, Inc.,

Opposer,

v.

OFFICIUM S.r.l.,

Applicant.

Opposition No. 91211908

APPLICANT’S MOTION TO DISMISS

Applicant, OFFICIUM S.r.l., hereby moves the Trademark Trial and Appeal Board to dismiss the Notice of Opposition of Opposer, P Swiss, Inc., based solely on fraud, for failure to state a claim upon which relief can be granted, pursuant to Fed. R. Civ. Pro. 12(b)(6) and Trademark Trial and Appeal Board Manual of Procedure § 503.

Opposer has failed to plead adequate standing make its claims and fails to plead sufficient facts to make out a claim for fraud, particularly in light of the heightened pleading requirements applicable to claims of fraud under Fed. R. Civ. P. 9(b).

BRIEF IN SUPPORT OF MOTION

I. *Background*

As background for the motion, Applicant states the following:

Applicant filed an application to register its mark PIPPO PEREZ (“Applicant’s Mark”) for various jewelry, watches and other goods in Class 14 on March 13, 2012. The application was filed as an extension of protection of its International Registration

No. 1115471 further to the Madrid Protocol and Section 66(a) of the Trademark Act. On February 5, 2013, the application was published for opposition. Opposer, following extension of time, filed a Notice of Opposition on August 5, 2013 opposing registration of Applicant's Mark based on fraud. Opposer's fraud claim can be summarized as follows:

Opposer purports to own Registration Nos. 2992552 for the mark "P" and Design that it claims to have acquired from the company Pippo Worldwide, LLC in February 2007 (see ¶ 6, Notice of Opp), although USPTO records show the mark had been assigned from Pippo Worldwide, LLC to an individual named Earl T. Shannon (see USPTO Trademark Assignment Abstract of Title database, Reel 3528, Frame 0983) and that the registration was cancelled almost a year ago on October 12, 2012 for non-use under Section 8 of the Trademark Act.

Opposer further alleges the existence of a legally binding agreement between itself and a non-party to this proceeding, a Mr. Giuseppe Perez, that "affect[ed] the superiority of rights to the designations PIPPO or PIPPO PEREZ in connection with watches, timepieces or similar in the United States" (see ¶ 8, Notice of Opp.) and that Mr. Perez agreed not to use the designations. Although Mr. Perez is a non-party, Opposer alleges "[u]pon information and belief" that Mr. Perez is "formally associated with Applicant and its business operations in the United States under the PIPPO PEREZ trademark (see ¶ 4, Notice of Opp.). Opposer attempts to support the allegation via a 1-page excerpt from Applicant's Italian website that indicates only that an Italy company

known as Pippo Perez was at some point founded by Mr. Perez (a/ka/ Pippo Perez), Mr. Maurizio March, and Mr. Michele Capalbo (see “Exhibit C”, Notice of Opposition).

Accordingly, (1) based on the aforementioned claimed ownership of a cancelled registration for the mark “P” and Design that was assigned to a non-party to this proceeding; (2) based on the claimed existence of a vaguely described agreement somehow affecting the superiority of rights in the mark PIPPO PEREZ between Opposer and another non-party to this proceeding who is “upon information and belief” somehow “formally associated” with Opposer, and (3) based solely on conjecture derived “upon information and belief” that Opposer somehow made a false declaration, which was a material misrepresentation, which is somehow imputed from the non-party to Applicant, and that somehow it must have been an intent to deceive the USPTO, Opposer claims fraud.

II. *Legal Standards*

To survive a motion to dismiss, Opposer must show that the Notice of Opposition has alleged such facts that, if proven, would establish: (1) standing, and (2) a valid ground for granting the relief sought. See, e.g., *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024 (CCPA 1982).

For purposes of this motion, well-pleaded allegations must be accepted as true and the Petition must be construed in the light most favorable to Opposer. See, e.g., *Advanced Cardiovascular Systems, Inc. v. SciMed Life Systems, Inc.*, 988 F.2d 1157 (Fed. Cir. 1993). The claimant must allege well-pleaded factual matter and more than

“[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements,” to state a claim plausible on its face. *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937, at 1949 (2009) (citing *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, at 555(2007)).

Moreover, as to the claim of fraud, it must be set forth with particularity; it must contain explicit circumstances constituting fraud, rather than implied expressions; and it cannot be based solely upon information and belief. See, Fed. R. Civ. P. 9(b); Trademark Rule 2.116(a). See also *King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801 (CCPA 1981) (“[t]he pleadings [must] contain explicit rather than implied expressions of the circumstances constituting fraud”); *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1479 (TTAB 2009) (allegations based solely upon information and belief fail to meet the Fed. R. Civ. P. 9(b) requirements as they are unsupported by any statement of facts providing the information upon which petitioner relies or the belief upon which the allegation is founded).

Thus, to satisfy Rule 9(b), a fraud claim, and in particular those allegations made upon “information and belief,” must be accompanied by a specific statement of facts upon which the belief is reasonably based. See *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 91 USPQ2d 1656, 1670 (Fed. Cir. 2009). The circumstances referred to in Federal Rule 9 “‘must be pleaded in detail’—‘[t]his means the who, what, when, where, and how’ of the alleged fraud.” *Id.* at 1667 (internal citations omitted). That is, the time, place and contents of the false representations, the facts misrepresented, and

identification of what has been obtained, shall be stated with specificity. See *W.R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670, 672 (Comm'r Pat. 1977); and *Saks, Inc. v. Saks & Co.*, 141 USPQ 307 (TTAB 1964). Additionally, the pleadings must allege sufficient underlying facts from which a tribunal may reasonably infer that a party acted with the requisite state of mind. *Exergen Corp.*, 91 USPQ2d at 1667.

III. *Opposer Has No Standing*

As discussed above, Opposer must prove adequate standing to withstand this motion. To establish standing, Opposer must prove that it is not a mere intermeddler, but rather that it has a real interest in the outcome of this proceeding and thus a reasonable basis for its belief that it would be damaged by registration of Applicant's Mark. See, *Richie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). However, Opposer's claims (and lack thereof) demonstrate that its involvement in this proceeding is merely that of an intermeddler.

Opposer does not rely upon any established rights in the mark PIPPO

PEREZ, nor any mark for that matter. Opposer merely claims ownership of a registration for the mark "P" that USPTO records show was not even owned by Opposer; which USPTO records show was cancelled for non-use almost a year ago and pertaining to a mark that Opposer does not even argue is confusingly similar to the mark PIPPO PEREZ that is the subject of this opposition. Instead, Opposer, asserting no valid claim to any mark but rather one at best owned by another and was abandoned, cancelled or

expired, relies on a claim of the existence of a vaguely described contract between itself and a non-party alleged somehow formally associated with Applicant, which does not prohibit Applicant's use. Opposer does not claim damage under these alleged facts, nor does it seem feasible. Opposer has no standing.

IV. Opposer Has Failed To Plead a Claim for Fraud

Even if the Board could somehow find standing, Applicant submits that Opposer has failed to adequately plead a claim for fraud. This is because even if the Board accepts as true all well-pleaded allegations and construes them in light most favorable to Opposer, there is still no fraud.

Opposer's entire fraud claim is centered around an alleged knowing, intentional and false declaration provided in support of the application that is alleged to contravene a legally binding agreement that is relevant to the dispute in this proceeding. However, the entirety of Opposer's allegations are threadbare and do not support any claim of fraud. Consider the following:

According to Opposer, there is a legally binding agreement between it and Mr. Giuseppe Perez, a third-party to this action, that supposedly affects the superiority of rights between those parties regarding certain marks including PIPPO PEREZ. But we are not told how those rights are affected; which rights are allegedly owned by whom; how such affectations impact Applicant, who is not alleged to be a party to any such agreement, including how its claim in a declaration could be false; what the duration of such rights may be, if any; etc.

The circumstances creating rights and obligation on the part of Applicant resulting from an alleged contract between Opposer and a third-party to this dispute are hardly pleaded in detail as required by the applicable rules. We know the “who” addressed by the alleged contract **and we know it does not concern Applicant**. But we do not know the what, when, where, and how that would provide any relevant details supporting any claimed rights.

Are we to presume from the Notice of Opposition that the alleged agreement is oral only and that there is no written contract? Where is the alleged agreement and what are the details? Why has Opposer not attached the agreement, presumably the instrument that gives rise to its rights in this matter, to the Notice of Opposition?

Even under common law, a defendant charged with a breach of contract is entitled to have the contract made part of the pleadings. For example, in common law a motion craving Oyer has historically been used to force a party to place documents sued upon, or a collateral document necessary to the plaintiff’s claim, into the record and be treated as though they were part of the pleadings. See, e.g., *P & T Enterprises v. Commonwealth Sur. Assocs.*, 39 Va. Cir. 286, 288 (Va. Cir. Ct. 1996); *Resk v. Roanoke County*, 73 Va. Cir. 272, 274 (Va. Cir. Ct. 2007). This gave the party craving Oyer the chance to file a plea in abatement if any difference existed between the formal pleading and the document which was made part of the record by Oyer. The motion provides a defendant the opportunity to submit to the Court the question of whether a plaintiff suing for breach of contract has stated a claim upon which relief may be granted. *Ragone v. Waldvogel*, 54

Va. Cir. 581, 582 (Va. Cir. Ct. 2001). However, here we are given no details concerning the alleged contract and are left to speculate about any rights and obligations, notwithstanding the fact that it is already alleged the Agreement is made by Opposer with a third party.

All of the critical allegations in the Notice of Opposition are made “upon information and belief”. Rather than setting forth the alleged facts and circumstances with any particularity, Opposer’s allegations are merely implied expressions and conclusory statements in contravention of the applicable rules and requirements.

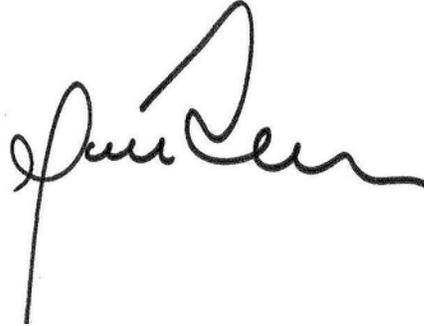
It is only upon “information and belief” that Mr. Perez is formally associated with Applicant and its business operations in the United States under the PIPPO PEREZ mark. As is clear, Opposer has simply taken an excerpt from Applicant’s Italian website showing that Giuseppe Perez was one of several founders of the Italian company. This allegation cannot be taken as true because it is based solely on information and belief. Opposer has no idea of the association between Applicant and Opposer. What gives rise to a “formal association” with Applicant – we are not told. It is only upon “information and belief” that there is a contract binding the parties in this matter; that Applicant “**or**” Mr. Perez knew about any legally binding agreement between the parties; or that the declaration is alleged to be false.

V. Conclusion

As demonstrated, the Notice of Opposition fails to allege proper standing and fails to allege a proper claim for fraud under the rules.

WHEREFORE, Applicant requests that the opposition be dismissed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Mark Lebow". The signature is written in a cursive style with a large initial "M" and a long, sweeping underline.

Mark Lebow
Attorney for Applicant
Ladas & Parry
1727 King Street, Suite 105
Alexandria, VA 22314
Tel: (703) 837-9600

September 16, 2013

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Certificate of Service

I hereby certify that the within APPLICANT'S MOTION TO DISMISS was served on this 16th day of September 2013 via U.S. mail, postage prepaid, to the below listed counsel of record for Opposer:

Casimir W. Cook II, Esq.
Roylance Abrams Berdo & Goodman LLP
1300 19th Street NW, Suite 600
Washington, DC 20036

/Christina Dow /

Christina Dow