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

Proceeding	91221497
Party	Defendant PlainLegal, Inc.
Correspondence Address	Nehal Madhani PLAINLEGAL, INC. 214 W. 29th Street 5TH FL NEW YORK, NY 10001 trademarks@plainlegal.com
Submission	Motion to Dismiss - Rule 12(b)
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Date	05/22/2015
Attachments	MOTION-TO-DISMISS Opp. No. 91221497.pdf(2191598 bytes)

ii) In Paragraph 20 of the Notice, Opposer further alleges that “on information and belief that Applicant made false statements with the intent to induce authorized agents of the United States Patent and Trademark Office to grant the registration of Applicant’s Mark.”

iii) Lastly, in Paragraph 22 of the Notice, Opposer alleges that “as an attorney registered with the New York State bar, Applicant’s founder attempted to use his legal knowledge and training to deceive both the United States Patent and Trademark Office and Opposer, whose technology and communications he had literally been ‘following’ since 2013.”

II. Legal Standard

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of Opposer’s well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to Opposer. *Id.* The tenet that a court must accept as true all of the allegations contained in a complaint is inapplicable to legal conclusions. Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice. Only a complaint that states a plausible claim for relief survives a motion to dismiss. *See Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1949-50 (2009), *citing Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 555-56 (2007). To survive a motion to dismiss, a complaint must contain “enough facts to state a claim to relief that is plausible on its face.” *Bell Atlantic Corp. v. Twombly*, 550 U.S. at 570. The pleading must be examined in its entirety, construing the allegations therein so as to do justice. Fed R. Civ. P. 8(e); see also *Int’l v. Otto Kern GmbH*, 83 USPQ2d 1861, 1862 (TTAB 2007). Whether a plaintiff can actually prove its allegations is a matter to be determined

not upon motion to dismiss, but rather at final hearing or upon summary judgement. *Advanced Cardiovascular Systems*, 26 USPQ2d at 1041.

To prevail on a claim of fraud, an Opposer must prove four elements: (1) that Applicant made a false representation to the USPTO; (2) that the false representation is material to the registrability of a mark; (3) that applicant had knowledge of the falsity of the representation; and (4) that Applicant made the representation with intent to deceive the USPTO. *In re Bose Corp.*, 91 USPQ2d 1938, 1940 (Fed. Cir. 2009). The Opposer “must allege the elements of fraud with particularity in accordance with Fed. R. Civ. P. 9(b), made applicable to Board proceedings by Trademark Rule 2.116(a), Under Rule 9(b), together with Fed. R. Civ. P. 11 and USPTO Rule 11.18, ‘the pleading [must] contain explicit rather than implied expression of the circumstances constituting fraud’”. *Asian and Western Classic B.V. v. Lynne Selkow*, 92 USPQ2d 1478, 1479 (TTAB 2009) citing *King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801, 803 (CCPA 1981). Moreover, “pleadings of fraud ‘on information and belief,’ when there is no allegation of ‘specific facts upon which the belief is reasonably based’ are insufficient.” *Asian and Western Classic B.V. v. Lynne Selkow*, 92 USPQ2d 1478, 1479 (TTAB 2009) citing *Exergen Corp. v. Wal-Mart Stores Inc.*, 91 USPQ2d 1656, 1667, n.4 (Fed. Cir. 2009).

III. Sufficiency of Pleadings

The pleadings of fraud on the USPTO in the Notice do not set forth sufficient underlying facts from which the Board could reasonably infer that Applicant made a false statement or representation to the USPTO.

A pleading of fraud on the USPTO must include an allegation of intent. *In re Bose*, 91 USPQ2d 1938, 1939-1940 (Fed. Cir. 2009). Moreover, “although Rule 9(b) allows that intent may be alleged generally, the pleadings must allege sufficient underlying facts from which a court may reasonably infer that a party acted with the requisite state of mind.” *Asian and Western Classic B.V. v. Lynne Selkow*, 92 USPQ2d 1478, 1479 (TTAB 2009) citing *Exergen Corp. v. Wal-Mart Stores Inc.*, 91 USPQ2d 1656, 1667, n.4 (Fed. Cir. 2009).

Even if the pleadings are accepted as true, the Notice fails to set forth sufficient underlying facts from which a court could reasonably infer that the Applicant made a false statement or representation to the USPTO with the requisite intent to deceive. As such, the pleadings cannot form the basis for a fraud claim.

In the Notice, Opposer alleges that Applicant’s founder Nehal Madhani, with the Twitter account @nehalm, indicated his explicit interest in Opposer’s PLAINSITE product and name by following Opposer’s PlainSite Twitter account, @PlainSite, on March 8, 2013. *See* Notice ¶7. The fact that Applicant may have followed Opposer’s PlainSite Twitter account, @PlainSite, along with a number of other Twitter accounts Applicant followed on or around that date, is not a basis for fraud and clearly does not demonstrate that Applicant made a false statement or misrepresentation to the USPTO with the requisite intent to deceive the USPTO.

Opposer then alleges that Mr. Madhani incorporated Applicant, PLAINLEGAL, INC., in the States of Delaware and New York as of April 11, 2013 and April 16, 2013, respectively. *See* Notice ¶8. Similarly, the fact that Applicant may have incorporated PLAINLEGAL, INC. does not demonstrate that Applicant made a false statement or misrepresentation made to the USPTO with the requisite intent to deceive the USPTO.

Opposer further alleges that Applicant filed its application for the mark PLAINLEGAL, Serial No. 86/180,979, on January 31, 2014, with the intention to use the mark in connection with “Facilitating the delivery of legal services of others via the Internet, namely, providing temporary use of online non-downloadable software for collecting information, preparing and generating documents and forms, filing documents and forms, and managing dates and deadlines” in International Class 42. *See* Notice ¶9. Although Applicant may have filed its application for the mark PLAINLEGAL, Opposer fails to provide any specific or general representation that in filing its application that Applicant included any false statement or made any misrepresentation to the USPTO with the requisite intent to deceive the USPTO during the prosecution of the application for the mark PLAINLEGAL.

Therefore, even when accepting the allegations in the Notice as true, Opposer only adequately alleges that 1) Applicant’s founder, Mr. Madhani, followed Opposer’s Twitter account in March of 2013, 2) Mr. Madhani incorporated Applicant, PLAINLEGAL, INC., in April of 2013, and 3) Applicant filed a trademark application for the mark PLAINLEGAL in connection with goods and services defined in International Class 42. These allegations fail to show that Applicant made a false statement or misrepresentation to the USPTO material to the registrability of the applied-for mark. Moreover, Opposer’s allegations in its Notice also fail to allege any underlying facts from which it may be reasonably inferred that Applicant made any false statement or misrepresentation to the USPTO with the requisite intent to deceive the USPTO. Accordingly, Opposer has clearly failed to properly plead with particularity a claim of fraud.

IV. Relief Requested

For the foregoing reasons, Applicant requests that this motion to dismiss pursuant 12(b)(6) be granted and the claim of fraud on the USPTO in the Notice be dismissed with prejudice. Granting of the instant motion will narrow the issues in this Opposition.

DATED this May 22, 2015

Respectfully submitted,



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CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM was served on May 22, 2015 by first-class mail, postage prepaid, upon correspondence for Opposer:

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