

Goodman

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: May 30, 2008

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Cancellation No. 92048699

Lester H. Schweiss

v.

Family Watchdog LLC

Before, Walters, Drost and Wellington, Administrative
Trademark Judges.

By the Board:

This case now comes up on respondent's motion, filed
February 19, 2008, to dismiss for failure to state a claim
under Fed.R.Civ.P. 12(b)(6).

In support of its motion, respondent argues that the
"Petition to Cancel fails to plead any statutory basis or
any facts relevant to a statutory ground negating
Registrant's right to continued ownership of Registration
No. 3157991 [and] further has pleaded no facts to
establish its standing."

In response, petitioner submits that he has adequately
pleaded standing and the grounds of priority and likelihood
of confusion and fraud in paragraphs 5-13 of the petition to
cancel.

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The purpose of a motion to dismiss is not to decide the merits of the challenged claims but to test the sufficiency of the allegations. *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993). Generally, to withstand a motion to dismiss for failure to state a claim, petitioner needs only to allege such facts as would, if proved, show (1) that petitioner has standing to petition for cancellation of the registered mark and (2) that a statutory ground for cancelling such registration exists. *Lipton Industries, Inc., v. Ralston Purina Co.*, 670 F.2d 1029, 213 USPQ 185 (CCPA 1982).

In this case, petitioner has sufficiently alleged his standing by his allegations in paragraphs 5-7 of the petition to cancel that he has adopted and is using the terms FAMILY WATCHDOG and FAMILY WATCHDOG.COM in connection with "products and services related to home computer, computer network and internet safety and security with an emphasis on keeping children and families safe while online."

With respect to petitioner's priority and likelihood of confusion claim, we note that respondent's arguments go solely to the merits of petitioner's claim of priority rather than to the sufficiency of the allegations, and such matters cannot be resolved on a motion to dismiss. We find

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petitioner's allegations in paragraphs 5-10 of the petition to cancel sufficiently allege a claim of priority and likelihood of confusion that if proved, would entitle petitioner to relief.

We do find, however, that petitioner's allegations of fraud in paragraphs 11 and 13 of the petition, which appear to be based on respondent's knowledge of the same or confusingly similar mark at the time of the filing of its application, fail to state a claim.

To assert a fraud claim based on fraudulent execution of the declaration, plaintiff "must allege particular facts which, if proven, would establish that: (1) there was in fact another use of the same or a confusingly similar mark at the time the oath was signed; (2) the other user had legal rights superior to applicant's; (3) applicant knew that the other user had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise; and that (4) applicant, in failing to disclose these facts to the Patent and Trademark Office, intended to procure a registration to which it was not entitled." *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1205 (TTAB 1997). A sufficient pleading of a fraud claim must consist of more than mere parroting of the requisite

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elements of the claim. "Averments of fraud must include an explicit expression of the factual circumstances alleged to constitute fraud." *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999).

In this case, petitioner has alleged only that at the time of filing its application respondent knew of petitioner's prior use of the terms FAMILY WATCHDOG and FAMILYWATCHDOG.COM which it failed to disclose to the Office and as a result of these "substantive omissions registrant fraudulently obtained its registration." Here, petitioner has failed to allege superior legal rights known to respondent at the time the declaration was signed. Inasmuch as there can be no fraud in failing to disclose to the Office third party uses unless they are believed to involve superior rights, petitioner's fraud claim is insufficient, and dismissal of the fraud claim under Fed.R.Civ.P. 12(b)(6) is appropriate.

However, the Board freely grants leave to amend a pleading if found, upon challenge under Fed.R.Civ.P. 12(b)(6), to be insufficient, particularly where the challenged pleading is the initial pleading.

In view thereof, petitioner is allowed until THIRTY DAYS from the mailing date of this order to file and serve an amended petition to cancel that properly alleges a claim of fraud, failing which, the present allegation of fraud

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shall be dismissed and the petition to cancel will go forward on the priority of use and likelihood of confusion ground.

Proceedings herein remain otherwise suspended.

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The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>