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

Proceeding	92061516
Party	Defendant WeDo, Inc.
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Submission	Motion to Dismiss - Rule 12(b)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

WeddingWire, Inc.

Cancellation No. 92061516

Petitioner,

Mark: WEDO

v.

Reg. No.: 4,338,563

WeDo, Inc.

Respondent.

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**RESPONDENT'S MOTION AND MEMORANDUM  
IN SUPPORT OF A MOTION TO DISMISS  
THE PETITION FOR CANCELLATION UNDER RULE 12(b)(6)**

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**INTRODUCTION**

WeDo, Inc. (“WeDo” or “Respondent”) respectfully requests dismissal with prejudice of all claims in WeddingWire, Inc.’s (“WeddingWire” or “Petitioner”) Petition for Cancellation of the WEDO mark because the Petition fails to state claims for relief under Federal Rule of Civil Procedure 12(b)(6).

WeddingWire seeks to cancel WeDo’s WEDO registration for a mobile application in class 9 and a photo sharing website in class 42 on the grounds of abandonment, fraud and an alleged failure to use the WEDO mark prior to the application filing date. All allegations in the Petition, however, rest on the false premise that WeDo’s beta testing of the WEDO products could not support registration and use in commerce of the WEDO mark. This is directly contrary to the guidance of the TMEP, on which WeDo relied when it filed its use-based application on September 27, 2012.

In some cases a specimen may consist of an excerpt from a website labeled as “beta.” This term is commonly used to describe a preliminary version of a product or service. Although some beta websites may not be accessible to consumers, others are. Thus, the use of this term in connection with an apparently functioning website shown in a specimen does not, by itself, necessarily mean that the relevant goods or services shown on the website are not in actual use in commerce or that the specimen is unacceptable.

TMEP 904.03(i)(D); *see also* TMEP 904.03(e) (“Specimens for software may also indicate that the software is a ‘beta’ version. This term is commonly used in the software field industry to identify a preliminary version of the product.”).

WeddingWire fails to plead a prima facie case of abandonment because three years have not passed since WeDo filed its use-based WEDO application in September 2012. The Petition also does not allege that WeDo lacks intent to resume use of the WEDO mark. The exhibits to the Petition, consisting of printouts from WeDo’s website from September 2012 and May 2015, show WeDo’s use of the WEDO mark during 2012 beta testing and WeDo’s continued efforts to develop its WEDO brand.

WeddingWire’s fails to state a claim for fraud because WeddingWire identifies no facts to support that WeDo had any intent to deceive the USPTO. WeddingWire alleges that WeDo “knew the WEDO mark had not yet been used in commerce with the applied for goods and services as its mobile application and photo sharing services were, at most in a beta testing stage.” Petition, ¶ 8. Thus, the only factual allegation relating to WeDo’s intent is that WeDo knew its products were only in the beta testing stage. WeddingWire does not identify any facts to support a claim that the WEDO products were not in a beta testing phase or that WeDo knew its beta testing was somehow insufficient to support a claim of use in commerce. WeddingWire also does not plead any facts that explain how WeDo acted with intent to deceive the UPSTO,

especially in light of specific guidance in the TMEP that websites and software products offered to consumers are in use in commerce during the product development, or beta testing phase.

Finally, WeddingWire also fails to state a claim that the WEDO registration should be cancelled as void ab initio. The only alleged fact that WeddingWire relies on to support this claim is the printout of the WeDo website from September 2012 that WeDo filed as its class 42 specimen of us. Petition, ¶4. The printout from the September 2012 website identifies the WEDO products as in beta testing and invites consumers to contact WeDo to become test users of the WEDO products. *Id.* The contents of WeDo's website in 2012 do not support a plausible claim of nonuse. WeddingWire alleges no additional facts to support its allegation the WEDO mark was not used in commerce at least as early as the September 27, 2012 filing date, as shown in the class 9 specimen for a mobile application filed with the USPTO on the same day.



Indeed, WeddingWire conveniently ignores the fact that the class 9 specimen shows the WEDO mark in use on a mobile application.

WeddingWire did not allege facts sufficient to support any plausible claims the WEDO registration is subject to cancellation. Thus, the Petition must be dismissed.

## ARGUMENT

The purpose of a Rule 12(b)(6) motion is to allow the Board “to eliminate actions that are fatally flawed in their legal premises and destined to fail, and thus to spare litigants the burdens of unnecessary pretrial and trial activity.” *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 1160 (Fed. Cir. 1993).

To survive a Rule 12(b)(6) motion, WeddingWire’s claims for cancellation must allege facts that, if proven, would establish that it is entitled to the relief sought, that is, that (1) WeDo has standing to maintain the claim and (2) a valid ground exists for cancelling the registration. *Doyle v. Al Johnson’s Swedish Restaurant & Butik, Inc.*, 101 USPQ2d 1780, 1782 (TTAB 2012) (citing *Young v. AGB Corp.*, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998)); Trademark Manual of Board Procedure (TBMP) § 503.02. The claims “must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 663 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). “Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice” and are not accepted as true. *Ashcroft*, 556 U.S. at 678 (2009) (citing *Twombly*, 550 U.S. at 555). The Board, in reviewing a Rule 12(b)(6) motion to dismiss, construes the claims in a light most favorable to the WeddingWire. *Consolidated Foods Corp. v. Big Red, Inc.*, 226 USPQ 829, 831 (TTAB 1985).

Even under the Board’s deferential standard, WeddingWire fails to state any plausible claims for cancellation. Its claims contain no facts that reasonably support the pleaded abandonment, fraud and void ab initio grounds, or any other grounds to cancel the WEDO registration. WeDo’s motion to dismiss should be granted.

**A. Petitioner’s abandonment claim fails because it alleges neither three years of non-use nor facts to support Respondent’s intent to abandon the WEDO registration.**

To adequately plead abandonment, WeddingWire “must recite facts which, if proven, would establish at least three consecutive years of nonuse, or alternatively, a period of nonuse less than three years coupled with proof of intent not to resume use.” *Dragon Bleu (SARL) v. VENM, LLC*, 112 U.S.P.Q.2d 1925, 1930 (T.T.A.B. 2014). For an abandonment claim to survive a motion to dismiss, WeddingWire “must plead ultimate facts pertaining to the alleged abandonment, thus providing fair notice to the defendant of plaintiff’s theory of abandonment.” *Id.* Nonuse of a mark prior to registration is only relevant if that nonuse occurs *after* the applicant makes a sworn statement of use. *Id.* Thus, the period which constitutes prima facia evidence of abandonment did not begin until WeDo filed its use-based application on September 27, 2012. Because three years did not pass between the filing date of WeDo’s application and the filing date of WeddingWire’s petition to cancel, WeddingWire fails to state a claim for prima facia abandonment. *See id.* at 1931 (granting motion to dismiss for failure to state a claim of abandonment for a period of nonuse of less than three years).

Without facts sufficient to support prima facia abandonment, WeddingWire must plead “ultimate facts that pertain to the alleged abandonment.” The same as the party failing to adequately plead abandonment in *Dragon Bleu*, WeddingWire similarly fails to plead any additional facts regarding WeDo’s alleged intent to abandon the WEDO mark. *See id.* (finding that website evidence that showed use on some but not all goods identified in a registration did not provide evidence of abandonment or of an intent not to commence use of the marks). In fact, WeddingWire’s own pleading, as well as the exhibits to its Petition, demonstrate that WeDo continues to own and operate active websites that display the WEDO mark for use in connection with the WEDO products identified in its registration. The alleged fact that the WEDO products

may remain in beta testing establishes neither abandonment nor the intent to abandon the WEDO mark. Thus, the Petition fails to include any plausible factual basis to support an abandonment claim or any intent to abandon the WEDO mark. *See id.* (granting motion to dismiss on analogous facts.)

**B. Petitioner didn't sufficiently plead its fraud claim or identify any supporting facts.**

To assert a viable fraud claim, WeddingWire must allege with particularity that (1) WeDo made a false representation to the USPTO, (2) WeDo had knowledge of the falsity of the representation, (2) the false representation was material to registration of WeDo's marks, and (4) WeDo made the representation with the intent to deceive the USPTO. *In re Bose Corp.*, 91 USPQ2d 1938, 1941-42 (Fed. Cir. 2009). A fraud claim must be accompanied by a specific statement of facts upon which the allegation is reasonably based. *E.&J. Gallo Winery v. Quala S.A.*, Opposition No. 91186763 (November 7, 2009) [not precedential] (citing *Exergen Corp. v. Wal-Mart Stores, Inc.*, 91 USPQ2d 1656, 1670 (Fed. Cir. 2009)).

The party asserting a fraud claim bears a heavy burden of proof. *In re Bose Corp.*, 91 USPQ2d at 1941 (citing *W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 153 USPQ 749, 750 (CCPA 1967)). Indeed, "the very nature of the charge of fraud requires that it be proven 'to the hilt' with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party." *Id.* at 1939 (quoting *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981)).

WeddingWire's Petition contains absolutely no factual allegations to support the claim that WeDo had knowledge of the falsity of the representation or any intent to deceive the USTPO. To the contrary, the facts alleged by WeddingWire show that WeDo promoted its WEDO products as in a beta testing phase and, consistent with the TMEP, use of a mark during

the beta testing phase can be use in commerce. TMEP 904.03(i)(D), 904.03(e). WeddingWire's allegations in paragraphs 4 through 6 summarize the content of WeDo's websites that describe the beta testing phase of development for the WEDO products and invite users to consumers to contact WeDo to test the WEDO products. Paragraph 8 of the Petition makes it clear that the beta testing is the only allegation supporting WeddingWire's fraud claim: "on September 27, 2012, [WeDo] knew that the WEDO mark had not yet been used in commerce with the applied for goods and services as its mobile application and photo sharing services were, at most, in beta testing stage."

It's inconceivable that these allegations could support a plausible claim of fraud because the TMEP specifically recognizes that software products and websites under development may very well be in use in commerce during the beta testing phase. *See* TMEP 904.03(i)(D), 904.03(e). For the Board to find otherwise would mean that an applicant cannot rely on the TMEP and allege use in commerce while its products are in a beta testing stage of development without potentially subjecting itself to a fraud claim by a party like WeddingWire that seeks to use a trademark registered to another company during that company's beta testing phase.

WeddingWire's petition contains no facts to support its "belief" that WeDo had any intent to deceive the USPTO when it filed its use-based application on September 27, 2012. WeddingWire does not allege facts to support a "belief" that WeDo was not engaged in beta testing WEDO products in September 2012, or that consumers did not use the WEDO products during this beta testing phase. WeddingWire also does not allege facts that support that WeDo intended to deceive the USPTO or that WeDo somehow knew its beta testing was insufficient to establish use in commerce. Pleading on "information and belief" is not sufficient support for a fraud claim when the alleged facts, i.e. beta testing disclosed in the specimen of use, does not

and cannot support an intentional act of fraud on the USPTO. WeddingWire's fraud pleading consists of speculation and conclusions, and falls far short of meeting the heavy burden for pleading a fraud claim.

WeDo did not engage in any fraud on the USPTO and WeddingWire fails to plead a cognizable fraud claim. *See, e.g., Kathleen Hiraga, supra; Novozymes Bioag, Inc. v. Cleary Chemicals, Inc.*, Opposition No. 91200105 (August 16, 2013) [not precedential]; *Bio-One, Inc. v. A.L.E.G., Inc.*, Cancellation No. 92052195 (March 1, 2012) [not precedential].

**C. Petitioner does not allege facts to support the invalidity of the WEDO application.**

Finally, WeddingWire also fails to state a claim that the WEDO registration should be cancelled as void ab initio because the WEDO mark was not in use on the filing date of the application. The only fact that WeddingWire alleges in support of its nonuse claim is that WeDo's class 42 website specimen filed in September 2012 identifies the WEDO products as in a beta testing phase. Petition, ¶4. WeddingWire's Petition includes no other allegations to support the pleaded conclusion that WeDo's mark was not in use in September 2012. Because WeddingWire identifies only the class 42 specimen in support of its nonuse claim, WeddingWire is merely challenging the sufficiency of the specimen. A challenge to a specimen is not a proper basis to cancel a registration. *See Marshall Field & Co. v. Mrs. Fields Cookies*, 11 U.S.P.Q.2d 1355, 1358-59 (T.T.A.B. 1989) (holding that the insufficiency of the specimens is not grounds to cancel a mark). As the Board recently explained, a claim for cancellation is "futile" if the claim only asserts the insufficiency of the specimens. *Joshua Domond v. 37.37, Inc.*, 113 U.S.P.S.2d 1164, 1265 n.2 (T.T.A.B. 2015).

A careful review of WeddingWire's Petition reveals that WeddingWire's only challenge is to the sufficiency of the specimen because the Petition contains no other facts supporting the

alleged nonuse of the WEDO mark on the September 2012 filing date. For example, Paragraph 7 of the Petition consists entirely of conclusions the WEDO mark is not used. The Petition contains no facts to support the conclusion the WEDO mark was not in use on the September 2012 filing date of the application. These conclusions are convenient for WeddingWire, who desires to use a mark that is already registered to WeDo. The U.S. Supreme Court, however, made it clear that “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice” and are not accepted as true. *Ashcroft*, 556 U.S. at 678 (2009) (citing *Twombly*, 550 U.S. at 555). WeddingWire’s Petition merely recites the elements of a nonuse claim, including the conclusion the WEDO mark is not in use.

Once again, WeddingWire must do more than plead its beliefs. It must allege facts that support a plausible claim for relief that WeDo’s marks were not in use in commerce at least as early as the filing date of WEDO’s application. These are insufficient allegations to support a claim the WEDO application was void ab initio.

**D. Granting Petitioner leave to amend would be futile.**

The dismissal of WeddingWire’s Petition should be with prejudice. TBMP § 503.03 (stating that the Board has discretion to deny a party the opportunity to amend the pleadings). As discussed above, WeddingWire cannot plead facts that would allow it to prevail on any of its claims. Under these circumstances, allowing WeddingWire to amend its pleading would be futile and should not be permitted. *See, e.g., American Hygienic Labs, Inc. v. Tiffany & Co.*, 228 USPQ 855, 859 (TTAB 1986) (denying leave to amend when doing so would serve no useful purpose).

**CONCLUSION**

For the reasons stated above, WeDo respectfully requests that WeddingWire's Petition for Cancellation be dismissed with prejudice.

**WeDo, Inc.**

By its Attorneys,

Date: June 26, 2015

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**CERTIFICATE OF SERVICE AND MAILING**

I hereby certify that a true and correct copy of the foregoing Motion to Dismiss is being served upon Petitioner's Attorney of Record by first-class mail, with a courtesy copy sent by e-mail:

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and that a copy of the same was filed electronically on the same date via ESTTA with the Trademark Trial and Appeal Board.

Date: June 26, 2015

/katrinaghull/  
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