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

Proceeding	92061516
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

WEDDINGWIRE, INC., Petitioner, v. WEDO, INC., Respondent.	Cancellation No.: 92061516 Registration No.: 4,338,563

PETITIONER'S OPPOSITION TO RESPONDENT'S MOTION TO DISMISS THE PETITION FOR CANCELLATION

Petitioner WeddingWire, Inc. ("Petitioner") hereby opposes Respondent WeDo, Inc.'s ("Respondent") motion to dismiss. Petitioner has filed a Petition for Cancellation of Respondent's WEDO mark, Registration No. 4,338,563. The Petition for Cancellation alleges three claims for relief: (1) abandonment, (2) fraud, and (3) invalidity.

Respondent moves to dismiss the Petition, arguing that, as to each claim for relief, Petitioner has not alleged sufficient facts. Respondent's motion ignores the well-pleaded factual basis of each of Petitioner's three claims for relief, and therefore should be denied. ***First***, Petitioner has adequately pleaded abandonment through allegations that Respondent has abandoned the WEDO mark because it has engaged in a substantial period of nonuse, and its actions evince the intent not to resume use. ***Second***, Petitioner has adequately pleaded fraud through allegations that Respondent knew that it was not using its mark in commerce, yet it filed a Declaration of Use with the USPTO in support of its claimed first use date, knowingly, and with the intent to deceive the USPTO. ***Third***, Petitioner has adequately pleaded invalidity

through allegations that, because Respondent filed a use-based application without ever having used its mark in commerce, the application is void ab initio for lack of a filing basis. For these reasons, discussed in detail below, the Board should deny Respondent's motion.

BACKGROUND

Petitioner filed its Petition for Cancellation ("the Petition") on May 18, 2015. The following facts are drawn from the Petition.

On September 27, 2012, Respondent filed Application Serial No. 85/739,875 for the mark WEDO, in connection with "'downloadable software in the nature of a mobile application for providing a social network, event planning and photo sharing' in International Class 9, and 'photo sharing services, namely, providing a website featuring technology enabling users to upload, view and download photos' in International Class 42." (Petition for Cancellation ("Pet.") ¶ 3.) In its Declaration of Use accompanying its Application, Respondent alleged a first use anywhere date of June 1, 2012, and a first use in commerce date of September 16, 2012. (*Id.*) In support of the claimed first use date, Respondent submitted a photocopy of a screenshot of its website, as it appeared at that time. (*Id.*) That screenshot stated that Respondent was "currently in private beta," and that "[i]f you are interesting using being [sic] a test user of WeDo, request an invite." (*Id.* ¶ 4.) On May 21, 2013, Respondent's mark was registered under Registration No. 4,338,563. (*Id.*)

Respondent's current webpage contains identical text – namely, that Respondent's website is in "private beta" and that individuals may contact Respondent with requests to become a "test user" - to that submitted in support of Application Serial No. 85/739,875. (*Id.* ¶ 5.) The specimen Respondent submitted in support of Application Serial No. 85/739,875 is identical to the way Respondent's webpage appeared on the date the Petition was filed. (*Id.*) Although

Respondent's webpage has tabs that purport to lead a viewer to "Legal" and "Investors," those tabs are inactive and simply re-open the same homepage. (*Id.*)

As of the date the Petition was filed, Respondent had another webpage as well, located at www.wedo.co. (*Id.* ¶ 6.) This webpage featured a screenshot depicting Respondent's software, and permitted viewers to click a button that reads "Let me know when it's ready!" (*Id.*) If a viewer clicked on that button, the viewer was told "We are currently in development." (*Id.*)

Petitioner is the nation's leading technology company serving the wedding, corporate, and social events industry. (*Id.* ¶ 1.) Petitioner founded its business in 2006, and launched its related website in 2007. (*Id.*) In connection with its online marketplace services, Petitioner intends to use the tagline "We Do." (*Id.* ¶ 2.) Petitioner believes that Respondent's registration of the WEDO mark will block any application that Petitioner files to register its "We Do" tagline as a trademark. (*Id.*) Because Petitioner believed it would be harmed by the continued, invalid registration of Respondent's WEDO mark, it filed its Petition for Cancellation.

The Petition sets forth three claims for relief. First, that Respondent has abandoned the WEDO mark. Second, that Respondent committed fraud in connection with Application Serial No. 85/739,875. Third, that Application Serial No. 85/739,875 is void ab initio because Respondent never used WEDO mark in commerce. (*Id.* ¶¶ 11-16.)

On June 26, 2015, Respondent filed a motion to dismiss the Petition, pursuant to Federal Rule of Civil Procedure 12(b)(6), attacking all three of Petitioner's claims for relief.

LEGAL STANDARD

The Board should not grant a motion to dismiss pursuant to Federal Rule of Civil Procedure 12(b)(6) unless the Petition is "fatally flawed in [its] legal premises and destined to fail . . . ." *Advanced Cardiovascular Sys., Inc. v. Scimed Life Sys., Inc.*, 988 F.2d 1157, 1160 (Fed. Cir. 1993). The complainant seeking relief must allege sufficient factual material to permit

the Board to ascertain the grounds upon which the claim rests, and to raise the right to relief above the speculative level. *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 & n.3 (2007). Under this standard, the pleading party must set forth "more than labels and conclusions, and a formulaic recitation of the elements of a cause of action will not do." *Twombly*, 550 U.S. at 555; *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) ("Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice.").

When evaluating a motion to dismiss, the Board must assume the truth of all the well-pleaded allegations in the petition. *Consol. Foods Corp. v. Big Red, Inc.*, 226 U.S.P.Q. 829, 831 (T.T.A.B. 1985). All claims must be construed in the light most favorable to the non-moving party. *Id.* Thus, to survive a motion to dismiss, all the non-moving party need do is "nudge[] their claims across the line from the conceivable to plausible." *Twombly*, 550 U.S. at 570. Petitioner exceeds this standard.

ARGUMENT

Respondent contends that Petitioner has not alleged sufficient facts in support of its three claims for relief. Respondent's arguments are based on a flawed reading of the Petition, and flat out ignore the Petition's well-pleaded factual allegations. The Board should deny Respondent's motion.

I. Petitioner has sufficiently alleged abandonment.

Under the Lanham Act, a mark is deemed abandoned "[w]hen its use has been discontinued with intent not to resume such use. . . . Nonuse for 3 consecutive years shall be prima facie evidence of abandonment." 15 U.S.C. § 1127. "Use" of a mark, in this context, "means the bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in the mark." *Id.* If the period of nonuse is less than three years, the party claiming abandonment must allege facts evidencing the intent of the mark owner not to use the mark. *Dragon Bleu (SARL) v. VENM, LLC*, 112 U.S.P.Q. 2d 1925, 1930 (T.T.A.B. 2014). "Intent not to resume may be inferred from circumstances." 15 U.S.C. § 1127. "A registrant's proclamations of his intent to resume or commence use in United States commerce during the

period of nonuse are awarded little, if any, weight." *Rivard v. Linville*, 133 F.3d 1446, 1449 (Fed. Cir. 1998). Thus, to adequately plead abandonment, a petitioner need only plead 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*, 112 U.S.P.Q. at 1930.

Petitioner has more than adequately alleged abandonment of the WEDO mark through allegations that Respondent has engaged in a period of nonuse less than three years, coupled with the intent not to resume use. The Petition alleges that, the "mark in Registration No. 4,338,563 was not in use in 2012 nor has it ever been in use." (Pet. ¶ 12.) Petitioner alleges specific facts in support of this allegation. The Petition alleges that Respondent was not using the WEDO mark as of the date Respondent filed Application Serial No. 85/739,875, stating that, in 2012 Respondent's website featuring the WEDO mark was in "private beta," and website viewers were invited to apply to become "test user[s]." (*Id.* ¶ 4.) The Petition further alleges that, at the time the Petition was filed, Respondent's website contained precisely the same language, evidencing that Respondent never commenced using the mark. (*Id.* ¶ 5.) Although Respondent's webpage has tabs that purport to lead a viewer to "Legal" and "Investors," those tabs are inactive and simply re-open the same homepage. (*Id.*) These allegations alone sufficiently state a claim for abandonment, but Petitioner's allegations go even beyond this. The Petition also alleges that Respondent maintains a second website, www.wedo.co. (*Id.* ¶ 6.) At the time the Petition was filed, this webpage featured a screenshot depicting Respondent's software, and permitted viewers to click a button that read "Let me know when it's ready!" (*Id.*) If a viewer clicked on that button, the viewer was told "We are currently in development." (*Id.*)

From the state of Respondent's websites, it is clear that Respondent was not using the WEDO mark in 2012, that it continues its period of nonuse at least to the date the Petition was filed, in 2015, and that it does not intend to resume use in the future. *See* 15 U.S.C. § 1127 ("Intent not to resume may be inferred from circumstances."). Viewing the Petition's well-

pleaded factual allegations in the light most favorable to Petitioner, as the Board must do, Petitioner has adequately alleged a period of nonuse, coupled with an intent not to resume use.

Respondent argues that the "alleged fact that the WEDO products may remain in beta testing establishes neither abandonment nor the intent to abandon the WEDO mark." (Mot. at 5-6.) Respondent relies for support upon section 904.03(i)(D) of the TMEP. Respondent, however, quotes only the portion that is moderately helpful to its position: "Thus, the use of [the term beta] 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 . . . ." (Mot. at 2 (quoting TMEP § 904.03(i)(D) (emphasis added).) Tellingly, Respondent omits the very next sentence, which states: "However, if examination of the specimen indicates that the beta version is not in actual use in commerce, the examining attorney *must* refuse registration under §§1 and 45 of the Trademark Act because applicant has not provided evidence of use of the applied-for mark in commerce." TMEP § 904.03(i)(D) (emphasis added).

The circumstances here involve far more than the mere fact that Respondent's products remain in beta. Petitioner has alleged that Respondent's products were in "private beta" at the time Respondent applied for the mark, and that Respondent's products remain in "private beta" to this day. (Pet. ¶¶ 4-5.) Petitioner has also alleged facts regarding the current status of Respondent's websites from which it is reasonable to infer that the "beta" version of Respondent's products are not – and have never been – in actual use in commerce. One need only look at Respondent's second website, www.wedo.co, to see that Respondent's mark has never been used in commerce. An individual viewing that website on the date the Petition was filed was told that Respondent's products are not "ready," and that Respondent was "currently in development." (*Id.* ¶ 6.) Products that are not ready, and that are currently only in development are not being used in commerce. Moreover, while Respondent's "products" are ostensibly "downloadable software in the nature of a mobile application for providing a social network, event planning and photo sharing," and "photo sharing services, namely, providing a website

featuring technology enabling users to upload, view and download photos," (*id* ¶ 3), Respondent's "beta" websites accomplish none of these functions, (*id.* ¶¶ 4-6.) In short, Respondent's reliance upon section 904.03(i)(D) of the TMEP is unavailing, and Petitioner has adequately alleged that Respondent abandoned its WEDO mark with no intent to resume use.

Accordingly, the Board should dismiss Respondent's motion to dismiss Petitioner's abandonment claim.

II. Petitioner has sufficiently alleged fraud.

A party may seek cancellation of a registered trademark on the ground that the "registration was obtained fraudulently." 15 U.S.C. § 1064(3). "Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application." *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 48 (Fed. Cir. 1986). Pursuant to Federal Rule of Civil Procedure 9(b), allegations of fraud must be pleaded with particularity. However, "[m]alice, intent, knowledge, and other conditions of a person's mind may be alleged generally." Fed. R. Civ. P. 9(b).

Petitioner has more than adequately alleged that Respondent fraudulently made a false statement to the USPTO in the Declaration of Use accompanying Application Serial No. 85/739,875. Specifically, Petitioner alleges that Respondent falsely stated that the WEDO mark was in use in commerce, with a first use date of September 16, 2012, when in fact the WEDO mark had not then – and indeed, has not since – been used in commerce. (Pet. ¶ 14.) The factual underpinnings of Petitioner's claim for fraud are as follows. The Petition alleges that, in Respondent's Declaration of Use, Respondent falsely stated that it began using the WEDO mark in commerce on September 16, 2012. (*Id.*¶ 3.) In fact, Respondent had never used the WEDO mark in commerce and Respondent's website at that time indicated that it was in "private beta" requiring viewers to request invitations to become "test user[s]." (*Id.* ¶ 4.) The Petition further alleges that Respondent knew when it submitted its signed Declaration of Use that the WEDO mark had not been used in commerce. (*Id.* ¶ 8.) Petitioner alleges that this misrepresentation

was material, and that Respondent made these false statements knowingly, and with the subjective intent to deceive the USPTO. (*Id.* ¶¶ 9-10.)

As the Board well knows, "use" of a mark "means the bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in the mark." 15 U.S.C. § 1127. Petitioner has sufficiently alleged facts demonstrating that Respondent did precisely what the Lanham Act excludes from the definition of use – Respondent filed a Declaration of Use when its true intention was simply to reserve its rights in the mark, a mark that had never actually been used in commerce. One need look no farther than Respondent's second website, www.wedo.co, to appreciate the scope of Respondent's fraud. Nearly three years after Respondent filed its false Declaration of Use, it was still telling potential consumers that its products are not "ready" and that they are "currently in development." (Pet. ¶ 6.) This cannot be use in commerce. Respondent was not using its mark in commerce in 2012, it was not using its mark in commerce as of the filing of the Petition in 2015, and its false statement to the contrary was a material misrepresentation, made knowingly and with the intent to deceive.

Respondent again relies on section 904.03(i)(D) of the TMEP, this time for the proposition that the mere fact that its products were in beta testing does not necessarily mean that its Declaration of Use was fraudulent. Once again, Respondent's argument ignores that Petitioner has alleged much more than the mere fact that Respondent's products were in beta testing at the time Respondent submitted its Declaration of Use. Fatal to Respondent's argument are Petitioner's allegations regarding the current state of Respondent's websites. Although nearly three years elapsed between the date Respondent filed its Declaration of Use, and the date the Petition was filed, as of the filing date Respondent's websites were still inactive, still in "private beta," and still contained no indication that Respondent's products are – ever have been or ever will be – used in commerce. These additional facts further bolster Petitioner's fraud allegations because they indicate that Respondent has never used, or intended to use, the WEDO mark in commerce.

Petitioner has alleged sufficient facts supporting its fraud claim with the specificity Rule 9(b) requires. Fed. R. Civ. Pro. 9 ("In alleging fraud or mistake, a party must state with particularity the circumstances constituting fraud or mistake. Malice, intent, knowledge, and other conditions of a person's mind may be alleged generally."). Accordingly, the Board should deny Respondent's motion to dismiss the fraud claim.

III. Petitioner has sufficiently alleged that Application Serial No. 85/739,875 was void ab initio.

Petitioner's third claim for relief alleges that Application Serial No. 85/739,875 was void ab initio for lack of a filing basis because it was filed on a Section 1(a) basis, based on actual use of the mark in commerce, when in fact Respondent had not – and never has since – used the WEDO mark in commerce. (Pet. ¶ 16.)

Petitioner has adequately alleged that Application Serial No. 85/739,875 was not being used in commerce on the date of filing. Petitioner has alleged that Respondent submitted a screenshot of its webpage in support of its first use in commerce date. (*Id.* ¶¶ 3-4.) As detailed above, Petitioner has also alleged that Respondent's products were not in use at that time – described as they were as being in "private beta" – a description that has not been altered in any way in the nearly three years that elapsed. (*Id.* ¶¶ 4-5.) At this stage of the proceedings, these allegations are all that is required.

Respondent's arguments to the contrary are unavailing. Respondent argues that the Petition merely concludes that the WEDO mark was not used in commerce, without alleging facts in support of this conclusion. (Mot. at 8-9.) This argument completely ignores the facts Petitioner has alleged, discussed in detail above, that demonstrate that Respondent's mark has never been used in commerce, not at the time Respondent filed Application Serial No. 85/739,875, nor at any other time.

Accordingly, the Board should deny Respondent's motion to dismiss Petitioner's invalidity claim.

IV. Alternatively, The Board should grant leave to amend.

As demonstrated above, the Petition sufficiently alleges all three claims for relief, and Respondent's motion should be denied in its entirety. However, if the Board grants any part of Respondent's motion, Petitioner hereby requests that leave to amend be granted. *See* TBMP § 503.03 (stating that, if the Board determines that a complaint fails to state a claim, that "the Board generally will allow the plaintiff an opportunity to file an amended pleading"). The Board should grant leave to amend except in the rare case "where justice does not require that leave to amend be given . . . ." *Id.*

CONCLUSION

For the foregoing reasons, Petitioner respectfully requests that the Board deny Respondent's motion to dismiss in its entirety.

Respectfully submitted,

Dated: July 16, 2015

By: _____

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PROOF OF SERVICE BY MAIL

I am employed with the law firm of Morrison & Foerster LLP, whose address is 425 Market Street, San Francisco, California, 94105; I am not a party to the within cause; I am over the age of eighteen years and I am readily familiar with Morrison & Foerster's practice for collection and processing of correspondence for mailing with the United States Postal Service and know that in the ordinary course of Morrison & Foerster's business practice the document described below will be deposited with the United States Postal Service on the same date that it is placed at Morrison & Foerster with postage thereon fully prepaid for collection and mailing.

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PETITIONER'S OPPOSITION TO RESPONDENT'S MOTION TO DISMISS THE PETITION FOR CANCELLATION

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I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed at San Francisco, California, this 16th day of July, 2015.

Grace Gabriel
(typed)

Grace Gabriel
(signature)

sf-3552110