

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

DUNN

Mailed: November 2, 2015

Cancellation No. 92061516

WeddingWire, Inc.

v.

WeDo, Inc.

By the Trademark Trial and Appeal Board:

This case comes up on Respondent's motion to dismiss the petition to cancel under Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief can be granted. The motion is contested.

Registration No. 4338563 issued May 21, 2013 to WeDo, Inc. from an application filed September 27, 2012 alleging use in commerce of the mark WEDO for "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."

WeddingWire, Inc. filed a petition to cancel the registration on the grounds of nonuse as of the filing date of the underlying application, abandonment, and fraud.

In lieu of filing an answer, Respondent moved to dismiss the petition for failure to state a claim.

In order to withstand a motion to dismiss, petitioner need only allege such facts which, if proved, would establish that petitioner is entitled to the relief sought; that is, (1) petitioner has standing to bring the proceeding, and (2) a valid statutory ground exists for cancelling the registration. *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007). Specifically, “a complaint 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, 129 S. Ct. 1937, 1949 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007).

The petition to cancel alleges (Par. 1-2) that Petitioner is a technology company serving the wedding, corporate, and social events industry, that Petitioner intends to use WE DO in its marketing materials for its online marketplace services, and that Respondent’s registration will block any application which Petitioner files for the WE DO trademark. This is sufficient to plead Petitioner’s standing. See *Nobelle.Com, LLC v. Quest Communications Int’l, Inc.*, 66 USPQ2d 1300, 1304 (TTAB 2003) (standing to assert abandonment requires only that plaintiff be in a position to have a right to use the mark in question).

The use in commerce requirement is met for trademarks when the mark “is placed in any manner on the goods” and “the goods are sold or transported in commerce”, and the use in commerce requirement is met for service marks when a mark is “used or displayed in the sale or advertising of services” and the services are “rendered in commerce.” Trademark Act Sec. 45. The petition to cancel alleges (Par. 3-6) that

Respondent's WEDO mark was not in use in commerce with either its software or its photo sharing services in 2012 when the application was filed inasmuch as Respondent's webpages currently show the software and services to be in the beta testing stage, and the webpages shows the software and services to be identical to what was submitted in 2012. This is sufficient to plead nonuse. *Aycock Engineering, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 90 USPQ2d 1301, 1305 (Fed. Cir. 2009) ("The registration of a mark that does not meet the use requirement is void ab initio.").¹

Fraud in procuring a trademark registration occurs when an applicant knowingly makes false, material representations of fact in connection with its application with the intent to deceive the USPTO. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009). In addition to the allegations of nonuse, the petition to cancel alleges (Par. 8-10) that Respondent signed its application alleging that the mark was in use in commerce with the listed goods and services while knowing that that the mark was not in use in commerce with the listed goods and services, that the false statement was material, and made knowingly and with the intent to deceive the USPTO. This is sufficient to plead fraud. *Daimlerchrysler Corporation and Chrysler, LLC v. American Motors Corporation*, 94 USPQ2D 1086, 1089 (TTAB 2010) ("where a pleading asserts that a known misrepresentation, on a

¹ USPTO will not reject a specimen merely because it indicates that the software or website is a beta version. See Trademark Manual of Examining Procedure § 904.03(e) and 904.03(i)(D) (October 2015) ("TMEP"). However, this does not mean that the presence of the term "beta" on a specimen changes the use requirement for the software or website, but merely acknowledges that in some instances a beta version is in use in commerce.

material matter, is made to procure a registration, the element of intent, indispensable to a fraud claim, has been sufficiently pled.”).²

A registered trademark is considered abandoned if its “use has been discontinued with intent not to resume such use.” Trademark Act Sec. 45. With respect to abandonment, the petition to cancel alleges (Par. 12) that Respondent’s mark was not in use in 2012 nor has it ever been in use, that Respondent has not used the mark in commerce for at least the last three consecutive years immediately preceding the filing date of the petition, and that Respondent has abandoned its mark due to nonuse with no intent to commence use. This is sufficient to plead abandonment. *See Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ.2d 1925, 1930 (TTAB 2014) (“a plaintiff 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.”).

Respondent’s motion to dismiss the petition to cancel for failure to state a claim is DENIED. Respondent is ordered to file its answer to the petition to cancel within THIRTY DAYS of the mailing date of this order.

Proceedings herein are resumed, and dates are reset below.

Deadline for Discovery Conference	12/30/2015
Discovery Opens	12/30/2015
Initial Disclosures Due	1/29/2016
Expert Disclosures Due	5/28/2016
Discovery Closes	6/27/2016
Plaintiff’s Pretrial Disclosures	8/11/2016
Plaintiff’s 30-day Trial Period Ends	9/25/2016
Defendant’s Pretrial Disclosures	10/10/2016

² Respondent cites no legal support, and the Board is aware of none, for the proposition that submitting a specimen of use which indicates that the software or website is a beta version precludes a fraud claim.

Defendant's 30-day Trial Period Ends	11/24/2016
Plaintiff's Rebuttal Disclosures	12/9/2016
Plaintiff's 15-day Rebuttal Period Ends	1/8/2017

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.