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

Proceeding no.	92083349
Party	Defendant Jetharam Nemaram Gehlot
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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**

FM World Spolka z Ograniczona
Odpowiedzialnoscia,

Petitioner,

v.

Jetharam Nemaram Gehlot,

Registrant.

Cancellation No. 92083349

U.S. Reg. No. 7,026,718

MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM

Registrant Jetharam Nemaram Gehlot, pursuant to Federal Rule of Civil Procedure 12(b)(6), respectfully submits this motion to dismiss Counts I-II, including both fraud claims under Count I, alleged by Petitioner FM World Spolka z Ograniczona Odpowiedzialnoscia. Petitioner's allegations do not meet the high pleading standards for either of the two fraud claims or either of the two "invalid" claims.

LEGAL STANDARD

1. Motion to Dismiss Standard

A motion to dismiss must be granted when a party fails to state a claim upon which relief can be granted. Fed. R. Civ. P. 12(b)(6); T.B.M.P. § 503. A pleading that offers "labels and conclusions" or "a formulaic recitation of the elements of a cause of action will not do." *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (quotations and citation omitted). The complaint must allege facts which, when taken as true, raise

more than a speculative right to relief. *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555 (2007). The Court is not required to accept “[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements.” *Iqbal*, 556 U.S. at 678. Only a complaint that states a plausible claim for relief will survive a motion to dismiss, and a plausible claim “asks for more than a sheer possibility that a defendant has acted unlawfully.” *Id.* at 678-79.

2. Fraud Standard

Allegations of fraud are held to a higher pleading standard under Federal Rule 9(b), which states that “a party must state with particularity the circumstances constituting fraud or mistake.” Fed. R. Civ. P. 9(b); Trademark Rule 2.116(a). “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).

“Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application” with the intent to deceive the USPTO. *In re Bose Corp.*, 580 F.3d 1240, 1244 (Fed. Cir. 2009). These are four separate elements: (i) there was a false representation to the USPTO; (ii) the false representation is material to the registrability of the mark; (iii) there was knowledge of the falsity of the representation; and (iv) the representation was made with an intent to deceive the USPTO. *Id.* at 1244-1245. Actual, subjective knowledge of declarant of the falsity of the representation is required, as well as subjective intent of the declarant to

deceive. Id.; see also *Nationstar Mortgage LLC v. Mujahid Ahmad*, 112 U.S.P.Q.2d 1361 (T.T.A.B. 2014).

ARGUMENT

I. PETITIONER FAILS TO STATE A CLAIM FOR “Count I; A. Fraudulent Allegation Of Use In Commerce”

Petitioner’s first fraud claim, based on Respondent's alleged failure to use the mark in commerce prior to the filing date of the statement of use, fails to state a claim for several reasons.

First, Petitioner fails to allege an intent to deceive the USPTO, a required element of fraud. Instead, Petitioner alleges only an “intent to procure a registration”, which is not the same as an intent to deceive. A knowingly false material representation of fact is not enough to allege or prove fraud; Petitioner must allege with particularity, and subsequently present sufficient evidence to establish, that Respondent made the knowing and false representation for the express purpose of deceiving the USPTO. The pleadings must contain sufficient allegations of facts from which the decision maker may reasonably infer that a party acted with the requisite state of mind. Having failed to even allege an intent to deceive, Petitioner obviously also fails to allege an intent to deceive with particularity as required for a fraud claim. This first fraud claim should be dismissed for at least this reason.

Second, the filing date of the statement of use is not material to the registration of the mark. A plaintiff alleging fraud based on nonuse must plead that

there was no use in commerce prior to the statement of use *or* prior to the deadline for filing the statement of use. *See Embarcadero Tech., Inc. v. Delphix Corp.*, 117 USPQ2d 1518, 1526 (TTAB 2016) (petitioner must plead that respondent did not use its mark with the goods in the registration within the time for filing its statement of use).

Respondent here filed its statement of use *prior to* the deadline for filing the statement of use. Where a claim of nonuse is asserted in an *inter partes* proceeding, “the Board also will consider evidence of use which occurred after the filing of the statement of use but within the original or extended period for filing the statement of use.” *Embarcadero Tech., Inc.*, 117 USPQ2d at 1524. Consequently, Petitioner's allegation that Respondent failed to use the mark by the *filing date* of the SOU is insufficient to support the fraud claims. This first fraud claim should be dismissed for at least this reason as well.

Third, Petitioner's fraud claim is expressly based in part on an allegedly false statement of date of first use. However, the stated date of first use, even if false, does not constitute fraud because the first use date is not material to the Office's decision to register the mark. *Kathleen Hiraga v. Sylvester J. Arena*, 90 USPQ2d 1102 (TTAB 2009) [precedential]; *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1926 (TTAB 2006); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 76 (TTAB 1983) (“The [Trademark] Examining Attorney gives no consideration to alleged dates of first use in determining whether conflicting marks should be published for opposition.”).

Fourth, Petitioner's allegations in the first fraud claim that the alleged false statements were made with the declarant's knowledge of falsity is conclusory and not supported by sufficient facts to infer the Mr. Gehlot acted with the intent to deceive the USPTO. This first fraud claim should be dismissed for at least this reason.

Fifth and finally, the allegations in the first fraud claim regarding Respondent's failure to use the mark "in connection with majority of the goods listed in the Statement of Use" are unspecific allegations in they do not specify which goods were allegedly not in use. Thus, the allegations are insufficient under Fed. R. Civ. P. 9(b) to support a fraud claim and should be dismissed for this reason as well.

II. PETITIONER FAILS TO STATE A CLAIM FOR "Count I: Fraud, B. Fraudulent Statement As To The Meaning Of YUTIKA"

Petitioner's second fraud claim is based on an allegedly false statement that the word YUTIKA has no meaning in a foreign language. Petitioner asserts, "On information and belief, the word YUTIKA is a Hindu girl name and the meaning of YUTIKA is 'flower.' See Exhibit A hereto." Petitioner is not asserting that the *definition* of YUTIKA is "flower" in any foreign language. Rather, Petitioner is asserting that YUTIKA is a personal name and that that personal name has the meaning flower.

The second fraud claims entirely lacks any allegations regarding either knowledge of the alleged falsity and or intent to deceive the USPTO, and thus

entirely fails to allege two of the four elements of fraud, much less with particularity as required to plead fraud. *Intellimedia Sports, Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1205 (TTAB 1997). 43 USPQ2d at 1208 (finding that where petitioner failed to plead the third fraud factor, petitioner “a fortiori ... failed to sufficiently plead the fourth element of the claim”). This second fraud claim should be dismissed for at least these failures to allege the basis elements of fraud.

Regarding materiality, Petitioner states in a conclusory manner that the allegation that YUTIKA is a personal name and that that personal name has the meaning flower “was material”, without any allegations regarding how or why that allegation, if true, could possibly be material to registrability. Thus, having failed to allege materiality with particularity, the allegations are insufficient under Fed. R. Civ. P. 9(b) to support the fraud claims.

Moreover, even assuming that it is true that YUTIKA is a personal name and that that personal name has the meaning “flower” as alleged, this would not be material to registrability because personal names are not subject to the doctrine of foreign equivalents and there is no other reason except via the doctrine of foreign equivalents why it might be material. *Ricardo Media Inc. v. Inventive Software LLC*, 2019 USPQ2d 311355 (T.T.A.B. 2019) (“generally consumers would be unlikely to ‘stop and translate’ personal name marks, because doing so would point to not only a different person or people (whether real or fictional), but also to a different source, and to the mark losing any ‘instant recognizability’”). Since Petitioner does not allege any meaning except via the meaning of a personal name, the allegation

that YUTIKA is a personal name and that that personal name has the meaning flower, even if taken as true, cannot be material because it would not be subject to the doctrine of foreign equivalents.

Finally, the statement that YUTIKA does not have any meaning in a foreign language is not false, even under the allegations pleaded by the Petitioner, because the Petitioner does not allege that YUTIKA translates to “flower” but only that YUTIKA is a personal name with the alleged meaning of flower. Thus, Petitioner’s allegation is that YUTIKA means flower in the same sense that the personal name Philip means a lover of horses, which is to say, not in any real definitional sense that could possibly be relevant to doctrine of foreign equivalents.

III. PETITIONER FAILS TO STATE A CLAIM FOR “Count II: Invalid Application – No Use In Commerce In Connection With Majority Of The Goods”

Petitioner alleges “invalid application” and that the “718 Registration is therefore void and invalid” due to alleged non-use “in connection with the majority of the goods”, without ever specifying what goods are alleged to not have been used.

Nonuse on some, but not all, of the identified goods as of the deadline for the underlying applications’ statements of use is not grounds for voiding a registration in its entirety, as would result from a successful fraud claim. *See Grand Canyon West Ranch LLC v. Hualapai Tribe*, 78 USPQ2d 1696, 1697-98 (TTAB 2006). Rather, nonuse of the involved mark on some of the identified goods in the involved

underlying applications can result in only a partial judgment and deletion of the goods on which the mark was not used. *Id.*

In alleging an “Invalid Application” and that the “718 Registration is therefore void and invalid”, Petitioner is alleging a claim and is seeking a remedy which cannot be had even assuming that a “majority” of the goods were not used. The claim should be dismissed for at least this reason.

Separately, Petitioner does not state what specific goods from the recitation of goods are alleged to have not been used and therefore violates the “fair notice” requirement for pleading in all *inter partes* cases before the Board. *See, e.g., Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1349 (TTAB 2017) (likelihood of confusion claim based on claimant’s use of two marks conjointly must be pleaded clearly enough to provide fair notice of the claim to the defendant); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007) (elements of each claim should be stated concisely and directly, and include enough detail to give the defendant fair notice).

IV. PETITIONER FAILS TO STATE A CLAIM FOR “Count III: Invalid Application – No Meaning In A Foreign Language Provided”

This count alleges that the application and registration are “invalid” based on an allegedly false statement made by the Registrant regarding the meaning of the term YUTIKA. This count is not a fraud claim or a mere descriptiveness claim or a likelihood of confusion claim or a claim based in any way on any alleged non-use.

This count cites no authority or theory by which the application and/or registration might be “invalid” based on the allegedly false statement even assuming that is was false. This count does not state any cognizable claim under the Trademark Act. It should be dismissed for failure to state a claim.

This claim should also be dismissed because the statement to the USPTO was not false even under the allegation by Petitioner that YUTIKA is a personal name and that that personal name has the meaning flower, which is not an allegation YUTIKA has a definition of flower in any foreign language.

Dated: December 12, 2023

Respectfully submitted,

/Jeff Goehring/

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Attorney for Petitioner

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CERTIFICATE OF SERVICE

The foregoing Motion was served on counsel of record listed below on this 12th day of December 2023.

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