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

Proceeding	91229272
Party	Defendant Dentsply Sirona Inc.
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Attachments	Dentsplyreplymemorandum.pdf(323066 bytes)

Instead, Roth merely contends that “RT” is confusingly similar to its own registered mark, “ROTH®.” That, however, does not show that the designation “RT” actually *is* a term of art or of significance in the field. As reflected in not only the authorities cited by Dentsply (and ignored in Roth’s responding papers) but also Roth’s own authorities, this is insufficient to state a claim of falsity – let alone knowing falsity – of Dentsply’s representation.

Second, Roth’s opposition does not address Dentsply’s express acknowledgement on its products and its website that “ROTH®” is a registered mark owned by Opposer, along with an express disclaimer of any endorsement. Even if the designation “RT” had been a term of art or of significance in the field, thus – which it is not – Roth cannot plausibly plead an intent to deceive in light of this express acknowledgement and disclaimer to the world at large.

II. ARGUMENT

1. Opposer Has Not Adequately Pleaded Falsity and Knowledge of Falsity

Roth contends that Dentsply knowingly made a false representation to the PTO that the designation “RT” has no significance and is not a term of art in the relevant trade or industry. Roth contends that this was a knowing false representation in light of its alleged similarity to its own registered mark, ROTH®, which Roth alleges is likely to cause confusion. *See Opp’n* at 7. But even assuming similarity or potential for confusion, “RT” is not “ROTH.” Whatever Roth may contend regarding the significance or import of “ROTH,” that does not make Dentsply’s statement false, let alone knowingly false. It does not show that RT itself – not ROTH – actually does have significance and/or is a term of art in the industry.

Neither party would likely dispute that Roth’s predecessor, Dr. Ronald Roth, pioneered a set of prescription values for orthodontic brackets that is widely used in the orthodontic industry. Indeed, in the related cancellation proceeding, Dentsply has asserted, among other things, that the

name “Roth” applies to a series of clinical values for orthodontic brackets in the public domain, and is generic. In any event, had Dentsply represented to the PTO that “Roth” is not a term of art or of significance in the field, Opposer might well have alleged falsity. That, however, is not what Dentsply is alleged to have represented to the PTO. The representation, instead, was that “RT” – not “Roth” – is not a term of art or of significance in the industry. That statement has not been plausibly alleged to be false. Thus, it cannot plausibly be alleged to have been made with knowledge of falsity. It cannot support a claim of fraud.

In its opening memorandum, Dentsply cited, *inter alia*, King Automotive, Inc. v. Speedy Muffler King, Inc., 667 F.2d 1008 (U.S. Ct. Cust. Pat. App. 1981) and ZAO Odessky Konjatschnyi Zawod v. SIA “Baltmark Invest.” 2013 WL 594677 (E.D. Va. Nov. 6, 2013) for the proposition that Roth’s opposition failed to adequately plead facts in support of its fraud claim. See Dentsply Mem. at 7-8. In its response, Roth does not address these authorities and thus concedes the point. See Roth Mem. passim.

Roth asserts that “RT” is confusingly similar to and is intended to signify the Roth name. But, to echo the U.S. Court of Customs and Patent Appeals, “RT” is not the same as **ROTH**; it is “a different mark.” King Automotive, 667 F.2d at 1011. Whether, as Roth contends, “RT” is confusingly similar to “ROTH” may well be a question for determination on the merits. But at this stage, it is at least disputed. As such, Dentsply could not have *known* that its representation (that “RT” was neither a term of art nor of significance in the industry) was untrue when it was made. See King Automotive, 667 F.2d at 1011 & n.4 (affirming dismissal of fraud claim premised on denial of awareness of prior use of mark, “SPEEDY MUFFLER KING,” where prior use was of “different mark, “MUFFLER KING”); see also ZAO Odessky, 2013 WL 5945677 (granting motion to dismiss fraud claim involving registered mark “SHUSTOFF,”

despite failure to reference allegedly prior mark of “SHUSTOV”). In failing to address these authorities, Roth concedes their validity and applicability.

Simply put, Roth cannot parlay a disputed contention of similarity into a prior knowledge of falsity. On the merits, the Board may ultimately determine that “RT” is a term of art or of significance in light of Opposer’s mark **ROTH®**. Or it may conclude otherwise. But however the Board ultimately decides that question, neither scenario would support a claim that Dentsply’s statement was made at the time with knowing falsity.¹

Roth’s own citations in its response undermine its arguments. While failing to address King Automotive and ZAO Odessky, Roth cites Caymus Vineyards v. Caymus Medical, Inc., 2013 WL 6665451 (T.T.A.B. July 12, 2013); DaimlerChrysler Corp. v. American Motors Corp., 94 U.S.P.Q. 2d 1086 (T.T.A.B. 2010) and Wolverine Outdoors, Inc. v. Marker Volkl (Int’l) GMBH, 2010 WL 9597362 (T.T.A.B. June 21, 2010). In Caymus, however, the question was whether the name “CAYMUS” itself had any significance, not whether a different mark – however confusingly similar – had any significance. It thus does not support Roth’s contention.

Similarly, DaimlerChrysler did not involve claims premised on statements regarding a different mark. Instead, it involved registrant’s statement that it had previously used the “AMC” mark in commerce in connection with automobiles where it had allegedly never done so.

¹ In its opposition, Roth argues that Dentsply is suggesting that proof is required at the pleading stage. See Roth Opp’n at 4 n.1. Roth misunderstands Dentsply’s assertion. At trial on the merits, a fraud claim would indeed require proof by “clear and convincing evidence.” *E.g. In Re Bose Corp.*, 580 F.3d 1240, 1243 (Fed. Cir. 2009); see Dentsply Mem. at 4-5. At the pleading stage, however, a fraud claim imposes a “heightened pleading standard,” including “explicit rather than implied expression of the circumstances constituting fraud,” under a standard in which the declarant had *subjective* knowledge of the falsity of the statement. Allegations that an applicant “should have known” that a representation was false – *i.e.*, an objective standard such as one that might apply to a negligence claim – does not satisfy the requirement of a “willful intent to deceive.” In Re Bose Corp., 580 F.3d at 1245-46.

DaimlerChrysler, 94 U.S.P.Q. 2d at *2. And in Wolverine, the Board *dismissed* the fraud claim.

Wolverine, 2010 WL 9597362 at *3.

2. Opposer Cannot Plausibly Allege Intent to Deceive in Light of Applicant's Explicit Acknowledgement and Disclaimer

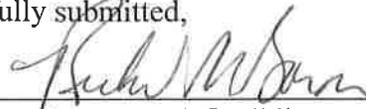
Roth's response in opposition also fails to address the effect of Dentsply's express, public acknowledgement that "ROTH®" is Opposer's registered mark, and its express, public disclaimer of any endorsement. In light of this express acknowledgement and disclaimer, Roth cannot plausibly plead an intent to deceive on the part of Dentsply – even if the designation "RT" had been a term of art or of significance. Tellingly, Roth's initial Notice of Opposition misleadingly truncated Dentsply's statement to *omit* the acknowledgement and disclaimer, reflecting its awareness that this negates the possibility of scienter. Only after Dentsply called Roth out on the truncation did Roth supply the complete language in its Amended Notice.

As Dentsply noted in its opening memorandum, Roth cannot plausibly allege an intent to deceive in light of Dentsply's public acknowledgment of the "ROTH" mark and disclaimer of endorsement. In its response to the motion, Roth does not address this argument either, *see Roth Opp'n passim*, and thus concedes it.

III. CONCLUSION

WHEREFORE, for the foregoing reasons, Applicant Dentsply respectfully requests that Opposer's claim of fraud on the PTO be dismissed.

Respectfully submitted,

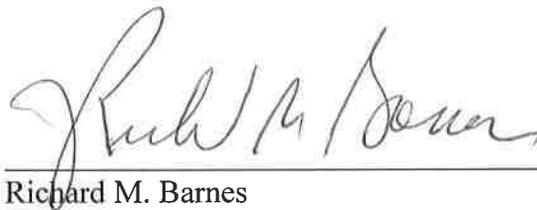


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CERTIFICATE OF SERVICE

I hereby certify that on this 28th day of November, 2016, a true and complete copy of the Reply Memorandum Supporting Applicant's Partial Motion to Dismiss has been served via First Class Mail, postage prepaid to:

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