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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.
Correspondence Address	JUSTIN H MCCARTHY II DENTSPLY LEGAL DEPARTMENT 221 W PHILADELPHIA ST YORK, PA 17401-2991 UNITED STATES trademarks@dentsply.com
Submission	Motion to Dismiss - Rule 12(b)
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Signature	/Matthew Kohel/
Date	09/12/2016
Attachments	Partial Motion to Dismiss for Failure to State a Claim.pdf(5892 bytes) Memorandum of Law in Support of Partial Motion to Dismiss.pdf(26284 bytes) Exhibit A to Partial Motion to Dismiss.pdf(400665 bytes)

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

Roth Licensing, LLC, a California limited liability company,	:	
	:	Opposition No.: 91229272
Opposer,	:	
v.	:	
	:	
Dentsply Sirona Inc., a Delaware corporation,	:	
	:	
Applicant.	:	
	:	

In re Application of Dentsply Sirona Inc.:

Serial No.:	86/742,723
Filed:	August 31, 2015
Trademark:	RT Rx
Filing Basis:	1(a)
Published:	July 12, 2016

**APPLICANT’S PARTIAL MOTION TO
DISMISS FOR FAILURE TO STATE A CLAIM**

Pursuant to Federal Rules of Civil Procedure 9(b) and 12(b)(6), Applicant Dentsply Sirona Inc., through its undersigned counsel, respectfully moves the Trademark Trial and Appeal Board to dismiss Count Two for “Fraud on the PTO” in Opposer Roth Licensing, LLC’s Notice of Opposition for failure to state a claim upon which relief can be granted.

Dated: September 12, 2016

Respectfully submitted,

GOODELL, DeVRIES, LEECH & DANN, LLP

By: /s/ Matthew D. Kohel
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CERTIFICATE OF SERVICE

I, Matthew D. Kohel, hereby certify that a true and complete copy of Applicant's Partial Motion to Dismiss for Failure to State a Claim has been served on Sheppard, Mullin, Richter & Hampton LLP, counsel for Opposer, Roth Licensing, LLC, by mailing said copy on September 12, 2016, via First Class Mail, postage prepaid to:

Brian M. Daucher
Gazal Pour-Moezzi
Sheppard Mullin Richter Hampton, LLP
650 Town Center Drive, 4th Floor
Costa Mesa, CA 92626

I further certify that an Entry of Appearance naming myself as counsel for Applicant was filed on September 12, 2016, and mailed as stated above to counsel for Opposer.

 /s/ Matthew D. Kohel
Matthew D. Kohel

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**MEMORANDUM OF LAW SUPPORTING APPLICANT’S
PARTIAL MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM**

INTRODUCTION

Opposer fails to state a clam for fraud on the PTO because it does not satisfy the heightened pleading standard of Federal Rule of Civil Procedure 9(b). The controlling authority is clear that a fraud claim must be supported by factual allegations that explicitly set forth the circumstances of the fraud, and specifically, an applicant’s subjective intent to deceive. Opposer does not meet that requirement because its allegations lack the requisite particularized factual support, are made solely “on information and belief,” and the claim is wrongfully pled because it is based on “Opposer’s belief” about the truthfulness of Applicant’s statements to the PTO. As a result, Opposer does not allege 1) facts that could establish by clear and convincing evidence that

Applicant deliberately intended to defraud the PTO or 2) sufficient underlying facts from which the Board could reasonably infer that Applicant acted with deceptive intent. Because Opposer's allegations fall far short of Rule 9(b)'s pleading standard, its fraud claim should be dismissed.

RELEVANT FACTS AND ALLEGATIONS

On August 1, 2016, Roth Licensing, LLC ("Opposer") filed a Notice of Opposition (the "Notice") in opposition to Dentsply Sirona Inc.'s ("Applicant") application for registration of the "RT Rx" mark. Count Two in the Notice is a claim of fraud on the PTO.

Opposer's fraud claim is based on two statements made by Applicant. First, Opposer partially quotes a disclaimer from Applicant's website. Opposer's truncated quotation states, "Our RT Rx has values that are equivalent to the Roth® prescription values." Notice at ¶ 10. In full, Applicant's disclaimer states,

Our RT Rx has values that are equivalent to the Roth® prescription values.
No endorsement is implied. Roth® is a registered trademark of [Opposer].¹

"[O]n information and belief," Opposer alleges that the truncated language from the disclaimer is intended to draw an association between the "RT Rx" mark and the "ROTH" mark. *Id.*

Second, Opposer relies on a statement that Applicant made to the PTO in May 2016 regarding the significance of "RT." *Id.* at ¶ 13. Relying on the partial quote of Applicant's disclaimer, "Opposer believes" that Applicant's statement that RT has no significance in the field of orthodontics was false and misleading.² *Id.*

¹ A complete copy of the disclaimer as it appears on one of Applicant's web pages is attached as Exhibit A. *See Anderson v. Kimberly-Clark Corp.*, 570 Fed.Appx. 927, 932 (Fed. Cir. 2014) ("In evaluating a Rule 12(b)(6) motion, a court may rely on documents outside the pleadings if they are integral to the plaintiff's claims and their authenticity is not disputed.").

² Applicant denies Opposer's allegation that its statement to the PTO about the significance of RT was false and misleading.

APPLICABLE LEGAL STANDARDS

To survive a motion to dismiss, “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, 678 (2009) (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). To meet this standard, a plaintiff must provide “more than labels and conclusions, and a formulaic recitation of a cause of action’s elements will not do.” *Twombly*, 550 U.S. at 555. Specifically, a plaintiff must plead “factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.” *Id.* Importantly, a court “is not bound to accept as true a legal conclusion couched as a factual allegation.” *Iqbal*, 556 U.S. at 678.

Fraud in procuring a trademark registration “occurs when an applicant for registration . . . knowingly makes false, material representations of fact in connection with an application to register.” *Media Online Inc. v. El Clasificado, Inc.*, 88 U.S.P.Q.2d 1285, at *4 (T.T.A.B. 2008). To constitute fraud, the “deception must be willful.” *In re Bose Corp.*, 580 F.3d 1240, 1243, 91 U.S.P.Q.2d 1938 (Fed. Cir. 2009). *See Meineke Discount Muffler v. Jaynes*, 999 F.2d 120 126 (5th Cir. 1993) (“To succeed on a claim of fraudulent registration, the challenging party must prove by clear and convincing evidence that the applicant made false statements with the intent to deceive [the PTO].”). While intent can be inferred from indirect and circumstantial evidence, “such evidence must still be clear and convincing, and inferences drawn from lesser evidence cannot satisfy the deceptive intent requirement.” *In re Bose Corp.*, 580 F.3d at 1245.

The Board follows Fed. R. Civ. P. 9(b), which imposes a heightened pleading standard for fraud claims. *Asian and Western Classics B.V. v. Selkow*, 92 U.S.P.Q.2d 1478, at * 1 (T.T.A.B. 2009). Under Rule 9(b), together with Fed. R. Civ. P. 11 and USPTO Rule 11.18, “the pleadings [must] contain explicit rather than implied expression of the circumstances constituting

fraud.” *Id.* (quoting *King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 1009-10, 212 U.S.P.Q. 801 (C.C.P.A. 1981)).

A fraud claim “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.” *In re Bose Corp.*, 580 F.3d at 1243 (quotation omitted). For that reason, pleadings of fraud made “on information and belief,” that lack “specific facts upon which the belief is reasonably based” are insufficient. *Asian and Western Classics B.V.*, 92 U.S.P.Q.2d 1478, at * 1. And, allegations that an applicant “should have known” that their representation to the PTO was false does not satisfy a fraud claim’s required element of a “willful intent to deceive.” *In re Bose Corp.*, 580 F.3d at 1245-46.

As shown herein, Opposer fails to plead fraud with the requisite particularity.

ARGUMENT

Opposer fails to state a fraud claim because it has not pled particular facts sufficient to establish that Applicant knowingly made a false statement to deceive the PTO. Its claim is based on Applicant’s May 18, 2016 statement to the PTO about the significance of “RT.” Notice at ¶ 13. However, Opposer does not allege facts that could establish by clear and convincing evidence that Applicant knew that its representation was fraudulent. Opposer also does not set forth facts showing how Applicant intended to defraud the PTO with its statement about “RT.” Indeed, Opposer does not even allege that Applicant made its representation about the significance of “RT” with deceptive intent.

Instead, Opposer concludes Paragraph 13 of the Notice with the vague and non-specific allegation that “Opposer believes and alleges that, in the context of the above facts, this response to the PTO was false and misleading.” *Id.* Opposer does not explicitly allege the factual

circumstances of the purported fraud; and Opposer's subjective belief about the veracity of Applicant's statement is irrelevant. *In re Bose Corp.*, 580 F.3d at 1245 (fraud "occurs when an **applicant** knowingly makes false material representations") (emphasis added). Consequently, Opposer does not "point to [clear and convincing] evidence to support an inference of deceptive intent" by Applicant. *In re Bose Corp.*, 580 F.3d at 1246. Because Opposer does not properly plead the essential element of intent, its fraud claim is fundamentally flawed and should be dismissed.

Moreover, Opposer's disingenuous reliance on an incomplete quotation from Applicant's disclaimer does not establish intent. *See* Notice at ¶¶ 10, 23-24. That is because Opposer alleges solely "on information and belief" that the "RT Rx" mark is intended to draw an association with the "ROTH" mark (*id.* at ¶ 10), without providing "a statement of facts upon which [Opposer's] belief is founded." *Asian and Western Classics B.V.*, 92 U.S.P.Q.2d 1478, at * 1. *See Exergen Corp. v. Wal-Mart Stores Inc.*, 575 F.3d 1312, 1330, 91 U.S.P.Q.2d, 1656, 1670 n.7 (Fed. Cir. 2009) ("[P]leadings on information and belief [under Rule 9(b)] require an allegation that the necessary information lies within the defendant's control, and . . . such allegations must also be accompanied by a statement of the facts upon which the allegations are based."). Without a supporting statement of facts, Opposer cannot connect the misleading truncation of Applicant's disclaimer to Applicant's statement to the PTO about the significance of "RT." Therefore, Opposer's failure to provide a supporting statement of facts is fatal to its claim.

Also, the Notice fails to state a claim because paragraphs 22 through 27 are merely a restatement of the deficient allegations from paragraphs 10 and 13, and a terse recitation of the elements of a fraud cause of action. In paragraphs 22 through 27, Opposer does not set forth any supporting facts suggesting Applicant's knowledge or deceptive intent. In paragraph 22,

Opposer simply asserts that Applicant made “material representations of fact . . . by representing to the PTO that the term ‘RT’ has no significance in the field of orthodontics or as applied to the goods in the Application.” Notice at ¶ 22. Opposer does not characterize this statement as a misrepresentation, but only as a “representation.” Opposer offers no facts that could establish by clear and convincing evidence that Applicant made this statement knowing that it was fraudulent.³ Therefore, a court could not reasonably infer from this conclusory allegation that Applicant intended to defraud the PTO.

In paragraph 23, Opposer alleges that Applicant “knew or should have known” that the term “RT” was intended to draw an association to the ROTH mark and Dr. Roth. Notice at ¶ 23. The Federal Circuit has expressly held that a plaintiff does not state the intent element of a fraud claim by alleging that a defendant “should have known” that its statement was false. *In re Bose*, 580 F.3d at 1244 (“By equating ‘should have known’ of the falsity with a subjective intent, the Board erroneously lowered the fraud standard to a simple negligence standard.”).

Although Opposer alleges that Applicant “knew” about a purported association between “RT” and “ROTH” and Dr. Roth, Opposer does not state particular facts which, if proven, would establish that by clear and convincing evidence. *See Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 U.S.P.Q.2d 1203, at *4 (T.T.A.B. 1997) (“a sufficient pleading of the third element of a fraud claim must consist of more than a merely conclusory allegation that the defendant ‘knew’ about a third party’s superior rights in the mark”). Opposer’s only evidence is a misleading truncation of a disclaimer on Applicant’s website. However, it is not plausible that Applicant would use a disclaimer to draw an association between “RT Rx” and “ROTH” because the

³ A similar allegation appears in paragraph 13 of the Notice. Even if incorporated by reference via paragraph 21 of the Notice, the allegation from paragraph 13 does not save Opposer’s fraud claim because, as discussed above, it is wrongly based on Opposer’s subjective belief that the statement was misleading.

purpose of a disclaimer is precisely the opposite. *See Iqbal*, 556 U.S. at 686 (“Rule 9 merely excuses a party from pleading [state of mind] under an elevated pleading standard. It does not give him license to evade the less rigid – though still operative – strictures of Rule 8.”).

Applicant’s disclaimer expressly states “No endorsement is implied,” and it identifies Opposer as the owner of the “ROTH” mark. It is therefore implausible that Applicant would fraudulently seek to create an association between the “RT Rx” and the “ROTH” marks through its disclaimer.

Additionally, the allegation in paragraph 23 that Applicant “knew” that “RT” was intended to draw an association to “ROTH” restates that allegation from paragraph 10, where Opposer 1) made it only “on information and belief” and 2) did not provide a statement of facts upon which its belief is founded. Thus, paragraph 23 cannot be relied on to establish that Applicant’s statement to the PTO about “RT” was a knowing falsehood.

Next, paragraph 24 is insufficient because Opposer simply alleges that “Applicant made these representations to the PTO with the intent to induce” it to publish and register the RT Rx mark. Opposer does not allege that Applicant made a fraudulent statement to the PTO with deceptive intent, or state any facts from which deceptive intent could reasonably be inferred. Because Opposer does not “point to evidence to support an inference of deceptive intent, it has failed to satisfy the clear and convincing evidence standard required to establish a fraud claim.” *In re Bose Corp.*, 580 F.3d at 1246. *See Media Online Inc.*, 88 U.S.P.Q.2d at *4 (motion for leave to amend complaint denied because the proposed pleading failed “to set forth with particularity the allegedly false statement or statements that purportedly allowed the Office to allow registration”).

Paragraphs 25, 26 and 27 do not include facts. They are a mere recitation of a legal standard – precisely the type of allegation that *Twombly* and *Iqbal* rejected.

CONCLUSION

For the reasons set forth herein, Applicant’s motion to dismiss Opposer’s claim for fraud on the PTO should be granted.

Respectfully submitted,

GOODELL, DeVRIES, LEECH & DANN, LLP

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 /s/ Matthew D. Kohel
Matthew D. Kohel

Exhibit A



OmniArch MicroProgressive .018 Upper Left 2 14° Torque 9° Angulation 0° Rotation

An Advanced Versatile Twin Design

- Mid-size design for easier handling and placement
- Raised gingival tie-wing for easy ligation - tapered occlusal tie-wing to avoid interference
- Incisal edge of base is designed to be parallel with the incisal edge of the tooth to facilitate placement



SKU 77-221-70

Call



Features and Benefits

Resources

OmniArch is a mid-sized bracket system that combines all the outstanding elements of typical twin systems with a highly advanced bracket design. Clinicians benefit from optimal size, wedged torque in base and easy bonding. Patients benefit from a bracket that is comfortable and esthetically pleasing. Conveniently, OmniArch is available in a wide range of prescriptions and options.

- Aligned angulation - The incisal aspect of OmniArch parallels the tooth's incisal edge, while the tie wings flow with the long, or crown axis. This provides unequalled mesiodistal/incisogingival orientation with precise tipping results
- Wedged Torque - OmniArch's wedged torque provides the aligned slots and placement advantages of torque in the base or diagonal design. It further incorporates a unique tie wing designed to reduce occlusal interference and the resulting discomfort, bond failure, and repositioning.
- The entire mandibular arch has a single scribe line running across the gingival wings, the mandibular second bicuspids have an additional scribe line on the incisal wings, and the maxillary bicuspids have a scribe line running across the incisal wings.
- Low profile design for greater comfort.
- Permanent ID mark for easy bracket identification.
- Chamfered archwire slot - milled for precision.
- OmniArch is the ideal size - small enough to be aesthetically pleasing, yet easy to handle and sized right for rotational and torque control not typically found in minis.

*Our RT Rx has values that are equivalent to the Roth® prescription values. No endorsement is implied. Roth® is a registered trademark of Roth Licensing LLC.