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

Proceeding	91230403
Party	Defendant Boschin, Luigi
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Securrency, Inc.,

Opposer,

v.

Luigi Boschin,

Applicant.

Opposition No. 91230403
Application Serial No. 86/904,230
Mark: SECURENCY

APPLICANT LUIGI BOSCHIN'S MOTION TO DISMISS

I. INTRODUCTION

Pursuant to Federal Rule of Civil Procedure 12(b)(6) and TBMP § 503, Applicant Luigi Boschin ("Applicant") hereby moves to dismiss Opposer Securrency, Inc.'s ("Opposer") claim for fraud on the USPTO. In this regard, Opposer has not pled fraud with the requisite particularity. Accordingly, Opposer's claim for fraud should be dismissed.

II. RELEVANT BACKGROUND

On February 10, 2016, Applicant filed an application to register the SECURENCY trademark in connection with "Currency Trading; Currency Exchange Services; Currency Transfer Services; Financial Services, namely, providing a virtual currency for use by members of an on-line community via a global computer network for direct digital real property transactions, fractional ownership transactions and usage of real property transactions; financial services, namely, providing a virtual currency for use by members of an on-line community via a global computer network for direct digital personal property transactions, fractional ownership transactions and usage of personal property transactions; offering real estate fractional ownership programs to others; offering real estate properties, boats and yachts, and farms fractional ownership programs to others; Financial services, namely, providing a virtual currency for use by members of an on-line community via a global computer network; Financial services, namely,

providing electronic transfer of a virtual currency for use by members of an on-line community via a global computer network” in International Class 36. The U.S. Patent and Trademark Office (“PTO”) assigned the application Serial No. 86/904,230 and the application was published for opposition on July 5, 2016.

On October 3, 2016, Opposer filed a Notice of Opposition in this proceeding on the alleged grounds of (1) priority and likelihood of confusion, (2) no use of the mark in commerce, (3) no bona fide intent to use mark, (4) Applicant not being the rightful owner, and (5) fraud on the USPTO. However, because Applicant believes that Opposer’s claim for fraud is deficient, Applicant hereby files a motion to dismiss for failure to state a claim.

III. LEGAL STANDARD FOR MOTION TO DISMISS

When it appears from the face of the complaint that the plaintiff fails to allege facts sufficient to state a claim upon which relief can be granted, dismissal is appropriate. *Scheuer v. Rhodes*, 416 U.S. 232, 236 (1974); T.M.B.P. § 503.02. Although the Trademark Trial and Appeal Board (“Board”) must accept all material allegations in the complaint as true, as well as reasonable inferences drawn from them, the Board should not accept as true unreasonable inferences, unwarranted deductions of fact or legal conclusions cast as factual assertions. *Smith v. Local 819 I.B.T. Pension Trust*, 291 F.3d 236, 240 (2d Cir. 2002); *Western Mining Council v. Watt*, 643 F.2d 618, 624 (9th Cir. 1981).

IV. ARGUMENT

In order to state a claim for fraud, an opposer must allege facts supporting the following elements: (1) the applicant made a false representation of fact in connection with applicant’s trademark application; (2) the false representation was material; and (3) the applicant made the false, material representation of fact knowingly. *In re Bose Corporation*, 580 F.3d 1240 (Fed. Cir. 2009); *PCAOB-Online v. Public Company Accounting Oversight Board*, 2005 TTAB LEXIS 76, at *8 (TTAB 2005) (non-precedential); *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46 (Fed. Cir. 1986). Moreover, ***the circumstances constituting the fraud must be pled with particularity.***

Fed. R. Civ. P. 9(b); *Intellimedia Sports, Inc. v. Intellimedia Corporation*, 43 U.S.P.Q.2d 1203, 1997 TTAB LEXIS 15, at *6–7 (TTAB 1997) (granting defendant’s motion to dismiss fraud claim for failure to plead with particularity).

Furthermore, the Board has made it clear that allegations based on “information and belief” do not meet the particularity requirements for pleading fraud. *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1479 (TTAB 2009) (“[A]llegations [based solely upon information and belief] fail to meet the Fed. R. Civ. P. 9(b) requirements as they are unsupported by any statement of facts providing the information upon which petitioner relies or the belief upon which the allegation is founded (*i.e.*, known information giving rise to petitioner’s stated belief, or a statement regarding evidence that is *likely* to be discovered that would support a claim of fraud”).

And fraud claims cannot be based on allegations that an Applicant submitted an unacceptable specimen. *This Little Piggy Wears Cotton v. Piggy Toes*, 2004 TTAB LEXIS 447, *12-14 (TTAB 2004). In this regard, because a specimen is submitted to an examining attorney for evaluation, there can be no fraud on this basis. *Id.*

Finally, an opposer’s conclusory statement that Applicant knew Opposer had superior rights is insufficient to state a claim for fraud on the USPTO with particularity. *Intellimedia Sports, Inc. v. Intellimedia Corporation*, 43 U.S.P.Q.2d 1203, 1997 TTAB LEXIS 15, at *12-15 (TTAB 1997). “In short, under FRCP 9(b) and the authorities discussed above, a sufficient pleading of the third element of a fraud claim must consist of more than a mere conclusory allegation that the defendant “knew” about a third party’s superior rights in the mark.” *Id.*

In the instant case, Opposer’s fraud allegations are contained in paragraphs 31.a, 31.b, and 31.c. However, the allegations contained in these paragraphs are insufficient because they do not meet the particularity requirements for pleading fraud on the USPTO with the requisite particularity. **First**, all three paragraphs begin with the phrase “upon information and belief.” As the Board made clear in *Asian and Western Classics*, allegations based on information and belief


do not meet the particularity requirements. **Second**, paragraph 31.a alleges—on information and belief—that Applicant was not using his SECURENCY trademark but contains no actual factual allegations supporting such a conclusion. In other words, Opposer fails to set forth any of the so called reasons or information that leads Opposer to believe (wrongly) that Applicant did not make use of the mark. **Third**, paragraph 31.b. alleges fraud based on Applicant submitting a specimen that does not show use, but the Board has made it clear in *This Little Piggy Wears Cotton* that the submission of a specimen is not a basis for fraud. And **fourth**, paragraph 31.c contains a conclusory allegation that Applicant knew Opposer had the right to use the SECURENCY mark. But the Board has made it clear in *Intellimedia Sports* that a conclusory allegation that Opposer knew Applicant had superior rights is insufficient to state a claim for fraud. As a result, because paragraphs 31.a, 31.b, and 31.c are clearly insufficient to state a claim for fraud, Opposer’s claim for fraud on the USPTO should be dismissed for failing to state a claim.

V. CONCLUSION

For all the foregoing reasons, Applicant respectfully requests that the Board grant the Motion to Dismiss Opposer’s claim for fraud on the USPTO.

Dated: November 14, 2016

Respectfully submitted,



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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copies of the following documents:

APPLICANT LUIGI BOSCHIN'S MOTION TO DISMISS

has been served on

Kevin Keener
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161 North Clark Street, Suite 4700
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by mailing such document on November 14, 2016 by First Class Mail, postage prepaid.

I declare under penalty of perjury under the laws of the State of California and the United States of America that the foregoing is true and correct.

Dated: November 14, 2016



Bruno W. Tarabichi