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

Proceeding	91230403
Party	Defendant Luigi Boschin
Correspondence Address	BRUNO TARABICHI OWENS TARABICHI LLP 4750 ALMADEN EXPRESSWAY 124-359 SAN JOSE, CA 95118 UNITED STATES btarabichi@owenstarabichi.com
Submission	Reply in Support of Motion
Filer's Name	Bruno Tarabichi
Filer's e-mail	btarabichi@owenstarabichi.com
Signature	/bruno tarabichi/
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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: SECURRENCY

APPLICANT LUIGI BOSCHIN'S REPLY BRIEF
IN SUPPORT OF MOTION TO DISMISS

I. INTRODUCTION

Opposer Securency, Inc. ("Opposer") has no real factual basis to allege fraud in this opposition proceeding. It cites to no actual facts showing that Applicant Luigi Boschin ("Applicant") made a false representation of fact in connection with his trademark application or that any alleged false representation of fact was made knowingly. The dead giveaway is Opposer's need to qualify all its fraudulent allegations with the phrase "upon information and belief," which the TTAB has held legally insufficient to meet the standard of pleading fraud with particularity. Furthermore, Opposer claims that Applicant was not using its SECURRENCY trademark but fails to include a single supporting factual allegation supporting such an allegation. Opposer also argues that Applicant submitted a specimen that does not show use, despite the fact that the TTAB has held allegations of an improper specimen do not support a fraud claim. And finally, Opposer's unsupported, conclusory statement that Applicant knew Opposer had superior trademark rights is insufficient under precedential TTAB case law.

II. ARGUMENT

A. THE FRAUD CLAIM IS GOVERNED BY FRCP 9(b), NOT FRCP 8 AND 12 AS OPPOSER INCORRECTLY ARGUES IN ITS OPPOSITION BRIEF

As an initial matter, Opposer begins its opposition brief by incorrectly arguing that "[t]he Board considers Registrant's motion under the liberal pleading standards of Rules 8 and 12 of the" Federal Rules of Civil Procedure. Opp'n, at 1. However, this is clearly wrong because notice pleading under Rule 8 does not apply to fraud claims. When the claim being pled is fraud, the pleading is considered under the much more stringent standard imposed by Rule 9(b), which requires that fraud be pled with particularity. *Intellimedia Sports, Inc. v. Intellimedia Corp.*, 1997 TTAB LEXIS 15, *7-8 (TTAB 1997). This includes claims of fraud pled in opposition proceedings before the TTAB. *Id*. Accordingly, Opposer's initial citation to Rule 8 is incorrect.

B. OPPOSER ESSENTIALLY ADMITS THAT IT IMPROPERLY PLED FRAUD ON INFORMATION AND BELIEF

In its opposition brief, Opposer essentially admits that it pled the fraud allegations "on information and belief" because, like many fraud cases, Opposer does not actually possess the facts supporting the Applicant's alleged fraud. Opp'n, at 2. However, as detailed in Applicant's moving papers, a party cannot plead fraud in an opposition proceeding based "on information and belief"—regardless of how difficult it may be for a party to possess facts supporting 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)").

C. OPPOSER'S RECITATION OF A HISTORY BETWEEN OPPOSER AND APPLICANT DOES NOT PROVIDE A BASIS FOR A FRAUD CLAIM

In its opposition brief, Opposer unconvincingly argues that it pleaded fraud with particularity because it included a few paragraphs in its Notice of Opposition regarding the fact that the parties have a history with each other, as opposed to coming to this opposition as strangers. However, the fact that the parties may have engaged in negotiations to evaluate a potential business arrangement at one point does not magically transform Applicant's application into a fraudulent act on the USPTO. In fact, a review of Opposer's allegations reveals that its claim of "retaliation" (which does not equate to fraud in any event) is mere speculation that is alleged impermissibly "upon information and belief." Notice of Opposition, at ¶ 28. As such, Opposer's misguided attempt to use these allegations to allege fraud do not satisfy the particularity standard for Rule 9(b).

D. CONTRARY TO OPPOSER'S ASSERTION, RULE 12(b)(6) MOTION IS USED TO DISMISS CLAIMS THAT DO NOT SATISFY RULE 9(b)

In its opposition brief, Opposer incorrectly argues that Applicant's motion to dismiss is not being made pursuant to Rule 12(b)(6), but instead pursuant to Rule 9(b). Opp'n, at 3. This is incorrect. Applicant's motion to dismiss is being made pursuant to Rule 12(b)(6) on the grounds that Opposer did not properly plead its fraud claim as required by Rule 9(b). *Intellimedia Sports, Inc. v. Intellimedia Corp.*, 1997 TTAB LEXIS 15, *7-8 (TTAB 1997) (granting 12(b)(6) motion to dismiss fraud claim for failing to plead with particularity as required by Rule 9(b)).

E. OPPOSER'S CONCLUSORY ALLEGATIONS OF FRAUD ARE DEFICIENT AND DEVOID OF THE REQUIRED PARTICULARITY

Without needlessly repeating the arguments in Applicant's moving papers, Opposer's fraud allegations, which are contained in paragraphs 31.a-c of the Notice of Opposition, fail to meet the particularity requirements of Rule 9(b) for at least four reasons. **First**, all three paragraphs begin with the phrase "upon information and belief," which does not meet the

particularity requirements. *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1479 (TTAB 2009). **Second,** paragraph 31.a alleges—on information and belief—that Applicant was not using his SECURRENCY trademark but contains no actual factual allegations supporting such a conclusory allegation. **Third**, paragraph 31.b. alleges fraud based on Applicant submitting a specimen that does not show use, but the Board has made it clear that the submission of a specimen that does not show use does not provide a basis for a fraud claim.[1] *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 2014 TTAB LEXIS 284, *43, n. 70 (TTAB 2014); *Paris Glove of Canada, Ltd. v. SBC/Sporto Corp.*, 2007 TTAB LEXIS 84, *24 (TTAB 2007) ("As for the adequacy of the specimen to demonstrate use of the registered mark, that does not go to the issue of fraud.")[2] And **fourth**, paragraph 31.c contains a conclusory allegation that Applicant knew Opposer had the right to use the SECURRENCY mark, but such conclusory allegations are insufficient to state fraud. *Intellimedia Sports, Inc. v. Intellimedia Corporation*, 43 U.S.P.Q.2d 1203, 1997 TTAB LEXIS 15, at *12-15 (TTAB 1997). As a result, Opposer clearly fails to state a claim for fraud, and 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.

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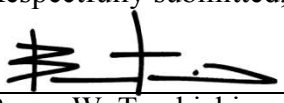
[1] In its opposition brief, Oppose tries to re-characterize its allegation as alleging that Applicant fabricated its specimen. But Opposer only alleges that "Applicant willfully submitted a specimen with the Application does not show use . . ." Notice of Opposition, at ¶ 31.b. The paragraph does not allege the "fabrication" of any specimen. The mere fact that Applicant created the specimen isn't fabrication. Almost all specimens are created by the applicant who owns the trademark.

[2] Opposer noted that Applicant cited *This Little Piggy Wear Cotton v. Piggy Toes* for the same proposition and that *This Little Piggy* is not precedential. Applicant therefore now cites precedential opinions standing for the same rule that submitting a specimen that does not show use is not a basis for fraud.

Dated: December 19, 2016

Respectfully submitted,



Bruno W. Tarabichi
OWENS TARABICHI LLP
4750 Almaden Expressway 124-359
San Jose, California 95118
Tel. (408) 298-8204
Fax (408) 521-2203
btarabichi@owenstarabichi.com
Attorneys for Applicant
Luigi Boschin

CERTIFICATE OF SERVICE

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

APPLICANT LUIGI BOSCHIN'S REPLY BRIEF IN SUPPORT OF MOTION TO DISMISS

has been served on

Kevin Keener
Keener & Associates, PC
161 North Clark Street, Suite 4700
Chicago, IL 60601

by mailing such document on December 19, 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: December 19, 2016

Bruno W. Tarabichi