

UNITED STATES PATENT AND TRADEMARK OFFICE  
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Baxley

October 16, 2018

Opposition No. 91241179

*Sprint Communications Company L.P.*

*v.*

*AT&T Intellectual Property II, L.P.*

**By the Trademark Trial and Appeal Board:**

I. Applicant's involved application

AT&T Intellectual Property II, L.P. ("Applicant") seeks to register the mark AT&T ENHANCED PUSH-TO-TALK in standard characters for "Telecommunication services, namely, providing voice, text, data, pictures, music and video via wireless networks and two-way radio dispatching services; electronic transmission of voice, text, images, data and information by means of two-way radios, mobile radios, cellular telephones, dispatch radios, pagers; paging services; mobile telephone communication services; wireless Internet access; and wireless data services for mobile devices via a wireless network for the purpose of sending and receiving electronic mail, facsimiles, data, images, information, text, numeric messaging and

text messaging and for accessing a global communications network” in International Class 38.<sup>1</sup> The application includes a disclaimer of PUSH-TO-TALK.

Sprint Communications Company L.P. (“Opposer”) filed a notice of opposition to registration of Applicant’s mark. As grounds for opposition, Opposer alleges that (1) Applicant’s mark is unregistrable without a disclaimer of ENHANCED; and (2) Applicant committed fraud by not disclaiming the word ENHANCED in the involved application.

## II. Mere descriptiveness claim not pleaded

The ESTTA cover form for the notice of opposition indicates that, in addition to the grounds set forth *supra*, Opposer intends to pursue a claim that the mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. § 1052(e)(1). However, because Opposer did not plead that claim in the text of the notice of opposition, that claim is not properly before the Board.<sup>2</sup> See *Embarcadero Techs. Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1827 n.2 (TTAB 2013).

## III. Motion to dismiss moot in part, granted in part

In lieu of an answer, Applicant, on June 22, 2018, filed a motion to dismiss the mere descriptiveness and fraud claims under Fed. R. Civ. P. 12(b)(6) for failure to

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<sup>1</sup> Application Serial No. 87649171, filed October 17, 2017, based on an assertion of use in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), and alleging February 21, 2012 as the date of first use anywhere and as the date of first use in commerce.

<sup>2</sup> In any event, the allegations set forth in the notice of opposition are only with regard to the ENHANCED PUSH-TO-TALK portion of the involved mark. A claim under Section 2(e)(1) is based on the mark in entirety. See, e.g., *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 759 F.3d 1327, 111 USPQ2d 1649, 1650 (Fed. Cir. 2014). Because Opposer’s allegations are not based on the mark in its entirety, there would appear to be no basis for a Section 2(e)(1) claim.

state a claim. Opposer filed a brief in response thereto. Because the mere descriptiveness claim is not properly before the Board, the motion to dismiss is moot with regard thereto.

A motion to dismiss under Rule 12(b)(6) for failure to state a claim upon which relief can be granted is a means of testing the sufficiency of a complaint. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995); TBMP § 503.02. To state a claim upon which relief can be granted, Opposer need only allege such facts which, if proved, would establish that Opposer is entitled to the relief sought; that is, (1) Opposer has standing to bring the proceeding, and (2) a valid statutory ground exists for refusing registration of the mark in the application at issue. *See Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007).

Turning to the issue of standing, the starting point for a standing determination in an opposition proceeding is Trademark Act Section 13(a), 15 U.S.C. § 1063(a), which provides that “[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor....” Section 13(a) establishes a broad class of persons who are proper opposers; by its terms the statute only requires that a person have a belief that he would suffer some kind of damage if the mark is registered. That is, an opposer must have a real interest in the proceeding, i.e., a direct and personal stake in the outcome of the proceeding, and a reasonable basis for a belief of damage. *See Ritchie v.*

*Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1026 (Fed. Cir. 1999); *Universal Oil Prod. Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972). There is no requirement that actual damage be pleaded and proved to establish standing or to prevail in an opposition proceeding. *See Ritchie*, 50 USPQ2d at 1025. For purposes of ruling on a motion to dismiss, the Board must accept as true all well-pleaded and material allegations of the complaint, and must construe the complaint in favor of the complaining party. *See Jewelers Vigilance Corp. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2022 (Fed. Cir 1987).

Opposer's allegations in the preamble and paragraphs 1 and 3-9 are sufficient to indicate a real interest in the outcome of the proceeding in the outcome of the proceeding and a reasonable basis for a belief of damage from registration of the involved mark. That is, Opposer has alleged that it is engaged in the sale of the same or related services as those listed in Applicant's involved application and that it has the right to use the wording ENHANCED PUSH-TO-TALK in a merely descriptive manner. *See Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844 (TTAB 2017). Because Opposer has pleaded standing to allege one ground, it may assert any other legally sufficient claims. *See Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1877 (TTAB 2011). Accordingly, the Board finds that Opposer has sufficiently alleged its standing to maintain this proceeding.

With regard to the grounds for cancellation at issue herein, Federal Rule of Civil Procedure 8(a)(2) requires that a pleading contain a "short and plain statement of the claim showing that the pleader is entitled to relief." Rule 8(a)(2) does not require

detailed factual allegations, but requires more than labels, conclusions, formulaic recitations of the elements of a cause of action, and naked assertions, i.e., “more than an unadorned, the-defendant-unlawfully-harmed-me accusation.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). Indeed, “a complaint must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Id.* (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged. *Ashcroft*, 556 U.S. at 678. The plausibility standard is not akin to a “probability requirement,” but it asks for more than a sheer possibility of the allegations asserted. *Id.* Indeed, a plaintiff need not allege specific facts that would establish a *prima facie* case for the claim(s) asserted. *See Bell Atlantic*, 550 U.S. at 555 (citing *Swierkiewicz v. Sorema N. A.*, 534 U.S. 506, 508 (2002)). In the context of Board *inter partes* proceedings, a plaintiff need only allege enough factual matter to suggest that its claim is plausible and to “raise a right to relief above the speculative level.” *Id.*, 550 U.S. at 555-56. Although the Board, in deciding a Rule 12(b)(6) motion, must accept as true all factual allegations in the complaint, it is not bound to accept as true a legal conclusion couched as a factual allegation. *Id.* at 555.

Regarding the fraud claim, a registration is obtained fraudulently under the Trademark Act where an applicant or registrant “knowingly makes a false, material representation with the intent to deceive the PTO.” *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009). Under Federal Rule of Civil Procedure 9(b),

fraud claims must be pleaded “with particularity.” That is, a fraud claim requires identification of the specific who, what, when, where, and how of the material misrepresentation or omission committed before the USPTO. *Cf. Exergen Corp. v. Wal-Mart Stores Inc.*, 575 F.3d 1312, 91 USPQ2d 1656, 1667 (Fed. Cir. 2009) (allegations of inequitable conduct in patent cases require pleadings of specific conduct upon which allegation is based). A pleading that simply alleges the substantive elements of fraud, without setting forth the particularized factual bases for the allegation, does not satisfy Rule 9(b). *See id.* (citing *King Auto., Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801, 802-03 (CCPA 1981)). Allegations made upon information and belief without a recitation of specific fact upon which that belief is based are insufficient. *See Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1479 (TTAB 2009).

Knowledge and intent, as conditions of mind of a person, may be averred generally in support of an allegation of fraud. *See Fed. R. Civ. P. 9(b); DaimlerChrysler Corp. v. American Motors Corp.*, 94 USPQ2d 1086, 1088 (TTAB 2010). Nonetheless, a plaintiff must allege facts from which the Board may infer deceptive intent. *See Asian and Western Classics B.V.*, 92 USPQ2d at 1479. First, Opposer’s fraud claim is insufficient because Opposer has pleaded the basis therefor “[o]n information and belief” without reciting specific facts that would support an inference that the averments in the declaration were knowingly false and made with deceptive intent.<sup>3</sup> *See* notice of

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<sup>3</sup> Opposer is reminded that, by alleging fraud, it is essentially accusing its adversary of lying. This accusation should only be made when there is a firm basis therefor.

opposition, paragraphs 13 and 14. Second, to the extent that Opposer alleges fraud based on averments in the application declaration, those averments were based on “the trademark/service mark sought to be registered” i.e., the mark in its entirety, and not its component parts.<sup>4</sup>

Rather, Opposer’s fraud claim is essentially based on Applicant’s failure to: (1) include the allegedly laudatorily descriptive word ENHANCED in the disclaimer that was part of the involved application as originally filed, and (2) advise the Examining Attorney of the meaning of the wording ENHANCED PUSH-TO-TALK with regard to Applicant’s involved services. A review of Applicant’s involved application indicates that it was approved for publication as filed, i.e., without any Office Actions issued in connection therewith. Thus, the Examining Attorney never raised the issues of disclaiming the word ENHANCED or requiring further information regarding the meaning of the wording ENHANCED PUSH-TO-TALK, and Applicant made no specific statements with regard to these issues, false or otherwise. Applicants typically do not include disclaimers in their original applications and only add them during *ex parte* examination when required in Office Actions by Examining Attorneys. *See* TMEP § 1213 *et seq.* Likewise, applicants typically do not explain the meaning of wording in a relevant trade or industry unless Examining Attorneys have made inquiries in Office Actions. *See* Trademark Rule 2.61(b) Had the Examining

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<sup>4</sup> Application declarations are phrased in terms of a subjective belief, thereby making it extremely difficult to prove fraud so long as the signer has an honestly held, good faith belief. *See Woodstock's Enterprises Inc. (California) v. Woodstock's Enterprises Inc. (Oregon)*, 43 USPQ2d 1440, 1443 (TTAB 1997).

Attorney determined that a disclaimer of ENHANCED was warranted or that he needed further information regarding the meaning of the wording ENHANCED PUSH-TO-TALK in connection with the services at issue, he could have required such disclaimer and/or information. *See* Trademark Rule 2.61(b); TMEP § 1213 *et seq.* By its fraud claim, Opposer is essentially asking the Board to penalize Applicant for failure to comply with requirements that the Examining Attorney never made. *See Century 21 Real Estate Corp. v. Century Life of Am.*, 10 USPQ2d 2034, 2035 (TTAB 1989). Based on the foregoing, the pleaded fraud claim is insufficient, and the motion to dismiss is granted with regard thereto.

In the interest of completeness, the Board finds that Opposer has adequately provided fair notice of a claim that the mark is unregistrable without adding the word ENHANCED to the existing disclaimer of PUSH-TO-TALK in paragraphs 6-11 of the notice of opposition. *See* Trademark Act Section 6(a), 15 U.S.C. § 1056(a); *Montecash LLC v. Anzar Enters. Inc.*, 95 USPQ2d 1060, 1063-64 (TTAB 2010); *Kellogg Co. v. Pack'Em Enters. Inc.*, 14 USPQ2d 1545, 1548-49 (TTAB 1990); TMEP § 1213.01(b) (October 2017). Whether Opposer can prevail in this case is a matter for resolution after proper introduction of evidence at trial (or upon properly filed motion for summary judgment). *See Prosper Bus. Dev. Corp. v. Int'l Bus. Machs., Corp.*, 113 USPQ2d 1148, 1152 (TTAB 2014).

Based on the foregoing, the motion to dismiss is moot with regard to the mere descriptiveness claim and granted with regard to the fraud claim. Paragraphs 12-15 are *sua sponte* stricken from the notice of opposition. *See* Fed. R. Civ. P. 12(f); TBMP

§ 506.01. Inasmuch as there would appear to be no basis for a fraud claim, the Board finds that granting leave to replead those claims is unwarranted at this time.<sup>5</sup> *See* TBMP § 503.03. The opposition will go forward solely on the Section 6(a) disclaimer claim only.

#### IV. Proceedings resumed, dates reset

Proceedings herein are resumed. Applicant is allowed until twenty days from the mailing date set forth in this order to file its answer. Remaining dates are reset as reset as follows.

Answer Due	11/9/2018
Deadline for Discovery Conference	12/9/2018
Discovery Opens	12/9/2018
Initial Disclosures Due	1/8/2019
Expert Disclosures Due	5/8/2019
Discovery Closes	6/7/2019
Plaintiff's Pretrial Disclosures Due	7/22/2019
Plaintiff's 30-day Trial Period Ends	9/5/2019
Defendant's Pretrial Disclosures Due	9/20/2019
Defendant's 30-day Trial Period Ends	11/4/2019
Plaintiff's Rebuttal Disclosures Due	11/19/2019
Plaintiff's 15-day Rebuttal Period Ends	12/19/2019
Plaintiff's Opening Brief Due	2/17/2020
Defendant's Brief Due	3/18/2020
Plaintiff's Reply Brief Due	4/2/2020
Request for Oral Hearing (optional) Due	4/12/2020

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is

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<sup>5</sup> If after obtaining discovery, Opposer believes it has a specific factual basis for a fraud claim, it may seek leave of the Board to file an amended notice of opposition wherein it adds that claim. *See* Fed. R. Civ. P. 15(a); TBMP § 507.

taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).