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

Proceeding	91267957
Party	Defendant Sebe Inc.
Correspondence Address	FRANK S. BENJAMIN DENTONS US LLP 303 PEACHTREE STREET NE, SUITE 5300 ATLANTA, GA 30308 UNITED STATES Primary Email: trademarks.us@dentons.com Secondary Email(s): frank.benjamin@dentons.com, benjamin.harbuck@dentons.com, katie.krutzsch@dentons.com, angelica.pogson@dentons.com 404-527-4986
Submission	Reply in Support of Motion
Filer's Name	Benjamin P. Harbuck
Filer's email	trademarks.us@dentons.com, frank.benjamin@dentons.com, benjamin.harbuck@dentons.com, katie.krutzsch@dentons.com
Signature	/benjamin p. harbuck/
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Attachments	Reply in Support of MTD NEEVA BABY Opposition.pdf(24775 bytes)

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

Dagamma Ecommerce Solutions Inc.,)	
Opposer,)	
)	Opposition No. 91267957
v.)	
)	Serial No. 88/955,330
Sebe Inc.)	
Applicant.)	Mark: NEEVA BABY
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**APPLICANT’S REPLY IN SUPPORT OF ITS MOTION TO DISMISS
PURSUANT TO FED. R. CIV. P. 12(b)(6)**

Applicant Sebe Inc. (“Applicant”), by and through its undersigned counsel, hereby replies in support of its motion to dismiss the claims asserted by Opposer Dagamma Ecommerce Solutions Inc. (“Opposer”) in its March 3, 2021 Notice of Opposition, pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure and Sections 503 and 502.02(b) of the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”). Applicant respectfully requests that the Trademark Trial and Appeal Board (the “Board”) dismiss the instant Opposition pursuant to Rule 12(b)(6).

I. INTRODUCTION

In its response to the instant motion to dismiss, Opposer has only proven Applicant’s point. First, Opposer has shown how its claims of no use in commerce and fraud are actually based on reverse passing off claims that are never proper before this Board.¹ Furthermore, Opposer still fails to allege any facts whatsoever for its “digital mockups”-as-specimens fraud claim, completely

¹ Furthermore, contrary to Opposer’s misleading assertion on p. 1 of its response to the present Motion to Dismiss, Applicant has never stated that it is liable for reverse passing off. In fact, Applicant truthfully stated quite the opposite--that it “did provide legitimate specimens to the USPTO in relation to its Application, was making actual use of the mark at the time of its Application, and was not engaged in any reverse passing off.” Motion to Dismiss, p. 3, Introduction.

failing to meet the heightened pleading burden for fraud. And finally, Opposer still has no standing, as its claims for standing are based in the improper claim of reverse passing off, and the damages claimed by Opposer cannot be remedied by this Board.

II. ARGUMENT²

a. Opposer's Response Shows how its Claims of no Use in Commerce and Fraud are Actually Based on Reverse Passing Off Claims that are Never Proper Before this Board

In its response, Opposer did not claim that reverse passing off was proper subject matter before this Board, nor did it cite to any cases that could support this proposition. That is because it appears that such cases do not exist, as reverse passing off is not a proper claim before this Board. Not only is this board not equipped to handle such claims, but if this Board accepts Opposer's reverse passing off claim as within the jurisdiction of this Board, it will destroy the important distinction between Lanham Act 43(a) claims for reverse passing off and Lanham 1(a) claims for lack of use. *See, e.g., Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 30 (2003); *Pure Gold, Inc. v. Syntex (USA) Inc.*, 221 U.S.P.Q. 151 (TTAB 1983); *Andersen Corp. v. Therm-O-Shield Int'l, Inc.*, 226 U.S.P.Q. 431, 432 n.5 (TTAB 1985); *Electronic Water Conditioners, Inc. v. Turbomag Corp.*, 221 USPQ 162, 163-64 (TTAB 1984) (holding that actions under Section 43(a) are "outside the jurisdiction of this Board").

In fact, Opposer's response only provided further confirmation that its Opposition is truly based on a reverse passing off claim, by restating on p. 8 of its response its claim "that Applicant intentionally concealed information that would connect the goods to the Opposer by placing its own label over the original manufacturing identification information." This is the textbook

² For Legal Standard, see Applicant's Motion to Dismiss, p. 3, Argument - Legal Standard.

definition a Lanham Act 43(a) claim for reverse passing off: “The act or an instance of falsely representing another's product as one's own in an attempt to deceive potential buyers.” Passing Off and Reverse Passing Off Definition, *Black's Law Dictionary* (11th ed. 2019), available at Westlaw; see also *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 30 (2003); 15 U.S.C. § 1125(a) (providing a civil action for “false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which ... is likely to cause confusion ... as to the origin ... of his or her goods”). Opposer’s 1(a) lack of use claim is based solely on reverse passing off, and should therefore be dismissed.

Furthermore, one prong of Opposer’s claim for fraud is likewise based on reverse passing off (the other prong is based on supposed “digital mockups” as addressed below). In its response, Opposer argued that it has “set forth the specific actions that constituted acts of fraud before the USPTO” by repeating at length its allegations of reverse passing off. Opp. Response to Mot. to Dismiss, p. 5-6. Because Lanham Act 43(a) claims like reverse passing off are never proper before this Board, this fraud claim must be dismissed.

b. Opposer Still Fails to Allege any Facts Whatsoever for its “Digital Mockups”-as-Specimens Fraud Claim, Completely Failing to Meet the Heightened Pleading Burden for Fraud

The fact remains that Opposer alleges absolutely no facts at all to support its claim of fraud due to alleged “digital mockups” specimens.

Opposer’s cited case of *Kaszuba v. Iancu*, Case No. 2019-1547, 823 Fed.Appx. 973 (Fed. Cir. August 5, 2020) is inapposite here. Importantly, in *Kaszuba*, the fraud claim alleged at least *one fact* to form the basis for such a claim. Namely, the petitioner in *Kaszuba* alleged that, “pursuant to applicable federal regulations, Kaszuba was required to register his beer label on the

Certificate of Label Approval (“COLA”) registry before selling beer in commerce,” but that “no such label was registered on the COLA registry” despite the fact that the applicant had alleged use. *Id.* at 980.

Therefore, in *Kaszuba*, petitioner had some factual basis for its allegation of no use of the mark in commerce and fraud in claiming use, since a regulatory registration necessary for use had not been obtained. Here, there is no comparable factual basis. Aside from the fraud claim that is based on a Section 43(a) passing off claim and is therefore not proper before this Board, as discussed above, there is not a single alleged fact supporting Opposer’s claim that Applicant’s specimen was a “digital mockup.” Simply put, Opposer fails to meet the fraud pleading standard of Fed. R. Civ. P. 9(b) because it makes allegations based solely on information and belief, and has alleged *absolutely no facts* that support its fraud claim. “Pleadings of fraud made on ‘information and belief’ when there is no allegation of ‘specific facts upon which the belief is reasonably based’ are insufficient.” *Asian and W. Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1479 (TTAB 2009) (citing *Exergen Corp. v. Wal-Mart Stores, Inc.*, 91 USPQ2d 1656, 1670 (Fed. Cir. 2009)).

If the Board allows Opposer’s claims, it will be running contrary to Fed. R. Civ. P. 9(b) and will be opening the floodgates for further discovery fishing expeditions that do not even allege a single fact to support their fraud claims. Because all of Opposer’s bases for claiming fraud are not in this Board’s jurisdiction and/or are not adequately pled, Opposer’s fraud claims must be dismissed.

- c. Opposer Still has no Standing, as its Claims for Standing are Based in the Improper Claim of Reverse Passing Off, and the Damages Claimed by Opposer Cannot be Remedied by this Board**

Opposer still has no standing. In order to have standing, Opposer must show a “real interest,” *i.e.*, a direct and personal stake, in the outcome of the proceeding, as well as a “reasonable basis” to believe that it will be damaged by the registration. *See, e.g., Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1063 (Fed. Cir. 2014).

Opposer claims in its response that both its “real interest” in the outcome of the proceeding and its “reasonable belief” of damage lie in its allegation that Applicant engaged in reverse passing off of Opposer’s products. *See* Opp. Response to Mot. to Dismiss, pp. 10-11 (“Opposer’s real interest in the proceeding arises out of its contention that Applicant, at the time of the Application was filed, was not applying the trademark to Applicant’s own procured products, but instead to products that Applicant acquired and re-sold in violation of Opposer’s exclusive rights to sell such products within the U.S. by Opposer.... The nature of the damage is set forth in the opposition and Opposer’s reasonable belief is established by the obvious loss caused by the distribution of the devices by Applicant”). As discussed above, reverse passing off is not a proper claim before the Board. Therefore, Opposer has alleged no real interest in the outcome of the proceeding and no reasonable belief of damage in any claim that can be brought before this Board.

Furthermore, even if Opposer’s claimed damage had occurred, which it has not, such damage could not be remedied by this Board. Opposer claims that its damage is “caused by distribution of the devices by Applicant.” (Opp. Response to Mot. to Dismiss, p. 11). Yet this Board has no power to affect the distribution of Applicant’s devices in any way, and instead is limited only to remedies in relation to the trademark registration at issue. TBMP § 102.01 (“The Board is empowered to determine only the right to register.... The Board is not authorized to determine the right to use, nor may it decide broader questions of infringement or unfair competition.”). Therefore, Opposer’s claimed damage, which relates only to product distribution,

shows that it has no real interest in the outcome of a proceeding relating only to the registration of the NEEVA BABY mark, and no reasonable basis to believe it will be damaged by the registration of the NEEVA BABY mark. Rather, Opposer's claimed damage further cements the fact that the basis for the current opposition is simply not proper before the Board, as this Board cannot remedy Opposer's alleged damage because it cannot influence the distribution of products.

Finally, the cases cited by Opposer in regard to standing are inapposite here. First, as Opposer admits, all of its cited cases have "statutory grounds other than those pled by Opposer," which statutory grounds, unlike those here, were actually proper before this Board. Furthermore, in the cited case of *Best Lock Corp. v. Schlage Lock Co.*, 162 USPQ 552, 56 CCPA 1472 (CCPA 1969), the Board, "apparently on its own initiative," did take the position that Opposer had no standing, and this was only traversed based on specific arguments and factual circumstances that are not clear from the 52-year-old record, and which therefore cannot be applied here. *See id.* at 1475. And in both *Community of Roquefort v. Santo*, 170 USPQ 205 (CCPA 1971), and *Universal Overall Co. v. Stonecutter Mills Corp.*, 154 USPQ 104 (CCPA 1967), the Opposer claimed likelihood of confusion with its own registered mark, which claim itself can form the basis for standing in an opposition, unlike the claims of lack of use and fraud here. *See* TBMP § 309.03(b). Finally and importantly, in neither *Roquefort* nor *Universal Overall* did the Board actually discuss the issue of standing at all.

It therefore remains the case that Opposer lacks standing.

III. CONCLUSION

WHEREFORE, because: (a) Opposer's claims for lack of use in commerce are actually reverse passing off claims under Lanham Act Section 43(a), and such claims are not in the jurisdiction of the TTAB and are not the proper subject matter for an opposition proceeding; (b)

Opposer's claims of fraud are based solely on improper claims of reverse passing off, which are not proper for opposition proceedings, and fraud in the specimens, which is inadequately pled; and (c) Opposer has not shown that it has standing to bring this Opposition, Applicant respectfully requests that the Board dismiss the instant Opposition with prejudice. Applicant requests that the Board grant this Motion to Dismiss Pursuant to Fed. R. Civ. P. 12(b)(6), and grant such other and further relief as the Board deems just and proper.

Respectfully submitted,

Date: May 18, 2021

/s/ Benjamin P. Harbuck
Benjamin P. Harbuck
Frank S. Benjamin
Dentons US LLP
303 Peachtree Street NE, Suite 5300
Atlanta, GA 30308
404-527-4986
trademarks.us@dentons.com
frank.benjamin@dentons.com
benjamin.harbuck@dentons.com
katie.krutzsch@dentons.com
Attorneys for Applicant Sebe Inc.

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **APPLICANT’S REPLY IN SUPPORT OF ITS MOTION TO DISMISS PURSUANT TO FED. R. CIV. P. 12(b)(6)** was served by email upon:

Ryan Gile
Gile Law Group
1180 N. Town Center Drive, Suite 100
Las Vegas, NV 89144
Telephone: 702.703.7288
rg@gilelawgroup.com
ttab@gilelawgroup.com

counsel for Dagamma Ecommerce Solutions Inc., on this 18th day of May 2021.

/s/ Benjamin P. Harbuck
Benjamin P. Harbuck

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ESSTA on May 18, 2021

Benjamin P. Harbuck
Frank S. Benjamin
Dentons US LLP
303 Peachtree Street NE, Suite 5300
Atlanta, GA 30308
404-527-4986
trademarks.us@dentons.com
frank.benjamin@dentons.com
benjamin.harbuck@dentons.com
katie.krutzsch@dentons.com
Attorneys for Applicant Sebe Inc.