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

Proceeding no.	91271308
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

*In re* Application Serial No.: 88/880,340

Mark: SNAPSOLVE

Filing Date: April 21, 2020

Publication Date: April 27, 2021

SNAP INC.,

Opposer,

v.

WHIZESOLVE PTE. LTD.,

Applicant.

Opposition No. 91271308

**SNAP INC.'S MOTION TO DISMISS APPLICANT'S AMENDED  
COUNTERCLAIMS FOR CANCELLATION AND TO STRIKE  
APPLICANT'S AMENDED AFFIRMATIVE DEFENSE**

Pursuant to Federal Rule of Civil Procedure 12(b)(6), 12(f), and 12(f)(2), and Sections 503 and 506 of the Trademark Trial and Appeal Board Manual of Procedure (2021) (“TBMP”), Opposer Snap Inc. (“Snap”) moves to dismiss the amended counterclaims and strike the amended affirmative defense asserted by Applicant Whizsolve Pte. Ltd. (“Applicant”) in its Answer, Amended Affirmative Defenses [sic], and Amended Counterclaims to Amended Notice of Opposition (“Amended Answer”). *See* Amended Answer at 3-8, 13 TTABVUE 4-9.

**I. BACKGROUND**

Snap distributes the famous Snapchat® camera and messaging app, which enables users to edit and share photographs, videos, and messages on their mobile devices, among other uses. First Amended Notice of Opposition (“Amended Notice”) ¶ 1, 7 TTABVUE 2. Since at least 2019, the

Snapchat® app has included a feature allowing users to obtain solutions to math problems simply by scanning them into their mobile devices. *Id.* In addition to its rights under common law, Snap owns numerous registrations of marks containing “SNAP,” including the registrations of the SNAP mark at issue here. *Id.* ¶ 3, 7 TTABVUE 3-4.

On April 21, 2020, Applicant filed Application Serial No. 88/880,340 to register the mark SNAPSOLVE for goods and services in Classes 9, 16, 41, and 42, including a downloadable app for helping students solve math problems. *Id.* ¶ 10, 7 TTABVUE 6-13. Applicant moved to dismiss and for a more definite statement on October 5, 2021. 4 TTABVUE. Snap filed its Amended Notice on October 25, 2021. 7 TTABVUE. On November 29, 2021, Applicant filed an Answer containing three counterclaims for cancellation and two affirmative defenses. Answer at 3-8, 9 TTABVUE 5-10.

On January 6, 2022, Snap moved to dismiss Applicant’s counterclaims and strike its affirmative defenses as insufficiently pleaded. Snap Inc.’s Motion to Strike Applicant’s Affirmative Defenses and to Dismiss Applicant’s Counterclaims for Cancellation (“Original Motion”), 11 TTABVUE. Applicant responded by filing an Amended Answer containing four counterclaims for cancellation and one affirmative defense. Amended Answer, 13 TTABVUE. Three of Applicant’s new counterclaims are versions of its previous counterclaims (with even less factual support), to which Applicant added a conclusory fraud claim. *Compare* Amended Answer at 3-8, 13 TTABVUE 4-9 *with* Answer at 3-8, 9 TTABVUE 5-10. Applicant’s new estoppel defense is identical to its old one. *Compare* Amended Answer at 3, 13 TTABVUE 4 *with* Answer at 3, 9 TTABVUE 5.

As demonstrated below, each of Applicant’s amended counterclaims for cancellation remains fatally defective because, once again, Applicant has not alleged (and cannot allege) facts

supporting its claims that: (1) Snap abandoned the mark in Registration No. 4,111,564 (the “‘564 Registration”) through nonuse; (2) Snap fraudulently procured the ‘564 Registration; (3) Snap has never used the mark in Registration No. 6,420,265 (the “‘265 Registration”); and (4) Snap fraudulently procured the ‘265 Registration. Applicant twice having failed to state plausible claims, Snap is entitled to dismissal of Applicant’s amended counterclaims without leave to amend. In addition, Applicant’s estoppel defense is nakedly pleaded and factually unsupported, as before, and is not available in this opposition proceeding in any event. That defense therefore is insufficient and should be stricken from the Amended Answer.

## **II. ARGUMENT**

### **A. The Board Should Dismiss Applicant’s Counterclaims for Failure to State Plausible Claims for Cancellation.**

The purpose of a motion under Rule 12(b)(6) is to challenge “the legal theory of the complaint, . . . [and] to eliminate actions that are fatally flawed in their legal premises and destined to fail.” *Advanced Cardiovascular Sys., Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 1160 (Fed. Cir. 1993). To survive such a motion, the 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)). “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.” *Id.* In drawing those inferences, however, a court is not required to accept “conclusory statements” made by the counterclaimant as true, nor do “legal conclusion[s] couched as . . . factual allegation[s]” merit such deference. *Id.* (citation omitted). These are apt descriptions of the allegations in Applicant’s amended counterclaims, as shown below.

**1. Applicant’s Counterclaim for Cancellation of the ‘564 Registration on the Basis of Abandonment Remains Insufficiently Pleaded.**

A mark is deemed abandoned “[w]hen its use has been discontinued with intent not to resume such use,” with three consecutive years of nonuse serving as “prima facie evidence of abandonment.” 15 U.S.C. § 1127. Thus, to plausibly plead abandonment, Applicant “must recite *facts* which, if proven, would establish at least three consecutive years of nonuse, or alternatively, a period of nonuse less than three years coupled with proof of intent not to resume use.” *Dragon Bleu (SARL) v. VENM, LLC*, 112 U.S.P.Q.2d 1925, 1930 (T.T.A.B. 2014) (emphasis added) (citation omitted).

Applicant based its previous counterclaim for the ‘564 Registration on the allegations that Snap’s specimen did not show use of the mark, but the Office nonetheless accepted it. Answer at 4 ¶¶ 5-7, 9 TTABVUE 6. After Snap pointed out that the adequacy of a specimen *per se* is not a valid ground for challenging the resulting registration, Original Motion at 4, 11 TTABVUE 5 (citations omitted), Applicant stripped the specimen allegations from its counterclaims for the ‘564 Registration, leaving the following allegations as the sole basis for its abandonment claim:

3. At the time of the assignment [from Snap Interactive], Snap did not use SNAP INTERACTIVE or SNAP as a trademark for any goods or services. . . .
11. Opposer has not used the mark SNAP for the Class 45 services in the ‘564 Registration.
12. Opposer has not used the mark SNAP for the Class 45 services in the ‘564 Registration during the three-year period preceding the date of this cancellation counterclaim, and has no intention to use and/or resume use for such services.
13. As a result of its non-use of the SNAP trademark in connection with the services identified in ‘564 Registration, and with no intention to begin and/or resume use, Opposer has abandoned said SNAP trademark within the meaning of 15 U.S.C. § 1127, Section 45 of the Lanham Act.

Amended Answer at 4-5 ¶¶ 3, 11-13, 13 TTABVUE 5-6. In short, Applicant repeatedly alleges Snap’s nonuse of the SNAP mark without alleging a single fact supporting these conclusory claims. These are textbook examples of a “formulaic recitation of the elements of a cause of action,” which the Supreme Court has instructed “will not do.” *See Twombly*, 550 U.S. at 555. The Board should dismiss Applicant’s abandonment counterclaim for the ‘564 Registration without leave to replead.

**2. Applicant’s New Counterclaim for Cancellation of the ‘564 Registration on the Basis of Fraud Is Factually and Legally Insufficient.**

“Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application.” *In re Bose Corp.*, 580 F.3d 1240, 1243 (Fed. Cir. 2009) (citation omitted). As the Federal Circuit famously emphasized in *Bose*,

A party seeking cancellation of a trademark registration for fraudulent procurement bears a heavy burden of proof. Indeed, “the very nature of the charge of fraud 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.”

*Id.* (quoting *Smith Int’l, Inc. v. Olin Corp.*, 209 U.S.P.Q. 1033, 1044 (T.T.A.B. 1981)).

In addition, at the pleading stage, Federal Rule of Civil Procedure 9(b) requires parties alleging fraudulent procurement to “state with particularity the circumstances constituting fraud.” Fed. R. Civ. P. 9(b). Thus, while “[m]alice, intent, knowledge, and other conditions of a person’s mind may be alleged generally,” *id.*, the law requires a counterclaimant alleging fraudulent procurement to allege the *particular facts* supporting a reasonable inference that the registrant acted fraudulently. “The pleadings [must] contain *explicit* rather than implied expression of the circumstances constituting fraud.” *Asian & W. Classics B.V. v. Selkow*, 92 U.S.P.Q.2d 1478, 1478 (T.T.A.B. 2009) (quoting *King Auto., Inc. v. Speedy Muffler King, Inc.*, 212 U.S.P.Q. 801, 803,

667 F.2d 1008, 1010 (C.C.P.A. 1981) (emphasis added)). Conclusory statements like the ones in Applicant's counterclaims "do not suffice." See *Iqbal*, 556 U.S. at 678; see also *Twombly*, 550 U.S. at 555.

The following allegations are Applicant's entire basis for claiming fraudulent procurement of the '564 Registration:

15. At the time of the filing of the Request to Amend the SNAP INTERACTIVE registration, Snap did not, and does not use SNAP as a trademark or service mark for the services covered by the '564 Registration. Applicant searched online and did not identify any use of SNAP in connection with on-line social networking services.
16. In its renewal of the '564 Registration, Snap made verified statements under penalty of perjury that it used SNAP as a trademark on the covered services.
17. When it filed its application for renewal of the '564 Registration, Snap was fully aware that it did not make use of the mark shown on the services alleged in the '564 Registration, and consequently, the statements made were false and material to the USPTO's issuance of the renewal of registration.
18. In reliance on Snap's false statement of continued use of the mark covered by the '564 Registration, the USPTO issued a renewal of the '564 Registration.
19. By its conduct, Opposer has committed a fraud upon the USPTO.
20. But for Opposer's fraudulent conduct, the USPTO would not have renewed the '564 Registration.
21. Registration No. 411154 should be cancelled under Section 14 of the Trademark Act, 15 U.S.C. § 1064, because it was maintained by fraud on the USPTO.

Amended Answer at 6 ¶¶ 15-21, 13 TTABVUE 7.

As with Applicant's abandonment claim for the '564 Registration, Applicant does not allege any *facts* supporting these conclusory allegations of nonuse and fraudulent intent. Indeed, the only sentence that does not simply recite the elements of Applicant's claim is the allegation that "Applicant searched online and did not identify any use of SNAP in connection with on-line

social networking services.” *Id.* This allegation is insufficient to support an inference of nonuse, much less fraud. *See Equinix, Inc. v. OnePacket LLC*, Cancellation No. 92069714, slip op., 13 TTABVUE 18 (T.T.A.B. July 2, 2021) (nonprecedential) (unavailability of “advertising or promotional materials, or press coverage” about respondent’s services on “the Google, Bing and Yahoo internet search engines (on September 11, 2019) . . . does not establish Respondent’s lack of use of its mark for a three-year period”); *Toufigh v. Persona Parfum, Inc.*, 95 U.S.P.Q.2d 1872, 1875 (T.T.A.B. 2010) (no *prima facie* case of abandonment where “Petitioner did testify to having checked respondent’s website ‘on more than one occasion’” over a period “spanning merely a few weeks,” but there was “no evidence that he checked over a period of at least three years”); *cf. Buchan v. Livingood*, No. 92043742, 2005 WL 2747604, at \*4 (T.T.A.B. Oct. 19, 2005) (nonprecedential) (on motion for summary judgment, holding that “[t]he mere absence of petitioner’s mark on the Internet in no way satisfies the strict standard necessary to prove abandonment”).

Rule 9(b) requires Applicant to “allege sufficient underlying facts from which [the Board] may reasonably infer that [Snap] acted with the requisite state of mind.” *Exergen Corp. v. Wal-Mart Stores, Inc.*, 91 U.S.P.Q.2d 1656, 1668, 575 F.3d 1312, 1327 (Fed. Cir. 2009). Even if Applicant had sufficiently alleged nonuse (and it has not), Applicant has not alleged any **facts** relating to Snap’s supposed state of mind when it filed its Combined Declaration of Use and Application for Renewal for the ‘564 Registration. *See Bertini v. Apple Inc.*, No. 92068213, 2018 WL 5016953, at \*5 (T.T.A.B. Oct. 9, 2018) (nonprecedential) (“To the extent that Petitioner . . . asserts a claim of fraud based on nonuse of the mark at the time of filing the combined declaration, the Board finds that Petitioner has failed to allege sufficient facts regarding Respondent’s failure to use the mark and the declarant’s knowledge and intent regarding the alleged nonuse” (citing

Fed. R. Civ. P. 9(b))). The Board should dismiss Applicant’s fraud counterclaim for the ‘564 Registration without leave to replead.

**3. Applicant’s Claims that the ‘265 Registration Was Void *Ab Initio* and Fraudulently Procured Remain Insufficiently Pleaded.**

Applicant’s third and fourth counterclaims (previously its second and third) relate to the ‘265 Registration, which Applicant alleges was both void *ab initio* and procured by fraud. The former claim arises out of Section 1(a), under which applicants for registration must demonstrate that their marks are “in use in commerce.” 15 U.S.C. § 1051(a)(3)(C). For service marks, use in commerce occurs when a mark is “used or displayed in the sale or advertising of services and the services are rendered in commerce.” 15 U.S.C. § 1127. “The registration of a mark that does not meet the use requirement is void *ab initio*”—that is, “[n]ull from the beginning.” *Aycock Eng’g, Inc. v. Airflite, Inc.*, 90 U.S.P.Q.2d 1301, 1305 n.9, 560 F.3d 1350, 1357 n.9 (Fed. Cir. 2009) (citation omitted). The latter claim alleges fraudulent procurement.

As with Applicant’s first counterclaim for the ‘564 Registration, Applicant previously based at least its fraudulent procurement claim on the allegations that Snap’s specimen for the ‘265 Registration did not show use of the mark, but the Office nonetheless accepted it. Answer at 7-8 ¶¶ 25, 27-36, 9 TTABVUE 9-10. Having been apprised that this is not a valid ground for cancellation, Applicant stripped the specimen allegations from these counterclaims as well, leaving the following:

23. Opposer has never used, and does not use, the mark SNAP for the Class 42 services in the ‘265 Registration. . . .
26. Opposer submitted a Statement of Use for the ‘265 Registration on August 18, 2020, attesting under penalty of perjury, that the SNAP mark had been first used anywhere and first used in commerce on July 17, 2017 with the following Class 42 services . . . .
27. The Statement of Use declared under penalty of perjury that the representations made in the filing were true.

28. At the time Opposer sought to obtain the ‘265 Registration, Opposer had knowledge that it did not use, nor had it ever used, the SNAP mark in connection with the Class 42 services covered by the ‘265 Registration.
29. In reliance on Opposer’s verified statements, which falsely stated that Opposer used the mark SNAP on the services covered by the ‘265 Registration, the USPTO accepted the Statement of Use approving the application for registration. The Certificate of Registration issued for the ‘265 Registration on July 13, 2021.
30. Opposer has not used the SNAP mark in commerce in connection with the Class 42 services identified in the ‘265 Registration.
31. Opposer intended to mislead the USPTO into accepting the Statement of Use and approving the SNAP mark for registration in Class 42.
32. By its conduct, Opposer has committed a fraud upon the USPTO.
33. But for Opposer’s fraudulent conduct, the USPTO would not have issued the ‘265 Registration.

Amended Answer at 7-8 ¶¶ 23, 26-33, 13 TTABVue 8-9. These allegations merely repackage Applicant’s nonuse and fraud claims for the ‘564 Registration. Not surprisingly, both claims contain nothing but “[t]hreadbare recitals” of Snap’s supposed intent to mislead (which are entirely unsupported), and “mere conclusory statements” of nonuse and fraud. *Iqbal*, 556 U.S. at 678 (quoting *Twombly*, 550 U.S. at 555). As with Applicant’s other claims, these allegations “do not suffice” and are subject to dismissal. *Id.*

In sum, Applicant has *twice failed* to support its nonuse and fraud allegations with facts from which the Board could infer that Snap’s ‘564 and ‘265 Registrations are subject to cancellation. This failure creates an inference that Applicant cannot plausibly allege such facts. Its counterclaims should be dismissed with prejudice.

**B. Applicant’s Estoppel Defense Should Be Stricken as Either Unavailable on these Facts, Nakedly Pleaded, or Both.**

Rule 12(f) empowers the Board to “strike from a pleading an insufficient defense or any redundant, immaterial, impertinent, or scandalous matter” either “on its own” or “on motion made

by a party . . . within 21 days after being served with the pleading.” Fed. R. Civ. P. 12(f), (f)(1), (f)(2). A defense is insufficient when it is not supported by factual allegations in sufficient detail to fairly place the opposer on notice of the basis for the defense. *See IdeasOne, Inc. v. Nationwide Better Health, Inc.*, 89 U.S.P.Q.2d 1952, 1953 (T.T.A.B. 2009); TBMP § 311.02(b)(1) (“The elements of a defense should be stated simply, concisely, and directly. However, the pleading should include enough detail to give the plaintiff fair notice of the basis for the defense.”). Again, those factual allegations must be more than “‘naked assertion[s]’ devoid of ‘further factual enhancement.’” *Iqbal*, 556 U.S. at 678 (quoting *Twombly*, 550 U.S. at 557). The applicant must provide “more than labels and conclusions, and a formulaic recitation of the elements of a [defense] will not do.” *Twombly*, 550 U.S. at 555. Applicant has failed to satisfy these obligations.

As in its original Answer, Applicant’s amended affirmative defense asserts that “Opposer’s claims are barred by estoppel” without any factual explanation. Amended Answer at 3, 13 TTABVUE 4. The equitable defense of estoppel generally is not applicable in opposition proceedings because it runs from the publication date, not the date on which the opposer learns of the use (if any). *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 23 U.S.P.Q.2d 1701, 1703, 971 F.2d 732, 734 (Fed. Cir. 1992) (“As applied in trademark opposition or cancellation proceedings, these defenses [of laches and estoppel] must be tied to a party’s registration of a mark, not to a party’s use of the mark.”); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 U.S.P.Q.2d 1526, 1531 (T.T.A.B. 2008) (“Conduct which occurs prior to the publication of the application for opposition generally cannot support a finding of equitable estoppel.”); *Barbara’s Bakery, Inc. v. Landesman*, 82 U.S.P.Q.2d 1283, 1292 n.14 (T.T.A.B. 2007) (holding amendment to assert laches, acquiescence, and estoppel would be futile).

Applicant has not supported its estoppel defense by alleging *any relevant facts* arising during the four months separating its publication date (April 27, 2021) and the opposition date (August 25, 2021), nor could it hope to do so. In short, as before, Applicant “has done no more than list [this] defense[] by name, and has provided no further facts upon which [it] might plausibly be based.” See *Lodestar Anstalt*, 2017 WL 513974, at \*3. The Board should strike Applicant’s amended affirmative defense.

### III. CONCLUSION

For the foregoing reasons, Applicant has failed for the second time to state plausible counterclaims for cancellation, and its affirmative defense is likewise insufficiently pleaded. Snap therefore respectfully asks the Board to dismiss Applicant’s counterclaims with prejudice and strike Applicant’s affirmative defense from Applicant’s Amended Answer.

This 17th day of February, 2022.

Respectfully submitted,

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**CERTIFICATE OF TRANSMITTAL**

I hereby certify that a true and correct copy of the foregoing SNAP INC.'S MOTION TO DISMISS APPLICANT'S AMENDED COUNTERCLAIMS FOR CANCELLATION AND TO STRIKE APPLICANT'S AMENDED AFFIRMATIVE DEFENSE is being filed electronically with the Trademark Trial and Appeal Board via ESTTA on this, the 17th day of February, 2022.

*/Kris Teilhaber /*  
Kris Teilhaber

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**CERTIFICATE OF SERVICE**

This is to certify that a copy of the foregoing SNAP INC.'S MOTION TO DISMISS APPLICANT'S AMENDED COUNTERCLAIMS FOR CANCELLATION AND TO STRIKE APPLICANT'S AMENDED AFFIRMATIVE DEFENSE has been served on Respondent's counsel, Jacqueline M. Lesser, Baker & Hostetler LLP, 2929 Arch Street, Cira Centre, 12th Floor, Philadelphia, Pennsylvania 19104-2891, by electronic mail to the following email addresses:

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This 17th day of February, 2022.

*/Kris Teilhaber/*  
Kris Teilhaber