

THIS ORDER IS NOT A
PRECEDENT OF THE
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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mbm

February 15, 2024

Opposition No. 91281414

Niccolò Mascaro

v.

Treedefi Ltd

By the Trademark Trial and Appeal Board:

This proceeding now comes before the Board for consideration of Applicant's motion (filed October 31, 2023) to dismiss the second amended notice of opposition for failure to state a claim upon which relief can be granted under Fed. R. Civ. P. 12(b)(6).

The motion is contested.

The Board has considered the parties' briefs on the contested motion, but does not repeat or discuss all of their arguments, except as necessary to explain the Board's order. *Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

I. Background

Applicant seeks to register the standard character mark TREEDEFI on the Principal Register for the following goods and services:¹

- “Computer software platforms, downloadable, for processing and managing blockchain operations; Downloadable computer application software for mobile phones, namely, software for processing and managing blockchain operations via a wallet app; Downloadable computer software for processing and managing blockchain operations; Downloadable computer software for blockchain-based inventory management; Downloadable computer software for managing cryptocurrency transactions using blockchain technology; Downloadable computer software development tools” in International Class 9; and
- “Authentication of data in the field of financial transaction using blockchain technology; Computer programming; Computer software development; Information technology consulting services; Providing temporary use of on-line non-downloadable software for accessing, reading, and tracking information in the field of financial transaction on a blockchain; Software design and development; Platform as a service (PAAS) featuring computer software platforms for managing financial transactions using blockchain; Software as a service (SAAS) services featuring software for managing financial transactions using blockchain” in International Class 42.

On October 26, 2022, Opposer filed a notice of opposition opposing registration of Applicant’s involved mark on the following grounds: nonuse and lack of bona fide intent to use; non-ownership; and fraud.

In lieu of filing an answer, Applicant filed a motion to dismiss for failure to state a claim upon which relief can be granted on December 6, 2022. After obtaining an extension of time, Opposer filed an amended notice of opposition as a matter of course

¹ Application Serial No. 90881203, filed August 13, 2021. Class 9 goods filed pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b) and Class 42 services filed pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

on January 18, 2023. On March 19, 2023, Applicant filed a motion to dismiss the amended notice of opposition for failure to state a claim.

On July 21, 2023, the Board found that Opposer had sufficiently pleaded its entitlement to a statutory cause of action, but that Opposer had failed to plead a legally sufficient ground for opposition. The Board granted Applicant's motion to dismiss the first amended notice of opposition, in part, and provided Opposer leave to amend its claims of nonuse, non-ownership, lack of bona fide intent to use, and fraud.

On August 18, 2023, Opposer filed a second amended notice of opposition that replays its claims of nonuse, non-ownership, and lack of bona fide intent to use. The Board granted Applicant two extensions of time to file an answer or otherwise respond to the second amended notice of opposition. On October 16, 2023, Applicant filed a motion to further extend its time to file an answer or otherwise respond to the second amended notice of opposition up to and including October 30, 2023. 28 TTABVUE.² Opposer did not file a response to the motion to extend and the motion to extend is therefore **granted** as conceded. *See* Trademark Rule 2.127(a).

On October 31, 2023, Applicant filed a motion to dismiss the second amended notice of opposition for failure to state a claim upon which relief can be granted. Inasmuch as Applicant's motion to dismiss was filed one day after the extended deadline, Applicant was in technical default; however, Opposer filed a response to the

² Citations to the record or briefs in this order include citations to the publicly available documents on the Board's electronic docketing system, TTABVUE. The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry, if applicable. The Board expects that the parties will cite to the record using the TTABVUE docketing system throughout this proceeding.

motion to dismiss on November 20, 2023, and the Board therefore considers the technical default waived and addresses the motion to dismiss on the merits. *See generally* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 312.01 (2023) (citing MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69952 (October 7, 2016)).

II. Applicant’s Motion to Dismiss Opposer’s Second Amended Notice of Opposition

To survive a motion to dismiss, “a 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, 663, 129 S. Ct. 1937, 1949 (2009), *quoting Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 5470, 127 S. Ct. 1955, 1974 (2007). A claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw a reasonable inference that the defendant is liable for the misconduct alleged. *See Twombly*, 550 U.S. at 556-57. However, the plausibility standard does not require that a plaintiff set forth detailed factual allegations. *Id.* Rather, a plaintiff need only allege “enough factual matter ... to suggest that [a claim is plausible]” and “raise a right to relief above the speculative level.” *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346, 1354 (Fed. Cir. 2010). Moreover, it is well established that whether a plaintiff can actually prove its allegations is not a matter to be determined upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence. *See Libertyville Saddle Shop Inc. v. E. Jeffries &*

Sons, Ltd., 22 USPQ2d 1594, 1597 (TTAB 1992) (“A motion to dismiss does not involve a determination of the merits of the case...”).

In deciding Applicant’s motion, the Board has given no consideration to the matters that are outside of the pleadings. *See, e.g., Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1255-56 (TTAB 2009); TBMP § 503.04. Additionally, the Board has not considered arguments that go to the merits of the case and whether Opposer ultimately will be able to prove its allegations. *See, e.g., Advanced Cardiovascular Sys. Inc.*, 26 USPQ2d at 1041; *Covidien LLP v. Masimo Corp.*, 109 USPQ2d 1696, 1697 n.3 (TTAB 2017); *Scotch Whiskey Assos. v. U.S. Distilled Prods. Co.*, 18 USPQ2d 1391, 1393 (TTAB 1991).

A. Entitlement to a Statutory Cause of Action

The allegations supporting Opposer’s pleading of its entitlement to a statutory cause of action are substantively identical to the allegations in the first amended notice of opposition. For the same reasons set forth in the Board’s July 21, 2023 order, the Board finds that Opposer has sufficiently pleaded its entitlement to a statutory cause of action. 24 TTABVUE 4-6.

B. Non-Ownership as to Class 42

“[I]f the [person] filing the application is not the owner of the mark as of the filing date, the application is void ab initio.” *Great Seats, Ltd. v. Great Seats, Inc.*, 84 USPQ2d 1235, 1239 (TTAB 2007).

In support of its claim that Applicant is not and was not the owner of the involved mark for the identified services in Class 42 at the time the application was filed,

Opposer alleges, inter alia, the following: (1) that Opposer is the owner of the TREEDEFI mark and has common law rights in the mark; (2) that Opposer developed the services offered under the involved TREEDEFI mark “in collaboration with other individuals including Gheorhe Daniel Morosan and Lorenzo Castagnone;” (3) that Morosan and Castagnone formed Applicant TreeDeFi Ltd. without Opposer’s knowledge and filed the involved application; (4) that Morosan and Castagnone edited a portion of the source code to identify TreeDeFi Ltd. as the “license holder” for the website, but that no such license exists; (5) that after the involved application was filed, the parties reached an agreement whereby Opposer “would be the sole owner of TreeDeFi.” 24 TTABVue 3-6, second amended notice of opposition ¶¶ 2, 4-10.

These allegations are sufficient to allege a claim that Applicant is not and was not the rightful owner of the mark as of the filing date with respect to the Class 42 services. In its motion to dismiss, Applicant relies on documents outside the pleading and requests that the Board take judicial notice of, among other things, a copy of the Software Package Data Exchange License for the website to purportedly demonstrate that Applicant, in fact, is the owner of the mark.³ These arguments and evidence are improper for consideration on a motion to dismiss for failure to state a claim under Fed. R. Civ. P. 12(b)(6), which is solely a determination of the sufficiency of the

³ Additionally, Applicant cites to various Internet materials by providing the hyperlink to the website. “The Board does not accept Internet links as a substitute for submission of a copy of the resulting page.” *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1790 n.15 (TTAB 2018); *In re Olin Corp.*, 124 USPQ2d 1327, 1332 n.15 (TTAB 2017) (“Because the information displayed at a link’s Internet address can be changed or deleted, merely providing a link to a website is insufficient to make information from that site of record.”).

pleadings. *Libertyville Saddle Shop Inc.*, 22 USPQ2d at 1597. Nor will the Board consider material outside the pleadings on a motion to dismiss. Where a motion styled as one to dismiss involves a determination of the merits of the case or relies on matter outside the pleadings, the Board may construe the motion as one for summary judgment. In order to move for summary judgment, however, a party must have served its initial disclosures prior to its motion for summary judgment, unless the motion is based upon a claim of issue or claim preclusion or lack of jurisdiction. Trademark Rule 2.127(e). Applicant has not yet filed its answer and there is no indication that Applicant has served initial disclosures. Thus, to the extent Applicant's motion could have been construed as a motion for summary judgment, such motion would have been premature.

In view of the foregoing, Applicant's motion to dismiss is **denied** with respect to the claim of non-ownership.

C. Nonuse as to Class 42

The services in Class 42 were filed under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). An application filed under Section 1(a) of the Trademark Act is void ab initio where it is found that there was no use of the mark in commerce on the identified goods or services prior to the filing date of the application. *See Couture v. Playdom, Inc.*, 778 F.3d 1379, 113 USPQ2d 2042, 2043 (Fed. Cir. 2015) ("To apply for registration under Lanham Act § 1(a), a mark must be 'used in commerce.' 15 U.S.C. § 1051(a)(1). ... Use in commerce must be 'as of the application filing date.' 37 CFR § 2.34(a)(1)(i),” and “The registration of a mark that does not meet the use [in

commerce] requirement is void ab initio.”), *citing Aycock Engineering Inc. v. Airflite Inc.*, 560 F.3d 1350, 90 USPQ2d 1301, 1305 (Fed. Cir. 2009).

In its second amended notice of opposition, Opposer alleges that at the time Applicant filed the involved application, Applicant was not using the involved mark in connection with the use-based Class 42 services, and that the specimen submitted with the application is a screenshot of Opposer’s website. 24 TTABVUE 7-9, second amended notice of opposition ¶¶ 13-15, 20. These allegations are sufficient to allege a claim of nonuse as of the filing date of the involved application with respect to the Class 42 services.⁴

In view of the foregoing, the motion to dismiss is **denied** with respect to the claim of nonuse.

D. Lack of Bona Fide Intent to Use as to Class 9

Class 9 of the involved application was filed under Trademark Act Section 1(b), which applies to applications to register trademarks based on an applicant’s assertion of a bona fide intent to use the mark in commerce. An application under Section 1(b) requires a verified statement that the applicant believes it is entitled to use the mark in commerce. *See* 15 U.S.C. § 1051(b)(3)(A). The Federal Circuit has found that lack of bona fide intent is a proper ground on which an opposer may challenge a trademark application. *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 1375, 114 USPQ2d 1892,

⁴ To be clear, the allegations concerning the specimen submitted with the application are considered factual support for the claim of nonuse. The adequacy of the specimen submitted with an application is a matter of ex parte examination and is not a separate ground for opposition. *See Granny’s Submarine Sandwiches, Inc. v. Granny’s Kitchen, Inc.*, 199 USPQ 564, 567 (TTAB 1978).

1897 (Fed. Cir. 2015). *See also American Forests v. Barbara Sanders*, 54 USPQ2d 1860, 1862 (TTAB 1999).

To state a claim of lack of bona fide intent to use, “an opposer only has to notify the applicant of the general ‘circumstances, occurrences, and events’ causing the flaw in the application.” *Aktieselskabet Af 21 November 2001 v. Fame Jeans Inc.*, 525 F.3d 8, 86 USPQ2d 1527, 1538 (D.C. Cir. 2008) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. at 555 n.3 (2007)). “Although the complaint need not go into detail, it must at least notify the applicant of how the general circumstances fail to show intent.” *Id.* *See also Fair Indigo LLC*, 85 USPQ2d at 1539 (finding allegation that Applicant lacked the requisite bona fide intent coupled with allegation of a lack of documentary evidence sufficient to plead a claim of lack of bona fide intent to use).

The Board finds that Opposer has sufficiently pleaded its claim of lack of bona fide intent with respect to the Class 9 goods based on its allegation that at the time Applicant filed the involved application, Applicant was aware that Opposer was the owner of the involved mark and that Applicant therefore lacked a bona fide intent to use the involved mark in connection with the Class 9 goods.

In view of the foregoing, the motion to dismiss is **denied** with respect to the claim of lack of a bona fide intent to use.

III. Schedule

Proceedings are resumed. Applicant is allowed until **March 6, 2024** to file and serve an answer to the second amended notice of opposition. Dates are reset as follows:

Time to Answer	3/6/2024
Deadline for Discovery Conference	4/5/2024
Discovery Opens	4/5/2024
Initial Disclosures Due	5/5/2024
Expert Disclosures Due	9/2/2024
Discovery Closes	10/2/2024
Plaintiff's Pretrial Disclosures Due	11/16/2024
Plaintiff's 30-day Trial Period Ends	12/31/2024
Defendant's Pretrial Disclosures Due	1/15/2025
Defendant's 30-day Trial Period Ends	3/1/2025
Plaintiff's Rebuttal Disclosures Due	3/16/2025
Plaintiff's 15-day Rebuttal Period Ends	4/15/2025
Plaintiff's Opening Brief Due	6/14/2025
Defendant's Brief Due	7/14/2025
Plaintiff's Reply Brief Due	7/29/2025
Request for Oral Hearing (optional) Due	8/8/2025

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

IMPORTANT TRIAL AND BRIEFING INSTRUCTIONS

Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Such briefs should utilize citations to the TTABVue record created during trial to facilitate the Board's review of the evidence at final hearing. *See* TBMP § 801.03. 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).

TIPS FOR FILING EVIDENCE, TESTIMONY, OR LARGE DOCUMENTS

The Board requires each submission to meet the following criteria before it will be considered: 1) pages must be legible and easily read on a computer screen; 2) page orientation should be determined by its ease of viewing relevant text or evidence, for example, there should be no sideways or upside-down pages; 3) pages must appear in their proper order; 4) depositions and exhibits must be clearly labeled and numbered – use separator pages between exhibits and clearly label each exhibit using sequential letters or numbers; and 5) the entire submission should be text-searchable. Additionally, submissions must be compliant with Trademark Rules 2.119 and 2.126. Submissions failing to meet all of the criteria above may require re-filing. **Note:** Parties are strongly encouraged to check the entire document before filing.⁵ The Board will not extend or reset proceeding schedule dates or other deadlines to allow time to re-file documents. For more tips and helpful filing information, please visit the [ESTTA help](#) webpage.

⁵ To facilitate accuracy, ESTTA provides previews of each page before submitting.