

ESTTA Tracking number: **ESTTA627326**

Filing date: **09/16/2014**

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

| | |
|------------------------|--|
| Proceeding | 92059780 |
| Party | Defendant F.C. Franchising Systems, Inc. |
| Correspondence Address | FC FRANCHISING SYSTEMS INC SUITE 300 , 10700 MONTGOMERY ROAD CINCINNATI, OH 45242 UNITED STATES |
| Submission | Motion to Dismiss - Rule 12(b) |
| Filer's Name | Thomas M. Williams |
| Filer's e-mail | twilliams@ulmer.com,mmarrero@ulmer.com,mrink@ulmer.com,dblanton@ulmer.com |
| Signature | /Thomas M. Williams/ |
| Date | 09/16/2014 |
| Attachments | Motion to Dismiss.pdf(13983 bytes) |

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

| | | |
|--------------------------------|---|-----------------------------|
| FRESHCOAT SERVICES, LLC |) | |
| |) | |
| Petitioner, |) | Cancellation No. 92/059,780 |
| |) | |
| vs. |) | Mark: FRESH COAT PAINTING |
| |) | DONE RIGHT |
| F.C. FRANCHISING SYSTEMS, INC. |) | |
| |) | Registration No. 4,581,589 |
| Respondent. |) | |
| |) | |

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

MOTION TO DISMISS

Respondent, FC Franchising Systems, Inc. (“Respondent” or “FC”), through its undersigned counsel, hereby moves to dismiss Count II of the above-captioned Petition for Cancellation filed by Freshcoat Services, LLC (“Petitioner”) for failure to state a claim. Specifically, Petitioner’s purported fraud claim (Count II) fails to state a claim upon which relief can be granted. *See* Fed. R. Civ. P. 12(b)(6); 37 C.F.R. § 2.127(d).

I. FACTUAL BACKGROUND

Petitioner seeks to cancel Respondent’s Principal Register registration for the mark FRESH COAT PAINTING DONE RIGHT (Reg. No. 4,581,589). The Petition for Cancellation purports to allege two grounds for cancellation: (1) priority and likelihood of confusion under Section 2(d) (Count I), and (2) fraud (Count II). *See* Dkt. #1, Petition. The fraud count, Count II, appears in Paras. 25-30. Although Count II incorporates the previous Paragraphs in the Petition by reference, the Petition is completely devoid of any underlying facts supporting Petitioner’s fraud claim.

The Petition alleges that “Registrant made a false representation to the U.S.P.T.O. in the registration of Registrant’s FRESH COAT Mark.” *Id.* at Para. 26. However, the Petition does not identify the allegedly “false representation.” Nor does it identify who made the false statement, when it was made, or in what context. Without this information, Respondent is unable to answer the fraud allegation.

II. LEGAL ARGUMENT

“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.*, 91 U.S.P.Q.2d 1938, 1939 (Fed. Cir. 2009) (quotations omitted). Rule 9(b) applies to fraud claims asserted in proceedings before the Board. As a result, fraud claims must be pleaded with particularity. *See King Auto, Inc. v. Speedy Muffler King, Inc.*, 212 U.S.P.Q. 801, 803 (C.C.P.A. 1981).

According to Rule 9(b): “In alleging fraud or mistake, a party must state with particularity the circumstances constituting fraud or mistake.” Fed. R. Civ. P. 9(b). This requires the pleader to allege the “who, what, when, where and how” of the alleged fraud. *Exergen Corp. v. Wal-Mart Stores, Inc.*, 91 U.S.P.Q.2d 1656, 1670 (Fed. Cir. 2009) (cited in T.B.M.P. § 309.03(c) n.33).

Petitioner’s fraud claim falls far short of the mark. It does not allege any of the requisite “who, what, when, where [or] how” facts. It merely alleges that “Registrant made a false representation to the USPTO in the registration of Registrant’s FRESH COAT Mark.” *See* Dkt. #1, Petition at Para. 26. It does not allege “who” made the alleged false statement, “what” the statement was, “when” it was made, or “where [or] how” it was made. *See Exergen*, 91 U.S.P.Q.2d at 1670. As a result, the Petition fails to meet the pleading requirements for fraud on

the U.S.P.T.O. Count II of the Petition must be dismissed pursuant to Fed. R. Civ. P. 12(b)(6).
See GMA Accessories, Inc. v. Dorfman-Pacific Co., No. 91/196,926, 2011 WL 12303167 at *6
(T.T.A.B. Aug. 26, 2011) (granting motion to dismiss fraud counterclaim) (not precedential).

III. CONCLUSION

Respondent respectfully request the Board to dismiss Count II of the Petition, which purports to allege fraud on the U.S.P.T.O. The count fails to satisfy the particularity requirements of Rule 9(b).

Date: September 16, 2014

Respectfully submitted,

/s/ Thomas M. Williams/
One of the Attorneys for
FC Franchising Systems, Inc.

Thomas M. Williams
Ulmer & Berne, LLP
500 West Madison Street
Suite 3600
Chicago, IL 60661
Telephone (312) 658-6556
Facsimile (312) 658-6557
twilliams@ulmer.com

Michael A. Marrero
Ulmer & Berne LLP
600 Vine Street, Suite 2800
Cincinnati, Ohio 45202-2409
Tel: (513) 698-5078
Fax: (513) 698-5079
mmarrero@ulmer.com

CERTIFICATE OF SERVICE

On September 16, 2014, I served the foregoing **MOTION TO DISMISS** on the parties in said action by depositing a true copy thereof with the United States Postal Service as first class mail, postage prepaid, at Chicago, Illinois, enclosed in a sealed envelope addressed to counsel of record for Petitioner as follows:

Brent D. Sausser
The Law Firm of Sausser & Spurr, LLC
2 Rosedale Drive
Charleston, SC 29407
info@sausserspurrllaw.com,
bsausser@sausserspurrllaw.com

Dated: September 16, 2014

By: /s/ Thomas M. Williams
Thomas M. Williams