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

Proceeding	92065178
Party	Defendant The General Conference Corporation of Seventh-day Adventists
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Attachments	Exhibit 1.pdf(102088 bytes) Motion to Dismiss Amended Petition 4847-8053-2042 v.1.pdf(74191 bytes)

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

Philanthropist.com, Inc.,)	
)	
Petitioner)	
)	
v.)	Cancellation No. 92065178
)	
The General Conference Corporation)	
of Seventh-Day Adventists,)	
)	
Registrant)	

REGISTRANT’S MOTION TO DISMISS
PETITIONER’S AMENDED PETITION FOR CANCELLATION

Pursuant to Fed. R. Civ. P. 12(b)(6) and TBMP §503, Registrant The General Conference Corporation of Seventh-Day Adventists (“Registrant”) hereby moves to dismiss the Amended Petition for Cancellation (the “Amended Petition”) filed by Petitioner Philanthropist.com, Inc. (“Petitioner”).

I. INTRODUCTION

Petitioner’s Amended Petition still fails to set forth a claim upon which relief can be granted, since Petitioner has once again failed to explain how it has standing to seek cancellation of Registrant’s U.S. Reg. Nos. 1,176,153 and 1,218,657. Furthermore, the Amended Petition was not filed under after the deadline set by the Board in its Order, and fails to comply with the Board’s clear and unambiguous rules regarding the form and substance of pleadings in *inter partes* actions.

Therefore, the Board should grant this Motion and dismiss the Amended Petition. Furthermore, since Petitioner has already been given the opportunity to correct the defects in the

original Petition and failed to do so, Petitioner should not be given another opportunity to amend its pleading and the Amended Petition should be dismissed with prejudice.

II. STATEMENT OF FACTS

Petitioner Philanthropist.com, Inc. is a “cybersquatter” or domain name pirate that acquires domain names containing trademarked terms belonging to others and then attempts to sell them to the rightful owner for sums far exceeding Petitioner’s acquisition costs. Although Petitioner attempts to characterize its business as only involving the acquisition and sale of “generic” domain names, Petitioner is currently offering for sale multiple domain names containing registered trademarks, such as <maryclaire.com>¹, <valleybank.com>², <communitybankofthesouth.com>³, <thenationsnewspaper.com>⁴, and others.

Registrant is the entity established to hold title to the assets of the Seventh-Day Adventist Church, one of the largest religious bodies in the world with a total congregation of over 19.1 million persons. Registrant owns numerous U.S. and worldwide trademark registrations for marks consisting of or containing ADVENTIST, including U.S. Reg. Nos. 1,176,153 and 1,218,657 for the mark ADVENTIST. Registrant and its predecessors in interest have used these marks in the United States in connection with various goods and services since at least as early as 1860, and have built up a significant amount of established goodwill and consumer recognition in the ADVENTIST mark.

In June of 2016, as part of its cybersquatting business, Petitioner acquired the domain name <adventist.com>. Petitioner immediately listed this domain name for sale with an asking

¹ Marie-Claire Album S.A. owns numerous registrations for the mark MARIE CLAIRE, including U.S. Reg. Nos. 838,440; 1,224,181; 1,949,940; and many others.

² VALLEY BANK is a registered trademark of River Valley Bancorp, Inc. (U.S. Reg. No. 3,306,637).

³ COMMUNITY BANK OF THE SOUTH is a registered trademark of Community Bank of the South (U.S. Reg. No. 4,108,235).

⁴ THE NATION’S NEWSPAPER is a registered trademark of Gannett Co. (U.S. Reg. No. 1,399,353).

price of \$1.2 million. Petitioner stated on its web site that this asking price was due to the high “business brandability” of the domain name.

On December 8, 2016, Registrant filed a complaint with the National Arbitration Forum under the Uniform Domain Name Resolution Procedure (“UDRP”) seeking to have Petitioner’s <adventist.com> domain name transferred to Registrant. On January 13, 2017, Petitioner filed the original Petition for Cancellation in this case (the “Original Petition”), in an effort to gain leverage against Registrant in the pending UDRP proceeding and attempt to force Registrant to withdraw the UDRP complaint. However, on January 24, 2017, the Forum issued a decision denying Registrant’s complaint. Registrant has not taken or threatened any further action against Petitioner.

The Original Petition alleged claims of descriptiveness, genericness, failure to function as a mark, and fraud. Registrant filed a Motion to Dismiss on February 21, 2017, arguing that i) that Petitioner had failed to plead standing; ii) that Petitioner’s descriptiveness claim was barred due to the incontestability of Registrant’s registrations; iii) that Petitioner’s claim for “failure to function as a mark” was a redundant and unnecessary restating of its genericness claim; and iv) that Petitioner had failed to adequately plead fraud.

The Board agreed with Petitioner and granted Petitioner’s Motion to Dismiss in an Order dated May 1, 2017 (the “Order”). However, the Board allowed Petitioner a period of 30 days (i.e. until May 31, 2017) to file an Amended Petition. Petitioner did not file the Amended Petition until June 1, 2017, one day after the Board’s deadline as set forth in the Order.

III. PETITIONER’S AMENDED PETITION FOR CANCELLATION WAS NOT TIMELY FILED

Petitioner’s Amended Petition for Cancellation should be dismissed on both procedural and substantive grounds. First, the Amended Petition must be dismissed because it was not

timely filed. The Board's Order dismissing the Original Petition allowing Petitioner an opportunity to file an amended pleading was first mailed on May 1, 2017. Order, at 1. Petitioner acknowledged this mailing date in the Amended Petition. *See* Amended Petition, at 1 ("In accordance with the Board's May 1, 2017 Order..."). The Order allowed Petitioner 30 days from the mailing date of the Order to file an amended pleading, i.e. until **May 31, 2017**, "failing which the original petitions will be **dismissed with prejudice**." (Order, at 13) (emphasis added). However, the Amended Petition for Cancellation was not filed until June 1, 2017, the day after the deadline set by the Board in its Order.⁵

Petitioner has not argued that its failure to comply with the Board's Order constituted "excusable neglect," nor has it offered any other justification for its failure to comply with this deadline. Petitioner may attempt to argue that its delay was only one day and that this may not cause prejudice to Registrant or delay the resolution of the case. However, the Board has its rules for a reason and they must be upheld in order to ensure that others follow them in the future. "While our law clearly favors resolution of disputes on their merits, [the Board] cannot condone" failure to comply with its rules. *DeLorme Publ'g Co. v. Eartha's Inc.*, 60 USPQ2d 1222, 1224 (TTAB 2001).

Therefore, the Amended Petition should be dismissed on this basis alone, without any further consideration of the merits. Moreover, the Board should not give Petitioner any further opportunities to submit an amended Petition, as Petitioner has already been given a second chance and the Board's Order expressly provided for dismissal with prejudice if Petitioner failed to comply.

⁵ May 31, 2017 was a Wednesday and was not a Federal holiday, so there is no justification for Petitioner waiting until the next business day to submit the Amended Petition.

IV. PETITIONER'S AMENDED PETITION FOR CANCELLATION DOES NOT COMPLY WITH THE BOARD'S RULES

Petitioner's Amended Petition for Cancellation should also be dismissed because it does not comply with the Board's clear and unambiguous rules for the form and content of pleadings. The TBMP states that a Petition for Cancellation must contain a short and plain statement of the reason(s) why the Petitioner believes it is or will be damaged by the registration sought to be cancelled and the grounds for cancellation. TBMP §309.03(a)(2); *see also* Fed. R. Civ. P. 8(a). It also provides that "all averments should be made in numbered paragraphs, the contents of each of which should be limited as far as practicable to a statement of a single set of circumstances." TBMP §309.03(a)(2) (citing Fed. R. Civ. P. 10(b)).

In this case, however, the majority of the Amended Petition consists of lengthy paragraphs of legal argument, including case citations. It is impossible to distinguish between what Petitioner intends to be operative factual allegations and mere attorney statements. *Cf. Christiane E, LLC v. International Expeditions, Inc.*, 106 U.S.P.Q.2d 2042, 2044 (TTAB 2013) (attorney statements in brief or motion are not evidence) (citations omitted). Petitioner does not begin numbering paragraphs until Page 5, and even then, the numbered paragraphs are not limited to "a statement of a single set of circumstances," as required by both the TBMP and the Federal Rules, but instead contain numerous irrelevant assertions and citations to case law and treatises.

Under these circumstances, it is impossible for Registrant to prepare an Answer that would comply with the Board's rules, since Registrant cannot respond in the form of short, numbered paragraphs if the original pleading is not in this form. Moreover, as discussed above, Registrant cannot even ascertain which of the wide-ranging statements constitute factual

allegations and therefore it cannot properly respond as required by Fed. R. Civ. P. 8(b). Therefore, the Petition must be dismissed.⁶ See *Isle of Aloe, Inc. v. Aloe Creme Laboratories, Inc.*, 180 USPQ 794, 796 (TTAB 1974) (striking Notice of Opposition which did not contain single paragraphs limited to a single set of circumstances); see also *Stanard v. Nygren*, 658 F.3d 792, 798 (7th Cir.2011) (“[T]he issue is notice; where the lack of organization and basic coherence renders a complaint too confusing to determine the facts that constitute the alleged wrongful conduct, dismissal [under Fed. R. Civ. P. 8 and 10] is an appropriate remedy.”); *Pinnavaria v. C-Phone*, No. O1 C 50341, 2002 WL 575699, at *1 (N.D. Ill. Apr. 12, 2002) (striking a complaint, *sua sponte*, for failure to comply with Fed. R. Civ. P. 8(a) and 10(b) where failure to number paragraphs made complaint too difficult for defendant to respond).

Furthermore, as explained in Section III above, the dismissal should be with prejudice as Petitioner has already had multiple opportunities to file a pleading that complies with the Board’s rules. Petitioner is not appearing pro se and is represented by experienced counsel, so there is no justification for Petitioner’s failure to comply with the Board’s clear and unambiguous rules. Moreover, Petitioner is clearly aware of the requirement to set forth its allegations in numbered paragraphs, as it did so in its original Petition for Cancellation in this proceeding.

V. PETITIONER HAS AGAIN FAILED TO ESTABLISH STANDING

Finally, even if the Board disregards Petitioner’s late filing and its failure to follow the Board’s rules by filing an intelligible pleading, Petitioner has still failed to explain how it has standing to bring this proceeding. The Amended Petition still does not set forth any real interest in the proceeding or a reasonable basis for Petitioner’s purported belief that it will be damaged

⁶ The Board has in some cases stricken non-complying pleadings under TBMP §506 and Fed. R. Civ. P. 12(f) rather than dismissing them under TBMP §503 and Fed. R. Civ. P. 12(b). If the Board believes that striking Petitioner’s non-complying Amended Petition would be a more appropriate remedy than dismissal in this case, Petitioner requests that the Board treat this Motion as a Motion to Strike under TBMP §506.

by the continued registration of Registrant's mark. Therefore, the Amended Petition must also be dismissed for failure to properly plead standing.

As set forth in the prior Motion to Dismiss, in order to establish standing, Petitioner must demonstrate both "a real interest in the proceedings as well as a 'reasonable' basis for [its] belief of damage." *Ritchie v. Simpson*, 170 F.3d 1092, 1095 (Fed. Cir. 1999). In order to establish a "real interest," Petitioner must show that it has a "direct and personal stake" in the outcome herein and is more than a "mere intermeddler." *Id.* "A party does not gain standing before the Board by virtue of the mere subjective 'belief that a trademark violates rights under Trademark Act [Section] 14' ...[T]he belief in damage resulting from registration must be *objectively* reasonable." *NSM Resources Corp. and Huck Doll LLC v. Microsoft Corp.*, 113 U.S.P.Q.2d 1029, 1033 (TTAB 2014).

In the original Petition, Petitioner alleged that it had standing because i) Petitioner owned the domain name <adventist.com>, which contains Registrant's ADVENTIST Mark; and ii) Registrant had filed a UDRP domain name dispute against Petitioner regarding the <adventist.com> domain name. However, the Board correctly found that these assertions were not sufficient to establish standing.

Petitioner now claims that it has standing because of i) a letter sent by Registrant to Petitioner in November of 2016; and ii) the alleged "negative market impact" that Registrant's actions have had upon the value of Petitioner's <adventist.com> domain name. However, these allegations are still not sufficient to demonstrate a "direct and personal stake" in the outcome of the proceeding and an objectively reasonable basis for Petitioner's purported belief that it will be damaged by the continued registration of Registrant's Mark.

First, with regard to the November 2016 letter, Registrant has already taken the legal action that it threatened in that letter by filing the UDRP complaint against the <adventist.com> domain name on December 9, 2016. That case has already been decided and the appeal period has expired. Registrant has not taken or threatened any further legal action since the UDRP case was concluded. Therefore, Petitioner does not have any “objectively reasonable” belief that Registrant will take any legal action against Petitioner with regard to Petitioner’s <adventist.com> domain name. Furthermore, even if Registrant had threatened additional legal action, this would not be enough by itself to establish standing. *See Continental Specialties Corp. v. Continental Connector Corp.*, 192 U.S.P.Q. 449, 452 (TTAB 1976) (“[I]t is well settled that the threat of a suit for infringement...does not by itself constitute damage within the meaning of Section 13 of the Trademark Act.”).

Petitioner’s only other allegation as to why it has standing is the alleged negative impact that Registrant’s ownership of the ADVENTIST trademark will have upon the market value of Petitioner’s <adventist.com>. However, this allegation is based on pure speculation and is not an “objectively reasonable” basis for a belief of likely damage. Petitioner has not alleged that it has tried and failed to sell the domain name, or that potential buyers of the domain name have expressed concern about Registrant’s ownership of the ADVENTIST mark. In fact, Petitioner’s web site still prominently advertises the domain name as “a hand-picked premium domain name” and claims that its “brandability is very high.” Exhibit 1.

Petitioner’s hypothetical speculation that the market value of its domain name might somehow be damaged by Registrant’s continued ownership of the ADVENTIST mark is clearly not an objectively reasonable basis for believing that Petitioner is being directly damaged by the registration of U.S. Reg. Nos. 1,176,153 and 1,218,657. Under Petitioner’s logic, any “mere

intermeddler” could obtain standing to cancel another party’s trademark merely by paying the minimal registration fee (often less than \$10) to register a domain name containing that mark. This is clearly not what the Federal Circuit intended when it held that a party seeking to cancel another’s mark must have a “direct and personal stake” in the continued registration of the mark. *Ritchie*, 170 F.3d at 1095.

In its decision granting Registrant’s original Motion to Dismiss, the Board was clear that in order to demonstrate standing to cancel Registrant’s mark on the basis of alleged genericness, Petitioner would need to allege that it offers the same or related goods or services as those of Registrant, or that it has a legitimate need to use the ADVENTIST mark in a descriptive or generic manner in connection with its business:

[Petitioner] does not allege that it manufactures, offers, or sells goods and services that are the same as or similar to, or within the normal expansion of, the goods and services which Respondent offers or that business in which Respondent operates; nor does Petitioner allege a commercial or business need to use the mark ADVENTIST for business purposes which include or encompass Respondent’s identified goods and services...Petitioner does not allege that it needs to use the term ADVENTIST descriptively in being able to carry out its business as a domainer, or that it *has* made use of the mark ADVENTIST, or of a mark that includes the term, descriptively or otherwise, as a trademark or as a trade name for its domainer business.

Order, at 7; *see also Sheetz of Delaware, Inc. v. Doctors Associates Inc.*, 108 U.S.P.Q.2d 1341, 1350 (TTAB 2013) (explaining that in order to establish standing to oppose or cancel the registration of an allegedly generic mark, plaintiff must show that it is “engaged in the manufacture or sale of the same or related goods as those listed in the applicant’s application; that is, that plaintiff has the right to use the term in a descriptive or generic manner”); *Bison Designs LLC v. Tough Gear, Inc.*, Opp. No. 91201036, at *12-13 (TTAB Feb. 5, 2015) (dismissing opposition for failure to allege standing where opposer “fail[ed] to allege, for example, that Opposer is engaged in the sale of the same or related products and that the Opposer

has an interest in using the term SURVIVAL BRACELET descriptively or generically in its business”); J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, at §20:50 (4th Ed. 2004) (“To obtain standing to cancel on the ground that the registered mark is descriptive or generic, petitioner must plead and prove that the registration is inconsistent with petitioner’s equal right to use the term on similar goods as a descriptive or generic designation.”).

Petitioner has still not claimed that it offers any of the same goods and/or services covered by Registrant’s U.S. Reg. Nos. 1,176,153 and 1,218,657, or that it has any legitimate need to use the term ADVENTIST descriptively or generically in its business. Therefore, Petitioner has failed to establish that it has any basis for seeking cancellation of Registrant’s mark on the ground of genericness.

VI. CONCLUSION

For the reasons set forth above, Registrant respectfully requests that the Board dismiss the Amended Petition with prejudice.

Respectfully submitted,

By:  _____

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Date: June 29, 2017

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing REGISTRANT'S MOTION TO DISMISS PETITIONER'S AMENDED PETITION FOR CANCELLATION was served this 29th day of June, 2017, by e-mail only:

Eve J. Brown
Bricolage Law, LLC
1193 Walnut Street, Suite #6
Newton, Massachusetts 02461



Connie Fuentes

4847-8053-2042, v. 1

Exhibit 1

† Adventist.com

Adventist.com is for sale

MAKE OFFER



Submit Best Offer

 Make Offer

QUICK FACTS

Invest in this premium domain name and take your marketing strategy to the next level.

- ✓ Adventist.com is a "hand-picked" premium domain name
- ✓ The original creation date for this name was 09/25/1998
- ✓ Religion brandability is very high for Adventist.com
- ✓ Domain length is 9 characters and TLD extension is ".com"
- ✓ Buy with confidence, payments secured by Escrow.com
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