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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
Correspondence Address	BASSAM N IBRAHIM BUCHANAN INGERSOLL & ROONEY PC 1737 KING STREET, SUITE 500 ALEXANDRIA, VA 22314-1404 UNITED STATES SaundersA@gc.adventist.org, bassam.ibrahim@bipc.com
Submission	Reply in Support of Motion
Filer's Name	Bassam N. Ibrahim
Filer's e-mail	bassam.ibrahim@bipc.com
Signature	/Bassam N. Ibraihm//s/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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Philanthropist.com, Inc.,	)	
	)	
Petitioner	)	
	)	
v.	)	Cancellation No. 92065178
	)	
The General Conference Corporation	)	
of Seventh-Day Adventists,	)	
	)	
Registrant	)	

**REGISTRANT’S REPLY BRIEF IN SUPPORT OF ITS MOTION TO DISMISS**

Pursuant to TBMP §502.02(b), Registrant The General Conference Corporation of Seventh-Day Adventists (“Registrant”) hereby submits its reply brief in support of its Motion to Dismiss (“Registrant’s Motion) the Petition for Cancellation filed by Petitioner Philanthropist.com, Inc. (“Petitioner”).

**I. INTRODUCTION**

Petitioner has failed to explain in its response brief (“Petitioner’s Brief”) why its Petition should not be dismissed. The Petition does not allege any specific basis for standing other than a prior UDRP case between the parties which has already been decided. Petitioner argues in its Brief that it still has standing because there is “no guarantee” that Registrant will not take further action against Petitioner in the future, but this type of vague and hypothetical assertion does not satisfy the requirement that a Petitioner must have a “real interest” in the proceeding at the time of filing.

Petitioner has also failed to show that its Second, Third, and Fourth Causes of Action are sufficiently pled to allege actionable claims for cancellation. Petitioner has not even responded

to Registrant's arguments regarding the Second and Third Causes of Action (descriptiveness and "failure to function as a mark") and has essentially conceded that these claims should be dismissed. Petitioner apparently also does not understand that a fraud claim (Petitioner's Fourth Cause of Action) must be pleaded with a significantly higher level of detail and particularity than other claims, including specific allegations of false statements and an intent to deceive the USPTO, neither of which is adequately set forth in the Petition for Cancellation.

Therefore, Petitioner's entire Petition should be dismissed for failure to allege standing, or, in the alternative, Petitioner's Second, Third, and Fourth Causes of Action must be stricken from the Petition.

## **II. PETITIONER HAS FAILED TO ESTABLISH STANDING**

Petitioner has admitted that a party seeking to bring a cancellation proceeding must demonstrate both a "real interest" in the proceeding and a "reasonable" basis for its belief that it will be damaged. Petitioner's Brief, at 1-2. However, Petitioner has failed to explain how the allegations set forth in the Petition for Cancellation demonstrate either a real interest or an objective reasonable basis for believing that Petitioner will be damaged.

Petitioner has acknowledged that the UDRP proceeding regarding the ADVENTIST.COM domain name, which was pending at the time Petitioner filed the Petition, has now been resolved. However, Petitioner now claims that "there is certainly no guarantee that Petitioner's registered domain will remain free from future challenges by Registrant." Petitioner's Brief, at 3.

Petitioner's argument that Registrant may again try to challenge Petitioner's ownership of the ADVENTIST.COM domain name in the future is purely hypothetical and does not suffice to establish Petitioner's standing to bring this proceeding. The threshold for standing requires a

real current interest, not merely a possibility that the party bringing the proceeding may have an interest at some point in the future. Petitioner has not alleged that Registrant has threatened to bring further proceedings affecting the domain name or has made any statements or actions since the decision in the UDRP case which might reasonably suggest that Petitioner intends to take further action against the domain name.

Furthermore, the Motion to Dismiss must be decided based upon the averments set forth in the Petition, and not upon new arguments that are raised for the first time in the Petitioner's response brief. To the extent that the allegations in the Petition for Cancellation set forth any argument for standing, this argument is based upon the now-decided UDRP action. *See* Petition, at ¶15 ("Petitioner has standing to bring this action based on Registrant's assertion of the challenged registration against Petitioner in a pending dispute before the National Arbitration Forum."). This argument is obviously now moot. If Petitioner wanted to allege standing based upon the possibility of future action by Registrant against Petitioner, it should have moved to amend the Petition after the National Arbitration Forum issued the decision in the UDRP case. Having failed to do so, Petitioner cannot now try to assert an alternative basis for standing in its brief that is nowhere to be found in the Petition.

Finally, as explained in Registrant's Motion, the Board's precedent states that in order to have standing to bring a cancellation action based upon alleged genericness, a petitioner must show that it is using the purportedly generic term in connection with similar goods or services to those offered by the registrant. Registrant's Motion, at 4 (citing *Sheetz of Delaware, Inc. v. Doctors Associates Inc.*, 108 U.S.P.Q.2d 1341, 1350 (TTAB 2013) and *Bison Designs LLC v. Tough Gear, Inc.*, Opp. No. 91201036, at \*12-13 (TTAB 2014)). The mere registration of a domain name does not constitute use of a mark in commerce. Petitioner has not pointed to any

averments in the Petition claiming that Petitioner is using the term “Adventist” in connection with the offering of any goods or services, and there is no authority for the proposition that merely owning a domain name containing a term gives the registrant standing to challenge another party’s registration of that term as a mark.

In conclusion, the allegations set forth in the Petition for Cancellation fail to establish that Petitioner has a “real interest” in the proceedings or an objectively reasonable basis for its belief that it will be damaged. Therefore, the Petition must be dismissed in its entirety.

### **III. PETITIONER HAS FAILED TO PLEAD ITS FRAUD CLAIM WITH THE REQUIRED LEVEL OF SPECIFICITY**

Petitioner has also failed to explain why its fraud claim should be allowed to stand. Petitioner merely argues that the allegations in the Petition contain enough facts to state a claim to relief that is “plausible on its face.” Petitioner’s Brief, at 5. However, Petitioner completely fails to address the fact that both the Federal Rules and the TBMP require that a fraud claim be pleaded with a higher level of detail than other claims, including “the who, what, when, where and how of the alleged fraud,” *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1326-27 (Fed. Cir. 2009), as well as a specific allegation that the applicant/registrant made the allegedly false statements with the intent to procure a registration to which it was not entitled. *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 U.S.P.Q.2d 1203, 1205 (TTAB 1997).

Petitioner has pointed to certain allegations that it made in the Petition for Cancellation; however, these allegations fall well short of the required level of particularity for a fraud claim. As explained in Registrant’s Motion, the allegation that others were allegedly using “Adventist” in a descriptive or generic manner at the time the application was filed does not establish that the declaration filed by Registrant in connection with its application was false or fraudulent. The declaration only stated that Registrant believed it was entitled to use the mark in commerce, and

that no other person or entity had “the right to use the mark in commerce.” The alleged descriptive or generic use of the term “Adventist” by others does not conflict with the statements in the declaration, since this type of use does not constitute use as a “mark in commerce.” Therefore, even if all of the averments in the Petition are taken as true, they do not show that Registrant made any false claims in the prosecution of its application. *See Dragon Bleu (SARL) v. VENM, LLC*, 112 U.S.P.Q.2d 1925, 1928 n.9 (TTAB 2014) (dismissing fraud claim and stating that “there is no fraud absent an actually false statement”).

Therefore, even taking the averments in the Petition for Cancellation as true, they do not establish that Registrant made any false or fraudulent statements in connection with the procurement of its registration for the ADVENTIST mark, nor do they allege that Registrant had any bad faith intent to procure a registration to which it was not entitled. “Intent to deceive [the USPTO] is an indispensable element of the analysis in a fraud case [and] is an element to be pleaded in a fraud claim.” *Dragon Bleu*, 112 U.S.P.Q.2d at 1927. The Petition thus fails to set forth a legally sufficient allegation of fraud, and Petitioner’s Fourth Cause of Action must be dismissed accordingly.

#### **IV. PETITIONER HAS NOT DISPUTED REGISTRANT’S ARGUMENTS REGARDING PETITIONER’S SECOND AND THIRD GROUNDS FOR CANCELLATION**

Finally, Petitioner has not even responded to Registrant’s arguments regarding Petitioner’s Second and Third Grounds for Cancellation, Descriptiveness and “Failure to Function as a Mark.” Petitioner has thus waived any objections that it might have had to the dismissal of these two causes of action. Furthermore, as explained in Registrant’s Motion, descriptiveness is unavailable as a basis for cancellation against an incontestable registration as a matter of law. *Park ‘n Fly Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189 (1985). Petitioner

has not cited any authority to the contrary. As for the claim for “Failure to Function as a Mark,” this claim is merely a restatement of Petitioner’s descriptiveness and genericness claims, and is thus clearly redundant and unnecessary. Therefore, these causes of action must also be dismissed.

**V. CONCLUSION**

For the reasons set forth above, Registrant respectfully requests that the Board dismiss the Petition for Cancellation in its entirety, or, in the alternative, dismiss Petitioner’s Second, Third, and Fourth Grounds for Cancellation.

Respectfully submitted,

By:   
Bassam N. Ibrahim  
Bryce J. Maynard  
Buchanan Ingersoll & Rooney, P.C.  
1737 King Street, Suite 500  
Alexandria, Virginia 22314-1404  
(703) 836-6620  
  
Attorneys for Registrant

Date: March 21, 2017

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing REGISTRANT'S REPLY BRIEF IN SUPPORT OF ITS MOTION TO DISMISS was served this 21<sup>st</sup> day of March, 2017 by email on:

Eve J. Brown  
Bricolage Law, LLC  
1193 Walnut Street, Suite #6  
Newton, Massachusetts 02461  
[ejbrown@bricolagelaw.com](mailto:ejbrown@bricolagelaw.com)

  

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Connie Fuentes