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

Proceeding	92067714
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

INTOUCH TECHNOLOGIES, INC.,  Petitioner,  v.  PREPARED HEALTH, INC.,  Registrant.	Cancellation No.: 92067714  Registration No. 5,271,618 For the mark ENTOUCH
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**PETITIONER’S OPPOSITION TO REGISTRANT’S MOTION TO DISMISS  
PETITIONER’S AMENDED FRAUD CLAIM PURSUANT TO FEDERAL RULES OF  
CIVIL PROCEDURE 9(b) AND 12(b)(6)**

Petitioner InTouch Technologies, Inc. respectfully submits this memorandum in opposition to Registrant Prepared Health, Inc.’s Motion to Dismiss Petitioner’s Amended Fraud Claim Pursuant to Federal Rules of Civil Procedure 9(b) and 12(b)(6) (Dkt. 17) (the “Motion”) and respectfully requests that the Board deny the Motion for the reasons set forth herein.

**I.     INTRODUCTION.**

The Motion should be denied because Petitioner pleaded sufficient detail in the Amended Petition to meet the heightened pleading requirements of Rule 9(b). In its Amended Petition, Petitioner describes the who, what, when, where, and how of the alleged fraud: (1) Petitioner was using a confusingly similar mark, the INTOUCH mark, at the time Registrant signed the Statement of Use for the ENTOUCH mark (Amended Petition at ¶¶ 9-13 and 18), (2) Petitioner had legal rights in the INTOUCH mark that were prior and superior to Registrant’s rights in the ENTOUCH mark (*id.* at ¶ 10), (3) (a) Registrant knew that Petitioner had rights superior to those of Registrant because Petitioner informed Registrant of those rights in writing prior to Registrant filing the Statement of Use (*id.* at ¶ 15) and (b) Registrant believed that a likelihood of confusion

would result from Registrant's use of the ENTOUCH mark because, *inter alia*, the parties had discussed and Registrant knew that INTOUCH was phonetically and otherwise virtually identical to ENTOUCH (*id.* at ¶ 16), Registrant knew that the parties used their respective marks to offer overlapping goods and services to the same consumers (*id.*) and, during a telephone conference between Registrant and Petitioner regarding the likelihood of confusion between Registrant's mark and Petitioner's marks, Registrant expressed concern with the parties using their respective marks on the same goods and services (*id.*), and (4) Registrant, in failing to disclose these facts to the U.S. Patent and Trademark Office ("USPTO"), intended to procure a registration for the ENTOUCH mark to which Registrant was not entitled (*id.* at ¶ 19).

## **II. STATEMENT OF FACTS.**

Since at least as early as 2003, Petitioner has continuously used the INTOUCH and other INTOUCH-formative marks ("Petitioner's Marks") in connection with telehealth goods and services, including, without limitation, computer software and equipment for physicians, patients, patients' family and patients' friends to remotely monitor, communicate and share information regarding the patients' health and treatment, and for physicians to otherwise provide remote healthcare services ("Petitioner's Goods and Services"). *See* Amended Petition at ¶ 9.

Petitioner is also the owner of record of several trademark registrations for use of Petitioner's Marks with certain of Petitioner's Goods and Services. *See id.* at ¶ 5 and Schedule B. For example, on May 18, 2004, the USPTO awarded U.S. Reg. No. 2,843,750 to Petitioner for use of the INTOUCH HEALTH mark with certain software and hardware "used by caregivers, medical experts and patients' family and friends to, via remote transmission, audibly and/or visually 1) monitor patients/residents, 2) communicate live with each other and 3) exchange information concerning the care of the patient/resident." *Id.* at Schedule B.

More than 10 years later, on March 11, 2015, Registrant filed an application to register a phonetically and otherwise virtually identical mark, the ENTOUCH mark (“Registrant’s Mark”), for use with overlapping goods and services including, for example, “computer software for patients to access, research, review, record, organize, manage, and share health, medical, and wellness information with their healthcare professionals, family, friends, and others.” *Id.* at ¶¶ 3 and 12. The application included a date of first use of March 31, 2015, and subsequently registered as Registration No. 5,271,618 (“Registrant’s Registration”). *Id.* at ¶¶ 3 and 10.

Petitioner is the owner of several trademark applications for use of Petitioner’s Marks (“Petitioner’s Applications”). *Id.* at ¶ 4 and Schedule A. On March 14, 2016, and July 13, 2017, the USPTO issued Office Actions provisionally refusing registration of Petitioner’s Applications under Section 2(d) of the Trademark Act based on an alleged likelihood of confusion with Registrant’s Mark. *Id.* at ¶ 6 and Schedule C.

On or about December 15, 2016, Petitioner informed Registrant in writing of Petitioner’s prior use of Petitioner’s Marks and the likelihood of confusion from Registrant’s use of Registrant’s Mark:

As you may know, InTouch has been operating since 2003 and provides a variety of remote care products and services to healthcare providers, including products and services to connect providers and patients. We also own several trademark registrations for INTOUCH, INTOUCH HEALTH and INTOUCH TECHNOLOGIES.

We noticed that your company recently decided to offer a mobile app with the name ENTOUCH to connect healthcare providers and patients. Since ENTOUCH is virtually identical to our mark, and given that you are using it on very similar goods and services, we are concerned that your ongoing use will cause problems for us, as well as for patients and providers.

Amended Petition at ¶ 15. Registrant confirmed receipt of Petitioner's letter in a subsequent response thereto. *Id.* and Schedules D and E. Registrant also admitted receiving Petitioner's letter. *See* Answer to Petition for Cancellation at ¶ 14 (Dkt. 12).

Prior to Registrant filing the Statement of Use for Registrant's Mark, Registrant and Petitioner engaged in communications regarding Registrant's use of a confusingly similar mark, Petitioner's prior rights in Petitioner's Marks, and Petitioner's demand that Registrant discontinue use of Registrant's Mark. *See* Amended Petition at ¶ 16. During a telephone conference between Registrant and Petitioner regarding the likelihood of confusion between Registrant's Mark and Petitioner's Marks, the parties discussed the similarities between Petitioner's Marks and Registrant's Mark, and the associated goods and services, and Registrant admitted that it would not be comfortable if the parties used their respective marks on the same goods and services. *Id.* Nevertheless, Registrant did not want to invest time and resources in rebranding, so it proposed, during the same telephone conference, delaying any action with regard to Registrant's use of Registrant's Mark until there was actual evidence of confusion in the marketplace. *Id.* at ¶ 17. Registrant's counsel subsequently confirmed Registrant's desire to continue using Registrant's Mark until there was actual confusion: "I was under the belief that there was a tacit understanding between the parties that, until there is confusion in the marketplace, they would continue with their marks and businesses as is." *Id.* Notwithstanding Registrant's counsel's contention to the contrary, Petitioner did not agree that the parties could use their respective marks until there is confusion in the marketplace.

Notwithstanding the foregoing, on June 5, 2017, Registrant represented to the USPTO that no other person has the right to use a similar mark in commerce. Specifically, David M.

Coyle, on behalf of Registrant, declared as follows in the Trademark/Service Mark Statement of Use filed with the USPTO for Registrant's Mark, pursuant to 15 U.S.C. § 1051(a)(3):

To the best of the signatory's knowledge and belief, no other persons . . . have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services/collective membership organization of such other persons, to cause confusion or mistake, or to deceive.

To the best of the signatory's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, the allegations and other factual contents made above have evidentiary support.

The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

Amended Petition at ¶¶ 18 and Schedule G.

### **III. LEGAL STANDARDS.**

A petition to cancel a registration for fraud in procuring the registration should not be dismissed if, taking all of the petitioner's allegations as true and construing the petition in the light most favorable to the petitioner, the petitioner may plausibly be entitled to the requested relief. *See Stanspec Co. v. Am. Chain & Cable Co.*, 531 F.2d 563, 566, 189 USPQ 420 (CCPA 1976); *see also* Fed. R. Civ. P. 12(b).<sup>1</sup> Where the petition avers fraud based on the execution of a knowingly false declaration, "averments of fraud must include an explicit expression of the factual circumstances alleged to constitute fraud." *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1293 (TTAB 1999) (citing Fed. R. Civ. P. 9(b); *King Automotive, Inc. v. Speedy Muffler*

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<sup>1</sup> Petitioner has standing based on Petitioner's ongoing and prior use of Petitioner's marks. Registrant has not challenged this conclusion.

*King, Inc.*, 667 F.2d 1008, 212 USPQ 801 (CCPA 1981)). In particular, the party must allege when and how the fraud occurred, the content of the false representations, and what was obtained by reason of the asserted fraud. *Caymus Vineyards v. Caymus Med., Inc.*, Opp. No. 91204667, 2013 WL 6665451, at \*3 (TTAB July 12, 2013).

In the context of a false declaration regarding another's use of the same or confusingly similar mark at the time the declaration was signed, "the party must allege particular facts which, if proven, would establish that: (1) there was in fact another use of the same or a confusingly similar mark at the time the oath was signed; (2) the other user had legal rights superior to applicant's rights; (3) applicant knew that the other user had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise; and (4) applicant, in failing to disclose these facts to the Patent and Trademark Office, intended to procure a registration to which applicant was not entitled." *Ohio State*, 51 USPQ2d at 1293.

**IV. PETITIONER PROPERLY PLEADED ITS FRAUD CLAIM IN THE AMENDED PETITION.**

As set forth below, Petitioner has provided more than adequate detail as to the who, what, when, where, and why of the alleged fraud and, therefore, the motion should be denied. *See Ohio State*, 51 USPQ2d at 1293 (requiring an "explicit expression of the factual circumstances"). The alleged facts, if proven, would establish that (1) there was in fact another use by Petitioner of the same or a confusingly similar mark at the time Registrant signed its Statement of Use, (2) Petitioner's legal rights were superior to Registrant's, (3) Registrant knew that Petitioner had rights in the mark superior to Registrant's and either believed that a likelihood of confusion would result from Registrant's use of its mark or had no reasonable basis for believing otherwise, and (4) Registrant, in failing to disclose these facts to the USPTO, intended to procure a

registration to which it was not entitled, and thereby committed fraud upon the USPTO. *See Ohio State*, 51 USPQ2d at 1293; *Am. Online, Inc. v. Freehaven Invs., Ltd.*, Can. No. 30,808, 2001 WL 1547929, at \*7 (TTAB Nov. 26, 2001).

**1. The same or a confusingly similar mark was in use at the time Registrant signed the Statement of Use.**

First, the Amended Petition alleges such facts as would, if proved, establish that there was another user of a confusingly similar mark at the time Registrant signed the Statement of Use. For example, the Amended Petition includes the following:

- Petitioner has continuously used Petitioner's Marks with certain of Petitioner's Goods and Services since at least as early as 2003 and, without limiting the foregoing, Petitioner has used Petitioner's Marks with telehealth goods and services (including, without limitation, computer software and equipment for physicians, patients, patients' family and patients' friends to remotely monitor, communicate and share information regarding patients' health and treatment, and for physicians to otherwise provide remote healthcare services) since at least as early as 2003. *See* Amended Petition at ¶ 9.
- The only difference between Petitioner's INTOUCH mark and Registrant's Mark is Registrant's use of the letter "e" in place of the letter "i". *Id.* at ¶ 11.
- Registrant's goods and services overlap with Petitioner's Goods and Services. For example, Registrant's goods and services and Petitioner's Goods and Services both include software used by caregivers, patients and others to remotely share healthcare information. *Id.* at ¶ 12.
- On March 14, 2016 and July 13, 2017, the USPTO issued Office Actions provisionally refusing registration of Petitioner's Applications under Section 2(d) of the Trademark Act based on an alleged likelihood of confusion with the mark in the trademark application that issued as Registrant's Registration. *Id.* at ¶ 6 and Schedule C.
- If, as the USPTO contends, Petitioner's Marks are similar to Registrant's Mark in sight, sound, and commercial impression, such that they are likely to cause confusion as to source, sponsorship or association, when used in connection with Petitioner's Goods and Services and Registrant's goods and services, respectively, then Petitioner is the senior user with priority over Registrant and is entitled to cancellation of Registrant's Registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), because, among other things, Petitioner's first use of Petitioner's Marks is prior to any priority date Registrant can rely upon. Amended Petition at ¶ 13.
- Registrant, by its representative David M. Coyle, signed a Statement of Use in support of Registrant's application to register Registrant's Mark on June 5, 2017. *Id.* at ¶ 18.



Petitioner submits that these facts, if proved, establish that there was another user of the same or a confusingly similar mark at the time Registrant signed the Statement of Use.

**2. Petitioner's legal rights in the mark are superior to Registrant's.**

The Amended Petition also alleges facts in addition to the foregoing that would, if proved, establish that Petitioner had legal rights in Petitioner's Marks superior to Registrant's rights in Registrant's Mark. Specifically, the Amended Petition alleges that

- Petitioner has used Petitioner's Marks with telehealth goods and services, (including, without limitation, computer software and equipment for physicians, patients, patients' family and patients' friends to remotely monitor, communicate and share information regarding patients' health and treatment, and for physicians to otherwise provide remote healthcare services) since at least as early as 2003. Amended Petition at ¶¶ 9 and 12.
- Registrant's first use of Registrant's Mark is March 31, 2015, and Registrant's earliest constructive priority date is March 11, 2015. *Id.* at ¶ 10.

These facts together with the pleaded facts regarding likelihood of confusion, taken as true, establish that Petitioner's legal rights in Petitioner's Marks are superior to Registrant's rights in Registrant's Mark.

**3. Registrant knew Petitioner's rights to be superior and believed that likelihood of confusion would result.**

In addition, the Amended Petition alleges facts that would, if proved, establish that Registrant knew of Petitioner's superior rights and either believed that a likelihood of confusion would result from Registrant's use of the mark or had no reasonable basis for believing otherwise:

- On or about December 15, 2016, Petitioner informed Registrant of Petitioner's prior use of Petitioner's Marks and the likelihood of confusion from Registrant's use of Registrant's Mark:

As you may know, InTouch has been operating since 2003 and provides a variety of remote care products and services to healthcare providers, including products and services to

connect providers and patients. We also own several trademark registrations for INTOUCH, INTOUCH HEALTH and INTOUCH TECHNOLOGIES.

We noticed that your company recently decided to offer a mobile app with the name ENTOUCH to connect healthcare providers and patients. Since ENTOUCH is virtually identical to our mark, and given that you are using it on very similar goods and services, we are concerned that your ongoing use will cause problems for us, as well as for patients and providers.

Registrant confirmed receipt of Petitioner's letter in a subsequent response thereto. Amended Petition at ¶ 15 and Schedules D and E.

- Prior to Registrant filing the Statement of Use for Registrant's Mark, Registrant and Petitioner engaged in communications regarding Registrant's use of a confusingly similar mark, Petitioner's prior rights in Petitioner's Marks, and Petitioner's demand that Registrant discontinue use of Registrant's Mark. During a telephone conference between Registrant and Petitioner regarding the likelihood of confusion between Registrant's Mark and Petitioner's Marks, the parties discussed the similarities between Petitioner's Marks and Registrant's Mark, and the associated goods and services, and Registrant admitted that it would not be comfortable if the parties used their respective marks on the same goods and services. This admission regarding Registrant's concern about a likelihood of confusion, together with the facts regarding similarities between Registrant's Mark and Petitioner's Marks and overlap of the associated goods and services, confirmed Registrant's belief that there was a likelihood of confusion between Petitioner's use of Petitioner's Marks and Registrant's use of Registrant's Mark. *Id.* at ¶ 16.
- Notwithstanding Registrant's belief that there was a likelihood of confusion between Registrant's Mark and Petitioner's Marks, Registrant did not want to invest time and resources in rebranding at this point in time. Thus, it proposed, during the same telephone conference, delaying any action with regard to Registrant's use of Registrant's Mark until there was actual evidence of confusion in the marketplace. Registrant's counsel subsequently confirmed Registrant's desire to continue using Registrant's Mark until there was actual confusion: "I was under the belief that there was a tacit understanding between the parties that, until there is confusion in the marketplace, they would continue with their marks and businesses as is." Notwithstanding Registrant's counsel's contention to the contrary, Petitioner did not agree that the parties should use their respective marks until there is confusion in the marketplace. *Id.* at ¶ 17 and Schedule F.

These facts, taken as true, establish that Registrant knew of Petitioner's rights and believed that a likelihood of confusion would result from Registrant's use of Registrant's Mark. In response to Petitioner's accusations, Registrant expressed no reasonable basis for believing that confusion was not likely to occur (and, indeed, on the facts as pleaded, had none). Nevertheless, Registrant submitted a sworn statement to the contrary. *See id.* at ¶ 18.

**4. Registrant intended to procure a registration to which it was not entitled.**

Finally, the Amended Petition alleges that (a) Registrant affirmatively represented to the USPTO in Registrant's Statement of Use that no other persons were entitled to use a similar mark in connection with goods or services in such near resemblance as to be likely to cause confusion, (b) Registrant did so with the intent to procure a registration to which it is not entitled, and (c) the USPTO relied on Registrant's statement when issuing Registrant's Registration. *Id.* at ¶¶ 18, 19. *See Bart Schwartz Int'l Textiles, Ltd. v. FTC*, 289 F.2d 665 (CCPA 1961) (holding that withholding information that others have the right to use a mark in commerce is grounds for cancellation and demonstrates intent to deceive); *see also* Fed. R. Civ. P. 9(b) (allowing intent to be pleaded generally). This allegation, taken as true and combined with the facts above, supports a finding that Registrant intended to procure a registration to which it was not entitled.

**V. CASE LAW SUPPORTS DENIAL OF REGISTRANT'S MOTION.**

Registrant's Motion relies heavily on *King Automotive*, 667 F.2d 1008. In *King Automotive*, the petition failed to allege that the registrant knew of the petitioner's rights. *Id.* at 1010–11. Here, Petitioner avers specific facts about conversations where Petitioner informed Registrant of Petitioner's Marks and discussed concerns about likelihood of confusion. Amended Petition at ¶¶ 15–16. Moreover, in *King Automotive* the petitioner failed to plead any facts reflecting either the registrant's belief that the parties' marks would be likely to confuse or that

the registrant had no reasonable basis for believing otherwise. 667 F.2d at 1011. Here, Petitioner specifically pleads facts describing Registrant's reaction to notice of Petitioner's Marks, a reaction that did not identify any reasonable basis for disagreeing with Petitioner's concerns about confusion, but instead expressing a preference to do nothing about it until the situation worsened. Amended Petition at ¶¶ 16–17. Drawing all inferences in Petitioner's favor, these pleaded facts (unlike the pleadings in *King Automotive*) support an inference either that Registrant believed that the parties' marks are likely to cause confusion or that Registrant had no reasonable basis for believing otherwise.

*Caymus* provides a closer analogue than *King Automotive* to the facts pleaded here by Petitioner. 2013 WL 6665451, at \*3. In that case, the applicant counterclaimed to cancel the opposer's registration based on allegations (i) that the examining attorney had required opposer to indicate whether CAYMUS had any geographical significance; (ii) that the examining attorney had subsequently amended the application to state that "the wording 'CAYMUS' has no significance other than trademark significance"; and (iii) that opposer's grapes were grown and/or its wine was produced at or near the Caymus locale in the Napa Valley wine region of California. *Id.* The Board explained that "applicant alleges when and how the fraud allegedly occurred and the content of the false representation, and identifies what was obtained by reason of the asserted fraud." *Id.* The pleaded facts in the present case are even more directly probative of fraud than the adequate pleadings in *Caymus*. In *Caymus*, the opposer's false representation was pleaded by circumstantial evidence (the examiner's request for geographic significance combined with the examiner's amendment of the application to attest no geographic significance), and the opposer's knowledge of facts contrary to its representation was also pleaded by circumstantial evidence (opposer's grapes or winemaking were located at or near the

Caymus region of Napa Valley). Here, Petitioner has pleaded facts that directly evidence both Registrant's false representation (the June 5, 2017 Statement of Use, *see* Amended Petition at ¶ 18) and Registrant's knowledge of facts contrary to the representation (Registrant's confirmed receipt of Petitioner's December 15, 2016 notice along with Registrant's subsequent communications regarding likelihood of confusion with Petitioner's Marks, *see* Amended Petition at ¶¶ 15-17).

The Motion further argues that Registrant's statement on June 5, 2017, even if it was a false representation, lacked materiality because the Examining Attorney's XSearch Search Summary included Petitioner's Marks in a set of 111 search result hits. Motion at 9, 10. This argument sidesteps the real issue: but for the Registrant's false statement, which was required for the application to progress to publication, Registrant could not have properly completed the application, and thus could not have received the Registration at issue. *See Am. Massage Therapy Ass'n v. Implus Footcare, LLC*, Opp. No. 91234785, 2017 WL 5624668, at \*7 (TTAB Nov. 11, 2017) (finding allegedly fraudulent statement to be material because "without it [the application] would not have passed to publication"); *see also* 15 U.S.C. § 1051(a)(3) (requiring applicant to verify that no other entity has the right to use the mark or a confusingly similar mark to register for a trademark).

Moreover, many Board opinions recognize that falsely subscribing to the following statement in connection with a trademark application is adequate for alleging fraud:

“[T]hat to the best of the signatory's knowledge and belief, *no other person has the right to use the mark in commerce*, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive.”

*Am. Massage*, 2017 WL 5624668, at \*6-7 (alterations in original) (quoting application); *Ohio*

*State*, 51 USPQ2d at 1291; *see also Am. Online*, 2001 WL 1547929, at \*6 (allowing fraud counterclaim to go forward based on allegations that the registrant “signed a fraudulent application declaration because it knew of respondent’s superior rights”). In *American Massage*, the alleged fraud—adequately pleaded—was that the applicant’s declaration contained a false representation of fact (i.e., that no other parties had the right to use the applied-for mark), and the applicant knew that others were using the wording ‘trigger point’ to describe or identify the goods identified in its application and that others had the right to use the applied-for mark in commerce. 2017 WL 5624668, at \*7. In *Ohio State*, the alleged fraud—adequately pleaded—was that the opposer’s registration was obtained by a declaration that contained a false representation of fact (i.e., that no other university had the right to use the applied-for mark) when the opposer allegedly knew that the State of Ohio had chartered applicant and that applicant had opened its doors as a university several decades prior to the opposer. 51 USPQ2d at 1291. In *Angel Flight of Georgia, Inc. v. Angel Flight America, Inc.*, the plaintiff’s fraud claim—adequately pleaded—proceeded through trial and resulted in judgment cancelling the defendant’s mark where “trial testimony revealed Angel Flight West was aware other organizations were using names such as ‘The Angel Flight’ at the time the registration application was filed, but did not disclose that information to the Patent and Trademark Office.” 522 F.3d 1200, 1211, 86 USPQ2d 1422 (11th Cir. 2008). The court of appeals affirmed on the ground that “[i]t was possible for the trial court to infer the reason [registrant] concealed this information was because he knew or believed the other Angel Flight organizations had an equal right to use of the Angel Flight mark.” *Id.* On this authority, Petitioner’s alleged facts supporting its fraud claim trod the well-worn path of a well-pleaded complaint, and Registrant’s Motion should therefore be denied.

**VI. THE MOTION MISAPPLIES RULE 9(b)'S PLEADING STANDARD.**

At this stage of the litigation, Petitioner does not need to “prove that PreparedHealth thought its ENTOUCH mark was likely to cause confusion,” as Registrant claims. Motion at 7 (emphasis added). Federal Rule of Civil Procedure 9(b) provides that “conditions of a person’s mind may be alleged generally.” Allegations made “upon information and belief” are acceptable when accompanied by a statement of facts upon which the belief is founded. *Petroleos Mexicanos v. Intermix S.A.*, 97 USPQ2d 1403, 1407 (TTAB 2010).

The Motion assumes the wrong standard: the question on a motion to dismiss is not whether Petitioner’s proof is adequate but whether Petitioner’s factual allegations are sufficiently detailed. For example, the Motion argues that statements by Registrant and its counsel do not reflect whether Registrant “believed that confusion was likely” but rather demonstrate that Registrant “believed confusion was not likely.” Motion at 8, 9. These arguments are backwards because they ask the Board to make inferences against Petitioner instead of drawing all justifiable inferences in Petitioner’s favor. *See Angel Flight*, 522 F.3d at 1211 (affirming cancellation of mark where “[i]t was possible for the trial court to infer the reason [registrant] concealed this information was because he knew or believed the other Angel Flight organizations had an equal right to use of the Angel Flight mark”). Registrant also repeatedly discounts Petitioner’s detailed statement of facts regarding communications between Registrant and Petitioner because those statements do not *directly* prove Registrant’s subjective belief that its Registration was likely to cause confusion with Petitioner’s Marks. *See, e.g.*, Motion at 7-8 (arguing, among other points, that Registrant’s statement that it “would not be comfortable” with the parties using their respective marks cannot be a basis for showing likelihood of confusion). Again, Registrant argues that Petitioner cannot prove fraud merely by showing that Registrant

knew of Petitioner’s Marks. Motion at 3. In each of these arguments, Registrant plainly misapplies the standard for surviving a motion to dismiss. Petitioner does not need to allege *direct* proof of Registrant’s subjective belief in likelihood of confusion. See Bart Schwartz, 289 F.2d at 669 (affirming cancellation based on “both direct and circumstantial evidence”). All that is required is an “explicit expression of the factual circumstances.” *Ohio State*, 51 USPQ2d at 1293; see also Section III *supra* (legal standard); Section V *supra* (several cases applying the standard).

As explained in Section IV, *supra*, with specific reference to the numbered paragraphs of the Amended Petition, Registrant acknowledged Petitioner’s notice of Petitioner’s Marks and discussed likelihood of confusion with Petitioner (including the USPTO’s Office Action finding likelihood of confusion between an application for Petitioner’s Marks and Registrant’s Registration). Amended Petition at ¶¶ 15, 16. Registrant provided no reasonable basis for disputing likelihood of confusion but instead tried to kick the can down the road until the situation got worse. *Id.* at ¶ 17; see also *supra* Section IV (describing the factual pleadings of the Amended Petition). Taken as true, as they must be at this stage of the proceeding, these facts supply the required “statement of facts upon which the [petitioner’s] belief is founded.” *Petroleos Mexicanos*, 97 USPQ2d at 1407. Therefore Respondent’s arguments must fail.

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**VII. CONCLUSION**

For the reasons set forth above, Petitioner respectfully requests that the Board deny Registrant's Motion.

Dated: July 11, 2018.

STOEL RIVES LLP

/Joshua G. Gigger/

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Attorneys for Petitioner

**CERTIFICATE OF SERVICE**

I hereby certify that I served the foregoing **PETITIONER’S OPPOSITION TO REGISTRANT’S MOTION TO DISMISS PETITIONER’S AMENDED FRAUD CLAIM PURSUANT TO FEDERAL RULES OF CIVIL PROCEDURE 9(b) AND 12(b)(6)** on the following named persons on the date indicated below by:

- X mailing with postage prepaid
- hand delivery
- facsimile transmission
- overnight delivery
- X e-mail attachment in PDF format

to said persons a true copy thereof, contained in a sealed envelope, addressed to said persons at their last-known address indicated below.

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DATED: July 11, 2018

/Nancy Johnson/\_\_\_\_\_

Nancy Johnson