

ESTTA Tracking number: **ESTTA888655**

Filing date: **04/09/2018**

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

Proceeding	92067982
Party	Defendant Adam Summers
Correspondence Address	ADAM SUMMERS 7704 QUARTERFIELD ROAD SUITE E GLEN BURNIE, MD 21061 UNITED STATES Email: uspto@mdcosmetic.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Alisa C. Simmons
Filer's email	trademark@fitcheven.com, asimmons@fitcheven.com
Signature	/Alisa C. Simmons/
Date	04/09/2018
Attachments	Motion to Dismiss.pdf(39759 bytes)

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

Paradise International, Inc.
Petitioner,

v.

Adam Summers,
Registrant.

Cancellation No. 92067982

Registration No. 4423790
For TrueRatings

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MOTION TO DISMISS

The Petition for Cancellation filed by Petitioner identifies priority and likelihood of confusion, failure to use the mark in commerce before application, and committing fraud on the Office as grounds for cancellation. However, it fails to properly allege that Petitioner has priority over Registrant in the alleged likelihood of confusion grounds for cancellation and fails to plead with any particularity the alleged fraud that Registrant allegedly committed on the Office. Accordingly, Registrant Dr. Adam Summers (“Registrant”) respectfully requests that the Petition be dismissed for failure to state a claim pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure.

I. BACKGROUND

Registrant is the owner of the valid U.S. Registration No. 4423790 for the TrueRatings trademark, which issued on October 29, 2013, for use with services in Classes 35 and 42. On May 31, 2017, Petitioner filed U.S. Application Serial No. 87470035 (“Petitioner’s Application”) for TrueRating.com for the electronic commerce services of providing information about products via telecommunication networks for advertising and sales purposes in Class 35. On August 29, 2017, the Examining Attorney examining Petitioner’s Application issued an office action refusing Petitioner’s Application on the grounds of likelihood of confusion with

Registrant's Registration No. 4423790, finding the Petitioner's mark essentially identical in sound, appearance, meaning, and commercial impression to the mark in Registrant's Registration No. 4423790 when used in connection with providing related services.

On February 27, 2018, Petitioner filed a petition to cancel Registrant's Registration No. 4423790 based on the three grounds of priority and likelihood of confusion, failure to use the mark in commerce before application, and committing fraud on the USPTO.

II. LEGAL STANDARD

A motion to dismiss for failure to state a claim "is a test solely of the legal sufficiency of a complaint." See § 503.02 of the Trademark Trial and Appeal Board Manual of Examining Procedure (TBMP). Under FRCP 12(b)(6), the Board must dismiss a petition for cancellation if it fails to state a claim that is "plausible on its face." T.B.M.P. § 503.02 (citing *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). "Threadbare recitals of the elements of a cause of action, supported by mere conclusory statements, do not suffice." *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). The purpose of FRCP 12(b)(6) "is to allow the court to eliminate actions that are fatally flawed in their legal premises and destined to fail, and thus to spare litigants the burdens of unnecessary pretrial and trial activity." *Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 26 U.S.P.Q.2d 1038, 1041 (Fed. Cir. 1993). When ruling on a motion to dismiss, the Board shall accept factual allegations pled in the opposition as true, but "[c]onclusory allegations of law and unwarranted inferences of fact do not suffice to support a claim." *Bradley v. Chiron Corp.*, 45 U.S.P.Q.2d 1819, 1822 (Fed. Cir. 1998).

To properly plead likelihood of confusion as grounds for cancellation, a petitioner must plead that it owns a prior registered mark or has prior use of a mark that is confusingly similar to a registrant's mark. *Russell Chemical Co. v. Wyandotte Chemicals Corp.*, 143 U.S.P.Q. 252 (CCPA 1964).

To properly plead that a registrant has committed fraud in the procurement of a registration, a petitioner must establish that: (i) registrant made a false representation to the

Office; (ii) the false representation is material to the registerability of the mark; (iii) the registrant had knowledge of the falsity of the representation; and (iv) the registrant made the representation with the intent to deceive the Office. *In re Bose Corp.*, 91 U.S.P.Q.2d 1938, 1941 (Fed. Circ. 2009).

III. ANALYSIS

Petitioner has not properly pled the elements of a claim for likelihood of confusion or of fraud on the Office.

A. Petitioner Does Not Plead Priority Over Registrant in its Ground for Cancellation Based on Likelihood of Confusion.

Petitioner fails to plead priority of use or prior registration of a mark that is confusingly similar to Registrant's mark. Priority is an essential element of likelihood of confusion. Petitioner's ground for cancellation based on likelihood of confusion should fail due to this omission.

B. Petitioner Has Not Alleged with Particularity Facts to Support Its Fraud Claims.

Fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes a false, material representation of fact in connection with an application to register with the intent of obtaining or maintaining a registration to which it is otherwise not entitled. *See Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925, 1926 (TTAB 2014) (citing *In re Bose Corp.*, 580 F.3d 1240; 91 USPQ2d 1938, 1939 (Fed. Cir. 2009)); *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986). Fed. R. Civ. P. 9(b) provides that the circumstances constituting the alleged fraud shall be stated with particularity. *See also King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801, 803 (CCPA 1981) (stating that "the pleadings [must] contain explicit rather than implied expressions of the circumstances constituting fraud").

Here, Petitioner fails to plead the required elements to make a fraud claim. Specifically, Petitioner alleges only:

¶ 3 On information and belief, Respondent has not used the Respondent's Mark in commerce on any of the services listed in Respondent's Registration on or prior to issuance thereof on October 29, 2013.

¶ 4 On information and belief, Respondent has never used the Respondent's Mark as a trademark in commerce on most if not all of the services recited in the Respondent's Registration (set forth above), and has certainly never used the Respondent's Mark on *all* of the services recited in the Respondent's Registration.

¶ 5 On information and belief, Respondent had full knowledge that its original application to the PTO, which resulted in the Respondent's Registration, was riddled with falsehoods and grossly overstated its use of the Respondent's Mark. As such, Respondent knowingly and intentionally committed fraud on the PTO.

¶ 6 Respondent's Registration is therefore void *ab initio* based on non-use of the Respondent's Mark and fraud on the PTO.

Petition, Docket 1.

In the statements above, the Petitioner does not identify particularly any false material representations made by Petitioner to the Office during the prosecution of the Registration. Petitioner also fails to meet the required pleading standard for a fraud claim. Petitioner, in its allegations, relies not on particular facts but on "information and belief," which the Board has found insufficient.

Accordingly, Petitioner has not sufficiently pled allegations to support the grounds for cancellation based on fraudulent representations to the Office.

IV. CONCLUSION

Petitioner has failed to meet the *Twombly* standard for asserting its claims. While the Board must accept the pleaded facts as true for purposes of Registrant's motion, Petitioner is still obliged to allege the facts necessary to state a claim. Petitioner has not alleged that it has priority of registration or use over Registrant in its likelihood of confusion grounds for opposition, and Petitioner has not plead with particularity allegations to support grounds that

the Registrant committed fraud on the Office. Accordingly, Registrant respectfully requests that the Board grant its motion to dismiss the petition under Rule 12(b)(6).

Dated: April 9, 2018

Respectfully submitted,
Dr. Adam Summers

/Alisa C. Simmons/

Sherril N. Blount

Alisa C. Simmons

Fitch Even Tabin & Flannery LLP

120 South LaSalle Street, Suite 2100

Chicago, IL 60603

Tel: 312-577-7000

Email: Trademark@fitcheven.com, asimmons@fitcheven.com

Attorneys for Registrant

Certificate of Service

The undersigned hereby certifies that a copy of the foregoing **Motion to Dismiss** has been served upon all parties, at their address of record by email set forth below on this date:

Adam E. Engel
The Engel Law Group PLLC
280 Madison Avenue, Suite 705
New York, NY 10016
Email: AEE@ELGPLLC.COM

Attorney for Petitioner

Dated this 9th day of April, 2018.

/Alisa C. Simmons/
Alisa C. Simmons
Sherri N. Blount
Fitch Even Tabin & Flannery LLP
120 South LaSalle Street, Suite 1600
Chicago, IL 60603
Tel: 312-577-7000
Email: Trademark@fitcheven.com, asimmons@fitcheven.com

Attorneys for Registrant