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

Proceeding	92067982
Party	Plaintiff Paradise International Inc.
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Date	05/04/2018
Attachments	18-05-04 PETCANCEL - MTD OPP wEXHS A-B - to file.pdf(225972 bytes )

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

In the Matter of Registration No. 4,423,790  
issued on October 29, 2013, for TrueRatings

PARADISE INTERNATIONAL INC.,  Petitioner,  v.  ADAM SUMMERS,  Respondent.	OPPOSITION TO RESPONDENT'S MOTION TO DISMISS  and in the alternative  MOTION TO AMEND PETITION TO CANCEL  Cancellation No. 92067982
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**INTRODUCTION**

PARADISE INTERNATIONAL INC. (“Paradise Int’l.” or “Petitioner”) hereby opposes Respondent’s Motion to Dismiss its Petition to Cancel, which misrepresents the Petition to Cancel and otherwise asks the Board to apply an overly formalistic reading of the language of the Petition and the applicable case law. The major thrust of the Petition, as well as a similar Petition filed against the same mark at issue here (Exh. A - Cancellation No. 92063886), is that Dr. Summers grossly, knowingly, and with the intent to deceive overstated the goods and services on which he had used the mark at the time of his registration, and that to the extent he has ever actually used the mark on anything such use has been *de minimus*, sporadic, and, in any event, now non-existent. Dr. Summers’s approach to trademark registration is, in fact, a textbook example of the abuses that the Board and the Federal Circuit intended to sanction and stamp out in *Medinol* and *In re Bose Corp.*, respectively.

Accordingly, the Respondent’s Motion should be denied in its entirety, and the Petition should be granted on each of the grounds identified as “grounds for cancellation” relied on by Petitioner, namely (1) Dr. Summers committed fraud on the USPTO because he never used the

mark on the vast majority of goods and services identified in his application (2) no use in commerce for the same reason and (3) Petitioner has priority because Respondent has no use whatsoever to compare to Petitioner's actual and continuous use, and the USPTO has already stated, through an Office Action in Petitioner's application file, that the similarities between Petitioner's mark and Respondent's mark create a likelihood of confusion.

In the alternative, the Petitioner hereby moves to amend its Petition, and attaches herewith a Proposed Amended Petition (EXH. B) that Petitioner believes should satisfy Respondent's overly rigid view of the rules of pleading.

### **ARGUMENT**

The parties do not dispute that on a motion to dismiss the Board shall accept all well-pleaded facts as true, as well as all reasonable inferences drawn from such well-pleaded facts. *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009); *Bradley v. Chiron Corp.*, 45 U.S.P.Q.2d 1819, 1822 (Fed. Cir. 1998) (forbidding only "unwarranted inferences of fact").

The parties also do not dispute the standard for pleading fraud on the USPTO as grounds for cancellation. As Respondent states, "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. Cir. 2009)."

The Petition meets each of these elements, and while it is unclear from Respondent's Motion which elements they think have not been adequately pled, the allegations and legal standard set forth in the Respondent's own Motion establish that the Petition is on firm ground.

First, Dr. Summers represented that at the time of his application he used the mark on a laundry list of goods and services (which, incidentally, were reproduced in one single block in the Petition not as a way of obfuscating the nature of Petitioner's grounds for cancellation, but rather because the list is so long that reproducing it piece by piece in separate allegations would have been overly tedious). Pet. pp. 1-2. The Petition then explicitly states that "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," and that he has since not done so either. Pet ¶¶3, 4. This is a clear statement of falsity. Second, it is beyond dispute that the goods and services on which a mark is allegedly used are material to the USPTO's determination of registerability. *See, e.g. In re Bose.*

Moreover, Dr. Summers purported to be the owner of the mark, and was the only potential individual user of the mark (it was not registered in a company's name), and was the only individual involved in the filing of the application and the only affiant in support of the application – in other words, it was a one-man show. *See, MPC Franchise, LLC v. Tarantino*, 826 F.3d 653 at 661 (readily finding a knowing falsehood because of the personal nature of the application: "Tarantino's misstatement of ownership was not a mistake . . . Tarantino was not attempting to register the mark on behalf of the corporation . . . he registered it for himself."). The inference that Dr. Summers had full knowledge of the falsity of the laundry list he used as the basis for his application is not only a reasonable inference, it is a necessary one.

Similarly, the factual allegations described above and set forth in the Petition directly support the inference that Dr. Summers knowingly made those numerous false statements to the USPTO with the intent to deceive the USPTO and thereby acquire a registration to which he is not entitled. It is axiomatic that is virtually impossible for one person to discern with absolute

certainty what is in another person's mind. This is especially true when those two people have never met and are now in an adversarial posture.

Rightfully, the courts and this Board recognize this truism and allow a plaintiff/petitioner to proceed past the pleading stage based on reasonable inferences of intent drawn from the defendant/respondent's actual knowledge and behavior. For example, in *Spiral Direct*, the cancellation petition was based on the central allegation that, like here, the applicant had simply not used the mark on the goods claimed in the application. *Spiral Direct, Inc. v. Basic Sports Apparel, Inc.*, 2017 WL 8317022 at \*19 (M.D. Fla. 2017). The court readily distinguished *Bose* because in *Bose*, the parties did not dispute whether the mark could be found on any goods produced by the applicant, and instead the issue was whether merely servicing indisputably trademarked goods that were no longer being manufactured and sold qualified as a "use in commerce." The *Spiral Direct* court concluded that "[unlike in *Bose*], where a trademark owner knows that he has not used a trademark in commerce but nonetheless submits an application based on use of the mark in commerce, the Court may infer a fraudulent intent." *Spiral Direct* at \*19 (and even there the applicant was at least in the business of manufacturing and selling the type of goods at issue). The court in *MPC Franchise* came to a similar conclusion based on similar facts, namely that an inference of intent to deceive is readily drawn when the applicant knowingly submits false (sworn) statements in its application that relate to *the applicant's own knowledge and conduct*. *MPC Franchise* at 660-661.

In *In re Bose*, the key was that the registrant had a misunderstanding about whether its activities, which were not in dispute, qualified as a "use in commerce." Here, the Petition describes a fundamentally different scenario. First, Dr. Summers filed the application himself - there was no lawyer or other party involved in the registration who could have suffered from any

kind of misconception about the facts set forth in the application, or any opportunity for an honest mistake caused by a miscommunication between Dr. Summers and anyone else. Second, the Petition rests, in large part, on the simple allegation that Dr. Summers was not using the mark *at all or in any way* on most if not all of the goods and services he identified in his application.

**CONCLUSION**

There is no close call to referee here. Dr. Summers is essentially a squatter who used his application and registration in an attempt to lay claim to a wide swath of property that he had never used and therefore had no right to exclude others from using. His Motion to Dismiss should be denied in its entirety.

Dated: New York, New York  
May 4, 2018

**THE ENGEL LAW GROUP, PLLC**

By:   
Adam E. Engel

280 Madison Avenue – Suite 705  
New York, NY 10016  
(212) 665-8095

Attorneys for Petitioner

I hereby certify that a true and complete copy of this letter has been served on Alisa C. Simons by forwarding said copy on April 23, 2018 via email to:

Alisa C. Simmons  
Fitch Even, Tabin & Flannery LLP  
Counsel for Dr. Summers  
ASimmons@fitcheven.com

Signature: 

Date: May 4, 2018

**EXHIBIT A**

ESTTA Tracking number: **ESTTA750467**

Filing date: **06/06/2016**

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

**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

Name	TruRating Ltd.		
Entity	Limited Company	Citizenship	United Kingdom
Address	107 Leadenhall Street London, EC3A4AF UNITED KINGDOM		

Attorney information	Victoria J. B. Doyle Fried Frank LLP One New York Plaza New York, NY 10004-1980 UNITED STATES teas@friedfrank.com, victoria.doyle@friedfrank.com Phone:212-859-8000
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**Registration Subject to Cancellation**

Registration No	4423790	Registration date	10/29/2013
Registrant	Summers, Adam 7704 Quarterfield Rd Glen Burnie, MD 21061 UNITED STATES		

**Goods/Services Subject to Cancellation**

<p>Class 035. First Use: 2008/02/01 First Use In Commerce: 2008/02/01 All goods and services in the class are cancelled, namely: An interactive web site for users to review and rate internet content, people, companies, products and/or services utilizing a software application to award points whereby web site users are eligible to exchange points earned for promotional items consisting of coupons, rebates, discounts or special offerings on goods and/or service provided by web site sponsors; Attorney referrals; Audit support services, namely, review and analysis of a company's sales, as well as the preparation, organization and presentation of the documents and data requested by a government body, and advice on government audit processes, policies and strategy; Business consulting services, namely, providing a turnkey business solution for reviewing products and services, planning documentation and workflow, hiring technical writers, managing projects for business purposes, tracking user satisfaction, and running usability studies for business purposes; Business consulting services, namely, providing a turnkey solution for reviewing product and service documentation and workflow, managing projects for business purposes, tracking user satisfaction, and running usability studies for business purposes; Health care cost review; Health care utilization and review services; Promoting the goods and services of others by providing a website featuring coupons, rebates, price-comparison information, product reviews, links to the retail websites of others, and discount information; Providing a web site featuring statistical data on physicians' performance for the purpose of assisting prospective patients in making physician selection decisions; Providing business research services, namely, researching dental patient insurance information for dental offices; Providing independent ratings and reviews of other businesses for commercial purposes; Providing independent review of clinical trials for business purposes; Providing information on the topic of promoting patient, physician and employee satisfaction via a global computer network</p>
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Class 042. First Use: 2008/02/01 First Use In Commerce: 2008/02/01

All goods and services in the class are cancelled, namely: Providing a website featuring temporary-use of non-downloadable software allowing website users to post ratings, reviews and recommendations on employers and employees and places of employment for use by employees, employers, business owners, and consumers; providing a website featuring temporary use of non-downloadable software allowing website users to post ratings, reviews and recommendations on products and services for commercial purposes

## Grounds for Cancellation

No use of mark in commerce before application, amendment to allege use, or statement of use was filed

Trademark Act Sections 14(1) and 1(a), (c), and (d)

Attachments

Pet\_to\_Cancel\_RN\_4423790.pdf(169815 bytes )

## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/vjbd/
Name	Victoria J. B. Doyle
Date	06/06/2016

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

In the Matter of Registration No. 4,423,790  
issued on October 29, 2013, for TrueRatings

TRURATING LTD.,

Petitioner,

v.

ADAM SUMMERS,

Respondent.

Cancellation No.

PETITION FOR CANCELLATION

TRURATING LTD. (“TruRating” or “Petitioner”), a company organized and existing under the laws of the United Kingdom with its principal place of business at Bankside House, 107 Leadenhall Street, London, England EC3A 4AF, believes that it has been and will be damaged by the continued presence on the Principal Register of Registration No. 4,423,790, dated October 29, 2013, for the trademark TrueRatings for “[a]n interactive web site for users to review and rate internet content, people, companies, products and/or services utilizing a software application to award points whereby web site users are eligible to exchange points earned for promotional items consisting of coupons, rebates, discounts or special offerings on goods and/or service provided by web site sponsors; Attorney referrals; Audit support services, namely, review and analysis of a company's sales, as well as the preparation, organization and presentation of the documents and data requested by a government body, and advice on government audit processes, policies and strategy; Business consulting services, namely, providing a turnkey business solution for reviewing products and services, planning

documentation and workflow, hiring technical writers, managing projects for business purposes, tracking user satisfaction, and running usability studies for business purposes; Business consulting services, namely, providing a turnkey solution for reviewing product and service documentation and workflow, managing projects for business purposes, tracking user satisfaction, and running usability studies for business purposes; Health care cost review; Health care utilization and review services; Promoting the goods and services of others by providing a website featuring coupons, rebates, price-comparison information, product reviews, links to the retail websites of others, and discount information; Providing a web site featuring statistical data on physicians' performance for the purpose of assisting prospective patients in making physician selection decisions; Providing business research services, namely, researching dental patient insurance information for dental offices; Providing independent ratings and reviews of other businesses for commercial purposes. Providing independent review of clinical trials for business purposes; Providing information on the topic of promoting patient, physician and employee satisfaction via a global computer network” in International Class 35, and “[p]roviding a website featuring temporary use of non-downloadable software allowing website users to post ratings, reviews and recommendations on employers and employees and places of employment for use by employees, employers, business owners, and consumers; providing a website featuring temporary use of non-downloadable software allowing website users to post ratings, reviews and recommendations on products and services for commercial purposes” in International Class 42.

As grounds of cancellation, it is alleged that:

### **FIRST CAUSE OF ACTION**

1. Petitioner TruRating provides retail companies with proprietary software as a service (SAAS) services for point-of-sale consumer ratings of businesses, as well as market

research and analysis services with a focus on consumer-driven market research. Petitioner is the owner of the trademark TruRating, the domain name <https://www.trurating.com>, which it first acquired in 2011, a related website, and mobile application.

2. Petitioner has been operating under its TruRating trademark since at least as early as October 2012, and using the mark in U.S. commerce since at least as early as June 2014.

3. Petitioner is the owner of U.K. Registration No. 3039473 (dated Jan. 27, 2014), and E.U. Registration No. 13335674 (dated Oct. 7, 2014) for the mark “TruRating” for services in Classes 35, 38, 41 and 42.

4. On August 28, 2015, Petitioner filed a U.S. trademark application for registration of the mark “truRating THE RATINGS REVOLUTION” and design for services in Classes 35 and 42 in the U.S. Patent & Trademark Office (“PTO”). The application was assigned Serial No. 86/741,301 (the “truRating Application”). On December 11, 2015, the PTO Examining Attorney refused to register the truRating Application based on a likelihood of confusion under Section 2(d) of the Trademark Act with Respondent’s Registration No. 4,423,790 for the mark TrueRatings.

5. On information and belief, Respondent has not used the TrueRatings mark in commerce on any of the services listed in the 4,423,790 Registration on or prior to issuance of the 4,423,790 Registration on October 29, 2013.

6. On information and belief, Respondent has never used the designation TrueRatings as a trademark in commerce on each of the services recited in 4,423,790 Registration, namely, an interactive web site for users to review and rate internet content, people, companies, products and/or services utilizing a software application to award points whereby web site users are eligible to exchange points earned for promotional items consisting of

coupons, rebates, discounts or special offerings on goods and/or service provided by web site sponsors; Attorney referrals; Audit support services, namely, review and analysis of a company's sales, as well as the preparation, organization and presentation of the documents and data requested by a government body, and advice on government audit processes, policies and strategy; Business consulting services, namely, providing a turnkey business solution for reviewing products and services, planning documentation and workflow, hiring technical writers, managing projects for business purposes, tracking user satisfaction, and running usability studies for business purposes; Business consulting services, namely, providing a turnkey solution for reviewing product and service documentation and workflow, managing projects for business purposes, tracking user satisfaction, and running usability studies for business purposes; Health care cost review; Health care utilization and review services; Promoting the goods and services of others by providing a website featuring coupons, rebates, price-comparison information, product reviews, links to the retail websites of others, and discount information; Providing a web site featuring statistical data on physicians' performance for the purpose of assisting prospective patients in making physician selection decisions; Providing business research services, namely, researching dental patient insurance information for dental offices; Providing independent ratings and reviews of other businesses for commercial purposes. Providing independent review of clinical trials for business purposes; Providing information on the topic of promoting patient, physician and employee satisfaction via a global computer network, providing a website featuring temporary use of non-downloadable software allowing website users to post ratings, reviews and recommendations on employers and employees and places of employment for use by employees, employers, business owners, and consumers; providing a website featuring

temporary use of non-downloadable software allowing website users to post ratings, reviews and recommendations on products and services for commercial purposes.

7. On information and belief, any use of the designation TrueRatings by Respondent has been de minimis, and thus legally insufficient to support a U.S. trademark registration.

8. Registration No. 4,423,790 is void ab initio based on non-use of the TrueRatings mark.

WHEREFORE, Petitioner believes that it is being and will be damaged by the continued presence on the Principal Register of Registration No. 4,423,790 for TrueRatings and petitions that it be cancelled.

Please recognize as attorneys for Petitioner in this proceeding Jeffrey I. D. Lewis, and Victoria J. B. Doyle (members of the Bar of the State of New York), and the law firm of Fried, Frank, Harris, Shriver & Jacobson LLP, One New York Plaza, New York, New York 10004. Please address all communications to Victoria J. B. Doyle, Esq. at the above address.

Respectfully submitted,

Dated: June 6, 2016

By: /Victoria J. B. Doyle/  
Jeffrey I. D. Lewis  
Victoria J. B. Doyle

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Attorneys for Petitioner  
TruRating Ltd.

**CERTIFICATE OF SERVICE**

I certify under penalty of perjury pursuant to 28 U.S.C. § 1746 that on the 6th day of June, 2016, I caused to be served on the following, by First Class Mail, postage prepaid, a true copy of the foregoing Petition for Cancellation:

Mr. Adam Summers  
7704 Quarterfield Road  
Suite E  
Glen Burnie, Maryland 21061

/Victoria J. B. Doyle/

**EXHIBIT B**





Promoting the goods and services of others by providing a website featuring coupons, rebates, price-comparison information, product reviews, links to the retail websites of others, and discount information; Providing a web site featuring statistical data on physicians' performance for the purpose of assisting prospective patients in making physician selection decisions; Providing business research services, namely, researching dental patient insurance information for dental offices; Providing independent ratings and reviews of other businesses for commercial purposes. Providing independent review of clinical trials for business purposes; Providing information on the topic of promoting patient, physician and employee satisfaction via a global computer network

and in Class 42 for

[p]roviding a website featuring temporary use of non-downloadable software allowing website users to post ratings, reviews and recommendations on employers and employees and places of employment for use by employees, employers, business owners, and consumers; providing a website featuring temporary use of non-downloadable software allowing website users to post ratings, reviews and recommendations on products and services for commercial purposes.

2. Petitioner Paradise Int'l has used and continues to use "TrueRating.com" and "TrueRating" on the web as mark(s)<sup>1</sup> for their services, at [www.truerating.com](http://www.truerating.com), and specifically in connection with "[e]lectronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes."

3. On May 31, 2017 Petitioner filed a U.S. trademark application for registration of the mark "TureRating.com" for services in Class 35 in the U.S. Patent & Trademark Office ("PTO"). The application was assigned Serial No. 87470035 (the "TrueRating.com Application"). On August 29, 2017 the PTO Examining Attorney refused to register the TureRating.com Application based on a likelihood of confusion with Respondent's Mark under Section 2(d) of the Lanham Act.

4. Dr. Summers is a successful practicing plastic surgeon.

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<sup>1</sup> Under well-settled law, and as acknowledged by the Respondent in correspondence with the Petitioner, "TrueRating.com" and "TrueRating" are effectively one and the same mark.

5. Dr. Summers is listed, in his personal capacity, as the owner of the mark in the trademark application for the Respondent's Mark ("Respondent's Application").

6. Dr. Summers is listed, in his personal capacity, in the "Correspondence Information" section of Respondent's Application.

7. Every statement and claim regarding use set forth in Respondent's Application was based solely on Dr. Summers's alleged activities and uses of the Respondent's Mark. There is not a single statement or claim regarding use that purports to refer to the activities of any other person. Dr. Summers was not relying on information from any other person when filling out Respondent's Application – all of the statements and claims come from Dr. Summers's first-hand knowledge.

8. Dr. Summer signed, in his personal capacity, Respondent's Application, and thereby personally attested under oath to the truthfulness of all the statements and claims set forth therein.

9. Dr. Summers has not established any business entity to engage in any of the goods and services listed in Respondent's Application.

10. Respondent had not used the Respondent's Mark in commerce on any of the goods or services identified in Respondent's Application on or prior to the first-use date of February 1, 2008 set forth therein.

11. Respondent has never used the Respondent's Mark as a trademark in commerce on the services recited in the Respondent's Application, and has certainly never used the Respondent's Mark on *all* of the services recited in the Respondent's Application.

12. Respondent had full knowledge that his original application to the USPTO, which resulted in the Respondent's Registration, was riddled with falsehoods and grossly overstated his use of the Respondent's Mark.

13. Respondent knowingly submitted and attested to these falsehoods with the intent of acquiring a registration to which he knew he was not entitled, and with the intent of deceiving the USPTO.

14. Respondent's Registration was therefore improperly acquired through fraud on the USPTO.

15. Respondent's Registration is also therefore void *ab initio* based on non-use of the Respondent's Mark.

16. Because the Respondent has never used the Registrant's Mark in commerce, and because Petition has continuously used its mark and continues to do so, Petition must be deemed the senior user and must be granted priority over the Respondent's Mark.

17. Petitioner has been and continues to be harmed by the Respondent's Registration because, among other things, the TrueRating.com Application has been refused and the Petitioner's efforts to develop its mark and related business have been and will continue to be hampered by the Respondent's threats and interference.

**WHEREFORE**, the Petitioner petitions that the PTO cancel Respondent's Registration.

Dated: New York, New York  
May 4, 2018

**THE ENGEL LAW GROUP, PLLC**

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