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

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|---------------------------|--|
| Proceeding | 92074305 |
| Party | Defendant Automated Pet Care Products, LLC |
| Correspondence Address | AUTOMATED PET CARE PRODUCTS LLC 2900 AUBURN CT AUBURN HILLS, MI 48326 UNITED STATES Primary Email: tmapps@krinternetlaw.com No phone number provided. |
| Submission | Motion to Dismiss - Rule 12(b) |
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| Signature | /Virginia Sanderson/ |
| Date | 08/04/2020 |
| Attachments | Mtn. to Dismiss Petition for Cancellation of LITTER-ROBOT (FINAL 8.4.20).pdf(215948 bytes) |

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

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|-----------------------------------|---|-----------------------------|
| ROBOTSHOP INC., |) | Cancellation No.: 92074305 |
| |) | |
| Petitioner, |) | Registration No.: 5,259,515 |
| |) | |
| v. |) | |
| |) | Mark: LITTER-ROBOT |
| |) | |
| AUTOMATED PET CARE PRODUCTS, LLC, |) | |
| |) | |
| Respondent. |) | |
| |) | |

RESPONDENT’S MOTION TO DISMISS PETITIONER’S CANCELLATION

Pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure (“FRCP”) and Section 503, *et seq.*, of the Trademark Trial & Appeal Board Manual of Procedure (“TBMP”), Respondent Automated Pet Care Products, LLC (formerly Automated Pet Care Products, Inc.) (“Respondent” or “AutoPets”) hereby moves to dismiss Petitioner RobotShop Inc. (“Petitioner” or “RobotShop”)’s Cancellation of AutoPets’ Registration No. 5,259,515 (the “515 Registration”) for the mark LITTER-ROBOT (the “Mark” or “LITTER-ROBOT Mark”). As demonstrated below, each of the claims set out in the Petition are defective because Petitioner has not stated, nor can it state, claims for which relief may be granted.

Petitioner’s petition suffers from clear deficiencies that warrant dismissal. First, Petitioner’s allegation that the Mark is generic and/or merely descriptive is deficient as Petitioner fails to plead facts that amount to a plausible claim. In addition, Petitioner fails to satisfy the heightened pleading standards for fraud, as set forth in Rule 9(b) of the Federal Rules of Civil

Procedure, or the specific requirements for pleading fraud on the United States Patent and Trademark Office (“USPTO”), as set forth in *In re Bose Corp.*, 580 F.3d 1240 (Fed. Cir. 2009). Indeed, Petitioner’s claim of fraud makes unsubstantiated, conclusory allegations of “fact” based on nothing more than an “inference” and Petitioner’s inaccurate and incomplete review of the Response and Affidavit submitted to the USPTO. Furthermore, Petitioner’s Petition for Cancellation entirely fails to plead any facts that would establish that Respondent had the specific intent to deceive the USPTO.

In short, Petitioner’s Petition does not allege facts from which the Board could reasonably infer that Respondent’s Mark is generic and/or descriptive or that Respondent committed fraud on the USPTO in procuring and maintaining its ‘515 Registration for the LITTER-ROBOT Mark. Given these serious pleading deficiencies, Petitioner’s Petition for Cancellation should be dismissed.

I. FACTUAL BACKGROUND

The following facts are taken in part from the allegations in the Petition (which, if well pled, are to be accepted as true solely for purposes of the instant motion), the documents referenced therein, the ‘515 Registration, and its associated file wrapper.¹

Respondent AutoPets is a Michigan based company that produces, markets, and sells the Litter-Robot, an automatic self-cleaning robotic litter box for cats. Respondent owns all associated intellectual property, including its original marketing photographs, trademarks, trade dress, and packaging design. Respondent also has federal registrations for a multitude of trademarks, including three registrations for the mark LITTER-ROBOT under USPTO Reg. Nos. 4674125,

¹ The Registration, and the file wrapper containing it, are of record because “[t]he file of each . . . registration against which a petition or counterclaim for cancellation is filed forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose in accordance with paragraph (b)(2) of this section.” 37 C.F.R. §2.122(b)(1).

4674124, and 5259515. At issue in Petitioner's Cancellation is Respondent's '515 Registration for the word mark LITTER-ROBOT, which covers goods in Class 3 for "[a]utomated pet appliances, namely, litter boxes" (the "Goods").

On October 13, 2016, Respondent filed its application for the LITTER-ROBOT Mark, claiming a first-use date of April 7, 2000. On February 1, 2017, a Priority Action was issued against the application on the basis of descriptiveness. Because the LITTER-ROBOT Mark had been in-use since 2000, Respondent's attorney intended to assert a claim of acquired distinctiveness in order to overcome the refusal. On March 28, 2017, Respondent filed its response to the refusal (the "Response") claiming the LITTER-ROBOT Mark had obtained secondary meaning based on consistent use in commerce for over 17 years, the number of Litter-Robot units sold under the mark, the amount spent on marketing LITTER-ROBOT branded products, and articles/publications featuring the Litter-Robot. To further support its contentions, Respondent submitted with its Response an affidavit signed by its President, Brad Baxter (the "Affidavit"). The USPTO accepted Respondent's Response and on August 8, 2017, the Certificate of Registration was issued for the LITTER-ROBOT Mark. Since its inception, Respondent AutoPets has continuously used the LITTER-ROBOT Mark in U.S. commerce in connection with the relevant Class 3 Goods.

As admitted by Petitioner in its Petition for Cancellation, Petitioner is a reseller of Respondent's Litter-Robot in Canada. Petition ¶2 & Exs. A-B, & D. In mid-May 2020, a dispute arose between Petitioner and Respondent AutoPets regarding Petitioner's sudden use of the LITTER-ROBOT Mark in the promotion and sale of non-AutoPets products. Petition ¶16 & Ex. D.

On May 26, 2020, Petitioner commenced the instant cancellation proceeding asserting

three claims, namely that the LITTER-ROBOT Mark is generic and/or descriptive and fraudulent procurement. Petitioner's claim for fraud rests upon the argument that the Affidavit submitted by Respondent in connection with its Office Action Response is defective because it was not signed under oath and was directed to the mark "litter robot" rather than the mark "litter-robot." For the reasons stated below, Petitioner fails to state a single valid claim for relief and the Petition should be dismissed without leave to amend the same.

II. LEGAL STANDARD

The purpose of Rule 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.*, 988 F.2d 1157, 1160 (Fed. Cir. 1993). To survive a motion to dismiss, a petition for cancellation must allege "sufficient factual content that, if proved, would allow the Board to conclude, or to draw a reasonable inference, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the registration." *Dragon Bleu (Sarl) v. VENM, LLC*, 112 U.S.P.Q.2d 1925, 1926 (TTAB 2014). A petition to cancel must "state a claim to relief that is plausible on its face." *Bell Atl. Corp. v. Twombly*, 550 U.S. 554, 570 (2007). Specifically, the claimant in a TTAB proceeding "must allege well-pleaded factual matter and more than '[t]hreadbare recitals of the elements of a cause of action, supported by mere conclusory statements.'" TBMP §503.02 (citing *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009)). This means the factual allegations of a complaint must be sufficient to "raise a right to relief above the speculative level." *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007).

III. ARGUMENT

A. Petitioner Fails to Plead Facts That Amount to a Plausible Claim That Respondent's Mark is Generic or Merely Descriptive

Petitioner seeks cancellation of the LITTER-ROBOT Mark on the grounds that the mark is generic for automated pet appliances, namely, litter boxes. *See* Petition ¶¶17-19. In order to prevail on its claim that the Mark is generic, Petitioner must establish that it has become the generic name for the goods offered in connection with it. *See* Lanham Act §14(3), 15 U.S.C.A §1064(3). However, Petitioner fails to provide any basis on which the LITTER-ROBOT Mark can be found to be generic.

In support of its claim, Petitioner alleges that “[t]he generic designation ‘litter robot’ has been used not only by Petitioner (as robot litter), but also by other pet appliance providers to identify their robot litters.” *See* Petition ¶5. Additionally, Petitioner attaches copies of its webpage and those of third parties using the phrase “robot litter.” Petition Exs. A-C. Petitioner’s allegations are insufficient because the registration at issue in this proceeding is for LITTER-ROBOT not “robot litter.” The fact that Respondent has also disputed the confusing nature of Petitioner’s use of “robot litter” simply has no bearing on this cancellation proceeding. Petition Ex. D. Yet, rather than establishing that Respondent’s Mark is generic, Petitioner instead focuses on its own use of the generic phrase “robot litter.” The assertion that “robot litter” is generic is irrelevant to the continued registration of the Mark. Moreover, while Petitioner has submitted evidence that it has used “robot litter” in conjunction with Respondent AutoPets’ products, it has made no showing of the reverse—namely, that Petitioner has used the LITTER-ROBOT Mark in conjunction with non-AutoPets’ products. Petitioner’s inclusion of Exhibit C to the Petition, a purported screenshot of a single third-party’s website using the phrase “litter robot” in conjunction with a non-AutoPets product, is evidence of infringement, not genericization. Petitioner’s allegations of generic designation are entirely conclusory and can therefore be disregarded on this motion. Petition ¶¶17-19; *see also Iqbal, supra*, 556 U.S. at 678 (“Threadbare recitals of the elements of a cause of action,

supported by mere conclusory statements, do not suffice” to avoid dismissal.); *see also id.* at 678–79 (federal pleading standards do “not unlock the doors of discovery for a plaintiff armed with nothing more than conclusions.”) Accordingly, Petitioner does not assert any facts on which one can conclude that Respondent’s LITTER-ROBOT Mark is generic.

In addition to its claim that the Mark is generic, Petitioner asserts that the “designation ‘litter-robot’ is merely descriptive of the goods listed in the ‘515 Registration, and Respondent has not shown and cannot show that the designation has acquired distinctiveness.” *See* Petition ¶20.

Section 2(f) of the Lanham Act provides that “nothing ... shall prevent the registration of a mark used by the applicant that has become distinctive of the applicant's goods in commerce.” 15 U.S.C. §1052(f). Under Section 2(f), a mark that is otherwise barred from registration in view of other Section 2 requirements can still obtain registration if the applicant proves that the mark has become distinctive. *See Yamaha Int’l Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 1580 (Fed. Cir. 1988). Therefore, the presumption of validity that attaches to a Section 2(f) registration includes a presumption that the registered mark has acquired distinctiveness. To rebut this presumption, a party seeking to cancel a Section 2(f) registration must produce sufficient evidence for the Board to conclude, in view of the entire record in the cancellation proceeding, that the party has rebutted the mark's presumption of acquired distinctiveness by a preponderance of the evidence. *See 3 McCarthy on Trademarks and Unfair Competition* §20:64 (5th ed.). Respondent AutoPets’ Mark has acquired distinctiveness under Section 2(f) of the Trademark Act (15 U.S.C. §1052(f)).

Petitioner asserts—incorrectly—that Respondent’s Mark has not gained acquired distinctiveness because the Affidavit submitted along with a Statement under Section 2(f) was misleading and/or submitted fraudulently. Aside from this meritless accusation, which is discussed

in further detail below, Petitioner fails to assert any facts on which one could rebut the presumption that the Mark has acquired distinctiveness under Section 2(f) or that the Mark is merely descriptive.

For the foregoing reasons, Petitioner has failed to state a cognizable claim for cancellation of Respondent's Mark on the grounds of genericness or mere descriptiveness. As such, Petitioner's first and second grounds must be dismissed in their entirety.

B. Petitioner Fails to State a Claim for Fraud

“Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application.” *In re Bose Corp.*, 580 F.3d 1240, 1243 (Fed. Cir. 2009) (quoting *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 48 (Fed. Cir. 1986)). 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 USPTO; (ii) the false representation is material to the registrability of the mark; (iii) registrant had knowledge of the falsity of the representation; and (iv) registrant made the representation with intent to deceive the USPTO. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009). Further, at the pleading stage, FRCP 9(b) requires parties alleging fraud to “state with particularity the circumstances constituting fraud.” Fed. R. Civ. P. 9(b). Thus, while “[m]alice, intent, knowledge, and other conditions of person's mind may be alleged generally[,]” *Id.*, the law requires a petitioner claiming fraudulent procurement to allege with particularity those facts tending to show that the registrant engaged in fraud in connection with its application. A party seeking cancellation of a trademark registration for fraud bears a heavy burden, because “absent the requisite intent to mislead the USPTO, even a material misrepresentation would not qualify as fraud under the Lanham Act warranting cancellation.” *Id.*

at 1940 (citing *King Auto., Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 1011 n.4, 212 USPQ 801 (CCPA 1981)).

In petitioning to cancel on the ground of fraud, a petitioner must allege the elements of fraud with particularity in accordance with Fed. R. Civ. P. 9(b). CFR ¶2.116(a). Under Rule 9(b), together with Fed. R. Civ. P. 11 and USPTO Rule 11.18, “the pleadings [must] contain explicit rather than implied expression of the circumstances constituting fraud.” *Asian & Western Classics B.V. v. Selkow*, 92 USPQ2d 1478 (TTAB 2009) (quoting *King Auto., Inc.*, 212 USPQ at 803).

Petitioner has not sufficiently alleged that AutoPets knowingly made false statements that were material to the USPTO’s decision in approving the LITTER-ROBOT Mark for registration. Rather, Petitioner makes the following weak allegations for fraud: “[the] Affidavit is misleading because it purports to show that Respondent’s use of the mark was substantially exclusive and continuous for the 5 years prior to the Response. But, the Baxter Affidavit says nothing about exclusive or substantially exclusive use of the mark. Additionally, the Affidavit is defective as it was not under oath as required by TMEP 1604.08(d), and therefore is not actually an affidavit, nor does it a declaration for at least the same reason...The Affidavit is further misleading because it is specifically directed to the mark ‘litter robot’ which was not the mark for which registration was sought and ultimately obtained...These facts show, or at least infer, that at the time of Respondent’s Response, Registrant intended to obfuscate the issue by providing misleading arguments, including arguments where the person most knowledgeable about the facts did not sign.” Petition ¶12, 14, and 29.

Petitioner’s claim of fraud fails because Petitioner does not identify a single fact, which, if true, would support even an inference of deceptive intent. *See NSM Res. Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1034 (TTAB 2014). Instead, Petitioner’s claim is based on its allegations that

Respondent's evidence showing the Mark was distinct and had secondary meaning was insufficient. Petitioner does not, however, allege that Respondent intentionally made any false statements in offering such evidence or that the evidence was fraudulent or provide any fact from which deceptive intent can be inferred. Rather, Petitioner alleges that the Response submitted by Respondent AutoPets was, in its view, misleading and hence was submitted fraudulently. Petitioner fails to allege that Respondent knowingly made a false statement to the USPTO. *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ 1925, 1928 (TTAB 2014) (dismissing fraud counterclaim because the applicant failed to allege any false statements on which the claim could lie). Petitioner's allegations concerning Respondent's purported misleading evidentiary showing do not give rise to an inference of deceptive intent. *Id.* at 9 ("Even if we were to find that the Examining Attorney erred in accepting Opposer's arguments in favor of registration ... there is no fraud absent an actually false statement").

In summary, Petitioner's fraud claim is not actually based on fraud, but instead asserts, at best, a decision by the examining attorney based on sloppy paperwork. Because Petitioner has failed to plead any fraudulent intent with the requisite particularity and, as such, Petitioner's third ground for cancellation must be disregarded.

IV. CONCLUSION

For the foregoing reasons, Respondent respectfully asks the Board to grant its Motion to Dismiss under Rule 12(b)(6) and TBMP §503, *et seq.* and dismiss all of Petitioner's claims with prejudice.

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DATED: August 4, 2020

Respectfully Submitted,
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CERTIFICATE OF SERVICE

I hereby certify that on August 4, 2020, a true and correct copy of the foregoing RESPONDENT'S MOTION TO DISMISS PETITIONER'S CANCELLATION was filed electronically with the Trademark Trial and Appeal Board via ESTTA.

I further certify that on August 4, 2020, a true and correct copy of the foregoing RESPONDENT'S MOTION TO DISMISS PETITIONER'S CANCELLATION was served on Petitioner's Attorney of Record by electronic mail as follows:

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DATED: August 4, 2020

By: /Virginia Sanderson/