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

Proceeding	92077077
Party	Plaintiff Loren Miles
Correspondence Address	MICHAEL G. SMITH 433 BELLE GROVE RD. PO BOX 833022 RICHARDSON, TX 75080 UNITED STATES Primary Email: pto@patent-counselors.com 512-539-8753
Submission	Opposition/Response to Motion
Filer's Name	Michael G. Smith
Filer's email	pto@patent-counselors.com
Signature	/Michael G. Smith/
Date	10/12/2021
Attachments	ResponseToAnswer5962194.pdf(80692 bytes )

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<b>Party</b>	<b>Plaintiff Loren Miles</b>
<b>Correspondence Address</b>	<b>433 BELLE GROVE RD., PO BOX 833022, RICHARDSON TX UNITED STATES, 75080</b>
<b>Submission</b>	<b>Response to Answer</b>
<b>Filer's Name</b>	<b>Michael G. Smith</b>
<b>Filer's Email</b>	<b>pto@patent-counselors.com</b>
<b>Signature</b>	<b>/Michael G. Smith/</b>
<b>Date</b>	<b>12 OCT 2021</b>
<b>Attachments</b>	<b>Exhibits 1-10</b>

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

In the Matter of:

Registration No. 5,962,194 for INSPR, Classes 25, 35 and 45, registered 14 Jan 2020

Loren Miles, Individual Plaintiff
v.
INSPR, LLC Owner

Cancellation No.:  
Reg. No. 5,962,194  
Mark: INSPR

**Plaintiff's Response to  
Defendant Registrant's Answer dated 29 AUG 2021**

## I. INTRODUCTION

The Order to Suspend Proceedings dated 08 Sept 2021 stated "... no party should file any paper which is not germane to the motion" and that "[a]ny paper filed during the pendency of this motion which is not relevant thereto will be given no consideration".

Plaintiff requests that this Response to Defendant Registrant's Motion for Judgement be entered into the record of these proceedings and considered because the arguments herein and a new Affidavit dated 27 Aug 2021 are germane and relevant because they tend to prove not only is the Defendant Registrant's Motion for Judgement inappropriate at this stage of the proceedings, but that the trademark "INSPR" Reg. No. 5,962,194 should be canceled.

Plaintiff opposes the Defendant Registrant's Motion for Judgement on the pleadings because under the TTAB *precedential* opinion in Nationstar Mortgage LLC v. Ahmad, Opposition No. 91177036, no reasonable jury would find that the Defendant Registrant was merely negligent, and thus the Defendant Registrant intentionally deceived the public and the USPTO as to the identity of the Owner of trademark "INSPR" Reg. No. 5,962,194.

In addition, Plaintiff submits a new affidavit that casts doubt on the Defendant Registrant's use of the trademark "INSPR" Reg. No. 5,962,194.

Accordingly, Plaintiff petitions the TTAB to cancel the registration of trademark "INSPR" Reg. No. 5,962,194.

## II. STATEMENT OF UNCONTROVERTED MATERIAL FACTS

Plaintiff offers a chronological timeline of facts as best known in reference to public records and the pleadings of the Defendant Registrant:

- A. On 05 Jan 2018, "INSPR, INC." was formed in Delaware as a "Domestic Entity". Yet as of 30 Sept 2021, "INSPR, INC" in Delaware had no registered agent (and as such the

Delaware Department of State, Division of Corporations have stated the corporation's status as "Forfeited, Failure to appoint R/A." Exhibit 1 submitted herewith and incorporated by reference herein.

- B. On 15 Mar 2018, trademark application serial #87835621 was filed for mark "INSPR" with Owner of Mark being "INSPR LLC" with Owner address at 645 Shore Acres Drive, Mamaroneck, NY 10543. Exhibit 2 submitted herewith and incorporated by reference herein.
- C. On 07 Aug 2018, in the state of Delaware, "Inspr, LLC" was converted to "Inspr Inc." Delaware Secretary of State file #6702051. Exhibit 1 of the Answer of Defendant Registrant dated 15 June 2021 and paragraph 1 of the Answer of Defendant Registrant dated 15 June 2021 and incorporated by reference herein.
- D. On 12 Sept 2018, a Change of Correspondence address for the representing law firm was filed. Exhibit 3 submitted herewith and incorporated by reference herein.
- E. On 13 May 2019, Notice of Publication was made to Applicant "INSPR LLC". Exhibit 4 submitted herewith and incorporated by reference herein.
- F. On 28 May 2019, Notice of Allowance was made to Applicant "INSPR LLC" with Owner address at 645 Shore Acres Drive, Mamaroneck, NY 10543. Exhibit 5 submitted herewith and incorporated by reference herein.
- G. On 27 Nov 2019, Statement of Use was filed by Applicant "INSPR LLC" with Owner address at 645 Shore Acres Drive, Mamaroneck, NY 10543. Exhibit 6 submitted herewith and incorporated by reference herein.
- H. On 27 Nov 2019, the trademark "INSPR" Reg. No. 5,962,194 was granted to Applicant "INSPR LLC" with Owner address at 645 Shore Acres Drive, Mamaroneck, NY 10543.

Exhibit 7 submitted herewith and incorporated by reference herein.

- I. On 23 Sept 2020, “INSPR, INC.” in the state of Delaware became “Forfeited, Failure to appoint a R/A”, which means that “INSPR, INC.” became non-existent in the state of Delaware due to failure to have a registered agent. Furthermore, the “the Tax Information” indicates that the last annual report was filed for 2018 and the “Filing History” indicates that on 24 Aug 2020 that “Agent Resignation” occurred without appointment of another agent. Exhibit 1 submitted herewith.
- J. On 14 OCT 2020, the trademark “INSPR” Reg. No. 5,962,194 was sold by “Inspr Inc” to INSPR Partners, LLC of Missouri. Exhibit H of the Response of Defendant Registrant dated 29 Aug 2021 and incorporated by reference herein.
- K. On 05 May 2021, this Petition for Cancellation was filed by Plaintiff.
- L. On 07 July 2021, the assignment of the mark from “INSPR Inc” to “INSPR PARTNERS LLC” was executed. Exhibits I-L H of the Response of Defendant Registrant dated 29 Aug 2021 and incorporated by reference herein.
- M. On 09 July 2021, the assignment of the mark from “INSPR Inc” to “INSPR PARTNERS LLC” was recorded at the USPTO. Exhibits I-L H of the Response of Defendant Registrant dated 29 Aug 2021 and incorporated by reference herein
- N. As of the day of the submission of this Response, the Owner of trademark “INSPR” Reg. No. 5,962,194 is still publicly identified as “INSPR LLC” with Owner address at 645 Shore Acres Drive, Mamaroneck, NY 10543. Exhibit 8 submitted herewith and incorporated by reference herein.
- O. The Affidavit of Robin Bykofsky dated 27 AUG 2021 submitted herewith asserts that Joanna Williams of INSPR stated on 17 June 2021 that “we have not been in business

since March 2020” and that INSPR “have no inventory since that time” and incorporated by reference herein. Exhibit 9 submitted herewith and incorporated by reference herein.

**III. ANSWER TO DEFENDANT REGISTRANT’S RULE 12(C) MOTION FOR  
JUDGMENT ON THE PLEADINGS**

The Defendant Registrant’s Motion for Judgement on the pleadings rests on the assertion that there is no issue of material fact and that there is insufficient evidence for a reasonable jury to return a verdict in favor of the Plaintiff. Plaintiff asserts that issue of material fact exist and that there is sufficient evidence for a reasonable jury to return a verdict in favor of the Plaintiff.

Defendant Registrant’s Motion for Judgement on the pleadings fails on both prongs.

1. Genuine Issue of Material Fact

One genuine issue of material fact is whether the Defendant Registrant was merely negligent or intentional in not reporting the identity of the Owner of the trademark “INSPR” Reg. No. 5,962,194.

2. Sufficient Evidence exists for a Reasonable Jury to Return a Verdict in Favor of the Plaintiff

The Trademark Trial and Appeal Board (TTAB) at the U.S. Patent and Trademark Office (PTO) issued a *precedential* opinion in Nationstar Mortgage LLC v. Ahmad, Opposition No. 91177036, which is the most recent comprehensive statement by the TTAB on the standard of proof in a fraud claim at the PTO since *In re Bose Corp.*, 580 F.3d 1240 (Fed. Cir. 2009).

Most surprisingly, the Answer dated 29 Aug 2021 neglects to discuss, mention or even cite this controlling precedential opinion on fraud and intent to deceive by the TTAB.

In finding that the applicant’s misrepresentations were fraudulent, the TTAB acknowledged that allegations of fraud should not be taken lightly and that “[s]ubjective intent to deceive, however difficult it may be to prove, is an indispensable element in the analysis.” Slip Op. at 33 (citing Bose). “While fraud will not lie if a statement, though false, was made with a

reasonable and honest belief that it was true,” the TTAB stated, “there are limits to what may be claimed in good faith.” *Id.* The TTAB concluded:

[T]he law does not require “smoking gun” evidence of deceptive intent, but instead has long recognized that direct evidence of deceptive intent is rarely available and deceptive intent may be inferred from the surrounding facts and circumstances. *See id.* We may infer deceptive intent where, “the involved conduct, viewed in light of all the evidence...indicate[s] sufficient culpability to require a finding of intent to deceive.” *Id.* at 33-34.

The representations of the Owner of the trademark “INSPR” Reg. No. 5,962,194 have been habitual and consistent from 07 Aug 2018 to now, as shown below.

On 15 Mar 2018, trademark application serial #87835621 was filed for mark “INSPR” with Owner of Mark being “INSPR LLC” with Owner address at 645 Shore Acres Drive, Mamaroneck, NY 10543, even though “INSPR LLC” was a Delaware entity.

On 07 Aug 2018, in the state of Delaware, “Inspr, LLC” was converted to “Inspr Inc.” Delaware Secretary of State file #6702051. Accordingly, “Inspr, LLC” has not existed since 07 August 2018”, which made “INSPR, Inc” the Owner of the mark.

On 13 May 2019, Notice of Publication was made to Applicant “INSPR LLC”, the lack of correction of the Owner is a misrepresentation to the public and to the USPTO as to the identity of the Owner of the mark because “Inspr Inc.” was held out to the public and the USPTO as the Owner of the mark at that time since “Inspr, LLC” had already been converted to “Inspr Inc.” and thus “INSPR LLC” did not exist at that time.

On 28 May 2019, Notice of Allowance was made to Applicant “INSPR LLC” with Owner address at 645 Shore Acres Drive, Mamaroneck, NY 10543. The lack of correction of the Owner is a misrepresentation to the public and to the USPTO as to the identity of the Owner of the mark because “Inspr Inc.” was held out to the public and the USPTO as the Owner of the mark at that time since “Inspr, LLC” had already been converted to “Inspr Inc.” and thus

“INSPR LLC” did not exist at that time.

On 27 Nov 2019, Statement of Use was filed by Applicant “INSPR LLC” with Owner address at 645 Shore Acres Drive, Mamaroneck, NY 10543 which is a misrepresentation to the public and to the USPTO as to the identity of the Owner of the mark because “Inspr Inc.” was held out to the public and the USPTO as the Owner of the mark at that time since “Inspr, LLC” had already been converted to “Inspr Inc.” and thus “INSPR LLC” did not exist at that time.

On 27 Nov 2019, the trademark “INSPR” Reg. No. 5,962,194 was granted to Applicant “INSPR LLC” with Owner address at 645 Shore Acres Drive, Mamaroneck, NY 10543. The lack of correction of the Owner is a misrepresentation to the public and to the USPTO as to the identity of the Owner of the mark because “Inspr Inc.” was held out to the public and the USPTO as the Owner of the mark at that time since “Inspr, LLC” had already been converted to “Inspr Inc.” and thus “INSPR LLC” did not exist at that time.

On 23 Sept 2020, the state of “INSPR, INC.” in the state of Delaware became “Forfeited, Failure to appoint a R/A”, which means that “INSPR, INC.” became non-existent in the state of Delaware.

On 14 OCT 2020, the trademark “INSPR” Reg. No. 5,962,194 purportedly was sold by “Inspr Inc” to INSPR Partners, LLC of Missouri, which was an invalid transaction because “Inspr Inc” not exist at that time (see previous paragraph), thus “Inspr Inc” did not own the mark at that time, and could not convey Ownership of the mark.

On 09 July 2021, the assignment of the mark from “INSPR Inc” to “INSPR PARTNERS LLC” was recorded at the USPTO, only after the filing of this Petition for Cancellation, and presumably only because of the filing this petition. Defendant Registrant has not offered any evidence that the assignment was recorded in order to comply with the public’s interest in

knowing the Owner and thus the source of goods manufactured under the mark.

The habitual and consistent misrepresentations of the Owner of the mark are beyond mere negligence, especially since the prosecution of the mark was managed by a law firm.

No reasonable jury would find the habitual and consistent misrepresentation of the Owner of the mark to be based on “a reasonable and honest belief that it was true”. Perhaps some mistakes for a short period of time might be understandable as mere neglect, but repeated misrepresentations of Ownership to the USPTO over the extended period of time from 07 Aug 2018 to now would almost assuredly be understood by a jury as intentional.

The TTAB also stated in *Nationstar Mortgage LLC v. Ahmad* that:

“Applicant was obligated to read and understand what he was signing and investigate the accuracy of his statements in the application to confirm they had evidentiary support prior to signature and submission to the USPTO”. *Id* at 38. And “Applicant’s signature and submission of the application to the Office was subject to the requirements of 37 C.F.R. § 11.18, which requires that a party signing and presenting a paper to the Office conduct a reasonable inquiry to confirm that legal contentions are warranted by existing law and factual contentions have evidentiary support.” *Id* footnote 83 at 38.

Furthermore, the Registrant Defendant cannot blame this on their counsel because the TTAB in *Nationstar Mortgage LLC v. Ahmad* also stated:

Even if counsel had been retained to file the involved application, applicant would have “shared the duty to ensure the accuracy of the application and the truth of its statements.” citing *Hachette*, 85 USPQ2d at 1094 (citing *Smith Int’l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1047 (TTAB 1981)). *Id* at 38-39.

It is very clear from *Nationstar Mortgage LLC v. Ahmad* that the Registrant Defendant had a duty to ensure that the representations to the USPTO were accurate. Not only was this duty breached, but the duty was breached repeatedly over the extended period of time from 07 Aug 2018 to now, from which a reasonable jury could most certainly find an intent to deceive.

Plaintiff maintains assertion of Counts I, II and III from the original Petition filed on 05 May 2021.

#### **NEW COUNT IV**

##### **THE TRADEMARK IS ABANDONED DUE TO NONUSE**

19. This Count IV is added as a new count based on information that has become known to the Plaintiff since the filing of the Petition to Cancel on 05 May 2021.
20. Under Section 45 of the Trademark Act, “a mark shall be deemed to be abandoned “[w]hen its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment.”
21. “INSPR, LLC” has been the registrant and Owner from the beginning of the prosecution of mark 5,962,194 through registration and continues to be the Owner of mark 5,962,194, in accordance with paragraphs C-K above.
22. The registrant and Owner “INSPR, LLC” of mark 5,962,194, has not used the mark 5,962,194 since at least August 7, 2018 when the registrant and Owner “INSPR, LLC” was converted to “INSPR, INC” in the state of Delaware, in accordance with paragraph D above.
23. More than 3 years has transpired since “INSPR, LLC” was converted to “INSPR, Inc.”, in accordance with paragraph 22.
24. The Registrant “INSPR, LLC” has not used the mark 5,962,194 in over 3 years, in accordance with paragraphs 21-23 above.
25. A prima facie case of abandonment of mark 5,962,194 exists by registrant and Owner “INSPR, LLC”, in accordance with paragraphs 20 and 24.

26. Furthermore, the statements by Joanna Williams of INSPR on 17 June 2021 in Exhibit 9 that “we have not been in business since March 2020” and that INSPR “have no inventory since that time” is confirmation and admission of the non-use of mark 5,962,194 “INSPR” during a substantial portion of the last 3 years during which there is also prima facia evidence of abandonment of mark 5,962,194, in accordance with paragraph L above.
27. Joanna Williams was the “Co-Founder, Chief Operating and Supply Chain Officer” of “INSPR” according to her LinkedIn profile. Exhibit 10 submitted herewith and incorporated by reference herein.
28. Plaintiff requests cancelation of mark 5,962,194 due to the prima facia case of abandonment of mark 5,962,194 in accordance with paragraphs 20-25 and non-use of mark 5,962,194 under Section 45 of the Trademark Act in accordance with paragraphs 26-27.

WHEREFORE, Plaintiff Loren Miles, an individual, prays that Registration No. 5962194 be canceled in class 25.

Please recognize Michael G. Smith, member in good standing of the District of Columbia Bar, Bar No. 478674, PO box 833022, 433 Belle Grove Rd., Richardson TX 75080, Phone: 512-539-8753 as Plaintiff Loren Miles, Individual’s attorney in connection with this cancellation proceeding. All correspondence should be directed to Michael G. Smith.

Respectfully submitted

/Michael G. Smith/

Michael G. Smith, Esq.  
Attorney for Plaintiff

PO box 833022, 433 Belle  
Grove Rd., Richardson TX  
75080

pto@patent-counselors.com  
D.C. Bar No. 47867

Date: 12 Oct 2021

CERTIFICATE OF SERVICE

I hereby certify that on 12 SEPT 2021, the foregoing was filed electronically with the Clerk of Court to be served by operation of the Court's electronic filing system upon the following:

Douglas D. Churovich, MO # 77,900  
Churovich Law, LLC  
11916 Paradise Lane  
Des Peres, MO 63131  
(314) 662-0711  
ATTORNEYS FOR CURRENT REGISTRANT,  
INSPR Partners, LLC

Michael R. Graif  
Mintz, Levin, Cohn, Ferris, Glovsky  
and Popeo, P.C.,  
666 Third Avenue  
New York, NY 10017  
(212) 692-6287  
ATTORNEYS FOR ORIGINAL REGISTRANT,  
INSPR INC f/k/a INSPR LLC

s/ Michael G. Smith, Esq.