

ESTTA Tracking number: **ESTTA1269822**

Filing date: **03/04/2023**

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

Proceeding no.	92081480
Party	Defendant BFrank, LLC
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Submission	Motion to Dismiss - Rule 12(b)
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Date	03/04/2023
Attachments	2023.03.03 BFrank motion to dismiss.pdf(130347 bytes )

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

Frank August, LLLP	§	Cancellation No. 92081480
Petitioner,	§	
v.	§	In the matter of Registration
	§	
BFrank, LLC	§	No. 6291012
Respondent.	§	
	§	Mark: BFrank

**MOTION TO DISMISS**

COME NOW Respondent BFrank, LLC (“Respondent”), by and through undersigned counsel moves to dismiss the Petitioner’s Petition to Cancel registration No. 6291012 for failure to state a claim pursuant to Fed. R. Civ. P. 12(b)(6) and Section 503 of the Trademark Trial and Appeal Board Manual of Procedure. In support, thereof, Respondent states as follows:

**PROCEDURAL HISTORY AND ALLEGATIONS OF PETITION TO CANCEL**

1. On May 19, 2020 Respondent filed a Section 1(b) intent-to-use application with the United States Patent and Trademark Office (“USPTO”) for the mark “B Frank” + Design in International Class 25 for “Hats; Hoodies; Leggings; Pants; Shirts; Shirts and short sleeved shirts; Socks; Sports bras; Tights; Athletic jackets; Athletic pants; Athletic shirts; Athletic tights; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Body shirts; Gym pants; Jogging pants; Lounge pants; Moisture-wicking sports bras; Moisture-wicking sports shirts; Short-sleeve shirts; Sport shirts; Sports jackets; Sports pants; Sports shirts; Sports shirts with short sleeves; Sports caps and hats; Stretch pants; Sweat

jackets; Sweat shirts; T-shirts; Tee shirts; Wind pants; Wind shirts; Women's hats and hoods; Yoga pants; Yoga shirts". *See* application serial no. 88922872.

2. On September 22, 2020 Respondent's application was Published for Opposition in the Trademark Official Gazette.
3. Following the expiration of the Opposition period, the USPTO issued a Notice of Allowance to Respondent on November 17, 2020.
4. Respondent supplied the USPTO with the required specimens on January 5, 2021. The specimens were evaluated and examined by the examining attorney assigned to the application, who decided they were sufficient to establish the use as required under both the Lanham Act and the TMEP.
5. As a result, Respondent's application was registered March 9, 2021. *See* registration serial no. 6291012.
6. On June 30, 2022, Petitioner filed a Section 1(b) intent-to-use application with the USPTO for the mark "Be Frank," in International Class 25 for "Hats; Shirts." *See* Application Serial No. 97483514 (herein "Application 514").
7. On August 1, 2022, Petitioner's Application 514 was issued a likelihood of confusion rejection, citing Respondent's existing registration as the basis for said rejection.
8. On January 31, 2023 Petitioner filed a Petition to Cancel. In its petition, Petitioner alleges: (1) On information and belief, Registrant did not use Registrant's Mark in commerce in connection with any or all Registrant's Goods prior to May 17, 2021, the end of the first six month period for showing use set in the Notice of Allowance mailed November 17, 2020, so the verified statement made that the mark was in use on all Registrant's Goods made in the Statement of Use filed January 15, 2021 was false, and such false statement was relied upon

by the U.S. Patent and Trademark Office in issuing the '012 Registration and therefore material to the decision to issue said registration and (2) In the alternative, any use of Registrant's Mark on Registrant's Goods prior to May 17, 2001, was ornamental in nature, and thus failed to function as a registrable mark, pursuant to Sections 1 and 45 of the U.S. Trademark Act, 15 USC Sections 1051 and 1127. See TTABUVE 1 at ¶¶ 7-8.

9. Petitioner's allegations have been debunked through the documents as provided to the USPTO and examined by the examining attorney for Respondent's application.
10. As set forth below, the Petition to Cancel does not allege sufficient facts that support Petitioner is entitled to the relief sought as Petition lacks valid grounds for canceling the subject registration. Accordingly, the Petition to Cancel should be dismissed with prejudice.

#### **LEGAL STANDARDS ON A MOTION TO DISMISS**

Under Federal Rule of Civil Procedure 12(b)(6), a purported cause of action may be dismissed when the complaint fails to state a claim upon which relief can be granted. Under Trademark Trial and Appeal Board Manual of Procedure ("TBMP") §503, a registrant may move to dismiss a petition for cancellation for "failure to state a claim upon which relief can be granted."

To survive a motion to dismiss under rule 12(b)(6), the complaint must meet two criteria: (1) it must assert a plausible claim on its face; and (2) it must set forth and contain sufficient factual allegations to support the claim. *Corporacion Habanos, S.A. v. Rodriguez*, 99 U.S.P.Q.2d 1873, 1874 (TTAB 2011) (citing *Ashcroft v. Iqbal*, 556 U.S 662, 678 (2009)).

"While a complaint attacked by a Rule 12(b)(6) motion to dismiss does not need detailed factual allegations, a plaintiff's obligation to provide the grounds of his entitlement to relief and requires more than labels and conclusions, and a formulaic recitation of the elements of a cause of

action will not do.” *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555 (2007). Instead, a plaintiff must allege facts that raise a reasonable expectation that discovery will reveal evidence of the claim. *Id.* at 556. When a plaintiff has not “nudged their claims across the line from conceivable to plausible, their complaint must be dismissed.” *Id.* at 570. Thus, “only a complaint that states a plausible claim for relief survives a motion to dismiss.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009).

To satisfy the new standard under *Twombly* and *Iqbal*, “a complaint must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Id.* (citing *Twombly*, 550 U.S. at 570). A claim has facial plausibility when the plaintiff pleads enough factual content that allows the court to draw the reasonable inference that the defendant is liable under the alleged claim. *Id.* (citing *Twombly*, 550 U.S. at 556). “A court considering a motion to dismiss can choose to begin by identifying pleadings that, because they are no more than conclusions, are not entitled to the assumption of truth.” *Id.* at 1950. Therefore, if allegations are merely “conclusory,” they are “not entitled to be assumed true.” *Id.* Even if a court decides that the factual allegations are entitled to an assumption of truth, however, the facts must also “plausibly suggest an entitlement to relief.” *Id.* at 1951.

In addition, USPTO filings—as public records—are properly the subject of judicial notice under Federal Rule of Evidence 201 and proper before the Board even on motion to dismiss for failure to state a claim. *See Nike, Inc.*, 116 U.S.P.Q.2d 1025, at \*3; *Express Homebuyers USA, LLC v. WBH Mktg. Inc.*, 323 F. Supp. 3d 784, 789 (E.D. Va. 2018) (confirming that documents “taken directly from the PTO’s website” can be judicially noticed); *Genetic Techs. Ltd. v. Bristol-Myers Squibb Co.*, 72 F. Supp. 3d 521, 526 (D. Del. 2014) (“A court may also take judicial notice of the prosecution histories [of USPTO filings], which are ‘public records.’”).

## ARGUMENTS AND AUTHORITIES

*Petitioner does not provide any factual support for their conclusory allegations.*

Petitioner fails to clear the second hurdle under *Twombly* and *Iqbal*. That is, Petitioner does not provide any factual support for their conclusory allegations. Under *Iqbal*, mere conclusory statements are not entitled to an assumption of truth. 129 S. Ct. at 1950. Therefore, if allegations are merely “conclusory” they are “not entitled to be assumed true.” *Id.* In Petitioner’s complaint paragraphs 7 and 8 entail the entirety of their claims. Paragraph 7 is conclusory and provides no facts or evidence to support it. Petitioner in paragraph 7 furthers, “...the verified statement made that the mark was in use on all Registrant’s goods made in the Statement of Use filed January 15, 2021 was false, and such false statement was relied upon by the U.S. Patent and Trademark Office in issuing the ‘012 Registration.” Under the Federal Rules of Evidence 201 the statement of use (“SOU”) mentioned by the Petitioner, taken directly from the USPTO is judicially noticed, therefore the SOU itself as evidence is considered true. Under 15 U.S.C. §§1051(a)(3)(B) and 1051(b)(3)(C), the verification of an application for registration must include an allegation that "to the best of the signatory's knowledge and belief, the facts recited in the application are accurate." The language in 37 C.F.R. §2.20 that "all statements made of [the signatory's] own knowledge are true and all statements made on information and belief are believed to be true" satisfies this requirement. Such statements were made by the Respondent and accepted by the USPTO. Petitioner incorrectly states the mark was required to be used on “all” goods made in the Statement of Use. On the contrary 37 C.F.R. §§2.56(a), 2.76(b)(2), 2.88(b)(2) requires “one” specimen for each class, which was provided and accepted by the USPTO.

Paragraph 8 of Petitioner’s complaint is also conclusory and provides no facts or evidence to support it. Petitioner alleges any use prior to May 17, 2021 was ornamental in nature and failed

to function as a trademark. Prior to registration, an applicant must file a statement of use under 15 U.S.C. §1051(d) that states that the mark is in use in commerce, and includes dates of use, the filing fee for each class, and one specimen evidencing use of the mark for each class. In examining a specimen filed a statement of use under 15 U.S.C. §1051(d), the examining attorney must refuse registration if the specimen indicates that the goods have not been "sold or transported in commerce." 15 U.S.C. §1127. In an application for registration under §1(b) of the Trademark Act, no specimen is required at the time the application is filed. However, before a registration will issue, the applicant must file an allegation of use that includes one specimen for each class, showing use of the mark in commerce on or in connection with the goods or in the sale or advertising of the services. *See* 37 C.F.R. §§2.56(a), 2.76(b)(2), 2.88(b)(2). Before registration was granted, Respondent was required to submit one specimen per class. Respondent's application was filed in one class; International class 25. Respondent produced three (3) specimens containing various items within International class 25. Examining attorney accepted one of the three specimens submitted as satisfactory and meeting all requirements under the law. As a result, the application was registered. *See* Registration No. [6291012](#).

### **CONCLUSION**

Petitioner is not entitled to a statutory cause of action as required under the law to bring a cancellation. Therefore, Respondent respectfully urges this Board dismiss the Petition to Cancel in its entirety, with prejudice.

Dated: March 3, 2023

Respectfully Submitted,

KEARNEY, MCWILLIAMS & DAVIS, PLLC

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**CERTIFICATE OF SERVICE**

I, Jordan B. Franklin, hereby certify that on March 3, 2023, I served a true and correct copy of the foregoing MOTION TO DISMISS by Respondent, by electronic mail to:

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