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

Proceeding no.	92082065
Party	Defendant Upper Columbia Media Association
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

OLIVET NAZARENE UNIVERSITY

Petitioner,

v.

UPPER COLUMBIA MEDIA
ASSOCIATION

Registrant.

Cancellation No. 92082065

REGISTRANT’S MOTION TO DISMISS

Registrant Upper Columbia Media Association (“Registrant”) hereby submits this Motion to Dismiss Petitioner’s Olivet Nazarene University’s (“Petitioner”) Petition for Cancellation pursuant to Fed. R. Civ. P. 12(b)(6), TBMP Sec. 503, Fed. R. Civ. P. 12(f), and TBMP Sec. 506.

I. INTRODUCTION

Registrant is the owner of U.S. Reg. No. 6,045,426 for the mark SHINE 104.9 and U.S. Reg. No. 6,045,559 for the mark SHINE FEST & Design, both of which registered on May 5, 2020 (hereinafter collectively referred to as the “Challenged Registrations.” Petitioner has filed a Petition for Cancellation against both of the Challenged Registrations. The Petition does not contain any specifically enumerated claims, but appears to allege claims for i) likelihood of confusion, based upon Petitioner’s alleged ownership of U.S. Reg. No. 4,113,384 for the mark SHINE; and ii) fraud, based upon allegedly false statements made by Registrant to the USPTO during the prosecution of the applications that became the Challenged Registrations.

However, Petitioner’s Petition fails to include any specific allegations establishing Petitioner’s entitlement to bring this cancellation proceeding. In addition, Petitioner’s fraud

claim is woefully inadequate because it does not identify the specific allegedly false statements made by Registrant, nor does it allege the required elements of materiality, actual knowledge, and intent to deceive.

Therefore, the Board should dismiss Petitioner's Petition in its entirety, or at a minimum, dismiss Petitioner's fraud claim for failure to state a claim under Rule 12(b)(6).

II. THE STANDARD FOR A MOTION TO DISMISS

A motion to dismiss for failure to state a claim is a test of the legal sufficiency of the allegations in a complaint. See *Advanced Cardiovascular Sys. Inc. v. SciMed Life Sys. Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). In order to withstand such a motion, a complaint must allege such facts as would, if proven, establish that there is a valid ground exists for denying the registration sought, or cancelling an issued registration. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); *Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780, 1782 (TTAB 2012). The Board generally accepts all well-pleaded, material allegations in the complaint that are accepted as true for purposes of a motion to dismiss; however, the Board is "not required to accept as true legal conclusions or unwarranted factual inferences." *In re Bill of Lading Transmission and Processing System Patent Litig.*, 681 F.3d 1323, 103 U.S.P.Q.2d 1045, 1051 (Fed. Cir. 2012).

III. THE BOARD MUST DISMISS THE PETITION FOR FAILURE TO ALLEGE ENTITLEMENT TO A STATUTORY CAUSE OF ACTION

The Board should dismiss Petitioner's Petition in its entirety for failure to allege entitlement to a statutory cause of action to bring this proceeding.¹ Entitlement to a statutory cause of action is an affirmative requirement in every inter partes case before the Board.

¹ This element was previously referred to as "standing," but in recent case law, the Board prefers the term "entitlement to a statutory cause of action." TBMP §309.03(b). There is no meaningful substantive difference between the analysis of "standing" and the analysis of "entitlement to a statutory cause of action." *Id.*

Australian Therapeutic Supplies Pty., Ltd. v. Naked TM, LLC, 965 F.3d 1370, 2020 USPQ2d 10387, at *3 (Fed Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-126 (2014)). In order to establish entitlement to bring a statutory cause of action, a plaintiff must allege that it has a real interest in the proceeding, that it has a belief of damage, and that its belief of damage has a “reasonable basis in fact.” *Ritchie v. Simpson*, 170 F.3d 1092, 1094 (Fed. Cir. 1999).

In this case, Petitioner has failed to explain how it will be damaged by the continued registration of the Challenged Registrations. Petitioner merely alleges that it owns a prior registration for a similar mark, and that Registrant’s use of the marks in the Challenged Registrations is likely to cause confusion. 1 TTABVue, at 2-3. Petitioner never specifically states that it will be harmed by the continued registration of the Challenged Registrations, let alone explain exactly how it will be damaged by the continued registration of the Challenged Registration, for example, by specifically alleging that the continued registration of these marks will impair Petitioner’s ability to freely use and register its alleged SHINE marks, and it is not the Board’s job to try to interpret the allegations in the Petition to imply a claim of damage. *See Energy Beverages LLC v. Burner Water Beverages Ltd.*, Opposition No. 91253791, at *8 (TTAB Jan. 11, 2023) (dismissing opposition for failure to allege entitlement to a statutory cause of action where opposer “[did] not explain how or why Opposer believes it would be harmed” by the registration of the applicant’s mark).

Therefore, as Petitioner has failed to allege entitlement to a statutory cause of action, the Petition for Cancellation must be dismissed in its entirety.

IV. THE BOARD MUST DISMISS PETITIONER’S FRAUD CLAIM FOR FAILURE TO ALLEGE THE REQUIRED ELEMENTS OF FRAUD WITH PARTICULARITY

Even if the Board finds that Petitioner has adequately alleged standing to seek cancellation of Registrant's registrations, the Board must still dismiss the fraud claim for failure to allege a viable claim of fraud.

As noted above, the Petition appears to allege two claims, likelihood of confusion and fraud. The Federal Rules of Civil Procedure and the Board's rules require that any fraud claim must be pleaded "with particularity." Fed. R. Civ. P. 9(b); Trademark Rule 2.116(a). Under these rules, "the pleadings [must] contain explicit rather than implied expression of the circumstances constituting fraud." *King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801, 803 (CCPA 1981). The Board has observed that "[t]here is no room for speculation, inference, or surmise" in a fraud claim. *Smith Int'l, Inc. v. Olin Corp.* 209 U.S.P.Q. 1033, 1044 (TTAB 1981).

Fraud on the Trademark Office occurs when an applicant knowingly makes false, material representations of fact in connection with its application with the intent to deceive the USPTO. *In re Bose Corp.*, 580 F.3d 1240, 1245 (Fed. Cir. 2009); *Nationstar Mortgage LLC v. Ahmad*, 112 U.S.P.Q.2d 1361, 1365 (TTAB 2008). All of these elements must be pleaded with particularity in order for a fraud claim to be properly pled.

Petitioner's fraud claim consists solely of the following allegations in Paragraph 16 of the Petition:

16. Finally, Registrant committed fraud on the United States Patent and Trademark Office by representing that it was not aware of any similar or confusingly similar marks when it prosecuted the registrations of its SHINE 104.9 and SHINE FEST marks, which were knowingly false statements based on actual or constructive knowledge of Petitioner's earlier-registered SHINE trademark.

Petition for Cancellation, 1 TTABVUE at 3.

This bare-bones paragraph clearly fails to meet the requirements of Fed. Rule 9(b). First, Petitioner has failed to identify the specific statement which allegedly constitutes fraud. Petitioner does not point to any document in which Registrant allegedly stated that it was “not aware of any similar or confusingly similar marks,” and this language is not included in the USPTO’s standard Declarations that Registrant signed when filing its applications that eventually became the challenged registrations. The lack of identification of a specific false statement made by Registrant fails to meet the heightened “particularity” requirement for claims of fraud.

Moreover, Paragraph 16 merely alleges that the claims were false and that Registrant “may have had actual or constructive knowledge” that the claims were false. Petitioner does not allege that the purported false statements were material, that Petitioner had actual knowledge that the statements were false, or that Petitioner made the statements with the intent to deceive the USPTO. *See Kastle Systems International LLC v. Lee Strategy Group LLC*, Opp. No. 91227930, at *4-5 (TTAB Dec. 21. 2017) (finding fraud claim insufficient as a matter of law where it failed to allege materiality, knowledge, or intent to deceive). Any one of these failures constitutes sufficient grounds for dismissing Petitioner’s fraud claim.

First, Petitioner has not specifically alleged that the supposedly false statement – that Registrant was not aware of any “similar or confusingly similar marks” – was material. As noted above, this language is not required when prosecuting an application before the USPTO, so even if Registrant had made this statement, it would not have been material to the USPTO’s decision to grant the registrations.

Second, Petitioner has not alleged that Registrant knew that the statements were false at the time Registrant allegedly made the statements to the USPTO. The claim that Registrant had

“actual or constructive knowledge” of the alleged falsity is equivalent to a claim that Registrant “knew or should have known” that the statements were false, which is insufficient to allege a viable claim for fraud. *See Asian and Western Classics B.V. v. Selkow*, 92 U.S.P.Q.2d 1478, 1479 (TTAB 2009) (“Pleadings of fraud which rest solely on allegations that the trademark applicant or registrant made material representations of fact in connection with its application or registration which it ‘knew or should have known’ to be false or misleading are an insufficient pleading of fraud because it implies mere negligence and negligence is not sufficient to infer fraud or dishonesty.”); *NSM Resources Corp. v. Microsoft Corp.*, 113 U.S.P.Q.2d 1029, 1037 (TTAB 2013) (“Pleadings of fraud ‘based on information and belief’ without allegations of specific facts upon which the belief is reasonably based are insufficient.”).

Finally, even if an allegation that Registrant had “actual or constructive knowledge” that its alleged statements were false is sufficient, the fraud claim would still fail because it does not allege that Registrant made the allegedly false statements with the specific intent to deceive the USPTO. *See Media Online, Inc. v. El Clasificado, Inc.*, 88 U.S.P.Q.2d 1285, 1287 (TTAB 2008) (finding fraud claim invalid because “[P]etitioner’s proposed pleading is devoid of any allegations with regard to respondent’s scienter.”).

Therefore, as Petitioner has failed to allege the required elements of a specific statement, materiality, actual knowledge, and intent, Applicant’s Petitioner’s fraud claim must be dismissed.

V. CONCLUSION

For the reasons set forth above, Registrant respectfully requests that the Board dismiss the Petition for Cancellation in its entirety, or, in the alternative, dismiss Petitioner’s claim for fraud.

Respectfully submitted,

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Date: May 18, 2023

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing REGISTRANT'S MOTION TO DISMISS was served this 18th day of May, 2023 via email, on:

Jason Elster, jason@elstermcgrady.com
Paul McGrady, paul@elstermcgrady.com
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/Florence Goodman/

Florie Goodman