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

Proceeding no.	92082065
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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

PETITIONER'S RESPONSE IN OPPOSITION
TO REGISTRANT'S MOTION TO DISMISS

Petitioner Olivet Nazerene University ("Petitioner") respectfully submits that the Board should deny the Motion to Dismiss (the "Motion") filed by Registrant Upper Columbia Media Association ("Registrant"). Registrant argues that Petitioner's Petition for Cancellation (the "Petition") should be dismissed because a) Petitioner "never specifically states that it will be harmed" and therefore lacks entitlement to a statutory cause of action, and b) Petitioner does not plead its fraud claim with sufficient particularity. However, as set forth in the Petition and below, Petitioner plainly alleges harm and a "real interest" in this dispute, and Petitioner sufficiently alleges that Registrant committed fraud on the United States Patent and Trademark Office (the "PTO") in procuring the registrations subject to the Petition. Therefore, Registrant's Motion should be denied.

I. LEGAL STANDARD

The only issue raised by a motion to dismiss for failure to state a claim is the legal

sufficiency of the pleaded claims.[1] *See Lewis Silkin LLP v. Firebrand LLC*, 2018 TTAB LEXIS 436, *2, 129 USPQ2d 1015, 1016 (TTAB 2018). To survive a motion to dismiss under Fed. R. Civ. P. 12(b)(6) "Petitioner need only allege facts which, if proved, would establish that it has 1) an entitlement to a statutory cause of action under Trademark Act Section 14, 5 and 2) a valid statutory ground exists for cancelling the subject registration." *DrDisabilityQuotes.com, LLC v. Krugh*, 2021 TTAB LEXIS 70, *5, 2021 USPQ2d 262 (TTAB 2021).

In order to allege entitlement to a statutory cause of action, a petitioner must allege that the "cancellation action is within its zone of interests protected by the statute, 15 U.S.C. § 1064, and that it has a reasonable belief in damage proximately caused by registration of the marks, *i.e.*, that it is not a mere intermeddler." *Marshall Tucker Band, Inc. v. MT Indus.*, 2021 TTAB LEXIS 136, *9 (TTAB 2021). "Under the simplified notice pleading rules of the Federal Rules of Civil Procedure, the allegations of a complaint should be 'construed as to do substantial justice.'" *DrDisabilityQuotes.com, LLC*, 2021 TTAB LEXIS at *6 (citing *Scotch Whisky Ass'n v. U.S. Distilled Prods. Co.*, 952 F.2d 1317, 21 USPQ2d 1145, 1147 (Fed. Cir. 1991)).

II. ARGUMENT

A. Petitioner Adequately Alleges Entitlement to a Statutory Cause of Action.

The Petition plainly establishes that Petitioner is no "mere intermeddler," and that the present cancellation action is within Petitioner's zone of interests. A party alleging that it is a competitor in the same goods and/or services satisfies the requirement of establishing entitlement to a statutory cause of action. *See DrDisabilityQuotes.com, LLC v. Krugh*, 2021 TTAB LEXIS 70,

[1] Registrant references Fed. R. Civ. P 12(f) in the preliminary paragraph of its Motion, but the Motion neither requests that the Board strike any portion of the Petition, nor does it make any claim or provide any argument that any portion of the Petition is "redundant, immaterial, impertinent, or scandalous" as contemplated by Rule 12(f). Thus, no Rule 12(f) motion to strike is properly before the Board. *See Monster Energy Co. v. Chun Hua Lo*, 2023 TTAB LEXIS 14, n.4, 2023 USPQ2d 87 (TTAB 2023) (refusing to consider affirmative defenses where they were referenced but not pleaded).

*7 (TTAB 2021) ("Petitioner essentially alleges that it is a competitor of Respondent in that it offers the same services in the disability and life insurance industry, Petitioner has pleaded facts that, if proven, would establish its entitlement to a statutory cause of action."). Independently, a party alleging a plausible likelihood of confusion claim also establishes its entitlement to a statutory cause of action. *See JNF LLC v. Harwood Int'l Inc.*, 2022 TTAB LEXIS 328, *4-6 (TTAB 2022) ("To establish a reasonable basis for a belief that one is damaged by the registration sought to be cancelled, a petition may assert a likelihood of confusion which is not wholly without merit...."") (citations omitted). Finally, similar to alleging competition, a party alleging ownership of registrations in the same commercial space as an opposing party also satisfies the requirement for entitlement to a statutory cause of action. *See Monster Energy Co. v. Chun Hua Lo*, 2023 TTAB LEXIS 14, *15-16 (TTAB 2023) (holding that an entitlement to a statutory cause of action exists where pleaded registrations establish a direct commercial interest in the proceedings) (citing *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1377 (Fed. Cir. 2002) ("In most settings, a direct commercial interest satisfies the 'real interest' test."); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (pleaded registrations were "suffice to establish ... direct commercial interest")).

Here, Petitioner alleges each above-referenced, independent basis for establishing its entitlement to a statutory cause of action. Petitioner alleges that it is a competitor of Registrant, in that the registrations for SHINE FEST and SHINE 104.9 (the "Challenged Registrations") cover the same goods and services as Petitioner's SHINE mark, namely live and recorded Christian radio programing and music. Pet. ¶¶ 8, 12. Petitioner also alleges that the Challenged Registrations are identical or substantially similar to Petitioner's SHINE mark, Pet. ¶¶ 10-11, and they cause and will continue to cause a likelihood of confusion in the minds of consumers. Pet. ¶¶ 13-14. Not only

does Petitioner allege a likelihood of confusion, but Petitioner alleges actual confusion, Pet. ¶15, which Registrant ignores when arguing that "Petitioner never specifically states that it will be harmed by the continued registration of the Challenged Registrations…" (Mot. p. 3.) Finally, Petitioner alleges ownership of the mark SHINE, U.S. Trademark Registration No. 4113384, covering the same goods and services as the Challenged Registrations, namely, production and distribution of live and recorded Christian radio programing and music for others in International Class 041. *See* Pet. ¶ 3, 8, 12.

Registrant's Motion ignores Petitioner's allegations establishing its "real interest" in this cancellation action and its reasonable belief that the Challenged Registrations have caused, and are likely to continue to cause Petitioner damage, and therefore the Motion should be denied.

B. Petitioner Adequately Alleges that Registrant Committed Fraud on the PTO.

Registrant argues that Petitioner's fraud claim should be dismissed because 1) "Petitioner has failed to identify the specific statement which allegedly constitutes fraud," 2) "Petitioner does not allege that the purported false statements were material," 3) Petitioner does not allege that Registrant had actual knowledge that the statements were false, and 4) Petitioner does not allege Registrant "made the statements with the intent to decisive the PTO." (Mot. p. 5.) As with Registrant's other argument to dismiss the Petition, Registrant simply ignores the allegations contained in the Petition establishing a plausible claim that Registrant committed fraud on the PTO. Therefore, the Board should deny Registrant's Motion in its entirety.

As an initial matter, "[a] trademark applicant commits fraud in procuring a registration when it makes material representations of fact in its declaration which it knows or should know to be false or misleading." *Medinol Ltd. v. Neuro Vasx, Inc.*, 2003 TTAB LEXIS 227, *13 (TTAB 2003) (citing *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484-85 (Fed. Cir. 1986)). A party claiming that the declaration submitted in support of an application for registration

was executed fraudulently because there was another use of the same or a confusingly similar mark at the time the declaration was signed must allege facts which, if proven, would establish: a) the existence of a confusingly similar mark at the time the declaration was signed; b) the other user had superior legal rights; c) the applicant knew about the other user's superior rights, and d) applicant, in failing to disclose these facts to the PTO, intended to procure a registration to which it was not entitled. *See Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010); *see also Intellimedia Sports, Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1205 (TTAB 1997). That is precisely what Petitioner alleges here. *See* Pet. ¶ 16.

Petitioner alleges that it registered with the PTO its SHINE mark on April 6, 2008 (U.S. Reg. No. 4,113,384), that Registrant claimed first use of the marks associated with the Challenged Registrations years after Petitioner received said registration from the PTO, and therefore there existed a confusingly similar mark at the time Registrant signed and submitted to the PTO a declaration that it was not aware of any such mark. *See* Pet. ¶¶ 2-4, 9. Petitioner alleges that it has superior rights in the SHINE mark, and that Registrant had both constructive and actual notice of Petitioner's federal registration for its SHINE mark prior to submitting its applications for the Challenged Registrations (SHINE 104.9, U.S. Reg. No. 6,045,426 and SHINE FEST & Design, U.S. Reg. No. 6,045,559). *See* Pet. ¶¶ 8-9. And Petitioner alleges that, despite its knowledge of Petitioner's registration, Registrant represented to the PTO "that it was not aware of any similar or confusingly similar marks when it prosecuted the registrations of [the Challenged Registrations],"[2] and that Registrant knew such statements were false when it made them to the

[2] Contrary to Registrant's unsupported assertion that no such representation is required when prosecuting a trademark registration, the standard trademark prosecution declaration maintained and utilized by the PTO, which Registrant executed when prosecuting the Challenged Registrations, requires applicants to attest that, "[t]o the best of the signatory's knowledge and belief, no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive." *See*

PTO. Pet. ¶ 16. The Petition thus alleges Registrant's fraud with sufficient particularity as required by the holding in *Qualcomm Inc.*

III. CONCLUSION

The Petition sufficiently alleges that Petitioner is entitled to a statutory cause of action, and further that Registrant had actual and constructive knowledge of Petitioner's superior rights in the SHINE mark and knowingly represented to the PTO that it had no such knowledge for the purpose of prosecuting the applications that resulted in the Challenged Registrations. Thus, the Motion should be denied in its entirety. In the event the Board determines that additional allegations are necessary to provide Registrant notice of the claims pending against it, Petitioner respectfully requests leave to amend its Petition.

Date: June 8, 2023

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https://tsdr.uspto.gov/documentviewer?caseId=sn88397983&docId=RFA20190426083648#docIndex=12&page=1 (SHINE 104.9 application with declaration) (last visited June 5, 2023);
https://tsdr.uspto.gov/documentviewer?caseId=sn88448578&docId=RFA20190531082646#docIndex=12&page=1 (SHINE FEST application with declaration) (last visited June 5, 2023).