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

Proceeding	91243939
Party	Plaintiff Facebook, Inc.
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Submission	Motion to Dismiss - Rule 12(b)
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Attachments	2018.12.28 Facebook Motion to Dismiss (PAWSBOOK).pdf(132367 bytes)

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

In the matter of application Serial No. 87761486
For the Trademark PAWSBOOK
Published in the *Official Gazette* on June 5, 2018

FACEBOOK, INC.,)	
)	
Opposer,)	
)	Opposition No. 91243939
v.)	
)	
OLUSEGUN AKOGUN,)	
)	
Applicant.)	

MOTION TO DISMISS APPLICANT’S COUNTERCLAIM

Opposer/Counterclaim-Respondent Facebook, Inc. (“Facebook” or “Opposer”) respectfully requests the Board enter an order dismissing Applicant’s counterclaim asserting Opposer’s mark, Reg. No. 4,471,161¹, should be cancelled (Dkt. 6 at 5) for failure to state a claim upon which relief may be granted in accordance with Fed. R. Civ. P. 12(b)(6) and TBMP § 503.

I. Statement of Facts and Procedural Background

On January 19, 2018, Applicant filed the Subject Application on the basis of Applicant’s use of the mark in commerce pursuant to 15 U.S.C. § 1051(a). And on June 5, 2018 the United

¹ Applicant’s Answer and Counterclaim states in the heading on page 5 that Applicant seeks to cancel Opposer’s mark, Reg. No. 4,339,123. However, in the first paragraph underneath that heading, (and on the first page of the Answer and Counterclaim) Applicant says he “hereby seeks cancellation of Opposer’s Registration No. 4,471,161, registered on January 21, 2014 for the word mark FACEBOOK covering various services in International Class 041.” Dkt. 6 at 5. The analysis does not change whether Applicant is asking the Board to cancel one particular FACEBOOK word mark or another. Opposer intends this motion to ask the Board to dismiss Applicant’s counterclaim to cancel either Reg. No. 4,339,123 or 4,471,161. To the extent Applicant is asking the Board to cancel any other registrations that he mentions throughout his Answer and Counterclaim, this motion applies to those as well.

States Patent and Trademark Office published the Subject Application in the Official Gazette in connection with the following services in International Class 42:

Computer services, namely, creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking services in the field of pet ownership, pet care, pet adoption, pet grooming, pet nutrition, pet care; Computer services, namely, creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking, all related to pet ownership; Creating an on-line community for pet owners.

On June 28, 2018, Facebook timely took a 30-day extension of time. On July 26, 2018, Facebook took a second extension of time. During that time the parties discussed potential settlement, but were unable to reach a resolution. On October 2, 2018, Facebook timely filed its Notice of Opposition. *See* Dkt. 1. Then on November 26, 2018, Applicant filed his Answer and Counterclaim. *See* Dkt. 6. Applicant asserts a counterclaim for cancellation of Facebook’s word mark FACEBOOK, Reg. No. 4,471,161 (“Facebook’s Mark”), registered on January 21, 2014 for services in International Class 41, and specifically for:

Providing computer, electronic and online databases in the field of cultural commentary, social entertainment events, art, performing arts, music, dance, and education; on-line journals, namely, blogs in the fields of cultural commentary, social entertainment events, art, performing arts, music, dance, education, politics, culture, economics, and science; electronic publishing services, namely, publication of text and graphic works of others via computer and communications networks in the fields of cultural commentary, social entertainment events, art, performing arts, music, dance, education, politics, culture, economics, and science; publishing of electronic publications; entertainment services, namely, providing temporary use of interactive, multiplayer and single player games for games played via computer or communication networks; providing information about online non-downloadable computer games and video games via computer or communication networks; contest and incentive award programs designed to recognize, reward and encourage individuals and groups which engage in self-improvement, self-fulfillment, charitable, philanthropic, volunteer, public and community service and humanitarian activities and sharing of creative work product.

Applicant alleges Facebook’s Mark should be cancelled because it was “in reality a phantom mark registration of ___Book,” or an improper registration of “two marks simultaneously,” and

constitutes fraud on the United States Patent and Trademark Office (“USPTO”). *See* Dkt. 6 ¶¶ 70-76.

II. Applicant’s Counterclaim for Cancellation Should be Dismissed

A. Motion to Dismiss Legal Standard

Federal Rule of Civil Procedure 12(b)(6) allows a party to move to dismiss allegations for “failure to state a claim upon which relief can be granted.” Fed. R. Civ. P. 12(b)(6). “The purpose of a Rule 12(b)(6) motion is to allow for elimination of 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.” *See Fiat Grp. Autos. S.p.A. v. ISM, Inc.*, 94 U.S.P.Q.2d 1111, 1112 (T.T.A.B. 2010) (citation omitted).

To state a claim upon which relief may be granted in a proceeding before the Board, a notice or petition “must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face.” *See Doyle v. Al Johnson’s Swedish Rest. & Butik Inc.*, 101 U.S.P.Q.2d 1780, 1782 (T.T.A.B. 2012) (quoting *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009) (dismissing petition to cancel based on deficient factual pleadings)). “Determining whether a complaint states a plausible claim for relief [is] a context-specific task that requires the reviewing court to draw on its judicial experience and common sense.” *Iqbal*, 556 U.S. at 679 (citation omitted). “While the court assumes that the facts in a complaint are true, it is not required to indulge in unwarranted inferences in order to save a complaint from dismissal.” *Juniper Networks Inc. v. Shipley*, 98 U.S.P.Q.2d 1491, 1493 (Fed. Cir. 2011) (citation omitted). Additionally, the Board is “not bound to accept as true a legal conclusion couched as a factual allegation.” *Acceptance Ins. Cos., Inc. v. United States*, 583 F.3d 849, 853 (Fed. Cir. 2009) (citation omitted).

For claims asserting fraud, Trademark Rule 2.116(a) incorporates the heightened pleading standard set forth in Federal Rule of Civil Procedure 9(b). *See Asian & W. Classics B.V. v. Selkow*, 92 U.S.P.Q.2d 1478, 1479 (T.T.A.B. 2009). Under Rule 9(b), “a party must state with particularity the circumstances constituting fraud or mistake.”

B. Applicant’s Counterclaim for Cancellation Fails to State a Claim

Applicant alleges Facebook’s Mark should be cancelled on two grounds: 1) because Facebook registered two marks simultaneously in registering FACEBOOK, and 2) because Facebook committed fraud in procuring the subject registration of FACEBOOK. Applicant’s counterclaim is essentially an attack on Facebook’s enforcement efforts employed AFTER it acquired the subject registration; neither ground for cancellation states a claim of relief.

i. Facebook Did Not Register Two Marks in a Single Registration

Applicant alleges that the subject registration improperly comprises two separate marks—Face and Book. Applicant’s allegation is unsupported by the facts alleged in the counterclaim and well-established law.

Facebook can and did obtain a registration for the compound mark FACEBOOK. A compound mark is one that is comprised of two or more distinct words (or words and syllables) that are represented as one word (e.g., BOOKCHOICE, PROSHOT, MAXIMACHINE, and PULSAIR). TMEP 1213.05(a).

Applicant alleges that Facebook’s compound mark is two separate marks because Facebook uses its registration as the basis to support oppositions against applications to register marks that contain either the term “face” or “book.” The law permits Facebook’s actions where the marks at issue are “sufficiently similar” in terms of sight, sound, and commercial impression such that confusion is likely. *In Re White Birch Vineyards, LLC*, No. 86217989, 2016 WL

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