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

Proceeding no.	92082469
Party	Defendant Medicom Technologies
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Attachments	Opposition_Motion_Dismiss_Amended_Counterclaim.pdf(213447 bytes)

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

In the matter of Trademark
Registration No. 5,528,767
Filing Date: November 27, 2017
Registration Date: July 31, 2018
Mark: MEDICOM

AMD MEDICOM INC.,)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92082469 (parent case)
)	Cancellation No. 92082470
)	Cancellation No. 92082471
MEDICOM TECHNOLOGIES,)	Cancellation No. 92082472
)	
Respondent.)	
)	

**RESPONDENT MEDICOM TECHNOLOGIES’ OPPOSITION TO PETITIONER AMD
MEDICOM’S MOTION TO DISMISS RESPONDENT’S AMENDED COUNTERCLAIM**

Medicom Technologies, Inc. (“Respondent”), by and through its counsel, hereby responds to the Motion to Dismiss Respondent’s Amended Counterclaim (the “Motion”) filed by AMD Medicom Inc. (“Petitioner”).

Respondent’s Answer to Amended Petition to Cancel, includes amended counterclaims (the “Amended Counterclaim”) seeking cancellation of Petitioner’s U.S. Trademark Reg. Nos. 4,800,112 and 6,617,480 for the MEDICOM and MEDICOM and Design marks, respectively, (the “AMD Registrations”) on the grounds that Petitioner has discontinued the use of the MEDICOM and/or MEDICOM and Design marks with the intent not to resume use of the marks in connection with a number of goods recited in the registrations and on the basis that Petitioner made material false statements in connection with the applications to register the MEDICOM and MEDICOM and Design marks.

In response to Respondent's Amended Counterclaim, Petitioner filed a Motion to Amend the AMD Registrations and a Motion to Dismiss the Amended Counterclaim asserting only that Respondent has failed to plead its fraud claims with particularity. The Motion to Amend the AMD Registrations seemed intent on trying to avoid the fraud and abandonment claims raised by Respondent by deleting those goods that had been abandoned and are the subject of Respondent's fraud claims. As Respondent did not consent to the Motion to Amend the AMD Registrations, and was not otherwise permissible, the Board has deferred a ruling on the Motion to Amend. Respondent now addresses the allegations in Petitioner's Motion to Dismiss.

Respondent's Amended Counterclaim, avers facts that establish Respondent has entitlement to a statutory cause of action and a valid statutory ground for cancelling Petitioner's registrations. Respondent's counterclaim asserting fraud, identifies with particularity facts, which at this stage are to be taken as true, and that establish Petitioner knowingly made a false, material representation of fact in connection with its underlying applications, with the intent to deceive the USPTO.

ARGUMENT

To sufficiently plead fraud, Respondent must allege that Petitioner knowingly made a false, material representation of fact in connection with its underlying application, with the intent to deceive the USPTO. *See In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009). "Knowledge" and "intent" may be averred generally so long as Respondent pleads sufficient facts from which the Board may reasonably infer that a specific individual (1) knew of the withheld material information or of the falsity of the material misrepresentation, and (2) withheld or misrepresented this information with a specific intent to deceive the PTO. *See Exergen Corp. v. Wal-Mart Stores, Inc.*, 91 USPQ2d 1656, 575 F.3d 1312, 1328–29 (Fed. Cir. 2009). Allegations based on 'information and belief' are permitted under Rule 9(b) if the pleading sets forth

the facts upon which the belief is founded. *Id.* at 1330. An allegation based on information and belief is especially appropriate when essential information lies uniquely within the other party's control. *Id.* To plead the circumstances of the fraud with the particularity required under Rule 9(b), the pleading must "identify the specific: who, what, when, where, and how of the material misrepresentation or omission committed before the PTO." *Id.* at 1326. Respondent's amended counterclaims expressly identifies the specific who, what, when, where, and how of the material misrepresentation committed by Petitioner.

Respondent's Amended Counterclaim includes allegations that Guillaume Laverdure, the Chief Operating Officer of Petitioner, signed a Statement of Use on June 18, 2015, in connection with the application that became U.S. Registration Number 4,800,112 that claimed, pursuant to a sworn declaration, the mark was in use in connection with all of the goods within the application. *See* Amended Counterclaim ¶ 8. Respondent's Amended Counterclaim also includes allegations that Guillaume Laverdure was in a position to have direct knowledge as to the goods being offered by Petitioner by virtue of his role as Chief Operating Officer of Petitioner. *See* Amended Counterclaim ¶ 9. The Amended Counterclaim further avers facts that Petitioner was not using the MEDICOM mark in connection with all of the goods in its application and had not been using the mark with all of the goods in its application for over a year prior to the date of the Statement of Use. *See* Amended Counterclaim ¶ 9 and Exhibit G. Mr. Laverdure's position, combined with allegations concerning the extended non-use of the MEDICOM mark with all of the goods within the application provide specific facts and circumstances that would allow the Board to conclude that Guillaume Laverdure had knowledge that his representation in the Statement of Use was false. *See* Amended Counterclaim ¶ 9 and Exhibit G. As the application to register the MEDCIOM mark would not have issued to registration in connection with the same goods and services but for this

false representation, and the purpose of such a knowing misrepresentation is necessarily to secure protection for a mark with goods and services not currently in use, Respondent has pleaded the circumstances of Petitioner’s fraud with the requisite particularity to allow a reasonable trier of fact to infer that Petitioner had the necessary intent to commit fraud on the USPTO. *See Exergen Corp*, 575 F.3d at 1328.

Alternatively, the Amended Counterclaim asserts that the claim of use with all of the goods within the application, when there is evidence that the mark was not in use with all of the goods in the application, was made with a reckless disregard for the truth of the statement. *See* Amended Counterclaim ¶ 9. A ‘reckless disregard’ satisfies the requisite intent for fraud on the USPTO. *See Chutter, Inc. v. Great Management Group, LLC v. Great Concepts, LLC*, 2021 WL 4494251, Opposition No. 91223018 and Cancellation No. 92061951 (TTAB Sept. 30, 2021)(“reckless disregard satisfies the requisite intent for fraud on the USPTO in trademark matters”). “Documents submitted to the USPTO must be investigated and read thoroughly before filing” given the nature of the declaration that accompanies such filings. *Id.* at 6. At a minimum the Statement of Use signed by Guillaume Laverdure manifests a reckless disregard for the truth of the matter asserted in the Statement of Use.

Respondent’s Amended Counterclaim also includes allegations that Corey Pedneault, the Senior Vice-President of Finance and Sales Operations signed an Amendment to Allege Use on April 23, 2021, in connection with the application that became U.S. Registration Number 6,617,480 that claimed, pursuant to a sworn declaration, the MEDICOM and Design mark was in use in connection with all of the goods within the application. *See* Amended Counterclaim ¶ 11. Respondent’s amended counterclaim also includes allegations that Corey Pedneault was in a position to have direct knowledge as to the goods being offered by Petitioner by virtue of his role

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