

UNITED STATES DISTRICT COURT FOR THE DISTRICT OF OREGON

Lynx Franchising Intellectual Property, LLC v. Superior Fence and Construction, Inc.

Lynx Franchising Intellectual Property, LLC v. Superior Fence & Construction, Inc., Case No. 3:25-cv-00150-MC (D. Or. Nov. 25, 2025) · No. 3:25-cv-00150-MC · Decided November 25, 2025

SUMMARY

The United States District Court for the District of Oregon addresses Plaintiff Lynx Franchising Intellectual Property, LLC’s motion to dismiss Superior Fence and Construction, Inc.’s fourth counterclaim seeking cancellation of trademark registrations for alleged fraud. The court rejects the counterclaim’s theory that the predecessor’s certification of the Lanham Act’s “in commerce” requirement was fraudulent, but holds that the alleged fraudulent certification of ownership and the alleged fraudulent Section 15 declaration were sufficiently pleaded to survive dismissal.

CASE DETAILS

|                       |                                                                                                                                                                                                                                                                                                                                                            |
|-----------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| COURT                 | United States District Court for the District of Oregon                                                                                                                                                                                                                                                                                                    |
| WRITING FOR THE COURT | Michael J. McShane                                                                                                                                                                                                                                                                                                                                         |
| JURISDICTION          | United States District Court for the District of Oregon                                                                                                                                                                                                                                                                                                    |
| DECIDED               | November 25, 2025                                                                                                                                                                                                                                                                                                                                          |
| DOCKET                | 3:25-cv-00150-MC                                                                                                                                                                                                                                                                                                                                           |
| DISPOSITION           | other                                                                                                                                                                                                                                                                                                                                                      |
| PROCEDURAL POSTURE    | Plaintiff moved under Federal Rule of Civil Procedure 12(b)(6) to dismiss Defendant's fourth counterclaim, which sought cancellation of Plaintiff's registered trademarks based on alleged fraud in obtaining the registrations and incontestability status.                                                                                               |
| STANDARD OF REVIEW    | On a Rule 12(b)(6) motion, the court accepts well-pleaded factual allegations as true, disregards legal conclusions and threadbare recitals, and determines whether the remaining facts state a plausible claim for relief. Fraud allegations must also satisfy Rules 8(a) and 9(b), including particularity as to the circumstances of the alleged fraud. |
| PRECEDENTIAL VALUE    | unknown                                                                                                                                                                                                                                                                                                                                                    |

TOPICS

trademark law

motions to dismiss

intellectual property

civil procedure

trademark infringement

## PRACTICE AREAS

trademark law

intellectual property

civil procedure

## QUESTIONS PRESENTED

1. Whether Superior Fence plausibly alleged that Plaintiff's predecessor fraudulently certified that its mark was being used in commerce when the predecessor allegedly operated only within Florida.
2. Whether Superior Fence plausibly alleged that Plaintiff's predecessor fraudulently certified ownership of or entitlement to use the mark despite knowledge of potentially senior users of Superior Fence.
3. Whether a state-court action against Plaintiff's licensee involving use of part of Plaintiff's registered mark constituted a proceeding involving the trademark rights under 15 U.S.C. § 1065(2).
4. Whether Superior Fence plausibly alleged that Plaintiff knowingly made a material misrepresentation in its Section 15 declaration.
5. Whether a fraudulent Section 15 declaration provides a basis for cancellation of the trademark registration itself or only cancellation of incontestability status.

## HOLDINGS

1. Yes. A Florida fence-installation company operating only intrastate was using its mark in commerce because its economic activities, considered in the aggregate with similar activities, could substantially affect interstate commerce and therefore could be regulated by Congress.
2. Yes. Superior Fence plausibly and particularly alleged that the predecessor certified that no other person had the right to use the mark while knowing of potentially confusingly similar marks used by companies with earlier priority.
3. Yes. A proceeding involves trademark rights when the applicant's rights to use the mark could be adversely affected, including when the proceeding could result in the applicant's licensee being enjoined from using part of the registered mark in a geographic area. The mark owner's presence as a named party is not required.
4. Yes. Superior Fence plausibly alleged that Plaintiff knowingly made a material misrepresentation by stating that no proceeding involving its rights to the mark was pending when Plaintiff filed its Section 15 declaration one week after its licensee was served with the state-court complaint.
5. Yes, in the Ninth Circuit. The district court held that *Robi v. Five Platters, Inc.* remains controlling and provides that a fraudulent Section 15 affidavit is a ground for cancellation of the mark's registration itself, not merely cancellation of incontestability status.

## KEY QUOTATIONS

*“Because Congress could regulate intrastate fence installation services in 2010, SFR’s fence installation services were, as a matter of law, rendered “in commerce.””* (at 9)

*“Accordingly, to determine whether a mark is involved in a proceeding, this Court will consider the extent to which the applicant’s rights to the mark could be adversely affected by the proceeding.”* (at 14)

*“As such, this Court is bound by Robi, which provides that a fraudulent § 15 affidavit is a ground for cancellation of the mark’s registration.”* (at 18)

## FACTUAL BACKGROUND

Superior Fence has operated under the names Superior Fence & Construction and Superior Fence in Oregon and Washington since 1990 and alleged earlier and senior use of those terms than Plaintiff’s predecessor. Plaintiff and its predecessor owned or claimed rights in marks containing Superior Fence & Rail, and Plaintiff later licensed those rights to McGraw Enterprises. After Superior Fence sued McGraw in Oregon state court seeking to enjoin its use of Superior Fence, Plaintiff filed a Section 15 declaration stating that no proceeding involving its trademark rights was pending. Superior Fence alleged that Plaintiff and its predecessor made false and knowingly misleading statements to the Trademark Office concerning use in commerce, ownership or entitlement to use, and the absence of a proceeding involving the marks.

## PROCEDURAL HISTORY

Lynx brought an action alleging trademark infringement and unfair competition. Superior Fence asserted defenses and counterclaims in its Second Amended Answer, including a fourth counterclaim seeking cancellation of two trademark registrations on fraudulent-certification theories. The court granted the motion to dismiss with prejudice as to the theory that the predecessor falsely certified use in commerce, but denied the motion as to the alleged fraudulent certification of ownership or entitlement to use the marks and the alleged fraudulent Section 15 declaration.

## DISPOSITION

other

## CASES CITED

- *Burget v. Lokelani Bernice Pauahi Bishop Trust*, 200 F.3d 661, 663 (9th Cir. 1999)
- *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555, 557, 570 (2007)
- *Ashcroft v. Iqbal*, 556 U.S. 662, 678-79 (2009)
- *Cafasso v. General Dynamics C4 Systems*, 637 F.3d 1047, 1055 (9th Cir. 2011)
- *Hokto Kinoko Co. v. Concord Farms, Inc.*, 738 F.3d 1085, 1097 (9th Cir. 2013)
- *Robi v. Five Platters, Inc.*, 918 F.2d 1439, 1444 (9th Cir. 1990)
- *In re Rosuvastatin Calcium Patent Litigation*, 703 F.3d 511, 519 (Fed. Cir. 2012)
- *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1287, 1290 (Fed. Cir. 2011) (en banc)
- *Larson Manufacturing Co. of South Dakota, Inc. v. Aluminart Products Ltd.*, 559 F.3d 1317, 1340 (Fed. Cir. 2009)
- *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 49 (Fed. Cir. 1986)

- *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1181 (Fed. Cir. 1995)
- *In re Bose Corp.*, 580 F.3d 1240, 1245-46 (Fed. Cir. 2009)
- *United States v. Lopez*, 514 U.S. 549, 559-60 (1995)
- *Taylor v. United States*, 579 U.S. 301, 306 (2016)
- *Wickard v. Filburn*, 317 U.S. 111, 125, 127-29 (1942)
- *United States v. Morrison*, 529 U.S. 598, 601-02, 613 (2000)
- *Quiksilver, Inc. v. Kymsta Corp.*, 466 F.3d 749, 755 (9th Cir. 2006)
- *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1047 (9th Cir. 1999)
- *Pennsylvania State University v. Vintage Brand, LLC*, 755 F. Supp. 3d 563, 581-82 (M.D. Pa. 2024)
- *British Broadcasting Corporation v. Scott Stander & Associates, Inc.*, 2017 WL 11682913, at \*6 (C.D. Cal. Mar. 17, 2017)
- *Holley Performance Products, Inc. v. Quick Fuel Technology, Inc.*, 624 F. Supp. 2d 610, 615-16 (W.D. Ky. 2008)
- *Levi Strauss Co. v. Esprit US Distribution Ltd.*, 588 F. Supp. 2d 1076, 1083 (N.D. Cal. 2008)
- *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 548 F. Supp. 2d 811, 814 (N.D. Cal. 2008)
- *Sunrise Jewelry Manufacturing Corp. v. Fred S.A.*, 175 F.3d 1322, 1327 (Fed. Cir. 1999)
- *Gutier v. Hugo Boss Trade Mark Management GmbH & Co. KG*, 555 F. App'x 947, 949 (Fed. Cir. 2014)
- *Great Concepts, LLC v. Chutter, Inc.*, 90 F.4th 1333, 1339, 1341-43 (Fed. Cir. 2024)
- *Miller v. Gammie*, 335 F.3d 889, 899-900 (9th Cir. 2003)
- *United States v. Gonzalez-Zotelo*, 556 F.3d 736, 740-41 (9th Cir. 2009)
- *Cardinal Chemical Co. v. Morton International, Inc.*, 508 U.S. 83, 97 (1993)

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