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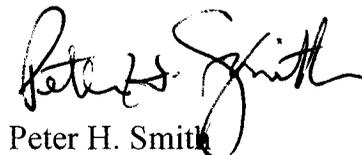
Re: Opposition No. 91162780 and Counterclaim for Cancellation
Applicant/Petitioner: Keith Cangiarella
Opposer/Respondent: Message In A Bottle, Inc.

Ladies/Gentlemen:

I am enclosing the originals of Opposer Message In A Bottle, Inc.'s Brief as Defendant in the Counterclaim and Opposer Message In A Bottle, Inc.'s Reply to Applicant Keith Cangiarella's Brief as Defendant in the Opposition, both for filing in the above-referenced proceeding. Please file these documents.

Thank you.

Very truly yours,


Peter H. Smith

PHS/clf
Enclosures
cc: Message In A Bottle, Inc.



12-19-2009

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

MESSAGE IN A BOTTLE, INC., Opposer, v. KEITH CANGIARELLA, Applicant.	Opposition No.: 91162780 Application Serial No.: 78/229,875 Mark: MESSAGE IN A BOTTLE
KEITH CANGIARELLA, Petitioner, v. MESSAGE IN A BOTTLE, INC., Registrant.	Counterclaim for cancellation Registration No.: 2,243,269 Mark: MESSAGE IN A BOTTLE
OPPOSER MESSAGE IN A BOTTLE, INC.'S BRIEF AS DEFENDANT IN THE COUNTERCLAIM	

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OPPOSER MESSAGE IN A BOTTLE, INC. ("Opposer") hereby submits its brief as defendant in the counterclaim in the above-referenced opposition proceeding, by which Applicant Keith Cangiarella ("Applicant") seeks cancellation of Opposer's Registration No. 2,243,269 for the mark MESSAGE IN A BOTTLE.

I. INTRODUCTION

This counterclaim for cancellation is one of two proceedings which have been consolidated into a single proceeding arising from a dispute between Opposer and Applicant over the mark MESSAGE IN A BOTTLE ("the Trademark"). In his counterclaim, Applicant has requested cancellation of Opposer's existing registration, and this brief is limited to Opposer's defense to that counterclaim, Opposer having previously filed its brief as plaintiff in the opposition proceeding against Applicant's application to register the Trademark in Class 16, Application Serial No. 78/229,875.

II. DESCRIPTION OF THE RECORD

The portion of the record pertinent to this counterclaim includes all items listed in Opposer's Notice of Reliance filed herein on March 31, 2008, and the transcript filed herein on April 16, 2008, of the deposition of Roger Rojas (hereinafter "Rojas") taken on March 24, 2008 (hereinafter "Rojas Depo"). Pursuant to said Notice of Reliance, the record includes a certified copy of Opposer's registration of the Trademark, Registration No. 2, 243,269 dated May 4, 1999; a fictitious business name statement filed in Stanislaus County, California, on January 27, 1999, by Roger and Adriana Rojas for the fictitious business name "Message in a Bottle"; a fictitious business name statement filed

in Stanislaus County, California, on October 23, 2003, by Gold Shells, Inc., for the fictitious business name "Message in a Bottle"; the articles of incorporation of Gold Shells, Inc., filed with the California Secretary of State on July 7, 2003; an amendment to the articles of incorporation of Gold Shells, Inc., changing its corporate name to Message In A Bottle, Inc., filed with the California Secretary of State on July 19, 2007; Applicant's Answers to Opposer's Requests for Admission; and Applicant's Responses to Opposer's Revised First Set of Interrogatories.

Applicant has also filed a Notice of Reliance herein on May 14, 2009, attempting to introduce certain other documents to the record. Opposer's objections thereto are set forth below. Said Notice of Reliance includes the complete file at the Patent & Trademark Office ("PTO") for Opposer's registration, to which Opposer has no objection, but Opposer objects to inclusion in the record of all other documents listed by Applicant.

Applicant's PTO application file is also deemed to be part of the record.

Opposer notes that Applicant has not filed any deposition transcript as part of the record herein.

III. ISSUE

The sole issue to be decided in connection with this counterclaim is whether Opposer or its predecessor committed fraud in the procurement or maintenance of the existing registration so as to provide a basis for cancellation of the registration.

IV. EVIDENTIARY OBJECTIONS

Opposer objects to the following testimony and/or evidence offered by Applicant:

A. Evidence Requested by Opposer to be Excluded: Applicant's Exhibits W, Y, Business Wire press release, November 11, 1996; Exhibit V, Computer Networks and ISDN Systems Volume 29, Copyright 1997; Exhibit U, Orange County Register, Section Accent, April 4, 1999; Exhibit O, Primedia Business Magazine & Media Inc., Telephony, Section Intelligence & Software; ISSN: 0040-2656; and Exhibit X, Dunn & Bradstreet Inc., Message in a Bottle/Gold Shell Inc., business reports, all cited in Applicant's May 14, 2009 Notice of Reliance, Sections II (A) – (E).

B. Grounds for Objection: Opposer objects to the introduction of the above exhibits and moves to strike them as evidence on the grounds that they are not printed publications or official records within the meaning of 37 C.F.R. § 1.122.(e) and TBMP § 704.08, they are inadmissible hearsay under Federal Rule of Evidence 801, and they are not relevant evidence under Federal Rule of Evidence 402.

Applicant seeks to introduce these excerpts from technical publications, a newspaper advertisement, and business reports. However, there is no indication that they are available to the general public in libraries or of general circulation among members of the public. Because conference papers, dissertations, and journal papers are not usually in general circulation, they are not admissible via a notice of reliance under 37 C.F.R. § 1.122.(e). See, e.g., Hunter Publishing Co. v. Caulfield Publishing Ltd., 1 U.S.P.Q. 2d 1996, 1999 n.2 (TTAB 1986). Likewise, press releases, press clippings, and

business reports are inadmissible. Harjo v. Pro-Football Inc., 1999 WL 375907 *17 (TTAB 1999).

Applicant additionally seeks to introduce these documents for the truth of statements made in the documents. Applicant's Notice of Reliance Sections II (A)-(E). All of these documents are, therefore, hearsay, and are presumptively inadmissible. Federal Rule of Evidence 802.

Finally, these documents do not constitute relevant evidence under Federal Rule of Evidence 402. For example, Applicant contends that Exhibits V, W, and Y will be used to show that "the concept of Message in a Bottle is not a novel concept". Applicant's Notice of Reliance Sections II (A) and (B). Whether a concept is novel or not is irrelevant to the issue of likelihood of confusion between two trademarks. Accordingly, these exhibits should additionally be excluded for irrelevancy.

Opposer's rebuttal to Applicant's objection to Exhibit N to the Rojas Depo is set forth in Opposer's Reply to Applicant's Brief as Defendant in the Opposition.

V. FACTS

Opposer holds U.S. registration 2,243,269 from the PTO for the mark MESSAGE IN A BOTTLE dated May 4, 1999, for which Section 8 and 15 affidavits have been filed and accepted by the PTO. A certified copy of the registration showing the Section 8 and 15 filings and the title in Opposer is attached to Opposer's Notice of Reliance herein. See also Rojas Depo 9:9-11:1, and Opposer's registration file. This registration resulted from the filing of an intent-based application with the PTO on January 6, 1997, by Roger

Rojas, Opposer's predecessor. Rojas Depo 16:7-16, and Exhibit D thereto. Rojas thereafter filed a statement of use claiming first use anywhere and in commerce as January 16, 1999. See Rojas Depo, Exhibit K. The registration was for recited services in Class 38, which Rojas believed was entitled "Communications" at the time Rojas' application for registration was filed. Rojas Depo 10:4-9. The recited services are, "receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others." Rojas Depo 10:13-18. This description of services was specifically agreed upon as between Rojas and the PTO examining attorney after the examining attorney rejected the definition of services originally set forth in the application. Rojas Depo 16:22-17:18. See also the Examiner's Amendment set forth as Exhibit E thereto. Rojas filed Section 8 and 15 affidavits between the fifth and sixth anniversaries of the registration. See Exhibit P to Rojas Depo. The PTO accepted these affidavits. See Exhibit Q to Rojas Depo. Rojas subsequently assigned the registration to Gold Shells, Inc., a California corporation, on October 5, 2004, and this assignment was recorded with the PTO on October 15, 2004. Rojas Depo 40:8-19. However, Rojas was allowed by a license agreement to continue to use the Trademark concurrently with the corporation. Rojas Depo 35:15-25, and Exhibit N thereto. The name of Gold Shells, Inc., was subsequently changed to Message In A Bottle, Inc., and this change of name was recorded with the PTO on January 30, 2008. Rojas Depo 41:5-18, and Exhibit T thereto. Opposer then filed an application for renewal of the registration on March 25, 2009, and renewal was granted by the PTO on March 31,

2009, continuing the registration in effect for an additional ten years from May 4, 2009. See Opposer's registration file. Opposer or its predecessor have continuously used the Trademark in commerce since January 16, 1999. Rojas Depo 25:9-20 and 36:1-15.

VI. ARGUMENT

A. The Only Possible Basis for Cancellation of Opposer's Registration in this Proceeding is Fraud.

Section 15 of the Trademark Act (15 USC §1065) states, in relevant part,

Except on a ground for which application to cancel may be filed at anytime under paragraphs (3) and (5) of section 14 of this Act, . . . the right of the registrant to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable: . . .

In the present case, Opposer holds an incontestable registration, its continuing use affidavit having been filed and accepted by the PTO between the fifth and sixth anniversaries of the original registration date. See the certified registration set forth as Exhibit A to the Rojas Depo, the continuing use affidavit set forth as Exhibit P to the Rojas Depo, and the PTO's acceptance of same set forth in Exhibit Q to the Rojas Depo.

Nevertheless, a so-called "incontestable" registration may still be cancelled at any time under the circumstances set forth in Section 14 of the Trademark Act (15 USC §1064), which states in relevant part as follows:

A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, . . . , by the registration of a mark on the principal register established by this Act, . . . (3) At any

time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 4 or of subsection (a), (b), or (c) of section 2 for a registration under this Act, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. . . .

In the present case, the Applicant has not pleaded any of the above grounds except for fraud (and abandonment, but that has not been seriously argued by Applicant). Therefore, the only possible ground for cancellation of Opposer's registration in this case is fraud. Unless the TTAB finds that Opposer or its predecessor has committed fraud in the procurement or maintenance of the registration, the registration should be deemed to be incontestable pursuant to the terms of Section 15 of the Trademark Act.

B. The Record Contains Evidence that There Was No Fraud by Opposer or Its Predecessor.

Rojas, Opposer's predecessor and the original applicant for Opposer's registration, addressed the issue of fraud in his deposition by specifically denying having made any false statements in the application or the continuing use affidavit. Rojas Depo 59:10.

On a related subject, Rojas also denied that he had any knowledge of other parties with prior use of the Trademark at the time he filed the application for registration, including knowledge which he obtained from a trademark search report. Rojas Depo 56:25-57:13.

Rojas also confirmed on deposition the truth of the basic allegations in the original application and statement of use. He testified that he used the Trademark for the services recited in the registration by using the mark on the banner of his website, as letterhead on direct mailing promotions that he sent out to individuals, and as hang tags and labels attached to bottles associated with providing his communication services. Rojas Depo 11:25-12:12. Rojas also testified that the Trademark was continuously used by him for such services in commerce from the time he started using it in January, 1999, until the time when he assigned the registration to Opposer. Rojas Depo 25:9-20. He also testified that Opposer continuously used the Trademark for such services in commerce from the time of its existence to the time of the deposition. Rojas Depo 36:1-15.

Opposer does business with the Trademark at an internet website, www.messageinabottle.com. A copy of the text of that website is attached to Rojas Depo as Exhibit V. The website displays the Trademark and describes the goods and services that are offered by Opposer under that mark. In the description of services offered, the website says, "Simply choose a bottle, choose a message or write your own and then tell us to whom you want it sent. We'll do the rest." The website additionally shows that communications are received from others, printed on paper, enclosed in a bottle, and sent to the recipient. Rojas Depo, Exhibit V. A version of Applicant's website is also in evidence as Exhibit W to Rojas Depo. Applicant's website shows that Applicant is also using the Trademark for receiving communications from others, recording such

communications in written or printed form, and transmitting such communications to others, exactly as recited in the services for which Opposer's service mark registration was granted. All of this shows that there was no fraud by Rojas or Opposer.

C. Applicant Has Produced No Evidence of Fraud on the Part of Opposer.

While Applicant in his brief has flailed out in many directions in an attempt to argue that Opposer and/or its predecessor engaged in fraud in the procurement and/or maintenance of Opposer's registration, in fact, Applicant has submitted no admissible evidence to back up its allegations. There is nothing in the record herein which supports Applicant's wild allegations of fraud. Applicant seems to suggest that it was fraud merely to apply for registration of the Trademark as a service mark in Class 38, but the record shows that Rojas and Opposer followed all PTO procedures in the application and the maintenance and assignment of the registration and this has resulted in Opposer's ownership of an incontestable registration as set forth above. Opposer makes the following points in responding to some of the allegations in Applicant's brief:

1. Applicant Fails to Distinguish Between Opposer's Assignment and Licensing of Opposer's Trademark and Service Mark and Opposer's Assignment of its Service Mark Registration.

On page 18 of Applicant's brief, he cites as "fact" that "the Opposer is not an assignee of the Trademark as stated but only of the servicemark registration of mark 'Message In A Bottle'." However, this is not true. See the licensing agreement attached to Rojas Depo as Exhibit N, in which Rojas licensed Opposer to use the Trademark (without regard to whether it is being used as a trademark or a service mark), and the

assignment document attached to Rojas Depo as Exhibit R. In the assignment, Rojas assigned to Opposer all rights to the Trademark (without regard to whether it is a trademark or a service mark) as well as Rojas' service mark registration.

Applicant's confusion on this subject is also apparent in the first full paragraph on page 7 of his brief. Applicant's discussion there is muddled, and it is difficult to follow his argument, but the evidence shows that Rojas claimed rights to MESSAGE IN A BOTTLE both as a trademark and a service mark, and that he assigned those rights, along with his service mark registration, to Opposer. Applicant claims that "only the trademark, to which Rojas Roger has no exclusive right, is assigned," but the evidence shows otherwise.

2. Applicant is Incorrect in His Argument that Opposer's Opposition was Invalid Since Opposer Did Not Own the Registration at the Time Applicant's Application was Published for Opposition.

On pages 10 and 11 of his brief, Applicant argues that the "cause of action" for the opposition arose when Applicant's application was published for opposition, and since Rojas' registration was assigned to Opposer after that date, Opposer had no right to file the opposition. With all due respect, that makes no sense whatsoever. Opposer was incorporated and had received the assignment of Rojas' registration prior to its filing the opposition, so it clearly had standing to do so.

Indeed, Section 13 of the Trademark Act (15 USC §1063) says that an opposition may be filed by "[a]ny person who believes that he would be damaged by the registration of a mark upon the principal register." Opposer believed it would be damaged by

Applicant's having a registration for the same mark, and therefore Opposer had standing. There is no issue as to when a "cause of action" arose.

Applicant also argues on page 11 that Opposer received ownership of the service mark on October 5, 2004, the date of the assignment document, but in fact Opposer received the right to use the mark commencing with the licensing agreement of July 7, 2003. See Exhibits N and R to Rojas Depo.

3. Applicant is Incorrect in Stating that Opposer's Business is Carried Out Only by Goods, not Services.

The intertwining of goods and services is inherent in each party's use of the Trademark, as set forth in Opposer's brief as plaintiff in the opposition. For evidence of use of the Trademark by Opposer for the same goods as are recited in Applicant's application, see Rojas Depo 51:4-19 and 53:1-23. For evidence of use of the Trademark by Applicant for the same services as recited in Opposer's registration, see Applicant's website, a text of which is set forth in Exhibit W to Rojas Depo. See also Rojas Depo 45:16-25. Applicant has admitted to utilizing services in selling his recited products. Applicant's Responses to Interrogatories, Response Nos. 1 and 2. He has also admitted that services are provided "ancillary to sales of products worldwide". Applicant's Responses to Interrogatories, Response Nos. 20 and 22. Opposer uses its service mark for services in connection with the sale of goods (excluding kits) described in Applicant's application. Rojas Depo 51:4-52:4. Applicant's argument tries to set up a dichotomy between goods and services, but this flies in the face of reality in this case, in which the evidence shows a clear intertwining of goods and services by both parties.

Applicant argues at the bottom of page 14 that it was not acceptable for Opposer's predecessor to file for registration of the Trademark as a service mark because it "has made use of tangible goods as the main component of his business". However, Applicant sets forth no standard for making this judgment. In fact, as the evidence shows, and as Opposer has argued, goods and services are intertwined in the businesses of Applicant and Opposer, and either the service aspect or the goods aspect of the business can properly be the subject of an application for trademark or service mark registration. Likewise, at the top of page 15 of Applicant's brief, Applicant says, "The remnants of this service mark still alive, the mark has transformed itself into a Trademark with the use of it in tangible items that is the main component of the business and which are used in conveying messages." First, it makes no sense to suggest that there has been a "transformation" of the mark from a service mark to a trademark simply because goods are involved with the furnishing of services. Second, Applicant's admission in this sentence that the goods are used in "conveying messages" clearly shows the service aspect of the business. Likewise, on page 19, in the third paragraph, Applicant describes Opposer's business as being achieved "through the conveyance of tangible goods, hence making the delivery of tangible goods the main component of the business," yet argues that the Class 38 service classification is inappropriate. This makes no sense, as "conveyance" and "delivery" both highlight the service aspect of the business.

On page 19 of Applicant's brief, in the second paragraph, Applicant refers to Opposer as having claimed his services to be as a "telecommunication business".

However, this is not true. Rojas specifically testified that he did not ever intend to file for “telecommunication” services. Rojas Depo 59:21-24. In fact, in the entire application file for Opposer’s registration, there is no reference to “telecommunications”. See PTO file for Opposer’s registration.

Further evidence of the intertwining of goods and services can be found in Applicant’s California Secretary of State registration of the Trademark. Applicant, though complaining in this proceeding about Opposer having sought its registration as a service mark, actually obtained its California registration as a service mark in Class 35, registration no. 059960, dated November 30, 2004, admitted in paragraph 7 of his original counterclaim herein. See Rojas Depo 55:9-25 and 56:1-9 and Exhibit BB thereto. This is further evidence of the intertwining of goods and services by the parties, and also of the hypocrisy and disingenuousness of Applicant’s position in attacking Rojas for filing in a service classification.

4. The 1997 Definition of “Telecommunications” Includes the Description of Services in Opposer’s Registration.

On page 14 of Applicant’s brief, he quotes the definition of “telecommunication” in 47 USC §153 as “the transmission between or among points specified by the user, of information of the user’s choosing, without the change in form or content of the information sent and received.” Applicant then argues that Opposer’s business involves a “definite change in the form of information.” However, this is not the case. In fact, the evidence shows that there is no change in form or content of the information sent and received by Opposer or Applicant in the transmission of their communications. The

recipient of the message receives it in the same form and with the same content as when the message was sent.

In any event, the title “telecommunications” for Class 38 is irrelevant to the issue of fraud herein. It is clear from Rojas’ testimony that he believed the title of Class 38 was “communications” at the time he filed his application in 1997. Rojas Depo 10:7-9. He also denied filing his application for “telecommunications”. Rojas Depo 59:21-24. Thus, the evidence shows that he had no intention to file his application for anything other than what was specifically recited in the application, which made no reference to telecommunications. See the original application in Opposer’s registration file.

I represented Rojas in connection with the filing of his application for the Trademark in the PTO on January 6, 1997, and previously had assisted him with adopting an appropriate description of the services for which he wanted to register the mark and an appropriate classification for those services within the International Schedule of Trademark Classification. In doing so, I used a version of the International Schedule of Trademark Classification which was published in Appendix A of Hawes, James E., Trademark Registration Practice, which listed Class 38 as a service class entitled “Communication”. I did not consult any other text or publications in regard to classifying Rojas’ intended services, and my affidavit on this subject was filed in the present TTAB proceeding on August 11, 2006.

It appears that the actual title to Class 38 in 1997 was “Telecommunications”. See Acceptable Identification of Goods and Services Manual (1997[first] edition). However,

the explanatory note in that publication says, "This class [38] includes mainly services allowing at least one person to communicate with another by a sensory means. Such services include those which: (1) allow a person to talk to another, (2) transmit messages from one person to another, and (3) place a person in oral or visual communication with another (radio and television)." (Emphasis added) The evidence shows that Rojas and Opposer obtained a registration for the Trademark with a description of services which falls within the above definition, allowing communication between persons by a "sensory means", namely paper messages in bottles, by the transmission of "messages from one person to another". Rojas Depo 51:4-19 and 53:1-23. An affidavit by Rojas covering this subject was filed in the present TTAB proceeding on August 11, 2006. Furthermore, the current definition of Class 38 services is the same as set forth above. See TMEP Section 1401.02(a), which contains the same explanatory note.

5. Registration of the Trademark in Class 38 was Entirely Appropriate.

a. The Description of Services was Agreed To by the PTO.

Rojas' original application was for Class 38, without specifying any title for the class, and was specifically for "written communication services, namely the telephonic, electronic, or mail receiving of text, the recording of text utilizing print media, and arrangements for delivery of the recorded text to others". See the application file for Opposer's registration. The PTO examiner issued an office action dated September 15, 1997, which said, "The recitation of services is unacceptable as indefinite. The applicant may adopt the following recitation, if accurate: 'electronic mail services, namely, the

recording, storage and subsequent transmission of written messages by telephone in Int. Class 38'." See the application file for Opposer's registration. Thereafter, however, an examiner's amendment was issued dated March 16, 1998, referring to a telephone call between the examiner and Rojas' attorney, stating that the recitation of services had been amended to read as follows: "Receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others, in Int. Class 38". See application file for Opposer's registration and Rojas Depo 17: 1-18. This latter description appears in Opposer's registration. Thus, it is clear that there was no "fraud" involved and the description of services covered by the registration was agreed upon through communications between the PTO and Rojas through his attorney.

b. The Specimen Used in the Statement of Use was Explicit with Regard to the Type of Communications for which Registration was Sought.

Rojas' original application was based on intent. Thus, a statement of use was eventually required and was filed. Rojas' statement of use was accompanied by a specimen which consisted of a letter from Rojas to customers featuring the Trademark and stating, "Our service is sending art quality greetings in unique and distinctive bottles to that someone special. You let us know the communication you want to send, and who you want it sent to, and we will record your communication in beautifully hand-written form, insert it in a bottle, and transmit it for you. To receive our service visit our website at www.messageinabottle.com and fill out the order form". Rojas Depo 24:19-25 and

Exhibit K thereto. The inclusion of this specimen was a clear disclosure of the means to be used under the Trademark to transmit the communications, namely bottles. Obviously, no fraud was involved.

- c. The Specimen Accompanying Rojas' Combined Affidavit of Use and Incontestability was Explicit in Regard to the Type of Communications which were Continuing under the Trademark.

Rojas filed a combined affidavit of use and incontestability with the PTO dated October 1, 2004, which made no reference to "telecommunications" but recited continuing use of the Trademark for the services described in the registration. It was accompanied by a page from Opposer's website featuring the mark and clearly showing that Rojas' and Opposer's services involved the transmission of messages in bottles. See Exhibit P to Rojas Depo. Again, this exhibited full disclosure and obviously no fraud was involved.

On page 18 of Applicant's brief, a case is cited for the proposition that the identification of goods or services must be specific, definite, clear, accurate, and concise. From the history of Opposer's registration, it is clear that the PTO accepted Rojas' identification of services as such.

6. Applicant Misuses the Term "the Trademark".

Applicant is careless in his brief in using references to "the Trademark". In the present brief, and in other documents relevant to this proceeding, Opposer has used "the Trademark" as a defined term to mean the mark MESSAGE IN A BOTTLE, without regard to whether the mark is being used as a trademark or a service mark. For example,

on pages 16 and 17, Applicant underlines the term “Trademark” with the apparent belief that it is referring only to trademarks and not service marks, which is not the case.

7. Applicant has Admitted the Validity of Opposer’s Registration and Ownership of the Service Mark.

While the whole purpose of Applicant’s counterclaim is to attempt to have Opposer’s registration cancelled, Applicant at the bottom of page 20 has admitted that Opposer “has most successfully proved the registration and ownership of the servicemark ‘Message In A Bottle’.”

8. Applicant’s Argument is at Odds with His Own Admission.

At the top of page 21, Applicant claims that “the services of Rojas Roger were registered under the Class 38 which would have nothing to do with the business of the Applicant.” However, Applicant has previously admitted to direct competition between the parties in Applicant’s Responses to Interrogatories, Response Nos. 11, 12, 13, 14 and 39. See also Applicant’s e-mail to Opposer, Exhibit U to Rojas Depo.

9. Applicant’s Argument is Absurd that Opposer’s Predecessor Committed Fraud by Adopting the Same Type of Business as Applicant.

On page 21 of Applicant’s brief, Applicant makes an outrageous argument that since Applicant used the mark first, “Roger most fraudulently entered into this sphere of business” and copied him. This totally ignores and is contradicted by the fact that Rojas filed his application long before Applicant started using the Trademark, and that Applicant himself admitted knowing about Rojas’ registration at the time Applicant filed

his application. See Applicant's Answers to Requests for Admission, Answer Nos. 6 and 8, as well as Rojas Depo 43:11-22, Exhibit U.

10. Applicant's Argument is Absurd that Opposer has Used the Corporate Form to Commit Fraud.

On page 21 of Applicant's brief, Applicant's rambling accusation of fraud includes the claim that Rojas' incorporating his business somehow gave him an advantage and that the corporation was used "for his own fraudulent, mean and most treacherous purposes". There is no evidence in the record to support such gibberish or Applicant's claims of "injustice".

11. There is No Evidence of Abandonment by Opposer.

On page 20 of Applicant's brief, Applicant "infers" that the Trademark has been abandoned by Opposer, but this is totally contrary to the evidence. See Rojas Depo 25:9-20 and 36:1-15.

D. There is a High Standard of Proof for Fraud, Which Has Not Been Met.

A trademark is obtained fraudulently under the Trademark Act only if the applicant or registrant knowingly makes a false, material representation with the intent to deceive the PTO. There is no fraud if a false misrepresentation is occasioned by an honest misunderstanding or inadvertence without a willful intent to deceive. Unless a challenger can point to evidence to support an inference of deceptive intent, it has failed to satisfy the clear and convincing evidence standard required to establish a fraud claim. In Re Bose Corp., 91 USPQ2d 1938 (Fed. Cir. 2009), which overruled the Medinol Ltd. case cited on page 12 of Applicant's brief.

“Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application.” Torres vs. Cantine Torresella S.r.l., 808 F.2d 46, 48 (Fed. Cir. 1986). A party seeking cancellation of a trademark registration for fraudulent procurement bears a heavy burden of proof. W.D. Byron & Sons, Inc. vs. Stein Bros. Mfg. Co., 377 F.2d 1001, 1004 (CCPA 1967). Indeed, “The very nature of the charge of fraud requires that it be proven ‘to the hilt’ with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.” Smith Int’l, Inc. vs. Olin Corp., 209 USPQ 1033, 1044 (TTAB 1981).

Before the PTO, “[a]ny ‘duty’ owed by an applicant for trademark registration must arise out of the statutory requirements of the Lanham Act,” which prohibit an applicant from making “knowingly inaccurate or knowingly misleading statements.” Bart Schwartz Int’l Textiles, Ltd. vs. Fed. Trade Comm’n, 289 F.2d 665, 669 (CCPA 1961). Therefore, the court stated that, absent the requisite intent to mislead the PTO, even a material misrepresentation would not qualify as fraud under the Lanham Act warranting cancellation. King Automotive, Inc. vs. Speedy Muffler King, Inc., 667 F.2d 1008, 1011 n.4 (CCPA 1981).

There is “a material legal distinction between a ‘false’ representation and a ‘fraudulent’ one, the latter involving an intent to deceive, whereas the former may be occasioned by a misunderstanding, and inadvertence, a mere negligent omission, or the

like.” Kemin Indus. Inc. vs. Watkins Prods., Inc., 192 USPQ 327, 329 (TTAB 1976). In other words, deception must be willful to constitute fraud. Smith Int’l., 209 USPQ at 1043. See also Woodstock’s Enters. Inc. (Cal.) vs. Woodstock’s Enters. Inc. (Or.), 43 USPQ 2d 1440, 1443 (TTAB 1997); First Int’l Scvrs. Corp. vs. Chuckles, Inc., 5 USPQ 2d 1628, 1634 (TTAB 1988); Giant Food, Inc. vs. Standard Terry Mills, Inc., 229 USPQ 955, 962 (TTAB 1986).

VII. CONCLUSION

Applicant appears to be under the impression that all one has to do to have an incontestable service mark registration cancelled is to make unsupported claims of fraud through a variety of allegations. On the contrary, averments of fraud must include an explicit expression of the factual circumstances alleged to commit fraud. See Fed. R. Civ. P. 9(b); and King Automotive, Inc. vs. Speedy Muffler King, Inc., 667 F.2d 1008, 212 USPQ 801 (CCPA 1981). Applicant’s only real argument of fraud appears to be that Rojas never intended to use or used the Trademark for the services recited in the application and registration, and this is refuted by the evidence in the record.

It is respectfully submitted that Applicant has set forth no evidentiary basis for his fraud allegations, or for the allegation of abandonment, and that, since these are the only bases pleaded for cancellation of Opposer’s registration, the counterclaim for

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cancellation should be denied.

Respectfully submitted,

MESSAGE IN A BOTTLE, INC.

By its attorney,



Date: December 19, 2009

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Modesto, CA 95358
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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Opposer Message In A Bottle, Inc.'s Brief as Defendant in the Counterclaim was mailed first-class mail, postage prepaid, to Keith Cangiarella, 331 N. Harrington Drive, Fullerton, California 92831, on December 19, 2009.

Dated: December 19, 2009



PETER H. SMITH

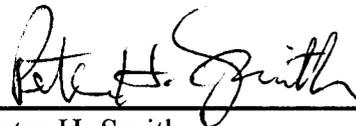
CERTIFICATE OF EXPRESS MAILING UNDER 37 CFR SECTION 2.198

Mark: MESSAGE IN A BOTTLE
Registration No.: 2,243,269
Opposition No.: 91162780
Mailing Date: December 19, 2009
Name of party filing paper: Message In A Bottle, Inc.
Type of paper being filed: OPPOSER MESSAGE IN A BOTTLE, INC.'S BRIEF
AS DEFENDANT IN THE COUNTERCLAIM

Express Mail Mailing Label Number: *EH 817869336 US*
Date of Deposit: December 19, 2009

I hereby certify that the above-identified Opposer Message in A Bottle, Inc.'s Brief as Defendant in the Counterclaim dated December 19, 2009, which is attached, is being deposited on December 19, 2009, with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR Section 2.198 in an envelope addressed to:

Trademark Trial & Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451



Peter H. Smith

Date: December 19, 2009

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

<p>MESSAGE IN A BOTTLE, INC., Opposer, v. KEITH CANGIARELLA, Applicant.</p>	<p>Opposition No.: 91162780 Application Serial No.: 78/229,875 Mark: MESSAGE IN A BOTTLE</p>
<p>KEITH CANGIARELLA, Petitioner, v. MESSAGE IN A BOTTLE, INC., Registrant.</p>	<p>Counterclaim for cancellation Registration No.: 2,243,269 Mark: MESSAGE IN A BOTTLE</p>
<p>OPPOSER MESSAGE IN A BOTTLE, INC.'S REPLY TO APPLICANT KEITH CANGIARELLA'S BRIEF AS DEFENDANT IN THE OPPOSITION</p>	

OPPOSER MESSAGE IN A BOTTLE, INC. ("Opposer") hereby submits its reply, as plaintiff in the above-referenced opposition proceeding, to the Reply Brief by Keith Cangiarella ("Applicant") as Defendant in the Opposition, filed herein on November 25, 2009.

The issues to be decided in connection with this opposition proceeding, as described in Opposer's Brief as Plaintiff in the Opposition, are as follows:

1. Whether Applicant's mark so resembles Opposer's registered mark as to be likely to cause confusion or cause mistake or to deceive.
2. Whether the goods identified in Applicant's application are or may be related to the services identified in Opposer's registration of the identical mark so as to support a finding of likelihood of confusion.
3. Whether Applicant's mark may disparage Opposer's mark and falsely imply a connection with Opposer.
4. Whether Opposer has a priority right to the Trademark under Section 7(c) of the Trademark Act through constructive use based on the filing date of its predecessor's original intent-to-use service mark application.
5. Whether Applicant's application should be rejected due to Applicant's fraud through untrue statements in the application.

Applicant's reply brief presents no evidence to counter Opposer's arguments on the above issues. Indeed, the record contains no such evidence. Applicant simply repeats the arguments it has made in its brief as plaintiff in the counterclaim, arguing that

Opposer and its predecessor, Roger Rojas ("Rojas"), have committed fraud in mischaracterizing what the Trademark was used for, and therefore its registration should be cancelled due to such fraud, and therefore Opposer has no priority rights based on the registration and is not in a position to succeed in the opposition proceeding. These arguments have no evidentiary support, and Opposer's reply to them is set forth in Opposer Message In A Bottle, Inc.'s Brief as Defendant in the Counterclaim, filed contemporaneously filed herewith.

Applicant's objection to Opposer's evidence as set forth in Exhibit N to the deposition of Roger Rojas ("Rojas Depo"), which is a copy of a licensing agreement between Rojas and Opposer, is without merit. Applicant relies on 15 USC §1060, which says that acknowledgment of an assignment shall be prima facie evidence of the execution of an assignment, "and when the prescribed information reporting the assignment is recorded in the United States Patent & Trademark Office, the record shall be prima facie evidence of execution." From this statute, Applicant argues that since the licensing agreement was not acknowledged, the document should be rejected as evidence. It is respectfully submitted that this argument makes no sense. While the statute says that acknowledgment shall be prima facie evidence of execution, it does not invalidate a document which does not bear an acknowledgment. Furthermore, the language from the statute quoted above indicates that the recordation of an assignment by the PTO is also prima facie evidence of execution, and Opposer did record an assignment from Rojas with the Patent & Trademark Office. See Rojas Depo 40:8-19 and Exhibit R thereto. In

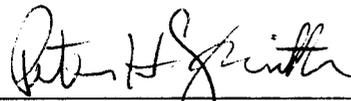
any event, Applicant's argument goes only to the validity of the document, and not whether it is properly submitted in evidence in this proceeding. Applicant's objection to this portion of the evidence should therefore be rejected.

Therefore, Opposer submits that its position as plaintiff in the opposition has not been rebutted, and Opposer respectfully confirms its request that Applicant's application for registration of the mark MESSAGE IN A BOTTLE be rejected.

Respectfully submitted,

MESSAGE IN A BOTTLE, INC.

By its attorney,



Date: December 19, 2009

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CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing OPPOSER MESSAGE IN A BOTTLE, INC.'S REPLY TO APPLICANT KEITH CANGIARELLA'S BRIEF AS DEFENDANT IN THE OPPOSITION was mailed first-class mail, postage prepaid, to Keith Cangiarella, 331 N. Harrington Drive, Fullerton, California 92831, on December 19, 2009.

Dated: December 19, 2009



PETER H. SMITH

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