

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed:
September 7, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Message in a Bottle, Inc. f/k/a Gold Shells, Inc.

v.

Keith Cangiarella

Opposition No. 91162780
to application Serial No. 78229875
filed on March 25, 2003

Request for Reconsideration

Mark R. Leonard of Davis & Leonard, LLP for Message in a
Bottle, Inc. f/k/a Gold Shells, Inc.

Keith Cangiarella, pro se.

Before Seeherman, Cataldo and Taylor, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

On June 15, 2010 the Board issued a decision denying
applicant Keith Cangiarella's counterclaim to cancel opposer
Message in a Bottle, Inc.'s Registration No. 2243269 and
granting opposer's opposition to the registration of
applicant's mark solely with respect to the issue of
likelihood of confusion.

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On July 13, 2010 applicant timely filed a request for reconsideration of that decision. Opposer has filed a brief in response.

We turn first to applicant's arguments with respect to our findings regarding certain exhibits that he submitted. First, applicant contends that the Board improperly characterized his exhibit H as being a document from the registration file that applicant sought to cancel, when it was an Office action for a different application, Serial No. 76556304, also filed by opposer. Applicant is correct. However, this mischaracterization does not affect our decision herein; the Office action is part of the record and we did consider it. However, the fact that a different examining attorney considered the mark MESSAGE IN A BOTTLE merely descriptive of goods does not prove that opposer committed fraud in obtaining its registration for the mark for services. As we explained at length in our June 15, 2010 decision, the specimen submitted with opposer's Statement of Use for the registration at issue clearly indicated the nature of opposer's services to the examining attorney. Therefore, opposer did not make a misrepresentation in the prosecution of its underlying application. Moreover, even if opposer had made a material misrepresentation, it is not sufficient for a finding of

fraud that a statement be false or even material, there must also be an intent to deceive.

Applicant also takes issue with our sustaining, because they are not printed publications as contemplated by Trademark Rule 2.122(e), opposer's objections to his Exhibits W, X and Y. We pointed out in our June 15, 2010 decision that, in responding to opposer's objections to these exhibits, applicant addressed only opposer's relevancy objection, and not whether the exhibits constitute printed publications. Applicant should have responded to the admissibility of the exhibits at the time opposer objected to them, rather than waiting until a decision had issued.

In any event, we find no error in our ruling on opposer's objections. With respect to applicant's argument, raised for the first time in the motion for reconsideration, that because the articles are marked "© Nexis," [sic], this makes them acceptable as printed publications, this is incorrect. As applicant himself recognizes, "the notice of reliance may be accompanied by an electronically generated document which is the equivalent of the printed publication or relevant portion, as, for example, by a printout from the **NEXIS computerized library of an article published in a newspaper or magazine of general circulation.**" Motion for reconsideration, p. 3, emphasis in original. An "article," although taken from the NEXIS database, must still have been

published in a newspaper or magazine of general circulation. It is not sufficient that it shows a copyright notice by LexisNexis. Exhibits W and Y, as applicant concedes, are business wire reports, and there is no evidence that the wire service reports ever appeared as an article in a printed publication.¹ And there is no indication that the Dun & Bradstreet reports (Exhibit X) were ever published.²

As we stated in our June 15, 2010 opinion, even if we had considered these exhibits, they would not have changed our decision. Therefore, although we are not persuaded of any error in our rulings on these exhibits, there can be no error in our not considering them.

¹ Applicant makes the statement that these reports "clearly demonstrate that Exhibit V would have been available to the general public as the information was released to the general public via Press Releases." Motion for reconsideration, p. 3. Whether or not the press releases were used in the preparation of the Bell Laboratories article that is the subject of Exhibit V (and it is certainly not clear that this is the case), Exhibit V was treated as part of the record. However, we see no error in our considering the Bell Laboratories article, published in a journal called "Computer Networks and ISDN Systems" as being in a technical publication that would not be viewed by the ordinary public that are the consumers of opposer's and applicant's goods and services.

² Because applicant did not discuss the admissibility of these exhibits in his response to opposer's objections, we did not discuss in our opinion the various reasons why the exhibits were not admissible as printed publications. For the sake of completeness, we point out that Exhibits W, X and Y are not admissible under *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031 (TTAB 2010), as Exhibit X does not bear a URL address or the date it was downloaded, and Exhibits W and Y do not bear complete URL addresses, nor did applicant, in response to opposer's objection, provide any information about whether the website is publicly available.

Applicant also argues, with respect to his Exhibits O and V, that "third parties researching trademarks would have considered the goods and services to point to computers." Motion for reconsideration, p. 3. We reiterate that we treated these exhibits of record, although we found them to have limited probative value because the articles were published in technical publications. The fact that the term "message in a bottle" has been referred to in two technical journals in connection with Bell Labs' Metaphorium website, or that Bell Labs has used the term for its own messaging system, has limited probative value with respect to applicant's fraud claim, which is based on the assertion that opposer intentionally misidentified and misclassified its services in obtaining its registration.

Many of applicant's arguments regarding whether opposer's services are properly classified in Class 38, or that opposer committed fraud in so classifying them and in its identification of services, were discussed in our June 15, 2010 decision, and we will not repeat them here. A motion for reconsideration should not be used to reargue the points presented in the brief on the case. See TBMP § 543. We reiterate that a party seeking cancellation of a trademark registration for fraudulent procurement bears a heavy burden of proof. *W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 377 F.2d 1001, 1004, 153 USPQ2d 749, 750

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(CCPA 1967). A trademark registration is obtained fraudulently only if the applicant/registrant knowingly makes a false, material representation with the intent to deceive the USPTO. In re Bose Corp., 91 USPQ2d 1938, 1941 (Fed. Cir. 2009). Therefore, absent the requisite intent to mislead the USPTO, even a material misrepresentation does not qualify as fraud, and warrant cancellation of a registration. See King Auto., Inc. v. Speedy Muffler King, Inc., 667 F.2d 1008, 212 USPQ 801 (CCPA 1981).

We do want to address one point, newly made in applicant's motion for reconsideration. Applicant notes the statement made by opposer's attorney in its brief that in indicating the class of services in opposer's underlying application the attorney consulted a trademark treatise by James E. Hawes, Trademark Registration Practice, which listed the heading for Class 38 as "Communications." This statement is not actually of record nor, after a decision has issued, can we treat it of record because applicant relies on it. However, even if this statement were of record, it would not support applicant's claim of fraud. Applicant argues that opposer's attorney did not do the correct research to classify the services in opposer's application that resulted in the registration applicant counterclaimed to cancel. However, there is no fraud if a false misrepresentation is occasioned by an honest

misunderstanding or inadvertence without a willful intent to deceive. In re Bose Corp., 91 USPQ2d at 1942.

Reasonableness is not part of the analysis. Id.

Applicant's position simply does not reflect the law regarding what fraud is.

Applicant has also submitted arguments regarding the Board's finding that his mark, as used for his goods, is likely to cause confusion with opposer's registered mark. With respect to the evidence of actual confusion, applicant states that "the Board has placed great weight and importance on the emails submitted by Roger Rojas, Ex. X, Ex. Z and Ex. Y." Motion for reconsideration, p. 6. However, although the Board did not discount the evidence, applicant mischaracterizes what the Board stated:

We recognize that it is difficult to obtain evidence of actual confusion. The evidence submitted by opposer, although perhaps individually not sufficient to show actual confusion, when taken together paints a circumstantial picture that people consider applicant's goods sold under the mark MESSAGE IN A BOTTLE and opposer's services rendered under that identical mark to emanate from the same source. **However, we do not need such evidence in order to conclude that applicant's use of his mark for his identified goods is likely to cause confusion with opposer's mark, although the evidence submitted by opposer reinforces that conclusion.**

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(emphasis added). It is clear that we did not rest our decision, or "place great weight," on the evidence of the emails. On the contrary, we stated that it merely reinforced the conclusion that we drew based on the other evidence of record with respect to other du Pont factors.

Applicant also argues that opposer has only opposed registration of applicant's mark for part of his identified goods. Applicant asserts that opposer does not provide kits and, therefore, even if the Board is not persuaded by applicant's motion for reconsideration, his application should be registered for "kits comprised of bottles, paper for creating promotional messages, advertising messages, greeting messages and invitations and packaging and boxes for mailing." However, a plaintiff need not use its mark for, or prove likelihood of confusion with, all of the goods listed in an applicant's single class application in order to successfully oppose the application. Likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the opposed application. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). As opposer has pointed out in its response to the motion for reconsideration, opposer's notice of opposition was brought against

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applicant's application as a whole, not against only certain of the goods in Class 16.

Decision: Applicant's request for reconsideration is denied.