

**UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451**

Mailed: August 7, 2009

Opposition No. 91164764

Brink's Network, Incorporated

v.

The Brinkmann Corporation

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of 1) opposer's motion (filed April 30, 2009) for leave to file an amended notice of opposition, and 2) opposer's motion (filed May 13, 2009) for leave to file a second amended notice of opposition. The motions are fully briefed.

The Board may, upon its initiative, resolve a motion filed in an inter partes proceeding by telephone conference. See Trademark Rule 2.120(i)(1); TBMP § 502.06(a) (2d ed. rev. 2004). On August 6, 2009 the Board convened a telephone conference to resolve the issues presented in the motions. Participating were Alan S. Cooper, counsel for opposer, Gary A. Clark, counsel for applicant, and the assigned Interlocutory Attorney.

Initially, it is noted that opposer's April 30, 2009 motion for leave to amend is granted to the extent that it deletes opposer's claim of ownership of Registration No.

2476114.<sup>1</sup> Opposer's May 13, 2009 motion for leave to file a second amended notice of opposition is granted to the extent that it deletes opposer's claim of ownership of Registration Nos. 2691470 and 2646784.<sup>2</sup>

We turn to opposer's motion insofar as it seeks to add an assertion of fraud as an additional ground for opposition.<sup>3</sup> Opposer seeks to add the same fraud claim by way of paragraphs 26 through 34 of its amended notice of opposition filed with its April 30, 2009 motion, and by way of paragraphs 24 through 32 of its second amended notice of opposition filed with its May 13, 2009 motion.

Opposer's proposed fraud claim alleges that applicant did not use the mark BRINKMANN for "home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters,

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<sup>1</sup> It is noted that Registration No. 2476114 was canceled under Trademark Act Section 8 on May 9, 2008.

<sup>2</sup> It is noted that no affidavit pursuant to Trademark Act Section 8 has been filed in Registration No. 2691470, which was registered on February 25, 2003, and that Registration No. 2646784 was cancelled under Trademark Act Section 8 on June 13, 2009.

<sup>3</sup> Because opposer's two motions for leave to amend seek to add the same fraud claim, the Board does not give separate consideration herein to each motion. The Board's ruling pertains specifically to opposer's May 13, 2009 motion and its accompanying second amended notice of opposition.

adapters and wall mount brackets" as of June 12, 1978, the date that applicant set forth in its use-based application as the date of first use and date of first use in commerce for its mark BRINKMANN for the goods in International Class 9. Opposer's proposed claim is predicated on an assertion that Mr. Brinkmann, President of applicant, either knew or should have known, upon signing the involved application, that the mark BRINKMANN had not been used in connection with these goods at least as early as June 12, 1978. Opposer posits that the assertion was a "knowing misstatement of material fact with respect to the date of first use," and that to the extent that the date of first use applicant provided in its application did not pertain to all items it listed in International Class 9, applicant failed to comply with TMEP Section 903.09 by not specifying the goods which actually corresponded to the stated date of first use.

#### Analysis

Amendments to pleadings in inter partes proceedings before the Board are governed by Fed. R. Civ. P. 15, made applicable to Board proceedings by operation of Trademark Rule 2.116(a). After a responsive pleading has been filed, a party may amend its pleading only by written consent of every adverse party, or by leave of the Board. Leave shall be freely given when justice so requires. See Fed. R. Civ. P. 15(a). The Board liberally grants leave to amend pleadings at

any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. See TBMP § 507.01 (2d ed. rev. 2004). See also *Hurley International LLC v. Volta*, 82 USPQ2d 1339, 1341 (TTAB 2007). Where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion for leave to amend. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1785 (Fed. Cir. 1990).

The timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) is a factor in determining whether the adverse party would be prejudiced by allowance of the proposed amendment. The motion should be filed as soon as any ground for such amendment becomes apparent. See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993). To support a motion to amend, opposer need not prove the allegations in its pleadings; it is only necessary that opposer allege facts sufficient to state a claim upon which relief may be granted. *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798, 1799 (TTAB 2000).

With respect to the proposed fraud claim, it is well-settled that if a mark was in use, in connection with the goods identified in a use-based application, as of the filing date of

such application, a statement of first use, even if false, does not constitute fraud on the USPTO. An erroneous date of first use does not constitute fraud unless, inter alia, there was no valid use of the mark until after the filing date of the application based on Section 1(a). See, e.g., *L. & J.G. Stickley Inc. v. Cosser*, 81 USPQ2d 1956, 1970 n.17 (TTAB 2007); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1926 (TTAB 2006).

In general, the essence of a claim of fraud on the USPTO is that an applicant made a statement which was false, but which the USPTO relied upon in determining that a mark should be published for opposition or registered, and that, but for its reliance on the false statement, the USPTO would not have approved the mark for publication or registration. An erroneous date of first use cannot result in the allowance of a registration which would otherwise not be allowed, as long as there was technical trademark use prior to the filing date of the application, because the examining attorney gives no consideration to alleged dates of first use in determining whether a mark should be published for opposition. *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 76 (TTAB 1983).

Here, the claim of fraud which opposer seeks to add is futile and legally insufficient. The proposed claim is predicated on an alleged "knowing misstatement of fact with respect to the date of first use of the mark BRINKMANN in connection with home security systems and components," and thus

does not set forth a claim on which relief can be granted under prevailing law.<sup>4</sup> Furthermore, there is no support for opposer's assertion that an applicant's failure to specify in its use-based application the goods to which a date of first use pertains, as suggested in TMEP Section 903.09, serves as the foundation for a fraud claim in an opposition proceeding.

In view thereof, opposer's motion for leave to file a second amended notice of opposition is denied to the extent that opposer seeks to add a fraud claim as a ground for opposition.

Paragraphs 24 through 32 of opposer's second amended notice of opposition are hereby stricken. See TBMP § 506.01 (2d ed. rev. 2004).

As stated above, opposer's motion is granted to the extent that opposer seeks to delete its claims of ownership of Registration Nos. 2476114, 2691470 and 2646784.

Accordingly, the operative pleading in this proceeding is now the second amended notice of opposition, filed May 13, 2009, with the exception of stricken paragraphs 24 through 32 thereof.

Applicant is allowed twenty (20) days from the mailing date of this order in which to file its answer to the operative pleading, as defined above.

#### Schedule

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<sup>4</sup> Inasmuch as opposer's proposed fraud claim is hereby denied on the basis of the futility of the claim, the Board need not provide full discussion of the issues of the timing of opposer's motion or potential prejudice to applicant. It clearly would be prejudicial to require applicant to answer, at any stage in the

With respect to the parties' consented motion (filed June 29, 2009) for an extension of discovery and trial periods, said motion is granted as modified, inasmuch as counsels confirmed during the conference that by way of their consented motion the parties seek an extension of discovery by approximately three months.

In view thereof, the close of discovery, and trial dates, are hereby reset as follows:

DISCOVERY PERIOD TO CLOSE:	11/06/09
30-day testimony period for party in position of plaintiff to close:	02/04/10
30-day testimony period for party in position of defendant to close:	04/05/10
15-day rebuttal testimony period to close:	05/20/10

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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proceeding, allegations that do not state a legally sufficient ground for opposition.

