THIS OPINION IS A
PRECEDENT OF THE TTAB

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

Faint

Mailed: January 29, 2009

Opposition No. 91169571

G&W Laboratories, Inc.

v.

G W Pharma Limited

Before Hairston, Holtzman and Mermelstein, Administrative Trademark Judges.

By the Board:

Opposer G&W Laboratories, Inc. (hereinafter "Labs") owns two trademark registrations: G&W in typed form[1] and the following mark,[2]

both for "suppositories; tablets, namely, laxative tablets and anti-diarrheal tablets; pharmaceutical preparations in topical semi-liquid dosage forms, namely, topical dermatological creams and ointments; liquid-containing pads for treating hemorrhoid-related conditions and for cleansing the rectal and vaginal areas" in Class 5; and

[1] Registration No. 2577687, registered June 11, 2002 with dates of first use anywhere and first use in commerce of 1919.

"distributorships in the field of suppositories and pharmaceutical preparations in the forms of tablets, topical semi-solid dosages, namely, topical creams and ointments, and liquid-containing pads to drug wholesalers, healthcare providers, managed care organizations and retail pharmacy services and retail grocery stores" in Class 35.

Following commencement of this opposition on the ground of priority and likelihood of confusion, applicant GW Pharma Limited (hereinafter "Pharma") filed counterclaims to cancel these registrations in their entireties on the ground of fraud, alleging that Labs had not rendered the Class 35 services in the registrations on behalf of others and had not used the marks in commerce for those services. Pharma did not allege that Labs committed fraud in connection with the goods in Class 5.

On May 22, 2008, Labs filed a motion which we construe as one to dismiss the counterclaims against Class 35 as moot, and to dismiss the counterclaims against Class 5 for failure to state a claim. The motion has been fully briefed.

As background for the motion, on April 7, 2008, during the course of this proceeding, and after assertion of Pharma's counterclaims, Labs made its required filings under

[2] Registration No. 2606786, registered August 13, 2002 with dates of first use anywhere and first use in commerce of 1981.

Trademark Act Section 8 with respect to each of the registrations subject to Pharma's counterclaims. By its Section 8 filings, Labs deleted Class 35 from its registrations, stating "[t]his entire class is to be **deleted** from the registration." (Emphasis in original).

Labs argues that Pharma's counterclaims for cancellation were based on a single contention, namely, that Labs fraudulently obtained its registrations as to the recited Class 35 services, and not as to the goods in Class 5. Because such services have now been deleted from the registration, Labs argues that the counterclaims should be dismissed as moot.

In opposition to the motion, Pharma argues that deletion of the class of services during maintenance of the registrations does not cure fraud. Pharma moreover argues that if fraud is shown as to Labs' Class 35 services, the registration must be cancelled in its entirety. Pharma relies on *Medinol Ltd. v. Neuro Vasx Inc.*, 67 USPQ2d 1205, 1208 (TTAB 2003) which provides,

> [D]eletion of the goods upon which the mark has not yet been used does not remedy an alleged fraud upon the Office. If fraud can be shown in the procurement of a registration, the entire resulting registration is void.

(Citation omitted).

In reply, Labs admits that it does not and never has used the marks in connection with the services listed in

Class 35, but contends that any claim of fraud directed to its now deleted Class 35 services cannot be "bootstrapped to the remaining class of goods in the registrations."

Labs' motion to dismiss the counterclaims as moot with respect to Class 35 of the registrations is denied. Pharma is correct that the fraud claim is not rendered moot by the deletion of services through a Section 8 filing. It is settled that fraud cannot be cured merely by deleting from the registration those goods or services on which the mark was not used at the time of the signing of a use-based application or a Section 8 affidavit. *Turbo Sportswear v. Marmot Mountain Ltd.*, 77 USPQ2d 1152, 1155 (TTAB 2005). *See also Medinol,* 67 USPQ2d at 1208.

However, Labs' motion to dismiss the counterclaims as to Class 5 for failure to state a claim is well taken. Pharma's contention that fraud as to one class of a multiple class registration subjects the entire registration to cancellation is incorrect. The line of cases to have considered fraud since *Medinol* has involved single class applications or registrations. These cases have consistently held that fraud as to any goods or services in a single class will lead to a finding that the application or registration is void in the class in which fraud has been committed. *See, e.g., Herbaceuticals Inc. v. Xel Herbaceuticals*, 86 USPQ2d 1572, 1577 (TTAB 2008) (fraud

found as to four of six single class registrations); *Hachette Filipacchi Presse v. Elle Belle LLC,* 85 USPQ2d 1090, 1095 (TTAB 2007) (fraud found in single class registration); *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1037 (TTAB 2007) (fraud found as to services in single class application even after allowance of amendment of application to one based on intent to use); *Hurley Int'l LLC v. Volta,* 82 USPQ2d 1339, 1344 (TTAB 2007) (fraud found as to non-use for services in single class registration); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha,* 77 USPQ2d 1917, 1928 (TTAB 2006) (counterclaim petition for cancellation of petitioner's pleaded registrations granted when fraud found as to some goods identified in single class registrations). However, we have not had occasion to consider whether fraud in less than all classes of a multiple-class registration will subject the entire registration to cancellation for fraud.

An applicant for a trademark registration may file for registration in more than one class by filing a single application. *See* Trademark Rule 2.86. Such an application requires, for each class, payment of the application filing fee and submission of dates of use and a specimen of use for each class before the application will proceed to registration. *Id.* Thus, a multiple-class application can be viewed as a series of applications for registration of a

mark in connection with goods or services in each class, combined into one application. As a general matter, the filer of such an application is in the same position it would be had it filed several single-class applications instead. *See, e.g., Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1101-02, 192 USPQ 24, 28 (CCPA 1976) (noting combined application is regarded as though it were group of individual applications); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224, 1226 (TTAB 1987)(noting multiple-class application for goods and services is essentially two separate applications combined for convenience of applicant and USPTO); *Electro-Coatings, Inc. v. Precision National Corp.*, 204 USPQ 410, 420 (TTAB 1979)("there are, in law, three applications and three oppositions to be adjudicated, because each class in a multiple class application constitutes a separate case."). In view thereof, we find that each class of goods or services in a multiple class registration must be considered separately when reviewing the issue of fraud, and judgment on the ground of fraud as to one class does not in itself

require cancellation of all classes in a registration.[3]

Accordingly, the counterclaims to cancel Class 5 fail to state a valid basis for cancellation, and the motion to dismiss the counterclaims as to that class is granted.

As we noted, Pharma's counterclaims to cancel the registrations as to Class 35 are not moot. In a cancellation proceeding against a registration having multiple classes, the respondent's request in a Section 8 affidavit to delete a class that is subject to cancellation is governed by Trademark Rule 2.134(a). Trademark Rule 2.134(a) provides that after the commencement of a cancellation proceeding, if the respondent applies for cancellation of the involved registration under Section 7(e) of the Act without the written consent of every adverse party to the proceeding, judgment shall be entered against the respondent. The request to delete a class of goods or services sought to be cancelled is, in effect, a voluntary cancellation of the registration as to that class under

[3] As a practical matter, holding otherwise would simply provide an incentive against the filing of multiple-class applications. For example, had Labs instead sought and obtained two separate registrations – one in Class 5 and one in Class 35, its Class 5 registration would effectively be insulated from a claim of fraud, even if we held that fraud as to one class taints other classes in the same registration. We see no justification for treating applications or registrations differently based solely on whether the applicant originally sought single-class registrations or a single, multiple-class one.

Section 7(e) of the Trademark Act. *See* TBMP § 602.02(a) (2d ed. rev. 2004).

With regard to its services in Class 35, Labs has stated that it deleted those services from each of its registrations when it filed its Section 8 affidavits in connection with the registrations, and provided copies of the relevant Section 8 affidavits. Labs' failure to file affidavits of continued use with respect to its Class 35 services and its explicit request to delete such services from its registrations – resulting in cancellation of that class – fit squarely within the ambit of Trademark Rule 2.134(a). In view thereof, and because Pharma's written consent to Labs' voluntary cancellations is not of record, judgment is hereby entered against Labs.

In sum, judgment on the counterclaims as to the services in Class 35 in Registration Nos. 2577687 and 2606786 is hereby entered. The counterclaims as to Class 5 in Registration Nos. 2577687 and 2606786 are dismissed.[4]

The opposition proceeding is resumed. Dates are reset as set out below.

DISCOVERY PERIOD TO CLOSE:	**CLOSED**
30-day testimony period for party in position of plaintiff to close:	**CLOSED**

[4] In view of our decision herein, Pharma's contested motion to compel discovery on the counterclaims is denied as moot.

30-day testimony period for party in position of defendant to close: **March 19, 2009**

15-day rebuttal testimony period for plaintiff to close: **May 3, 2009**

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.l25.

Briefs shall be filed in accordance with Trademark Rules 2.l28(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

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