

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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

Butler

Mailed: April 16, 2007

Opposition No. 91170389

Kipling Apparel Corp.

v.

Michael Rich

Before Walters, Bucher and Cataldo, Administrative Trademark
Judges.

By the Board:

Applicant seeks to register the mark



for "clothing, namely, pants, shorts, sweatpants, overalls,
shirts, tee-shirts, sweatshirts, dresses, skirts, blouses,
jackets, vests, coats, rainwear, lingerie, sleepwear, underwear,
loungewear, beachwear, swimwear, infantwear, gloves, socks
hoisery, belts."¹ The application was filed based on use under
Trademark Act §1(a). The following statement preceded the
identification of goods:

The applicant, or the applicant's related company or
licensee, is using the mark in commerce, and lists below the
dates of use by the applicant, ..., of the mark on or in
connection with the identified goods

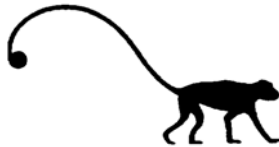
The following statement followed the identification of goods:

¹ Application Serial No. 76643592, filed July 25, 2005.

In International Class 025: the mark was first used at least as early as March 7, 2005, and first used in commerce at least as early as March 7, 2005, and now is in use in such commerce.

The application was accompanied by a signed declaration attesting to the truth of the statements made in the application.

As grounds for the opposition, opposer alleges 1) likelihood of confusion with its previously registered marks consisting in whole or in part of the following long tailed monkey design:²



and 2) fraud on the United States Patent and Trademark Office (USPTO) because applicant was not using his mark on all the goods identified in the application at the time he filed his use-based application yet he included a verified statement of use for all goods listed. Opposer alleges further that applicant knew "or believed" that the statement was false and made such statement with the intent of inducing the USPTO to rely thereon and allow the application to publish.

In his answer, applicant admits filing his application with a statement that he was using his mark in commerce on all of the identified goods and that the application contained a declaration.³ Applicant admits that he made a mistake and should have separated

² Registration No. 2806067 consists solely of the design. Registration No. 1952995 is for the mark KIPLING and design. Registration No. 1511776 is for the mark KIPLING BACK TO THE BAG and design.

the goods that were currently in use, "namely, shirts and hats," from "the remainder of the goods that were to be used in commerce."⁴ Applicant further admits opposer's ownership of its pleaded marks "associated with the Registrations listed..."⁵ Applicant otherwise denies the essential allegations of the notice of opposition. Applicant's denials of the remaining fraud allegations are qualified with explanations. Applicant admits a mistake was made in the application process whereby he inadvertently selected to file his application completely under Trademark Act §1(a), use in commerce, instead of under Trademark Act §1(b), intent to use, at least in part. Applicant alleges that he was unaware at the time of filing that he was doing so incorrectly and submits an affidavit in support thereof with his answer.

This case now comes up on opposer's motion, filed October 12, 2006, for summary judgment in its favor on its claim of fraud. The motion is fully briefed.

In support of its motion, opposer argues that applicant has committed fraud in attempting to procure a registration for his involved mark, thus making the involved application void ab initio. More specifically, opposer argues that applicant has admitted in his answer and affidavit accompanying his answer that, at the time of the filing date of the application, he was only using his mark on "shirts and hats" and not on all of the remaining identified goods.⁶

³ Paragraph Nos. 16-18 of the notice of opposition and answer, respectively.

⁴ Paragraph Nos. 19 and 20 of the answer.

⁵ Paragraph No. 9 of the notice of opposition and answer, respectively.

⁶ Paragraph no. 20 of applicant's answer; paragraph no. 6 of applicant's affidavit.

Opposer contends that applicant's misstatement of fact is material to the application and of the type that applicant knew or should have known was false.

Opposer relies on the admissions in applicant's answer and applicant's statements in his accompanying affidavit.

In response, applicant, also relying on his affidavit, notes that he was not represented by counsel and argues that he filed the application in good faith and believed at the time he signed the declaration supporting the application that he did so correctly. Applicant states that he did not realize he made a mistake until the Notice of Opposition was filed and he requests an opportunity to correct the application. Applicant also argues that he is the owner of Registration No. 3089320 for the mark MONORICO for essentially the same goods for which he now seeks to register his MONORICO and long tailed monkey design mark. Applicant argues that he did not have a willful intent to deceive the USPTO but believed he was entitled to a registration because the word portion of the subject mark is the same as his registered mark and both involve the same goods.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music*

Show, Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ 1542 (Fed. Cir. 1992).

Fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes false, material representations of fact in connection with an application to register. See *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986). Statements regarding the use of the mark on goods and services are certainly material to issuance of a registration covering such goods and services. See *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628 (TTAB 1988). See also *Hachette Filipacchi Presse v. Elle Belle, LLC*, ___ USPQ2d ___ (TTAB April 9, 2007);⁷ *Hurley International LLC v. Paul and Joanne Volta*, ___ USPQ2d ___ (TTAB January 23, 2007);⁸ *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917 (TTAB 2006); and *Medinol Ltd. v. Neuro Vasx, Inc.*, 67 USPQ2d 1205 (TTAB 2003).

In this case, opposer has established the absence of genuine issues of material fact for trial with regard to its claim of fraud and that it is entitled to summary judgment in its favor on this ground.

There is no dispute, and applicant has admitted, that applicant had not used his mark in connection with most of the

goods identified in his application at the time he filed his use-based application. His application included a declaration attesting to the truth of all the statements made in the application. The subject application, filed under Section 1(a) of the Trademark Act, would have been refused registration but for applicant's misrepresentation regarding his use of the mark. Prior to publication, applicant had an opportunity to remedy the matter because a misstatement in an application as to the goods or services on which a mark has been used does not rise to the level of fraud where an applicant amends the application prior to publication. See *Universal Overall Co. v. Stonecutter Mills Corp.*, 154 USPQ 104 (CCPA 1967). However, applicant cannot now correct the false statement in the involved application. Rather, his remedy lies with filing a new application relying on an appropriate and correct basis.

In inter partes proceedings, " ... fraud occurs when an applicant or registrant makes a false material representation that the applicant or registrant knew or should have known was false." See *General Car and Truck Leasing Systems, Inc. v. General Rent-A-Car, Inc.*, 17 USPQ2d 1398, 1400 (D.C. S.Fla. 1990). The fact that applicant misunderstood a clear and unambiguous requirement for a use-based application and was not represented by legal counsel does not shield applicant from our finding that he knew or should have known that the representation of fact in his application was false. Nor does such circumstance

⁷ Cancellation No. 92042991.

otherwise preclude our finding of fraud. See *Hurly, supra*. Even if applicant did not act willfully or in bad faith, it was not reasonable for applicant to state use dates in a use-based application for goods upon which he had no use. Applicant was under an obligation to investigate thoroughly the validity of his belief before signing the declaration in support of the application. *Id.* Further, this representation is clearly material to the application.

We find that there are no genuine issues of material fact that applicant's misrepresentation was material and, thus, fraudulent, thus making the application void ab initio. Accordingly, opposer's motion for summary judgment is granted on its fraud claim only and the opposition is sustained.

In view of our finding of fraud, and because opposer did not move for summary judgment on its likelihood of confusion claim, we need not reach the issue of likelihood of confusion.

⁸ Opposition No. 91158304.