Mailed: May 15, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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H. Michael Bishop

v.

Marina Flournoy

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Opposition No. 91175625
to Application No. 78780720
filed on December 26, 2005

Opposition No. 91175737
to Application No. 78780721
filed on December 26, 2005

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ON REMAND FROM THE U.S. COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

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Christine Lardas, Esq.,[1] for H. Michael Bishop.

Marina L. Flournoy, *pro se.*

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Before Drost, Mermelstein, and Bergsman, Administrative Trademark Judges.

Opinion by Mermelstein, Administrative Trademark Judge:

On September 5, 2008, the Board issued a decision dismissing these proceedings based on opposer's failure to

[1] Opposer appears to have prosecuted its appeal *pro se* before the Federal Circuit. It is not clear whether Ms. Lardas continues to represent opposer in these matters, although no request for withdrawal or substitution of counsel has been received by the Board.

submit evidence in support of its case. Opposer appealed to the U.S. Court of Appeals for the Federal Circuit. On April 1, 2009, the Court remanded these matters to the Board for further proceedings. The Court noted that in her answer, applicant "Flournoy admitted that she had knowledge that Bishop had been using both of the marks on his original artwork. Flournoy also admitted that the category in which she filed for these trademarks includes original artwork." *Bishop v. Flournoy*, No. 2009-1084, slip op. at 5 (Fed. Cir. Apr. 1, 2009) ("Bishop II"). The Court reasoned that

> the admissions made by Flournoy may have been sufficient to establish standing and fraud or likelihood of confusion. The Board did not specifically address whether Flournoy's admissions were sufficient to establish Bishop's standing and request for relief. Rather than decide on appeal whether the admissions are sufficient, we remand for the Board to address in the first instance whether the admissions satisfied Bishop's burden of proof.

Id.

Discussion

It is clear that the subject goods identified in the application include original artwork, as well as reproductions, and that applicant recognized this fact in her answer. As for applicant's knowledge of opposer's use of the marks in question, applicant's answer includes the following statements:

> Allegation No. 2: "Mr. Bishop, opposer, has a priority right in the mark."

Answer to allegation No. 2:

> As to knowing Mr. Bishop uses the mark on his artwork: Admitted.
> As to Mr. Bishop having a priority right in the mark: Denied

Answer at 2 (Mar. 24, 2007). Thus, while applicant admitted that opposer "uses the mark" on similar or even identical goods, applicant flatly denied that opposer had priority.

Where a party alleges rights based on use (as opposed to rights based on a registered trademark), priority is a necessary element of a claim under Trademark Act § 2(d), 15 U.S.C. § 1052(d). The statute prohibits registration of a mark which

> [c]onsists or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive....

Id. (emphasis added).

As the Federal Circuit recognized, opposer alleges two grounds for relief in these oppositions: (1) priority and a likelihood of confusion with opposer's previously used marks; and (2) fraud ("Ms. Flournoy was dishonest when she signed her verification indicating that she had no knowledge of another's right to the mark."). *Bishop II*, slip op. at 2; *see* Notice of Opp. at 1 (Feb. 12, 2007). In the present

posture of these matters, applicant's firm denial of opposer's claim of priority is fatal to both claims.

As to opposer's likelihood of confusion claim, it is clear that priority is a necessary element. Because opposer did not provide any admissible evidence, *see Bishop II*, Slip. Op. at 5 ("we agree that the Board was not required to consider Bishop's untimely submitted evidence"), opposer's priority is established – if at all – by the admissions, if any, in applicant's answer. But as applicant's answer makes clear, she denied opposer's claim of priority. To be certain, applicant's denial does not mean that opposer did not in fact have priority. Nonetheless, its effect was to place the burden upon opposer to prove this necessary fact by the submission of competent evidence, something which was not done, as our reviewing court recognized. Accordingly, opposer's claim of priority and likelihood of confusion must fail.

The notices of opposition also alleged that in filing her applications, applicant falsely indicated "she had no knowledge of another's right to the mark." The following declaration was submitted in connection with applicant's applications:

> The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the

> validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Application (Dec. 26, 2005).

To prevail on such a fraud claim, opposer would have to establish not only that applicant's declaration[2] was false (*i.e.*, that applicant did not have superior rights in the mark), but also that applicant knew or should have known that her oath was false. *Am. Sec. Bank v. Am. Sec. & Trust Co.*, 571 F.2d 564, 197 USPQ 65, 67 (CCPA 1978)("Appellant misreads the cited statute and rules. They require the statement of *beliefs* about exclusive rights, not their actual possession. Appellant has produced no evidence impugning appellee's beliefs.").

[2] The application and declaration were signed by applicant's counsel, as permitted under the applicable rules. *See* Trademark Rule 2.33(a).

Here, opposer neither pled nor proved applicant's knowledge of opposer's superior rights, and – more importantly – applicant admitted no such thing:

> Allegation No. 3: "Ms. Flournoy was dishonest when she signed her verification indicating she had no knowledge of another's right to the mark."
>
> Answer to allegation No. 3: Denied

As noted, applicant admitted her knowledge that opposer used the mark on the same goods. But applicant did not admit that opposer's rights (if any) were superior to hers. If anything, applicant's denial of opposer's claim of priority implies the opposite, namely, that applicant believed that it was she – not opposer – who possessed superior rights in the mark. Once again, applicant's denial of opposer's priority did not establish applicant's priority, but it did put the burden upon opposer to prove the elements of its fraud claim, namely, that opposer possessed superior rights to the mark and that opposer knew this to be the case.

Conclusion

We have assumed for the sake of this decision that applicant's admission that opposer is using the mark was sufficient to establish opposer's standing. Nonetheless, it is clear that opposer cannot prevail on either its likelihood of confusion claim or its fraud claim absent

evidence – or an admission – of priority.

After careful consideration of the record, we adhere to the result reached in our previous decision.

Decision: The opposition is accordingly DISMISSED.