

ESTTA Tracking number: **ESTTA186804**

Filing date: **01/15/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91177858
Party	Defendant Nordstrom, Inc.
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Date	01/15/2008
Attachments	Applicant'sMotForSJ.pdf (17 pages)(465294 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ZANELLA, LTD.,)	Opposition No. 91177858
)	
Opposer/Respondent,)	Application No. 77025247
)	
v.)	
)	
NORDSTROM, INC.,)	
)	
Applicant/Petitioner.)	Docket No. 700043.80073
_____)	

**APPLICANT'S MOTION FOR SUMMARY JUDGMENT CANCELLING
OPPOSER'S REGISTRATIONS FOR FRAUD**

TABLE OF CONTENTS

I. INTRODUCTION AND SUMMARY OF ARGUMENT1

II. SUMMARY OF PROCEEDINGS2

III. STATEMENT OF UNDISPUTED FACTS2

IV. ARGUMENT7

 A. Legal Standard for Summary Judgment – No Material Facts in
 Dispute7

 B. Summary Judgment Cancelling a Registration for Fraud Is
 Appropriate Where the Undisputed Facts Establish That the
 Registrant Made False Claims of Use.....8

 C. The Undisputed Facts Establish That Opposer Committed
 Fraud by Making False Claims of Use.....8

 1. Opposer Made False Representations in the
 Procurement of Each Registration9

 2. Opposer’s Misrepresentations Were Material to
 Registration.....10

 3. Opposer Knew or Should Have Known That Its
 Representations of Use Were False11

V. CONCLUSION.....12

TABLE OF AUTHORITIES

CASES

<i>Anderson v. Liberty Lobby, Inc.</i> , 477 U.S. 242 (1986).....	7
<i>Blansett Pharmaceutical Co. v. Carmrick Labs. Inc.</i> , 25 USPQ2d 1473 (TTAB 1992).....	2
<i>Celotex Corp. v. Catrett</i> , 477 U.S. 317 (1987).....	7
<i>First Int’l Serv. Corp. v. Chuckles, Inc.</i> , 5 USPQ2d 1628 (TTAB 1987).....	10
<i>General Car and Truck Leasing Systems Inc. v. General Rent-A-Car Inc.</i> , 17 USPQ2d 1398 (S.D. Fla. 1990).....	11
<i>Hachette Fillipacchi Presse v. Elle Belle, LLC</i> , 85 USPQ2d 1090 (TTAB 2007).....	8, 10, 11, 12
<i>Hurley Int’l LLC v. Volta</i> , 82 USPQ2d 1339 (TTAB 2007).....	7, 8, 10, 11
<i>Matsushita Electric Industrial Co. Ltd. v. Zenith Radio Corp.</i> , 475 U.S. 574 (1987).....	7
<i>Medinol Ltd. v. Neuro Vasx, Inc.</i> , 67 USPQ2d 1205 (TTAB 2003).....	8, 10, 11, 12
<i>Sinclair Oil Corp. v. Kendrick</i> , 85 USPQ2d 1032 (TTAB 2007).....	8, 10
<i>Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha</i> , 77 USPQ2d 1917 (TTAB 2006).....	10
<i>Sweats Fashion, Inc. v. Pannill Knitting Co.</i> , 4 USPQ2d 1793 (Fed. Cir. 1987).....	7
<i>Torres v. Cantine Torresella S.r.l.</i> , 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986).....	8
<i>United Rum Merchants, Ltd. v. Distiller’s Corp.</i> , 9 USPQ2d 1481 (TTAB 1988).....	7

RULES

37 C.F.R. § 2.127(e).....	2
Fed. R. Civ. P. 56(c).....	6

I. INTRODUCTION AND SUMMARY OF ARGUMENT

Opposer/Respondent Zanella, Ltd. (“Opposer” or “Zanella”) owns the following registered marks that all matured from applications based on Zanella’s representations of actual use in commerce under Section 1(a) of the Trademark Act:

ZANELLA, Registration No. 1519894 for “men’s wearing apparel, namely raincoats, [mantles], jackets, shirts, [blouses, waistcoats,] trousers, pants, [socks, stockings, ties, scarves, hats, swimwear,] vests [and underwear] in Class 025;

ZANELLA and Design, Registration No. 1527003 for “men’s wearing apparel, namely raincoats, mantels, jackets, shirts, blouses, waistcoats, trousers, pants, socks, stockings, ties, scarves, hats, swimwear, vests and underwear” in Class 025;

ZANELLA, Registration No. 1990695 for “women’s clothing, namely shorts, skirts, dresses, blouses, pants, jackets, coats, vests, scarves, hats, swimwear, raincoats, socks and underwear” in Class 025;

ZANELLA (stylized), Registration No. 1992385 for women’s clothing, namely shorts, skirts, dresses, blouses, pants, jackets, coats, vests, [scarves, hats, swimwear,] raincoats, [socks, and underwear] in Class 025; and

ZANELLA and Design, Registration No. 2453062 for “women’s and men’s clothing, namely, shorts, skirts, blouses, pants, jackets, coats, vests, scarves, hats, swimwear, raincoats, socks, underwear, mantles, shirts, waistcoats, trousers, stockings and ties” in Class 025.

(the “Zanella Marks” or “Zanella Registrations”).

In each underlying application, Opposer represented to the U.S. Patent and Trademark Office (USPTO) that it had adopted and was using the mark for the claimed goods. Opposer now admits that it had no use for many of the goods for which it claimed use and secured registration. In addition, with respect to Registration Nos. 1519894 and 1527003, Opposer filed Declarations of Use and Incontestability under Sections 8 and 15 stating that the marks were in use with various men’s apparel when no such use had occurred. Opposer knew or should have known that it was not using the marks as it claimed. But for these false representations and declarations, the USPTO would not have issued the broad registrations upon which Zanella seeks to rely in this Opposition.

Thus, the undisputed facts establish fraud in the procurement of the Zanella Registrations, making summary judgment cancelling of these registrations proper. Nordstrom therefore respectfully requests that this motion be granted and Registration Nos. 1519894, 1527003, 1990695, 1992385 and 2453062 be cancelled in their entireties.

II. SUMMARY OF PROCEEDINGS

On October 19, 2006, Applicant/Petitioner Nordstrom, Inc. ("Applicant" or "Nordstrom") filed U.S. Application Serial No. 77025247 to register the mark ZELLA in Class 25 on the basis of an intent-to-use the mark in commerce under Section 1(b). The mark was published for opposition on February 27, 2007.

Opposer filed a Notice of Opposition on June 15, 2007 alleging that Nordstrom's ZELLA mark, when applied to the goods in Application No. 77025247, is likely to cause confusion with the Zanella Registrations and marks. Nordstrom filed its Answer on July 24, 2007 and the parties have engaged in preliminary discovery by means of interrogatories and requests for documents and admissions. Through this initial discovery, Nordstrom learned of the undisputed facts relied on in this motion. Nordstrom timely moved to amend its Answer in this Opposition to add a counterclaim to cancel Opposer's pleaded Zanella Registrations based on fraudulent procurement. Nordstrom's motion to amend is pending.

The discovery period is set to close on May 1, 2008. Pursuant to 37 C.F.R. Section 2.127(e), this motion for summary judgment is timely as the first testimony period has not yet opened. *See, e.g., Blansett Pharmaceutical Co. v. Carmrick Labs. Inc.*, 25 USPQ2d 1473 (TTAB 1992).

III. STATEMENT OF UNDISPUTED FACTS

The following facts are undisputed:

Registration No. 1519894

1. Opposer filed underlying Application Serial No. 73662018 for the mark ZANELLA on May 21, 1987, together with a declaration signed by its Managing Director, Landino Lovison,

attesting to the truth of the statement that Opposer “has adopted and is using [its mark] for men’s wearing apparel, namely raincoats, mantels [sic], jackets, shirts, blouses, waistcoats, trousers, pants, socks, stockings, ties, scarves, hats, swimwear, vests and underwear.” Application Serial No. 73662018. Durrance Decl., Exh. 8.

2. Opposer was not using the mark found in Registration No. 1519894 on or in connection with men’s mantles, blouses, waistcoats, socks, stockings, ties, scarves, hats, swimwear, or underwear distributed in the U.S. prior to May 21, 1987. Zanella’s Resp. RFA Nos. 33-42; Durrance Decl., Exh. 1. Zanella’s Resp. Interr. No. 37; Durrance Decl., Exh. 2.

3. On August 31, 1995, Opposer filed a combined Declaration of Use and Incontestability under Sections 8 and 15 signed by its Vice President-Finance, Ricky R. Miller, attesting that its mark “has been in continuous use in commerce regulated by the United States for five consecutive years from the date of the registration to the present, on or in connection with all of the goods stated in the registration.” Registration No. 1519894, Affidavit of Use and Incontestability. Durrance Decl., Exh. 6. At that time, the following goods were listed in the registration:

Men’s wearing apparel, namely raincoats, mantles, jackets, shirts, blouses, waistcoats, trousers, pants, socks, stockings, ties, scarves, hats, swimwear, vests and underwear.

Registration No. 1519894. Durrance Decl., Exh. 4.

4. At the time Opposer submitted its combined Affidavit of Use and Incontestability under Sections 8 and 15 to the USPTO for U.S. Trademark Registration No. 1519894, the mark was not being used on or in connection with men’s mantles, blouses, waistcoats, socks, stockings, ties, scarves, hats, swimwear or underwear. Zanella’s Resp. RFA Nos. 67-76; Durrance Decl. Exh. 1. Zanella’s Resp. Interr. No. 37; Durrance Decl., Exh. 2.

5. Opposer has never distributed mantles, waistcoats, socks, stockings, ties, hats, swimwear, or underwear in connection with the mark found in Registration No. 1519894 in the U.S. Zanella’s Resp. RFA Nos. 24-31; Durrance Decl., Exh. 1.

Registration No. 1527003

6. Opposer filed underlying Application No. 73662076 for the mark ZANELLA and Design on May 21, 1987, together with a declaration signed by its Managing Director, Landino Lovison, attesting to the truth of the statement that Opposer “has adopted and is using [its mark] for men’s wearing apparel, namely raincoats, mantels [sic], jackets, shirts, blouses, waistcoats, trousers, pants, socks, stockings, ties, scarves, hats, swimwear, vests and underwear.” Application Serial No. 73662076; Durrance Decl., Exh. 9.

7. Opposer was not using the mark found in Registration No. 1527003 on or in connection with men’s mantles, blouses, waistcoats, socks, stockings, ties, scarves, hats, swimwear, or underwear distributed in the U.S. prior to May 21, 1987. Zanella’s Resp. RFA Nos. 33-42; Durrance Decl., Exh. 1. Zanella’s Resp. Interr. No. 38; Durrance Decl., Exh. 2.

8. On August 31, 1995, Opposer filed a combined Affidavit of Use and Incontestability under Sections 8 and 15 signed by its Vice President-Finance, Ricky R. Miller, attesting that its mark “has been in continuous use in commerce regulated by the United States for five consecutive years from the date of the registration to the present, on or in connection with all of the goods stated in the registration.” Registration No. 1527003, Affidavit of Use and Incontestability. Durrance Decl., Exh. 7. At that time, the following goods were listed in the registration:

Men’s wearing apparel, namely raincoats, mantels [sic], jackets, shirts, blouses, waistcoats, trousers, pants, socks, stockings, ties, scarves, hats, swimwear, vests and underwear.

Registration No. 1527003; Durrance Decl., Exh. 5.

9. At the time Opposer submitted its combined Affidavit of Use and Incontestability under Sections 8 and 15 to the USPTO for U.S. Trademark Registration No. 1527003, the mark was not being used on or in connection with men’s mantles, blouses, waistcoats, socks, stockings, ties, scarves, hats, swimwear or underwear. Zanella’s Resp. RFA Nos. 57-66; Durrance Decl., Exh. 1.

10. Opposer has never distributed mantles, waistcoats, socks, stockings, ties, hats, swimwear, or underwear in connection with the mark found in Registration No. 1527003 in the U.S.

Zanella's Resp. RFA Nos. 24-31; Durrance Decl., Exh. 1.

Registration No. 1990695

11. Opposer filed underlying Application No. 74548674 for the mark ZANELLA on July 13, 1994 based on actual use in commerce identifying its goods improperly as "women's wearing apparel." In response to a requirement to identify its goods with more particularity, Applicant represented that the mark was in use in connection with:

Women's clothing, namely shorts, skirts, dresses, blouses, pants, jackets, coats, vests, scarves, hats, swimwear, raincoats, socks and underwear

and ultimately acquiring registration for such goods. Response to Office Action, received July 3, 1995 in Application Serial No. 74548674; Durrance Decl., Exh. 10. Registration No. 1990695; Durrance Decl., Exh. 11.

12. Opposer was not using the mark found in Registration No. 1990695 on or in connection with women's scarves, hats, swimwear, socks, or underwear distributed in the U.S. prior to July 13, 1994. Zanella's Resp. RFA Nos. 43-47; Durrance Decl., Exh. 1.

13. Opposer has never distributed hats, swimwear, socks, or underwear in connection with the mark found in Registration No. 1990695 in the U.S. Zanella's Resp. RFA Nos. 24-27; Durrance Decl., Exh. 1.

Registration No. 1992385

14. Opposer filed underlying Application No. 74548675 for the mark ZANELLA (stylized) on July 13, 1994 based on actual use in commerce identifying its goods improperly as "women's wearing apparel." In response to a requirement to identify its goods with more particularity, Applicant represented that the mark was in use in connection with:

Women's clothing, namely shorts, skirts, dresses, blouses, pants, jackets, coats, vests, scarves, hats, swimwear, raincoats, socks and underwear

and ultimately acquiring registration for such goods. Response to Office Action, received July 3, 1995 in Application Serial No. 74548675; Durrance Decl., Exh. 12. Registration No. 1992385; Durrance Decl., Exh. 13.

15. Opposer was not using the mark in Registration No. 1992385 on or in connection with women's scarves, hats, swimwear, socks, or underwear distributed in the U.S. prior to July 13, 1994. Zanella's Resp. RFA Nos. 43-47; Durrance Decl., Exh. 1.

16. Opposer has never distributed hats, swimwear, socks, or underwear in connection with the mark found in Registration No. 1992385 in the U.S. Zanella's Resp. RFA Nos. 24-27; Durrance Decl., Exh. 1.

Registration No. 2453062

17. Opposer filed underlying Application No. 76021021 for the mark ZANELLA and Design on April 11, 2000, together with a declaration signed by its President, Armando Di Natale, attesting to the truth of the statement that Opposer "has adopted and is using [its mark] for the following goods:

Women's and men's clothing, namely, shorts, skirts, blouses, pants, jackets, coats, vests, scarves, hats, swimwear, raincoats, socks, underwear, mantels [sic], shirts, waistcoats, trousers, stockings and ties.

Application Serial No. 76021021; Durrance Decl., Exh. 3.

18. Opposer was not using the mark found in U.S. Trademark Registration No. 2453062 on or in connection with scarves, hats, swimwear, socks, underwear, mantles, waistcoats, stockings, or ties distributed in the U.S. prior to April 11, 2000. Zanella's Resp. RFA Nos. 48-56; Durrance Decl., Exh. 1.

19. Opposer has never distributed hats, swimwear, socks, underwear, mantles, waistcoats, stockings, or ties in connection with the mark found in U.S. Trademark Registration No. 2453062 in the U.S. Zanella's Resp. RFA Nos. 24-31; Durrance Decl., Exh. 1.

IV. ARGUMENT

A. Legal Standard for Summary Judgment – No Material Facts in Dispute

Summary judgment is appropriate where there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c); *see Celotex Corp. v. Catrett*, 477 U.S. 317 (1987). The aim of summary judgment is judicial economy, that is, to save the time and expense of trial where no genuine issue of material fact remains, and where no evidence beyond that which is already available in support of the summary judgment motion could reasonably be expected to change the result. *United Rum Merchants, Ltd. v. Distiller's Corp.*, 9 USPQ2d 1481, 1482 (TTAB 1988).

No genuine issue for trial exists where the record taken as a whole could not lead a rational trier of fact to find for the non-moving party. *Matsushita Electric Industrial Co. Ltd. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1987). A dispute is genuine only if, on the entirety of the record, a reasonable trier of fact could resolve a factual matter in favor of the non-moving party. *Sweats Fashion, Inc. v. Pannill Knitting Co.*, 4 USPQ2d 1793 (Fed. Cir. 1987), *citing Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986). Disputes over facts which will not affect the outcome under the governing law are immaterial and do not preclude the entry of summary judgment.

When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial. *Hurley Int'l LLC v. Volta*, 82 USPQ2d 1339, 1343 (TTAB 2007). The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial. *Id.*

B. Summary Judgment Cancelling a Registration for Fraud Is Appropriate Where the Undisputed Facts Establish That the Registrant Made False Claims of Use

In a cancellation proceeding based on fraud, a petitioner is entitled to judgment when it proves that: (1) the registrant made a representation of fact to the USPTO in its application; (2) the representation was material; and (3) the registrant knew or should have known the representation to be false or misleading. *See Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 49, 1 USPQ2d 1483, 1485 (Fed. Cir. 1986).

The Board has consistently applied this test and granted summary judgment for cancellation based on fraud when the undisputed facts establish that an applicant for registration made a false claim of use in the procurement of its registration. *Hachette Fillipacchi Presse v. Elle Belle LLC*, 85 USPQ2d 1090 (TTAB 2007) (summary judgment granted based on admission that registrant had not used its mark in connection with a significant number of the listed goods at the time it filed an application based on use); *Hurley Int'l*, 82 USPQ2d at 1344 (summary judgment granted based on admission that registrant had not used its mark in connection with a significant number of the listed services at the time it filed an application based on use); *Medinol Ltd. v. Neuro Vasx, Inc.*, 67 USPQ2d 1205 (TTAB 2003) (summary judgment granted on undisputed fact that registrant had used its mark on only one of two claimed goods at time of filing its statement of use). *See also Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032 (TTAB 2007) (summary judgment granted based on undisputed evidence that the applicant for registration had not engaged in use of its mark in commerce at the time of filing use-based application).

C. The Undisputed Facts Establish That Opposer Committed Fraud by Making False Claims of Use

The undisputed facts establish that in obtaining each of the Zanella Registrations Opposer made material, false representations concerning its use that it knew or should have known were false:

1. Opposer Made False Representations in the Procurement of Each Registration

a. Registration Nos. 1519894 and 1527003

Opposer filed U.S. Trademark Application Serial Nos. 73662018 and 73662076 under Section 1(a) on May 21, 1987 for the marks ZANELLA and ZANELLA and Design, respectively. In connection with these applications, Opposer represented in signed declarations that the respective marks were in use in connection with, among other goods, “men’s mantles, blouses, waistcoats, socks, stockings, ties, scarves, hats, swimwear and underwear.” (UF Nos. 1, 6).¹ Opposer admits that as of May 21, 1987, it had not used either mark in the U.S. in connection with men’s mantles, blouses, waistcoats, socks, stockings, ties, scarves, hats, swimwear and underwear. (UF Nos. 2, 7). In fact, with respect to hats, swimwear, socks, underwear, mantles, waistcoats, stockings, and ties, Opposer admits that it has never distributed such goods in connection with the marks found in Registration Nos. 1519894 and 1527003 in the U.S. (UF Nos. 5, 10).

In addition to misrepresentations at the time of filing, Opposer filed false statements in combined Affidavits of Use and Incontestability under Sections 8 and 15 on August 31, 1995. Each respective affidavit contained the statement that the marks were in continuous use with all of the goods stated in the registration for five consecutive years from the date of registration to the present. (UF Nos. 3, 8). To the contrary, as now admitted by Opposer, use on all goods had not commenced at the time of filing the affidavits, let alone from the date of registration. (UF Nos. 4, 9).

b. Registration Nos. 1990695 and 1992385

Opposer filed U.S. Trademark Application Serial Nos. 74548674 and 74548675 under Section 1(a) on July 13, 1994 for the marks ZANELLA and ZANELLA (stylized), respectively. In connection with these applications, Opposer asserted that the respective marks were in use in connection with, among other goods, “women’s scarves, hats, swimwear, socks and underwear.”

¹ Undisputed facts in the numbered paragraphs of Section III, above, are cited as “UF No. ___” for ease of reference.

(UF Nos. 11, 14). Opposer admits that as of July 13, 1994, it had not used either mark in the U.S. in connection with women's scarves, hats, swimwear, socks and underwear. (UF Nos. 12, 15). In fact, with respect to hats, swimwear, socks, and underwear, Opposer admits that it has never distributed such goods in connection with the marks found in Registration Nos. 1990695 and 1992385 in the U.S. (UF Nos. 13, 16).

c. Registration No. 2453062

Opposer filed U.S. Trademark Application Serial No. 76021021 under Section 1(a) on April 11, 2000 for the mark ZANELLA and Design. In connection with this application, Opposer represented in a signed declaration that the ZANELLA and Design mark was in use in connection with, among other goods, "scarves, hats, swimwear, socks, underwear, mantles, waistcoats, stockings and ties." (UF No. 17). Opposer admits that as of April 11, 2000, it had not used the ZANELLA and Design mark in the U.S. in connection with scarves, hats, swimwear, socks, underwear, mantles, waistcoats, stockings, or ties. (UF No. 18). In fact, with respect to hats, swimwear, socks, underwear, mantles, waistcoats, stockings, and ties, Opposer admits that it has never distributed such goods in connection with the mark found in Registration No. 2453062 in the U.S. (UF No. 19).

2. Opposer's Misrepresentations Were Material to Registration

There is no question that Opposer's misrepresentations were material to registration of the Zanella Marks because the USPTO will not issue a registration under Section 1 covering goods upon which the mark has not been used. The Board has repeatedly asserted, "Statements regarding the use of the mark on the identified goods and/or services are certainly material to the issuance of a registration." *Sinclair Oil*, 85 USPQ2d at 1035; *Hachette Fillipacchi Presse*, 85 USPQ2d at 1093; *Hurley Int'l*, 82 USPQ2d at 1344. See also *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1927 (TTAB 2006); *Medinol*, 67 USPQ2d at 1208; *First Int'l Serv. Corp. v. Chuckles, Inc.*, 5 USPQ2d 1628, 1636 (TTAB 1987).

3. Opposer Knew or Should Have Known That Its Representations of Use Were False

Opposer knew or should have known at the time of filing each application and making such assertions that its marks were not in use in connection with many of the goods for which it claimed use (*see* UF Nos. 2, 4, 5, 7, 9, 10, 12, 13, 15, 16, 18, 19).

It is well-established that the intent required to establish fraud on the USPTO need not be specific, and fraud occurs when an applicant or registrant makes a material representation that it knew or should have known was false. *See Medinol*, 67 USPQ2d at 1209 (*citing General Car and Truck Leasing Systems Inc. v. General Rent-A-Car Inc.*, 17 USPQ2d 1398, 1400 (S.D. Fla. 1990)). “The appropriate inquiry is therefore not into the registrant’s subjective intent, but rather into the objective manifestations of that intent.” *Id.* Excuses such as inattentiveness, misunderstanding, difficulty with the English language, reliance on attorney action, lack of attorney representation, or suffering health problems will not preclude a finding of fraud, especially in light of the degree of solemnity with which a statement of use and other declarations are made. *See id.* (statement of use should be investigated thoroughly prior to signature and submission to the USPTO); *Hachette Fillipacchi Presse*, 85 USPQ2d at 1094 (fact that English was not the registrant’s native language or that registrant apparently had continuing difficulty with the language did not change finding of fraud; nor did the misunderstanding on the part of respondent’s attorney preclude a finding of fraud); *Hurley Int’l*, 82 USPQ2d at 1345 (the fact that applicants allegedly misunderstood a clear and unambiguous requirement, were not represented by counsel, and were suffering health problems did not change finding of fraud).

The case of *Hachette Fillipacchi Presse* is of particular relevance. In *Hachette Fillipacchi Presse*, the Board entered summary judgment based on the fraudulent procurement of the mark ELLE BELLE for a laundry list of clothing items for men, women and children, based on a finding that respondent had not used its mark in connection with a significant number of the listed goods at the time it filed an application based on use and signed the accompanying declaration. *Hachette Fillipacchi Presse*, 85 USPQ2d at 1093. The Board reasoned that an

applicant has an obligation to confirm the meaning and accuracy of the statements contained in the application before signing the declaration and prior to submission to the USPTO. *Id.* at 1094. The Board found that respondent failed its obligation and that respondent's misunderstanding or the misunderstanding on the part of respondent's attorney would not preclude a finding of fraud. *Id.* Nor did Respondent's subsequent attempt to amend its application to remove goods on which its mark had never been used preclude a finding of fraud. *Id.* at 1094-95.

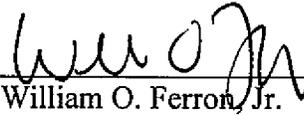
The present case is analogous to *Hachette Fillipacchi Presse*. Like the respondent in that case, Opposer here filed use-based applications for a laundry list of clothing items. In filing such applications, Opposer asserted that it had adopted and was using the respective marks in connection with all of the identified goods despite the fact that Opposer knew or should have known that it had no use for many of the goods. Opposer was under an affirmative obligation to insure the accuracy of its representations to the USPTO, and clearly failed to do so – as highlighted by the goods for which it now admits it never had use. Opposer cannot now rely on inadvertence or misunderstanding to excuse such gross inaccuracies. As a result, Opposer has committed fraud and the Zanella Registrations should be canceled in their entirety. *See Medinol*, 67 USPQ2d at 1208.

V. CONCLUSION

Opposer was obliged to confirm the accuracy its representations to the USPTO, especially on the threshold issue of use of its marks on the claimed goods. Opposer indisputably failed in its obligation and made false representations to the USPTO by claiming it was using the Zanella Marks on a variety of clothing goods when it knew or should have known it was not. The USPTO would not have registered the Zanella Marks for the claimed goods *but for* Opposer's misrepresentations. As such, Opposer has committed fraud, and under the controlling law each of the Zanella Registrations should be deemed void *ab initio*. Summary judgment cancelling Registration Nos. 1519894, 1527003, 1990695, 1992385 and 2453062 in their entirety is proper.

DATED this 15th day of January, 2008.

Respectfully submitted,
SEED IP Law Group PLLC



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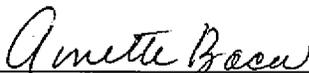
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CERTIFICATE OF SERVICE

I, Annette Baca, hereby certify that on this 15th day of January, 2008, the foregoing **APPLICANT'S MOTION FOR SUMMARY JUDGMENT CANCELLING OPPOSER'S REGISTRATIONS FOR FRAUD** was served upon Opposer's counsel by depositing same with the U.S. Postal Service, first-class postage prepaid, on January 15, 2008, addressed as follows:

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