

**THIS OPINION IS NOT  
CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

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

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Mailed: October 9, 2008

Opposition No. 91179897

Information Builders, Inc.

v.

Bristol Technologies, Inc.

**Before Walters, Drost and Wellington,  
Administrative Trademark Judges.**

**By the Board:**

This case now comes up for consideration of (1) opposer's combined motion for summary judgment and to amend the pleadings (filed April 3, 2008), (2) applicant's motion to amend the filing basis of its involved application (filed May 8, 2008), and (3) applicant's cross-motion for judgment on the pleadings (filed May 8, 2008). All the aforementioned motions are fully briefed.

As background, applicant seeks to register the mark BRISTOL FOCUS in standard character format for "computer operating programs; computers and instructional manuals sold

as a unit; operating system programs" <sup>1</sup> in International Class 9.

On October 5, 2007, opposer filed a notice of opposition to registration of applicant's BRISTOL FOCUS mark. As grounds for opposition, opposer alleges that applicant's mark, when used on the identified goods, so resembles opposer's previously used and registered FOCUS and FOCUS derivative marks for various computer goods and services, as to be likely to cause confusion, mistake or to deceive. Opposer has also asserted a claim of dilution as grounds for its opposition.

Applicant, in its answer, has denied the salient allegations of the notice of opposition as originally filed.

***Opposer's Motion to Amend Notice of Opposition***

We turn first to opposer's motion to amend the notice of opposition to add the claims of fraud and non-use of the mark in commerce at the time of the filing of the involved application.<sup>2</sup> Concurrently therewith, opposer has submitted an amended pleading. The amended allegations read:

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<sup>1</sup>Application Serial No. 78954755, filed on August 17, 2006, based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. Section 1051(a), claiming dates of first use and first use in commerce as of July 25, 2006.

<sup>2</sup>As noted above, opposer originally opposed registration of the involved application solely on the grounds of likelihood of confusion and dilution.

Paragraph 11

Upon information and belief, the opposed application is void ab initio because, although filed under Section 1(a), Applicant did not use the alleged trademark in commerce prior to the filing date of the application.

Paragraph 12

Upon information and belief, Applicant engaged in fraud in the U.S. Patent and Trademark Office by falsely claiming use of the mark in commerce in connection with the goods identified in its application.

In support of its motion, opposer argues that, as a result of applicant's responses to opposer's interrogatory requests, opposer has learned that applicant's involved mark was not in use in commerce at or prior to the date of the filing of the opposed application, and further that at the time of filing, and during the prosecution of the application, applicant falsely claimed that its mark was in use in commerce. Opposer further asserts that the facts concerning applicant's alleged non-use and fraud have only recently come to light in applicant's responses to opposer's second set of interrogatories and, therefore, opposer should be allowed to amend the notice of opposition to include the claims of fraud and non-use.

Applicant has not specifically opposed the merits of opposer's motion to amend the pleadings; rather, in response to opposer's motion, applicant seeks to amend the filing basis of its involved application from a use based application to an

intent to use basis in order to defeat the additional claims sought to be added by opposer.

Under 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, e.g., Polaris Industries v. DC Comics*, 59 USPQ2d 1789 (TTAB 2001); and *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701 (TTAB 2000).

Inasmuch as applicant has not opposed opposer's motion to amend on the merits and in view of the Board's liberal approach in allowing pleadings to be amended, opposer's motion for leave to amend the notice of opposition is **granted** and the amended notice of opposition (filed April 3, 2008) is now opposer's operative pleading in this case.

***Applicant's Motion to Amend Filing Basis and Opposer's Motion for Summary Judgment on its Claim of Non-Use.***

We next turn to applicant's motion to amend. Applicant seeks to amend the basis for registration of its involved application from Trademark Act Section 1(a) to Section 1(b), asserting a bona fide intent to use the mark in commerce.

In 1995, the Office changed its policy towards post-publication amendments to add or substitute a basis for registration to applications which are not the subject of a Board proceeding. *In re Monte Dei Maschi Di Siena*, 34

USPQ2d 1415 (Comm'r Pats. 1995) (applicant allowed, after publication, to add a Section 44(e) basis for registration). The new Office practice to allow such amendments was codified on October 30, 1999 in the Trademark Law Treaty Implementation Act (TLTIA), which revised Trademark Rule 2.35.<sup>3</sup> *Grand Canyon West Ranch, LLC v. Hualapai Tribe*, 78 USPQ2d 1696, 1698 (TTAB 2006). In 2002, the Board extended the rationale behind the TLTIA amendment to permit post-publication amendments to the filing basis of an application involved in an inter partes proceeding under Trademark Rule 2.133(a). *Leeds Technologies Ltd. v. Topaz Communications Ltd.*, 65 USPQ2d 1303 (TTAB 2002) ("In light of *In re Monte* and the change in Office Practice allowing post-publication amendments to add or substitute a basis, followed by reexamination, when necessary, and republication, the Board's previous decisions regarding such amendments no longer appear to be good law ... [P]ost-publication amendments to the basis for an application, pursuant to Trademark Rules 2.35 and 2.133(a), are now allowed.").

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<sup>3</sup>Trademark Rule 2.35(b) states, in part:

(2) After publication, an applicant may add or substitute a basis in an application that is not the subject of an inter partes proceeding before the Trademark Trial and Appeal Board, but only with the express permission of the Director, after consideration on petition. Republication will be required. The amendment of an application that is the subject of an inter partes proceeding before the Board is governed by § 2.133(a).

When an applicant substitutes one basis for another, the Office will presume that there was a continuing valid basis, unless there is contradictory evidence in the record, and the application will retain the original filing date. See Trademark Rule 2.35(c); *Sinclair Oil Corporation v. Kendrick*, 85 USPQ2d 1032, 1033 (TTAB 2007). In an application under Section 1(b), an applicant must verify that it has a bona fide intent to use the mark in commerce on or in connection with the goods or services listed therein. If the verification is not filed with the initial application, the verified statement must allege that the applicant had a bona fide intention to use the mark in commerce as of the filing date of the application. See Trademark Rule 2.34(a)(2)(i).

In opposition to applicant's motion, opposer argues that the sole purpose of applicant's proposed amendment is to cure its blatant fraud in alleging use in the initial application and in its subsequent response to the examining attorney's office action. In this regard we note that amending the filing basis of the opposed application to Section 1(b) does not protect the application from the fraud claim. *Sinclair Oil Corporation, supra*, 85 USPQ2d at 1033; *Grand Canyon West Ranch, LLC, supra*, 78 USPQ2d at 1698.

Notwithstanding the foregoing, we find that the proposed amendment does meet all the requirements of a

Section 1(b) filing basis except for the submission of a verified statement alleging that applicant had a bona fide intention to use the mark in commerce as of the filing date of the application. See Trademark Act Section 1(b)(3), 15 U.S.C. Section 1051(b)(3). Moreover, inasmuch as there is no evidence of record that applicant did not have a continuing valid filing basis, applicant can maintain its original filing date, i.e., August 17, 2006. See Trademark Rule 2.35(c). In view thereof, applicant's motion to amend the filing basis of its involved application is **granted** to the extent that applicant is allowed **twenty days** from the mailing date of this order in which to file and serve a verification which states that applicant had a bona fide intent to use its mark as of the filing date of its application.

Accordingly, the Board defers consideration of opposer's motion for summary judgment on its claim of non-use pending applicant's submission of its verification, as ordered herein. If applicant files a verification acceptable to the Board, opposer's claim of non-use in commerce in its pleading and its motion for summary judgment in connection with that claim will be deemed moot and neither will be given any further consideration. However, if applicant fails to file a proper verification or fails to file a verification altogether, opposer's claim of non-use

remains valid and the Board will consider opposer's motion for summary judgment concerning this claim.

***Opposer's Motion for Summary Judgment on its Asserted Claim of Fraud***

Opposer has filed a motion for summary judgment on its newly asserted claim of fraud. In support of its motion, opposer argues that the involved application, as originally filed, was supported by a specimen of use in the nature of a classified advertisement in a newspaper giving notice that applicant intends to use the involved mark BRISTOL FOCUS. Opposer further contends that, despite this clear wording in the advertisement of an intention to use, applicant nevertheless filed its application based on actual use in commerce under Section 1(a) of the Trademark Act, claiming a date of first use the date the advertisement ran, i.e., July 25, 2006.

Opposer further notes that, in an office action dated January 12, 2007, the examining attorney found that the specimen submitted with applicant's original application was not acceptable as evidence of use, and suggested the possibility of amending the filing basis of the application to intent to use. Opposer asserts that, rather than amending its filing basis, applicant, in its July 15, 2007 response to the examining attorney's office action, submitted a substitute specimen which it indicated consisted

of "a computer system with the mark appearing on the video display," and claiming that the substitute specimen was in use in commerce as of the filing date of applicant's application. Opposer states, however, that, in response to opposer's interrogatory requests, applicant stated that no computer system bearing applicant's BRISTOL FOCUS mark had been shipped at the time of applicant's discovery response nor had its computer operating program been completed.

In view of applicant's discovery responses, opposer contends that applicant's statements concerning its use of its mark in commerce as of the filing date of the application in its originally filed application and in its response to the examining attorney's office action were fraudulent.

In support of its motion for summary judgment, opposer has submitted (1) a copy of applicant's originally filed application including a copy of the original specimen in support thereof, (2) a copy of the examining attorney's January 12, 2007 office action, (3) a copy of applicant's July 17, 2007 response to the examining attorney's January 12, 2007 office action which includes a copy of applicant's substitute specimen, and (4) a copy of applicant's responses to opposer's second set of interrogatory requests.

In response to opposer's motion, applicant contends that it only recently became aware that the date of

commercial use of the substitute specimen it submitted in support of its use-based application was not as early as the filing date of the application. Moreover, applicant argues that, if its request to amend its filing basis from use in commerce to intent to use is accepted by the Board, opposer's claim of fraud would be moot.

In reply, opposer asserts that, "having its hand caught in the cookie jar" by opposer's filing of its motion for summary judgment, applicant is now attempting to finesse its fraud by belatedly amending the application from use based to an intent to use basis. Opposer additionally contends that applicant's motion to amend can be interpreted as an admission of applicant's fraud.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548 (1986). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed

facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

Fraud in procuring a trademark registration occurs when an applicant for registration makes material misrepresentations of fact concerning use of the mark, which it knew or should have known to be false or misleading, and acts in a "reckless disregard for the truth." *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986). See also *Herbaceuticals Inc. v. Xel Herbaceuticals Inc.*, 86 USPQ2d 1572, 1576 (TTAB 2008); and *Maid to Order of Ohio Inc. v. Maid-to-Order Inc.*, 78 USPQ2d 1899, 1905 (TTAB 2006). A party making a fraud claim is under a heavy burden of proof because fraud must be proved by clear and convincing evidence, leaving nothing to speculation, conjecture, or surmise. Any doubt must be resolved against the party making the claim. *Sinclair Oil Corporation v. Kendrick*, supra at 1035.

Here, applicant argues that it only recently became aware that its substitute specimen was not in use as of the filing date of its application.

In view thereof and based on the record before us, we find that that opposer has failed to sustain its burden of proof on summary judgment. Applicant's responses to

opposer's discovery requests and the ex parte prosecution history of applicant's application by themselves fail to establish the absence of a genuine issue of material fact regarding applicant's intent to deceive the USPTO. As often stated by the Board, factual questions involving fraudulent intent are particularly unsuited to disposition on summary judgment. *Copelands' Enterprises, Inc. v. CNV, Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1299 (Fed. Cir. 1991). There remain genuine issues of material fact at least as to whether applicant's statement of use as of the filing date, made at the time of its submission of its substitute specimen, was false and, if so, whether it was made with a reasonable and honest belief that it was true. *Knorr-Nahrmital Aktiengesellschaft v. Havland Int'l., Inc.*, 206 USPQ 827, 834 (TTAB 1980) ("The claim of fraud will not be sustained if it can be proven that the statement, though false, was made with a reasonable and honest belief that it was true."). *See also Maids to Order of Ohio Inc. v. Maid-to-Order Inc.*, *supra* at 1907 ("While these activities are not, in any way, conclusive on the question of whether MTO has in fact used the mark MAID TO ORDER in interstate commerce, they do serve to establish that Ms. Kern had a good faith belief that MTO had used/was using the mark MAID TO ORDER in interstate commerce at the time of filing the application."). *Compare Herbaceuticals Inc. v. Xel*

*Herbaceuticals Inc.*, supra at 1577 (fraud found where applicant admitted that it was not using in commerce all of the goods listed in the statement of use); *Sinclair Oil Corporation v. Kendrick*, at 1036 (fraud found where applicant's discovery responses state that the mark has never been used in commerce); *Hurley International LLC v. Volta*, 82 USPQ2d 1339, 1344 (TTAB 2007) (fraud found where applicant admitted that as of the filing date of their involved application, they were not using the mark in U.S. commerce).

Hence, opposer's motion for summary judgment on the claim of fraud is **denied**.<sup>4</sup>

***Applicant's Motion for Judgment on the Pleadings***

We now turn to applicant's motion for judgment on the pleadings. We note that applicant seeks judgment solely on opposer's asserted claim of dilution.

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<sup>4</sup>The parties should note that the evidence submitted in connection with a motion for summary judgment or opposition thereto is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); and *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983). Additionally, the issues for trial are not necessarily limited to those identified by the Board in explaining the denial of opposer's motion for summary judgment.

In support of its motion, applicant contends that opposer cannot prevail on its dilution claim inasmuch as the examining attorney, who prosecuted applicant's involved application, found no similar marks that would bar registration of applicant's mark. Moreover, applicant argues that opposer has not shown any evidence of damages that would be sustained in the event applicant's involved mark was registered. Further, applicant argues that opposer has refused to respond to applicant's discovery requests, on confidentially grounds, concerning the extent of consumer awareness of opposer's pleaded marks. Applicant therefore concludes that there is no factual information to support opposer's claim of dilution inasmuch as there is no evidence demonstrating how broadly known opposer's pleaded marks are in the industries serviced by opposer.

In response, opposer argues that applicant's reliance on the examining attorney's finding during the examination process that no similar marks exist on the register which would bar registration of applicant's mark is inappropriate and does not constitute a ground for a motion for judgment on the pleadings.

A motion for judgment on the pleadings provides a means of disposition of cases when the material facts are not in dispute and judgment on the merits can be achieved by focusing on the pleadings. See Fed. R. Civ. P. 12(c). Such

a motion is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice. For purposes of the motion, all well pleaded factual allegations of the non-moving party must be accepted as true, while those allegations of the moving party which have been denied (or which are taken as denied, pursuant to Fed. R. Civ. P. 8(b)(6), because no responsive pleading thereto is required or permitted) are deemed false. Conclusions of law are not taken as admitted. *Baroid Drilling Fluids Inc. v. SunDrilling Products*, 24 USPQ2d 1048 (TTAB 1992); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024 (TTAB 1983); and Wright & Miller, *Federal Practice and Procedure: Civil 2d* § 1367 et seq. (1990).

All reasonable inferences from the pleadings are drawn in favor of the nonmoving party. *Baroid Drilling Fluids, Inc.*, *supra*, 24 USPQ2d at 1049. A party may not obtain judgment on the pleadings if the nonmoving party's pleading, the allegations of which are accepted as true, raises issues of fact that, if proved, would establish that the nonmoving party is entitled to judgment. *Id.*; *see also* Wright & Miller, *supra*, §1368 at 525-26.

As a threshold matter, we note that applicant has submitted evidence outside of the pleadings in support of

its motion. We have not converted applicant's motion into a motion for summary judgment, and therefore we have based our decision solely on the pleadings themselves and the briefs on that portion of the motion without regard to the attached evidence. See Fed. R. Civ. P. 12(c); see also *Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478, 1479 n.2 (TTAB 1998) (matters outside the pleading excluded) and *DAK Industries Inc. v. Daiichi Kiosho Co.*, 35 USPQ2d 1434, 1436 (TTAB 1995) (exhibits excluded).

In its originally-filed notice of opposition, as well as in its amended pleading, opposer has alleged that its pleaded marks are famous, that such fame was acquired prior to the filing date of applicant's involved application, and that the registration of applicant's mark will dilute the distinctive quality of opposer's alleged famous marks. See ¶ 10 of opposer's originally-filed and amended notice of opposition. For purposes of applicant's motion, we must construe opposer's allegations as true.

The Board finds that opposer's allegations sufficiently set forth its standing in this case, as well as its claim for dilution. Applicant has denied the salient allegations in opposer's notice of opposition including those which pertain to opposer's claim of dilution. Thus, applicant's denial of these allegations, whether expressly or

effectively, raise issues of fact material to opposer's dilution claim.

Accordingly, applicant's motion for judgment on the pleadings as to opposer's dilution claim is denied.<sup>5</sup>

To summarize, opposer's motion to amend the pleadings is granted; opposer's motion of summary judgment on its asserted claim of fraud is denied; applicant's motion for judgment on the pleadings is denied; applicant's motion to amend the filing basis of its involved application from use in commerce to intent to use is granted to the extent that applicant is allowed twenty days from the mailing date of this order in which to submit a verification stating that applicant had a bona fide intention to use the mark in commerce as of the filing date of the application and opposer's motion for summary judgment on its claim of non-use is deferred pending applicant's response to the instant order.

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<sup>5</sup>Even if the Board were to consider the evidence submitted outside the pleadings and construe applicant's motion as one for summary judgment, applicant's motion would nevertheless be denied inasmuch as applicant, based on the record before us, has failed to carry its initial burden of establishing that no genuine issues of material fact exist with respect to the factual elements of opposer's claim of dilution and that it is therefore entitled to judgment as a matter of law. Indeed, based on the record before us, at a minimum, a genuine issue of material fact exists as to the fame of opposer's pleaded marks in the marketplace.

Proceedings herein are resumed. Applicant is allowed **twenty days** from the mailing date of this order in which to file an answer to opposer's amended notice of opposition.

Discovery and trial dates are reset as follows:

DISCOVERY PERIOD TO CLOSE: **12/22/2008**

Testimony period for party in position of plaintiff to close: (opening thirty days prior thereto) **3/22/2009**

Testimony period for party in position of defendant to close: (opening thirty days prior thereto) **5/21/2009**

Rebuttal testimony period to close: (opening fifteen days prior thereto) **7/5/2009**

**NEWS FROM THE TTAB:**

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>  
[http://www.uspto.gov/web/offices/com/sol/notices/72fr42242\\_FinalRuleChart.pdf](http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf)

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any

protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:  
<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>