

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
May 3, 2011

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Daniel Ryan Way and CMDW, Inc.

v.

Anthony R. Falwell

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Opposition No. 91184128  
to application Serial No. 76525574  
filed on June 26, 2003

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Willmore F. Holbrow and Daniel J. Russell of Blakely,  
Sokoloff, Taylor & Zafman for Daniel Ryan Way and CMDW, Inc.

Anthony R. Falwell, pro se.

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Before Seeherman, Holtzman and Mermelstein, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Daniel Ryan Way, an individual, and CMDW, Inc., a  
corporation, have filed an opposition to the registration by  
Anthony R. Falwell of the mark PLAN B JEANS, in typed  
drawing form, with a disclaimer of JEANS, for goods  
identified as "men['s], women['s], boys['], and girls[']  
clothing, namely, jeans, pants, shorts, jackets, t-shirts,  
shirts, and shoes; women's and girls' clothing, namely,

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skirts and dresses."<sup>1</sup> The application was filed on June 26, 2003, based on an asserted intent-to-use the mark in commerce. On September 29, 2003 applicant filed an amendment to allege use, claiming dates of first use and first use in commerce on September 1, 2003.

The ground for the opposition is fraud. Specifically, opposers have alleged that opposer Daniel Ryan Way is a majority shareholder in opposer CMDW, Inc.; that CMDW owns application Serial No. 78572707 for the mark PLAN B SKATEBOARDS, and that examination of this application has been suspended pending the disposition of applicant's application because, if applicant's mark is registered, it may be cited against CMDW's application; that, upon information and belief, applicant does not provide and did not provide on the date claimed in the amendment to allege use, shoes, men's shorts or boys' shorts, and that the mark was not in use for all of the goods as claimed by applicant in the amendment to allege use; that upon information and belief applicant knew or should have known that the statements that the mark was in use in interstate commerce for all of the goods identified in the application were

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<sup>1</sup> Application Serial No. 76525574. At the time the application was filed, the Trademark Rules provided for the filing of a "typed" drawing. Applicant filed the application pro se. During the course of prosecution he retained an attorney, who filed a response to the first Office action, through which the mark was amended from "PLAN B jeans and sportswear" to PLAN B JEANS.

false or misleading; that upon information and belief applicant's statement that the mark was in use in commerce for all the goods identified in the application constituted a knowingly false representation of material fact; that upon information and belief, but for the false statement in the amendment to allege use, the USPTO would not have approved the amendment to allege use; and that due to applicant's filing of an amendment to allege use for goods that he knew or should have known were not in use in commerce, applicant committed fraud on the USPTO.<sup>2</sup>

Although represented by counsel at the time, on June 4, 2008, applicant himself filed an answer in which he stated, inter alia:

¶ 7. As shoes are listed in my Application, and I have every intention to use shoes as permitted in International Class 25. This was in no way an attempted [sic] to mislead the United States Patent and Trademark Office. As I have not yet used shoes in commerce, to satisfy the USTPO [sic] and the Examining Attorneys, I will remove any goods listed on my Application if USPTO deems it necessary.

¶ 8. As boys shorts are listed in my Application, and I have every intention to use boys shorts as permitted in International Class 25. This was in no way an attempted [sic] to mislead the United States Patent and Trademark Office.

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<sup>2</sup> In 2009, the Court of Appeals for the Federal Circuit, in *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009), clarified the law relating to fraud on the Patent and Trademark Office, stating that the "should have known" standard was inappropriate for purposes of determining intent to deceive. However, at the time the notice of opposition was filed, opposers' pleading followed the Board's interpretation of the law. See *Medinol v. Neuro Vasx, Inc.*, 67 USPQ2d 1205 (TTAB 2003).

¶ 10. The use of all but a few items listed in my Application for the mark PLAN B JEANS AND SPORTSWEAR was in no way an attempted [sic] to mislead the United States Patent and Trademark Office. As I worked to establish my mark [in] the Apparel Industry, I have been successful in establishing all but a few [sic] the many items I will use in International Class 25.

¶ 11. The goods identified in my mark are listed as permitted in International Class 25, the few not yet used, was in no way an attempted [sic] to mislead the United States Patent and Trademark Office.

¶ 14. Using [a]ll, but a few, of the apparel items listed in my mark PLAN B JEANS AND SPORTSWEAR, Serial No. 76/525,574, [w]as [n]ot an attempt to commit fraud on the Unite[d] States [sic] and Trademark Office or the Examining Attorneys. I would like to do what ever the USPTO would suggest to satisfy any use of goods listed in my amendment to use, not yet in use including removing the few items in question from my application.

On June 5, 2008, the Board noted the answer, as well as the fact that applicant had failed to include proof of service on opposers, and to expedite matters included a copy of the answer with the Board order. Then on June 10, 2008, applicant filed another answer, this time prepared by his attorney. In that answer, applicant admitted that "Ryan Way and CMDW, Inc. is owner of" application Serial No. 78572707; that the examining attorney has suspended examination of that application and that if applicant's mark registers, it may be cited against opposers' application. Applicant otherwise denied all the salient allegations in the notice of opposition. On June 11, 2008, applicant revoked the

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power of attorney granted to his counsel, and his counsel filed a motion to withdraw, which was granted. Since that time applicant has represented himself in this proceeding.

On July 28, 2008, opposers filed a motion for judgment on the pleadings, noting the admissions made by applicant in the answer filed on June 4, 2008. Applicant opposed the motion, stating that the answer filed on June 10, 2008 was the proper answer, and that the answer filed on June 4 was incomplete. On October 14, 2008, the Board denied opposers' motion, characterizing the first filing as informal and deeming the second, formal answer filed on June 10, 2008 as the operative pleading.

We note, initially, that in the trial brief, although Daniel Ryan Way and CMDW, Inc. continue to be listed in the caption as the opposers, there is no mention in the brief of Daniel Ryan Way as an opposer. Instead, all references to opposer are to CMDW, e.g., "CMDW, Opposer, Seeks to Register its Mark," p. 2, and "CMDW Has Standing To Bring This Claim." p. 10. In fact, "opposer" is always used in the singular. It therefore appears that Daniel Ryan Way is no longer interested in pursuing the opposition, and we dismiss the opposition with respect to him. All further references in this opinion to "opposer" mean CMDW, Inc.<sup>3</sup>

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<sup>3</sup> We also point out that, even if Daniel Ryan Way intended to continue to oppose the application, he has not established his standing. Although the notice of opposition alleges that he is a

The Record

By operation of the rules, the pleadings and the file of the opposed application are part of the record. In this case, as noted, the June 4, 2008 answer filed by applicant was deemed to be informal, and the answer filed on June 10, 2008 was held to be the operative pleading. Therefore, the June 4, 2008 filing is not automatically part of the record. However, in its description of the record opposer lists this document as part of the pleadings, and applicant does so as well in the description of the record in his brief. Accordingly, we deem the June 4, 2008 filing to be stipulated into the record. Opposer has made of record, by notice of reliance, twelve pages from applicant's discovery deposition, including certain exhibits; the file of opposer's application Serial No. 78572707, identified in the notice of opposition; and what are styled as responses to certain of opposers' document production requests. Responses to document production requests may normally not be made of record by notice of reliance, see Trademark Rule 2.120((j)(3)(ii)). However, a party may submit under a notice of reliance responses to document production requests that are not documents themselves, but state that no such documents exist, and that is what opposer has done. It also

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majority shareholder in CMDW, Inc., he did not submit any evidence to prove this allegation.

appears that applicant has treated some of the document production requests as interrogatories. Since responses to interrogatories may be made of record by notice of reliance, those responses are also of record.

Applicant had attempted to submit under a notice of reliance various materials, and they were the subject of a motion to strike. On June 25, 2010, the Board ruled that only pages 3, 4, 12, 13 and 55-61 were admissible (pages 55-61 being the printout of papers from applicant's application file and the data regarding the application taken from the USPTO's TESS and TARR electronic databases, while the relevant portions of the other pages are opposer's objections to certain of applicant's request for production of documents).<sup>4</sup>

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<sup>4</sup> We note that the other material applicant attempted to make of record by notice of reliance consists of some of the filings and Board orders in connection with motions to compel in this proceeding, email correspondence between applicant and opposer's attorneys with respect to discovery issues, and pages 22-85 of the discovery deposition taken of applicant by opposer. Trademark Rule 2.120(j)(1) provides that the discovery deposition of a party may be made of record by an adverse party, not the party whose deposition has been taken. Thus, opposer had the right to submit all or a portion of applicant's discovery deposition, but applicant could not make virtually his entire discovery deposition of record by notice of reliance. Trademark Rule 2.120(j)(4) provides that if only part of a discovery deposition is made of record by a party, an adverse party may introduce any part of the deposition which in fairness should be considered so as to make not misleading what was offered by the submitting party. In such a situation, the adverse party must provide a written statement explaining why it needs to rely on each additional portion submitted by the adverse party. Applicant clearly did not comply with this rule, having not provided any explanation as to why additional portions of the deposition had to be considered to make the portions relied on by opposer not misleading. Further, the rule does not contemplate

Finally, we note that with his trial brief applicant has submitted various exhibits. One is merely an order that previously issued in this proceeding, but the other exhibits, which were not properly made of record, have not been considered. Nor have we considered the statements made by applicant in his brief that are not supported by evidence in the record; a brief cannot substitute for the proper submission of evidence during a party's testimony period.

Standing

Opposer has made of record the file of its application Serial No. 78572707 for PLAN B SKATEBOARDS showing that action on the application has been suspended pending the disposition of applicant's instant application, and advising opposer that if applicant's mark is registered, the registration may be cited against opposer's application. Thus, opposer has shown that it has a personal stake in this proceeding, and has established its standing.

Fraud

"Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application."

Torres v. Cantine Torresella S.r.l., 808 F.2d 46, 48, 1

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an adverse party submitting the entirety of a discovery deposition, but only that portion or portions that make not misleading the portion submitted by the party taking the deposition.



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USPQ2d 1483 (Fed. Cir. 1986). "[T]he very nature of the charge of fraud requires that it be proven 'to the hilt' with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party." *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981).

It is opposer's position that applicant made knowingly false statements in the amendment to allege use that he filed on September 26, 2003. The amendment to allege use, which applicant signed, indicates (through the language appearing in the form) that applicant is using or using through a related company the mark in commerce on or in connection with all goods and/or services listed in the application or notice of allowance. Opposer contends that at the time applicant signed the amendment to allege use he was not using the mark PLAN B JEANS AND SPORTSWEAR on all the goods in commerce.

Opposer also asserts that applicant made false statements in his February 3, 2004 response to an office action in his declaration to support substitute specimens, in which he stated that "the substitute specimen submitted herewith was in use in commerce in association with the goods at least as early as the filing date of this application." Opposer claims that when applicant signed this declaration he knew that he had not used the mark on

all the goods listed in the identification of goods, an identification that he had amended in that same response.

Opposer bases its position that applicant made false statements in these two documents on the statements made in the informal answer applicant filed on June 4, 2008, and specifically the paragraphs quoted earlier in this opinion. However, in denying opposer's motion for judgment on the pleadings on the basis of this answer, the Board specifically rejected that filing as constituting applicant's answer. Because it is not, in fact, an operative pleading, we cannot treat the statements made in the document as admissions in an answer. See *Jet, Inc. v. Sewage Aeration Sys.*, 223 F.3d 1360, 55 USPQ2d 1854, 1858 (Fed. Cir. 2000) (citing *Kelley v. Crosfield Catalysts*, 135 F.3d 1202, 1205 (7th Cir. 1998) ("It is hornbook law that an amended complaint complete in itself and making no reference to nor adopting any portion of a prior complaint renders the latter *functus officio.*")); and Charles Alan Wright et al., Federal Practice and Procedure Section 1476 (2d ed. 1990) ("A pleading that has been amended under Rule 15(a) [of the Federal Rules of Civil Procedure] supersedes the pleading it modifies. ... Once an amended pleading is interposed, the original pleading no longer performs any function in the case."). In this connection, we note that the second, operative answer was filed just six days after the initial

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filing, and opposer was aware, as of October 14, 2008, when the Board denied opposer's motion for judgment on the pleadings, that the June 10, 2008 answer was the operative pleading. Thus, there is no question of prejudice to opposer by not allowing it to rely on applicant's "admissions" in the informal answer; it knew very early in the proceeding, almost six months before the close of discovery and at a point where it had ample time to take discovery, that it could not rely on applicant's statements in the June 4, 2008 filing to prove its case. On the other hand, there would be substantial prejudice to applicant if we were now to treat the statements made in the June 4, 2008 filing as admissions. The Board's October 14, 2010 order denying opposer's motion for judgment on the pleadings in effect advised applicant that the Board would not treat the statements in the June 4, 2008 filing as admissions; as a result, applicant might have believed that he had no need to testify or otherwise provide evidence about his use of his mark on his goods or testify about what he meant by the statements in his informal answer.

We should point out that even if we considered the statements made by applicant in the June 4, 2008 answer, they are not sufficient to prove with the necessary clear and convincing evidence that applicant committed fraud. As the Court stated in *In re Bose*, 91 USPQ2d at 1940, quoting

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Kemin Indus., Inc. v. Watkins Prods., Inc., 192 USPQ 327, 329 (TTAB 1976), "there is "a material legal distinction between a 'false' representation and a 'fraudulent' one, the latter involving an intent to deceive, whereas the former may be occasioned by a misunderstanding, an inadvertence, a mere negligent omission, or the like." Although the statements in the June 4 filing can be read as indicating that applicant did not use the mark on all of the goods identified in the application, these statements are not sufficient to prove a necessary element of fraud, namely, intent. On the contrary, the statements are replete with applicant's assertions that there was no attempt to mislead the USPTO.

We acknowledge opposer's point that it would be hard to elicit direct evidence of intent, e.g., testimony that the applicant intended to deceive the USPTO, or papers containing such a statement. However, more than the statements made by applicant would be necessary to us to infer an intent to deceive. There is a difference between the ground of nonuse and the ground of fraud; intent is a critical element of the latter but is not required to prove the former. Opposer brought this opposition on the ground of fraud, not on the ground of nonuse, and therefore it was required to prove this element.

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The only other evidence submitted by opposer in support of its claim of fraud are portions of applicant's discovery deposition and applicant's responses that he has no documents supporting his date of first use, and no documents with respect to any marketing and advertising plans. As for the discovery deposition testimony relied on by opposer, it shows only that between 2006 and the date of applicant's deposition in August 2009 applicant had ceased manufacturing, on a production scale, any products, although applicant also testified that this was temporary. Nor have there been any sales since the early part of 2006, and applicant's website was taken down in approximately April 2009.

None of this testimony or evidence shows that applicant made any false statements in his application papers, let alone demonstrates that his statements were made with an intent to deceive the Patent and Trademark Office. The amendment to allege use filed by applicant asserted use in 2003, and the declaration to support substitute specimens was filed in 2004; the fact that applicant has not manufactured or sold any goods under the mark since 2006 does not show that his statements about use of the mark in 2003 and 2004 were false. Certainly the evidence submitted by opposer is not sufficient to prove intent, a critical factor in proving fraud.

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Accordingly, we find that opposer has failed to prove, by clear and convincing evidence, that applicant committed fraud.

Decision: The opposition is dismissed. However, some of the statements made by applicant in his various papers raise questions as to whether applicant had used his mark on all of the goods identified in his application at the time he filed his amendment to allege use. Accordingly, the application is hereby remanded to the examining attorney, pursuant to Trademark Rule 2.131, to consider whether a refusal should be made on the basis that the mark had not been used on all of the identified goods when the amendment to allege use was filed, or whether certain of the goods should be deleted from the identification, or whether the basis for the application should be changed to intent-to-use. If the examining attorney determines that no refusal should issue, he should forward the application to registration; if a refusal issues and is ultimately made final, applicant may file an appeal of such refusal, or abandon the application.