



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

INTELLECTUAL RESERVE, INC.	)
Plaintiff	)
v.	)
SHEETS, KENDAL M.	)
Defendant	)

Cancellation No. 91191016

17/337, 328

**APPLICANT'S RESPONSE TO  
OPPOSER'S 12(B)(6) MOTION TO DISMISS APPLICANT'S  
AMENDED COUNTERCLAIMS**

Applicant, Kendal Sheets, submitted an Amended Answer and Counterclaim based on the Board's June 29, 2010 decision regarding consideration of Opposer's motion to dismiss applicant's counterclaim for failure to state a claim upon which relief may be granted. Based on the directions provided by Board and applicable procedural and caselaw, Applicant believes that he has, in all but one instance as an oversight, met the procedural guidelines laid out by the Board and has met the burdens for proper factual pleading of his counterclaims. Applicant requests leave to amend his counterclaims to correct the instance of pleading descriptiveness in paragraph 15 of the mark MORMON TABERNACLE CHOIR, Reg. No. 2766231, which is exempt from counterclaims of descriptiveness. This paragraph carried over from the Answer as an oversight and should have been removed. Further, in any instance the Board finds Applicant's pleadings insufficient, Applicant requests leave to amend and correct his pleadings so that the parties can move on to the substantive issues of the case.

As explain further herein, Applicant has alleged sufficient facts in the respective counterclaims to meet his burden under *Fed. R. Civ. P. 8(f)* for genericness and merely descriptive allegations and the higher burden under *Fed. R. Civ. P. (9)b* for fraud allegations. In a recent decision, *Meckatzer Lowenbrau Benedikt Weiss KG v. White Gold, LLC, 2010 TTAB LEXIS 132, \*5 (TTAB 2010)*, the Board set forth the following standard governing motions to dismiss under *Fed. R. Civ. P. 12(b)(6)*:

In order to withstand a motion to dismiss for failure to state a claim, a plaintiff need only allege such facts as would, if proved, establish that (1) the plaintiff has standing to maintain the proceedings, and (2) a valid ground exists for opposing the mark. The pleading must be examined in its entirety, construing the allegations therein liberally, as required by *Fed. R. Civ. P. 8(f)*, to determine whether it contains any allegations which, if proved, would entitle plaintiff to the relief, sought. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460 (TTAB 1992); and TBMP § 503.02 (2d. ed. rev. 2004). For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of plaintiff's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to plaintiff. See *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993); [\*6] see also 5A Wright & Miller, Federal Practice And Procedure: Civil 2d § 1357 (1990). ... The purpose of a *Rule 12(b)(6)* motion is to challenge "the legal theory of the complaint, not the sufficiency of any evidence that might be adduced" and "to eliminate actions that are fatally flawed in their legal premises and destined to fail ..." *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, *supra* at 26 USPQ2d 1041.

In *Hana Financial, Inc. v. Hana Bank* 500 F.Supp.2d 1228 (C.D. Cal.

2007), the Court stated:

In considering a motion under *12(b)(6)*, a court generally may not consider any material beyond the pleadings. *Cervantes v. City of San Diego*, 5 F.3d 1273, 1274 (9th Cir. 1993); *Lee v. City of Los Angeles*, 250 F.3d 668, 688 (9th Cir. 2001) (citing *Branch v. Tunnell*, 14 F.3d 449, 453 (9th Cir. 1994), *overruled on other grounds*, *Galbraith v. County of Santa Clara*, 307 F.3d 1119 (9th Cir. 2002)). However, "documents whose

contents are alleged in a complaint and whose authenticity no party questions, but which are not physically attached to the pleading, may be considered." *Branch*, 14 F.3d at 454.

A motion to dismiss a counterclaim brought pursuant to *Federal Rule of Civil Procedure 12(b)(6)* is evaluated under the same standard as a motion to dismiss the plaintiff's complaint. See *CTF Development, v. Penta Hospitality, LLC*, 2009 U.S. Dist. Lexis 99538, \*5-6 (N.D. Cal. 2009). *Rule 12(b)(6)* tests the legal sufficiency of the claims asserted and "must be read in conjunction with *Rule 8*, which requires a short and plain statement showing that the pleader is entitled to relief and contains a powerful presumption against rejecting pleadings for failure to state a claim." *Ileto v. Glock, Inc.*, 349 F.3d 1191, 1200 (9th Cir. 2003) (quotation marks omitted). These settled principles are qualified by the new, more stringent pleading standard articulated by the Supreme Court in *Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1949-50, 173 L. Ed. 2d 868 (2009).

A. GENERICNESS

Descriptiveness and genericness are not claims for fraud or mistake and are therefore outside the heightened pleading requirements in Fed. R. Civ. Pro. 9(b). *Aureflam Corp. v. Pho Hoa Phat I, Inc.*, 575 F.Supp. 2d 950, (N.D. Ca. 2005). Accordingly, these claims are governed by general rules of pleading that only require "a short and plain statement" of jurisdiction and the claim entitling the pleader to the relief requested. Fed. R. Civ. Pro. 8. Bare assertions bereft of

allegations of material fact to support them, however, cannot withstand a motion to dismiss for failure to state a claim. *Id*; see *Anderson v. Clow*, 89 F.3d 1399, 1403 (9th Cir. 1996).

The test for genericness was described by the Federal Circuit within *In re Dial-a-Mattress Operating Corp.* 240 F.3d 1341, 1344-1345 (Fed. Cir. 2001) as:

The determination of whether a mark is generic is made according to a two-part inquiry: "First, what is the genus of the goods or services at issue? Second, is the term sought to be registered . . . understood by the relevant public primarily to refer to that genus of goods or services?" *H. Marvin Ginn Corp. v. Int'l Assoc. of Fire Chiefs*, 782 F.2d 987, 990 (Fed. Cir. 1986). Placement of a term on the fanciful-suggestive-descriptive-generic continuum is a question of fact. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d at 1569-70, 4 U.S.P.Q.2D (BNA) at 1142-43. . . . Any competent source suffices to show the relevant purchasing public's understanding of a contested term, including purchaser testimony, consumer surveys, dictionary definitions, trade journals, newspapers and other publications. *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d at 1570, 4 U.S.P.Q.2D (BNA) at 1143; *In re Bed & Breakfast Registry*, 791 F.2d 157, 160, 229 U.S.P.Q. (BNA) 818, 819 (Fed. Cir. 1986).

The correct legal test for genericness requires evidence of "the genus of goods or services at issue" and the understanding by the general public that the mark refers primarily to "that genus of goods and services." Where the proposed mark is a phrase the board "cannot simply cite definitions and generic uses of the constituent terms of a mark"; it must conduct an inquiry into "the meaning of the disputed phrase as a whole." *In re The Am. Fertility Soc'y*, 188 F.3d at 1347). A corollary verbal formulation of the meaning underlying the word "generic" is the phrase "the common descriptive name" as a designation for a product. Neither designation affords trademark protection. Thus is true even though the name acquires secondary meaning by becoming identified with a particular producer. *G. Heileman Brewing Co., Inc., v. Anheuser-*

*Busch Inc. 676 F.Supp. 1436, 1466-1467 (E.D. WI. 1987); see Kellogg Co. v. Nat'l Biscuit Co., 305 U.S. 111, 118, 83 L. Ed. 73, 59 S. Ct. 109 (1938).* No matter how much money and effort the user of a generic term has poured into promoting the sale of its merchandise and what success it has achieved in securing public identification, it cannot deprive competing manufacturers of the product of the right to call an article by its name. *See Abercrombie & Fitch Co. v. Hunting World, Inc. 537 F.2d 4, 9 (2d Cir. 1976).*

Except for general allegations of lack of pleaded facts and one reference to audio recordings for the mark MORMON TABLERNACLE CHOIR, Opposer does not explain *why* Applicant's allegations of genericness lack particularity. As the Board knows, factual allegations for genericness do not need to rise to the level of Fed. R. Civ. P. 9(f) pleadings. Both the facts and references in the pleadings support Applicant's assertions that the pleadings meet the legal requirements. References to the registrations that include Opposer's own prosecution history are also included in the pleadings. As listed below, the amended counterclaims state factual reasons for why Opposer's marks are generic, as a whole, as applied to their goods and services. Applicant has never alleged that any of Opposer's "MORMON" marks are collective membership marks. However, the marks were filed by, and are currently owned by, a religious organization that refers to itself and its followers as "Mormons" and claims to be part the "Mormon" religion.

1. Reg. No. 3239919 for MORMON

Applicant properly pled, and submitted evidence in the form of dictionary definitions and

newspaper articles (which Opposer still objects to), that the mark “Mormon” is a generic term for over a century meaning a type of a religion having numerous sects and organizations and is generic for followers of Joseph Smith. As this term is applied to goods and services in class 41, Applicant pled that the term is generic in referring to Opposer’s goods and services of *historical* and *religious* educational services and in class 42 for genealogy services. Owners of the mark, which is a Mormon religious organization called The Church of Jesus Christ of Latter-Day Saints who refer to themselves “Mormons,” use the mark to teach religion and history and perform genealogy services under the description “Mormon” are clearly material facts that have been pled related to genericness of the trademark.

Applicant has pled that it is the genus of the mark, which is a name for a religious organization that derives from the fact that one of the *Mormon* organizations is performing the Mormon religious, historical and genealogical services. Opposer has argued in prosecution of its marks, that the Church of Jesus Christ of Latter-day Saints and “the Mormon Church” mean the same thing. This is a misleading argument, without any basis in fact, and one which Opposer has made to the Examining Attorneys and now is making with the Board. Opposer attempted to side-step the issue by alleging lack of a membership mark:

...Sheets reiterates the arguments...that the term “Mormon” is a generic name for followers of Joseph Smith...None of the MORMON marks are registered as membership marks for followers of Joseph Smith. Thus, Sheets’s allegations that the term Mormon denotes “followers” fails to state a claim for genericness upon which relief may be granted. (See Opp. Memo. in Support of 12(b)(6), p. 3).

This is not the case, nor have membership mark allegations been raised. This, however, is a mark owned by a Mormon religious organization. “Mormon” religious and historical

educational services are being provided by and for *Mormons*.

Opposer's subjective beliefs are that it is the only church within its "Mormon" religion, and that this should somehow carry over into rights under trademark law. Applicant has counterclaimed otherwise, that this is a generic term of a religion and affords no trademark rights.

For example in the file history, in the Nov. 1, 2005 Office Action the Examining Attorney issued a genericness rejection for religious services in class 45:

"MORMON" is just such an indicator. It immediately informs the reader that the religious services provided will be in the style and of the belief system known as "MORMON" as well as the Church of Jesus Christ of Latter-day Saints.

Opposer responded that Mormon religion can only come from its own church:

"...the mark MORMON is particularly capable of indicating the source of services provided in association with the mark. The pending action, indicates that "the Mormon Church, also known as the 'Mormon Church of Jesus Christ of Latter-day Saints', and 'The Church of Jesus Christ of Latter-day Saints' is a church in the sense of "a specified Christian denomination." and that "the term MORMON is utilized only in association with services provided by the Applicant. The term MORMON is never utilized to describe or utilize religious services provided by another source."

(See Request to Divide Application and Response for International Class 45, pp. 5-6). This clearly incorrect, as Applicant's (pleaded) evidence of Webster's dictionary and other dictionaries and news clippings described *Mormon* as a one of any several denominations and sects. Examiner Alt, in her rejections for genericness and descriptiveness, produced similar evidence. Opposer has never proffered any other definition or meaning for this term. Opposer

has no monopoly on its religion and the name of its religious beliefs, and should not be using the trademark laws to try and impose one. Applicant therefore requests the Board to deny Opposer's motion.

2. Reg. No. 1527447 for MORMON HANDICRAFT and Reg. No. 1524555 for MORMON HANDICRAFT

Applicant's counterclaims for "MORMON HANDICRAFT" marks assert genericness as to the respective goods and services of retail mail order catalog and ordering services selling handicrafts in class 43 and the handicrafts themselves in class 24. MORMON HANDICRAFT as a whole is generic because the impression of the mark is that the source of handicrafts is "Mormon." Both terms of the mark are generic and have no other meaning than the definitions of the terms that are submitted that MORMON" is generic for religion and its members, and "HANDICRAFT" is generic for a type of craft, according to the plain meaning of the term. In his April 22, 1987 Office Action, Examining Attorney Sidoti rejected the application for the mark in class 24 as being merely descriptive as being "handmade articles by Mormons and/or in keeping with traditional Mormon culture" and cited Webster's dictionary that "handicraft" means "articles fashioned by those engaged in [an occupation requiring skill with the hands]" in his March, 1987 Office Action. He also cited Webster's Third Dictionary that "Mormon" is defined as "of or relating to the Mormons." Opposer only overcame the rejection with a declaration of acquired distinctiveness.

The only goods listed for manufacture and sale are "handicrafts" branded as "Mormon" and services selling the same. No other definitions or alternative meanings were alleged or

applied-for by Opposer (which includes its predecessor-in-interest, the Corporation of the President of the Church of Jesus Christ of Latter-day Saints) or has been alleged here. Applicant pleaded that the mark as a whole rises beyond being descriptive, and is generic for a class of handmade articles that are made and sold by Mormons. Applicant therefore requests the Board to deny Opposer's motion.

3. Reg. No. 2913694 for MORMON TABERNACLE CHOIR and Reg. No. 2766231 for MORMON TABERNACLE CHOIR (and Design)

Applicant counterclaimed that both of MORMON TABERNACLE CHOIR '694 registration and the word portion of the '231 registration are generic for their goods and services in classes 9 and 41. These marks can be discussed together because Opposer asserted their similarity: "As will be noted, the enclosed U.S. Registration 2,766,231 is directed towards substantially similar goods and services as the present application [the application for Reg. 2,913,694]. (See Amendment, App. Ser. No. 76/505,493 (Dec. 2, 2003)).

Evidence of the meaning of "MORMON" has been submitted with Applicant's pleadings as a generic reference to mean a religion or followers of Joseph Smith. "TABERNACLE" is simply generic as to the plain meaning of the term. "CHOIR" is also generic as to the plain meaning of the term. The mark as a whole provides no other elevated definition in the sum of its parts or meaning other than the definitions of each individual term within the mark. Opposer never alleged any other definitions. Opposer registered the marks for "religious" themes in the various classes and stated that this is a singing group for the Church of Jesus Christ of Latter-day

Saints. However, Opposer did not register that name of its Latter-day Saints church in the mark, it used the term MORMOM, which is a generic term for a religion. The mark as a whole cannot be used to mean anything different than musical performers of a religious sect or group of followers. To identify the goods and services of “religious themes” Opposer chose to use the term “MORMON” in its registrations. Again, Opposer has no basis for its declarations that it is the only sect of the Mormon religion that are called “Mormons,” and Applicant has pleaded fact evidence showing that there are many “Mormon” sects.

Both Examining Attorneys used dictionary definitions, their knowledge that Mormon is a religious sect, and prior marks disclaiming “Tabernacle Choir” as basis for their rejections. One Examining Attorney only required “TABERNACLE CHOIR” to be disclaimed while the other required a disclaimer of the *entire* word portion of the design application including MORMON.

Both requirements were subsequently dropped without clear reasons for the reversals:

The Examining Attorney for reg. 2913694 stated:

The applicant’s mark, MORMON TABERNACLE CHOIR is merely descriptive of the goods and services because it described the religious sect of the group which performs the live performances and the group featured on musical recordings. The phrase “tabernacle choir” is descriptive as well and is routinely disclaimed to the same service. See attached third party registrations. (See Office Action (Feb. 12, 2002)).

The Examining Attorney for reg. 2766231 stated:

The applicant must disclaim the descriptive wording “MORMON TABERNACLE CHOIR” apart from the mark as shown. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a). The wording is merely descriptive of the subject matter of the goods and services about a group of singers of the Mormon church. Note the definitions below. (See Office Action, (Oct. 20, 2003))

Opposer overcame the Examining Attorneys’ rejections for descriptiveness by alleging

distinctiveness of the mark. It certainly possible that Opposer will not be able to substantiate its allegations. Applicant asserts that the mark as a whole is far beyond descriptive, it is a generic term for the religiously-themed performances and books and audio-visual recordings of those performances goods and services. Applicant therefore requests the Board to deny Opposer's motion.

4. Reg. No. 2883572 for BOOK OF MORMON

Other than sweeping allegations that the counterclaims contain vague statements and legal conclusions, Opposer fails to explain *why* the claims of genericness for this mark do not meet pleading requirements before the Board. The mark is registered for audio and video recordings with "religious content" and "religious books" among other goods in classes 9 and 16. Applicant pleaded that the mark as whole is generic for these goods. MORMON, as Applicant pleaded, is a generic reference for a religion or religious followers of Joseph Smith. The two other terms in the mark have a plain meaning as a "book." Opposer's own goods and services show that the mark is used for a book about religion and religious audio recordings, which are generic uses. Since "BOOK OF" modifies the term "MORMON", and "MORMON" is a generic term, then nothing in the mark could identify Opposer as the source of the goods. The mark, as a whole, signifies book content (written or recorded) from a Mormon religious sect, which by definition is generic.

According to their religious practices, all Mormons consider the writings of Joseph Smith, which he titled in 1830 as the "Book of Mormon," as their religious reference and doctrine. It is a religious book similar to the Bible for Christians, Torah for Jews, or Quoran for

Muslims. As explained above, Opposer has no basis in fact or law that it is the sole Mormon sect that is allowed to call themselves “Mormons,” thus the phrase BOOK OF MORMON cannot evidence a single source in the mind of the public. The Church of Jesus Christ of Latter-day Saints has no legal ownership rights nor copyrights in the “Book of Mormon” by Joseph Smith. However, this is exactly what Opposer and the Latter-day Saints church is attempting to claim in front of the Trademark Office. That book and its title have been in the public domain for over a century. Opposer alleged distinctiveness in its prosecution of the mark, declaring that it has used the Book of Mormon since 1830, which actually supports Applicant’s argument and Applicant’s evidence via dictionary definitions and other references: Opposer did not exist in 1830, but instead it was followers of the “Mormon” religion through Joseph Smith that were using the religious text back to 1830. The Trademark Office is not the proper forum for a religious sect to allege claims of exclusivity over religious teachings that are so disparate to well-known evidentiary references on the subject.

Opposer has not alleged any other meanings of the mark, as a whole, other than the plain definitions of its individual terms. The mark generically refers to a class of religious information found in a book. Applicant’s pleadings, therefore, should be accepted by the Board as adequate for its counterclaim. Applicant therefore requests the Board to deny Opposer’s motion.

B. DESCRIPTIVENESS

A mark is merely descriptive, and therefore unregistrable on the Principal Register pursuant to the provisions of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), if it immediately conveys "knowledge of a quality, feature,

function, or characteristic of the goods or services." *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007).

Descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or services for which registration is sought. That is, when we analyze the evidence of record, we must keep in mind that the test is not whether prospective purchasers can guess what applicant's goods [or services] are after seeing only applicant's mark. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978). The question is whether someone who knows what the goods or services are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-1317 (TTAB 2002); and *In re Patent & Trademark Services Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998).

In addition to considering the applied-for mark in relation to the goods or services for which registration is sought, the proper test for descriptiveness also considers the context in which the mark is used and the significance that the mark is likely to have on the average purchaser encountering the goods or services in the marketplace. *In re Omaha Nat'l Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991); and *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986).

An examining attorney may require an applicant to disclaim an unregistrable component

of a mark otherwise registrable. Trademark Act Section 6(a). Merely descriptive terms are unregistrable, under Trademark Act Section 2(e)(1) and, therefore, are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. *See In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (CCPA 1975); *In re Ginc UK Ltd.*, 90 USPQ2d 1472 (TTAB 2007); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977); and *In re Pendleton Tool Industries, Inc.*, 157 USPQ 114 (TTAB 1968).

1. Reg. No. 3239919 for MORMON

In its June 29, 2010 decision regarding Opposer's first Motion to Dismiss (docket no. 17), p. 8-9, the Board held:

We do find, however, that applicant has asserted a proper claim of mere descriptiveness as to the mark MORMON in Registration No. 3239919.

Opposer is now complaining again of the same pleading for mere descriptiveness that the Board has already held was properly pled. Opposer's motion is procedurally improper, and the Board should either deny Opposer's motion substantively or deny it as moot.

2. Reg. No. 2913694 for MORMON TABERNACLE CHOIR

Applicant noted the deficiencies in his pleadings in the Board's prior decision and amended this counterclaim to allege mere descriptiveness of the entire mark, not only the individual term "Mormon," stating:

MORMON TABERNACLE CHOIR merely describes or is merely descriptive of the services or goods being offered under Opposer's registrations, and thereby should not have been registered.

Otherwise, the counterclaim mimics the pleading text for mere descriptiveness of the mark MORMON, which the Board held was properly pled. Applicant therefore requests the Board to deny Opposer's motion.

3. Reg. No. 2883572 for BOOK OF MORMON

Applicant noted the deficiencies in his pleadings in the Board's decision and amended this counterclaim to allege mere descriptiveness of the entire mark, not only the individual term "Mormon," stating:

BOOK OF MORMON merely describes or is merely descriptive of the services or goods being offered under Opposer's registrations, and thereby should not have been registered...

Otherwise, the counterclaim mimics the pleading text for mere descriptiveness of the mark MORMON, which the Board held was properly pled. Applicant therefore requests the Board to deny Opposer's motion.

C. FRAUD

A third party may petition to cancel a registered trademark on the ground that the "registration was obtained fraudulently." *15 U.S.C. § 1064(3)*. "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*

(*Fed. Cir. 1986*). *In re Bose Corp.*, 580 F.3d 1240, 1243 (*Fed. Cir. 2009*).

*Fed. R. Civ. P. 9(b)* provides that the circumstances constituting the alleged fraud shall be stated with particularity. *DaimlerChrysler Corp. v. Amer. Motors Corp.*, 94 U.S.P.Q. 2d (BNA) 1086 (T.T.A.B. 2010). See also *King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801 (CCPA 1981) ("[t]he pleadings [must] contain explicit rather than implied expressions of the circumstances constituting fraud"). Intent to deceive is an indispensable element of the analysis in a fraud case. See *In re Bose Corporation*, 476 F.3d 1331, 91 USPQ2d 1938, 1941 (*Fed. Cir. 2009*). As such, intent to deceive the Office, whether to obtain a registration, or to maintain a registration, is also an element to be pleaded in a fraud claim. Nonetheless, intent, as a condition of mind of a person, may be averred generally. *Fed. R. Civ. P. 9(b)*. Acceptable pleadings include allegations with a fraud assertion that states with particularity representations of fact that petitioner alleges were false and were known to be false, were material, and were relied upon by the Office. See *DaimlerChrysler Corp.*, 94 U.S.P.Q. 2d (BNA) 1086, 1098-90 (TTAB 2010). Further, the assertions combining the references "material misrepresentations" "knowingly made" and "to procure" a registration constitute an allegation of respondent's intent. That is, where a pleading asserts that a known misrepresentation, on a material matter, is made to procure a registration, the element of intent, indispensable to a fraud claim, has been sufficiently pled. *Id.*

[B]ecause direct evidence of deceptive intent is rarely available, such intent can be inferred from indirect and circumstantial evidence. But such evidence must still be clear and convincing, and inferences drawn from lesser evidence cannot satisfy the deceptive intent requirement. When drawing an inference of intent, the involved conduct, viewed in light of all the evidence . . . must indicate sufficient culpability to require a finding of intent to deceive.

*In re Bose*, 580 F.3d 1240, 2009 U.S. App. LEXIS 19658, at \*10-11

Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application, and the obligation to refrain from knowingly making false, material statements applies with equal force to renewal applications. *See Torres v. Cantine Torresella S.r.l*, 808 F.2d 46, 48 (Fed. Cir. 1986).

Applicant's counterclaims for fraud meet the heightened pleading requirements of the particular circumstances constituting the fraud. First, however, in its motion Opposer states that in each counterclaim Applicant failed to allege proof of intent the fourth element required for proving fraud. In *In re Bose*, 580 F.3d 1240, the Court stated that

[B]ecause direct evidence of deceptive intent is rarely available, such intent can be inferred from indirect and circumstantial evidence.

Thus for each of Applicant's counterclaims, it is acceptable that intent can be inferred by the Board through indirect and circumstantial evidence of Opposer's statements.

1. Reg. No. 1527447 for MORMON HANDICRAFT

Applicant properly pleaded facts that during prosecution, Opposer (meaning its predecessor-in-interest) filed false assertions with the Trademark Office regarding entitlement to use the term "Mormon." In the prosecution history, Examiner Sidoti wrote:

Inquiry is made as whether there are other splinter groups also entitled to use the term "MORMON"? 37 C.F.R. Rule 2.61(b). (See Office Action, p. 2 (4/22/87))

Opposer, on page 8 of its October 22, 1987 Response, stated:

4. Use of the Term "Mormon" by others. In response to the inquiry of the Examining Attorney, Applicant states that it is not aware of any so-called "splinter groups" of the LDS Church which are using or which are entitled to use the term "Mormon." To the best of Applicant's knowledge, only the LDS Church and its subsidiaries and affiliates (which, of course, includes Applicant), are entitled to use the term "Mormon." (See Supplemental Declaration of Ronald A. Millett at paragraph 11; and Declaration of David B. Erickson at paragraph 7.)

Applicant has specifically pled that such allegations made in the prosecution history were willfully false and that the Examining Attorney materially relied on the false responses. In its first Answer and Counterclaims, Applicant produced evidence in the form of dictionaries, papers from the LDS Church itself, newspapers, and other sources naming "so-called 'splinter groups'". Historically, there are numerous splinter groups of "Mormon" sects, which is why dictionary definitions define the term as such. Opposer had a duty to bring information of splinter groups to the Examining Attorney's attention. Failing to produce relevant information to the Examining Attorney can constitute fraud:

Defendants have offered evidence suggesting that WMH knowingly failed to produce relevant information responsive to the Examining

Attorney's request for examples of competitors' use of "the same or similar goods in the identified color." And contrary to WMH's assertions, WMH did have a duty to provide any known examples to the Examining Attorney instead of unilaterally deciding they were not relevant. *See Gaffrig Performance Indus. v. Livorsi Marine, Inc., Nos. 99 C 7778, 99 C 7822, 2003 U.S. Dist. LEXIS 23018, 2003 WL 23144859, at \*14 (N.D. Ill. Dec. 22, 2003)* ("Although it is true that in the initial application there is no duty to so investigate and report, . . . in this case the PTO explicitly requested this information. . . . [The applicant] was obligated to truthfully answer whether there was other significant use of the mark -- regardless of whether [\*28] [the applicant] believed them to be junior users . . .").

*See WMH Tool Group, Inc. v. Woodstock, Int'l, Inc., 2009 U.S. Dist. LEXIS 125325, \*26; 93 U.S.P.Q.2D (BNA) 1570 (N.D. Ill. 2009).* Thus, a registrant's failure to bring requested evidence of others using the mark or genericness of the mark to the attention of the Trademark Office at the time of application can be evidence of fraud resulting in cancellation of a mark. *See G. Levor & Co. v. Nash, Inc., 123 U.S.P.Q. 234, 235 (T.T.A.B. 1959); Bart Schwartz Int'l Textiles, Ltd. V. FTC 129 U.S.P.Q. 258, 262 (C.C.P.A. 1961).*

Thus, Applicant has pled in fact and law a basis for fraudulent procurement of the trademark. Applicant therefore respectfully requests the Board to deny Opposer's motion.

2. Reg. No. 1524555 for MORMON HANDICRAFT

This trademark was procured using the same false assertions as the 1527447 mark. Applicant properly pleaded facts that during prosecution, Opposer (meaning its predecessor-in-interest) filed false assertions with the Trademark Office regarding entitlement to use the term "Mormon." In the prosecution history, Examiner Sidoti wrote:

Inquiry is made as whether there are other splinter groups also entitled to use the term

“MORMON”? 37 C.F.R. Rule 2.61(b). (See Office Action, p. 2 (4/22/87))

Opposer, on page 9 of its October 22, 1987 Response, stated:

5. Use of the Term “Mormon” by others. In response to the inquiry of the Examining Attorney, Applicant states that it is not aware of any so-called “splinter groups” of the LDS Church which are using or which are entitled to use the term “Mormon.” To the best of Applicant’s knowledge, only the LDS Church and its subsidiaries and affiliates (which, of course, includes Applicant), are entitled to use the term “Mormon.” (See Supplemental Declaration of Ronald A. Millett at paragraph 11; and Declaration of David B. Erickson at paragraph 7.)

Applicant has specifically pled that such allegations made in the prosecution history were willfully false and that the Examining Attorney materially relied on the false responses. In its first Answer and Counterclaims, Applicant produced evidence in the form of dictionaries, papers from the LDS Church itself, newspapers, and other sources naming “so-called ‘splinter groups’”. Historically, there are numerous splinter groups of “Mormon” sects, which is why dictionary definitions define the term as such. Opposer had a duty to bring information of splinter groups to the Examining Attorney’s attention. Failing to produce relevant information to the Examining Attorney can constitute fraud *See Gaffrig Performance Indus. v. Livorsi Marine, Inc., Nos. 99 C 7778, 99 C 7822, 2003 U.S. Dist. LEXIS 23018, 2003 WL 23144859, at \*14 (N.D. Ill. Dec. 22, 2003)* (“Although it is true that in the initial application there is no duty to so investigate and report, . . . in this case the PTO explicitly requested this information. . . . [The applicant] was obligated to truthfully answer whether there was other significant use of the mark -- regardless of whether [the applicant] believed them to be junior users . . .”). *See also WMH Tool Group, Inc. v. Woodstock, Int’l, Inc., 2009 U.S. Dist. LEXIS 125325, \*26; 93 U.S.P.Q.2D (BNA) 1570 (N.D. Ill. 2009)*. Thus, a registrant’s failure to bring requested evidence of others using the mark or

genericness of the mark to the attention of the Trademark Office at the time of application can be evidence of fraud resulting in cancellation of a mark. *See G. Levor & Co. v. Nash, Inc.*, 123 U.S.P.Q. 234, 235 (T.T.A.B. 1959); *Bart Schwartz Int'l Textiles, Ltd. V. FTC* 129 U.S.P.Q. 258, 262 (C.C.P.A. 1961).

Thus, Applicant has pled in fact and law a basis for fraudulent procurement of the trademark. Applicant therefore respectfully requests the Board to deny Opposer's motion.

3. Reg. No. 2766231 for MORMON TABERNACLE CHOIR (and Design)

Applicant has properly pled elements of fraud in its counterclaims, referring to a Section 2(f) declaration making assertions of exclusive rights to use the term "Mormon, and the failure to tell the Examining attorney of other sects and splinter groups of Mormons. This arose during the prosecution history. The Examining Attorney rejected the word portion of the mark as being merely descriptive of Mormons, for "a group of singers of the Mormon church." (see Office Action, p. 1, (10/20/2003)). In its response, Opposer supported its 2(f) claim with declarations that it is the only organization that can use the term "Mormon." It also used assertions made in the 2913694 prosecution history that no other entity has a right to use the mark either in identical form or in *near resemblance*. These were false assertions which hid the fact from the Examining Attorney that numerous sects that are "Mormons," which is discussed in the following paragraph regarding the '694 registration.

Applicant has pleaded sufficient facts and circumstances to meet the standard for pleading fraud. Applicant requests the Board to deny Opposer's motion.

4. Reg. No. 2913694 for MORMON TABERNACLE CHOIR

Here, Opposer made false declarations and omitted material evidence during the prosecution of the application. Again, Opposer filed a Section 2(f) declaration stating that is the only religious organization that has a right to be called “Mormons.” Opposer also made assertions in the application that no other entity has a right to use the mark either in identical form or in *near resemblance*. (see Application, p. 2, (11/20/2001)). These were false assertions which hid the fact from the Examining Attorney that numerous religious sects are called “Mormons,” which has been discussed previously herein regarding dictionary definitions and newspaper articles. This was material evidence to the Examining Attorney, since the Examiner accepted claims of distinctiveness of the mark based on these assertions.

Applicant has pleaded sufficient facts and circumstances to meet the standard for pleading fraud. Applicant requests the Board to deny Opposer’s motion.

5. Reg. No. 2883572 for BOOK OF MORMON

In this counterclaim, Applicant identified two individual declarations from the prosecution history that Applicant alleges contain willfully false statements regarding ownership, use, and acquired distinctiveness of the mark for its Section 2(f) claim. After receiving a rejection for mere descriptiveness, Opposer claimed that the mark had acquired distinctiveness based on it and its predecessors being “the exclusive provider of goods bearing the proposed mark and have used the mark exclusively in commerce, as well as worldwide, on some of the goods at least as early as 1830.”

According to their religious practices, all Mormons consider the writings of Joseph Smith, which he titled in 1830 as the “Book of Mormon” as their religious reference and doctrine. It is a religious book similar to the Bible for Christians, Torah for Jews, or Quoran for Muslims. Opposer has no basis in fact or law that it is the sole Mormon sect that is allowed to call themselves “Mormons,” thus the phrase BOOK OF MORMON cannot evidence a single source in the mind of the public. Opposer, the Church of Jesus Christ of Latter-day Saints has no legal ownership rights nor copyrights in the “Book of Mormon” by Joseph Smith and did not exist in 1830. However, this is exactly what Opposer and the Latter-day Saints church is attempting to claim in front of the Trademark Office. That book and its title have been in the public domain for over a century. Opposer alleged distinctiveness in its prosecution of the mark, declaring that it has used the Book of Mormon since 1830, which actually supports Applicant’s argument and Applicant’s evidence via dictionary definitions and other references: Opposer did not exist in 1830, but instead it was followers of the “Mormon” religion through Joseph Smith that were using the religious text back to 1830. Again, the Trademark Office is not the proper forum for a religious sect to allege claims of exclusivity over religious teachings that are so disparate to well-known evidentiary references on the subject.

Applicant has pleaded sufficient facts and circumstances to meet the standard for pleading fraud. Applicant requests the Board to deny Opposer’s motion.

6. Reg. No. 3239919 for MORMON

In its counterclaim, Applicant pleaded facts that in Opposer’s declarations it failed to inform Examiner Alt that other religious sects are also named and use the term “Mormon” for the

names of their services such as religious education. Opposer stated:

The phrase "Mormon Church" is sloppily used by only some of the public in place of the actual name of the religious organization more widely, and correctly, known as The Church of Jesus Christ of Latter-day Saints. (Response, p. 4 (9/30/2003).

These were false misrepresentations to the Examining Attorney and were used as the basis for Opposer's Section 2(f) claims. The Church of Jesus Christ of Latter-day Saints is clearly *not* the only "Mormon" sect, and evidence of such was included in Applicant's pleadings. Such subjective beliefs that it is the only "Mormon" church within that religion such that it alone can provide "Mormon" educational services have no place in the procurement of trademarks, especially when evidence so clearly shows otherwise. Opposer committed fraud by omitting such evidence of other Mormon sects and splinter groups from the Examining Attorney and making declarations that it alone has rights to the word "Mormon" since the days of Joseph Smith.

Applicant has pleaded sufficient facts and circumstances to meet the standard for pleading fraud. Applicant requests the Board to deny Opposer's motion.

CONCLUSION

Based on the foregoing, Applicant respectfully request the Board to deny Opposer's Motion to Dismiss.

Respectfully Submitted,

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**CERTIFICATION OF SERVICE**

I do hereby certify that on this 26th day of August, 2010, I served a copy of the above and foregoing pleading, **APPLICANT'S RESPONSE TO OPPOSER'S MOTION DISMISS COUNTERCLAIMS**, on all counsel for all parties to this proceeding, namely

Mr. Douglas R. Bush  
Mr. Michael A. Grow  
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by mailing same via United States Mail, properly addressed and first class postage prepaid.

/Kendal Sheets/ 26 Aug. 2010  
Kendal Sheets                      Date