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

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Mailed: March 26, 2010

Opposition No. 91190281
Opposition No. 91191705

Joe Cool Inc.

v.

W. Joseph Biggs

Before Seeherman, Holtzman, and Zervas, Administrative Trademark Judges:

By the Board:

This case comes up on applicant's motion, in Opposition No. 91191705, to dismiss the notice of opposition for lack of service and failure to state a claim. The motion is contested.

By way of background, applicant has filed two applications for marks for t-shirts, both of which have been opposed by Joe Cool Inc. (hereafter "opposer"). PANAMA CITY BEACH BIKE WEEK (PANAMA CITY BEACH disclaimed) is the subject of application Serial No 77559122 and has been opposed in Opposition No. 91190281, and PANAMA CITY BIKE WEEK (PANAMA CITY disclaimed) is the subject of application

Serial No. 77572901 and has been opposed in Opposition No. 91191705. In Opposition No. 91190281, which commenced May 19, 2009, and in Opposition No. 91191705, which commenced August 31, 2009, the operative notices of opposition essentially are identical, each comprising eighteen numbered paragraphs which in general vary only in the details unique to the opposed application.[1]

PROCEEDINGS ARE CONSOLIDATED

Because the parties are the same, and the two proceedings involve common issues of law and fact, the interest of judicial economy will be served by consolidation of Opposition Nos. 91190281 and 91191705. *See* Fed. R. Civ. P. 42(a) and TBMP §511 (2nd ed. rev. 2004). Accordingly, the Board sua sponte orders Opposition Nos. 91190281 and 91191705 to be consolidated.[2]

NO LACK OF SERVICE UNDER TRADEMARK RULE 2.101

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[1] In Opposition No. 91190281, the Board accepted opposer's amended notice of opposition on July 31, 2009 and opposer filed almost the same notice of opposition in Opposition No. 91191705 on August 31, 2009.

[2] With the exception of the need for a separate notice of opposition and answer in each proceeding, the consolidated proceedings shall be presented on the same record and briefs. The Board file will be maintained in Opposition No. 91190281 as the "parent" case, but all papers filed herein must include the proceeding numbers of both consolidated cases as shown in the captioning of this order.

With respect to opposer's motion in Opposition No. 91191705 regarding the lack of service, Trademark Rule 2.101(a) states that a notice of opposition "must include proof of service on the applicant, or its attorney or domestic representative of record, at the correspondence address of record in the Office, as detailed in §§2.101(b) and 2.119." A notice of opposition which does not include proof of service and was not properly served in a timely manner must be dismissed as a nullity. *Schott AG v. Scott*, 88 USPQ2d 1862, 1863-1864 (TTAB 2008). However, in those cases in which the Board has dismissed the opposition for lack of service, the failure to serve the notice of opposition was undisputed. *Schott AG v. Scott*, *supra* at 1863 (TTAB 2008)("opposer does not dispute the absence of a proof of service certificate or its failure to actually forward a service copy"); *Springfield Inc. v. XD*, 86 USPQ2d 1063, 1064 (TTAB 2008)("opposer states in the current motion that it did not, in fact, comply with the service requirements."). Moreover, there is a distinction between a complete lack of actual service and defective but curable actual service. *Chocoladefabriken Lindt & Sprungli AG v. Flores*, 91 USPQ2d 1698, 1700 (TTAB 2009).

Here, the notice of opposition includes a certificate of service, albeit defective and directed to applicant and not his counsel, and opposer contends that it served applicant at the address of record. While applicant has submitted a

declaration averring that he never received the service copy of the notice of opposition, this is not the equivalent of an admission by opposer that he failed to serve the pleading. While we agree that opposer has made an insufficient effort to comply with the service rules, applicant's motion for dismissal based on lack of service is denied.

OPPOSER IS SANCTIONED

In Opposition No. 91191705, the notice of opposition filed August 31, 2009 includes a certificate of service which states "Joe Cool, Inc. verifies that it has prepared a copy of the foregoing to be served on Applicant by fax transmission/1st class mail on 8 28 09." In Opposition No. 91190281, the Board's May 28, 2009 order noted opposer's failure to serve a motion to amend, and in its July 31, 2009 order, the Board found other instances of defective service; directed opposer to the sample of an acceptable certificate of service included in the Trademark Trial and Appeal Board Manual of Procedure (TBMP) (2nd ed. rev. 2004; advised opposer to obtain counsel; and warned opposer that all parties (even if pro se) must comply with the Board's rules.

We agree with applicant that the August 31, 2009 certificate of service for the notice of opposition is defective not only as it is directed to the wrong individual, but because (i) it fails to state that service has been

effected but states that the paper will be served at some unknown future date, (ii) it fails to identify the means of service but states two options (fax transmission/1st class mail), and (iii) it fails to specify the address at which service was made. Because repeated warnings have not resulted in compliance with the requirements for proof of service, as a sanction opposer is ordered as follows:

1. On each paper filed with the Board, opposer must include this certificate of service, modified to include the indicated information:

CERTIFICATE OF SERVICE

> I hereby certify that a true and complete copy of the foregoing (insert title of submission) has been served on (insert name of opposing counsel) by mailing said copy on (insert date of mailing), via First Class Mail, postage prepaid (or insert other appropriate method of delivery) to: (set out name and address of opposing counsel).

2. When opposer files a paper with Board, on the same day opposer must notify counsel for applicant by phone that the paper has been filed AND must email a courtesy copy of the filing to counsel for applicant.[3]

NO FAILURE TO STATE A CLAIM OF ORNAMENTATION

To withstand a motion to dismiss for failure to state a claim under Rule 12(b)(6), a notice of opposition need only

[3] If emailing attachments to the filing is impractical, the attachments may be omitted from the courtesy copy.

allege such facts as would, if proven, establish opposer's standing to maintain the proceeding and a ground or grounds for refusing registration to applicant. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

On July 31, 2009, in Opposition No. 91190281, the Board issued an order finding that the amended notice of opposition set forth opposer's standing and legally sufficient claims of priority and likelihood of confusion, and fraud. In addition the Board addressed the following allegation:

> 16. Applicant is not entitled to registration because [of] unclean hands and or violations of the antitrust Laws and or because [his] use [is] ornamental in nature.

The Board found this allegation sets forth a legally sufficient claim that the mark is unregistrable as ornamental but ordered stricken the extraneous wording ("unclean hands") and reference to matters outside the Board's jurisdiction ("violations of the antitrust laws").

With the instant motion in Opposition No. 91191705, applicant does not dispute opposer's standing but moves to dismiss the notice of opposition for failure to state a claim with respect to Paragraph 16 of the notice of opposition, the same allegation set forth above. The Board again finds a legally sufficient claim that the mark is unregistrable as ornamental, and that the allegation also includes extraneous

wording and references to matters outside the Board's jurisdiction. Consistent with our action in Opposition No. 91190281, the extraneous matter is stricken so that the relevant paragraph (¶16) of the notice of opposition reads:

> Applicant is not entitled to registration because [his] use [is] ornamental in nature.

Accordingly, applicant's motion to dismiss is granted only to the extent that the references to unclean hands and antitrust violations are stricken.

NEW FRAUD PLEADING REQUIRED

Since the Board last ruled on the sufficiency of the pleadings, the Board's primary reviewing court issued a decision in *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009), which establishes standards for pleading and proving 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." *In re Bose Corp.*, 91 USPQ2d at 1939, *citing Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2D 1483, 1484 (Fed. Cir. 1986). Intent to deceive is an indispensable element of the analysis in a fraud case. *Daimlerchrysler Corporation and Chrysler, LLC v. American Motors Corporation*, _ USPQ2d __ (TTAB 2010) *citing In re Bose*.

The notices of opposition in the two proceedings differ as to the fraud claim. While both include paragraphs 17 and

18 (a)-(c), Opposition No. 91191705 additionally includes Paragraph 18(d):

> 17. Upon information and belief, applicant knew of Opposers prior use of confusingly similar Marks and has himself not used [his] alleged Marks on the date he signed the application being opposed herein.
>
> 18. Upon information and belief the opposed Application thus contains false and or fraudulent statements.
> a. he did [not] inform the PTO of prior usages of mark
> b. he had no actual mark usage when he signed the application
> c [his] "usage" was ornamental
>
> d. he enclosed a specimen which does not show trademark use, in the application said specimen was rejected by the examining attorney in an office action. [A]pplicant then proceeded to concoct a fraudulent and false affidavit in response to the office action, and succeeded -- based on the fraudulent and false affidavit -- to reverse the examiners initial and correct refusal

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. *Daimlerchrysler Corporation and Chrysler, LLC v. American Motors Corporation*, __ USPQ2d __ (TTAB 2010). Accordingly, we find that the notice of opposition in Opposition No. 91191705, which includes the allegation regarding fraudulent statements made to reverse the initial refusal of registration, is a sufficient pleading of fraud. In contrast, the notice of opposition in Opposition No. 91190281 merely alleges false statements by applicant, does

not properly plead intent to deceive, and thus is an insufficient pleading of fraud.

Opposer is allowed until TWENTY days from the mailing date of this order to file an amended pleading of fraud in Opposition No. 91190281, failing which this consolidated proceeding will go forward on the claims of priority and likelihood of confusion, and ornamentation in both proceedings, and additionally on fraud in Opposition No. 91191705.

PROCEEDINGS RESUMED

Applicant is allowed until FORTY days from the mailing date of this order to file his answer in Opposition No. 91191705 and, if necessary, his answer to any amended notice of opposition in Opposition No. 91190281.

Proceedings in this consolidated proceeding are resumed and dates are reset as shown below:

Deadline for Discovery Conference	**6/4/10**
Discovery Opens	**6/4/10**
Initial Disclosures Due	**7/4/10**
Expert Disclosures Due	**11/1/10**
Discovery Closes	**12/1/10**
Plaintiff's Pretrial Disclosures	**1/15/11**
Plaintiff's 30-day Trial Period Ends	**3/1/11**
Defendant's Pretrial Disclosures	**3/16/11**
Defendant's 30-day Trial Period Ends	**4/30/11**
Plaintiff's Rebuttal Disclosures	**5/15/11**
Plaintiff's 15-day Rebuttal Period Ends	**6/14/11**

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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