

ESTTA Tracking number: **ESTTA359943**

Filing date: **07/26/2010**

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

Proceeding	91195327
Party	Defendant Hard Candy, LLC
Correspondence Address	GABRIEL GROISMAN COFFEY BURLINGTON 2699 SOUTH BAYSHORE DRIVE, PENTHOUSE MIAMI, FL 33133 UNITED STATES ggroisman@coffyburlington.com, nsalas@coffeyburlington.com
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Natalia Salas
Filer's e-mail	nsalas@coffeyburlington.com
Signature	/Natalia Salas/
Date	07/26/2010
Attachments	Motion to Dismiss.pdf ( 8 pages )(713330 bytes )

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

HardCandy Cases, LLC,

Opposer,

v.

Hard Candy, LLC,

Applicant.

In Re: Application Serial No. 77700559  
For the Mark: Hard Candy  
Published in the Official Gazette: 02/16/09

Opposition No. 91195327

---

**APPLICANT HARD CANDY, LLC'S MOTION TO DISMISS OPPOSER'S  
SECOND GROUND OF OPPOSITION AND BRIEF IN SUPPORT THEREOF**

Hard Candy, LLC ("Hard Candy" or "Applicant"), located and doing business at 6100 Hollywood Blvd., Seventh Floor, Hollywood, Florida, by and through undersigned counsel and pursuant to Rules 12(b)(6) and 9(b) of the Federal Rules of Civil Procedure, hereby moves to dismiss Opposer HardCandy Cases, LLC's ("HardCandy Cases" or "Opposer") Second Ground of its Notice of Opposition, as set forth in the brief below.

**I. INTRODUCTION**

Hard Candy and its predecessors have been selling HARD CANDY branded products in commerce, including cosmetics, fragrances, skin care and other products since 1995. Hard Candy currently owns U.S. trademark registration nos. 3,696,602, 1,987,262, 2,150,397, 2,666,792, 2,666,793, 2,343,732, 2,552,029, 2,567,186, and 2,362,340, all of which use the mark HARD CANDY, or some variation or abbreviation thereof.

On March 27, 2009, Hard Candy filed a Section 1(b), intent to use application with the US Patent and Trademark Office ("USPTO") for the mark HARD CANDY under international

**C O F F E Y B U R L I N G T O N**

---

OFFICE IN THE GROVE, PENTHOUSE 2699 SOUTH BAYSHORE DRIVE MIAMI, FLORIDA 33133  
T: 305.858.2900 F: 305.858.5261  
Email: info@coffeyburlington.com www.coffeyburlington.com

class 009 consumer electronics, Serial no. 77/917,147. At the time of the application at issue, Hard Candy had, and continues to have, a bona fide intent to expand its brand into various additional markets, including consumer electronics. The application is part of a now ongoing effort to use the HARD CANDY mark in Class 009 in commerce, as described in its application.

Almost ten (10) months *after* Applicant filed the aforementioned application, Opposer filed a Section 1(b), intent to use application with the USPTO for the mark HARD CANDY CASES, also under international class 009, Serial no. 77/917,147. On April 21, 2010, the USPTO issued a Non-Final Action, wherein the Office cited Applicant Hard Candy's prior pending applications, Serial nos. 77/700,559 and 77/700,0059, and stated that because "there may be a likelihood of confusion under Trademark Section 2(d) between [HardCandy Cases'] mark and [Hard Candy, LLC's] prior pending marks," it would suspend HardCandy Cases's application until one of Hard Candy's "*earlier filed* applications" mature into a registration – at which point HardCandy Cases's application would be refused.

Ignoring this bleak prognosis, Opposer filed a Notice of Opposition as deficient in legal merit as it is in factual basis: First, Opposer baldly alleges that Hard Candy did not have a bona fide intent to use the HARD CANDY mark at the time it filed the application at issue, despite Applicant's prior use of the HARD CANDY mark in commerce for nearly two decades and several recent intent to use applications evidencing Hard Candy's expansion of its brand into other markets. Second, Opposer claims that Hard Candy's application was somehow fraudulent because of the existence of Madonna's 2008 "Hard Candy" album. While discovery will certainly reveal that Hard Candy had and continues to have a bona fide intent to use the HARD CANDY mark for the goods described in its application, this motion is limited to Opposer's Second Ground for opposition, which fails as a matter of law because trademark law is clear in

stating that such fraud claims must be pled with requisite specificity and that a title to a single creative work, such as Madonna's "Hard Candy," is not entitled to trademark protection.<sup>1</sup>

## II. ARGUMENT

### A. Opposer's Second Ground Must be Dismissed.

A Notice of Opposition claiming that the oath in an applicant's application for registration was executed fraudulently because there was another use of the same or a confusingly similar mark at the time the oath was signed *must* be dismissed unless it "allege[s] *particular* facts which, if proven, would establish that: (1) there was in fact another use of the same or a confusingly similar mark at the time the oath was signed; (2) the other user had legal rights superior to applicant's; (3) applicant knew that the other user had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise; *and* that (4) applicant, in failing to disclose these facts to the Patent and Trademark Office, intended to procure a registration to which it was not entitled." *Intellimedia Sports, Inc. v. Intellimedia Corp.*, 43 USPQ 2d 1203 (TTAB 1997) (emphasis added).<sup>2</sup> HardCandy Cases's fraud claim fails to establish these requisite elements and must be dismissed accordingly.

#### 1. Madonna's "Hardy Candy" Album is Not Entitled to Superior Protection

First, Opposer cannot state a claim for fraud under Rule 12(b)(6) of the Federal Rules of Civil Procedure because it cannot establish the second element required to withstand a motion to dismiss, i.e., that the other user, Madonna, had legal rights superior to Applicant's.

---

<sup>1</sup> Concurrently herewith, Applicant has filed its Answer and Affirmative Defenses to Opposer's First Ground of its Notice of Opposition.

<sup>2</sup> All emphases are added unless otherwise stated.

“It is well settled that a mark may not be registered if it is merely the title of a single creative work.” *In re Author Services, Inc.*, 2003 WL 21979843 at \*3 (TTAB August 08, 2003). *See also, e.g., Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1163 (Fed. Cir. 2002) (holding title of a single book cannot be registered because it cannot serve as a source identifier); *In re Cooper*, 254 F. 2d 611 (CCPA 1958) (same); *In re Scholastic Inc.*, 223 USPQ 431 (TTAB 1984) (holding that “The Littles,” as portion of title for series of educationally oriented children's books, is not registrable since it does not perform trademark function); *In re Posthuma*, 45 USPQ 2d 2011 (TTAB 1998) (holding title of live theatrical production is not a registrable service mark). The title of an album of music, like books, plays, and other titles, is a single creative work not registrable on either the Principal or Supplemental Register. *In re Alphacritters, Inc.*, 2009 WL 4079119 (TTAB 2009) (“The ‘title of a single work’ refusal has been extended to musical recordings”). *See also* Trademark Manual of Examining Procedure, 1202.08(a) (6<sup>th</sup> ed. 2009) (“Single creative works include works in which the content does not change, whether that work is in printed, recorded or electronic form”).

Opposer argues that the declaration executed by Applicant with its application for Serial no. 77/700,559 was somehow fraudulent because Opposer “believes that at the time of filing its application in international class 009, [Applicant] was aware of the existence of the identical mark in the identical class of goods in use on Madonna’s ‘Hard Candy’ CD.” (Notice of Opposition at 17.) To “establish” that Madonna’s “Hard Candy” album gives Madonna superior rights to Hard Candy, LLC’s application, Opposer simply states that “[o]n April 25, 2008, the pop artist Madonna released her 11<sup>th</sup> album on Compact Disc entitled ‘Hard Candy.’ ... The appropriate international class for CDs is 009.” (Notice of Opposition at 11, 14.) This is plainly insufficient.

The title of a Madonna album is clearly a “single creative work” without trademark protection under the Lanham Act. As a result, Opposer cannot, under any circumstances, establish the requisite elements to plead a cause of action for Fraud Involving Oath in the Application.

2. Opposer’s Fraud Allegations are Inadequate as a Matter of Law

Pursuant to Trademark Rule 2.116(a), the sufficiency of petitioner's pleading of its fraud claim in a notice of opposition is also governed by Rule 9(b) of the Federal Rule of Civil Procedure, which contains a similar particularity requirement: “In all averments of fraud or mistake, the circumstances constituting fraud or mistake *shall* be stated with particularity.” Fed. R. Civ. P. 9(b). *See also Intellimedia Sports, Inc.*, 43 USPQ 2d at 1203. Moreover, “the alleged fraudulent misconduct ‘must be accompanied by some element of willfulness or bad faith, which must be established by *clear, unequivocal and convincing evidence.*” *International House of Pancakes, Inc. v. Elca Corp.*, 216 USPQ 521, 524 (TTAB 1982) (internal citations omitted).

Indeed, the Board has found that there is no fraud in signing the application oath if an applicant knew of third-party uses, but reasonably believed that its rights were superior to those third-party uses. *See Space Base, Inc. v. Stadis Corp.*, 17 USPQ 2d 1216, 1218-19 (TTAB 1990) (“[I]t is settled that there can be no fraud by reason of a party's failure to disclose the asserted rights of another person, including a prior applicant, unless that person is known to possess a superior or a *clearly established* right to use...”). *See also, e.g., Heaton Enterprises of Nevada, Inc. v. Lang*, 7 USPQ 2d 1842 (TTAB 1988); *McCarthy on Trademarks and Unfair Competition* § 31.76 (4<sup>th</sup> ed. updated 2007) (“It should be noted that in the application ‘oath’ declarant states ... an averment of the affiant or declarant's belief ... There is nothing in the oath or the statute

which requires applicant to disclose anyone who in fact may be using the mark, but does not, in the applicant's belief, possess the legal right to use.”).

In *King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801 (CCPA 1981), for example, the United States Court of Customs and Patent Appeals affirmed the Board's dismissal of a petitioner's fraud claim, reasoning that “Rule 9(b) requires that the pleadings contain explicit rather than implied expression of the circumstances constituting fraud.” *Id.* at 1010. In *King Automotive*, the petitioner purported to establish the third element of a fraud claim – that the respondent had personal knowledge of third-party use of the same or similar marks when respondent signed its application oath. The Court affirmed the Board’s finding that petitioner had failed to comply with the pleading requirements for fraud set forth by Rule 9(b) because the appellant had not stated the factual bases for its allegations of appellee's fraudulent misrepresentations to the Trademark Office with sufficient specificity. The Court found this to be the case even if the disclosures in the trademark search report supported appellant's contention that respondent knew of the alleged third-party use of the mark at issue, MUFFLER KING, because appellant's conclusory statement that Discoverer *knew* its declaration to be untrue is not supported by a pleading of any facts which reflect Discover's *belief* that the respective uses of MUFFLER KING and SPEEDY MUFFLER KING would be likely to confuse.

Similarly here, Opposer has not stated a claim for fraud because it failed to allege sufficient facts to establish the third or fourth elements needed to plead fraud, i.e., that applicant knew that Madonna had rights in the mark superior to Applicant’s and that Applicant intended to procure a registration to which it was not entitled. Instead, the only alleged basis for Opposer’s fraud claim simply states: “Upon information and belief, Opposer reasonably believes that at the

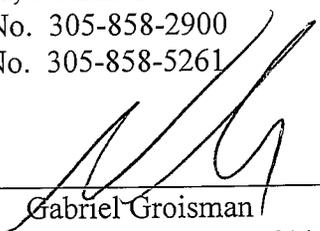
time of filing its application in international class 009, it was aware of the existence of the identical mark in the identical international class of goods in use on Madonna's 'Hard Candy' CD." (Notice of Opposition at 17.) Rule 9(b) requires that the pleadings contain explicit rather than implied expression of the circumstances constituting fraud. *King Automotive Inc.*, 667 F. 2d at 1010. As with the opposer in *King Automotive*, Opposer here "lack[s] the prerequisite averments of fact supportive of [opposer's] belief that [applicant] knew of a third-party's right to use [the mark] in commerce" when the application was filed. *Id.* Therefore, the Court should dismiss the Second Ground of Opposer's Notice of Opposition for failure to state a claim under Rules 12(b)(6) and 9(b) of the Federal Rules of Civil Procedure.

WHEREFORE, Applicant Hard Candy, LLC hereby moves this Court to dismiss Opposer's Second Ground of its Notice of Opposition with prejudice for failure to state a claim under FRCP 12(b)(6) and for failure to plead fraud with particularity under FRCP 9(b).

Respectfully submitted,

COFFEY BURLINGTON  
Counsel for Hard Candy, LLC  
2699 South Bayshore Drive, Penthouse  
Miami, Florida 33133  
Tel. No. 305-858-2900  
Fax No. 305-858-5261

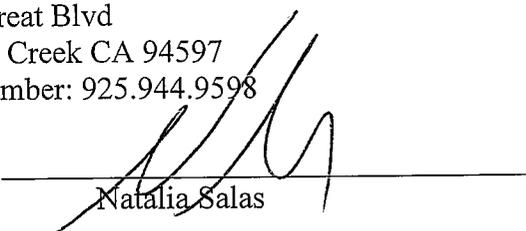
By: \_\_\_\_\_

  
Gabriel Groisman  
Florida Bar No. 25644  
ggroisman@coffeyburlington.com  
Natalia Salas  
Florida Bar No. 44895  
nsalas@coffeyburlington.com

**CERTIFICATE OF SERVICE**

IT IS HEREBY CERTIFIED that a true and correct copy of the foregoing was served on this 26<sup>th</sup> day of July, 2010, by facsimile transmission and by First Class Mail, proper postage upon:

Stuart J. West  
West & Associates, PC  
3rd Floor  
1255 Treat Blvd  
Walnut Creek CA 94597  
Fax Number: 925.944.9598



Natalia Salas