

Goodman

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

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

Mailed: July 29, 2013

Opposition No. **91198579**

Intellogy Solutions, LLC

v.

IntelliGolf, Inc.

**Before Quinn, Wolfson, and Hightower, Administrative
Trademark Judges.**

By the Board:

Applicant/counterclaim petitioner, Intelligolf, Inc.,
(hereafter applicant) has counterclaimed to cancel
opposer/counterclaim respondent Intellogy Solutions, LLC's
(hereafter opposer) pleaded registration for the mark
INTELLOGY¹ on the basis that opposer fraudulently filed a
false declaration with the initial filing of its
application, fraudulently filed improper specimens and
asserted false dates of first use in its initial filing of

¹ Registration No. 2498402, for Class 42: "computer services, namely, hosting and maintaining the web sites of others on a computer server for a global computer network." Registration issued October 16, 2001; Section 8 accepted, Section 15 acknowledged October 11, 2007; Section 8 (ten year) accepted, Section 9 granted August 12, 2011.

its application, and fraudulently filed false Section 8 and Section 15 declarations.²

In its answer, opposer denied that it has committed fraud on the USPTO.

This case now comes up on opposer's motion, filed February 12, 2013, for summary judgment on applicant's four fraud counterclaims.³ The motion is fully briefed.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes of material fact, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(a). A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). On summary judgment, the evidence must be viewed in a light favorable to the non-moving party, and all justifiable inferences are to be drawn in the nonmovant's favor. See, e.g., *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

Fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes false,

² The second amended counterclaim was filed on March 31, 2012.

³ On November 16, 2011 the Board required the parties to seek leave prior to filing any pretrial motions. On October 25, 2012, the Board granted opposer's request for leave to file a motion for summary judgment on the counterclaims.

material representations of fact in connection with an application to register or, in the case of maintaining a registration, when a registrant makes false, material representations of fact in connection with a Section 8 or 15 affidavit. *In re Bose Corp.*, 580 F.3d 1240; 91 USPQ2d 1938, 1939 (Fed. Cir. 2009); *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986). Specifically, it involves a willful withholding from the United States Patent and Trademark Office by an applicant or registrant of material information or facts which, if disclosed to the Office, would have resulted in the disallowance of the registration sought or to be maintained. *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628, 1634 (TTAB 1988).

The evidence on summary judgment consists of the declaration of Member-Manager of opposer, Robert Rhodes II, and accompanying exhibits, and the declaration of a customer of opposer, Jeffrey J. Segal, Chief Executive Officer of Medical Justice Corporation, and accompanying exhibits.

Applicant's evidence in response to opposer's motion for summary judgment consists of the declaration of a representative of applicant, Craig Schmidt, and accompanying exhibits.

In reply, opposer submitted the supplemental declaration of Robert Rhodes II, and accompanying exhibits.

First counterclaim

We turn to the first fraud counterclaim, for which applicant has alleged that opposer's initial application declaration was fraudulent.

The Board found, in our March 13, 2012 order that this claim was sufficiently pleaded. However, we do note that with regard to the third element of the claim i.e., opposer's knowledge of applicant's alleged superior rights, that in addition to applicant alleging that opposer knew of applicant's superior rights, applicant has also alleged that opposer "had sufficient information to require/warrant that opposer pursue further investigation . . ." of applicant's superior rights.

In this regard, we note that a trademark applicant has no duty to investigate potential conflicting uses that might be found through a trademark search, and therefore, there is no duty to investigate specific information such as when a third party may have started using a mark. *Maids to Order of Ohio Inc. v. Maid-to-Order Inc.*, 78 USPQ2d 1899, 1909 (TTAB 2006) citing *Money Store v. Harriscorp Finance, Inc.*, 689 F.2d 666, 216 USPQ 11 (7th Cir. 1982) (an applicant has no duty to investigate and report to the

USPTO all other possible users of the same or similar mark). Accordingly, a failure on the part of opposer to investigate when applicant started using the mark INTELLOGY or the domain name Intellogy.com would not constitute fraud.

The Board, in determining whether an applicant when he signed his application oath held an honest good faith belief that he was entitled to registration of his mark, has stated that "if the other person's rights in the mark, vis-à-vis the applicant's rights are not known by applicant to be superior or clearly established, e.g., by court decree or prior agreement of the parties, then the applicant has a reasonable basis for believing that no one else has the right to use the mark in commerce, and that applicant's averment of that reasonable belief in its application declaration or oath is not fraudulent."

Intellimedia Sports Inc. v. Intellimedia Corp., 43 USPQ2d 1203, 1207 (TTAB 1997).

Opposer maintains that at the time of filing its application to register its mark INTELLOGY, it was aware of applicant's registration of the domain name Intellogy.com, but was not aware that applicant had any trademark rights to the mark INTELLOGY. Robert Rhodes II declares that a trademark search was conducted on behalf of his company by

Rhodes & Mason PLC which "returned no usage of the mark 'intellogy' in commerce whatsoever." A copy of the search has been submitted with the declaration. Mr. Rhodes further declares that in November 2000 he "personally performed Internet searches for the term 'intellogy' and found no trademarked use of the mark in commerce," only finding use in connection with "the registration of the domain 'intellogy.com'" which "pulled up the same identical website content" as applicant's Intelligolf site. Mr. Rhodes declares that there appeared to be no "valid trademarked usage of the domain name" and no "trademarked usage of the mark 'intellogy' online via Internet searches, and in reliance on the clearance search services," he proceeded with re-branding his "content management software services from 'EMPOWER' to 'Intellogy.'" We note that opposer's knowledge of the registration of the domain name Intellogy.com did not, by itself, subject opposer to the duty to disclose applicant's existence to the Office.

Applicant argues that opposer's clearance search of the INTELLOGY mark was deficient as the search excluded the Sacramento Bee newspaper. However, even if the search was incomplete in some way, opposer's reliance thereon would not result in a finding of fraud absent a showing that

opposer knew that applicant had superior rights in the INTELLOGY mark.

Applicant attempts to raise a genuine dispute by arguing that opposer became aware of applicant's alleged superior trademark rights when it searched the internet and accessed applicant's Intelligolf website via the intellogy.com domain name, since the Intelligolf website provided for the sale of goods in trade. However, none of the goods were offered for sale under the trademark INTELLOGY. Despite applicant's arguments to the contrary, the purely technological function of the intellogy.com URL directing users to applicant's Intelligolf website is not evidence of trademark use. *See, e.g., In re Supply Guys, Inc.*, 86 USPQ2d 1488, 1493 (TTAB 2008) (use of LEADING EDGE TONERS as part of an internet address on a webpage was not use as a trademark for goods sold on the website).

Applicant also has argued that opposer should have been aware of its trademark use of INTELLOGY or Intellogy.com because its Intelligolf website, to which the domain name intellogy.com pointed, contained "active URL links" which referenced "'Trademark Copyrights and Terms of Use,'" which then linked to a "'Trademark, Copyrights and Terms of Use web page,'" which then linked to "Applicant's list of trademarks web page" which then linked to a

"`Trademark Notice web page.'" Applicant states that "IntellogyTM" was listed on the second page of the "`Trademark Notice' web page." However, trademark notice does not per se give a term trademark significance. See *In re A La Vieille Russie, Inc.*, 60 USPQ2d 1895 (TTAB 2001) (use of SM symbol in connection with RUSSIANART was not dispositive in determining service mark use, wherein such use was buried amid other informational matter).⁴ See also *In re Remington Products Inc.*, 3 USPQ2d 1714, 1715 (TTAB 1987) ("Mere intent that a term function as a trademark is not enough in and of itself, any more than attachment of the trademark symbol would be, to make a term a trademark").

Moreover, applicant's own submissions further support opposer assertions that applicant's rights in INTELLOGY or Intellogy.com as trademarks were not known by opposer to be superior or clearly established at the time opposer filed its INTELLOGY application.

In particular, the administrative panel decision from the WIPO Arbitration and Media Center involving the

⁴ Applicant's arguments regarding opposer's actions in connection with the parties' WIPO dispute, other domain name disputes, and opposer's actions in filing this opposition are simply not relevant to the issue of whether opposer's initial application declaration for the mark INTELLOGY was false.

parties, *Intellogy Solutions, LLC v. Craig Schmidt and Intelligolf, Inc.*, Case No. D2009-1244 (November 24, 2009), noted that

Respondents . . . do not appear to use that mark [INTELLOGY] on the home page of their <intellogy.com> website. . . . [P]rior to filing the [domain name] Complaint, Complainant had no actual knowledge of Respondent's prior use of the INTELLOGY mark in connection with its Intelligolf technology goods and services. . . . Respondents had no registration, and Respondents did not seem to be making any legitimate use of the INTELLOGY mark on the home page of its website.

Accordingly, we find that there is no genuine dispute of material fact that applicant's rights were not known by opposer to be superior or clearly established at the time of filing its INTELLOGY application, and the fraud claim fails on this basis alone.

In view thereof, opposer's motion for summary judgment on the first counterclaim is granted, and the first counterclaim is dismissed.

Second counterclaim

Turning next to the second counterclaim, our review of the pleadings in connection with the motion for summary judgment reveals that applicant has insufficiently alleged fraud in its second counterclaim.

In particular, applicant alleges that opposer's claimed date of first use as set forth in the underlying

application was false. It is well settled that a misstatement of a date of first use in commerce is not fraudulent nor is it otherwise fatal to the securing of a valid registration provided that there has been use of the mark in commerce prior to the filing date of registrant's application. *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 630 (TTAB 1986). Inasmuch as the second counterclaim is based on allegedly false dates of first use, the Board finds this portion of the second fraud counterclaim insufficient on its face.

With regard to applicant's allegations related to improper specimens, i.e., the submission of a press release by opposer rather than an advertisement as a specimen of service mark use, this allegation without more does not constitute fraud as the examining attorney could not have been misled as to what is apparent on the face of the specimen. *Neapco Inc. v. Dana Corp.*, 12 USPQ2d 1746, 1748 (TTAB 1989) citing *W. D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 377 F.2d 1001, 153 USPQ 749 (CCPA 1967) (finding no fraud as nothing was concealed from the examining attorney; the examining attorney was or should have been put on notice that the mark may also function as a part or model number in view of submission of a specimen which displayed it in such a manner).

Accordingly, inasmuch as these allegations fail to state a claim of fraud and are insufficient, the second counterclaim is dismissed with prejudice.⁵ See, e.g., *Bayer Consumer Care AG*, 90 USPQ2d 1587, 1592-93 (TTAB 2009) (dismissing with prejudice the second amended petition with respect to an untenable fraud claim without leave to replead).

Third and Fourth Counterclaims

With regard to the third and fourth counterclaims, we find that opposer has not met its initial burden of showing the absence of a genuine dispute of material fact such that it is entitled to judgment as a matter of law on applicant's Section 8 and 15 fraud counterclaims.⁶ In particular, a genuine dispute of material fact remains, at least, with respect to whether opposer (1) had continuous use of the INTELLOGY mark in connection with web hosting services during the five years prior to the time of filing

⁵ Having determined that the claim is insufficient on its face, we need not consider opposer's motion for summary judgment on this claim. See *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1480 (TTAB 2009) (finding motion for summary judgment moot on fraud claim due to improper and insufficient pleading).

⁶ We note that applicant also has pleaded that opposer acted with reckless disregard in connection with these claims. It is not established whether reckless disregard of the truth or falsity of a submission to the USPTO satisfies the intent to deceive requirement to constitute fraud. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1942 n.2 (Fed. Cir. 2009); *DaimlerChrysler Corp. v. American Motors Corp.*, 94 USPQ2d 1086, 1089 n.5 (TTAB 2010) (citing *Bose*).

the Section 15 declaration, and (2) was using the INTELLOGY mark in connection with web hosting services at the time it filed the Section 8 declarations.

In view thereof, opposer's motion for summary judgment with respect to the third and fourth fraud counterclaims is denied.⁷

This is the second motion for summary judgment that the Board has entertained. Applicant filed a motion for summary judgment on opposer's claim of likelihood of confusion on April 13, 2011, which was denied by the Board on July 18, 2011.

Inasmuch as the Board now has entertained motions for summary judgment on both the claims for opposition and the counterclaims for cancellation, the Board expects the parties to proceed to trial. As the Board has stated previously, no further pretrial motions will be entertained unless, prior to the filing thereof, the moving party

⁷ The fact that we have identified and discussed certain genuine disputes of material fact as a sufficient basis for denying opposer's motion for summary judgment on these counterclaims should not be construed as a finding that these are necessarily the only disputes which remain for trial.

The parties are reminded that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced during the appropriate trial period. See *Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

seeks, and is granted, leave to file its motion by the Board. If the parties seek to expedite matters, they may wish to consider the Board's accelerated case resolution (ACR) procedures.

Proceedings are resumed.

Dates are reset as follows:

Expert Disclosures Due	October 4, 2013
Discovery Closes	November 3, 2013
Plaintiff's Pretrial Disclosures Due	December 18, 2013
30-day testimony period for plaintiff's testimony to close	February 1, 2014
Defendant/Counterclaim Plaintiff's Pretrial Disclosures Due	February 16, 2014
30-day testimony period for defendant and plaintiff in the counterclaim to close	April 2, 2014
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	April 17, 2014
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	June 1, 2014
Counterclaim Plaintiff's Rebuttal Disclosures Due	June 16, 2014
15-day rebuttal period for plaintiff in the counterclaim to close	July 16, 2014
Brief for plaintiff due	September 14, 2014
Brief for defendant and plaintiff in the counterclaim due	October 14, 2014
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	November 13, 2014
Reply brief, if any, for plaintiff in the counterclaim due	November 28, 2014

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.

An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.