

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

Baxley

Mailed: June 21, 2012

Opposition No. 91200183

The Worlds Pageants, LLC

v.

Miss G-String International
LLC

Andrew P. Baxley, Interlocutory Attorney:

In the above-captioned proceeding, The Worlds Pageants, LLC ("opposer") opposes registration of Miss G-String International LLC's ("applicant") mark MISS G-STRING

INTERNATIONAL and design in the following form,  , for "[e]ntertainment services in the nature of conducting beauty pageants and talent contests" in International Class 41.¹ In the electronic cover sheet of the notice of

¹ Application Serial No. 77753000, filed June 5, 2009, and alleging April 29, 2009 as the date of first use anywhere and the date of first use in commerce. The application includes a disclaimer of the wording G-STRING INTERNATIONAL. The application includes the following description of the mark: "The mark consists of the stylized wording "MISS G-STRING INTERNATIONAL" with the wording "G-STRING" in yellow gold. The word "MISS" in white is above the word "G-STRING" and the word "INTERNATIONAL" in white is below "G-STRING". All of the wording is outlined in black. All of the words are superimposed on a woman's pink undergarment." The application also includes a statement that the colors white, yellow gold, pink and black are claimed as a feature of the mark.

opposition, opposer alleges grounds of deceptiveness and false suggestion of a connection under Trademark Act Section 2(a), 15 U.S.C. Section 1052(a), priority/likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), based on its previously used and registered mark MISS NUDE INTERNATIONAL in typed form for "entertainment services in the nature of promoting and conducting beauty pageants" in International Class 41,² and dilution of the MISS NUDE INTERNATIONAL mark under Trademark Act Section 43(c), 15 U.S.C. Section 1125(c). However, in the text of the notice of opposition, opposer has properly pleaded only a Section 2(d) claim.³ Accordingly, the Board

² Such mark is subject of Registration No. 2037202, which was issued on February 11, 1997 and has been renewed. The registration includes a disclaimer of NUDE INTERNATIONAL.

USPTO records indicate that Registration No. 2037202 was issued to Huggy Bear Productions, Inc. ("Huggy Bear"). A document dated February 10, 2003 and reflecting the assignment of such registration from Huggy Bear to Brava Enterprises, Inc. ("Brava"), effective as of March 6, 2000, is recorded with the USPTO's Assignment Branch at Reel 2774/Frame 0589. A document dated October 11, 2000 and reflecting the assignment of Registration No. 2037202 from Brava to Gracinda Cardoso ("Cardoso") is recorded with the Assignment Branch at Reel 2619/Frame 0495. A document dated May 17, 2001 and reflecting the assignment of such registration from Cardoso to R&D Promotions, Inc. ("R&D") is recorded with the Assignment Branch at Reel 2457/Frame 0887. Thus, when this proceeding was commenced on June 6, 2011, USPTO records identified R&D as the record owner of the Registration No. 2037202.

³ A claim of deceptiveness under Section 2(a) is based on allegedly false statements made in a mark and requires an allegation of facts that would establish that purchasers would be deceived in a way that would affect materially their decision to purchase applicant's goods. See *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1712 (TTAB 1993).

will treat the notice of opposition as alleging only a Section 2(d) claim.

Applicant, in the answer that it filed on July 19, 2011, denied the salient allegations of the notice of opposition. Applicant also set forth extensive "affirmative defenses" in which it raises various allegations concerning opposer's pleaded mark and pleaded registration.

On September 22, 2011, William Eadie ("Eadie"), a third party with the same address as applicant, recorded with the Assignment Branch at Reel 4627/Frame 0508 copies of (1) a default judgment order that was entered on April 1, 2005 by

A claim of false suggestion of a connection under Section 2(a) is derived from the right to privacy and requires an allegation of facts from which it may be inferred that the applicant's mark points uniquely to opposer, as an entity, i.e., that applicant's mark is opposer's identity or "persona;" that purchasers would assume that goods bearing applicant's mark are connected with opposer; and either that opposer's prior use of applicant's mark, or the equivalent thereof, as a designation of its identity or "persona," or an association of the same with opposer prior to applicant's. *Id.* at 1712-13. As set forth in the notice of opposition, opposer's Section 2(a) grounds are merely alternative means of raising its Section 2(d) claim.

A Section 2(d) claim requires allegations of either a registration for, or prior use of, a pleaded mark and likelihood of confusion between that pleaded mark and a defendant's involved mark. See Trademark Act Section 2(d); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). See also *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

A Section 43(c) dilution claim requires allegations that (1) opposer owns a famous and distinctive mark; (2) applicant's use of its mark began after opposer's mark became famous; and (3) applicant's use of its mark is likely to cause dilution of opposer's mark by blurring or by tarnishment. See *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1173-84 (TTAB 2001). Opposer has not alleged any of the elements of a dilution claim in the text of the notice of opposition.

Circuit Court for the Sixth Judicial Circuit in and for Pinellas County, Florida in a proceeding styled *Bell v. R&D Promotions, Inc. and Cardoso*, Case No. 04-7512-CI-11, and (2) an August 22, 2011 document reflecting the assignment of that judgment from Bell to Eadie.⁴

On September 27, 2011, opposer filed: (1) a document dated September 27, 2011, effective as of March 31, 2003, reflecting the assignment of various registrations including the pleaded registration from R&D Promotions, Inc. ("R&D") to Gracinda Cardoso ("Cardoso"); (2) a document dated September 27, 2011, effective as of May 6, 2009, reflecting the assignment of various registrations including the pleaded registration from Cardoso to opposer; and (3) receipts indicating recordation of such documents were with the USPTO's Assignment Branch.

On September 28, 2011, more than two months after the filing of applicant's answer, opposer filed a motion to strike applicant's denials of paragraphs 1 through 3 and 5 through 8 and affirmative defenses two through five from applicant's answer. Applicant filed a brief in response thereto. On October 28, 2011, applicant filed a motion to

⁴ The USPTO file for opposer's pleaded Registration No. 2037202 indicates that, on September 23, 2011, Eadie filed a request to amend the registration under Trademark Act Section 7, 15 U.S.C. Section 1057, to identify himself as the owner thereof and that the USPTO's Post-Registration Branch rejected that request in a November 10, 2011 Office Action because Eadie did not submit the appropriate fee. See Trademark Rule 2.6(a).

strike from USPTO records the assignment documents that opposer recorded and to take judicial notice that such documents are fraudulent. Applicant's motion to strike has been fully briefed.

Turning first to applicant's motion to strike the *nunc pro tunc* assignment documents that opposer filed on September 27, 2011 "from the record of the USPTO" and to "take judicial notice of the fraudulent assignments," applicant contends that, in view of such the judgment and assignment that Eadie recorded with the Assignment Branch, Eadie is the owner of Registration No. 2037202.⁵ Eadie must assert his ownership of Registration No. 2037202 by filing a petition under Trademark Act Section 18, 15 U.S.C. Section 1068, along with the appropriate filing fee, wherein he seeks to correct that registration to identify himself as the owner thereof. See *Chapman v. Mill Valley Cotton*, 17 USPQ2d 1815 (TTAB 1990); Trademark Rule 2.6(a); TBMP Section 309.03(d) (3d ed. 2011).

Regarding the merits of applicant's motion to strike, the Board is empowered only to determine the registrability of marks and may not order documents stricken from all USPTO

⁵ A review of the judgment at issue indicates that it is for financial damages only and does not expressly assign any intellectual property rights to Bell.

records.⁶ See TBMP Section 102.01. Moreover, “[o]nce an assignment or other document is recorded against an application or registration, the Assignment Services Branch will not remove the document from the records relating to that application or registration in the Assignment Database, even if the assignment or other document is subsequently found to be invalid.” TMEP Section 503.06(e) (8th ed. 2011).

Further, any determination as to whether or not such documents are fraudulent is a matter for resolution based on the evidence of record at trial, in deciding whether or not opposer has standing herein and whether or not opposer can rely upon the pleaded registration in support of its Section 2(d) claim. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000) (standing found based on ownership of a registration); *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989) (whether or not a party can prove allegations in a complaint is a matter for resolution at trial). Applicant's request that the Board take judicial

⁶ Recordation of an assignment document with the Assignment Branch is a ministerial act and is not a determination by the Office of the validity of the assignment document or the effect that document has on the title to the pleaded registration. Patent and Trademark Rule 3.54; TMEP Section 503.01 and 503.01(c).

notice that opposer's assignment documents are fraudulent is premature and will receive no consideration.⁷

Notwithstanding the foregoing, opposer's assignment documents, which opposer apparently intends to rely upon as evidence to establish that opposer has good chain of title to the pleaded registration, were prematurely filed during the discovery period, i.e., in advance of opposer's testimony period, and are therefore not properly before the Board.⁸ See TBMP Section 703.01(a). In view thereof, applicant's motion to strike is granted to the limited extent that the copies of opposer's assignment documents that opposer filed with the Board on September 27, 2011 will receive no consideration.⁹

Regarding opposer's motion to strike, that motion was untimely filed more than twenty-five days after applicant's answer. See TBMP Section 506.02 (3d ed. 2011).

⁷ The Board notes that parties regularly record *nunc pro tunc* assignment documents with the USPTO. Any determination regarding the alleged invalidity of opposer's assignment documents and/or the allegedly fraudulent execution and filing thereof would not be by way of judicial notice. See TBMP Section 704.12 and cases cited therein regarding the types of information of which the Board will and will not take judicial notice.

⁸ Opposer must make its assignment documents of record by introducing them into evidence through a testimony deposition during its testimony period. See Trademark Rule 2.123.

⁹ Opposer, however, is not precluded from seeking to properly make those documents of record during its testimony period.

Accordingly, the Board, in its discretion, declines to consider such motion.¹⁰

Nonetheless, the Board, in the interest of narrowing the issues herein, has reviewed applicant's answer. See Fed. R. Civ. P. 12(f) (the Board may review the pleadings "upon [its] own initiative at any time"). Applicant's denials of paragraphs 1 through 3 and 5 through 8 of the notice of opposition are in compliance with Fed. R. Civ. 8(b)(2).¹¹ Applicant's second through fifth affirmative defenses are amplifications of those denials which provide fuller notice of applicant's intended defense of the opposition.¹² See *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995); *Textron, Inc. v. Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973); TBMP Section 506.01. See also *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA

¹⁰ Under the Federal Rules of Civil Procedure, pleadings are intended to provide fair notice of the claims or defenses asserted. See *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999); *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988); TBMP Section 506.01. Matter will not be stricken unless it clearly has no bearing upon the issues in the case. See *id.*

¹¹ By denying those paragraphs, applicant is leaving the allegations set forth therein for opposer to prove at trial.

¹² As applicant's fourth affirmative defense, applicant alleges that opposer's pleaded mark is in typed form, while applicant's mark consists of wording in a specific stylization with a design element. However, a registration for a word mark in typed form, now known as a standard character form, encompasses any presentation of that word mark. See *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F3d 1344, 98 USPQ2d 1253, 1258 (Fed. Cir. 2011).

1973), regarding the relevant factors in determining likelihood of confusion. Whether or not opposer can establish the allegations set forth in the notice of opposition and whether or not applicant's intended arguments in defense of the opposition are persuasive are matters for resolution at trial. See *Flatley v. Trump, supra*.

Regarding applicant's sixth affirmative defense, however, applicant alleges that: (1) R&D, the record owner of pleaded Registration No. 2037202 when the notice of opposition was filed, was administratively dissolved on September 16, 2005 and was not reinstated (sixth affirmative defense, paragraph 10); (2) Registration No. 2037202 was renewed by R&D on April 16, 2007, notwithstanding its dissolution (sixth affirmative defense, paragraphs 11-14); (3) R&D abandoned the pleaded registered MISS NUDE INTERNATIONAL mark through its dissolution on September 16, 2005 (sixth affirmative defense, paragraph 15); (4) R&D cannot transfer the MISS NUDE INTERNATIONAL mark after its dissolution (sixth affirmative defense, paragraph 16); (5) opposer does not have standing to oppose because it was not formed until May 5, 2009, long after the dissolution of R&D, and therefore does not have a valid assignment of the MISS NUDE INTERNATIONAL mark; (6) because R&D abandoned the MISS NUDE INTERNATIONAL mark on September 16, 2005, any assignment of that mark to oppose is invalid (sixth

affirmative defense, paragraph 17); (7) opposer was administratively dissolved on September 24, 2010 and therefore was not a legal entity when it filed its three extensions of time to oppose and the notice of opposition (sixth affirmative defense, paragraphs 5 and 18); (8) opposer's attorney filed the notice of opposition "with malice of forethought by attesting to the invalid assignment of" the pleaded registration (sixth affirmative defense, paragraph 19); (9) applicant's first use of the involved MISS G-STRING INTERNATIONAL precedes opposer's use of MISS NUDE INTERNATIONAL (sixth affirmative defense, paragraphs 20-22); (10) opposer's attorney was suspended from the practice of law in the State of New Hampshire when opposer filed its extensions of time to oppose (sixth affirmative defense, paragraphs 23-26); and (11) opposer's third extension of time to oppose was improperly granted because it was filed (a) without either applicant's consent or a showing of extraordinary circumstances and (b) while opposer's attorney was suspended from the practice of law in the State of New Hampshire (paragraphs 27-31).

Applicant's arguments that opposer does not own the pleaded registration do not constitute attacks on the validity of that registration. Rather, those arguments are attacks on opposer's claim of ownership of that registration, which opposer must establish to rely upon that

registration at trial. See *Cunningham v. Laser Golf Corp.*, *supra*; *King Candy Co., Inc. v. Eunice King's Kitchen Inc.*, *supra*. As such, those arguments are relevant to opposer's assertion of standing to maintain this proceeding and as to whether opposer can rely upon that registration herein.

However, applicant's assertions that opposer's pleaded mark was abandoned¹³ and that R&D improperly renewed the registration for that mark after its dissolution¹⁴ are collateral attacks on the validity of opposer's pleaded Registration No. 2037202, which must be raised by way of a compulsory counterclaim. See Trademark Rules 2.106(b)(2)(i)

¹³ An abandonment claim requires an allegation of at least three consecutive years of nonuse or facts that show a period of nonuse less than three years coupled with an intent not to resume use. See Trademark Act Section 45, 15 U.S.C. Section 1127; *Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861 (TTAB 2007).

¹⁴ TMEP Section 1606.06 states as follows:

The Trademark Act and the Trademark Rules of Practice do not require that a renewal application be filed by the owner of the registration.

Therefore, if the renewal applicant is not the owner of record, the USPTO does not require that the renewal applicant show continuity of title from the original registrant before granting renewal.

However, registrations are renewed in the name of the party who is the owner of record of the registration, as shown in TRAM and TARR. The registration will be renewed in the name of a new owner only if the owner: (1) records an assignment or other document of title with the Assignment Services Branch; and (2) notifies the Post Registration staff at the time the renewal application is filed that the document has been recorded with the Assignment Services Branch.

(emphasis added).

and (ii) and 2.114(b)(2)(i) and (ii); TBMP Section 313. Because the pleaded registration was issued more than five years prior to the commencement of this proceeding, any counterclaim must be limited to the grounds set forth in Trademark Act Section 14(3), 15 U.S.C. Section 1064(3), i.e., claims of genericness, functionality, abandonment, fraud, and misrepresentation of source, or claims under Trademark Act Sections 2(a), (b), and (c), 15 U.S.C. Section 1052(a), (b), and (c). See *Arman's Systems, Inc. v. Armand's Subway, Inc.*, 215 USPQ 1048, 1050 (TTAB 1982). If applicant wants to assert nonownership of the pleaded registration on the ground that the registered mark was abandoned prior to its assignment to opposer, such assertion must be raised in a compulsory counterclaim.

So long as opposer makes of record at trial a copy of the pleaded registration showing current title and status thereof, applicant's assertion that its use of its involved mark precedes opposer's renewed use of the pleaded mark becomes relevant only if the pleaded registration is cancelled in a counterclaim. See Trademark Act Section 2(d); Trademark Rules 2.6(b) and 2.122(d)(1); *King Candy Co., Inc. v. Eunice King's Kitchen Inc., supra* (Section 2(d) requires either prior use or ownership of a registration); *Linville v. Rivard*, 26 USPQ2d 1508, 1513 (TTAB 1993), *rev'd*, *Rivard v. Linville*, 31 USPQ2d 1218 (Fed. Cir. 1993)

(readoption of a mark following abandonment creates a new first use).

Regarding applicant's allegation that opposer's attorney filed the notice of opposition "with malice of forethought," such allegation appears intended as an affirmative defense of unclean hands, based on opposer's claim of ownership of the pleaded registration in contradiction of USPTO records, which indicated at the time the notice of opposition was filed that R&D was the record owner of that registration. Although oppose must establish chain of title of the pleaded registration to rely upon at trial herein, opposer was not required to have recorded documentation establishing chain of title to the pleaded registration prior to filing the notice of opposition. See *Cunningham v. Laser Golf Corp., supra; Stagecoach Properties, Inc. v. Wells Fargo & Co.*, 199 USPQ 341, 347 (TTAB 1978).

Regarding applicant's assertion that opposer was administrative dissolved on September 24, 2010 and therefore was not a legal entity when it filed the requests to extend time to oppose and the notice of opposition, the Board notes that applicant, in support of its motion to strike, admits opposer was reinstated on September 26, 2011 and provides a copy of online records of the Secretary of State of the State of Florida showing such reinstatement. The

reinstatement "relates back to and takes effect as of the effective date of the administrative dissolution and the limited liability company resumes carrying on its business as if the administrative dissolution had never occurred." Fla. Stat Section 608.4482(3) (2011).

Regarding applicant's assertion that opposer's requests to extend time to oppose are invalid because they were filed by opposer's attorney while he was suspended from the practice of law in the State of New Hampshire, the Board notes that the letterhead of opposer's attorney on which opposer's attorney, in his capacity as attorney for nonparty R&D, sent a May 13, 2009 letter to applicant's former attorney, which applicant included as an exhibit to its motion to strike, indicates that opposer's attorney is also licensed to practice law in the State of New York. Opposer's attorney need only be in good standing in any state to appear before the Office. See Trademark Rule 2.17; Patent and Trademark Rules 11.1 and 11.14(a). Unless applicant is alleging that opposer's attorney is not an attorney in good standing in any state, that attorney's suspension in the State of New Hampshire is irrelevant herein.

Applicant's assertion that opposer's third request to extend time to oppose required applicant's consent is incorrect. Opposer could have based its third request to

extend time to oppose on either applicant's consent or a showing of extraordinary circumstances. See Trademark Rule 2.102(c)(3). Applicant's assertion regarding opposer's showing of extraordinary circumstances in its third request to extend time to oppose should have been raised by not later than the filing of applicant's answer. See Fed. R. Civ. P. 12(b); TBMP Section 211. By failing to timely raise such assertion, applicant has waived any objection to the Board's granting of the third extension of time to oppose.

Because applicant has interwoven several arguments, only some of which are properly before the Board, into its sixth affirmative defense, the Board, in exercising its inherent authority to control the conduct of its proceedings, finds that such defense should be repleaded. Applicant is allowed until twenty days from the mailing date set forth in this order to file an amended answer in which it repleads its sixth affirmative defense, limiting its arguments in accordance with the foregoing, failing which the Board will *sua sponte* strike the sixth affirmative defense from applicant's answer.¹⁵ See Fed. R. Civ. P.

¹⁵ The parties are reminded that, under Patent and Trademark Rule 11.18(b),

[b]y presenting to the Office ... any paper, the party presenting such paper ... is certifying that ... [t]o the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, ... [t]he paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the

12(f); TBMP Section 506.01. If applicant wants to seek to add a counterclaim, it must file a motion for leave to amend its answer to add a counterclaim, along with the required fee for a petition to cancel.¹⁶ See Fed. R. Civ. P. 13(a) and 15(a); Trademark Rules 2.6(a) and 2.107(a).

The parties' premature arguments and submissions herein suggest that the parties may want to pursue Accelerated Case Resolution (ACR) after the pleadings herein are clarified. Information concerning the Board's ACR procedure is available online at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. If the parties wish to pursue ACR, they should inform the Board as soon as possible.

Proceedings herein otherwise remain suspended.

cost of any proceeding before the Office; ... [and t]he allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery.

See also Fed. R. Civ. P. 11(b); TBMP Section 527.02.

¹⁶ Contrary to opposer's assertion, applicant's failure to include a compulsory counterclaim to cancel the pleaded registration in its answer does not necessarily constitute a waiver of any compulsory counterclaim. See Fed. R. Civ. P. 13 and 15(a); *See's Candy Shops Inc. v. Campbell Soup Co.*, 12 USPQ2d 1395 (TTAB 1989). The Board notes, however, that Federal Rule of Civil Procedures 13(f), upon which *See's Candy* is in large part based, was subsequently abrogated.

On the other hand, the filing of a motion for leave to amend the answer to add a counterclaim, along with the required filing fee, will not necessarily result in the institution of the counterclaim.