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

Baxley

Mailed: June 29, 2013

Opposition No. **91200183**

The Worlds Pageants, LLC and
Camila Productions Ltd.
(joined as party plaintiff)

v.

Miss G-String International
LLC

Cancellation No. 92055838

William Eadie

v.

The Worlds Pageants, LLC and
Camila Productions Ltd.
(joined as party defendant)

By the Trademark Trial and Appeal Board:

In the above-captioned opposition proceeding, the Worlds Pageants, LLC ("Worlds") filed a notice of opposition to registration of Miss G-String International LLC's ("G-String") 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] on the ground of 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]

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[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 work '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.

[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, was recorded on January 7, 2004, 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") was recorded on November 13, 2002, 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") was recorded on February 22, 2002, with the Assignment Branch at Reel 2457/Frame 0887. Thus, when the opposition proceeding was commenced on June 6, 2011, USPTO records identified R&D as the record owner of the Registration No. 2037202.

Following the commencement of the opposition proceeding, a document dated September 27, 2011, and reflecting the assignment of such registration from R&D to Cardoso, effective March 31, 2003, was recorded on September 27, 2011, with the Assignment Branch at Reel 4631/Frame 0418.

A document dated September 27, 2011, and reflecting the assignment of Registration No. 2037202 from Cardoso to Worlds,

In a June 21, 2012, order, as modified by a June 26, 2012, order, the Board, among other things, granted G-String's motion to strike *nunc pro tunc* assignment documents that Worlds filed on September 27, 2011, "from the record of the USPTO" to the limited extent that it struck such documents from the record of this proceeding on the ground that they were prematurely filed during the discovery period, i.e., in advance of opposer's testimony period, and are therefore not properly before the Board.[3] The Board,

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effective May 6, 2009, was recorded on September 27, 2011, with the Assignment Branch at Reel 4631/Frame 0436.

A document dated September 19, 2012, and reflecting the assignment of such registration from Worlds to Camila Productions Ltd. ("Camila") was recorded on December 13, 2012, with the Assignment Branch at Reel 4918/Frame 0559.

In addition, on September 22, 2011, William Eadie ("Eadie"), who is identified in a motion for summary judgment that G-String filed on June 14, 2013, as G-String's managing member, recorded with the Assignment Branch at Reel 4627/Frame 0508 copies of (1) a default judgment order for monetary damages that was entered on April 1, 2005, by 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.

[3] The Board noted that it is not empowered to order documents stricken from all USPTO records and that, once recorded, the USPTO's Assignment Services Branch will not remove a document from its records, even where that document is later found to be invalid.

G-String also asked the Board to "take judicial notice of the fraudulent assignments," and contended that, in view of the judgment and assignment that Eadie recorded with the Assignment Branch, Eadie is the owner of Worlds' pleaded Registration No. 2037202. The Board, noting that any determination as to whether or not Worlds' September 27, 2011, assignment documents are fraudulent is a matter for resolution based on the evidence of record at trial, declined to consider G-String's request to take judicial notice that those documents are fraudulent.

The Board also indicated that 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

however, indicated that Worlds was not precluded from introducing the stricken documents as evidence during its testimony period. The Board also reviewed G-String's answer and, in view of noted deficiencies, allowed G-String time to file an amended answer.

On July 10, 2012, G-String filed an amended answer in the opposition proceeding, and Eadie filed a petition under Trademark Act Section 18, 15 U.S.C. Section 1068, to correct Registration Nos. 2037202 and 3039826 to identify Eadie as the owner thereof,[4] which was instituted on July 12, 2012, as the above-captioned cancellation proceeding.[5]

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registration to identify himself as the owner thereof. However, the Board noted that the judgment at issue was entered against R&D and Cardoso for monetary damages only; that judgment does not expressly assign any intellectual property rights.

[4] Such registration, for the mark MISS NUDE WORLD in typed form for "[e]ntertainment services in the nature of promoting and conducting beauty pageants" in International Class 41, was issued to R&D on January 10, 2006, and alleges June 1964 as the date of first use anywhere and June 1987 as the date of first use in commerce. Section 8 affidavit accepted, Section 15 affidavit acknowledged.

A document dated September 27, 2011, and reflecting the assignment of such registration from R&D to Cardoso, effective March 31, 2003, was recorded on September 27, 2011, with the Assignment Branch at Reel 4631/Frame 0418.

A document dated September 27, 2011, and reflecting the assignment of Registration No. 2037202 from Cardoso to Worlds, effective May 6, 2009, was recorded on September 27, 2011, with the Assignment Branch at Reel 4631/Frame 0436.

A document dated September 19, 2012, and reflecting the assignment of such registration from Worlds to Camila was recorded on December 13, 2012, with the Assignment Branch at Reel 4918/Frame 0559.

In addition, on September 23, 2011, Eadie recorded with the Assignment Branch at Reel 4629/Frame 0425 copies of (1) a default judgment order that was entered on April 1, 2005 by 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

In lieu of an answer in the cancellation proceeding, Worlds, on August 21, 2012, filed a motion to dismiss the petition to cancel under Fed. R. Civ. P. 12(b)(6). In an August 24, 2012 order, the Board consolidated the above-captioned proceedings and suspended proceedings pending the Board's decision on the motion to dismiss. In the August 24, 2012 order, the Board stated that "[a]ny submission filed during the pendency of [the motion to dismiss] which is not germane thereto will receive no consideration." On September 4, 2012, Eadie filed a brief in response to the motion to dismiss, an amended petition to cancel, and a second amended petition to cancel.

Notwithstanding the plain language of the August 24, 2012 suspension order, Eadie, on January 15, 2013, filed a motion to strike assignment documents that Worlds recorded with the USPTO's Assignment Branch on December 13, 2012. Following full briefing of that motion, Eadie, on June 14, 2013, filed withdrawals of second amended petition to cancel in the cancellation proceeding and the motion to strike, and G-String filed a motion for summary judgment in the

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document reflecting the assignment of that judgment from Bell to Eadie.

[5] On September 6, 2012, Eadie filed a notice of ineffective service, wherein he indicated that the complaint was returned by the United States Postal Service. However, in view of the filing of Worlds' motion to dismiss, it is clear that Worlds had notice of the cancellation proceeding, and any issues regarding service of the complaint are therefore moot.

opposition. In view of Eadie's withdrawal of the motion to strike, that motion will receive no consideration.

Nonetheless, as the Board noted in the June 21, 2012, order, the Board has no authority to order documents stricken from Assignment Branch records. "[O]nce an assignment or other document is recorded against an application or registration, the [Assignment 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) (April 2013). Moreover, recordation of an assignment document with the Assignment Branch is a ministerial act and is not a determination by the USPTO of the validity of the assignment document or the effect that document has on the title to an application or registration. Patent and Trademark Rule 3.54; TMEP Section 503.01 and 503.01(c). Based on the foregoing, the Board, in exercising its inherent authority to control the conduct of cases on its docket, will not entertain any further motions to strike documents from Assignment Branch records in these consolidated proceedings.

Worlds incorporated a motion for sanctions under Fed. R. Civ. P. 11(b) into its brief in response to Eadie's motion to strike because that motion to strike was filed in contravention of the August 24, 2012, suspension order. However, the motion for sanctions was not filed as a

separate submission and was not filed in compliance with the safe harbor provision of Fed. R. Civ. P. 11(c)(2). Accordingly, Worlds' motion for sanctions will receive no consideration.

In addition, G-String's motion for summary judgment was filed in contravention of the August 24, 2012, order. Accordingly, the motion for summary judgment will receive no consideration.[6]

In view of the recordation with the USPTO's Assignment Branch of a document reflecting the assignment of the Registration Nos. 2037202 and 3039826 during the pendency of the above-captioned proceedings, as discussed *supra* in footnotes 2 and 4, Camila is hereby joined as a party

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[6] In any event, a cursory review of G-String's motion for summary judgment indicates that G-String failed to meet its initial burden of establishing that there is no genuine dispute as to any material fact and that it is entitled to entry of judgment as a matter of law on the Section 2(d) claim in the opposition proceeding. See Fed. R. Civ. P. 56(a). G-String's evidence in support of its assertion that there is no likelihood of confusion between the marks at issue consists of a search report from the USPTO's Trademark Electronic Search System (TESS) of currently registered and applied for marks that include the words MISS and INTERNATIONAL. Trademark search reports are not credible evidence of the third-party uses or of the registrations listed therein. *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1232 (TTAB 1992); *Burns Philip Food Inc. v. Modern Products Inc.*, 24 USPQ2d 1157, 1159 n. 3 (TTAB 1992), *aff'd unpublished*, 28 USPQ2d 1687 (Fed. Cir. 1993). Accordingly, the search report is not entitled to any probative value. *Centraz Industries Inc. v. Spartan Chemical Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006).

Moreover, even if the Board assumes that opposers in the opposition cannot establish ownership of its pleaded registration, as alleged by G-String, opposers would not be precluded from relying upon any existing common law rights in the MISS NUDE INTERNATIONAL mark in support of the pleaded Section 2(d) claim. See Trademark Act Section 2(d), 15 U.S.C. Section 1052(d); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

plaintiff in the opposition and as a party defendant in the cancellation proceeding. See Patent and Trademark Rule 3.73(b); TBMP Section 512.01 (3d ed. rev.2 2013).

The Board now turns to Worlds' motion to dismiss for failure to state a claim upon which relief can be granted under Fed. R. Civ. P. 12(b)(6). In timely response to the motion to dismiss, Eadie filed an amended petition to cancel and a second amended petition to cancel. See Fed. R. Civ. P. 15(a)(1)(B). In view of Eadie's withdrawal of the second amended petition to cancel, the second amended petition to cancel will receive no consideration. The amended petition to cancel is accepted as the operative complaint in the cancellation proceeding. See *id*.

Although the motion to dismiss is based on the original petition to cancel, the Board, will decide the motion to dismiss based on the amended petition to cancel. See TBMP Section 503.03. To set forth a legally sufficient complaint, Eadie need only allege sufficient factual matter as would, if proved, establish that (1) he has standing to maintain the proceeding, and (2) a valid ground exists for the relief requested. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Specifically, "a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face." *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937, 1949-50 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). In the context of

inter partes proceedings before the Board, a claim has facial plausibility when the plaintiff pleads factual content that allows the Board to draw a reasonable inference that plaintiff has standing and that a valid ground for the opposition or cancellation exists. Cf. *Twombly*, 550 U.S. at 556, 127 S.Ct. at 1955. In particular, a plaintiff need only allege "enough factual matter ... to suggest that [a claim is plausible]" and "raise a right to relief above the speculative level." *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346, 1354 (Fed. Cir. 2010).

Any person who believes he is or will be damaged by registration of a mark has standing to file a complaint. See Trademark Rule 2.111(b). At the pleading stage, all that is required is that a plaintiff allege facts sufficient to show a real interest in the proceeding, and a reasonable basis for his belief that he would suffer some kind of damage if the mark is registered. See TBMP Section 309.03(b).

The cancellation proceeding is analogous to a counterclaim in the opposition proceeding. However, even if Eadie is G-String's managing member, as he alleges in a declaration in support of G-String's motion for summary judgment, he and G-String are separate legal entities. As defendant in the opposition proceeding, G-String would have standing to assert such a counterclaim. See *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1293 (TTAB 1999).

However, Eadie, a nonparty to the opposition, must allege in the amended petition to cancel facts sufficient to show a real interest in the proceeding, and a reasonable basis for his belief that he would suffer some kind of damage if the mark is registered. Eadie adequately pleaded his standing in paragraphs 10-13 of the amended petition by alleging that he has asserted ownership interests in Registration Nos. 2037202 and 3039826.[7]

Regarding Eadie's pleaded fraud claim, such a claim requires allegations of a specific false statement of material fact made in obtaining or maintaining the involved registrations with the intent to deceive the USPTO into issuing or maintain that registration.[8] See *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009). In the amended Eadie has sufficiently alleged that Worlds and its predecessors-in-interest, R&D and Cardoso, committed fraud in paragraphs 6-9, 14-15, 19-20, 25-40 of the amended petition to cancel by "falsely claim[ing] ownership of

[7] In the amended petition to cancel, Eadie alleges that Worlds does not have standing in the opposition. However, Eadie is not a party to the opposition proceeding and therefore may not plead allegations in connection therewith.

[8] There is no fraud if a false misrepresentation is occasioned by an honest misunderstanding or inadvertence without a willful intent to deceive. *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981). Unless a party alleging fraud can point to clear and convincing evidence that supports drawing an inference of deceptive intent, it will not be entitled to judgment on a fraud claim. *In re Bose Corp., supra* at 1942. Any doubt must be resolved against the party making a claim of fraud. *Id.* at 1939.

trademarks not owned by the assignors" and preparing, executing, and filing with the USPTO on September 27, 2011, two fraudulent assignment documents of Registration Nos. 2037202 and 3039826, one from R&D to Cardoso and the other from Cardoso to Worlds, "with malicious intent to defraud the USPTO."[9]

However, in the prayer for relief of the amended petition, Eadie is asking the Board to assign the involved registrations to him. As noted *supra* and in the June 21, 2012 order, the judgment that Eadie purchased from Bell calls for monetary damages only from R&D and Cardoso; that judgment does not expressly transfer any intellectual property rights. Eadie is essentially asking the Board to assign him Registration Nos. 2037202 and 3039826 in lieu of the monetary damages called for in the judgment at issue as a means of enforcing that judgment for monetary damages. The Board is an administrative tribunal of limited

[9] Contrary to Eadie's assertion, Worlds was not required to establish that it is the record owner of Registration No. 2037202 when it filed the notice of opposition. Proof of claims asserted in an opposition proceeding is a matter for resolution on the merits at trial. See Trademark Rule 2.122(d)(2); *Flatley v. Trump,* 11 USPQ2d 1284 (TTAB 1989); TBMP Section 704.03. Moreover, as noted *supra*, even if opposers cannot establish ownership of pleaded Registration No. 2037202 in the opposition, they could rely on common law rights in the MISS NUDE INTERNATIONAL mark in that case to establish both standing and priority.

Further, Eadie has cited to no authority, nor is the Board aware of any authority, for his assertions that it was necessary for Worlds to obtain a "court order" to file a nunc pro tunc assignment document with the USPTO or that such assignment documents must be notarized.

jurisdiction that lacks jurisdiction to enforce a judgment for monetary damages. See generally *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477 (Fed. Cir. 1990) (Board's function is to determine whether there is a right to secure or to maintain a registration); *Luehrmann v. Kwik Kopy Corp.*, 2 USPQ2d 1303 (TTAB 1987) (Board has no authority to award fees, costs or monetary damages).

The present circumstances differ from those in *Chapman v. Mill Valley Cotton,* 17 USPQ 1414 (TTAB 1990), to which the Board referred in the June 21, 2012, order. *Chapman* involved an ownership dispute between related parties, whereas these proceedings involve a dispute between unrelated parties. In *Chapman*, a party to a joint venture opposed registration of the joint venture's application to register a mark on the ground that the opposer, and not the joint venture, owned the mark at issue and that the other party to the joint venture was not authorized to execute or file the application at issue. In view of document in which the other party's rights in the mark were assigned to the opposer, the Board ordered the application be amended to show the opposer as the applicant and that the registration issue in her name.

Moreover, a trademark registration is not a chattel which can be transferred in gross apart from the good will of the business in which the mark is used, or with that part

of the good will of the business connected with the use of and symbolized by the mark. See Trademark Act Section 10(a)(1), 15 U.S.C. Section 1060(a); *VISA, U.S.A., Inc. v. Birmingham Trust National Bank*, 696 F.2d 1371, 1375, 216 USPQ 649, 651 (Fed. Cir. 1982).

In any event, a finding a fraud could not result in title in the registration being transferred to Eadie, as Eadie has requested in his prayer for relief. If fraud can be shown in the procurement or maintenance of a registration, that registration is void in the international class or classes in which fraud has been committed and would be cancelled in such international class or classes. See *Herbaceuticals Inc. v. Xel Herbaceuticals Inc.,* 86 USPQ2d 1572, 1577 (TTAB 2008).

Because the Board lacks authority to grant the relief sought by way of the amended petition to cancel, the motion to dismiss under Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief can be granted is hereby granted. In keeping with Board practice, Eadie is allowed until twenty days from the mailing date set forth in this order to file a third amended petition, in accordance with the foregoing, failing which the cancellation proceeding will be dismissed with prejudice. Proceedings herein otherwise remain suspended.

Eadie is reminded that, under 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 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.

Accordingly, unless Eadie knows of facts that support each claim he intends to raise herein or has a good faith belief that evidence showing the factual basis for those claims is likely to be obtained after a reasonable opportunity for discovery or investigation, he should not plead those claims.