

This Opinion is not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Christian Lacroix
v.
Christian Lacroix, Snc

Opposition No. 91201563
Opposition No. 91202642

Anthony M. Verna III of Verna Law Firm, P.C.,
for Christian Lacroix.

Gabriel Goisman of Coffey Burlington, P.L.
For Christian Lacroix, Snc.

Before Cataldo, Bergsman and Wellington,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Christian Lacroix, Snc (“Applicant”) seeks registration on the Principal Register of the mark CHRISTIAN LACROIX (in standard characters) for the goods set forth below:

Cutlery, namely, knives, forks and spoons; nutcrackers not of precious metal; shears and scissors, in Class 8;¹

¹ Application Serial No. 85177445 (Opposition No. 91201563) was filed on November 16, 2010, under Section 44(d) of the Trademark Act, 15 U.S.C. § 1126(d), on claim of priority based on European Community trademark application number 009481003, filed on October 29, 2010.

Articles made of precious metals, their alloys or plated therewith, namely, ornamental objects, namely, ornamental pins, ornamental lapel pins, ornaments of precious metal in the nature of jewelry and jewelry boxes; jewelry; costume jewelry, namely, rings, key-rings, finger rings, buckles for watch straps, earrings, cuff links, bracelets, charms, brooches, necklaces, tie pins, medallions; timepieces and chronometric instruments, namely, watchbands, watches, wristwatches, clocks, small clocks, alarm clocks, cases and caskets for timepieces, in Class 14;

Buckles for clothing; buckles of precious metal; belt buckles, in Class 26; and

Articles made of precious metals, their alloys or plated therewith, namely, ashtrays, cigar cases, cigarette cases, cigar holders, cigarette holders, in Class 34.²

Both applications include the statement that “[t]he name(s), portrait(s), and/or signature(s) in the mark identifies christian lacroix, whose consent(s) to register is made of record.” Those statements are supported by two consents to use and register signed by Christian Lacroix filed with the applications. The first signed consent, dated April 21, 1987, identifies Classes 3, 9, 14, 18, 24 and 25 (even though Applicant is seeking to register its mark in Classes 8, 14, 26, and 34). It includes a USPTO date stamp of May 21, 1987 in the upper left-hand corner. The second signed consent, dated December 26, 1995, states that Christian Lacroix consents to the use and

Applicant stated in its application that it intends to rely on Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e) as the basis for registration.

² Application Serial No. 85177446 (Opposition No. 91202642) was filed on November 16, 2010, under Section 44(d) of the Trademark Act, 15 U.S.C. § 1126(d), on claim of priority based on European Community trademark application number 009481003, filed on October 29, 2010. Applicant stated in its application that it intends to rely on Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e) as the basis for registration.

registration of his name as a trademark “on goods in the classes identified in the attached application.”

In both applications, Applicant claimed ownership of the following registrations:³

- Registration No. 1499154 for the mark CHRISTIAN LACROIX (typed drawing form) for “perfumery,” in Class 3; “*jewelry; costume jewelry*,” in Class 14; “handbags; wallets; purses,” in Class 18; and “clothing for use by men, women and children, namely, ascots, babushkas, bandanas, bathing suits, bathrobes, blazers, blouses, blousons, body suits, boleros, boots, boxer shorts, brassieres, caftans, camisoles, capes, caps, cardigans, chemises, clogs, fur coats, over coats, sport coats, suit coats, top coats, corselets, culottes, dresses, girdles, gloves, halter tops, hats, head bands, hosiery, jackets, jeans, jumpers, jump suits, kerchiefs, leggings, leotards, loungewear, mittens, moccasins, mufflers, neckerchiefs, neckties, neckwear, overalls, overcoats, panties, pants, pantsuits, panty hose, parkas, peignoirs, playsuits, pocket squares, ponchos, pullovers, raincoats, sandals, scarves, shawls, knit shirts, undershirts, stockings, stoles, bathing suits, suits, suspenders, sweat shirts, sweaters, t-shirts, trousers, tuxedos, underpants, vests, vested suits,” in Class 25.⁴

- Registration No. 2896646 for the mark CHRISTIAN LACROIX (typed drawing form) for numerous goods in Classes 8, 14, and 21.⁵

- Registration No. 3547594 for the mark CHRISTIAN LACROIX (standard character form) for “towels, upholstery fabrics,” in Class 24.⁶

All three registrations include a statement that CHRISTIAN LACROIX identifies an individual whose consent is of record and thus, where the goods overlap with those in the Applications, the Examining Attorney may have presumed consent was of record.

See TMEP §§ 813 and 1206.04(c) (January 2017).⁷

³ The highlighted goods (*i.e.*, jewelry and costume jewelry) overlap with the goods in Application Serial No. 85177446.

⁴ Registered August 9, 1988; renewed.

⁵ Registered October 26, 2004; cancelled May 27, 2011.

⁶ Registered December 16, 2008; Section 8 affidavit accepted.

⁷ TMEP § 813 provides, in pertinent part, that “[i]f a consent to register is already part of the record in the file of a valid registration for a mark comprised in whole or in part of the same name, portrait, or signature for the same goods or services, the applicant may satisfy the requirement for a consent statement by claiming ownership of the registration and advising

Christian Lacroix (“Opposer”) opposes the applications on the ground of fraud. Specifically, Opposer alleges that when Applicant filed its applications, Applicant knew that Opposer did not consent to the registration of the CHRISTIAN LACROIX trademark for the goods identified in those applications, and that Applicant submitted the consents to use and register with the intent to deceive the USPTO.

Applicant, in its Answer, denies the salient allegations in the Notices of Opposition.

In an order dated July 31, 2012, the Board consolidated the oppositions.

I. Evidentiary Issues

A. The April 18, 2007 Consent to Use and Register.

In application Serial No. 85177446 (Opposition No. 91202642), Applicant filed a Post-Publication Amendment submitting a “General Consent” purportedly signed by Opposer and dated April 18, 2007.⁸ The consent reads as follows:

The undersigned, Christian Lacroix, consents to the use and registration of any trademarks including the terms <<CHRISTIAN LACROIX>>, already filed, or which will be filed in the future in the name of CHRISTIAN LACROIX, Société en Nom Collectif, having its principal place of business at 73, rue du Fauborg Saint-Honoré, 75008 PARIS, FRANCE.

In Opposition No. 91202642, Opposer alleged that his signature on the April 18, 2007 consent is a forgery, that Applicant knew that Opposer’s signature is a forgery,

the examining attorney that the consent is of record therein.” TMEP § 1206.04(c) is substantially the same. We note that Applicant did not advise the Examining Attorney that the consent is of record in its prior registrations.

⁸ September 26, 2011 Post-Publication Amendment.

and that Applicant made a material misrepresentation of fact by filing a consent to register that it knew to be false.⁹

To prove that the April 18, 2007 consent is a forgery, Opposer introduced two expert reports into the record through his testimony deposition on written questions.¹⁰ The expertise of the purported experts are in handwriting assessment. Applicant objected to the admissibility of the documents as hearsay.¹¹ Subsequently, on February 18, 2015, Applicant filed a “Statement of Objections to Opposer’s Evidence”¹² and renewed the objection in its brief.¹³

We need not resolve this evidentiary dispute for the reason discussed below. Suffice it to say that because the consent with the purportedly fraudulent signature was filed after the application was published for opposition, it played no role in the Trademark Examining Attorney’s review of the application and, therefore, it was not a material misrepresentation of fact on which the USPTO relied¹⁴ in approving the

⁹ Notice of Opposition ¶¶11-16 (Opposition No. 91202642) (1 TTABVUE 6-7).

¹⁰ Expert report of Annick Icart (41 TTABVUE 305-331 and 354-380) and the expert report of Suzanne Schmitt (41 TTABVUE 332-353 and 381-401). The reports were improperly designated as confidential but that designation appears to be improper. There is nothing in the record to indicate that the information contained therein is commercially sensitive, a trade secret, or personally private information. Accordingly, we will treat the reports as documents available to the public. *See Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014) (the Board will not be bound by improper confidentiality designations); Trademark Rule 2.116(g) (was amended effective January 14, 2017 to codify the Board’s practice of treating as public material that cannot reasonably be considered confidential).

¹¹ Christian Lacroix testimony deposition on written questions, p. 13 (42 TTABVUE 17).

¹² 54 TTABVUE.

¹³ Applicant’s Brief, p. 9-14 (90 TTABVUE 10-13).

¹⁴ The elements for proving fraud are discussed *infra*.

application for publication. In view thereof, the September 26, 2011 Post-Publication Amendment comprising the April 18, 2007 consent and any testimony or evidence regarding that consent will be given no consideration.

B. The judgment rendered by the Tribunal de Grand Instance de Paris on January 10, 2014.

In his testimonial deposition upon written questions, Opposer testified that “a judgment was rendered by the Tribunal de Grand Instance de Paris on January 10, 2014, stipulating that in keeping with the contract of 2005, any trademark filing containing my name must be expressly approved by me.”¹⁵ Opposer did not introduce a copy of that judgment.

In his testimonial deposition taken by Applicant, Opposer, on cross-examination, again testified about the January 10, 2014 judgment of the Tribunal de Grand Instance de Paris purportedly nullifying the February 3, 1987 Trademark Sale Agreement between Opposer and Applicant.¹⁶ This time Opposer introduced what is purported to be an English translation of that document.¹⁷ The January 10, 2014 judgment of the Tribunal de Grand Instance de Paris is on appeal.¹⁸

¹⁵ Opposer’s testimony deposition on written questions, pp. 49-50 (42 TTABVUE 53-54). Applicant lodged an objection on the ground that it is a leading question, the question lacks a predicate, and the question mischaracterizes the document. *Id.* at p. 13 (42 TTABVUE 17).

¹⁶ Opposer’s testimony deposition taken by Applicant, pp. 97-100 (73 TTABVUE 102-105).

¹⁷ Opposer’s testimony deposition taken by Applicant, Opposer’s Exhibit 1 (73 TTABVUE 241). Applicant objected to the testimony and exhibit on the grounds that it is outside the scope of the direct examination, there is no indication that the document was translated by a certified translator, and that the testimony is outside the knowledge of the witness. Opposer’s testimony deposition taken by Applicant, pp. 98-99 (73 TTABVUE 103-104). Applicant renewed its objection in its brief. Applicant’s Brief, p. 15 (90 TTABVUE 16). Opposer did not respond to Applicant’s objection in its reply brief.

¹⁸ Opposer’s testimony deposition taken by Applicant, p. 100 (73 TTABVUE 105).

Opposer does not refer to the January 10, 2014 judgment of the Tribunal de Grand Instance de Paris in its brief or otherwise explain how it is relevant to the fraud claims at issue in these oppositions.¹⁹ Moreover, neither party has requested suspension of these proceedings pending the outcome of the Paris litigation.

The only claim before us is whether Applicant committed fraud on the USPTO during the prosecution of the applications at issue by submitting consents to use and register to which Opposer did not consent. Even assuming that the January 10, 2014 judgment of the Tribunal de Grand Instances de Paris is admissible, it is not relevant to the fraud claim before us because, at the very least, the judgment was rendered after the filing date of the applications and after the applications were published for

¹⁹ Opposer, in its brief, argues that the ownership of the CHRISTIAN LACROIX trademark has reverted to Opposer.

On or about June 2, 2009, in conjunction with a Paris court-supervised business reorganization of Applicant's business, a bankruptcy trustee was appointed. Karczewski Decl., Exh. K.

Because of the reorganization and bankruptcy, the relationship between the parties was terminated. Thus, as a result of the termination of the parties' 2005 Services Agreement on September 7, 2009 due to Applicant's receivership proceedings, Christian Lacroix, through his sole proprietorship, XCLV, is the owner of the CHRISTIAN LACROIX trademarks.

Opposer's Brief, pp. 12-13 (83 TTABVUE 13-14).

This argument does not relate to the fraud claim before us. It is akin to an argument that the applications are void *ab initio* because Applicant is not the owner of the CHRISTIAN LACROIX trademark. Such a claim was not pleaded and it was not tried by implied consent.

Likewise, Opposer's argument in its brief that it had the final say in quality control (Opposer's Brief, pp. 21-23 (83 TTABVUE 22-24)) is akin to an argument that Applicant is not the owner of the CHRISTIAN LACROIX marks and, as indicated above, that claim was not pleaded, nor was it tried by implied consent.

opposition. As such, the judgment cannot be material misrepresentation of fact because it cannot have been considered by the USPTO in approving the applications for publication.

In view of the foregoing, the January 10, 2014 judgment of the Tribunal de Grand Instances de Paris is given no consideration.

II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application files.

A. Opposer's testimony and evidence.

1. Opposer's notice of reliance on the following items:²⁰

- a. Applicant's responses to Opposer's first set of interrogatories;²¹
- b. Applicant's supplemental responses to Opposer's first set of interrogatories;²²
- c. Applicant's supplemental responses to Opposer's second set of interrogatories;²³
- d. Applicant's responses to Opposer's first set of requests for admission;²⁴
- e. Select documents that Applicant produced in response to Opposer's first set of requests for production of documents;²⁵

²⁰ 36 TTABVUE. Documents designated as confidential are filed in 35 TTABVUE.

²¹ 36 TTABVUE 8-29.

²² 36 TTABVUE 369-396.

²³ 36 TTABVUE 560-569.

²⁴ 36 TTABVUE 398-415.

²⁵ 36 TTABVUE 30-272. In response to Opposer's request for admission No. 29, Applicant authenticated the documents it produced in response to Opposer's request for production of documents.

- f. Applicant's amended initial disclosures;²⁶
 - g. Opposer's opposition to Applicant's motion for summary judgment and the Karczewski declaration in support thereof and the Board's decision denying Applicant's motion for summary judgment;²⁷ and
 - h. Internet printout of the Schiaparelli Fall 2013 Couture Collection from the Style.com website;²⁸
- 2. The testimony deposition of Opposer on written questions with attached exhibits;²⁹ and
 - 3. The testimony deposition on written questions of Nicholas Topiol, the General Manager of Applicant, with attached exhibits.³⁰

B. Applicant's testimony and evidence.

- 1. Applicant's testimonial deposition of Opposer with attached exhibits;³¹
- 2. Stipulation to the admission of a worldwide list of registrations for the trademark CHRISTIAN LACROIX;³² and
- 3. Notice of reliance on the following items:³³
 - a. Applicant's motion for summary judgement;³⁴

²⁶ 36 TTABVUE 273-277.

²⁷ 36 TTABVUE 290-659. The documents were printed from the USPTO's TTABVUE database.

²⁸ 36 TTABVUE 660-662.

²⁹ 42 TTABVUE. Testimony and exhibits designated as confidential are filed at 41 TTABVUE.

³⁰ 47 TTABVUE. Testimony and exhibits designated as confidential are filed at 48 TTABVUE.

³¹ 73 TTABVUE. Testimony and exhibits designated as confidential are filed at 74 TTABVUE.

³² 75 TTABVUE.

³³ 76 TTABVUE. Documents designated as confidential are filed at 77 TTABVUE.

³⁴ 76 TTABVUE 26-239. The document was printed from the USPTO's TTABVUE database.

- b. Applicant's reply brief in support of its motion for summary judgment;³⁵
- c. The file history for Applicant's Registration No. 1499154;³⁶ and
- d. The file history for Applicant's Registration No. 2896646.³⁷

III. Standing

Standing is a threshold issue which plaintiffs must prove in every *inter partes* case. To establish standing in an opposition or cancellation proceeding, a plaintiff must show "both a 'real interest' in the proceedings as well as a 'reasonable basis' for its belief of damage." *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (quoting *ShutEmDown Sports, Inc., v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012)); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). The Court of Appeals for the Federal Circuit has enunciated a liberal threshold for determining standing in Board proceedings. *Ritchie*, 50 USPQ2d at 1030.³⁸

Opposer testified that his name is Christian Lacroix and that he is the manager and Chief Executive Officer of XCLX company.³⁹ Opposer is a designer of haute

³⁵ 76 TTABVUE 241-252. The document was printed from the USPTO's TTABVUE database.

³⁶ 76 TTABVUE 254-360.

³⁷ 76 TTABVUE 362-412.

³⁸ Opposer, in his brief, did not argue that he has standing and Applicant, in its brief, did not argue that Opposer does not have standing.

³⁹ Opposer's testimony deposition on written questions, p. 16 (42 TTABVUE 20).

couture and ready-to-wear clothing.⁴⁰ Opposer believes that he is perceived as an excellent and respected designer and that his name is well-known in the clothing and fashion industry.⁴¹ Even though he sold the CHRISTIAN LACROIX trademark to Applicant, Opposer “wanted to exert certain control over this work, and his work also consisted of verifying what was coming out of the house, the creative house.”⁴² Thus, between 1987 and 1999, Opposer was personally employed as Applicant’s artistic director, and between 1999 and 2009, Opposer worked as Applicant’s artistic director through Opposer’s company XCLX.⁴³ According to Opposer, Applicant is forbidden to use and register the CHRISTIAN LACROIX trademark without Opposer’s consent.⁴⁴ Opposer testified that he never gave his consent to Applicant to register his name in connection with the applications at issue.⁴⁵

This testimony proves that Opposer has a personal interest in these proceedings and a reasonable belief that he will be damaged by the registration of the CHRISTIAN LACROIX trademark and, therefore, Opposer has established its standing.

⁴⁰ Opposer’s testimony deposition on written questions, pp. 19-20 (42 TTABVUE 23-24).

⁴¹ Opposer’s testimony deposition on written questions, p. 21 (42 TTABVUE 25). *See also* the testimony deposition on written questions of Nicholas Topiol, pp. 11-13 (47 TTABVUE 15-17).

⁴² Opposer’s testimony deposition on written questions, p. 22-23 (42 TTABVUE 26-27).

⁴³ Opposer’s testimony deposition by Applicant, pp. 29-31 (73 TTABVUE 34-36). The first written agreement between Applicant and XCLX was the 2005 Services Agreement. *Id.* at pp. 31-32 (73 TTABVUE 36-37).

⁴⁴ Opposer’s testimony deposition on written questions, p. 26 (42 TTABVUE 30).

⁴⁵ Opposer’s testimony deposition on written questions, p. 18 (42 TTABVUE 22).

IV. Whether Applicant committed fraud in filing the applications at issue?

Fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes a false, material representation of fact in connection with an application to register with the intent of obtaining a registration to which it is otherwise not entitled. *In re Bose Corp.*, 580 F.3d 1240, 1245, 91 USPQ2d 1938, 1939-40, 1521(Fed. Cir. 2009); *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986); *Embarcadero Techs., Inc. v. Delphix Corp.*, 117 USPQ2d 1518 (TTAB 2016). A party alleging fraud in the procurement of a registration bears the heavy burden of proving fraud with clear and convincing evidence. *Bose*, 91 USPQ2d at 1243 (quoting *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981)). For example, the Board will not find fraud if the evidence shows that a false statement was made with a reasonable and honest belief that it was true, rather than an intent to mislead the USPTO into issuing a registration to which the applicant was not otherwise entitled. *See id.*; *see also Woodstock's Enters. Inc. (Cal.) v. Woodstock's Enters. Inc. (Or.)*, 43 USPQ2d 1440, 1443 (TTAB 1997), *aff'd (unpub'd)*, Appeal No. 97-1580 (Fed. Cir. Mar. 5, 1998). Intent to deceive is an indispensable element of the analysis in a fraud case. *See In re Bose Corp.*, 91 USPQ2d at 1941. The standard for finding intent to deceive is stricter than the standard for negligence or gross negligence, and evidence of deceptive intent must be clear and convincing. *Id.*

On February 3, 1987, Opposer, through The Company L.P.A., represented by its officers Opposer and Mr. Jean-Jacques Picart, assigned the CHRISTIAN LACROIX

trademark to Applicant in a Trademark Sale Agreement.⁴⁶ As part of the Trademark Sale Agreement, Opposer agreed to cooperate with Applicant in registering the CHRISTIAN LACROIX trademark.⁴⁷

Article 1: SUBJECT

The Company L.P.A. hereby transfers, without any exception or reserve, which is approved by Mr. Christian LACROIX, to the company CHRISTIAN LACROIX, which accepts, all the rights of property on the aforementioned trademark, “CHRISTIAN LACROIX”, for all categories of products and services as well as in every country in the world.

To the execution of this Agreement, and as needed, Mr. Christian LACROIX came forth, and he formally undertakes, in cooperation with the selling of the company, to provide assistance for any and all efforts, formalities and acts necessary to register said transfer, deposits, extensions and renewals, for all categories and countries, as well as for the protection of the trademark CHRISTIAN LACROIX, it is agreed that the cost of such undertakings shall be borne by the S.N.C. CHRISTIAN LACROIX.⁴⁸

The “Trademark Sale Agreement” guarantees that Applicant shall have all the rights of ownership in the trademark CHRISTIAN LACROIX.

⁴⁶ Opposer’s testimony deposition on written questions, Exhibit 11 (41 TTABVUE 130-134).

⁴⁷ Opposer’s testimony deposition on written questions, Exhibit 11 (41 TTABVUE 130 at 132).

⁴⁸ Opposer’s testimony deposition on written questions, Exhibit 11 (41 TTABVUE 130 at 132). The entire Trademark Sale Agreement was improperly designated as confidential. As noted above, we will treat as confidential only those portions of the document that truly are confidential. The part of the “Trademark Sale Agreement” providing consideration for the transfer was properly designated as confidential.

Opposer concedes that he is obligated to execute consents to use and register on behalf of Applicant pursuant to the Trademark Sale Agreement. Opposer’s testimony deposition on written questions, pp. 48 (42 TTABVUE 52). Opposer hedged that concession by explaining that he must consent “in the limit of the class categories concerned.” *Id.* However, there is no limit on the goods covered by the CHRISTIAN LACROIX trademark in the Trademark Sale Agreement because it includes “all categories of products and services.”

Article 4: CONSEQUENCE OF THE TRANSFER

Following the present transfer, the assignee takes over all the rights of the assignor and finally over those of Mr. Christian LACROIX on the trademark, so that as of the date of signature of the present document, the assignee shall have all rights of ownership as well as those of enjoyment and will be able to transfer or exploit it as it wishes, keep it in effect or abandon it.⁴⁹

In the event that Applicant wishes to sell the CHRISTIAN LACROIX trademark, Opposer shall have the right of first refusal.⁵⁰ Additionally, Opposer agreed not to utilize the mark CHRISTIAN LACROIX “for any and all professional or commercial purpose, if such use is not done in the best interest of [Applicant].”⁵¹

As part of the transaction, Opposer and Applicant executed what is in essence an employment contract (“Protocole”).⁵² Opposer has “full control over the Artistic Administration of [Applicant].”⁵³ In addition, all products sold under the CHRISTIAN LACROIX trademark will be submitted to Opposer for approval.

Creations and products that are exploited under the trademark “CHRISTIAN LACROIX”, in all categories, shall be submitted to the prior approval of Mr. Christian LACROIX; including publicity and any and all promotional campaign carried out based on his image. The choice of concession holders shall be submitted for prior verification to Mr. Christian LACROIX.⁵⁴

⁴⁹ Opposer’s testimony deposition on written questions, Exhibit 11 (41 TTABVUE 130 at 133).

⁵⁰ Opposer’s testimony deposition on written questions, Exhibit 11 (41 TTABVUE 130 at 133); *see also* Opposer’s testimony deposition on written questions, Exhibit 12 (41 TTABVUE 200 at 211).

⁵¹ Opposer’s testimony deposition on written questions, Exhibit 11 (41 TTABVUE 132).

⁵² Opposer’s testimony deposition on written questions, Exhibit 11 (41 TTABVUE 135-148).

⁵³ Opposer’s testimony deposition on written questions, Exhibit 11 (41 TTABVUE 135 at 140).

⁵⁴ Opposer’s testimony deposition on written questions, Exhibit 11 (41 TTABVUE 135 at 141).

Opposer formed XCLX, a sole proprietorship, “to provide independent consulting and assistance services, in particular – but not limited to – in the *haute couture* as well as the ready-to-wear business, fashion accessories, fragrance, cosmetics and beauty care products.”⁵⁵ Accordingly, on June 1, 2005, Opposer, through XCLX, and Applicant executed a “Services Agreement” whereby Opposer, through XCLX, controlled the artistic management for Applicant.⁵⁶

Article 1 – Object of the Contract

In this respect, XCLX shall exercise a complete control over all of the Articles and the manufacturing process of the Articles. Unless otherwise provided for by the Contract or agreed at a later date by the Parties, the Company must strictly comply with XCLX’s decisions in this respect, as well as with XCLX’s decisions and suggestions in the scope of the performance of the overall artistic management, which is assigned to it pursuant to the Contract.⁵⁷

The Services Agreement provides that Applicant “expressly undertakes to retain ownership of the [CHRISTIAN LACROIX] Trademarks throughout the term hereof.”⁵⁸

Opposer signed the April 21, 1987 consent and the December 26, 1995 consents to use and register that were attached to the applications at issue.⁵⁹ However, Opposer testified that he did not provide Applicant with any consents to use and register

⁵⁵ Opposer’s testimony deposition on written questions, Exhibit 12 (41 TTABVUE 200).

⁵⁶ Opposer’s testimony deposition on written questions, Exhibit 12 (41 TTABVUE 200 at 201).

⁵⁷ Opposer’s testimony deposition on written questions, Exhibit 12 (41 TTABVUE 200 at 201).

⁵⁸ Opposer’s testimony deposition on written questions, Exhibit 12 (41 TTABVUE 200 at 211).

⁵⁹ Opposer’s testimony deposition on written questions, pp. 28-29 (42 TTABVUE 32-33).

throughout the duration of the 2005 Services Agreement between XCLX and Applicant.⁶⁰ The 2005 Services Agreement between XCLX and Applicant was terminated by a judicial administrator on September 7, 2009.⁶¹ Opposer did not provide Applicant with any consents to use and register after the Services Agreement was terminated.⁶² Thus, Opposer testified that he did not consent to the use of his name in the applications at issue.⁶³ According to Opposer, Applicant never contacted Opposer to sign a consent to use and register after the termination of the Services Agreement.⁶⁴ In any event, Opposer would have refused to sign any consents to use and register his name because he was no longer working with Applicant.⁶⁵

Opposer argues that Applicant committed fraud on the USPTO by submitting the April 21, 1987 and December 26, 1995 consents to use and register signed by Opposer when Opposer did not expressly consent to the registration of the CHRISTIAN LACROIX trademarks in the applications at issue.⁶⁶

Through Applicant's submission of the Consent Documents to the USPTO, Applicant committed fraud by making material misrepresentations of fact, with respect to Opposer's purported consent to registration of Applicant's Marks for Applicant's Goods, with the intent to deceive the USPTO into granting to Applicant, without Opposer's

⁶⁰ Opposer's testimony deposition on written questions, pp. 26 (42 TTABVUE 30).

⁶¹ Opposer's testimony deposition on written questions, pp. 35 (42 TTABVUE 39).

⁶² Opposer's testimony deposition on written questions, pp. 35-36 (42 TTABVUE 39-40).

⁶³ Opposer's testimony deposition on written questions, pp. 36 (42 TTABVUE 33).

⁶⁴ Opposer's testimony deposition on written questions, pp. 36-37 (42 TTABVUE 40-41).

⁶⁵ Opposer's testimony deposition on written questions, pp. 37 (42 TTABVUE 41).

⁶⁶ Opposer's Brief, pp. 19-20 (83 TTABVUE 20-21).

consent, registrations of the CHRISTIAN LACROIX marks in International Classes 008, 014, 026, and 034.⁶⁷

We find that Applicant did not commit fraud on the USPTO during the prosecution of its applications because Opposer has not shown that Applicant intended to deceive the USPTO when it submitted the April 21, 1987 and December 26, 1995 consents to use and register signed by Opposer.

The name, portrait or signature of a particular living individual may not be registered without his or her *written consent*. Section 2(c) of the Trademark Act, 15 U.S.C. § 1052(c). The rationale behind Section 2(c) is:

to protect living individuals from the commercial exploitation of their names, except where those living individuals agree to such exploitation as evidenced by the written consent by the individual to the applicant's use and registration of his name as a mark.

Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A., 32 USPQ2d 1192, 1194 (TTAB 1994).

Under certain circumstances, a consent to registration may be implied from the terms of a written agreement. *See Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 USPQ2d 1025, 1032 n.11 (TTAB 2015) (citing *In re D.B. Kaplan Delicatessen*, 225 USPQ 342 (TTAB 1985) (consent to registration implied from terms of buy-out agreement whereby individual named in mark sold entire interest in business conducted under mark to applicant)).

⁶⁷ Opposer's Brief, 20-21 (83 TTABVUE 21-22).

In *Kaplan*, the Board found consent to the use and registration of the mark D.B. KAPLAN's DELICATESSEN implicit in the terms of a “buy out” agreement. Donald Kaplan, one of the original shareholders, officers and directors of the applicant corporation, entered into a “buy out” agreement that specifically provided that the mark D.B. KAPLAN's DELICATESSEN and any mark confusingly similar thereto was the property of D.B. Kaplan's Delicatessen, Inc. and further specifically provided that Donald Kaplan could not use D. B. KAPLAN's DELICATESSEN in any subsequent business venture. The Board held that the record supported a finding that Donald Kaplan consented to applicant's use and registration of the mark D.B. KAPLAN's DELICATESSEN in that “Kaplan has clearly relinquished to applicant corporation all rights in the mark ‘D.B. Kaplan Delicatessen’ which comprises his name and has agreed that he cannot use it in any subsequent business. We think that these provisions are beyond a mere ‘consent to use’ situation and that a reasonable reading of this provision clearly implies that consent to applicant's registration of the mark was contemplated.” *Id.* at 344.

Likewise, in the case before us, Opposer assigned to Applicant all of Opposer's rights in the trademark CHRISTIAN LACROIX, without any exception or reserve, including Opposer's agreement to assist Applicant in registering the CHRISTIAN LACROIX trademark. Additionally, Opposer agreed to refrain from use of the name for any professional or commercial gain that does not benefit Applicant. A reasonable reading of the Trademark Sale Agreement clearly implies Opposer's consent to Applicant's right to use and register the CHRISTIAN LACROIX trademark. There is

no fraud because Applicant believed that Opposer consented to Applicant's right to use and register the CHRISTIAN LACROIX trademark in the Trademark Sale Agreement and, thus, Applicant did not have the intent to deceive the USPTO when it filed the subsequent consents to the registration of the mark.

We find no support for Opposer's position that Applicant made false material misrepresentations of fact with the intent to deceive the USPTO in granting Applicant a registration to which Applicant was not entitled. Opposer has not shown that Applicant knew the submitted consents were no longer valid or enforceable, in spite of Opposer's most probable refusal to renew the consent. Rather, we find that Applicant submitted the April 21, 1987 and December 26, 1995 consents to use and register to facilitate registration of the CHRISTIAN LACROIX trademark to which it believed it was entitled.

Decision: The oppositions are dismissed.