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

Proceeding	91201703
Party	Plaintiff Michael Brandt Family Trust d/b/a Eco-Safe Industries, Inc.
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Attachments	229-182 Memo in Opp of Motion to Dismiss.PDF ( 12 pages )(121976 bytes ) 229-182 Exhibit A.PDF ( 16 pages )(1074250 bytes ) 229-182 Appendix.PDF ( 26 pages )(457088 bytes )

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

_____	)	
MICHAEL BRANDT FAMILY TRUST	)	
d/b/a ECO-SAFE OF DALLAS,	)	
	)	Opposition No. 91201703
Opposer,	)	
	)	Application Ser. No. 77/960,950
v.	)	
	)	
ISTITUTO ITALIANO SICUREZZA	)	
DEI GIOCATTOLE S.R.L.,	)	
	)	
Applicant.	)	
_____	)	

**MEMORANDUM IN OPPOSITION TO APPLICANT’S MOTION TO DISMISS  
OPPOSER’S FIRST AMENDED NOTICE OF OPPOSITION**

Opposer, Michael Brandt Family Trust, hereby submits this Memorandum in Opposition to Applicant’s Motion to Dismiss for Failure to State a Fraud Claim and a Claim Asserting That Applicant’s Application is *Void Ab Initio*, and Alternative Motion for More Definite Statement Regarding the *Void Ab Initio* Claim as served on February 24, 2011 (the “Motion”). Applicant’s Motion does not take issue with Opposer’s claim concerning a likelihood of confusion under Section 2(d) of the Act in Opposer’s First Amended Notice of Opposition, as accepted by Order of the Trademark Trial and Appeal Board (“TTAB”) on January 25, 2012 (hereinafter, the “FAN”). Nor does Applicant’s Motion appear to dispute that the FAN has stated all the elements of a claim for fraud on the United States Patent and Trademark Office (“PTO”).

Rather, the thrust of Applicant’s Motion is that the FAN, even as amended, fails to allege with sufficient particularity the “knowledge” and “intent” elements of a claim for fraud. In

addition, Applicant maintains that the FAN fails to state a claim for voidance of the entire Application because there is no conflict with the “anti-use by owner” rule and because the FAN fails to allege that the Applicant lacked a bona fide intent to use with respect to both the goods and services identified in the Application.

As set forth below, the motion should be denied because, under the pertinent Supreme Court standard, the FAN states objective facts from which one can infer that Applicant knowingly made a material misrepresentation in its Application with the intent to deceive the PTO. Specifically, that the Applicant applied for a trademark and service mark registration, when the Applicant knew that the ECO SAFE mark, in actuality, would be used as a certification mark, and with the intent that the PTO rely on Applicant’s omission and/or misrepresentation to grant the Applicant a federal trademark registration. When viewed against the Applicant’s admission that it is, in fact, an “institution...that certifies products manufactured by others as to whether such products meet specific standards related to environmental friendliness” (*see* Answer and Response to FAN at ¶ 9) and examples of Applicant’s use of its marks as contained in the PTO prosecution record, the FAN states a plausible claim for fraud, and is not based merely on speculation or a formulaic recitation of legal elements of a cause of action. In addition, because the Applicant does not have a bona fide intention to use the mark as a trademark or service mark for the identified goods and services, the FAN sufficiently states a claim that the application should be deemed void, either in whole or in part. Moreover, voidance of the application should be required because use of the mark as both an identifier of the Applicant’s own goods and services and at the same time as a certification mark for the goods of others would violate the “anti-use by owner” rule and 15 U.S.C. §§ 1054 and 1064.

As to Applicant's alternative request for a more definite statement regarding the void *ab initio* claim, the fact that Applicant has already filed Answers to Opposer's original and amended Notices of Opposition belies any contention that the allegations in the FAN are so ambiguous that Applicant is unable to frame a responsive pleading. Accordingly, Applicant's motion should be denied in its entirety.

### ARGUMENT

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. As recognized in TBMP § 503.02, "[i]n order to withstand such a motion, a complaint need only allege such facts that would, if proved, establish that the plaintiff is entitled to the relief sought....To survive a motion to dismiss, a complaint must 'state a claim to relief that is plausible on its face.' " *Id.* (citing *Bell Atlantic Corp v. Twombly*, 550 U.S. 554, 570 (2007)). When reviewing such a motion, the allegations must be construed as to do justice and to determine whether the complaint contains any allegations, which if proved, would entitle the plaintiff to the relief sought. *See, e.g., IdeasOne Inc. v. Nationwide Better Health*, 89 USPQ 2d 1952, 1953 (TTAB 2009).

A complaint or notice of opposition may be amended within 21 days after service of a motion to dismiss or with the written consent of the adverse party or by leave of the Board, which is freely given when justice so requires. *See* TBMP § 503.03 (citing *Fed. R. Civ. P.* 15(a)(1)(B)). Thus, often times, in response to a motion to dismiss, the plaintiff or opposer may respond to a motion to dismiss by filing an amended complaint. If the amended complaint corrects the defects noted in the motion to dismiss and states a claim upon which relief can be granted, then the motion to dismiss normally will be declared moot. *Id.* (citing *Fair Indigo LLC v. Style Conscience*, 85 U.S.P.Q.2d 1536, 1537 (TTAB 2007)). By Order of the Board,

Applicant's initial motion to dismiss was declared moot in view of Opposer's First Amended Notice of Opposition.

**I. The FAN States a Claim for Fraud with Sufficient Particularity**

As set forth in *In re Bose Corp.*, 580 F.3d 1240, 1245, 91 U.S.P.Q.2d 1938 (Fed. Cir. 2009), the elements of a claim of fraud on the Patent and Trademark Office are that the applicant knowingly made a false, material representation with the intent to deceive the PTO. Applicant contends that the FAN should be dismissed because, with respect to the elements of the Applicant's "knowledge" and "intent," there are "no alleged facts or circumstances by which a finder of fact could affirm the two state-of-mind allegations." *See* Motion at p. 3.

However, contrary to the Applicant's attempt to place the burden on Opposer to state facts to "affirm the two state of mind allegations," the Opposer need only allege facts from which the Applicant's state of mind may be inferred. As recognized in *In re Bose*, because "direct evidence of deceptive intent is rarely available, such intent **can be inferred** from indirect and circumstantial evidence." 580 F.3d at 1245 (emphasis added and citation omitted). Although *In re Bose* involved the consideration of the substantive merits of a claim for fraud, logically, the same principle should apply in determining the sufficiency of a claim for fraud at the pleading stage -- a conclusion that is consistent with the standards set forth by the Supreme Court in *Ashcroft v. Iqbal* and *Twombly*, cited *supra*, and relied on by the Applicant. *See Ashcroft*, 556 U.S. 662, 129 S. Ct. 1937, 1949 (2009) (stating that "[a] claim has facial plausibility [to survive a motion to dismiss] when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged.") (citing *Twombly*, 550 U.S at 556).

Here, Applicant has admitted that it is, in fact, “an institution based in Italy that certifies products manufactured by others as to whether such products meet specific standards related to environmental friendliness.” *See* Answer and Response to FAN at ¶ 9. Applicant’s admission as to its services is consistent with the type of certification activity that gives rise to a “certification mark.” *See* 15 U.S.C. § 1127 (defining “certification mark”); *see generally* TMEP § 1306. The prosecution history of the Applicant’s mark confirms that the Applicant uses its marks as certification marks to signify that the products of others meet certain standards, and not as identifiers of the source of Applicant’s own goods and/or services. *See* Office Action dated June 26, 2010 at p. 5, attaching evidence “retrieved from the Internet on June 26, 2010 as evidence that applicant’s marks are used in conjunction with products to show a product was tested and meets a certification standard.”; *see also* printed pages from the Applicant’s websites at [www.icqglobal.com/eng/marks/](http://www.icqglobal.com/eng/marks/) and [www.ecosafetextile.com/index.php?l=ENG](http://www.ecosafetextile.com/index.php?l=ENG), as of March 8, 2012, stating that the “ECO SAFE mark was created to differentiate non-toxic products to humans and the environment. It ensures that all textile articles and accessories do not contain substances harmful to humans and the environment and the physical and mechanical safety with a focus on children’s products,” attached as Exhibit A. Certainly, Applicant and its attorney, when they applied for registration of the ECO SAFE mark in the U.S., knew that the mark in actuality would be used in the U.S. as a certification mark, rather than as a trademark and/or service mark designating source. *See* FAN at ¶ 9, 10, 13, 15.

However, instead of properly submitting an application for a certification mark, the Applicant sought registration for a trademark for the goods listed in classes 22, 23, 24, 25 and 27 and a service mark for the services listed in class 42. As Applicant and its attorney are inherently charged with knowledge of the law, it may reasonably be inferred from the foregoing

facts that the Applicant's application for a trademark and service mark registration rather than for a certification mark, was not the result of any misunderstanding, inadvertence or mere negligent omission, but rather, as a result of an intent to deceive the PTO. *See* FAN at ¶ 12, 13, 16. Based on these facts, one could reasonably infer that the Applicant knew that its ECO SAFE mark would be used as a certification mark, yet with the intent to deceive the PTO regarding the true nature of its mark, submitted an application for a trademark and service mark registration.

*In re BP Lubricants USA, Inc.*, 637 F.3d 1307 (Fed. Cir. 2011), which is cited at page 5 of Applicant's Motion, and which addressed the sufficiency of a claim for false patent marking, does not compel a contrary conclusion. In that case, the court reaffirmed that, when pleading a claim sounding in fraud, "knowledge" and "intent" may be averred generally and that a plaintiff may plead upon information and belief under Rule 9(b). *See* 637 F.3d at 1311. However, the Federal Circuit found the false marking claim in *BP Lubricants* deficient because, unlike here, it alleged only "general allegations that BP knew or should have known that the patent expired" rather than "specific underlying facts from which we can reasonably infer the requisite intent..." 637 F.3d at 1311-12. The court recognized that, in some contexts, showing that certain statements are false may show the requisite state of mind. *See* 637 F.3d at 1312. (citing *Merck & Co. v. Reynolds*, 130 S. Ct. 1784, 1793, 176 L. Ed. 2d 582 (2010)). However, in a false patent marking claim, there is less of a relationship between factual falsity and state of mind, and, for such claims, the bar for proving deceptive intent is "particularly high." 637 F.3d at 1312-13 (citing *Pequignot v. Solo Cup. Co.*, 608 F.3d 1356, 1362-63 (Fed. Cir. 2010)).

Opposer submits that its claim for fraud is distinguishable because, unlike a claim for false patent marking, the fact that Applicant submitted an application for a trademark and service mark, while knowing that the mark would instead be used as a certification mark, is evidence of

Applicant's state of mind. That Applicant acted with the requisite state of mind is underscored by the admission that it is an institution that certifies that the goods of others meet certain standards of environmental friendliness (*see* Answer and Response to FAN at ¶ 9), and that its marks have been used to signify compliance with certain standards. *See* June 26, 2010 Office Action. Opposer's allegations are not general or conclusory, as in the inapposite cases cited by Applicant<sup>1</sup>, but rather, provide specific facts from which Applicant's intent may be inferred. *See Meth Lab Cleanup, LLC v. Spaulding Decon, LLC*, No. 8:10-cv-2550-T-30TGW, 2011 U.S. Dist. LEXIS 14455, \*6 (M.D. Fla. Feb. 4, 2011) (defendants had sufficiently alleged a claim of fraud, based on facts that the plaintiffs knowingly submitted false affidavits claiming that the marks at issue had become distinctive through substantial and exclusive use, when they knew that they were not, in fact, the only users of the marks) (copy attached). *Cf. Swiss Watch Int'l, Inc. v. Federation of the Swiss Watch Indus.*, 2012 TTAB LEXIS 3, \*52 (TTAB Jan. 30, 2012) (recognizing that "deliberately omitting relevant portions of a document, or making a statement that, while true, gives only part of the story and therefore is deliberately designed to mislead, may be treated as a false statement in this effect and also show the necessary element of intent") (copy attached).

In view thereof, Opposer submits that the FAN states a claim of fraud with sufficient particularity and should not be dismissed.

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<sup>1</sup> *See BP Lubricants*, 637 F.3d at 1311 ("complaint failed to allege any facts inferring that BP was aware of the patent's expiration."); *Twombly*, 550 U.S. at 566 ("nothing contained in the complaint invests either the action or inaction alleged with a plausible suggestion of conspiracy."); *Iqbal*, 556 U.S. at 886 (complaint failed to contain "facts plausibly showing that petitioners purposefully adopted a policy of classifying post-September-11 detainees as 'of high interest' because of their race, religion, or national origin.").

## **II. The FAN Properly States a Claim for Voidance of the Application in Whole or, at Least, in Part**

With respect to Opposer's claim for voidance of the Application, the Applicant submits that the claim should be dismissed because: 1) there is no alleged conflict with 15 U.S.C. § 1127 because "Applicant's application is and has always been a regular application, not an application for a certification mark" (*see* Motion at p. 7); and 2) the FAN alleges that the Applicant lacked a bona fide intent to use with respect to either the goods or the services in the Application, but not both.

Preliminarily, Applicant's first contention appears to attack the veracity of Opposer's allegations, which is not a proper subject of a motion to dismiss directed to the sufficiency of the pleadings. *Cf. Meth Lab Cleanup, supra*, 2011 U.S. Dist. LEXIS 14455, at \* 6 ("Plaintiff's arguments in favor of dismissal appear to attack the veracity of Defendants' allegations, which would be an issue for summary judgment."). While Applicant self-servingly states that "Applicant's application is and has always been a regular application not an application for a certification mark," nowhere does the Applicant affirm that it would not, in fact, be using its ECO-SAFE mark as a certification mark or that the mark would not, in fact, be applied to third-party products. As recently recognized by the TTAB, the realities of the Applicant's use of the ECO SAFE mark should not be ignored. *See In Re: The EyeCare Foundation, Inc.*, 2011 TTAB Lexis 65 (TTAB Mar. 10, 2011) ("We agree with the Trademark Examining Attorney that this tribunal should not be required to ignore the realities of use actually made by applicant merely because it made a tactical decision explicitly to carve out from the application's recitation of services what are arguably its core services - motivated only by the desire to foil a refusal of mere descriptiveness.") (copy attached); *see also In Re DNI Holdings, Ltd.*, 77 USPQ2d 1435 (TTAB 2005) ("Accordingly, despite Applicant's tactical decision to carve them out of its

recitation of services, we find that the relevant genus of services herein includes wagering on sporting events.”). The veracity of whether Applicant intends to use the ECO SAFE mark as a certification mark, which would be in line with the Applicant’s admission that it certifies the goods of others and with Applicant’s prior use of its marks, is an issue for discovery.

Concerning the Applicant’s second contention, that the Opposer fails to state a claim for avoidance of the application, the Applicant continues to maintain that “the claim fails as a matter of law because Opposer does not allege that Applicant lacked a bona fide intent to use the mark on all the goods and all the services listed in the application.” *See* Motion at p. 7. However, Applicant ignores the allegations in the FAN by which the entire application can be declared void. Specifically, as stated in Paragraphs 9-10, 14 and 15 of the FAN, Applicant does not have a bona fide intent to use the mark for either the goods in Classes 22, 23, 24, 25 and 27 or in connection with the services identified in Class 42, because the Applicant intends to use the mark as a certification mark on the goods of others, rather than as an identifier of Applicant’s own goods and/or services. In addition, the application should be deemed void *ab initio*, even if the Applicant did have an intent to use the ECO SAFE mark as a trademark and/or service mark, because Applicant’s obvious use of the mark at the same time as a certification mark (*see* Exhibit A) violates the “anti-use by owner” rule. *See* FAN at ¶ 11.

To assert as does Applicant at page 7 of its Motion, citing *Wet Seal Inc. v. FD Management Inc.*, 82 U.S.P.Q.2d 1629, 16 (TTAB 2007), that Opposer needs to claim that applicant lacks a bona fide intent to use the mark for **all** goods and services, exalts technical form over the substance of the “anti-use by owner” rule. While that burden might be necessary when the application involves both products and non-certification services, it cannot and arguably should not apply when as here, the application covers **both** products and certification services.

Otherwise, such a holding would render Section 1054 of the Act meaningless. Applicant's attempt to construct a bypass around the statutory language is in contravention of the clear will of Congress. While imaginative and perhaps bodacious, Applicant's argument fails by weight of sheer statutory construction and long standing application. Applicant stated its clear intent under oath and should not be permitted to find sheltered refuge in *Wet Seal, supra*, a case in which the "anti-use by owner" rule was not implicated and is distinguishable from the facts at hand.

Opposer submits that the FAN states sufficient facts which would support a claim for avoidance of the Application in whole, or at least, in part. In the event the TTAB disagrees, and finds that the pleading is technically deficient, Opposer respectfully requests that it be granted leave to file a Second Amended Complaint.

### **III. Applicant's Request for a More Definite Statement Should be Denied**

"A motion for a more definite statement is appropriate only in those cases where the pleading states a claim upon which relief can be granted, but is so vague or ambiguous that the movant cannot make a responsive pleading in good faith or without prejudice to itself." *See* TMEP § 505.01. Applicant's request for a more definite statement should be denied because there is no allegation that Opposer's void *ab initio* claim is so vague or ambiguous that Applicant cannot frame a response to the FAN. Such a contention would be disingenuous as Applicant has already filed an Answer to the original Notice of Opposition, as well as an Answer and Response to the FAN. In light of that fact, no more definite statement of the void *ab initio* claim should be required.

Respectfully submitted,

MICHAEL BRANDT FAMILY TRUST  
d/b/a ECO-SAFE OF DALLAS

Dated: March 15, 2012



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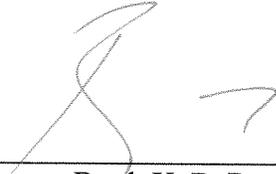
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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the Memorandum in Opposition to Applicant's Motion to Dismiss Opposer's First Amended Notice of Opposition this 15th day of March 2012, via First Class Mail, postage prepaid, as identified below:

Mark Lebow  
Young & Thompson  
209 Madison Street  
Suite 500  
Alexandria, VA 22314-1764



---

Barth X. DeRosa

# Exhibit A



## ICQ GLOBAL ENJOY THE SAFETY AND QUALITY

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## Marks

### HOW ICQ-IISG GRANTS SAFETY AND QUALITY

The safety of products is an indispensable requirement and a primary duty that every successful company has with consumers. A product cannot be classified as of a good quality if safety hasn't been previously guaranteed.

The Institute grants manufacturers the right to use its marks on their products upon the successful certification of products' samples, the inspections during the production and signing jointly the appropriate agreement according to codified procedures.

The manufacturer or the importer that decides to tag on its products IISG-ICQ mark, commits to submit its products to deepen analysis that are listed in the mark regulation. The regulation includes that goods have to go through inspections during the production and constant supervision on the market carried out by ICQ-IISG.

ICQ-IISG marks increase product's value and make immediately visible to consumer energy spent for product safety.

- [SAFE TOYS](#)
- [CHECKED SAFETY](#)
- [ECO SAFE](#)
- [CHECKED SAFETY PETS](#)

## THE SAFE TOYS MARK



A toy cannot be classified as of a good quality if safety hasn't been previously guaranteed. When consumers are children to give a safety and quality guarantee allow us to comply with a fundamental ethical principle and it's an important instrument to be competitive inside a market more and more careful and sensitized.

### WHAT DOES ICQ DO BEFORE GRANTING THE SAFE TOYS MARK

#### 1. AGE GRADING EVALUATION OF THE TOY

At ICQ-IISG the proper age grading is determined by an experienced psychologist who establishes the playing age of the toy according to cognitive and motor abilities possessed by the children during their development. The recommended age of a toy is an essential element to guarantee the safety of the product, and it is important that parents are aware of its importance on the packaging.

#### 2. RISK ASSESSMENT

Toys under development are studied in technical sessions by an ICQ-IISG team of experts with diversified skill sets to appraise possible risks connected with their use and abuse. Based on these evaluations the team establishes specific tests necessary for the certification and the granting of the mark SAFE TOYS.

#### 3. PHYSICAL AND MECHANICAL TESTS

The ICQ-IISG laboratory technicians check for the presence of any sharp edges or sharp points in the toy structure, the possibility of detaching parts that can provoke traumas or could cause choking hazards. Toys intended to bear the weight of a child (for example electrical or mechanical vehicles), must pass the crash test of the structure launched against an obstacle. Teddy bears are put through hard tests of torsion, tension, simulated bites, in order to withstand the accidental removal of small parts.

#### 4. CHEMICAL ANALYSIS, HYGIENE AND RADIOACTIVITY

A chemical analysis is carried out on toys and all the other articles related to children. The objective is to check raw materials, varnishes, adhesives and more to verify they are not hazardous and they conform to all safety requirements related to heavy metals and toxic substances.

#### 5. ELECTRICAL TESTS

At our labs we test electromagnetic compatibility and radio frequencies. Special tests are performed to evaluate the overheating of toy parts which could be in contact with the child. Special tests are carried out for electrical toys operating in contact with water such as bath toys.

#### 6. FLAMMABILITY TESTS

Soft toys and other toys made of textile or cushioned material are submitted to flammability tests. We analyze the ignition and the fire reaction of the materials with our special equipment.

To successfully pass the test, the speed of flame spreading on the toy must be inferior to an industry established safety threshold.

**7. PRODUCTION INSPECTIONS**

Certifying a product with our SAFE TOYS mark doesn't end with laboratory tests. We also follow the product through the production and inspection phases with sampling procedures. This allows us to ensure that the toys conform to safety requirements established by law and quality standards required by the purchaser.

**8. GRANTING THE MARK SAFE TOYS”**



**THE CHECKED SAFETY MARK**

The CHECKED SAFETY mark guarantees that the tested products comply with all the safety requirements and with the General Product Safety Directive – GPSD, that is not all.

**HOW TO GET THE CHECKED SAFETY MARK**

The presence of the CHECKED SAFETY mark on a product highlights that:

- an appropriate internal commission has previously evaluated any possible risk linked to the use of the product either from children or adults (RAP – Risk Assessment Protocol);
- an eco-toxicological commission has preventative evaluated all the chemical and microbiological risks;
- appropriate inspections have been carried out in the productive poles in order to ensure global safety of the production.

**THE ECO SAFE MARK**



**ECO SAFE mark was created to differentiate non-toxic products to humans and the environment. It ensures that all textile articles and accessories do not contain substances harmful to humans and the environment and the physical and mechanical safety**

**with a focus on children's products. The ECO SAFE mark provides consumer visibility to your financial commitment to verifying the absence of toxic substances in the product for environmental and human and it meets the growing need by the consumers to choose 'green' products.**

### **HOW TO GET THE ECO SAFE MARK**

Companies wishing to use the ECO SAFE mark on their products can contact ICQ by submitting an application form for certification. Recommended tests to be performed are determined by a Risk Assessment on each specific sample and a preliminary Factory Audit. After tests are completed, approved, and signed, the license for use of the mark is granted.

### **REQUIREMENTS FOR THE ECO SAFE MARK**

1. Absence of prohibited and harmful substances to the health and safety of humans and the environment, for example: aromatic amines, carcinogenic and allergenic dyes, formaldehyde, phenols, chlorinated aromatic compounds, heavy metals migration, nickel (allergic), phthalates, organostannic compounds.
2. Physical and mechanical safety, especially clothing and accessories for children (hazardous cords, laces, and small parts).
3. Analysis of potential risks.

For further information about ECO SAFE mark please visit the website [www.ecosafetextile.com](http://www.ecosafetextile.com)



### **THE CHECKED SAFETY PETS MARK**

**The CHECKED SAFETY PETS mark has been created to meet the need to provide safe products to our pets. The presence of the mark on a product guarantees that it complies with the safety requirements and with the General Product Safety Directive – GPSD, that is not all.**

### **HOW TO GET THE CHECKED SAFETY PETS MARK**

The presence of the CHECKED SAFETY PETS mark on a product highlights that:

- an appropriate internal commission has previously evaluated any possible risk linked to the use of the product (RAP – Risk Assessment Protocol);
- an eco-toxicological commission has preventative evaluated all the chemical and microbiological risks;

- appropriate inspections have been carried out in the productive poles in order to ensure global safety of the production.

As for other marks of ICQ-IISG, the Institute grants manufacturers the right to use the CHECKED SAFETY PETS mark on their products upon the successful certification of products' samples, the inspections during the production and signing jointly the appropriate agreement according to codified procedures.

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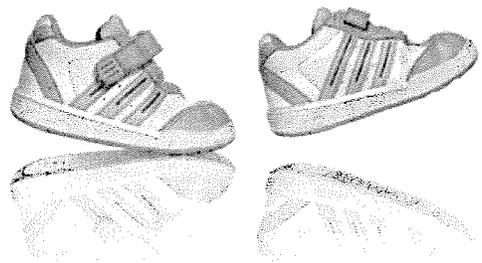


Consumer benefits

Eco safe products

**ECO SAFE - TEXTILE ARTICLES and ACCESSORIES**  
 ECO-FRIENDLY and SAFE for people, children and the environment

ECO SAFE was created to differentiate non-toxic products to humans and the environment. The ECO SAFE mark provides consumer visibility to your financial commitment to verifying the absence of toxic substances in the product for environmental and human. The ECO SAFE mark meets the growing need by the consumers to choose 'green' products.



*In collaboration with Philadelphia University.*

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ICQ

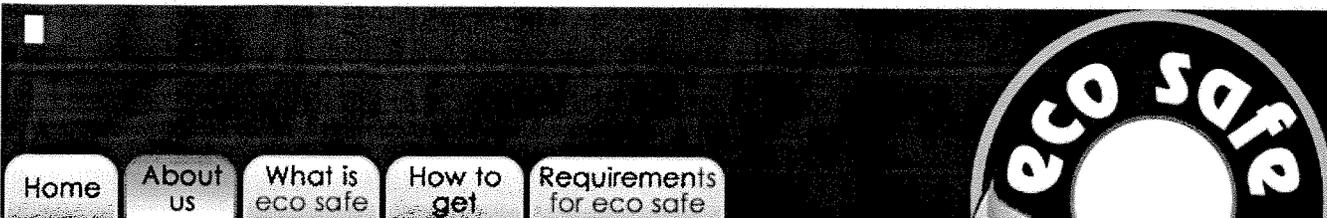
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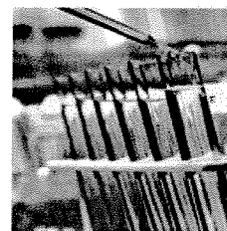
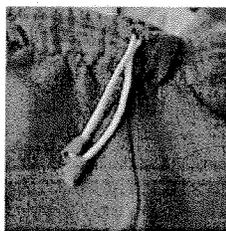
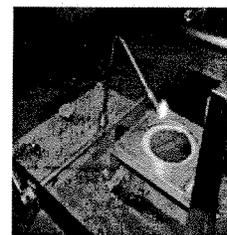
## ICQ - Textile Division

The ICQ textile laboratory was founded in 1995 and grew to become a major international quality assurance and safety company.

Thanks to our international partnerships the laboratory continues its leadership in safety and performance tests, with particular attention to the American market requirements.

The laboratory works according to the procedure established by national and international standards (UNI, EN, ISO, BS, AATCC, ASTM, DIN, etc) in the following proficiency fields:

- CHILDREN'S CLOTHING (specialty)
- ADULT CLOTHING
- HOME TEXTILES
- SHOES AND LEATHER ITEMS
- TEXTILE ACCESSORIES



Contact

Our Offices

ICQ

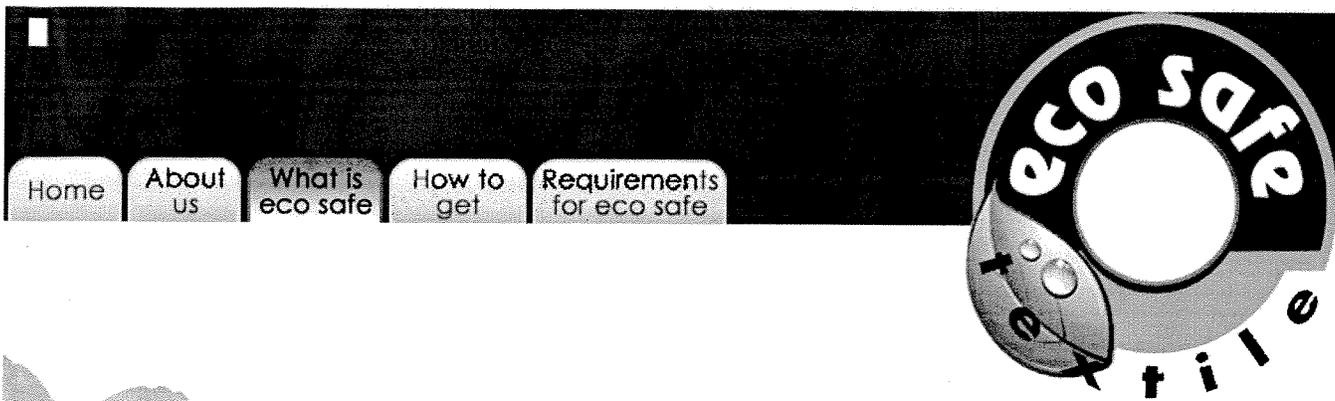
Press Release

Qr Code Instructions

Site map

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Credits



# What is eco safe

[Consumer benefits](#)

[Eco safe products](#)

ECO SAFE ensures that all textile articles and accessories do not contain substances harmful to humans and the environment.

Moreover the presence of this mark ensures physical and mechanical safety for clothing and accessories, with a focus on children's products.



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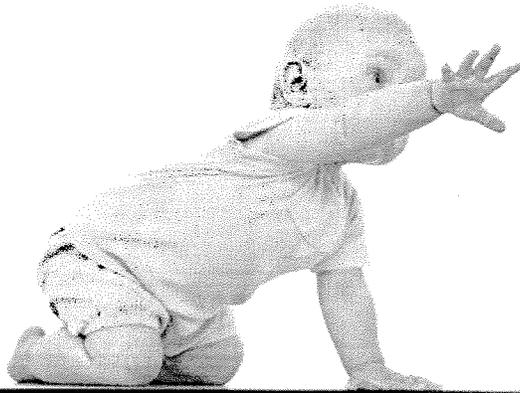
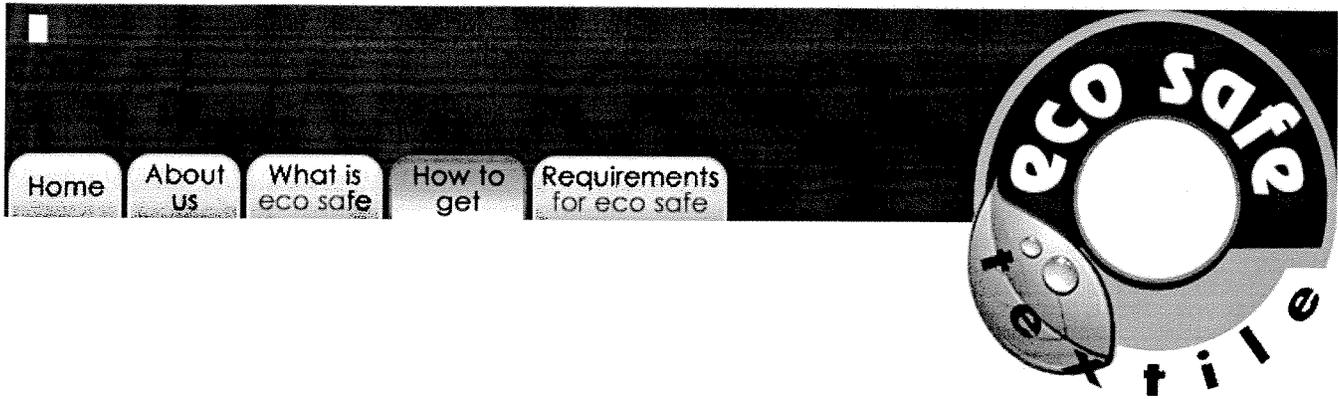
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# how to get eco safe

Consumer benefits

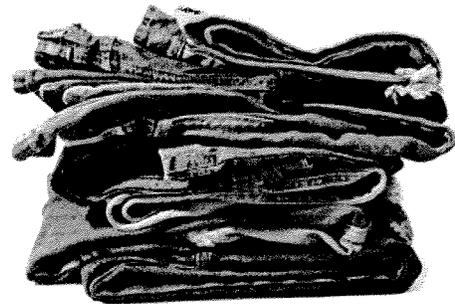
Eco safe products

Companies wishing to use the ECO SAFE mark on their products can contact ICQ by submitting an application form for certification.

Recommended tests to be performed are determined by a Risk Assessment on each specific sample and a preliminary Factory Audit.

After tests are completed, approved, and signed, the license for use of the mark is granted to the company for a period of 3 years.

See the ECO SAFE CERTIFICATION PROCESS [here](#).



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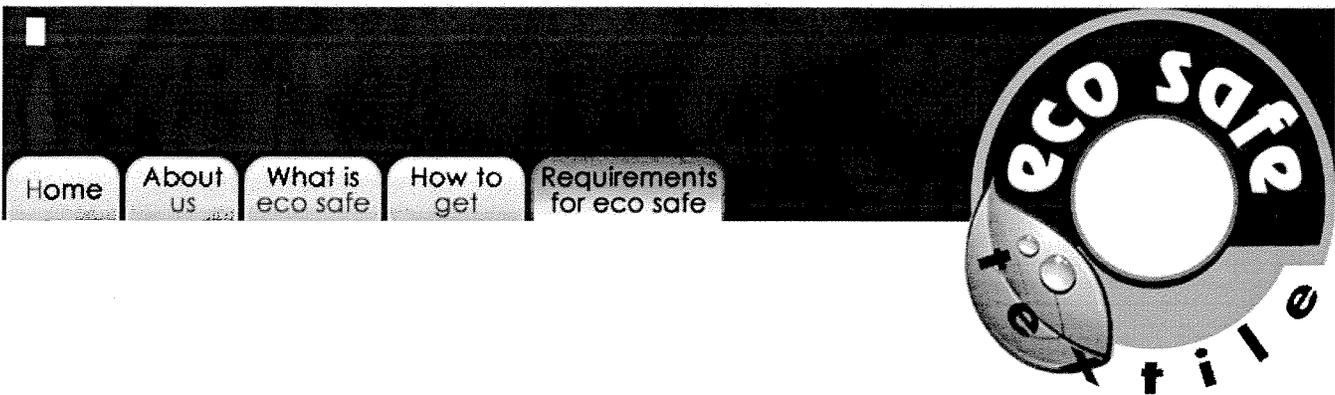
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# ECO SAFE certification process



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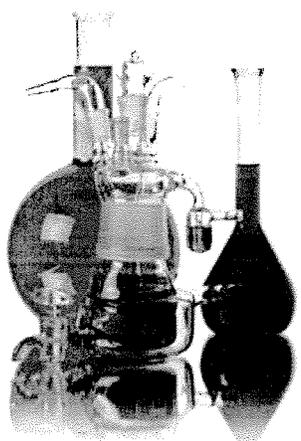


# eco safe requirements

Consumer benefits      Eco safe products

## REQUIREMENTS FOR THE ECO SAFE MARK

1. Absence of prohibited and harmful substances to the health and safety of humans and the environment, for example:
  - Aromatic Amines
  - Carcinogenic and allergenic dyes
  - Formaldehyde
  - Phenols
  - Chlorinated aromatic compounds
  - Heavy metals migration
  - Nikel (allergic)
  - Phthalates
  - Organostannic compounds



2. Physical and mechanical safety, especially clothing and accessories for children (hazardous cords, laces, and small parts).
3. Analysis of potential risks.

## HOW DO YOU GET THE ECO SAFE CERTIFICATION ON FINISHED PRODUCTS AND ACCESSORIES?

The ECO SAFE mark is released only if all components of the sample are approved. The sample must pass all tests and requirements to obtain a certification.

For this purpose, the following are reviewed:



- ° The outer fabric
- ° Fillings
- ° Liners
- ° Accessories
- zipper
- button
- shoulder pad
- trimming
- yarn

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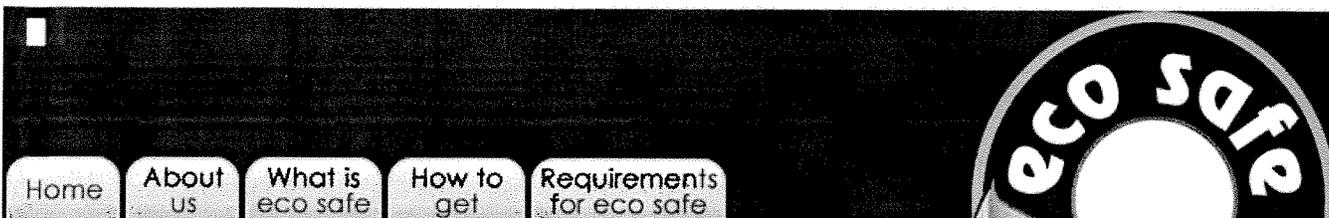
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# CONSUMER benefits



The presence of the ECO SAFE mark on products is a synonymous with:

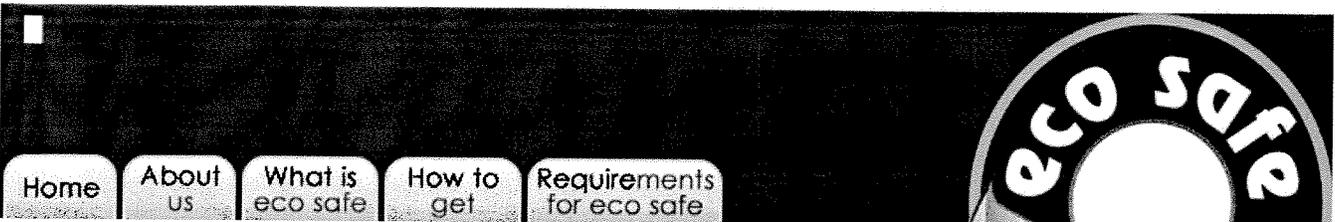
- ° environmental protection - ECOLOGY
- ° human health protection - SAFETY
- ° assurance of good products purchased - QUALITY



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# eco safe products



Consumer benefits

Eco safe products

ECO SAFE certified product will be readily recognizable to the consumer through the use of the ECO SAFE LABEL: it allows to display the ECO SAFE CONCESSION TO USE of the labeled product.

To see an example of ECO SAFE concession to use [click here](#).



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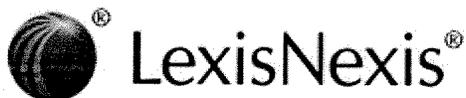
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# **Appendix of Unreported Cases**



**METH LAB CLEANUP, LLC, Plaintiff, v. SPAULDING DECON, LLC and LAURA SPAULDING, Defendants.**

**Case No. 8:10-cv-2550-T-30TGW**

**UNITED STATES DISTRICT COURT FOR THE MIDDLE DISTRICT OF FLORIDA, TAMPA DIVISION**

*2011 U.S. Dist. LEXIS 14455*

**February 4, 2011, Decided  
February 4, 2011, Filed**

**COUNSEL:** [\*1] For Meth Lab Cleanup, LLC, a foreign limited liability company, Plaintiff, Counter Defendant: Robert H. Thornburg, LEAD ATTORNEY, Allen, Dyer, Doppelt, Milbrath & Gilchrist, PA, Miami, FL; Ryan Thomas Santurri, Stephen D. Milbrath, LEAD ATTORNEYS, Allen, Dyer, Doppelt, Milbrath & Gilchrist, PA, Orlando, FL.

For Spaulding Decon, LLC, a Florida limited liability company, Laura Spaulding, Individually, Defendants, Third Party Plaintiffs, Counter Claimants: Enrico A. Mazzoli, Waters Law Group, PLLC, Louisville, KY.

**JUDGES:** JAMES S. MOODY, JR., UNITED STATES DISTRICT JUDGE.

**OPINION BY:** JAMES S. MOODY, JR.

**OPINION**

**ORDER**

THIS CAUSE comes before the Court upon Plaintiff's Motion to Strike Ten Affirmative Defenses and Motion for Rule 12 Dismissal of Defendants' Counterclaim (Dkt. 8) and Defendants' Response in opposition (Dkt. 13). The Court, having reviewed the motion, response, and being otherwise advised in the premises, concludes that the motion should be denied.

**BACKGROUND**

This is a copyright and trademark infringement action brought by Plaintiff Meth Lab Cleanup, LLC ("MLCC") against Defendants. MLCC offers compre-

hensive drug lab decontamination solutions, which includes decontamination of methamphetamine laboratory facilities. [\*2] MLCC offers these services under the mark METH LAB CLEANUP, as well as multiple trademark registrations, including the mark METH LAB CLEANUP LLC.

Defendant Spaulding Decon, a Tampa Bay vendor of drug decontamination services, is a former independent contractor of MLCC. Its owner, Defendant Laura Spaulding, attended one of MLCC's training seminars and was provided a copy of the training materials.

MLCC filed the instant complaint, alleging that Laura Spaulding created a copycat website, which displayed portions of MLCC's copyrighted material, including material from MLCC's website. MLCC asserts five claims of copyright and trademark infringement against Defendants based on Defendants' alleged unlawful acts of using MLCC's marks on their website and via other interstate business channels.

Defendants answered Plaintiff's complaint and asserted affirmative defenses and counterclaims, seeking, in part, cancellation of MLCC's portfolio of registrations for the mark METH LAB CLEANUP LLC based upon MLCC's alleged fraudulent sworn statements made in the applications submitted to the USPTO.

This case is now at issue upon Plaintiff's motion to strike ten of Defendants' affirmative defenses and motion [\*3] to dismiss Defendants' counterclaims related to the allegations of MLCC's purported fraud.

**DISCUSSION**

## I. Plaintiff's Motion to Strike

Rule 12(f) of the Federal Rules of Civil Procedure permits the Court to strike any "insufficient defense"; however, it is well settled among courts in this circuit that motions to strike are generally disfavored and will usually be denied unless it is clear the pleading sought to be stricken is insufficient as a matter of law. *Blanc v. Safetouch, Inc.*, 2008 U.S. Dist. LEXIS 68158, 2008 WL 4059786, \*1-2 (M.D. Fla. Aug. 27, 2008) (citing *Fabrica Italiana Lavorazione Materie Organiche S.A.S. v. Kaiser Aluminum & Chemical Corp.*, 684 F.2d 776 (11th Cir. 1982); *Thompson v. Kindred Nursing Centers East, LLC*, 211 F. Supp. 2d 1345 (M.D. Fla. 2002); *In re Sunbeam Securities Litigation*, 89 F.Supp.2d 1326 (S.D. Fla. 1999)). A "court will not exercise its discretion under the rule to strike a pleading unless the matter sought to be omitted has no possible relationship to the controversy, may confuse the issues, or otherwise prejudice a party." *Id.* (citing *Reyher v. Trans World Airlines, Inc.*, 881 F. Supp. 574 (M.D. Fla. 1995)).

The Court finds Defendants stated their affirmative defenses in short [\*4] and plain terms, and that those affirmative defenses adequately place Plaintiff on notice as to the issues to be litigated. Accordingly, Plaintiff's motion to strike is denied.

## II. Plaintiff's Motion to Dismiss

To survive a motion to dismiss, a complaint must include "enough facts to state a claim to relief that is plausible on its face." *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 127 S.Ct. 1955, 1960, 167 L. Ed. 2d 929 (2007). While in the ordinary case a plaintiff may find the bar exceedingly low to plead only more than "a statement of facts that merely creates a suspicion [of] a legally cognizable right of action," it is clear that "a plaintiff's obligation to provide the 'grounds' of his 'entitlement to relief' requires more than labels and conclusions, and a formulaic recitation of the elements of a cause of action will not do." *Id.* at 1959, 1965; see also *Davis v. Coca-Cola Bottling Co. Consol.*, 516 F.3d 955, 974, n.43 (11th Cir. 2008) (noting the abrogation of the "no set of facts" standard and holding *Twombly* "as a further articulation of the standard by which to evaluate the sufficiency of all claims"). Absent the necessary factual allegations, "unadorned, the-defendant-unlawfully-harmed-me accusation[s]" will [\*5] not suffice. *Ashcroft v. Iqbal*, 129 S.Ct. 1937, 1949, 173 L. Ed. 2d 868 (2009).

Plaintiff argues that Defendants' counterclaims (Counts I-IV), which include four declaratory actions

seeking cancellation of MLCC's trademark portfolio, (because they were procured by fraud), must be dismissed because they fail to plead the fraudulent acts with sufficient particularity. The Court disagrees.

A third party may petition to cancel a registered service mark on the grounds that the registration was obtained fraudulently. *Metro Traffic Control, Inc. v. Shadow Network Inc.*, 104 F.3d 336, 340 (Fed. Cir. 1997) (citing *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 47-48, 1 USPQ2d 1483, 1483-84 (Fed. Cir. 1986)). Fraud in procuring a service mark occurs when an applicant knowingly makes false, material representations of fact in connection with an application. *Id.* "[T]he obligation which the Lanham Act imposes on an applicant is that he will not make knowingly inaccurate or knowingly misleading statements in the verified declaration forming a part of the application for registration." *Id.* at 48 (quoting *Bart Schwartz Int'l Textiles Ltd. v. Federal Trade Comm'n*, 48 C.C.P.A. 933, 289 F.2d 665, 669, 129 USPQ 258, 260 (1961) [\*6] (emphasis in original)).

Plaintiff's arguments in favor of dismissal appear to attack the veracity of Defendants' allegations, which would be an issue for summary judgment. Moreover, the Court concludes that Defendants' counterclaims assert sufficient allegations of fraud. Defendants claim that Plaintiff knew that the applications did not qualify under Section 2(f) of the Trademark Act because Plaintiff was not the substantial and exclusive user of the marks during the relevant period of time (five years or more). Specifically, Defendants claim that Joseph and Julie Mazzuca knowingly submitted false affidavits claiming MLCC's marks had become distinctive because of this purported substantial and exclusive use when they knew that they were not the only users of the marks.

The Court also concludes that a general averment of damages is sufficient at this stage. Accordingly, Plaintiff's motion to dismiss is denied.

It is therefore ORDERED AND ADJUDGED that Plaintiff's Motion to Strike Ten Affirmative Defenses and Motion for Rule 12 Dismissal of Defendants' Counterclaim (Dkt. 8) is hereby DENIED.

**DONE** and **ORDERED** in Tampa, Florida on February 4, 2011.

/s/ James S. Moody, Jr.

**JAMES S. MOODY, JR.**

**UNITED [\*7] STATES DISTRICT JUDGE**



Swiss Watch International, Inc. v. Federation of the Swiss Watch Industry

Cancellation No. 92046786

Trademark Trial and Appeal Board

2012 TTAB LEXIS 3

May 31, 2011, Hearing

January 30, 2012, Decided

**DISPOSITION:**

[\*1]

Decision: We find that petitioner has failed to prove that it is entitled to judgment on any of the pleaded grounds. n29 Accordingly, the petition for cancellation is dismissed. As noted in footnote 12, respondent must submit, within thirty (30) days, a redacted version of the testimony and exhibits of Vincent Stauffer, marking as confidential only material that is truly sensitive, failing which the testimony and exhibits previously submitted under seal will become part of the public record.

n29 We have carefully considered all of petitioner's arguments and evidence, even if not specifically discussed herein, but have not found them persuasive.

**COUNSEL:**

Amaury Cruz and Henry Rodriguez of Amaury Cruz & Associates for Swiss Watch International

Abigail Rubinstein of Steptoe & Johnson LLP for Federation of the Swiss Watch Industry

**JUDGES:** Before Seeherman, Lykos and Kuczma n1, Administrative Trademark Judges.

n1 Judge Walters sat on the panel at the oral argument. She has since retired, and Judge Kuczma has been substituted for her on this decision. The change in composition of the panel does not necessitate a rehearing of the oral argument. *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1560 (TTAB 2011); see also *In re Bose*, 772 F.2d 866, 227 USPQ 1, 4 (Fed. Cir. 1985).

[\*2]

**OPINION BY: SEEHERMAN**

**OPINION:**

**THIS OPINION IS A PRECEDENT OF THE TTAB**

Opinion by Seeherman, Administrative Trademark Judge:

Swiss Watch International, Inc. (petitioner) has petitioned to cancel registrations for two certification marks owned by the Federation of the Swiss Watch Industry (respondent): Registration No. 3047277 for the mark SWISS and Regis-

tration No. 3038819 for the mark SWISS MADE, both in standard character form and both for certifying geographic origin of goods identified as "horological and chronometric instruments, namely, watches, clocks and their component parts and fittings thereof." n2 The certification statement in each registration is: "The certification mark, as used by persons authorized by the certifier, certifies geographical origin of the goods in Switzerland."

n2 Registration No. 3047277 issued on January 24, 2006, and Registration No. 3038819 issued on January 10, 2006.

As for its standing and grounds for cancellation petitioner has asserted, in its amended petition for [\*3] cancellation, that it owns a registration for the mark SWISS WATCH INTERNATIONAL; that it has applied to register the mark SWISS LEGEND for, inter alia, watches, and that this application has been refused registration by the USPTO on the basis of, among other things, likelihood of confusion with respondent's marks; that respondent intentionally misstated matters in the applications that resulted in its registrations or failed to state that it is not a government, a department of a government, or a body operating with governmental authorization; that the registrations were obtained fraudulently; that respondent has no legitimate control of the use of the terms SWISS or SWISS MADE; that respondent has improperly permitted and encouraged use of its marks for purposes other than to certify; that respondent discriminates in the granting of use of its certification marks; and that the terms SWISS and SWISS MADE cannot function as certification marks because they have become generic for horological and chronometric instruments. n3

n3 Petitioner also alleged that respondent has no authority to control the use of the terms SWISS or SWISS MADE, but did not, in its brief on the merits, present arguments regarding this aspect of its claim that respondent has failed to control the use of its marks.

[\*4]

Respondent has admitted that it is an unincorporated association with offices in Switzerland, and otherwise has denied the salient allegations in the petition to cancel. n4

n4 Respondent also asserted certain affirmative defenses, but because it made no mention of them in its trial brief, we deem them to have been waived. See, e.g., *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313, 1314 n.4 (TTAB 2005). In any event, with respect to those defenses, and as discussed herein, petitioner has shown its standing and that its petition to cancel states a claim.

#### The record and objections

By operation of the rules, the record includes the pleadings and the files of the registrations sought to be cancelled. Petitioner listed at page 5 of its trial brief the evidence that is of record:

Respondent's responses to petitioner's interrogatories (Exhibits 88-96);

Respondent's responses to petitioner's requests for admission (Exhibit 87);

Testimony depositions taken by petitioner [\*5] of Lior Ben-Shmuel, Rick Ruz and Henry Rodriguez, with petitioner's exhibits 1-75 and respondent's exhibits 1-4, n5 and testimony depositions taken by petitioner on written questions of respondent's employees Jean-Daniel Pasche, Yves Bugmann and Vincent Stauffer, with petitioner's exhibits 130-137; n6

Excerpts from printed publications, submitted by petitioner (Exhibits 76-78);

USPTO documents, submitted by petitioner (Exhibits 97-129);

Discovery documents (Exhibits 79-86), submitted by stipulation of the parties;

Testimony deposition upon written questions taken by respondent of Vincent Stauffer, with respondent's exhibits 1-8 and petitioner's exhibit 1-3; n7

USPTO documents submitted by respondent (Exhibits A-I);

Dictionary definitions submitted by respondent (Exhibits J-O); and

Printed publications submitted by respondent (Exhibits P-S). n8

n5 Petitioner submitted CD-ROM versions of these testimony depositions, as well as the printed versions. It was not necessary to submit the CD-ROMs and, in fact, the rules no longer provide that testimony can be submitted in this manner. See TBMP § 106.03 (3d ed. 2011).

[\*6]

n6 We find it necessary to comment on the listing of exhibits submitted as part of the testimony deposition of Henry Rodriguez. Approximately 60 exhibits are listed in the index as "The Printout." Trademark *Rule 2.123(g)(3)* provides, inter alia, that each deposition must contain "an index of the exhibits, briefly describing their nature and giving the pages at which they are introduced and offered in evidence." Although each of the exhibits are indeed "printouts," the listing of 60 exhibits in this manner is of almost no help to the Board, as it does not allow the judges reviewing the record to easily find the testimony regarding a particular exhibit.

n7 Although the procedure for taking testimony by written questions is a more cumbersome process than taking depositions upon oral examination, see Trademark *Rule 2.124*, the testimony of Messrs. Pasche, Bugmann and Stauffer was taken by this procedure because these witnesses were located outside of the United States.

n8 Some of the articles are in foreign languages; because respondent did not submit translations, they have no probative value. *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1405 (TTAB 1998)

[\*7]

In its trial brief respondent agreed that "the record consists of the items set forth in Petitioner's Trial Brief." p. 2. We agree that the foregoing evidence is of record. n9 In addition, respondent stated that the record also includes the file history for petitioner's application for the mark SWISS LEGEND, noting that petitioner asserted in the petition to cancel that its application to register this mark was refused by the USPTO, and that petitioner had mentioned in its brief that it had petitioned to cancel respondent's registrations after its application for SWISS LEGEND had been refused. Respondent included with its trial brief a declaration by respondent's attorney to which she attached a copy of an Office action in the SWISS LEGEND application, and copies of certain additional USPTO records. With its reply brief petitioner objected to these exhibits, contending that they were not properly made of record. This presents a somewhat unusual situation. Petitioner is correct that attaching a declaration with exhibits to a trial brief is not an acceptable method for making the evidence of record. At the same time, we have petitioner making statements in its brief about its own application [\*8] that are not supported by any evidence properly of record, and respondent in its brief treating those statements as though they are true. Normally, we would view such actions as a stipulation by the parties that petitioner's application had been refused on the basis of respondent's registrations. n10 However, in this case it appears that respondent would not have made such a stipulation if it could not provide further information about the grounds for refusal of petitioner's application. In these circumstances, we both refuse to consider the improperly submitted evidence and decline to treat the information about petitioner's application as stipulated into the record. We add that, in any case, this does not have an effect on our decision, since petitioner's filing of an application, and the Office's refusal of it, would go

to petitioner's standing, and petitioner has otherwise shown its standing through the evidence of its witness Lior Ben-Shmuel.

n9 To the extent that any evidence submitted under a notice of reliance could not properly be made of record by this procedure, we treat the parties' statements as stipulating to the admission of such evidence.  
[\*9]

n10 In point of fact, the September 2, 2004 Office action for petitioner's application that was submitted with respondent's brief advised petitioner of respondent's then-prior pending applications and stated that, if they registered, they might serve as a basis for refusal of petitioner's application.

Petitioner also objected to certain statements made in respondent's brief, contending that they are based on publications and webpages that were never made of record. With the exception of the dictionary definitions, of which we may take judicial notice, these objections are well taken, and no consideration has been given to evidence that was not properly made of record or to statements based on such evidence.

Respondent has raised objections as well, asserting that the deposition testimony of Rick Ruz and Henry Rodriguez consists "of nothing but unreliable hearsay testimony and should be stricken from the record." Brief, p. 2, n.1. Much of this testimony consists of statements made by the witnesses regarding information they received from third parties during telephone conversations with those [\*10] third parties. We agree that this testimony constitutes inadmissible hearsay, as opposed to verbal acts, as petitioner is seeking to use what the third parties said to the witnesses to prove the truth of those statements. The cases that petitioner has cited in arguing that this testimony is not hearsay are inapposite.

Respondent has also objected to the Internet printouts submitted as exhibits to Messrs. Ruz's and Rodriguez's testimony (petitioner's exhibits 3-14 and 18-75), as hearsay. We overrule this objection. Although they do not prove the truth of the statements made therein, the printouts are acceptable to show that the statements were made or the information was reported in the webpages. In fact, printouts from Internet webpages may now be made of record by notice of reliance, without requiring the testimony of the witness printing out the webpages to introduce and authenticate them. See *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031 (TTAB 2010). The benefit to both the parties and the Board of making such evidence of record by notice of reliance is highlighted by the testimony depositions of these witnesses, which consist of page after page in which they [\*11] identify the exhibits as being webpages that they printed.

Respondent also argues that the testimony of petitioner's witnesses Ruz and Rodriguez and the accompanying exhibits lack probative value. We have already ruled that the testimony reporting what third parties told the witnesses in telephone conversations is hearsay and will not be considered. As for the Internet evidence, respondent states that it could not readily verify the veracity of the evidence because Internet postings are transitory. However, the website evidence contains the URLs from which the pages were taken, and therefore respondent could have ascertained whether the webpages were accurate or have been changed. If respondent had shown that the website evidence was no longer accurate, it could have submitted it as a rebuttal to petitioner's evidence. See *Safer*, 94 USPQ2d at 1039 ("The date and source information on the face of Internet documents allow the nonoffering party the opportunity to verify the documents"). Respondent did not submit evidence showing the webpages introduced by petitioner had changed or were no longer accurate, and therefore we give the website evidence the probative value to [\*12] which it is entitled.

Respondent would also have us strike the testimony and accompanying exhibits of Messrs. Ruz and Rodriguez regarding use by third parties of the terms "Swiss" or "Swiss Made" in connection with their watches because the witnesses did not know whether or not the purveyors had been granted a license by respondent, or if respondent was involved in a dispute with the third parties. Although we decline to strike this evidence, to the extent that there is no evidence as to whether the watches satisfy respondent's certification standards, we have considered this in determining the probative weight to be accorded the testimony and exhibits.

The proceeding has been fully briefed, and an oral hearing was held before the Board. n11

n11 It is noted that neither party included parallel cites to The United States Patents Quarterly (USPQ) in their citation of authorities. When cases are cited in a brief, the case citation should include a citation to the USPQ if the case has appeared in that reporter. TBMP §§ 101.03 and 801.03 (3d ed. 2011).

[\*13]

As a preliminary matter, we note that respondent has filed what it has captioned a "Motion to Request Clarification After Oral Argument," a motion that petitioner has opposed. We agree with petitioner that respondent's motion is not seeking clarification of any statement made by the Board during oral argument, but is attempting to submit further comments in answer to questions raised by the judges during oral argument. Accordingly, we have given no consideration to this motion, nor to the statements made by petitioner in its responsive submissions as to what it could have argued if petitioner were to make additional comments. We also point out that Board practice does not allow parties to submit additional comments or clarify their positions after oral hearing, unless specifically requested to do so by the Board. For example, in the present case at the oral hearing the Board, noting that petitioner had submitted all of its evidence under seal, ordered that petitioner resubmit copies of its evidence in which only truly confidential material was redacted. If petitioner had some question about how to comply with the Board's request, perhaps in view of the confidentiality agreements the [\*14] parties had signed, a motion for clarification might have been warranted on this subject.

#### The Parties

The record shows that petitioner is a U.S. company that is a distributor or reseller of various brands of watches. Ben-Shmuel test., p. 6, 40. Petitioner also manufactures and sells watches under its own marks, including SWISS WATCH INTERNATIONAL and SWISS LEGEND. Id., p. 32.

Respondent is a Swiss organization whose purpose is to contribute to the "defense and development of the Swiss watch industry." Stauffer test., response 7. n12 It has a membership of approximately 500 companies or associations linked to the Swiss watch industry; such entities must, with rare exceptions, have their headquarters in Switzerland. Id., 10.1. Respondent visits the premises of applicants for membership in respondent to make sure the watches are produced in compliance with the "Ordinance governing the use of the appellation 'Switzerland' or 'Swiss' for watches." (English translation, hereafter referred to as "the Ordinance.") Id., 10.2. The Ordinance was issued by the Swiss Federal Government. Id., 11.1.2. The Ordinance "provides the conditions under which one may use Swiss names in relation [\*15] with watches and other horological products." Id., 12.2. The Swiss Federal Government, in article 53 of the Ordinance, has entrusted respondent with the task "of attributing identification signs to all producers of Swiss watches and movements and to keep the register thereof." Id., 12.4.1. The bylaws of the Swiss Federal Institute of Intellectual Property (Switzerland's equivalent of the USPTO) entrust respondent with the task of combating infringements of intellectual property rights, including Swiss geographical indications. Id.

n12 Mr. Stauffer's testimony was taken on written questions, and therefore each question and answer was numbered.

We also note that Mr. Stauffer's testimony deposition was marked "confidential" in its entirety, and respondent did not file a redacted copy for the public record. In order to adequately explain our analysis and the facts on which it is based we must refer to some of the testimony and exhibits, although we have tried to be sensitive about revealing anything that may be truly confidential. Further, because proceedings before the Board are public, all papers should be available to the public, except for information that is truly confidential. It is clear that not everything in Mr. Stauffer's testimony fits that description. **Accordingly, respondent is allowed until thirty (30) days after the issue date of this decision to file a redacted version of Mr. Stauffer's testimony, failing which the testimony in its entirety will become part of the public record.**

[\*16]

Standing

Mr. Ben-Shmuel has testified that his company sells, distributes and arranges for the manufacture of watches, including under the trademarks SWISS WATCH INTERNATIONAL and SWISS LEGEND. Therefore, petitioner has shown that it is not an intermeddler, but has a real interest in this proceeding. Accordingly, it has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

#### Certification marks

Because this proceeding involves certification marks, it is useful to review the provisions of the Trademark Act regarding such marks. "Certification mark" is defined in *Section 45* of the Act, 15 U.S.C. § 1127:

The term "certification mark" means any word, name, symbol, or device, or any combination thereof--

- (1) used by a person other than its owner, or
- (2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this chapter,

to certify regional [\*17] or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

Section 4 of the Trademark Act, 15 U.S.C. § 1054, provides:

Subject to the provisions relating to the registration of trademarks, so far as they are applicable, collective and certification marks, including indications of regional origin, shall be registrable under this chapter, in the same manner and with the same effect as are trademarks, by persons, and nations, States, municipalities, and the like, exercising legitimate control over the use of the marks sought to be registered, even though not possessing an industrial or commercial establishment, and when registered they shall be entitled to the protection provided in this chapter in the case of trademarks, except in the case of certification marks when used so as to represent falsely that the owner or a user thereof makes or sells the goods or performs the services on or in connection with which such mark is used. Applications and procedure under this section [\*18] shall conform as nearly as practicable to those prescribed for the registration of trademarks.

Section 14(5), 15 U.S.C. § 1064(5) provides that a petition to cancel a registration of a mark may be brought:

At any time in the case of a certification mark on the ground that the registrant (A) does not control, or is not able legitimately to exercise control over, the use of such mark, or (B) engages in the production or marketing of any goods or services to which the certification mark is applied, or (C) permits the use of the certification mark for purposes other than to certify, or (D) discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies.

In addition, as with all registrations, a petition to cancel a certification mark registration may be brought under *Section 14(3)* at any time "if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered," or if the registration was obtained fraudulently.

Petitioner has petitioned to cancel respondent's certification marks on grounds [\*19] A, C and D enumerated in Section 14(5), as well as the grounds of genericness and fraud set forth in Section 14(3). The standard of proof for cancelling certification mark registrations is the same as for cancelling a trademark registration, namely, petitioner bears the burden of proving its case by a preponderance of the evidence. *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 906 F.2d 1568, 15 USPQ2d 1359, 1361 (Fed. Cir. 1990).

Claim 1: Respondent permits its marks to be used for purposes other than to certify

The first ground discussed by petitioner in its brief is that respondent has permitted use of its certification marks for purposes other than to certify (Section 14(5)(C)). Petitioner bases this claim on the fact that respondent allows its members and licensees to use trademarks that include the word SWISS. Petitioner points to numerous uses of such marks, including WENGER SWISS MILITARY, SWISS ARMY, and DAVOSA SWISS.

The problem with petitioner's position is that it treats these third parties' uses of their various marks as though they are using the mark SWISS *per se*, i.e., petitioner views [\*20] the various SWISS formative marks used by the third parties as though they constitute a trademark use of respondent's certification mark SWISS. However, respondent's certification mark is not LEONARD SWISS or WENGER SWISS MILITARY or any of the marks used by respondent's members or licensees. n13 Although a certification mark cannot also be used as a trademark, for that prohibition to apply, the mark must be "identical or substantially or virtually identical." *In re 88Open Consortium Ltd.*, 28 USPQ2d 1314 (TTAB 1993) (88OPEN COMPATIBILITY CERTIFIED and design could be registered as a certification mark despite the applicant's ownership of a trademark registration for 88OPEN). It is clear that all of the third-party marks that are of record contain additional wording and/or design elements such that they cannot be considered identical or substantially or virtually identical to respondent's marks. We are not persuaded by petitioner's argument that respondent's members' and licensees' "trademarks are not sufficiently separate and distinct from Registrant's certification marks to satisfy this Board's requirement that the difference in purpose between the marks 'would be recognized [\*21] by the purchasers of the certified goods'" [quoting *In re Monsanto*, 201 USPQ 864, 869 (TTAB 1978)], and that "[t]he salient and distinguishing feature of these trademarks is the term 'Swiss.'" Reply brief, p. 10. On the contrary, the additional elements in the various marks clearly make these marks different from SWISS and from SWISS MADE.

n13 Petitioner has not pointed to any trademark use by third parties of SWISS MADE, and the record does not reflect any.

We acknowledge that, in general, entities that use a registrant's certification mark do not include the mark as part of their own trademarks, and that there are pitfalls to allowing users of the certification mark to do so. n14 However, trademark law does not prohibit a certification mark owner from permitting such use. Petitioner has quoted language from Section 19.92.50 of 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, 19-277 (4th ed. 2002), to support its claim that a certification mark owner is required to [\*22] protect its mark: "[E]ven where a defendant's product contains ingredients which have been certified by the owner of a certification mark, the defendant's incorporation of that certification mark into its own composite trademark might be likely to cause confusion as to sponsorship, affiliation or connection." The context of the quoted language relates to whether the Board could find *likelihood of confusion* where a certification mark owner brought an action against the user of a mark that, without permission, incorporated the certification mark into its own mark. n15 It does not stand for the proposition that a certification mark owner may not permit an authorized user to include the certification mark within the user's own trademark. n16

n14 For example, if the certifying authority determines that a user of the term is not complying with the certification standards, the certifying authority may have to undertake a cancellation proceeding or court action in order to have that party's registration cancelled. Further, the inclusion by many different entities of a certification mark in their individual trademarks may make it more difficult for the owner of the certification mark to prove likelihood of confusion by a third party that attempts to use that same term in its own mark.

[\*23]

n15 The case cited in McCarthy in support of this statement was *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875 (TTAB 1998), which McCarthy describes as "denying summary judgment of dismissal since it is possible that a likelihood of confusion with opposer's COGNAC certification mark could result from applicant's CANADIAN MIST AND COGNAC trademark for a blend of Canadian whiskey and genuine COGNAC brandy."

n16 The other cases cited by petitioner involving likelihood of confusion grounds are similarly inapposite.

Petitioner also argues, in support of this claim, that respondent has allowed the use by non-authorized third parties of marks that incorporate the term SWISS, and also has allowed the use of SWISS and SWISS MADE in a non-trademark fashion to promote the sale of watches. Aside from the fact that none of the third-party uses is for marks that are "identical or substantially or virtually identical" to SWISS or SWISS MADE, the prohibition as to using the same mark as a certification mark and trademark applies to uses that are [\*24] made or authorized by the certification mark owner. Thus, this argument that respondent has "allowed" non-authorized uses is more appropriately considered in conjunction with the claim that respondent does not control use of its certification marks, and in fact petitioner has referred throughout Section B of its brief ("Registrant does not control use of its certification marks") to the facts and arguments it has made here. Therefore, we address it below.

#### Claim 2: Respondent does not control use of its marks

Section 14(5)(A) of the Trademark Act provides that the registration of a certification mark may be cancelled if the registrant does not control, or is not able legitimately to exercise control over, the use of such mark. "The purpose of requiring control over use of a certification mark, as with a trademark, is two-fold: to protect the value of the mark and its significance as an indication of source, and to prevent the public from being misled or deceived as to the source of the product or its genuineness." *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1886 (TTAB 2006), citing *Midwest Plastic Fabricators, Inc. v. Underwriters Labs., Inc.*, 906 F.2d 1568, 15 USPQ2d 1359, 1362 (Fed. Cir. 1990). [\*25] The statute does not define "control." Case law has interpreted this provision in two ways. One is that the owner of the mark has, implicitly or explicitly, given permission to others to use the mark without ensuring that their products or services meet the certification mark owner's standards. For example, in *Midwest Plastic Fabricators*, it was claimed that the certification mark owner, Underwriters Laboratories, did not adequately inspect the products on which it allowed companies to apply the UL certification mark. The second interpretation of this provision is akin to the mark becoming generic, i.e., that the certification mark owner has failed to control use by third parties to the extent that the mark no longer acts as an indicator of source, or more particularly, as an indicator of certification of the products or services. See *Tea Board of India*, 80 USPQ2d at 1886.

Petitioner bases its claim that respondent does not control use of its certification marks on the contention that there is "widespread unauthorized use of the term SWISS by third parties who are not members or licensees of Registrant's organization." Brief, p. 23. Petitioner has listed, at pages 18-21 of [\*26] its brief, approximately 22 trademarks that include the term SWISS. n17 Thus, petitioner's claim is more akin to the second interpretation discussed above, since petitioner does not claim that respondent has failed to ensure that its members and licensees follow its standards. n18 To the extent that petitioner is claiming that the unauthorized uses are so extensive that SWISS and SWISS MADE have ceased to function as certification marks because the words are generic, we will address that subsequently. We confine our comments here to whether respondent has made adequate efforts to control the unauthorized use of its marks.

n17 As part of the record adduced by petitioner, it submitted approximately 75 exhibits consisting of Internet printouts showing the term SWISS used for various watches offered for sale, without making a distinction as to whether the users of the trademarks were members or licensees of respondent, whose use complied with respondent's certification requirements. Respondent had provided such lists to petitioner through discovery, and both petitioner and respondent have made them of record, petitioner through a notice of reliance and respondent as an exhibit to Mr. Stauffer's testimony. We assume that petitioner has listed in its brief all the trademarks it believes are being used without respondent's permission or control.

[\*27]

n18 There is some question about whether one or two of respondent's members may, with particular brands, not have followed all of the requirements of the Ordinance. In any event, not only has this not been clearly proven, but any such misuse is so limited that it would not be a basis for cancelling the registration. As stated *infra*, control does not have to be absolute.

Respondent's witness, Vincent Stauffer, has testified as to respondent's actions with respect to the unauthorized uses asserted by petitioner, and to respondent's policing efforts in general. We are somewhat hampered in our discussion of these activities because, as we stated previously, Mr. Stauffer's testimony has been submitted under seal. n19 We have tried to respect the information in the testimony that is truly confidential, and will refer to it generally.

n19 At the oral hearing, after noting that the entire testimony deposition of petitioner's witness Lior Ben-Shmuel had been marked "confidential," the Board ordered petitioner to submit a redacted version for the public record. We failed to give a similar instruction to respondent regarding Mr. Stauffer's testimony because we were not aware at the time that a redacted version had not been submitted, since the Board generally reviews only the briefs, and not the entire record, prior to oral argument. It was clear from the parties' briefs and the statements made during oral argument that Mr. Ben-Shmuel's entire testimony had been submitted under seal, but the briefs did not similarly reveal that the Stauffer testimony had been marked "confidential" in its entirety. As noted in footnote 12, respondent must now provide a redacted version of Mr. Stauffer's testimony.

[\*28]

Respondent has shown, through the testimony of Mr. Stauffer, that it engages in significant activities to ensure that only companies adhering to its standards (and by extension, the standards of the Swiss Ordinance) use the terms SWISS or SWISS MADE in connection with watches. It monitors all trademark applications in Class 14 worldwide and files opposition proceedings when there are dubious cases, monitors the use of SWISS, SWITZERLAND and SWISS MOVEMENT on watches displayed in watch-specialized magazines, buys or requests watch samples and inspects them, and inspects watches which have been seized by police forces or customs authorities worldwide. (response 15.1.1). In the United States, respondent has filed 25 oppositions against marks incorporating the terms SWISS or SWITZERLAND (response 16.1.3), with six settled via an agreement by which the applicant agreed to comply with the standards of the Swiss Ordinance (16.1.5, 16.1.6), and ten resolved with the withdrawal or abandonment of the application (16.1.7). Respondent also has worked with customs in the United States to prevent the importation of watches bearing the term "SWISS" which did not meet the standards of the Swiss Ordinance. [\*29] (response 15.1.4).

Of the 22 uncontrolled trademark uses asserted by petitioner, Mr. Stauffer has testified that respondent has brought oppositions against six of them, and is involved in actions against two others. n20 Others of the remaining asserted uncontrolled trademark uses do not involve registered marks, while two other applications have been abandoned, and respondent has contacted other companies to determine what actions will be taken.

n20 It is unclear from the wording of the questions in Mr. Stauffer's testimony whether these actions are oppositions.

Although petitioner acknowledges that respondent is not required to exercise absolute control, and that respondent has taken some actions, petitioner asserts that "it is reasonable to expect greater control than demonstrated by Registrant and its predecessor in interest when they have had over 75 years, since the alleged date of first use in 1931, to monitor and limit the unauthorized uses of 'Swiss' and 'Swiss Made' products in the U.S." Brief, [\*30] p. 23. The statute does not define "control" or indicate the degree of control required. As petitioner acknowledges, absolute control is not only not required, but the Board has recognized that absolute control would be impossible. *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d at 1888; see also *Midwest Plastic Fabricators*, 15 USPQ2d at 1362 (the certification mark owner's affirmative duty to control its certification mark does not mean "absolute control" since this would be "impracticable, if not impossible to satisfy"); *Engineered Mechanical Services, Inc. v. Applied Mechanical Technology, Inc.*, 584 F.

*Supp. 1149, 223 USPQ 324 (M.D. La. 1984)* ("The owner of a mark is not required to constantly monitor every nook and cranny of the entire nation and to fire both barrels of his shotgun instantly upon spotting a possible infringer ....").

The question is whether the control is adequate. As stated in *Midwest Plastic Fabricators, 15 USPQ2d at 1363*, "the owner must take reasonable steps, under all the circumstances of the case, to prevent the public from being misled." Respondent has an extensive worldwide monitoring and enforcement [\*31] system in place, including working with U.S. Customs officials. It has, as noted, brought numerous oppositions in the United States, and negotiated the abandonment or withdrawal of numerous applications. It has also filed letters of protest with the USPTO. We find, in the circumstances of this case, that respondent's control is adequate.

We also note petitioner's contention that respondent cannot control use of its certification marks "because of widespread third party use prior to Registrant's date of registration of its Marks, of the designation SWISS in connection with watches that do not originate in Switzerland." Brief, p. 24. It appears that petitioner is arguing that respondent can take no action against such registrations, and therefore, in effect, such third-party uses are permanent. However, petitioner's position is not correct. The date of the registration of respondent's marks is not the operative date for respondent to bring an action, since its rights do not arise only with the issuance of its registrations.

Petitioner has also submitted website evidence in which such terms as "Swiss," "Swiss made," "Swiss quartz," "Swiss movement," and "Swiss collection" have been [\*32] used in the descriptions of watches that are offered for sale on the various webpages. Our review of these exhibits shows that in most cases SWISS is used to identify the movements used in the advertised watches. Mr. Stauffer has also testified, with respect to some of these uses, that he is unfamiliar with them, or could only say that the trademarks used in connection with the watches have not been registered in the United States. n21

n21 Because of the nature of testimony on written questions, it is not possible to pose a follow-up question upon learning of an answer; instead, one must anticipate what the answer will be and submit a follow-up question in advance. As a result, the responses are not as complete as can be obtained through a deposition upon oral examination.

We do not regard accurate statements describing that a watch has a Swiss movement as showing that respondent has allowed uncontrolled use of its marks. Nor are instances of misuse that had not come to respondent's attention, when the record [\*33] shows that respondent has made very clear efforts to monitor third-party uses of SWISS and SWISS MADE. Although we acknowledge that there appear to be instances of misuse of SWISS, the instances that are in the record are not so extensive for us to conclude that the registrations should be cancelled. "[T]he mere fact of misuse ... is not sufficient to raise an inference that the control was not adequate or that [SWISS or SWISS MADE] has lost all significance as a mark. Even if control is not maintained and misuse occurs, it must be shown that the misuse was of such significance to permit an inference that the mark is generic." *Tea Board of India, 80 USPQ2d at 1888*.

### Claim 3: Respondent discriminates

*Section 14(5)(D)* provides for the cancellation of a certification mark if the registrant "discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies." The basis for petitioner's claim of discrimination is not that respondent refuses to certify the goods of those who maintain the standards which its marks certify, but that respondent's standards are wrong. Petitioner [\*34] argues that respondent's requirements that the watch movement be cased up in Switzerland and that the final inspection of the watch take place in Switzerland are unnecessary. This position is not well taken. The statutory provision is not dependent upon whether the Board or a third party likes the standards, or sees the need for them; the statute requires only that the owner of the certification mark allow any entity that meets the standards, whatever the owner determines those standards to be, to use the mark.

Petitioner also argues that respondent discriminates in the approval for use of its certification marks because it may deny membership in its organization. We are not persuaded by this argument. Although members of its organization are permitted to use the certification marks (because to be a member an entity must comply with the standards set forth in the Ordinance), there is no requirement that an entity be a member of respondent in order to use the certification marks.

Indeed, respondent has provided a list of companies that are not members but that are licensed to use its certification marks.

Petitioner has also argued that respondent's standards discriminate against U. S. companies that adhere to U.S. customs regulations. In its main brief petitioner has pointed to the Tariff Act of 1930, which provides that the country of origin of the movement determines the country of origin of the watch, and asserts that therefore U.S. Customs "would recognize 'Swiss Made' as an appropriate marking on the watch." pp. 25-26. Whether or not U.S. Customs would consider a watch to be made in Switzerland for duty purposes, or would consider "Swiss Made" to be acceptable to indicate the country of origin, it does not follow that respondent is discriminating against U.S. companies in terms of the use of its certification marks. Again, the language of the statute is clear: the discrimination contemplated by the statute refers to a refusal by the certification mark owner to certify "the goods or services of any person who maintains the standards or conditions which such mark certifies." n22

n22 In its reply brief, petitioner has asserted a public policy argument based on U.S. customs regulations, stating that U.S. companies cannot simultaneously comply both with U.S. customs regulations and with respondent's certification mark standards. To the extent that there is any conflict (and we do not say that there is), this is not the forum to resolve it. The grounds upon which a petition to cancel a certification mark may be brought have been set out elsewhere in this opinion. "Against public policy" or "conflicts with Customs requirements" are not permissible grounds for a cancellation proceeding. Cf. *The Institut National Des Appellations D'Origine v. Vinters International Company, Inc.*, 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992) ("We deal here only with the issue of registrability and what may be registered in the PTO. It is not our concern or that of the PTO what [the applicant] must do to comply with the BATF labelling requirements.")

[\*36]

In short, petitioner has not submitted any evidence that respondent has refused to permit the use of its certification marks for watches meeting its standards, namely, the watch movement is made in Switzerland, the watch is "cased up" in Switzerland, and the final inspection of the watch takes place in Switzerland. n23

n23 Petitioner has stated that respondent denied petitioner "its certification." Petitioner's arguments in connection with this statement have been marked "confidential," and therefore we cannot discuss them. Suffice it to say that there is no evidence that petitioner requested respondent to allow it to use respondent's certification marks for watches, or that petitioner's watches met respondent's certification mark standards.

#### Claim 4: Genericness

A registration for a certification mark, like other trademarks, may be cancelled at any time if the mark becomes the generic name for the goods or services. Trademark Act *Section 14(3)*. Petitioner claims that respondent's marks are generic [\*37] for watches, clocks and their component parts and fittings because the terms "primarily signify to the American purchaser the type of watch regardless of regional origin." Brief, p. 27. n24

n24 In this section of petitioner's brief, it directs its comments to respondent's mark SWISS, even titling the section "The term SWISS has become a generic term for the goods in question." However, because there are occasional references to SWISS MADE as well, we do not consider petitioner to have waived the ground of genericness with respect to SWISS MADE.

Petitioner's first argument is based on the case *In re Cooperativa Produttori Latte E Fontina Valle D'Acosta*, 230 USPQ 131 (TTAB 1986). An Italian cooperative had applied to register as a certification mark for "FONTINA cheese"

the following design, and the examining attorney required a disclaimer of FONTINA on the ground that it merely described or is the generic name for a type of cheese. The Board found that "fontina" [\*38] is not a certification mark indicating regional origin, but that the lower-case treatment of this word in various references as naming a kind of cheese with certain characteristics, and the evidence showing there is a domestic fontina cheese

demonstrates to us that, to the American purchaser, "fontina" primarily signifies a type of cheese (much like brie, swiss, parmesan or mozzarella) regardless of regional origin, rather than a mark of certification.

*Id.* at 134.

Petitioner argues that similar evidence of record in this proceeding "supports Petitioner's position that, for the goods at issue, "Swiss" and "Swiss made" primarily signify to the American purchaser the type of watch regardless of regional origin." Brief, p. 27. The evidence to which petitioner points is "common usages by the press of the terms "Swiss watch" and "Swiss precision" to convey certain qualities associated with accurate watches." *Id.* at 28. The excerpts submitted by petitioner, as part of its Exhibit 76, include the following:

... who compares the craftsmanship of a car to a fine Swiss watch. *Milwaukee Journal Sentinel*, Sept. 7, 2003;

"It [an airplane] runs like [\*39] a fine Swiss watch," he said, noting that the plane goes about 90 miles per hour. *The Detroit News*, Sept. 5, 2003;

Manhattan is like a fine Swiss watch, the old-fashioned kind that you wind up. They are incredible pieces of precision workmanship ... *Chillicothe Gazette*, August 20, 2003;

Instead of ticking like a Swiss watch, Vanderbilt's offense looked more like Swiss cheese when it first made contact with the Commodores' defense. *The Tennessean*, August 16, 2003. n25

n25 Besides these uses of "Swiss watch" as a simile or metaphor, petitioner also submitted excerpts of articles in which the phrase "Swiss watch" refers to actual Swiss watches, for example, "Swatch, the Swiss watch maker, made a name for themselves in the early '80s ..."; and "For the couple with a taste for classic Swiss watches with beautiful Volunteer faces, there were two ...."

We find this evidence unpersuasive in showing that the term "Swiss watch," when it is used for watches, has the meaning of any precise [\*40] watch, regardless of geographic origin. On the contrary, the use of "Swiss watch" as a metaphor for something of precision workmanship shows the renown of Swiss watches. In no way is this evidence similar to the evidence adduced in the *Fontina* case, where the term "fontina" was shown to refer to a type of cheese.

Petitioner also contends that SWISS and SWISS MADE have become generic for a category of watches, irrespective of where the watch is made, because of the evidence of use of SWISS by third parties that are not respondent's members or licensees and use SWISS as a trademark on goods that do not originate in Switzerland. As we indicated in discussing petitioner's claim that respondent does not control use of its marks, petitioner submitted approximately 75 exhibits consisting of Internet printouts showing the term SWISS used in connection with various watches. The witnesses who authenticated the Internet printout exhibits did not know whether the watches shown therein originated in Switzerland. In addition, during his testimony, Mr. Ben-Shmuel was asked about various third-party SWISS-formative marks for watches. Mr. Ben-Shmuel testified that some of the watches he was asked [\*41] about did not originate in Switzerland. However, because the documents he referred to in his testimony were not made of record, we cannot ascertain in what way SWISS or SWISS MADE was used. n26 Further, the basis for his knowledge was, in most cases, rather vague. For example:

Q: Do their watches [Skagen] meet the Ordinance requirements?

A: I don't know for certain but I don't think so. I don't know for certain.

Test. p. 73

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Q: Have you--do their watches, the Aqua Swiss watches meet the Ordinance requirement?

A: Again, and this is a brand that I have never dealt with, but I am pretty familiar with them; I have seen them advertised, and I have seen them around. I was offered deals with them but I never purchased it. And, from my understanding, not the Swiss Federation, they probably do not abide by the Swiss Federation rules but they do use 100 percent Swiss made movements which would provide by that.

Q: And how would they not meet the Swiss Ordinance?

A: Just the fact that they don't want to assemble the final inspection in Switzerland.

Q: And how do you know that?

A: Just from hearsay when we were discussing on the deal or [\*42] things like that. Now, they may do it on some of their watches. But the particular offer, you know, that I was offered at the time, is going back a few years, from my recollection, that wasn't the case.

Test. p. 75.

n26 There is no indication in the record that the documents reviewed by Mr. Ben-Shmuel in connection with his testimony were the exhibits introduced during the testimony of petitioner's other witnesses. The transcript includes only the statement by petitioner's attorney that "For the following series of questions I am just going to use a document to refresh his memory." p. 15.

This is not to say that all uses of SWISS and SWISS MADE in connection with watches that are of record are authorized or meet respondent's certification requirements. Certainly the testimony of Vincent Stauffer, respondent's employee, shows that there are uses that do not conform to respondent's certification standards and that, while respondent has taken many actions to stop unauthorized uses, it has not prevented [\*43] all of them. The question, though, is whether, as a result of these unauthorized uses, SWISS and SWISS MADE have lost their capacity to function as certification marks indicating geographic origin of the watches in Switzerland, and instead are viewed as generic "indicators of certain qualities or characteristics." Petitioner's Brief, p. 29.

First, we point out that a certification mark that is used to certify geographical origin can also certify certain qualities and characteristics of the product that are due to factors associated with the geographic area. *Tea Board of India, 80 USPQ2d at 1887*. In fact, the very definition of a certification mark is that it can certify quality, or accuracy, or other characteristics. Thus, the terms SWISS and SWISS MADE for watches can certify the quality or characteristic that the watches are timepieces of great precision, without affecting their status as certification marks. On the contrary, the association of Switzerland with precision watches actually enhances the certification mark function of SWISS and SWISS MADE.

We find petitioner has not proved that SWISS and SWISS MADE have lost their significance as indicators of geographic [\*44] source. The issue is not whether the public is expressly aware of the certification function of the marks or the certification process underlying use of the marks, but rather is whether the public understands that goods bearing

the marks come only from the region named in the marks. *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1885 (TTAB 1998). The relatively small number of clearly unauthorized third-party uses of SWISS or SWISS MADE that are in the record are insufficient to show that these terms, when used in connection with watches, refer to any watch that works with precision, as opposed to indicating their geographic origin. As the Board stated in *Tea Board of India*, 80 USPQ2d at 1893, "even assuming applicant had produced evidence of misuse, that is, use indicating a different geographic source for the tea or use in connection with nongenuine tea, we will not infer that the mark has become generic unless it is also shown by applicant that the misuse is so widespread and of such duration that it has caused DARJEELING to lose all significance as a mark."

Petitioner has also argued that "the terms 'Swiss' and 'Swiss [\*45] made' have become generic for a category of horological instruments, namely watches that incorporate movements in the Swiss style or use Swiss-developed mechanics, irrespective of where the watch is made." Brief, p. 29. It appears to be petitioner's position that SWISS identifies a type of movement, or a watch using such a type of movement. However, the evidence of record does not support such a finding. Certainly we cannot ascertain from the exhibits advertising various watches as having a "Swiss movement" that the movements do not come from Switzerland, or that "Swiss movement" refers to a specific type of movement that was originally developed in Switzerland but is now made throughout the world. As noted, the witnesses who introduced these exhibits during their testimony did not know whether or not the watches had Swiss movements, i.e., movements made in Switzerland. Petitioner cites to the testimony of Mr. Ben-Shmuel, at pages 8-9, in support of its argument, but that testimony is far from clear, and certainly insufficient to meet petitioner's burden of showing that SWISS is a generic term for watch movements, and therefore generic for watches containing a particular type of movement: [\*46]

Q: Based on your knowledge of the industry, and your experience, what is the US consuming public's understanding of the term "Swiss?"

A: You know, again, I guess, you know, the most important aspect of a timepiece, you know, is the brains of the actual timepiece, which is, you know, a movement if it's a quartz or an automatic movement. And, you know, when people look for--when consumers, in my experience, when they're looking into a quality, that they care about those major components which is art--is the Movement.

Q: Based on your knowledge and industry experience, is the term "Swiss" used in connection with watches that are made outside of Switzerland?

A: Yes, definitely. There are many companies out there that builds [sic] watches outside of Switzerland, but import watches into other countries, including the United States and abroad, obviously, that have "Swiss" in their name or somewhere on their watch, that the watches are not [sic] made or assembled in China, or somewhere else around the world.

(objections omitted).

Petitioner also asserts that "certification marks that act as an indicator of geographic origin generally arise due to the use [\*47] of a geographic term in connection with products tied to the land," brief, p. 29, and appears to contend that because respondent's marks SWISS and SWISS made are used in connection with manufactured goods--watches--consumers will not view the terms as indicating goods that invariably come from Switzerland. To the extent that petitioner is suggesting that geographic terms cannot function as certification marks unless they are used to certify goods that come from the land, we are unaware of any case law that would support such a position. Even in those situations where a certification mark is used in connection with products having an agricultural origin, there is a recognition that processing of the product, even when that processing does not have an intrinsic connection with the land, can be an element of the certification standards. See, for example, *Bureau National Interprofessionnel Du Cognac v. International Better Drinks Corp.*, 6 USPQ2d 1610 (TTAB 1988), in which the methods of distillation and aging conditions were, in addition to the grapes grown in the region, part of the standards for the use of the certification mark COGNAC. In this case, the manufacture of watches [\*48] is so closely associated with Switzerland that even Mr. Ben-Shmuel testified that "just like the Swiss are known for chocolate, they are known for old watch making," and that "it's [Swit-

erland] a region which is known for where the watch industry kind of started," p. 7; "the Swiss are considered legends in the watch industry" and the "Swiss are associated with the watch industry," pp. 50-51.

In short, the evidence shows that the geographic connection between watches and Switzerland is very strong, and that when the terms SWISS and SWISS MADE are used in connection with watches, consumers will understand that they signify the geographic origin of the goods, and will not regard the marks as generic terms.

#### Claim 5: Fraud

Although in its petition for cancellation petitioner did not specify that the ground of fraud was limited to respondent's registration for SWISS MADE, it is clear from petitioner's briefs that this is the case. See Subhead C: "Registrant committed fraud on the PTO in registering SWISS MADE." Brief, p. 24. n27 Petitioner asserts that in response to the Office action dated January 17, 2003, respondent submitted an exhibit containing its certification standards [\*49] coupled with the abstract of the Swiss Ordinance on which its standards are based. Petitioner contends that "registrant's decision to submit both documents was calculated to outfox the examiner" because the certification standards document respondent submitted "provides no description of the standards used by Registrant to determine whether others may use the mark SWISS MADE"; that "[t]he standards speak only of the indicators 'Swiss,' 'Swiss case,' 'Swiss dial,' and 'Swiss parts.'" Id. It is petitioner's position that the submission of the Ordinance, "which does discuss use of 'Swiss made,' was made to confuse the examiner into believing Registrant's standards covered" the mark SWISS MADE in order to overcome the Office action and obtain a registration. Id.

n27 Moreover, the basis for petitioner's fraud claim appears to have changed. In the petition for cancellation petitioner alleged that respondent "intentionally misstated matters in its application or failed to state that it is not a government, one of the departments of a government, or a body operating with governmental authorization ...." Petitioner did not pursue any claim that respondent failed to inform the examining attorney that it is not a government department and, indeed, it appears that respondent does operate with governmental authorization. Although petitioner did not plead, with the specificity required, that its fraud claim was based on misstatements in connection with respondent's certification standards, the parties have proceeded at trial as if that were the claim, and we therefore treat the pleadings as amended to conform to the evidence. See *Fed. R. Civ. P. 15(b)*.

#### [\*50]

Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with its application with an intent to deceive. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009); *Torres v. Cantine Torresella S.r.l.* 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986). A party seeking cancellation of a trademark registration for fraudulent procurement bears a heavy burden of proof. *W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 377 F.2d 1001, 54 C.C.P.A. 1442, 153 USPQ 749, 750 (CCPA 1967). Indeed, "the very nature of the charge of fraud requires that it be proven 'to the hilt' with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party." *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981).

The file for the registration of SWISS MADE shows that, when the underlying application was being examined, the examining attorney, on January 17, 2003, issued an Office action requiring respondent to "submit a copy of the standards used to determine whether others [\*51] may use the certification mark with their goods or services." In response, respondent submitted "a copy of its standards as well as an abstract of the Swiss Ordinance on which these standards are based." Petitioner is correct that the standards submitted by respondent do not specifically use the term "Swiss made," and state that "A watch is considered to be 'Swiss' if: 1. its movement is made in Switzerland; 2. its movement is cased up in Switzerland; and 3. the manufacturer carries out the final inspection in Switzerland." This is essentially the same wording that appears in Article 1(a) of the Ordinance. It is Article 3, paragraph 4 of the Ordinance that makes reference to the term "Swiss made": "4. The 1st and 3rd paragraphs are also applicable when these appellations are used in translation (in particular "Swiss", "Swiss made", "Swiss movement") with the true indication of origin of the watch or with the addition of words such as 'style', 'type', 'form' or other word combinations." n28

n28 Paragraph 1 of Article 3 states that "The name 'Switzerland', indications such as 'Swiss', 'Swiss product', 'manufactured in Switzerland', 'Swiss quality' or other appellations which contain the name 'Swiss' or 'Switzerland' or which may be confused therewith may be used solely for Swiss watches or watch movements," while paragraph 3 states "The indication 'Swiss movement' may be applied to watches which contain a Swiss movement. The word 'movement' must appear written out in full in the same type-face, dimension and colour as the appellation 'Swiss'."

[\*52]

The fact that the term SWISS MADE does not appear in respondent's "Standards" is not a sufficient basis for us to find fraud. Respondent's response to the Office action was quite clear; it advised the examining attorney that it was submitting "a copy of its standards as well as an abstract of the Swiss Ordinance on which these standards are based." The submissions are also clearly marked. The standards are titled "The Standards," and the Ordinance, which is a separate document, is titled "Ordinance governing the use of the appellation 'Switzerland' or 'Swiss' for watches." Respondent made no false statements to the examining attorney, and a false statement is one of the critical elements in proving fraud. Further, there must be an intent to deceive the USPTO. *Bose, 91 USPQ2d at 1941*. Although deliberately omitting relevant portions of a document, or making a statement that, while true, gives only part of the story and therefore is deliberately designed to mislead, may be treated as a false statement in its effect and also show the necessary element of intent, that is clearly not the case here. Petitioner's assertion that respondent submitted both documents in order to [\*53] "outfox the examiner" is not a substitute for showing that submitting both documents gave an incomplete picture and, in effect, resulted in the withholding of necessary information. The examining attorney was given both the Standards and the Ordinance; both were clearly marked; and respondent clearly stated in its response that it was submitting both, and that the Standards were based on the Ordinance.

We find that petitioner has not proven its asserted ground of fraud.

#### **Legal Topics:**

For related research and practice materials, see the following legal topics:

Trademark LawProtection of RightsRegistrationPrincipal RegisterTrademark LawSpecial MarksCertification  
MarksTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsCancellationsStanding



In re The Eyecare Foundation, Inc.

Serial No. 76701339

Trademark Trial and Appeal Board

2011 TTAB LEXIS 65

March 10, 2011, Decided

**DISPOSITION:**

[\*1]

Decision: The refusal to register under Section 2(e)(1) of the Lanham Act is hereby affirmed.

**COUNSEL:**

Myron Amer of Myron Amer, P.C. for The Eyecare Foundation, Inc.

Elissa Garber Kon, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

**JUDGES:** Before Bucher, Cataldo and Mermelstein, Administrative Trademark Judges.

**OPINION BY:** BUCHER

**OPINION:**

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

Opinion by Bucher, Administrative Trademark Judge:

The Eyecare Foundation, Inc. seeks registration on the Principal Register of the mark **THE EYE CANCER FOUNDATION** (*in standard character format*) for services recited in the application, as amended, as follows:

"charitable services, namely, charitable fundraising and providing grants to physicians for research on eye diseases" in International Class 36; and

"providing medical information to people with eye diseases and their families about their diseases and possible treatment options via the Internet; providing a charity-based, Internet database of patient medical information in the field of eye diseases where pat[i]ents can inquire about medical issues and procedures from other patients and can [\*2] relay information about their medical experience for support and community" in International Class 44. n1

n1 Application Serial No. 76701339 was filed on January 25, 2010, based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. No claim is made to the exclusive right to use the word "Foundation" apart from the mark as shown.

The Trademark Examining Attorney refused registration on the ground that the term is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). The record shows that applicant is also the owner of a registration for the mark **THE EYECARE FOUNDATION** for services similarly recited as

"charitable services, namely, charitable fundraising and providing grants to physicians for research on eye cancer and eye diseases" in International Class 36, and

"charitable services, namely, providing healthcare counseling and support to people with eye cancer and providing medical information to [\*3] people with eye cancer and other eye diseases and their families about their diseases and possible treatment options via the Internet" in International Class 44. n2

n2 Registration No. 2786259 issued on November 25, 2003. Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. No claim is made to the exclusive right to use the word "Foundation" apart from the mark as shown. Section 2(f) showing of acquired distinctiveness as to the mark in its entirety.

After the Trademark Examining Attorney made the refusal final, applicant appealed to this Board.

We affirm the refusal to register.

As a preliminary matter, although applicant argues against our consideration of some of the Trademark Examining Attorney's dictionary entries for the word "Foundation," we disagree inasmuch as this Board may take judicial notice of dictionary entries. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). [\*4] In any case, the Trademark Rules and United States Patent and Trademark Office practice support our consideration of all of these dictionary entries appropriately placed into the record by the Trademark Examining Attorney.

Despite the fact that applicant earlier disclaimed the generic term "Foundation" in this application, and did so years ago in its earlier registration, applicant appears to be arguing in its most recent submissions that, within this composite mark, the word "Foundation" has source-indicating significance in connection with the recited services. We disagree. The dictionary definitions uniformly support the disclaimer of the word "Foundation" as generic for this organization. Furthermore, the Trademark Examining Attorney placed into the record copies of the following third-party registrations wherein the word "Foundation" is disclaimed by the following array of cancer foundations:

NATIONAL FOUNDATION FOR CANCER RESEARCH<sup>1</sup>    SAMUEL WAXMAN CANCER RESEARCH FOUNDATION<sup>2</sup>    NATIONAL CHILDHOOD CANCER FOUNDATION<sup>3</sup>



### LUNG CANCER RESEARCH FOUNDATION

Dedicated to Discovery



n3 n4 n5 n6 n7 n8 n9 n10



n11 n12 n13 n14 n15 n16

n3 Registration No. 1992402 issued on August 13, 1996; renewed. No claim is made to the exclusive right to use the words "Foundation for Cancer Research" apart from the mark as shown.

[\*5]

n4 Registration No. 3397207 issued on March 18, 2008. No claim is made to the exclusive right to use the words "Cancer Research Foundation" apart from the mark as shown.

n5 Registration No. 2597035 issued on July 23, 2002; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. No claim is made to the exclusive right to use the words "Childhood Cancer Foundation" apart from the mark as shown.

n6 Registration No. 3380558 issued on February 12, 2008. No claim is made to the exclusive right to use the words "Lung Cancer Research Foundation" apart from the mark as shown.

n7 Registration No. 3721477 issued on December 8, 2009. No claim is made to the exclusive right to use the terms "Ovarian Cancer" or "Ovarian Cancer Foundation" apart from the mark as shown.

n8 Registration No. 2733684 issued on July 8, 2003; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. No claim is made to the exclusive right to use the words "Cancer Foundation" apart from the mark as shown.

n9 Registration No. 3375185 issued on January 29, 2008. No claim is made to the exclusive right to use the word "Foundation" apart from the mark as shown. Acquired distinctiveness under Section 2(f) as to the words "Skin Cancer."

[\*6]

n10 Registration No. 3380561 issued on February 12, 2008. No claim is made to the exclusive right to use the words "Lung Cancer Research Foundation" apart from the mark as shown.

n11 Registration No. 3663453 issued on August 4, 2009. No claim is made to the exclusive right to use the words "Gastric Cancer Foundation" apart from the mark as shown.

n12 Registration No. 3218985 issued on March 13, 2007. No claim is made to the exclusive right to use the words "Inflammatory Breast Cancer Foundation" apart from the mark as shown.

n13 Registration No. 3417465 issued on April 29, 2008. No claim is made to the exclusive right to use the words "Pediatric Cancer Foundation" apart from the mark as shown.

n14 Registration No. 3222080 issued on March 27, 2007. No claim is made to the exclusive right to use the words "Breast Cancer Foundation, Inc." apart from the mark as shown.

n15 Registration No. 3104009 issued on June 13, 2006. No claim is made to the exclusive right to use the words "Breast Cancer Foundation" apart from the mark as shown.

n16 Registration No. 3084973 issued on April 25, 2006. No claim is made to the exclusive right to use the words "Pancreatic Cancer Awareness Foundation" apart from the mark as shown.

[\*7]

In fact, consistent with the entire thrust of the case proffered by the Trademark Examining Attorney, we see from the registrations referenced above that the additional wording describing the type of cancer to which the respective

foundations are each devoting their efforts (i.e., analogous to applicant's involved "Eye Cancer" designation) is also disclaimed within each of the composite mark also having inherently distinctive matter, or alternatively, is shown to have acquired distinctiveness (e.g., "Skin Cancer Foundation" mark above). n17

n17 While in applicant's extant registration for "The Eyecare Foundation," the word "Eyecare" does not fit this pattern of naming a form of cancer, it is a composite mark totally analogous to the involved mark in the context of an analysis under Section 2(e)(1) of the Act. In that registration, applicant claimed acquired distinctiveness as to the mark in its entirety, while disclaiming the word "Foundation" apart from the mark as shown. Had applicant taken a different tact during the prosecution of the instant application, that too could well have been an option here.

[\*8]

Applicant's original recitations of services used the wording "eye cancer and other eye diseases" in a manner reminiscent of the existing recitation of services in its earlier registration. However, in an attempt to evade the refusal for descriptiveness under § 2(e)(1) of the Act, applicant deleted during the prosecution of this application all the earlier references to "eye cancer" from its recitation of services. Then, applicant argued that this move requires a reversal of the refusal to register:

The Examining Attorney has indicated that the determination of whether a mark is merely descriptive is considered in relation to the identified services. Since the identified services do not make any reference to "eye cancer," the refusal should be withdrawn.

Applicant's response of May 10, 2010, at 2. Furthermore, based upon the evidence of record, applicant now argues that "eye cancer" is so rare that the public in general is unaware that "eye cancer" is classified as an "eye disease." n18

n18 Even if we should conclude that "eye cancers" are rare, if as a matter of fact, "eye cancers" comprise a sub-set of "eye diseases," we would not be constrained to exclude them from this recited category should applicant present a poll reflecting a contrary public opinion on this very point.

[\*9]

As best we can understand it, applicant's position in its appeal brief is that the sole dispositive issue on appeal is whether the term "eye diseases" includes "eye cancer." Then in a confusing summation to its reply brief, applicant's counsel ended with the following *non sequitur*:

It is preliminarily to be noted that the trademark attorney's characterizing of the usage by Applicant of EYECARE and EYECANCER has not stated that EYECARE exceeds the scope of EYECANCER or *vice-versa*, that EYECANCER exceeds the scope of EYECARE.

Accordingly it should be assumed that the connotation of the words EYECARE and EYECANCER or *vice-versa* are broad enough to encompass each other.

For the foregoing reasons the Final Refusal should be overruled.

In fact, applicant's current position seems too clever by half. As argued by the Trademark Examining Attorney, the whole sequence of events surrounding applicant's amendment to the recitation of services undercuts its final arguments:

... The original identification of services included "providing medical information to people with **eye cancer and other eye diseases.**" The applicant's prior registration for a related [\*10] mark also included "providing medical information to people with **eye cancer and other eye diseases.**" This wording indicates that eye cancer is one of many eye diseases. The applicant would not have used the wording "and other" if eye cancer was not considered an eye disease. It is noted that in [its] amended identification of

services to delete "eye cancer," the applicant also deleted "and other" leaving only "eye diseases." The evidence below, including statements by the applicant ... clearly indicate that the applicant provides these services in connection with eye cancer as well as other eye diseases.

Trademark Examining Attorney's appeal brief at unnumbered 5. *Emphasis* supplied by the Trademark Examining Attorney.

We agree with the Trademark Examining Attorney that this tribunal should not be required to ignore the realities of use actually made by applicant merely because it made a tactical decision explicitly to carve out from the application's recitation of services what are arguably its core services - motivated only by the desire to foil a refusal of mere descriptiveness. This is particularly true where each of the involved websites is offering [\*11] a variety of interrelated services. It seems most appropriate to take all of those largely undifferentiated services into consideration when determining whether the alleged mark still immediately conveys information about the remaining, trimmed-down recitation of services. On the other hand, in this case, turning a blind eye to applicant's actual services would not help applicant's position inasmuch as the named services related to "eye cancers" are deemed still to be included in the pared-down recitation of services.

As noted by the Trademark Examining Attorney, from the time of the first Office action, "[t]his refusal was premised on evidence that the applicant's foundation services provide fundraising and counseling services in the field of 'eye cancer.'" For example, what follows is an excerpt from the undated declaration of applicant's president/chairman, Dr. Paul T. Finger, submitted to the U.S. Patent and Trademark Office during prosecution of this application, on June 9, 2010:

*The Eye Cancer* Foundation History

Established in 1998, The *Eye Cancer* Foundation is an educational and supportive resource for *eye cancer* patients, their families [\*12] and physicians. Our mission is two fold: one part focused on multi-centered research of new diagnostic treatments for *eye cancer* research, the other focused on providing much needed patient support services.

We understand that an *eye cancer* diagnosis can be overwhelming. It is for this reason that we provide two highly utilized web sites for patients and their families: The *Eye Cancer* Network. n19 [*emphasis* supplied by the Trademark Examining Attorney]

n19 On the top of this web page titled "The Eye Cancer Foundation," located at <http://www.eyecarefoundation.org/about.htm> is a letter to "Friends" from Paul T. Finger, MD, chairman of The Eye Cancer Foundation, directly above an email hyperlink to [contactus@eyecancerfoundation.net](mailto:contactus@eyecancerfoundation.net). Identical websites, both known as *eyecancernetwork*, are located at <http://eyecancer.com/> and at <http://www.eyecancer.com/>.

Although applicant's president/chairman referred to the above excerpt as a "now discontinued" description of [\*13] applicant's involved services, the entire evidence of record, to say nothing of common sense, suggests that this very language continues to encapsulate the two-fold purpose at the heart of applicant's mission.

Furthermore, in order to be found to be merely descriptive, it is not necessary that the term describe the totality of the goods or services. Rather, the descriptiveness of the term "Eye Cancer Foundation" is not negated by the fact that applicant, through various related foundations, networks and websites, may also provide fundraising services for medical research and website information for ocular patients and their families in relation to non-cancerous eye disorders or diseases (e.g., benign cysts, macular degeneration, etc.), which may well be more common than eye cancers.

In any case, whether applicant actually continues to perform all of the services included in the latest recitation is largely irrelevant for our purposes herein. n20

n20 Of course, if applicant does not provide any fundraising or patient information services related to eye cancer under this mark, the application may be statutorily infirm as misdescriptive, or deceptive.

[\*14]

Another of Dr. Finger's statements from the same declaration is as follows:

I disagree that the evidence of record would be understood by my peer physicians to believe that "eye diseases" is broad enough to encompass "eye cancer" because eye cancer is rare ... ."

Even if one concludes that this form of cancer is statistically quite rare when compared with the incidence of lung cancer or breast cancer, for example, that fact does not undercut in any way our determination under Section 2(e)(1) of the Lanham Act. The recitation of services still mentions "eye diseases." We find that "eye diseases" encompasses "eye cancer." n21 Accordingly, the suggestion that even other ocular oncologists would not consider "eye cancers" to be included within the category of "eye diseases" does not follow logically from the substantial evidence of record, whether one focuses on applicant's own websites, the cited dictionary definitions, the websites of organizations such as the American Cancer Society n22 or ASCO (American Society of Clinical Oncology), n23 or even the prosecution history revealed in the filewrapper of this application.

n21 *can.cer* -noun 1. Pathology. a. a malignant and invasive growth or tumor, especially one originating in epithelium, tending to recur after excision and to metastasize to other sites. b. *any disease characterized by such growths*. [RANDOM HOUSE DICTIONARY, 2011];

*cancer* A disease characterized by any of various malignant neoplasms composed of abnormal cells that tend to proliferate rapidly and invade surrounding tissue. Our Living Language: "... *Cancer, which represents more than 100 separate diseases*, destroys tissues and organs through invasive growth in a particular part of the body and by metastasizing to distant tissues and organs through the bloodstream or lymph system...." [THE AMERICAN HERITAGE SCIENCE DICTIONARY, 2002]. See *Notre Dame du Lac*, 217 USPQ at 508, footnote 7.

[\*15]

n22 <http://www.cancer.org/Cancer/EyeCancer/DetailedGuide/eye-cancer-diagnosis>

n23 <http://www.cancer.net/patient/Cancer+Types/Eye+Cancer>

In fact, for decades now in the Western world, all forms of cancers have been among the most lethal and feared classes of diseases stalking human kind. Hence, it strains credulity to claim that of all the known conditions and disorders of the eye, eye *cancers* would comprise classes of eye disorders that will *not* be thought of as eye *diseases*.

Moreover, applicant's services (i.e., offered under "The Eyecare Foundation," "The Eye Cancer Foundation," "The Eye Cancer Network," etc.) are clearly not directed to the field of ophthalmology generally (i.e., diagnosis and treatment of all conditions, disorders and/or diseases of the eye, from injuries and infections to tumors, glaucoma, cataracts, keratoconus, etc.). Rather, all of applicant's related websites made a part of the record (e.g., [www.eyecarefoundation.org](http://www.eyecarefoundation.org), <http://eyecancerfoundation.net/>, <http://eyecancer.com>, and <http://www.eyecancer.com/>) point to a narrow sub-speciality. These [\*16] sources identify Dr. Paul T. Finger as an "Eye *Cancer* Specialist" and Director of Ocular Oncology at The New York Eye *Cancer* Center. Dr. Finger's practice and foundations are focused on ocular tumors, eye *cancers* and related ophthalmic conditions. The record shows that ocular oncology is the branch of medicine dealing with tumors relating to the eye. Although some eye tumors can be benign, much of the focus of Dr. Finger's practice is actually on eye cancer, and the record shows that he has written numerous scientific articles about intraocular choroidal melanoma - including malignant eye tumors that metastasize to other organs of the body.

Accordingly, we find that applicant's proposed mark is merely descriptive of its services because it conveys information about a significant feature of the recited services. Specifically, the alleged mark tells consumers that applicant's foundation provides charitable fundraising and grants for research on eye diseases, such as eye cancer, and provides medical and patient-related information about eye diseases, including eye cancer.

**Legal Topics:**

For related research and practice materials, see the following legal topics:

Trademark LawProtection of RightsRegistrationDisclaimer of Unregistrable MatterTrademark LawProtection of RightsRegistrationFederal RegistrationTrademark LawProtection of RightsRegistrationPrincipal Register