

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

KIM

Mailed: September 24, 2012

Opposition No. 91201703

Michael Brandt Family Trust
d/b/a Eco-Safe Industries, Inc.

v.

Istituto Italiano Sicurezza
dei Giocattoli S.r.l.

**Before Holtzman, Bergsman and Shaw,
Administrative Trademark Judges**

By the Board:

This matter comes up on applicants' motion (filed February 24, 2012) to dismiss opposer's claim of fraud in opposer's amended notice of opposition. The motion is fully briefed.

By way of background, opposer filed a notice of opposition against application Serial No. 77960950 for ECO-SAFE and design¹ on September 21, 2011, on grounds of priority and

¹ For "ropes, string, fishing nets, tents, awnings, tarpaulins, sails, sacks and bags for the transportation or storage of materials in bulk; padding and stuffing materials not of rubber, paper or plastic; raw fibrous textile materials" in Class 22, "yarns and threads, for textile use" in Class 23, "textile fabrics for use in making clothing and household furnishings; knitted fabrics, curtains, pillow cases, bed quilts, quilt covers, duvets, duvet covers, bed sheets, bed spreads, bed blankets, comforters for bed, table cloths not of paper, textile napkins, towels, textile place mats" in Class 24, "clothing, namely, coats, mantles, raincoats, dusters, fur coats, dresses, suits, skirts, jackets, knitwear shirts, trousers, shorts sets, Bermuda shorts, jeans, waistcoats, shirts, t-shirts, tops,

likelihood of confusion and fraud. Opposer later filed an amended notice of opposition on January 11, 2012. The Board accepted the amended notice on January 25, 2012, and set applicant's time to answer the amended pleading.

On February 24, 2012, applicant timely filed an answer as well as a motion for partial dismissal of the amended notice.

For purposes of this order, we presume the parties' familiarity with the pleadings and with the arguments submitted with respect to the motion.

The Board has set forth the applicable standard of a motion to dismiss under Fed. R. Civ. P. 12(b)(6) as follows:

In order to withstand a motion to dismiss for failure to state a claim, a plaintiff need only allege such facts as would, if proved, establish that (1) the plaintiff has standing to maintain the proceedings, and (2) a valid ground exists for opposing the mark. The pleading must be examined in its entirety, construing the allegations therein liberally, as required by Fed. R. Civ. P. 8(f), to determine whether it contains any allegations which, if proved, would entitle plaintiff to the relief, sought. See *Lipton Industries*,

blouses, sweaters, blazers, cardigans, stockings, socks, underwear, corsets, brassiere, underpants, night-gowns, shifts, pajamas, nightwear, outerwear coats, hosiery, overalls, salopettes, dungarees, bonnet, clogs, bathrobes, bathing suits, beach-wraps, sun suits, sport jackets, waterproof jackets, wind-resistant jackets, anoraks, sweatsuits, ties, neckties, scarves, shawls, mufflers, foulards, caps, hats, hoods, gloves, sashes, belts; footwear, beach footwear, athletic footwear, boots, shoes and slippers" in Class 25, "carpets, rugs, mats and matting, linoleum for covering existing floors, floor coverings of rubber and synthetic rubber, hard surface coverings for floors, non-textile wall hangings" in Class 27, and "testing, analysis and evaluation of the textile products of others and toys of others for the purpose of certification" in Class 42.

Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460 (TTAB 1992); and TBMP § 503.02 (2d. ed. rev. 2004). For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of plaintiff's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to plaintiff. See *Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993); see also 5A Wright & Miller, *Federal Practice And Procedure: Civil 2d* §1357 (1990).

Fair Indigo LLC v. Style Conscience, 85 USPQ2d 1536, 1538 (TTAB 2007). Therefore, the notice of opposition must allege "enough facts to state a claim to relief that is plausible on its face." *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570, 127 S.Ct. 1955, 1974 (2007); see also *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937 (2009) (plausibility standard applies to all federal civil claims).

On the question of standing, opposer pleads ownership of three registrations for ECO-SAFE.² Considering that the

² Registration No. 1303116 for ECO-SAFE in typed form for "pest control services" in Class 37.

Registration No. 1631876 for ECO-SAFE and design for "pest control services; janitorial services" in Class 37.

Registration No. 1749733 for ECO-SAFE in typed form for "carpet freshening preparations in dust and powder forms; liquid hand soap" in Class 3, "insecticides in spray, powder, or liquid forms for domestic, commercial and industrial use" in Class 5, "pest control traps for rats, roaches, and other pests" in Class 21, "apparel; namely, tee shirts and hats" in Class 25, "cloth patches for shirts" in Class 26, and "organic pest control services" in Class 37.

literal elements of the marks are nearly identical and at least some of the parties' goods and services are arguably related, we find that opposer has adequately pleaded its standing. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); see also *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987); *Toufigh v. Persona Parfum Inc.*, 95 USPQ2d 1872, 1874 (TTAB 2010) (standing found where "parties' marks are identical, and their goods are at least arguably related").

As to the fraud claim alleged by opposer, we agree with applicant and find that the claim is not sufficiently pleaded. Under *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009), "a trademark is obtained fraudulently under the Lanham Act only if the applicant or registrant knowingly makes a false, material representation with the intent to deceive the PTO." The elements of fraud must be alleged with particularity in accordance with Fed. R. Civ. P. 9(b) and allegations based on "information and belief" must be accompanied by a statement of facts upon which the belief is founded. *Asian and Western Classics*, 92 USPQ2d at 1478-1479 (citing *Exergen Corp. v. Wal-Mart Stores Inc.*, 91 USPQ2d 1656, 1670 n.7 (Fed. Cir. 2009)). Opposer's claim of fraud essentially rests on the allegation that applicant's mark is,

in reality, a certification mark as opposed to a trademark or a service mark. However, opposer has failed to plead the factual basis of this central allegation. To the extent that opposer relies on the recitation of applicant's Class 42 services to conclude that applicant is utilizing its mark as a certification mark, opposer's claim of fraud fails as a matter of law.

For instance, opposer's allegation in ¶ 12 of its amended notice that "Applicant cannot as a matter of law have, on the one hand, a *bona fide* intent to provide testing, analysis and evaluation of the goods and services of others for the purposes of certification, and on the other hand, the *bona fide* intent to affix its certification mark to goods it actually intends to offer or sell in commerce" is erroneous. The testing, analysis and evaluation of the goods and services of others for the purpose of certification is readily recognized by the USPTO as a service. As applicant points out in its motion to dismiss, "Applicant's application is and has always been a regular application, not an application for a certification mark" and "use of a mark in connection with certification services is not use of a certification mark." *Motion to Dismiss*, pp. 6-7.

Thus, there is nothing inconsistent about applicant's *bona fide* intent to use its mark in connection with its goods and with its services. As such, there is no material misstatement or misrepresentation upon which opposer can base a claim of fraud.

Similarly, opposer's claim in ¶ 11 that the involved application is void *ab initio* because applicant's *bona fide* intent to use the mark as a trademark for its own goods is inconsistent with applicant's *bona fide* intent to use the mark as a certification mark, also fails because opposer has not alleged a proper factual basis for its claim that applicant's mark is a certification mark. Opposer's allegations in ¶¶ 9 and 10³ are not inconsistent with applicant's *bona fide* intent to use its mark in connection with its Class 42 services and therefore do not serve to form the factual basis of opposer's allegation that applicant's mark is a certification mark.

In ¶¶ 14 and 15 of the amended notice, opposer sets forth an alternative claim of fraud: "Applicant's declared *bona fide* intent to use the mark for all the goods in Class 22, 23, 24, 25 and 27 is a fraudulent and false representation made to the U.S. Patent and Trademark Office, since Applicant, on information and belief, is not in the position of manufacturing the various products listed in Classes 22, 23, 24, 25, and 27 [nor] in the position to grant licenses under the mark to third

³ 9. On information and belief, Applicant is an institution based in Italy that certifies various products manufactured by others as to whether such product meets unspecified standards of quality for "environmentally friendly" products.

10. Applicant, in fact, proposed during prosecution of its application that it be permitted to amend its description of services in class 42 to read "testing, analysis and evaluation of the goods and services of others for the purpose of certification, all the aforesaid services related to above mentioned lists of products belonging to classes 22, 23, 24, 25 and 27."

parties for the use of the mark in connection with the manufacturing of the products listed in Classes 22, 23, 24, 25, and 27." This claim is also insufficient as opposer has not pleaded the factual foundation for its "information and belief."

In view thereof, applicant's motion to dismiss opposer's claim of fraud is hereby **GRANTED**. To the extent that opposer believes it can re-state this claim such that relief may be granted thereon, opposer is allowed until **October 29, 2012**, to file a second amended notice of opposition, and applicant is allowed until **November 28, 2012**, to answer or otherwise move with respect to it. Proceedings herein are **RESUMED** and dates are **RESET** as follows:⁴

Second Amended Notice of Opposition Due	10/29/2012
Time to Answer Second Amended Notice of Opposition	11/28/2012
Deadline for Discovery Conference	12/28/2012
Discovery Opens	12/28/2012
Initial Disclosures Due	1/27/2013
Expert Disclosures Due	5/27/2013
Discovery Closes	6/26/2013
Plaintiff's Pretrial Disclosures Due	8/10/2013
Plaintiff's 30-day Trial Period Ends	9/24/2013
Defendant's Pretrial Disclosures Due	10/9/2013
Defendant's 30-day Trial Period Ends	11/23/2013
Plaintiff's Rebuttal Disclosures Due	12/8/2013
Plaintiff's 15-day Rebuttal Period Ends	1/7/2014

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served

⁴ Of course, should opposer fail to file an amended pleading, this matter will proceed only on opposer's claim of priority and likelihood of confusion.

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on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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