

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

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Mailed: February 24, 2014

Opposition No. 91201703

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

v.

Istituto Italiano Sicurezza
dei Giocattoli S.r.l.

**Before Taylor, Mermelstein, and Greenbaum,
Administrative Trademark Judges**

By the Board:

This matter comes up on two motions concurrently filed by opposer on August 22, 2013: 1) a motion to dismiss applicant's counterclaim under Fed. R. Civ. P. 12(b)(6) and 2) a motion for judgment on the pleadings.¹ The motions are fully briefed.

A brief review of the procedural history is instructive. On March 17, 2010, applicant filed application Serial No. 77960950 (the "'950 application") under Section 44 of the Trademark Act for



¹ As part of its response to the motion for judgment on the pleadings, applicant has cross-moved to dismiss the fraud claim and for sanctions.

for goods in Classes 22, 23, 24, 25, and 27, and services in Class 42. The services are identified as "testing, analysis and evaluation of the textile products of others and toys of others for the purpose of certification" in International Class 42. The application was published for opposition on May 24, 2011.

On September 21, 2011, opposer served and filed a notice opposing the '950 application based on claims of priority and likelihood of confusion, fraud and the application being void *ab initio*. On December 22, 2011, applicant filed a motion to dismiss the fraud and void *ab initio* claims concurrently with its answer to the notice of opposition. In response, opposer filed an amended notice of opposition on January 11, 2012, which was accepted by the Board.

On February 24, 2012, applicant again filed a motion to dismiss the fraud and void *ab initio* claims. As part of its motion, applicant argued that its application "is and has always been a regular application, not an application for a certification mark" and that "use of a mark in connection with certification services is not use of a certification mark." *Motion to Dismiss* (February 24, 2012), pp. 6-7. The Board granted the motion observing that opposer's fraud and void *ab initio* claims rest on the assertion "that applicant's mark is, in reality, a certification mark as opposed to a trademark or a

service mark." *Board's Order* (September 24, 2012), pp. 4-5.

Opposer was afforded leave to re-plead the claims.

On October 29, 2012, opposer filed its second amended pleading and applicant filed a third motion to dismiss the fraud claim (but not the void *ab initio* claim) on November 28, 2012. The Board, however, denied applicant's motion and accepted the pleading. On July 1, 2013, applicant filed its answer to the second amended notice of opposition and further counterclaimed for fraud against pleaded Registration No. 1749733. As part of its answer, applicant admits that its application is void *ab initio*. The salient allegations of the notice of opposition relating thereto, and their corresponding responses, are reproduced below:

17. Insofar as Applicant has declared that it has a *bona fide* intention to use the "ECO-SAFE & Leaf Design" mark as a trademark in connection with the goods in Classes 22, 23, 24, 25 and 27 in commerce in connection with the sale or offering of such products, but in reality intends to use and is in fact using the applied for mark as a certification mark, said *bona fide* intention is, as a matter of law, inconsistent with the anti-use by owner rule for certification marks under 15 U.S.C. §1054, and Applicant's Serial No. 77/960,950 is therefore void *ab initio*.

Answer: Admit

18. Insofar as Applicant has declared that it has a *bona fide* intent to use the mark as a service mark in connection with the testing, analysis and evaluation of the goods and services of others for the purposes of certification, but, in reality, intends to and is, in fact, using the applied-for mark as a certification mark, said *bona fide* intention, [sic] is as a matter of law,

inconsistent with the anti-use by owner [sic] for certification marks under 15 U.S.C. Section 1054, and Applicant's Serial No. 77/960,950 is therefore void *ab initio*.

Answer: Admit

21. Insofar as Applicant has declared that it has a *bona fide* intent to use the mark as a trademark for the goods identified in Classes 22, 23, 24, 25 and 27, and as a service mark for the services in Class 42, upon information and belief, Applicant had no such *bona fide* intention at the time it filed the application, and continues to have no such *bona fide* intention to use the mark as a trademark for the goods identified in Classes 22, 23, 24, 25 and 27 and services in Class 42.

Answer: Applicant admits that its application should be declared void because it was erroneously not characterized as a certification mark in its application, and denies the remainder of this paragraph.

22. Because Applicant lacks a *bona fide* intent to use the mark as a trademark and service mark, and never had such *bona fide* intent, the application should be declared void.

Answer: Applicant admits that its application should be declared void because it was erroneously not characterized as a certification mark in its application, and denies the remainder of this paragraph.

Based on these admissions, opposer now seeks judgment on the pleadings.

As a preliminary matter, we do not find the motion premature as there is an answer to the claims on which the motion is based and applicant's counterclaim is unrelated to the merits of the motion. See Fed. R. Civ. P. 12(c).

A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in the pleadings, supplemented by any facts of which the Board will take judicial notice. See *Land O' Lakes Inc. v. Hugunin*, 88 USPQ2d 1957, 1958 (TTAB 2008). Judgment may be granted only where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved, and the moving party is entitled to judgment on the substantive merits of the controversy, as a matter of law. *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1049 (TTAB 1992). Thus, opposer is not entitled to judgment on the pleadings where the answer raises issues of fact that would, if proven, defeat opposer's claim. *Id.* Here, applicant has admitted in its pleading that its mark is in fact a certification mark, that its use in connection with the stated goods and services violates the anti-use by owner rule for certification marks under 15 U.S.C. § 1054, and that its application is, therefore, void *ab initio*.

In view thereof, opposer's motion for judgment on the pleadings is hereby **GRANTED** as to opposer's claim that the application is void *ab initio*. The opposition is therefore **SUSTAINED** and registration to applicant is **REFUSED**. We need not and do not reach opposer's claims of likelihood of confusion and fraud.

As to opposer's motion to dismiss applicant's counterclaim, the motion is **MOOT** as we do not find that

applicant has standing to assert the counterclaim. Applicant's standing to counterclaim against one of the pleaded registrations was inherent in its position as the defendant in this opposition. See *Aries Systems Corp. v. World Book Inc.*, 26 USPQ2d 1926, 1930 n.12 (TTAB 1993). However, in declaring its application void *ab initio*, applicant has, through its own action, terminated the opposition and removed its sole basis for standing. See *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons, Inc.*, 14 USPQ2d 1879, 1881 (TTAB 1990). In view thereof, applicant's cross-motion seeking judgment on the fraud claim and seeking sanctions is also moot and will not be considered.

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