

ESTTA Tracking number: **ESTTA447883**

Filing date: **12/22/2011**

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

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| Proceeding | 91201703 |
| Party | Defendant Istituto Italiano Sicurezza dei Giocattoli S.r.l.li S.r.l. |
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| Submission | Motion to Dismiss - Rule 12(b) |
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| Date | 12/22/2011 |
| Attachments | Motion to Dismiss.pdf (4 pages)(14378 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,

Opposer,

v.

ISTITUTO ITALIANO SICUREZZA
DEI GIOCATTOLE S.R.L.

Opposition No. 91201703

**APPLICANT'S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM
OPPOSER'S FRAUD CLAIM AND OPPOSER'S CLAIM ASSERTING THAT
APPLICANT'S APPLICATION IS VOID *AB INITIO***

Applicant Istituto Italiano Sicurezza Dei Giocattoli S.R.L. ("Sicurezza") moves the Board pursuant to Fed. R. Civ. P. 12(b)(6) to dismiss the fraud claim and the claim that Applicant's application is void *ab initio* asserted by Opposer Michael Brandt Family Trust ("MBFT") in its Notice of Opposition.

I. MBFT fails to state a claim for fraud

MBFT fails to make *any* allegations with respect to the key state-of-mind elements of its fraud claim *and* fails to allege with particularity any facts that could even hypothetically support the missing state-of-mind allegations.

The elements of fraud require not only a false statement, but also the declarant's knowledge of the falsity and an affirmative intent to deceive the Patent and Trademark Office. "Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application." *Torres v.*

Cantine Torresella S.r.l., 808 F.2d 46, 48, 1 USPQ2d 1483 (Fed. Cir. 1986). As the Court stated in *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009), quoting *Kemin Indus., Inc. v. Watkins Prods., Inc.*, 192 USPQ 327, 329 (TTAB 1976), “there is a material legal distinction between a ‘false’ representation and a ‘fraudulent’ one, the latter involving an intent to deceive, whereas the former may be occasioned by a misunderstanding, an inadvertence, a mere negligent omission, or the like.”

MBFT has not alleged that applicant made the allegedly false statement with knowledge that it was false. MBFT has also not alleged that the allegedly false statement was made with the *intent to deceive the Office*. MBFT therefore has not alleged, much less alleged with particularity in accordance with the strictures of Fed. R. Civ. P. 9(b), the two signature elements of fraud.

According to the above, MBFT fails state a claim for fraud because it has not alleged all elements of fraud. Moreover, even were MBFT to make the required allegations it could not make them with the required particularity regarding the facts underlying the two state-of-mind elements. MBFT’s fraud claims should be dismissed without leave to amend.

II. MBFT fails to state a claim that applicant’s application is void

MBFT fails to state a claim that applicant’s application is void because MBFT fails to allege that Applicant lacked a bona fide intent to use its mark on *all* the goods and services listed in Applicant’s application. As a matter of law, Applicant’s application can be void only if there was a lack of intent to use the mark with respect to *all* goods and services listed in the application.

[C]ontrary to opposer's contention, an application will not be deemed void for lack of a bona fide intention to use absent proof of fraud, n4 or proof of a lack of

bona fide intention to use the mark on **all** of the goods identified in the application, **not just some of them.** See, with regard to use-based applications, *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 78 USPQ2d 1696 (TTAB 2006). Thus, we will decide this issue in terms of whether the items, if any, for which opposer has shown applicant's lack of bona fide intention to use the mark should be deleted from the application.

Wet Seal Inc. v. FD Management Inc., 82 USPQ2d 1629, 16 (TTAB 2007) (emphasis added).

An entire application cannot be deemed void for lack of bona fide intention to use a mark on some, but not all, of the goods or services identified in an application. *Id.* Opposer's remedy for Applicant's alleged lack of bona fide intent to use the mark on some, but not all, good listed in the application is merely deletion from the application of goods for which there was no intent to use. The remedy is not and cannot be the voidance of the entire application. Accordingly, based on the allegations made in the Notice, MBFT fails to state a claim for voidance of the application and has no right to ask for voidance of the application.

Pursuant to the rule announced in *Wet Seal*, MBFT must allege that Applicant lacked a bona fide intent to use with respect to *all* the goods and services listed in the application. Applicant's application lists various goods in classes 22, 23, 24, 25, and 27, and lists in class 42 the services of "Testing, analysis and evaluation of the textile products of others and toys of others for the purpose of certification."

MBFT does not allege that Applicant lacked a bona fide intent to use its mark in connection with all the listed goods and services. Rather, MBFT alleges that Applicant is an "institution that certifies various products manufactured by others" (Notice ¶9) and alleges that there is an inconsistency for a certifying party to have a bona fide intent to use a mark for certification services (the service listed in class 42) and at the same time a bona fide intent to use the mark for goods certified (classes 22, 23, 24, 25, and 27) (Notice ¶¶ 11, 12). MBFT's allegation in paragraphs 9 – 12 of its Notice is merely that there is an inconsistency and that

Applicant must have lacked a bona fide intent to use with *either* the goods *or* the services listed in the application, but not both.

December 22, 2011

Respectfully submitted,

/Mark Lebow/
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Certificate of Service

I hereby certify that the within MOTION TO DISMISS was served on this 22nd day of December 2011 via U.S. mail, postage prepaid, to the below listed counsel of record for Applicant:

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