

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

DUNN

Mailed: March 6, 2014

Opposition No. 91210390

Feel the World, Inc.

v.

Heapsylon LLC

By the Trademark Trial and Appeal Board:

This case comes up on applicant's motion to dismiss the amended notice of opposition pursuant to Fed. R. Civ. P. 12(b)(6) for failure to state a claim of fraudulent misuse of the federal registration symbol.¹ The motion is fully briefed.

On November 13, 2012, Heapsylon LLC filed an application pursuant to Trademark Act Sec. 1(b) seeking registration of the mark SENSORIA for "anklets; footwear; socks" (application Serial No. 85778259).

The amended notice of opposition alleges that opposer sells footwear and clothing; that opposer filed an application pursuant to Trademark Act Sec. 1(b) seeking registration of the mark SENSORI for "bottoms; footwear; sports caps and hats; tops" (application Serial No. 85779750); that the opposed application was

¹ On April 25, 2013, Feel the World, Inc. filed its notice of opposition. On May 30, 2013, applicant moved to dismiss. On June 13, 2013, opposer filed an amended notice of opposition. On September 30, 2013, the Board accepted the amended notice of opposition as the operative pleading.

cited as a potential bar to registrations under Trademark Act Sec. 2(d); that applicant used the federal registration symbol with its SENSORIA mark on its website offering the listed goods; that applicant does not own a federal registration for the mark SENSORIA; that after the opposition was filed, applicant ceased its use of the federal registration symbol; that applicant uses both registered and unregistered trademarks; that applicant knows that different symbols are used depending on whether the mark is registered federally; and that “on information and belief”, applicant’s improper use of the federal registration symbol was deliberate, and intended to deceive or mislead the general public into believing that the mark is registered.

To withstand a motion to dismiss for failure to state a claim upon which relief may be granted, a notice of opposition need only allege such facts as would, if proven, establish opposer's standing to maintain the proceeding and a ground or grounds for refusing registration to applicant. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000). The filing of opposer's application and the Office's action taken in regard to that application provides opposer with a basis for pleading its standing. *Fiat Group Automobiles S.p.A. v. ISM, Inc.*, 94 USPQ2d 1111, 1112 (TTAB 2010).

A fraud claim must allege improper use of a registration notice in connection with an unregistered mark, done with intent to deceive the purchasing public or others in the trade into believing that the mark is registered. *Copelands' Enterprises Inc. v. CNV Inc.*, 20 USPQ2d 1295, 1298 (Fed. Cir. 1991). Fed. R. Civ. P. 9(b) provides that the circumstances constituting the alleged fraud shall be stated with particularity. *King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801 (CCPA 1981) (“[t]he pleadings [must] contain explicit rather than implied expressions of the circumstances constituting fraud”). Intent to

deceive is an indispensable element of the analysis in a fraud case. See *In re Bose Corporation*, 476 F.3d 1331, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009).

Here, opposer asserts fraudulent intent based on “information and belief”, and asserts two facts, namely that applicant uses both registered and unregistered trademarks, and that applicant knows that different symbols are used depending on whether the mark is registered federally. This sole support of the allegation that applicant had the requisite intent to deceive the public with its use of the federal registration symbol is insufficient to plead fraud. See *Asian and Western Classics B.V. v. Lynne Selkow*, 92 USPQ2d 1478, 1479 (TTAB 2009) (“Pleadings of fraud made ‘on information and belief,’ when there is no allegation of ‘specific facts upon which the belief is reasonably based’ are insufficient”).²

Applicant’s motion to dismiss is GRANTED to the extent that opposer is allowed until THIRTY DAYS from the mailing date of this order to file an amended notice of opposition with a legally sufficient fraud claim, failing which the notice of opposition will be dismissed.

Applicant is allowed until THIRTY DAYS from the date of service of the second amended notice of opposition to file its answer. Dates are reset below:

Deadline for Discovery Conference

6/2/2014

² Compare *Meckatzer Löwenbräu Benedikt Weiß KG v. White Gold, LLC*, 95 USPQ2d 1185, 1187 (TTAB 2010) (“we find that petitioner has sufficiently alleged fraud. Its allegations are not based solely on ‘information and belief,’ but are also based on the results of an investigation which, petitioner alleges, revealed that respondent was not using its mark on all of the goods listed in its Statements of Use at the time the Statements of Use were filed.”) and *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010) (“opposer alleges ... that applicant ‘knew or should have known’ of opposer’s prior use and registration of its pleaded marks and ‘therefore could not have formed the requisite good faith belief that [a]pplicant is the owner of the mark sought to be registered, and that no other person, firm, corporation or association has the right to use said mark in commerce.’ To the extent that opposer intends to set forth a claim in this paragraph that applicant committed fraud by making false averments in the declaration in support of its involved application, such claim is legally insufficient.”).

Discovery Opens	6/2/2014
Initial Disclosures Due	7/2/2014
Expert Disclosures Due	10/30/2014
Discovery Closes	11/29/2014
Plaintiff's Pretrial Disclosures	1/13/2015
Plaintiff's 30-day Trial Period Ends	2/27/2015
Defendant's Pretrial Disclosures	3/14/2015
Defendant's 30-day Trial Period Ends	4/28/2015
Plaintiff's Rebuttal Disclosures	5/13/2015
Plaintiff's 15-day Rebuttal Period Ends	6/12/2015

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served 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 Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.