UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Baxley

Mailed: August 12, 2016

Opposition No. 91218260

Maurice D. Landers

v.

Jack and Jill Foundation Limited

Before Cataldo, Mermelstein, and Shaw,
Administrative Trademark Judges.

By the Board:

Maurice D. Landers ("Opposer") filed a notice of opposition to registration of Jack and Jill Foundation Limited's ("Applicant")[1] application to register THE SHAMROCK FUND in standard characters for "Charitable fundraising services; philanthropic services relating to the making of monetary grants in the field of health care; charitable monetary services, namely, accepting and administering monetary charitable grant contributions in the field of health care; charitable fundraising services by means of organization of special fundraising activities and events for health care" in International Class 36.[2] As grounds for opposition, Opposer alleged (1) likelihood of confusion with his previously used mark SHAMROCK FUND for

[1] Applicant is a limited company of Ireland.

[2] Application Serial No. 79107704, filed October 26, 2011, based on Trademark Act Section 66(a), 15 U.S.C. § 1141f(a), based on International Registration No. 1103024, issued October 26, 2011, with an October 14, 2011 date of priority under Trademark Act Section 67, 15 U.S.C. § 1141g. The application includes a disclaimer of FUND.

"offering charitable services and charitable fundraising services" under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), and (2) fraud in the application declaration. Applicant, in its answer, denied the salient allegations of the notice of opposition and added amplifications of those denials.

On March 3, 2016, Applicant filed a motion for summary judgment on the grounds of the priority portion of Opposer's Section 2(d) claim.[3] Applicant did not seek entry of judgment on the fraud claim, but asserted that such claim was insufficiently pleaded. After Opposer failed to respond the motion, the Board, in an April 28, 2016 order, granted the motion for summary judgment and dismissed the opposition with prejudice.[4]

On May 18, 2016, twenty days later, Opposer filed a motion for relief from judgment under Federal Rule of Civil Procedure 60(b)(1) on the ground of mistake, inadvertence, surprise, or excusable neglect. Applicant filed a brief in response.

In support of his motion, Opposer, appearing *pro se*, contends that he was unaware that motions for summary judgments were briefed without issuance of a notice from the Board setting a briefing schedule; that the provisions in TBMP § 528.02 that refer to the brief in response to a motion for summary judgment do not refer to the non-moving party as the person who would file such a brief; and that Opposer has

[3] The certificate of service states that Applicant served its motion by mail on March 3, 2016. Accordingly, Opposer's brief in response was due no later than April 7, 2016. *See* Trademark Rules 2.119(c) and 2.127(e)(1); TBMP § 528.02 (2016).

[4] On June 7, 2016, Applicant's involved application Serial No. 79107704 matured into Registration No. 4970837.

prepared for trial in this case by drafting pretrial disclosures. Accordingly, Opposer asks that judgment be vacated.

In response, Applicant contends that Opposer failed to show that his failure to respond to the motion for summary judgment was the result of excusable neglect and that, in any event, the record clearly indicates that it is entitled to entry of summary judgment. Accordingly, Applicant asks that the motion be denied.

A motion to set aside or vacate a judgment issued by the Board is governed by Fed. R. Civ. P. 60(b). *See* Trademark Rule 2.116(a); TBMP § 544. Thus, upon such terms as are just, the Board, on motion, may relieve a party from a final judgment for one of the reasons specified in Fed. R. Civ. P. 60(b).[5] Relief from a final judgment is an extraordinary remedy to be granted only in exceptional circumstances or when other equitable considerations exist. *See Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991). Public policy favors finality of judgments and termination of litigation. *See* TBMP § 312.03.

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[5] Those reasons are as follows:

> (1) mistake, inadvertence, surprise, or excusable neglect;
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> (2) newly discovered evidence that, with reasonable diligence, could not have been discovered in time to move for a new trial under Rule 59(b);
>
> (3) fraud (whether previously called intrinsic or extrinsic), misrepresentation, or misconduct by an opposing party;
>
> (4) the judgment is void;
>
> (5) the judgment has been satisfied, released, or discharged; it is based on an earlier judgment that has been reversed or vacated; or applying it prospectively is no longer equitable; or
>
> (6) any other reason that justifies relief.

Thus, Applicant's apparent belief that it need only show good cause to vacate the default judgment is incorrect.

By his motion, Opposer is essentially pleading ignorance of applicable procedural rules as a basis for vacating entry of judgment. Under Trademark Rule 2.127(e)(1), either a motion for discovery under Federal Rule of Civil Procedure 56(d) or "a brief in response to the motion for summary judgment shall be filed within thirty days from the date of service of the motion unless the time [to file a brief in response] is extended[6] by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board."[7] *See also* TBMP § 528.02. Opposer's assertion that the Trademark Board Manual of Procedure is not easily understood by laypersons is unpersuasive. Although Opposer correctly notes that TBMP § 528.02 does not refer to the nonmovant's filing of a brief in response, the Board is puzzled as to who else would file a brief in response to a motion when there are only two parties in this opposition proceeding. *See* Trademark Rule 2.116(b) (in an opposition, the opposer is in the position of plaintiff and the applicant is in the position of defendant). In addition, Opposer has provided no basis for his belief that the Board would issue, and should have issued, a notice in which it set forth a schedule for remaining briefing of the motion for summary judgment. There is nothing in the Trademark Rules that provides for the issuance of such a notice. Rather, due dates for motions are set in accordance with Trademark Rules 2.119(c), 2.127(a), and 2.127(e)(1). In view of the clear and unambiguous statement in Trademark Rule 2.127(a) that, "[w]hen a party fails to file a brief in response to a motion, the Board may treat the motion as

[6] Under Rule 2.127(e)(1), time to file a motion for Rule 56(d) discovery shall not be extended.

[7] Under Trademark Rule 2.119(c), five days is added to the time to respond when service of the motion is by mail.

conceded," it was incumbent upon Opposer to file a brief in response to the motion for summary judgment within the time allotted under Trademark Rules 2.119(c) and 2.127(a) or risk the possibility that the motion would be granted as conceded.[8]

"Gross carelessness, ignorance of the rules, or ignorance of the law are insufficient bases for 60(b)(1) relief. A party has a duty of diligence to inquire about the status of a case; Rule 60(b) relief will only be afforded in unique circumstances." *Edward H. Bohlin Co., Inc. v. Banning Co., Inc.*, 6 F.3d 350, 357 (5th Cir. 1993). *See also Latshaw v. Trainer Wortham & Co., Inc.,* 452 F.3d 1097, 1100–01 (9th Cir. 2006) (ignorance of rules does not warrant Rule 60(b)(1) relief); *Jones v. United States,* 255 F.3d 507, 511-12 (8th Cir. 2001) (same); Wright and Miller, Federal Practice & Procedure § 2858 (3d ed. April 2016).

A motion for summary judgment that is granted as conceded is treated as a form of default judgment. *See Williams v. Five Platters, Inc.*, 510 F.2d 963, 184 USPQ 744, 745 (CCPA 1974). *Cf. PolyJohn Enterprises Corp. v. 1-800-Toilets Inc.*, 61 USPQ2d 1860, 1862 (TTAB 2002) (dismissal under Trademark Rule 2.132(a) treated as a form of default judgment). Although the Board is generally liberal in setting aside default judgments that were entered as a result of a defendant's failure to file an answer (*see*

[8] The Board expects all parties, whether or not they are represented by an attorney, to comply with applicable rules and deadlines. *See ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1037 n.5 (TTAB 2012). Following Opposer's notification that he intended to represent himself in this proceeding, Opposer was cautioned that "it is strongly advisable for a party who is not acquainted with the technicalities of the procedural and substantive law involved in inter partes proceedings before the Board to secure the services of an attorney who is familiar with such matters." Opposer was further warned that "[a]ny party who does not retain counsel should be familiar with the authorities governing this proceeding, including the Trademark Trial and Appeal Board Manual of Procedure . . . , and the Trademark Rules of Practice. . . ." *Order*, 15 TTABVUE 1-2 (Aug. 29, 2015).

Information Sys. and Networks Corp. v. United States, 994 F.2d 792, 795 (Fed. Cir. 1993)), the Board is less liberal with regard to other default judgments. *See* TBMP § 312.03. The default judgment in this case was entered after Opposer, as plaintiff, failed to respond to a motion for summary judgment. *See* TBMP § 544. Notwithstanding that the Board generally disfavors default judgments, the Board is also justified in enforcing procedural deadlines and in minimizing the amount of its time and resources that must be expended on matters, such as the motion decided herein, which come before the Board solely as a result of one party's failure to follow a clear and straightforward rule. *See PolyJohn Enterprises Corp., supra.* Opposer brought this case and, in so doing, took responsibility for complying with applicable deadlines, but failed to do so. *See Atlanta-Fulton County Zoo, Inc. v. DePalma*, 45 USPQ2d 1858 1860 (TTAB 1998).

Based on the foregoing, we find that the circumstances herein do not warrant vacating entry of judgment under Rule 60(b)(1). Opposer's motion to vacate judgment is therefore denied. The entry of judgment on in Applicant's favor on Opposer's pleaded Section 2(d) claim stands.

Notwithstanding the foregoing, the Board notes that in the motion for summary judgment, Applicant sought entry of summary judgment only on the priority element of its Section 2(d) claim. Although Applicant asserted in a footnote that Opposer's fraud claim was insufficiently pleaded (17 TTABVUE 3 n.1), it did not expressly seek dismissal of that claim under Federal Rules of Civil Procedure 12(c) and 12(h)(2) for failure to state a claim, and we decline to treat Applicant's motion as seeking such

dismissal.[9] Accordingly, the grant of Applicant's motion as conceded should have resulted in entry of judgment on Opposer's Section 2(d) claim only. We hereby modify the April 28, 2016 order to the extent that judgment is entered in Applicant's favor on Opposer's Section 2(d) claim only. Applicant's inadvertently issued Registration No. 4970837 will be cancelled with involved application Serial No. 79107704 being restored to pendency.

Opposer's fraud claim is based on Applicant's alleged false averment that "to the best of its knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive." Such averment is made as part of a declaration of bona fide intent to use the mark in commerce that is attached to a request for extension of protection of an international registration when such request is received by the International Bureau for transmittal to the USPTO. *See* Trademark Act Sections 60(5) and 66(a), 15 U.S.C. §§ 1141(5) and 1141f(a); TMEP §§ 1902.05 and 1904.01(c) (April 2016).

Fraud in procuring or maintaining a trademark registration occurs when an applicant for registration or a registrant in a declaration of use or a renewal application knowingly makes specific false, material representations in connection with an application to register or in a post-registration filing with the intent of

[9] Because Applicant filed its answer on March 17, 2015, nearly one year prior to the filing of the motion for summary judgment, Applicant could not have sought dismissal of the fraud claim under Federal Rule of Civil Procedure 12(b)(6). *See* TBMP § 503.01.

obtaining or maintaining a registration to which it is otherwise not entitled.[10] *See In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009). In determining the sufficiency of fraud allegations, Federal Rule of Civil Procedure 9(b) requires identification of the specific who, what, when, where, and how of the material misrepresentation or omission committed before the USPTO. *Cf. Exergen Corp. v. Wal-Mart Stores Inc.*, 575 F.3d 1312, 91 USPQ2d 1656, 1667 (Fed. Cir. 2009) (allegations of inequitable conduct in patent cases require pleadings of specific conduct upon which allegation is based). A pleading that simply alleges the substantive elements of fraud, without setting forth the particularized factual bases for the allegation, does not satisfy Rule 9(b). *See id.* (citing *King Auto., Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801, 802-03 (CCPA 1981).

Knowledge and intent, as conditions of mind of a person, may be averred generally in support of an allegation of fraud. *See* Fed. R. Civ. P. 9(b); *DaimlerChrysler Corp. v. Am. Motors Corp.*, 94 USPQ2d 1086, 1088 (TTAB 2010). However, pleadings must allege sufficient underlying facts from which the Board may reasonably infer that a party acted with the requisite state of mind. *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1479 (TTAB 2009).

In addition,

> a plaintiff claiming that the declaration or oath in defendant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the

[10] "Materiality" of any false application statement is determined in the context of whether the false statement is critical to the Trademark Examining Attorney's decision to approve a mark for publication. *See Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1926 (TTAB 2006).

> oath was signed, must allege particular facts which, if proven, would establish that: (1) there was in fact another use of the same or a confusingly similar mark at the time the oath was signed; (2) the other user had legal rights superior to applicant's; (3) applicant knew that the other user had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise; and that (4) applicant, in failing to disclose these facts to the Patent and Trademark Office, intended to procure a registration to which it was not entitled.[11]

Intellimedia Sports Inc. v. Intellimedia Corp., 43 USPQ2d 1203, 1205 (TTAB 1997).

Opposer alleges in paragraphs 8 through 14 of the notice of opposition (1 TTABVUE 5-6) that, in view of e-mail exchanges between Opposer's representative and Applicant's officers prior to the filing of Applicant's involved application, Applicant knew, when it filed that application, that "Opposer was using [his] trademark for SHAMROCK FUND, and claiming trademark rights to the same for [his] chartiable fundraising services" and therefore committed fraud by making the aforementioned false averment in its application. Although these allegations do not expressly refer to an intent to deceive, we find that, taken together, they allege

[11] A declaration "is phrased in terms of a subjective *belief*, such that it is difficult, if not impossible, to prove objective falsity and fraud so long as the affiant or declarant has an honestly held, good faith belief." J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 31:76 (4th ed. 2015) (emphasis in original). An applicant's failure to disclose to the USPTO the asserted rights of another party is not fraudulent unless the applicant knew that the other party was possessed of a superior or clearly established right to use the same or a substantially identical mark for the same or substantially identical goods or services as those in connection with which registration is sought. Thus, if the parties' respective marks and goods or services are not substantially identical, then the applicant may have a reasonable basis for believing that contemporaneous use of such marks by the parties, on or in connection with their respective goods or services, is not likely to cause confusion. *Intellimedia Sports Inc.,* 43 USPQ2d at 1207.

enough factual matter to constitute a sufficient pleading of a fraud claim. *See DaimlerChrysler Corp.*, 94 USPQ2d at 1088-89.

Nonetheless, as a result of the entry of summary judgment for Applicant on the priority issue *supra*, Applicant is the prior user and therefore has superior rights in the mark THE SHAMROCK FUND. *See* Fed. R. Civ. P. 56(g). Although the priority issue was decided on default, that decision is as binding as one that was fully litigated. *See Williams,* 184 USPQ at 745. Under the law of the case doctrine, we do not revisit this conclusion.[12] In view of Applicant's adjudicated superior rights in its involved mark, Opposer cannot prevail on his fraud claim. *See Intellimedia Sports Inc.,* 43 USPQ2d at 1205.

Based on the foregoing, Opposer is allowed until thirty days from the mailing date set forth in this order to show cause why summary judgment should not be entered against Opposer on the fraud claim as well.[13] *See* Fed. R. Civ. P. 56(f). Proceedings herein are otherwise suspended.

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[12] "The law of the case is a judicially created doctrine, the purposes of which are to prevent the relitigation of issues that have been decided.... The doctrine requires a court to follow the decision on a question made previously during the case." *Jamesbury Corp. v. Litton Indus. Prods. Inc.*, 839 F.2d 1544, 5 USPQ2d 1779, 1783 (Fed. Cir. 1988).

[13] Any further briefing on the order to show cause is due in accordance with Trademark Rules 2.119(c) and 2.127(e)(1).