

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

DUNN

Mailed: April 3, 2015

Opposition No. 91218363

New Wave Innovations, Inc.

v.

Mr. Foamer, Inc.

**Elizabeth A. Dunn, Attorney (571-272-4267):**

This case comes up on Applicant's motion to dismiss the amended notice of opposition. The motion is contested.<sup>1</sup>

On November 2, 2013, Mr. Foamer, Inc. filed an application for registration of the mark MR. FOAMER (standard characters), claiming multiple bases for the following services (Application Serial No. 86108666)<sup>2</sup>:

---

<sup>1</sup> Applicant's reply brief indicates that Applicant has not been timely receiving its service copies of Opposer's filings. The parties are ordered to confer by phone within TEN DAYS of the mailing date of this order on how to ensure that email service copies are received and thereafter to leave a phone message for each other each day that they make a filing so that any lapses in email service may be rectified promptly. The sur-replies filed by the parties on January 21, 2015 and January 31, 2015 have been given no consideration. See Trademark Rule 2.127(a) ("The time for filing a reply brief will not be extended. The Board will consider no further papers in support of or in opposition to a motion.").

<sup>2</sup> As provided by Trademark Rule 2.34(b) (2), "In an application under section 1 or section 44 of the Act, an applicant may claim more than one basis, provided the applicant satisfies all requirements for the bases claimed."

**Opposition No. 91218363**

Int. Cl. 3: car wash cleaning and polishing preparations (Sec. 1(b)).

Int. Cl. 35: Online retail store services featuring car wash equipment and parts thereof (Sec. 1(a) alleging August 10, 2012 as its dates of first use).

Int. Cl. 35: installation and maintenance of car wash equipment and parts thereof (Sec. 1(a) alleging November 2, 2013 as its dates of first use).

On November 13, 2014, New Wave Innovations, Inc. filed an amended notice of opposition against Application Serial No. 86108666 with claims of priority of use and likelihood of confusion, and fraud.<sup>3</sup> Applicant moves to dismiss the amended notice of opposition for failure to state a claim upon which relief can be granted.

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.<sup>4</sup> See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000). Specifically, a complaint “must contain sufficient factual matter,

---

<sup>3</sup> On September 16, 2014, Opposer filed the original notice of opposition. On October 26, 2014, in lieu of an answer, Applicant filed a motion to dismiss. On November 13, 2014, in lieu of a response to the motion, Opposer filed an amended notice of opposition. A party to an inter partes proceeding before the Board may amend its pleading once as a matter of course within 21 days after service of a motion under Rule 12(b). See Fed. R. Civ. P. 15(a). Accordingly, Opposer’s amended notice of opposition is accepted as the operative pleading, and Applicant’s motion to dismiss the original notice of opposition is moot, and will be given no consideration.

<sup>4</sup> The Board notes that the parties’ briefs mistakenly failed to focus on what was pleaded, but instead focused on the parties’ opposing views as to the likelihood of the pleaded allegations being proven. This is not a matter to be addressed at the pleading stage, but at trial or upon motion for summary judgment.

**Opposition No. 91218363**

accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S. Ct. 1937, 1949-50 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). Here, Opposer’s allegation of standing is based on its alleged prior common law use of, and pending service mark application Serial Nos. 86305665 for the identical mark MR. FOAMER (standard characters) and 86303800 for the mark CHRISTMAS WISHES FROM MR. FOAMER and design, both for services identical in part to those offered by Applicant (first Paragraph 1, p. 1-2, Paragraph 2 and 16 )<sup>5</sup>:

Int. Cl. 35: Online retail store services featuring car wash equipment and parts thereof (Sec. 1(a) alleging December 15, 2011 as its dates of first use).

This is sufficient to plead Opposer’s standing. *See Spirits International B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birliđi*, 99 USPQ2d 1545, 1548 (TTAB 2011) and *Threshold.TV, Inc. and Blackbelt TV, Inc. v. Metronome Enterprises, Inc.*, 96 USPQ2d 1031, 1036 (TTAB 2010).

In order to plead a claim of likelihood of confusion, Opposer must plead that it has prior proprietary rights in the pleaded mark, and that contemporaneous use of the parties’ respective marks in connection with their respective good and services would be likely to cause confusion or mistake or to deceive consumers. *See Hornblower & Weeks, Inc. v.*

---

<sup>5</sup> Opposer is advised that the “nature of the action” section of its amended notice of opposition would have been better omitted inasmuch as it resulted in double numbering, a single allegation that goes on for the first four pages of the pleading, and redundancy. Pleadings should be a short statement of the claim with each allegation presented once, and separately numbered. See Fed. R. Civ. P. 10.

**Opposition No. 91218363**

*Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001). Here, Opposer asserts that there is likelihood of confusion in the marketplace based on Applicant's use of the same mark with the same or related goods and services. As to priority, the amended notice of opposition alleges that Opposer was the first to adopt and use the MR. FOAMER mark in commerce on December 2011, a date which is prior to the November 2, 2013 priority date for Applicant's goods, and the August 10, 2012 and November 2, 2013 priority dates alleged for Applicant's services. No more is necessary, and the Board finds the claim sufficient. *See Petroleos Mexicanos v. Intermix S.A.*, 97 USPQ2d 1403, 1406-1407 (TTAB 2010).

Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with its application with the intent to deceive the U.S. Patent and Trademark Office (USPTO). *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009). The party seeking cancellation must prove that Respondent knowingly, with the intent to deceive the USPTO, made a material misrepresentation that it was using its mark in commerce on the identified services as of the time it filed its statement of use, when no such use had been made. *Petróleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1408 (TTAB 2010). Alternately, a plaintiff claiming that the declaration or oath in a defendant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at

**Opposition No. 91218363**

the time the 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 U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled. *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768 (TTAB 2010).

Here, the amended notice of opposition alleges that Applicant made a false misrepresentation regarding its use of the mark at the time its statement of use was filed, with the requisite intent to deceive the USPTO. We find that this states a legally sufficient claim of fraud. *Meckatzer Löwenbräu Benedikt Weiß KG v. White Gold, LLC*, 95 USPQ2d 1185 (TTAB 2010).

To the extent that the amended notice of opposition contends that Applicant made a false misrepresentation regarding its dates of first use of the mark at the time its statement of use was filed, with the requisite intent to deceive the USPTO, this fails to state a claim of fraud. *See Hiraga v. Arena*, 90 USPQ2d 1102, 1107 (TTAB 2009) (“if the mark was in use in commerce as of the filing date, then the claimed date of first use, even if false,

**Opposition No. 91218363**

does not constitute fraud because the first use date is not material to the Office's decision to approve a mark for publication.”).

The Board also finds insufficient Opposer’s claim that Applicant made a false misrepresentation regarding the right of others to use the mark in commerce. In support of its fraud claim based on Applicant’s alleged misrepresentation that no other party had a right to use the mark, Opposer pleads only Applicant’s knowledge of Opposer’s use, and Opposer’s own subjective belief that its use gives Opposer superior rights to the mark. A fraud claim based on a false oath regarding the rights of others to use the mark only lies where the other party’s rights were clearly established, as by a prior agreement between the rights or a court decree.

For the purpose of fraud, knowledge of another party’s use of the mark is not equivalent to knowledge of another party’s superior rights to the mark. *See Metro Traffic Control v. Shadow Network Inc.*, 41 USPQ2d 1369 (Fed. Cir. 1997) (because ”the complex factual situation in this case apparently left Mr. Schwartz with an unclear understanding of the legal implications of his statement ... Mr. Schwartz's misstatements did not represent a ‘conscious effort to obtain for his business a registration to which he knew it was not entitled.’”); *Maids to Order of Ohio Inc. v. Maid-to-Order Inc.*, 78 USPQ2d 1899, 1909 (TTAB 2006) (“fact that [defendant], subsequent to filing its application, offered to purchase whatever rights [plaintiff] had in the MAID TO ORDER mark is not evidence that that [defendant]knew that [plaintiff]

**Opposition No. 91218363**

had prior or superior rights”); *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1207 (TTAB 1997) (“if the other person's rights in the mark, vis-a-vis the applicant's rights, are not known by applicant to be superior or clearly established, e.g., by court decree or prior agreement of the parties, then the applicant has a reasonable basis for believing that no one else has the right to use the mark in commerce, and the applicant's averment of that reasonable belief in its application declaration or oath is not fraudulent.”).<sup>6</sup>

In sum, after review of the pleading, the Board finds that the amended notice of opposition is legally sufficient as to the allegation of Opposer’s standing, claim of priority of use and likelihood of confusion, and claim of

---

<sup>6</sup> See also *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 76 (TTAB 1983) (“A failure to disclose to the Office the asserted right of another cannot be said to constitute fraud unless such other person was known by the nondisclosing party to possess a superior right to use the same or substantially identical mark for the same or substantially identical goods as those in connection with which registration was sought.”); *Yocum v. Covington*, 216 USPQ 211, 216-217 (TTAB 1982) (“the statement of an applicant that no other person “to the best of his knowledge” has the right to use the mark does not require the applicant to disclose those persons whom he may have heard are using the mark if he feels that the rights of such others are not superior to his.”); *Kemin Industries, Inc. v. Watkins Products, Inc.*, 192 USPQ 327, 329 (TTAB 1976) (“the allegations of ownership and exclusive use contained in the declaration or verification accompanying an application are made upon ‘belief/ and/or ‘information and belief’ and, as such, are couched in such a manner as to preclude a definitive statement by the affiant that could be ordinarily used to support a charge of fraud”); and *William Grant & Sons, Inc. v. National Distillers and Chemical Corporation*, 173 USPQ 813 (TTAB 1972) (counterclaim did not state a cause of action since, even if opposer's predecessor (at the time of filing application for registration) knew or should have known of prior registration of same mark as instant applicant now seeks to register, predecessor did not act fraudulently since such prior registration was known or should have been known to the examiner and, hence, predecessor's statement that no other party had right to use mark was not intended to mislead examiner).

**Opposition No. 91218363**

fraud based on Applicant's asserted failure to use the mark with the listed services at the time the application was filed.<sup>7</sup> The fraud claims based on Applicant's false dates of first use or exclusive right to use the mark are insufficient. Accordingly, Applicant's motion to dismiss the amended notice of opposition is denied in part, and granted in part.

Opposer is given leave to amend the notice of opposition within TEN DAYS of the mailing date of this order for the purpose of pleading additional fraud claims if Opposer can do so consistent with its obligations under Rule 11 and the legal principles set forth in this order.

Applicant's time to file its answer will be reset upon the resumption of proceedings.

Opposer is ordered to provide the Board with following information within TEN DAYS of the mailing date of this order:

- a) The filing date of the operative pleadings in the civil action between the parties and, if not already in the Board's proceeding file, a copy of those pleadings.
- b) If the parties to this proceeding are not the same legal entities involved in the civil action, an explanation of why the parties to this proceeding are in privity with the parties to the civil action.
- c) A copy of any district court order addressing the merits of pleaded claims or defenses in the civil action.
- d) A copy of any appeal from the district court order in the civil action.
- e) The current status of the civil action.

---

<sup>7</sup> The application was filed on the basis of Applicant's bona fide intent to use the mark on the goods, and thus there is no need for the mark to have been used on the goods at the time the application was filed.

**Opposition No. 91218363**

Proceedings herein remain suspended pending the Board's decision as to whether there is an overlap in the issues before the district court which warrants suspension of this proceeding.