

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

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Mailed: September 15, 2015

Opposition No. 91218616

Brown Brothers Harriman & Co.

v.

Robert Berry

M. Catherine Faint,
Interlocutory Attorney:

Now before the Board are the following motions filed by Opposer:

- 1) motion to amend the pleadings, filed January 29, 2015;
- 2) motion to compel discovery, filed May 5, 2015; and
- 3) motion to suspend pending the Board's ruling on the motion to compel, filed June 1, 2015.

Applicant did not file briefs in response to the motions within the time provided under Trademark Rule 2.127(a). Proceedings herein are considered suspended as of the filing of the motion to compel on May 5, 2015.

1. Motion to amend the pleadings

Consistent with Fed. R. Civ. P. 15(a), the Board liberally grants leave to amend pleadings at any stage of the proceeding when justice requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party. *See Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993). Where, as here, a party files a motion for leave to

amend prior to trial and prior to the close of discovery, prejudice is often not found. *See Hurley Int'l LLC v. Volta*, 82 USPQ2d 1339, 1341 (TTAB 2007); *Commodore*, 26 USPQ2d at 1506.

Although Applicant did not respond to the motion to amend the pleadings, the Board exercises its discretion to review the first amended notice of opposition.¹

In evaluating the sufficiency of a pleading, Trademark Rule 2.104(a) provides that:

The opposition must set forth a short and plain statement showing why the opposer believes he, she or it would be damaged by the registration of the opposed mark and state the grounds for opposition.

The elements of each claim should be stated concisely and directly, and include enough detail to give the defendant fair notice. *See Fed. R. Civ. P. 8(e)(1)*; *see also Harsco Corp. v. Elec. Sci. Inc.*, 9 USPQ2d 1570, 1571 (since function of pleadings is to give fair notice of claim, a party is allowed reasonable latitude in its statement of its claims). Under the simplified notice pleading of the Federal Rules of Civil Procedure, the allegations of a complaint should be construed liberally so as to do substantial justice. *Scotch Whisky Assoc. v. United States Distilled Prods. Co.*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991).

¹ Opposer is reminded that except for documents showing the current status and title of a pleaded registration, exhibits attached to a pleading are not evidence on behalf of the party to whose pleading they are attached unless they are thereafter, during the time for taking testimony, properly identified and introduced in evidence as exhibits. Trademark Rule 2.122(c)-(e).

Although Opposer alleges that its pleaded registrations are attached as Exhibit C to both its original and first amended notices of opposition, this is not the case. There are no attachments to the original notice of opposition and Exhibit C to the first amended notice of opposition appears to be a copy of the electronic filing of the original notice of opposition.

The Board has determined the following.

a. False Suggestion of a Connection

In its original notice of opposition, in the ESTTA cover sheet, Opposer alleges a count of false suggestion of connection under Trademark Act § 2(a). For a proper § 2(a) claim of false suggestion of a connection, a plaintiff must allege facts from which it may be inferred that its mark is famous and points uniquely and unmistakably to itself, as an entity -- i.e., that its mark is its identity or “persona” -- and that purchasers would assume that goods bearing the mark are connected with plaintiff. *See Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

To properly plead a Section 2(a) claim of false suggestion of a connection, a plaintiff must allege the following:

1. defendant’s mark is the same or a close approximation of the name or identity of a person or institution;
2. defendant’s mark would be recognized as such by purchasers, in that the mark points uniquely and unmistakably to the person or institution named or identified;
3. the person or institution named or identified is not connected with the goods sold or activities performed by the defendant under the mark; and,
4. the name or identity of the person or institution identified is of sufficient fame or reputation that when the defendant’s mark is used in connection with its goods or services, a connection with the person or institution would be presumed.

In re Nieves & Nieves, LLC, 113 USPQ2d 1629, 1632-33 (TTAB 2015) (citing *inter alia*, *Univ. of Notre Dame*, 703 F.2d 1372, 217 USPQ at 509; and *Bd. of Trs. v. Pitts*, 107 USPQ2d 2001, 2025 (TTAB 2013)).

Opposer's original pleading and first amended pleading do not contain any allegations regarding its marks as its name or identity, or that a connection with Opposer would be presumed. In view thereof, to the extent Opposer believes it has alleged a Section 2(a) false suggestion of a connection claim in the notice of opposition, it is hereby **stricken**.

b. Lack of Ownership, Non-Use of the Mark in Commerce and Fraud

Opposer argues in its motion to amend the pleading that based on Applicant's discovery responses and Opposer's independent investigation, Opposer seeks to amend its Notice of Opposition to include claims for non-use, lack of ownership and fraud. To assert these three grounds Opposer adds the following allegations at paragraphs Nos. 18 and 19 to its previous paragraph No. 17:

17. Additionally, Opposer believes that Applicant has not used the BBH Mark on or in connection with all of the goods as claimed in the instant Challenged Application and that Applicant falsely and knowingly claimed a date of first use of the BBH Mark in connection with those goods Applicant actually offers that precedes the actual date of first use in commerce for the mark by over a year.

18. In particular, Applicant committed fraud on the U"PTO as a result of Applicant's (a) failure to use the BBH Mark in commerce for many of the goods listed in the application; (b) lack of ownership of the mark shown in the opposed application; and (c) knowingly false representation to the Patent and Trademark Office that Applicant had used the BBH Mark in commerce prior to the filing date of the opposed application.

19. The foregoing knowingly false representations that the Applicant made under oath to the USPTO constitute fraud on the USPTO and another ground upon which the Board should deny registration of the Challenged Application.

A claim of nonuse of the mark in commerce requires pleading that the applicant did not use the mark in commerce on all of the goods or services listed in the use-based application as of the filing date. *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1045 (TTAB 2012); *see also* Trademark Rule 2.34(a)(1)(i). The standard for proving fraud in cases before the Board is laid out in *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009) and requires a plaintiff to plead and prove the following four elements:

1. applicant made a false representation to the USPTO;
2. the false representation is material to the registrability of a mark;
3. applicant had knowledge of the falsity of the representation; and
4. applicant made the representation with intent to deceive the USPTO.

Nationstar Mortg. LLC v. Ahmad, 112 USPQ2d 1361, 1365 (TTAB 2014) (citing *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009)). It is the preferred practice of the Board that the element of intent be pled specifically, but intent, as a condition of mind of a person, may be averred generally. *See* Fed. R. Civ. P. 9(b). The particularity element is satisfied when a plaintiff sufficiently specifies the time, place and content of the alleged false misrepresentation. *See* 5A Wright & Miller, *Fed. Prac. & Proc. Civ.* § 1297 n.15 (3d ed. Westlaw 2015) and cases cited therein. An applicant's statements, and specimens, regarding use of a mark for the goods and services identified in a use-based application are material to the examining

attorney's approval of the application for publication. *Nationstar*, 112 USPQ2d at 1365.

The law is clear that an application can be held void if the plaintiff pleads and proves either fraud or nonuse of a mark for all identified goods or services prior to the application filing date. *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 78 USPQ2d 1696, 1697 (TTAB 2006). However, the dates of first use alleged by an applicant in a use-based application or statement of use filed in an intent-to-use application, even if false, do not constitute fraud, as long as there was valid trademark use on or before the filing date of the application or statement of use. *Western Worldwide Enters. Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1141 (TTAB 1990) ("The Board repeatedly has held that the fact that a party has set forth an erroneous date of first use does not constitute fraud unless, inter alia, there was no valid use of the mark until after the filing of the [Section 1(a)] application").

The language in the first amended complaint is sufficient to allege non-use of the mark at Paragraph 17, but does not sufficiently allege fraud or lack of ownership. Opposer has not pled fraud with sufficient particularity and it is unclear whether Opposer has alleged any false material representations by Applicant with the necessary intent to deceive. *Compare DaimlerChrysler Corp. v. American Motors Corp.*, 94 USPQ2d 1086, 1089 (TTAB 2010) (finding allegations of material misrepresentations knowingly made to procure registration constitute sufficient allegation of intent element for pleading fraud); *see also, Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1287 (TTAB 2008) (finding fraud pleading

insufficient in part under Fed. R. Civ. P. 9(b) because false statements were not set forth with particularity). The lack of ownership claim lacks specificity because the allegation appears to be part of the fraud allegation, rather than a separate claim. *Compare, e.g., Levi Strauss & Co. v. R. Josephs Sportswear, Inc.*, 28 USPQ2d 1464 (TTAB 1993) (where opposer asserts applicant's mark is descriptive term which cannot be owned exclusively by anyone, rather than alleging someone other than applicant is owner of term as a mark) *recon. den.*, 36 USPQ2d 1328 (TTAB 1994). Although Opposer alleges "fraud on the USPTO and another ground," the Board finds this language too vague to clearly provide Applicant notice of what the "other ground" is.

Accordingly, to the extent Opposer alleges fraud or lack of ownership, the claims in Paragraphs 18 and 19 are insufficient.

To be clear, Opposer has sufficiently alleged claims of priority and likelihood of confusion, and non-use, but has not sufficiently alleged false suggestion of a connection, fraud and lack of ownership.

In view thereof, the motion to amend the pleadings is **granted** and Paragraphs 18 and 19 are hereby **stricken**.

b. Time for Amendment

Opposer is allowed until **TWENTY DAYS from the mailing date of this order** to file and serve a second amended notice of opposition that properly pleads its claims as noted herein. **Applicant** is allowed until **TWENTY DAYS from the service date of any amended pleading** to file and serve its answer thereto. **If no amended**

pleading is filed, Applicant is allowed until **FORTY DAYS** from the mailing date of this order to file and serve its answer to the first amended notice of opposition as construed herein.

2. Motion to Compel

Opposer seeks an order directing Applicant to appear for a noticed discovery deposition and compelling Applicant to produce those documents and things listed in Petitioner's notice at Applicant's deposition. Applicant has not responded to the motion. In support of its motion, Opposer argues it served its Request for Production of Documents and Things on December 1, 2014 and Applicant responded to 13 of Opposer's 15 production requests on January 2, 2015 with the phrase,

[t]he documents can be made available for inspection at 4401 W. Slauson Ave, Los Angeles, CA 90043 at a mutually convenient time and, if necessary, subject to an appropriate protective order.

Opposer was unsuccessful in getting Applicant to respond to attempts to arrange a date and time for inspection of the documents. On April 2, 2015, Opposer sent to Applicant a Notice of Deposition for April 23, 2015 including a request under Fed. R. Civ. P. 34 to produce documents and tangible things at the deposition. Opposer contacted Applicant via email and U.S. mail on April 6 and 16 2015, in an attempt to confirm Applicant's attendance at the noticed deposition or to request that Applicant propose alternate dates and times. Applicant responded via email on April 29, 2015, six days after the date of his noticed deposition, with the sole phrase, "[p]lease reschedule me." Opposer again contacted Applicant via email and U.S. mail on April 29, 2015 requesting Applicant's availability during the weeks of May

11 and May 25, 2015. As of the filing of the motion to compel, Applicant had not responded to Opposer's requests.

In an inter partes proceeding before the Board, the discovery deposition of a natural person who is a party may be taken on notice alone. A party to an inter partes proceeding before the Board may, after proper notice and a good faith effort to resolve the matter, file a motion to compel a party to attend a deposition. *S. Idus, Inc. v. Lamb-Weston, Inc.*, 45 USPQ2d 1293, 1298 (TTAB 1997); *see also*, Trademark Rule 2.120(e).

Applicant is advised that the Board's standard protective order is in place in this case to govern the exchange of confidential and proprietary information and materials. Applicant may view the order here: <http://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/standard-documents-and-guidelines>.

Opposer's notice of deposition was reasonable and timely under the rules, and Opposer has shown a good faith effort to resolve the matter prior to filing its motion. Applicant has not provided any reason to the Board why it has failed to appear for the deposition or provide documents in response to discovery.

Accordingly, Opposer's motion to compel Applicant's appearance at the deposition with documents responsive to discovery is **granted**. Applicant is allowed until **TWENTY DAYS** from the mailing date of this order to provide Opposer's counsel with at least three dates on which he can appear for a deposition; and said deposition must be conducted within **FORTY-FIVE DAYS** of the mailing date of

this order. *See Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 and 1655 n.12 (TTAB 2007) (parties have a duty to cooperate in resolving conflicts in the scheduling and taking of depositions). In the event that Applicant fails to appear as ordered herein, Opposer's remedy may lie in a motion for sanctions, as appropriate. *See* Trademark Rule 2.120(g)(1); TBMP § 411.05.

3. Pro Se Information

The Board notes that Applicant is representing himself in this proceeding. Although Patent and Trademark Rule 11.14 permits an entity to represent itself, 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. The United States Patent and Trademark Office (USPTO) cannot aid in the selection of an attorney. As the impartial decision maker, the Board may not provide legal advice; it may provide information solely as to procedure.

Any 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 (TBMP), and the Trademark Rules of Practice (37 C.F.R. Part 2), both accessible directly from the Board's web page: <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. Also on the Board's web page are links to ESTTA, the Board's electronic filing system² at

² The Board strongly encourages parties to file all papers through ESTTA, which operates in real time and provides a tracking number that the filing has been received. For assistance in using ESTTA, call 571-272-8500.

<http://estta.uspto.gov>, and TTABVUE, for case status and prosecution history at <http://ttabvue.uspto.gov/ttabvue>.

Trademark Rules 2.119(a) and (b) require that every paper filed in the USPTO in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney. Proof of service must be made before the paper will be considered by the Board. Accordingly, copies of all papers filed in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. *See* TBMP § 113.03. The statement, whether attached to or appearing on the paper when filed, will be accepted as prima facie proof of service, must be signed and dated, and should take the form of a certificate of service as follows:

I hereby certify that a true and complete copy of the foregoing (insert title of submission) has been served on (insert name of opposing counsel or party) by mailing said copy on (insert date of mailing), via First Class Mail, postage prepaid (or insert other appropriate method of delivery) to: (name and address of opposing counsel or party).

Signature _____
Date _____

Strict compliance with the Trademark Rules of Practice, and the Federal Rules of Civil Procedure (where applicable), is required of all parties before the Board, whether or not they are represented by counsel. *See McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, n.2 (TTAB 2006).

This *inter partes* proceeding is similar to a civil action in a federal district court. The parties file pleadings and a range of possible motions. This proceeding includes

designated times for disclosures, discovery (discovery depositions, interrogatories, requests for production of documents and things, and requests for admission, to ascertain the facts underlying an adversary's case), a trial period, and the filing of briefs. The Board does not preside at the taking of testimony; all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence unless it has been introduced in evidence in accordance with the applicable rules.

4. Dates Reset

Proceedings are resumed. **Opposer** is allowed until **TWENTY DAYS** from the **mailing date of this order** to file and serve a second amended notice of opposition that properly pleads its claims as noted herein. **Applicant** is allowed until **TWENTY DAYS** from the **service date of any amended pleading** to file and serve its answer thereto. **If no amended pleading is filed, Applicant is allowed until FORTY DAYS** from the **mailing date of this order** to file and serve its answer to the first amended notice of opposition as construed herein.

Applicant is allowed until **TWENTY DAYS** from the mailing date of this order to provide Opposer's counsel with at least three dates on which he can appear for a deposition; and said deposition must be conducted within **FORTY-FIVE DAYS** of the mailing date of this order and Applicant must appear at the deposition with its documents responsive to discovery.

Dates are reset as set out below.

Expert Disclosures Due	11/16/2015
Discovery Closes	12/16/2015
Plaintiff's Pretrial Disclosures Due	1/30/2016
Plaintiff's 30-day Trial Period Ends	3/15/2016
Defendant's Pretrial Disclosures Due	3/30/2016
Defendant's 30-day Trial Period Ends	5/14/2016
Plaintiff's Rebuttal Disclosures Due	5/29//2016
Plaintiff's 15-day Rebuttal Period Ends	6/28/2016

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.

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