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

AH/GFR

Mailed: December 16, 2009

Cancellation No. 92032341

PRAMIL S.R.L.

v.

MICHEL FARAH[1]

Before Drost, Bergsman and Wellington, Administrative Trademark Judges.

By the Board:

On January 29, 2008, the Board granted the petition of Pramil S.R.L. (hereinafter petitioner) to cancel Registration No. 2447970 for the mark OMIC PLUS owned by Michel Farah (hereinafter respondent), based on petitioner's priority of use and the likelihood of confusion between respondent's mark and petitioner's common law trademark OMIC for related goods. In regard to the question of priority, the Board found respondent had failed to introduce any evidence regarding the first use of his mark OMIC PLUS and therefore could only rely on his filing date of May 30, 2000

[1] An assignment of the involved registration was recorded in the Office's Assignment Branch (Reel 3775/Frame 0704) after issuance of the Board's decision in this case, from the individual Michel Farah to Fem Mitchell Group USA LLC. However, the instant motion for relief from judgment was filed in the name of assignor.

for purposes of priority. The Board further held petitioner had established a priority date of 1994 and had shown continuous and uninterrupted use of its mark since that date.

Respondent timely appealed from the decision of the Board to the U.S. Court of Appeals for the Federal Circuit, which affirmed the Board's decision. *Farah v. Pramil S.R.L.*, 300 Fed. Appdx. 915, Appeal No. 2008-1329 (Fed. Cir. November 24, 2008) (non-precedential).

On December 12, 2008, respondent filed with the Board a motion under Fed. R. Civ. P. 60(b)(2) for relief from final judgment, based upon his assertion of newly discovered evidence. The newly discovered evidence consists solely of the issuance of a registration based on a companion application for the mark OMIC for cosmetic goods related to the goods listed in the cancelled registration for OMIC PLUS.[2] Application for registration of the OMIC mark had been filed by respondent on October 1, 2007, the mark published for opposition on March 18, 2008 and, the mark having been unopposed, Registration No. 3440165 issued on June 3, 2008.[3] The new registration's dates of use are

[2] For clarity, we refer to the involved registration as the cancelled registration even though the Office has not yet cancelled it, because of the pendency of first, respondent's appeal, and second, the instant motion for relief from judgment.

[3] The identification of goods in the new OMIC registration lists "Body cream; Skin and body topical lotions, creams and oils for

identical to the dates of use of the involved cancelled registration.

Respondent argues the new registration "is prima facie evidence that [registrant], and not [petitioner], is the owner of the mark OMIC and has the exclusive right to use the mark OMIC in commerce. This prima facie evidence of [registrant]'s exclusive rights effectively destroys the very basis of [petitioner]'s claim for cancellation." Respondent went on to claim that the new registration did not exist until after the Board's decision in this case. As such, respondent argues the new evidence could not have been discovered prior to the Board's decision.

The Board Has Jurisdiction to Hear the Rule 60(b) Motion

As the Federal Circuit issued its mandate and opinion prior to the filing of respondent's motion, and the Federal Circuit's ruling is not the subject of a petition for a writ of certiorari, the Board has jurisdiction to hear this motion without leave from the Federal Circuit. *Standard Oil Co. of California v. United States*, 429 U.S. 17, 17-18 (1976).

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cosmetic use; Skin cream; Body oil; Skin moisturizer; Skin lighteners; Skin soap; Skin toners; Liquid soaps for hands, face and body; Body lotion; Skin lotion; Soaps for body care; Hand soaps." The identification in the cancelled OMIC PLUS registration lists "Cosmetics, namely body cream, body oil, skin cream, skin and body lotions, skin moisturizer, skin lightener, skin soap, skin toners, soaps for hands, face and body, in both liquid and solid form."

Merits of the Rule 60(b) Motion

Rule 60(b)(2) of the Federal Rules of Civil Procedure allows for relief from judgment based on "newly discovered evidence that, with reasonable diligence, could not have been discovered in time to move for a new trial under Rule 59(b)." Fed. R. Civ. P. 60(b)(2); *see also* discussion in TBMP §544 (2nd ed. rev. 2004). Every motion under Rule 60(b) "must be made within a reasonable time" and a motion under section (b)(2) must be filed "no more than a year after the entry of the judgment." Fed. R. Civ. P. 60(c)(1).

Respondent's motion has been filed within a year of the Board's decision granting the petition to cancel. We discuss infra whether it has been filed within a reasonable time. However, we first must address whether the evidence qualifies as newly discovered evidence under Rule 60(b)(2). Cases construing "newly discovered evidence" uniformly hold that the new evidence must be of facts in existence at the time of the trial, but only discovered later, to entitle a party to relief. *See generally* 11 C. Wright & A. Miller, Federal Practice and Procedure §2859 (2d ed. 1995); 12 J. Moore, Moore's Federal Practice § 60.42[3] (3d ed. 2009) ("Moore's"); *see, e.g., Swope v. Siegel-Robert, Inc.*, 243 F.3d 486, 498 (8th Cir. 2001), *cert. denied*, 534 U.S. 887 (2001); *Rivera Pomales v. Bridgestone Firestone, Inc., Rivera v. M/T Fossarina*, 840 F.2d 152, 156 (1st Cir. 1988);

Chilson v. Metropolitan Transit Authority, 796 F.2d 69, 70 (5th Cir. 1986); *National Anti-Hunger Coalition v. Executive Comm. Etc.*, 711 F.2d 1071, 1075 (D.C. Cir. 1983); *Corex Corp. v. U.S.*, 638 F.2d 119, 121 (9th Cir. 1981).

Based on respondent's own contentions, the new registration was not in existence at the time of trial as it registered on June 3, 2008, well after the Board's decision on January 29, 2008. Accordingly, the registration does not qualify as newly discovered evidence that would entitle respondent to the relief sought.

Even if the registration qualified as new evidence, while the Rule 60(b)(2) motion was filed within one year of the Board's entry of judgment, the motion does not meet the second requirement of Rule 60(c), that a Rule 60(b) motion be filed within a "reasonable time." Upon the issuance of his new registration in June 2008, respondent should have filed the Rule 60(b) motion with the Board. If the Board was inclined to grant the motion, the Board would have issued an order indicating its intention to grant the order upon proper remand, and respondent then could have filed a motion with the Federal Circuit to remand the appeal to the Board to grant the Rule 60(b) motion. Although the Federal Circuit has confronted this procedural issue only in the context of appeals of decisions from district courts, where it must apply the procedural law of the regional circuit in

which the district court sits,[4] we note that the procedure outlined above is followed in virtually all of the circuit courts.[5] *See* 12 Moore's § 60.67[2][b]; *see also Lans v. Gateway 2000, Inc.*, 110 F.Supp.2d 1 (D.D.C. 2000); *aff'd Lans v. Digital Equip. Corp.*, 252 F.3d 1320, 59 USPQ2d 1057 (Fed. Cir. 2001). As the Fourth Circuit has explained,

> [W]hen a Rule 60(b) motion is filed while a judgment is on appeal, the district court has jurisdiction to entertain the motion, and should do so promptly. If the district court determines that the motion is meritless, as experience demonstrates is often the case, the court should deny the motion forthwith; any appeal from the denial can be consolidated with the appeal from the underlying order. If the district court is inclined to grant the motion, it should issue a short memorandum so stating. The movant can then request a limited remand from [the appellate] court for that purpose.

Fobian v. Storage Technology Corp., 164 F.3d 887, 891 (4th Cir. 1999). This practice conserves the resources of the courts because if the trial court (in this case the Board) grants the motion, then the appellate court may not need to decide the appeal. If the trial court denies the motion, then an appeal from that decision may be incorporated into the appeal. By waiting to see whether the Federal Circuit

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[4] *See, e.g., Concept Design Electronics and Manufacturing Inc. v. Duplitronics Inc.*, 104 F.3d. 376, 43 USPQ2d 1114, 1117 (Fed. Cir. 1996) (non-precedential) (applying Fourth Circuit law).

[5] The only exception appears to be the Ninth Circuit, which does not permit a party to make a 60(b) motion directly in the district court while an appeal is pending but rather requires that a party ask the district court if it would entertain such a

would grant his appeal before filing his motion for relief from judgment, respondent unnecessarily maximized the resources that the Board and the Federal Circuit expended on this case.

If respondent was unsure whether the Federal Circuit and the Board would follow the prevailing procedure concerning the filing of a Rule 60(b) motion with the trial court during a pending appeal, respondent could have, in the alternative, brought the issuance of the registration to the attention of the Federal Circuit and sought suspension of the appeal and leave to file the Rule 60(b) motion. Respondent, however, did nothing upon issuance of the registration and has not explained why his inaction was reasonable under the circumstances. We therefore conclude that the Rule 60(b) motion does not satisfy the Rule 60(c) requirement that it be filed within a reasonable time.

Finally, we note that even if a Rule 60(b) motion involves newly discovered evidence that was in existence at the time of trial but not in possession of the moving party, and the motion is made both within a reasonable time and within the outside limit of one year, then the motion still may be denied if the evidence is merely cumulative or not of a type that would change the result. *See* 12 Moore's

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motion and then move the appellate court for remand to file the motion.

§ 60.42[8], [9]; *Atkinson v. Prudential Property Co.*, 43 F.3d 367 (8th Cir. 1994); *Matter of Wildman*, 859 F.2d 553 (7th Cir. 1988); *Trans Mississippi Corp. v. U.S.*, 494 F.2d 770 (5th Cir. 1974); *see also Smith Int'l Inc. v. Hughes Tool Co.*, 759 F.2d 1572, 225 USPQ 889 (Fed. Cir. 1985). In this case, the issuance of respondent's second registration for a very similar mark, virtually identical goods and identical dates of use does not change the underlying trial record in any significant way. Respondent contends that the registration is prima facie evidence that he, rather than petitioner, is the owner of the OMIC mark. Nonetheless, the registration is neither unrebuttable nor prima facie evidence of respondent's priority of use of that mark, and the evidence at trial established petitioner's priority of use.[6] The subsequent issuance by the Office of an arguably conflicting registration does not alter the record created at trial or dictate that the decision should be set aside.

In view thereof, registrant's motion for relief from final order of the Board is denied.

[6] Trademark Rule 2.122(b)(2) provides: "The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence."