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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92046965
Party	Plaintiff Gander Mountain Company
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Attachments	Motion to Amend Cancellation No 92046965 .pdf (7 pages)(242709 bytes) Proposed Amendment to Cancellation No. 92046965 .PDF (7 pages)(278696 bytes)

Cancellation No.: 92046965
Atty. Ref. No.: 7495

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Gander Mountain Company Petitioner, v. ELM Development, LLC Registrant.	Cancellation No.: 92046965 Reg. No.: 3,086,200 Mark: **THE GANDERGUNMEN** Petitioner's File No.: 7495

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

MOTION TO AMEND THE PLEADINGS AND MEMORANDUM IN SUPPORT THEREOF

Pursuant to 37 C.F.R. § 2.115 and Rule 15 of the Federal Rules of Civil Procedure, Petitioner Gander Mountain Company ("Petitioner"), a Minnesota corporation, by and through its attorneys hereby moves the Trademark Trial and Appeal Board (the "Board") to amend the Petition for Cancellation for Registration No. 3,086,200 issued on the Principal Register on April 25, 2006 to ELM Development, LLC ("Registrant"). The Proposed Amended Petition for Cancellation is attached as Exhibit A.

I. INTRODUCTION

Petitioner recently took the deposition of Registrant's President, Eric L. Marhoun. At that deposition, Petitioner learned that despite its statements to the United States Patent and Trademark Office ("USPTO") to the contrary, Registrant has **never** used THE GANDERGUNMEN in connection with "[e]ntertainment services, namely production and distribution of a hunting show." Based on this information, which Petitioner did not have access to prior to the deposition, and pursuant to 37 C.F.R. § 2.115 and Rule 15 of the Federal Rules of Civil Procedure, Petitioner hereby moves for leave to amend its Petition. The Amendment adds

additional bases for Registration No. 3,086,200 to be Cancelled. Specifically, these additional bases are (1) Registrant's mark does not meet the requirements for registration under §§ 1(a), 1(b), or 3(a) or of the Lanham Act (15 U.S.C. §§ 1051(a), 1051(b), and 1053(a) (service marks registrable)), because Registrant's mark fails to function as a service mark under Sections 23 and 24 of the Lanham Act, (15 U.S.C §§ 1091 and 1127); and (2) Registrant's mark should be cancelled because Registrant acquired its mark by committing fraud on the USPTO.

II. BACKGROUND

On December 9, 2003, Registrant filed an "intent-to-use" application for the mark THE GANDERGUNMEN, in connection with "[e]ntertainment services, namely production and distribution of a hunting show." Registrant was required to file a verified statement of use along with a specimen of the mark as used in commerce by no later than June 21, 2006. The day before the deadline, Registrant filed its statement of use claiming a date of first use in commerce of September 2002. Along with the statement of use, Registrant submitted as its specimen, a photograph of a trailer with the words, "Team GanderGunmen" painted in large letters on the side with the phrase, "The men who brought your hard gravity!" painted in smaller letters below. In its statement of use, Registrant stated that it had "a bona fide intention to use ... the mark in commerce . . . in connection with the identified. . . services."

On August 10, 2005, the USPTO refused Registrant's submitted specimen "because it does not show use of the mark in the sale or advertising of the services specified." On February 10, 2006, in a Response to the Office Action, Registrant submitted a substitute specimen. Once again Registrant claimed that it first used the mark in commerce in September 2002, and stated that it had "a bona fide intention to use . . . the mark in commerce . . . in connection with the identified. . . services."[1]

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[1] In its Response to the Office Action, Registrant also amended its bases to include actual use under §1(a) of the Lanham Act, and stated that "the mark was in use in commerce on or in connection with the . . . services listed in the application as of the application filing date."

At his deposition, Mr. Marhoun, Registrant's President, testified that Registrant never used the mark in connection with the stated services, including on the date alleged as the first use in commerce. Based on this newly discovered information, there are two additional bases to cancel Registrant's mark: (1) Registrant's mark is not used in connection with services, and therefore does not function as a service mark; and (2) Registrant knowingly made false material representations to the USPTO. Discovery is not set to close in this matter until February 13, 2008, and there is no prejudice to Registrant if the amendment is allowed. Accordingly, Petitioner should be granted leave to amend its Petition for Cancellation to reflect this new information.

III. ARGUMENT

A. Leave to Amend a Pleading is to be Freely Given

Amendments to pleadings in a cancellation proceeding are governed by 37 C.F.R. § 2.115, which states that such pleadings "may be amended in the same manner and to the same extent as in a civil action in a United States district court." Accordingly, Rule 15(a) of the Federal Rules of Civil Procedure governs amendments to pleadings in proceedings before this Board. Federal Rule of Civil Procedure 15(a) states that "leave to amend 'should be freely given when justice so requires;' this mandate is to be heeded." *Foman v. Davis*, 371 U.S. 178, 182, 83 S. Ct. 227, 230 (1992) (citation omitted); *see also Boral Ltd. v. FMC Corp.*, 59 U.S.P.Q.2d 1701, 1702 (T.T.A.B. 2000). An Amendment to a pleading may also properly include claims beyond those stated in the original complaint. TBMP § 507.02, Fed. R. Civ. P. 15(a); *see also, e.g., Marmark Ltd. v. Nutrexpa S.A.*, 12 U.S.P.Q. 1843, 1844 (TTAB 1989); *Fioravanti v. Fioravanti Corrado S.R.L.*, 230 U.S.P.Q. 36, 39 (TTAB 1986).

Though an amendment requires court approval, governing authorities have determined that, absent a substantial reason to deny, a court should freely grant leave to amend as justice requires. *Boral Ltd.* 59 U.S.P.Q.2d at 1702. One Circuit Court has stated that "Rule 15's policy of favoring amendments to pleadings should be applied with 'extreme liberality'." *DCD*

Programs, Ltd. v. Leighton, 833 F.2d 183, 186 (9th Cir. 1987) (citation omitted). To be sure, it has been the policy and practice of the Board to liberally grant leave to amend pleadings at any stage of the proceedings as justice requires, unless the amendment would prejudice the adverse party or violate settled law. TBMP § 507.02; *Boral Ltd.* 59 U.S.P.Q.2d at 1702.

B. Petitioner's Proposed Amendment Should Be Allowed

Petitioner's motion to amend its Petition should be granted unless allowing the amendment would be unduly prejudicial to Registrant or if the amendment is legally insufficient. *See Hurley Int'l LLC v. Volta*, 82 U.S.P.Q.2d 1339, 1341 (T.T.A.B. 2007). Because the proposed amendment would not cause Registrant any prejudice, and is legally sufficient, the motion for leave to amend should be granted.

1. Allowing the Amendment Does Not Prejudice Registrant

It is well settled that "the party opposing the amendment bears the burden of showing prejudice." *See DCD Programs*, 833 F.2d at 187. Here Registrant cannot meet its burden. First, even though discovery is not set to close in this matter until February 13, 2008, at this time Petitioner does not believe that it will need to additional discovery to support the bases for cancellation set forth in the Amended Petition. Indeed, based on the clear admissions of Registrant's President, Petitioner anticipates that if its amendment is granted, it will file a motion for summary judgment shortly thereafter. Therefore, allowing the amendment would not delay the proceedings. Furthermore, Registrant can hardly be heard to complain about the amendment when all the facts relevant to how Registrant was using the mark are solely in Registrant's possession and control, and were not discovered by Petitioner until December 12, 2007. Put simply, allowing this amendment would not cause Registrant any prejudice.

2. The Proposed Amendment is Legally Sufficient

Petitioner has properly plead the additional bases for cancellation in its Proposed Amended Petition. Specifically, in Paragraph 15, Petitioner alleges that Registrant is not using

THE GANDERGUNMEN in connection with the claimed services. If Registrant is not using the mark in connection with services, it cannot, by definition function as a service mark.

Similarly, Petitioner has properly alleged fraud on the USPTO. To constitute fraud on the USPTO, a statement must be (1) false, (2) a material representation, and (3) made knowingly. *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha,* 77 U.S.P.Q.2d 1917, 1926 (T.T.A.B. 2006). In Paragraphs 17-19, Petitioner alleges that Registrant made representations of material fact to the USPTO that Registrant knew or should have known were false. Despite knowing that it was not providing video production or distribution services for the benefit of others, Registrant claimed that it was using the mark in connection with the provision of services beginning in September 2002. All the elements for a fraud claim are present. At his deposition, Registrant's President admitted that Registrant has never provided video production or distribution services to others. This directly contradicts statements made to the USPTO claiming that Registrant was in fact providing such services, and had been doing so at least as early as September 2002. It is clear that "[s]tatements regarding the use of the mark on goods and services are certainly material to issuance of a registration." *See Standard Knitting*, 77 U.S.P.Q.2d at 1926; *First Int'l Services Corp. v. Chuckles, Inc.*, 5 U.S.P.Q.2d 1628 (T.T.A.B. 1988). Therefore the materiality element is met. Finally, Mr. Marhoun, as President of Registrant, and the person who signed each of the documents alleged to contain a false statement, knew or should have known that the statements were false.

III. CONCLUSION

Based on the foregoing, Petitioner's Motion to Amend its Petition for Cancellation should be granted.

Respectfully submitted,

GANDER MOUNTAIN COMPANY

Date: January 18, 2008

By: _____

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ATTORNEYS FOR PETITIONER

CERTIFICATE OF SERVICE

I hereby certify that the foregoing document has been served via first-class mail, postage prepaid, to Christopher J. Schulte and Heather J. Kliebenstein of Merchant & Gould P.C., P.O. Box 2910, Minneapolis, Minnesota 55402 this 18th day of January 2007.

Kevin S. Ueland, Esq.

Exhibit A

Cancellation No.: 92046965
Atty. Ref. No.: 7495

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Gander Mountain Company Petitioner, v. ELM Development, LLC Registrant.	Cancellation No.: 92046965 Reg. No.: 3,086,200 Mark: **THE GANDERGUNMEN** Petitioner's File No.: 7495

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

[PROPOSED] AMENDED PETITION FOR CANCELLATION

Petitioner Gander Mountain Company, a Minnesota corporation, with its principal place of business at 180 East Fifth Street, Suite 1300, St. Paul Minnesota 55101, believes that it is or will be damaged by Registration No. 3,086,200 issued on the Principal Register on April 25, 2006 to ELM Development, LLC ("Registrant") for the mark **THE GANDERGUNMEN** for "[e]ntertainment services, namely, production and distribution of a hunting show" in International Class 41 (the "Registration"), and hereby petitions to cancel such registration under the provisions of Title 15 of the U.S. Code. To the best of Petitioner's knowledge, Registrant is the current owner of the Registration and has a principal place of business at 15660 Ramsey Boulevard, N.W. Ramsey, Minnesota 55123.

As grounds for petition, it is alleged that:

Likelihood of Confusion

1. Petitioner is now, and for many years prior to Registrant's claimed first use date of September 2002 has been, engaged in the marketing, sale, and promotion of retail store services in the field of hunting, fishing and camping equipment and clothing and apparel under

the **GANDER MOUNTAIN** mark. Petitioner is one of the nation's largest retailers of firearms, hunting products, and gunsmithing services. Its **GANDER MOUNTAIN** mark is particularly associated in the mind of consumers with these products and services.

2. Petitioner first began use of the **GANDER MOUNTAIN** mark to identify its retail store and retail mail order services at least as early as 1960, and the mark has been in such use continuously since then.

3. Petitioner is the owner of several U.S. Trademark Registrations for the marks **GANDER MOUNTAIN** and **GANDER MTN.**, including the following:

Reg. No. / Reg. Date	Mark	Goods/Services	First Use
1,335,489 May 14, 1985	**GANDER MOUNTAIN**	Class 16: Outdoor Sportman's Supplies Catalogues Class 42: Retail Mail Order Services in the Field of Outdoor Sportman's Supplies; Retail Store Services Specializing in Outdoor Sportsman's Supplies	Feb. 7, 1960
1,927,194 Oct. 17, 1995	**GANDER MOUNTAIN**	Class 25: Footwear and Clothing, Namely Shirts, Coats, Jackets, Vests, Sweaters, Pants, Socks, Caps and Hats	July 31, 1992
2,564,297 April 23, 2002	**GANDER MOUNTAIN**	Class 9: Rifle Scopes Class 13: Rifle Cases, Pistol Cases, and Gun Cases Class 16: Playing Cards Class 21: Mugs Class 28: Deer Hunting Decoys Class 30: Plastic Cigarette Lighters Class 34: Candy	Jan. 7, 2002
2,864,302 July 20, 2004	**GANDER MTN.**	Class 35: Retail Sporting Goods Store Featuring Outdoor Sportsman's Supplies, Hunting, Fishing and Camping Equipment, Clothing and Apparel, and Motorized and Non-Motorized Vehicles, Namely, Boats, All-Terrain Vehicles (ATVs) and Snowmobiles	Dec. 3, 2002
2,923,383 Feb. 1, 2005	**GANDER MTN.**	Class 36: Credit Card Services	Aug. 14, 2003

4. On January 2, 2007, Petitioner filed an application for U.S. trademark registration of its mark **GANDER MTN.** for "financial sponsorship of sporting events, television and radio programs, contests, promotions, charitable events, and educational seminars in the field of hunting and fishing" in International Class 36. This application bears the serial number 77/074,174.

5. Petitioner first began use and use in interstate commerce of the **GANDER MOUNTAIN** mark to identify its sponsorship services at least as early as 1998, and the mark has been in such use continuously since then.

6. On January 2, 2007, Petitioner also filed an application for U.S. trademark registration of its mark **GANDER MTN**. for "entertainment in the nature of on-going television programs with outdoor themes" in International Class 41. This application bears the serial number 77/074,177.

7. Petitioner first began use and use in interstate commerce of the **GANDER MTN.** mark to identify its ongoing television programs at least as early as January 3, 2004, and the mark has been in such use continuously since then.

8. **THE GANDERGUNMEN** mark that is the subject of the Registration, when considered in its entirety, is confusingly similar in appearance, sound and commercial impression to Petitioner's **GANDER MOUNTAIN** and **GANDER MTN.** marks.

9. The services covered by the Registration are so closely related to those goods and services covered in Petitioner's **GANDER MOUNTAIN** and **GANDER MTN.** registrations that they fall within Petitioner's zone of natural expansion, as evidenced by Petitioner's pending applications for nearly identical services as described in Paragraphs 4 through 7. At the time Registrant first used and filed its application for the mark **THE GANDERGUNMEN** mark, it was foreseeable that Petitioner, a leading provider of hunting products and an avid sponsor of

hunting events, promotions, and television and radio programs, would offer its own television programs and that such use falls within the zone of natural expansion.

10. As stated, Petitioner filed its application for registration of the **GANDER MTN.** mark in connection with financial sponsorship of sporting events and radio and television programs based on Petitioner's first use of the mark at least as early as 1998.

11. Petitioner's date of first use of the **GANDER MTN.** mark in connection with its sponsorship activities clearly predates the date of first use claimed in the Registration for the mark **THE GANDERGUNMEN**, namely, September, 2002.

12. In view of the similarity in sound, meaning, and appearance of the respective marks, the prior use of Petitioner's **GANDER MOUNTAIN** and **GANDER MTN.** marks, and the goodwill associated with Petitioner's marks, it is alleged that Registrant's mark **THE GANDERGUNMEN**, when registered throughout the United States without limitation, in association with the production and distribution of a hunting show, so resembles Petitioner's marks as to be likely to cause confusion, to cause mistake, or to deceive a substantial number or persons to believe, mistakenly, that Registrant's services originate from, or are approved by, or are in some way associated with Petitioner, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

Failure to Function as a Service Mark

13. On information and belief, Registrant is not entitled to Registration No. 3,086,200 because the term for which registration has been obtained fails to function as a service mark under Trademark Act Sections 23 and 45, 15 U.S.C. §§ 1091 and 1127.

14. Registrant's specimen consists of a screen shot from a DVD showing the mark **THE GANDERGUNMEN** as identifying the title of a single hunting episode, as opposed to identifying a series of episodes or Registrant's production and distribution services.

15. Registrant's use of the mark in connection with the sale of DVDs does not identify Registrant as a provider of production or distribution services for the benefit of others, nor does it associate Registrant's mark with those claimed services. Any video production that Registrant did perform was in producing its own DVDs, which Registrant subsequently offered for sale. This activity was primarily for Registrant's own benefit and is unregistrable as a service. A term that is used only to identify a product sold or used in the performance of a service rather than to identify the service itself does not function as a service mark.

Fraud on the United States Patent and Trademark Office

16. On information and belief, Registrant's mark is invalid because Registrant made one or more material representations of fact to the USPTO that Registrant knew or should have known were false.

17. On information and belief, on December 9, 2003, Registrant filed its service mark application for **THE GANDERGUNMEN** in connection with "[e]ntertainment services, namely production and distribution of a hunting show."

18. On information and belief, on July 20, 2005, Registrant filed its statement of use. In this statement of use, Registrant claimed a date of first use in commerce in connection with the claimed services of September 2002. Additionally, Registrant stated that Registrant stated that it had "a bona fide intention to use ... the mark in commerce . . . in connection with the identified. . . services."

19. On information and belief, on February 10, 2006, Registrant filed a Response to an Office Action dated August 10, 2005, which had rejected Registrant's July 20, 2005 statement of use. In this Response, Registrant claimed that it first used the mark in commerce in September 2002, and stated that it had "a bona fide intention to use . . . the mark in commerce . . . in connection with the identified. . . services."

20. It is alleged that Registrant knew or should have know that such misrepresentations of fact as referenced in Paragraphs 17-19 herein were false and/or misleading.

21. It is alleged that Registrant has committed fraud in procuring a registration for **THE GANDERGUNMEN**, thus making the registration void.

22. By virtue of the foregoing, Petitioner believes that it is and will be damaged by the continued existence of the Registration because the Registration is likely to prevent Petitioner's applications for the marks **GANDER MOUNTAIN** and **GANDER MTN.** from achieving registration in the U.S. Patent and Trademark Office and enjoying all statutory benefits attendant thereto. Further, Petitioner is and will be damaged by the continued registration of Registrant's mark because Registrant will enjoy unlawful gain and advantage to which it is not entitled under the Lanham Act, 15 U.S.C. §§ 1051, et seq.

WHEREFORE, Petitioner prays that said Registration No. 3,086,200 be canceled and that this petition be sustained in favor of Petitioner.

Respectfully submitted,

GANDER MOUNTAIN COMPANY

Date: _____

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