

TTAB

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

76078278

Baxley

Mailed: September 30, 2009

Cancellation No. 92048118

Jack Richeson & Co., Inc.

v.

Select Export Corp. d/b/a
Trident

Before Walters, Zervas and Wellington,
Administrative Trademark Judges

By the Board:

Select Export Corp. d/b/a Trident ("respondent") is the owner of a registration for the mark TRIDENT and design in the following form,



for "surveying, measuring, and teaching apparatus and instruments, namely, computer stands specifically designed for holding computer equipment, triangular scales, [and] graduated acrylic rulers" in International Class 9; "artists' material, namely, easels, wooden easels, drafting compasses, drafting instruments, drafting rulers, drafting triangles, drawing boards, drawing compasses, drawing pads, drawing rulers, painting palettes, technical pens,



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adjustable triangles, T squares, drawing flexible curve ruler, [and] compasses" in International Class 16; "wooden taboret for architectural drawings plans and maps, furniture, auxiliary cart for art supplies, steel drafting tables, wooden drafting tables, wooden stools, wooden tops and melamine tops for use on top of drafting tables" in International Class 20.¹

By way of an amended petition to cancel, Jack Richeson & Co., Inc. ("petitioner") seeks cancellation of respondent's registration on the ground of fraud upon the USPTO based on the following three occurrences:

(1) in the application for such registration, filed on June 28, 2000, by knowingly and falsely: (a) asserting that it was using the mark on certain identified goods; (b) relying upon the 1999 catalog of petitioner's predecessor-in-interest, Trident S/A Industria De Precisao ("Trident"), as a specimen of use in support of that application; and (c) asserting that it is the owner of the involved registered mark;

(2) in the declaration under Trademark Act Section 15, 15 U.S.C. Section 1065, that it filed on September 17, 2007

¹ Registration No. 2619642, issued September 17, 2002, based on a use-based application filed on June 28, 2000, in which respondent alleged March 1, 1988 as both the date of first use anywhere and the date of first use in commerce. Section 8 affidavit accepted, Section 15 affidavit acknowledged. The registration includes a statement that the mark is lined for the color red.

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for the involved registration by knowingly and falsely asserting that: (a) it is the owner of the involved registered mark; and (b) it had used the involved mark on certain identified goods for five consecutive years from the date of the issuance of the involved registration and was still using that mark in commerce on or in connection with those goods; and

(3) in the declaration that it filed under Trademark Act Section 8, 15 U.S.C. Section 1058, on September 24, 2007 for the involved registration by knowingly and falsely: (a) asserting that it is the owner of the involved registered mark; and (b) relying upon specimens showing use of the involved registered mark on goods of Trident, when respondent is only a distributor of those goods.²

Petitioner further seeks to cancel the subject registration based on the grounds of abandonment of the involved mark because any use of that mark ceased in 2003; and nonownership of the involved mark.

Respondent, in its answer, denied the salient allegations of the amended petition to cancel and asserted various affirmative defenses, including that the petition to

² A review of the amended petition to cancel indicates that the fraud claim set forth therein is based upon allegations made on petitioner's knowledge and is based upon allegedly false material statements that respondent knowingly made. Accordingly, the fraud claim is adequately pleaded under the revised standards for fraud claims set forth in *In re Bose Corp.*, ___ F.3d ___, 91 USPQ2d 1938 (Fed. Cir. 2009).

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cancel is barred under the doctrine of *res judicata* (or claim preclusion) in view of the Board's dismissal with prejudice of the petition to cancel that Trident filed in Cancellation No. 92043330, styled *Trident S/A Industria De Precisao v. Select Import Corp. d/b/a Trident*.³

This case now comes up for consideration of:

(1) petitioner's motion (filed January 5, 2009) for summary judgment on its pleaded claims that respondent committed fraud upon the USPTO by: (a) falsely asserting in the application and Section 8 and Section 15 declarations that it owns the involved registered mark; and (b) relying upon specimens showing use of the involved registered mark by Trident in support of the application and Section 8 declaration for its involved registration when it is merely a distributor of goods sold thereunder; and

(2) respondent's cross-motion (filed February 5, 2009) for summary judgment on the grounds that: (a) this cancellation proceeding should be dismissed because the

³ In Cancellation No. 92043330, Trident sought to cancel the involved registration on the ground that respondent is not, and was not at the time the underlying application was filed, the owner of the registered mark. The Board, in a September 30, 2005 order, dismissed with prejudice the petition to cancel in that proceeding based on the predecessor-in-interest's loss of interest after the predecessor-in-interest failed to respond to a Board order to show cause following the withdrawal of its attorney from that proceeding.

Respondent, on May 29, 2008, filed a motion for summary judgment under the doctrine of *res judicata* in view of the earlier dismissal of Cancellation No. 92043330 and on grounds not at issue in this order. However, the Board denied that motion in a November 4, 2008 order.

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assignment of the pleaded TRIDENT mark from Trident to petitioner was in gross and is therefore null and void because Trident continues to use petitioner's pleaded mark in the United States, while petitioner has not used the pleaded mark since that mark was assigned to petitioner on August 15, 2007; and (b) there is no fraud because respondent's claim of ownership of the involved mark is not false and its reliance upon the specimens submitted with the application and Section 8 declaration is proper.

Each party has opposed the other's motion for summary judgment.

Summary judgment is an appropriate method of disposing of a case in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). In deciding a motion for summary judgment, the Board may not resolve issues of material fact; it may only ascertain whether such issues are present. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

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The Board turns first to respondent's cross-motion for summary judgment, through which it seeks dismissal of the petition to cancel because the assignment of the pleaded TRIDENT mark from Trident to petitioner was in gross and is therefore null and void.⁴ In essence, respondent's motion is based on the contention that petitioner acquired from Trident no rights in the TRIDENT mark, and its motion for summary judgment requires a showing that there is no genuine issue of fact about the absence of any rights in petitioner. We find, however, that there is a genuine issue of material fact as to whether rights in the pleaded TRIDENT trademark were acquired by petitioner via the purported assignment and thus as to petitioner's standing to maintain this proceeding.⁵ Accordingly, respondent's cross-motion for summary judgment on this basis is denied.

The Board turns next to the parties' cross-motions in connection with petitioner's claim that respondent committed fraud by knowingly and falsely asserting ownership of the involved registered mark in the underlying application and Section 8 and Section 15 declarations for the involved

⁴ We note that respondent relied upon that assignment in support of its earlier motion for summary judgment under the doctrine of *res judicata*.

⁵ To the extent that respondent alleges that petitioner has not used the pleaded mark since the assignment was executed on August 15, 2007 and has therefore abandoned the pleaded mark, we note that the alleged nonuse is for less than the three-year statutory presumption for abandonment. See Trademark Act Section 45, 15 U.S.C. Section 1127.

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registration.⁶ After reviewing the parties' arguments and evidence we find that disposition of this proceeding by summary judgment is inappropriate because there is an evidentiary conflict in the record as to whether respondent is a distributor or the owner of the involved registered mark.⁷ Petitioner asserts through the declaration of Ivan Manturana Segato, a director of Trident, that Trident commenced selling the relevant goods under its pleaded mark in the United States in 1979 and that respondent had been an importer and distributor of Trident's goods sold under the pleaded marks from the mid-1980's until 2003, but that the parties did not have a written contract. Through the declaration of respondent's founder Herbert Moebius Castaneda, respondent, in response, submits a May 1991 letter signed by respondent's president Herbert E. Moebius and Julio Cesar Aguirre of Trident in which the parties agreed that respondent "is not a distributor" and that goods manufactured by Trident for respondent are manufactured specifically for respondent and cannot be sold by Trident. In reply, petitioner asserts through the declaration of

⁶ Fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes false, material representations of fact in connection with an application to register. See *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986).

⁷ We note that the parties rely herein upon many documents that appear to be written in either Portuguese or Spanish. Any non-English documents that the parties intend to rely upon herein should be accompanied by proper translations into English.

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Domingos Zannoco, a director of Trident, that Mr. Aguirre was an independent sales representative of Trident and other art supply companies who was not authorized by Trident to sign the May 1991 letter then or at any other time.

Accordingly, there is, at a minimum, a genuine issue as to whether respondent falsely asserted ownership of the involved mark in the underlying application and Section 8 and Section 15 declarations for the involved registration. Further, if respondent's assertion of ownership of the mark was indeed false, there is a genuine issue of material fact as to whether respondent knew when it signed the application and the Section 8 and 15 declarations that it did not actually own the mark.

We turn next to the question of whether respondent's submission of specimens showing goods manufactured by Trident in support of the application and Section 8 declaration was fraudulent. Respondent concedes that those specimens show goods manufactured by Trident. However, respondent explains through the declaration of Mr. Moebius that Trident manufactured those goods for respondent and to respondent's specifications. Accordingly, there is a genuine issue of material fact as to the ownership of the mark for the goods shown in the specimens.⁸

⁸ The parties should not infer that the issues mentioned in this order are the only ones which remain for trial.

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In view thereof, both petitioner's motion for summary judgment and respondent's cross-motion for summary judgment are denied.⁹ The Board has now denied two motions for summary judgment from respondent and one such motion from petitioner, on a variety of issues. Because the parties have had ample opportunity through their motions for summary judgment to demonstrate any lack of genuine issues of material fact in this case pertaining to a variety of issues, the parties are hereby ordered not to file any further motions for summary judgment in this proceeding.

Proceedings herein are resumed. Testimony periods are reset as follows.¹⁰

Plaintiff's 30-day testimony period to close: **December 2, 2009**

Defendant's 30-day testimony period to close: **January 31, 2010**

Plaintiff's 15-day rebuttal testimony period to close: **March 17, 2010**

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.

⁹ The parties should note that evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983).

¹⁰ The pleaded fraud issues herein will be determined under the revised standards for fraud claims set forth in *In re Bose Corp.*, *supra*.

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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.

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.

Commissioner for Trademarks
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