

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

Mailed: January 27, 2010

Cancellation No. 92051149

Atwater Kent Manufacturing  
Company

v.

Michael D. Leveille

Jennifer Krisp, Interlocutory Attorney:

This proceeding is before the Board for consideration of petitioner's motion (filed December 15, 2009) to amend the petition to cancel. The motion has been fully briefed.

Michael D. Leveille ("respondent") is owner of the subject registration for the mark ATWATER KENT (standard characters) for "generators, namely, electric generators; starters for motors and engines; and ignition coils" in International Class 7, and "condensers; fuel level guages (sic); oil level sensors; fuel tank sending units in the nature of float-type resistance-based fuel tank level sending units and hydrostatic sending units" in International Class 9.<sup>1</sup>

Atwater Kent Manufacturing Company ("petitioner") petitioned to cancel said registration. The petition lists the following grounds: 1) false suggestion of a connection; 2) mark consists of or comprises a name, portrait or signature of a living individual without written consent; 3) fraud; 4)

---

<sup>1</sup> Registration No. 3366870, issued January 8, 2008.

abandonment; 5) misrepresentation of the source of the goods or services on or in connection with which the mark is used; 6) priority and likelihood of confusion.

Petitioner moves the Board for leave to file an amended petition which adds the following Paragraph 25 in its concurrently-filed proposed amended petition:

25. Pursuant to Section 14(3), Respondent is using the ATWATER KENT trademark to misrepresent the source of the goods/services in connection with which the ATWATER KENT mark is used. Respondent has deliberately sought to pass off its goods as those of Petitioner on its website, and in advertising and promotions indicating an association with the founder Atwater Kent and Petitioner itself.

In support of its motion, petitioner states that it "recently received documents in response to document demands that evidence that Respondent is using the ATWATER KENT trademark to misrepresent the source of the goods/services in connection with which the ATWATER KENT mark is used." Petitioner further states that, "Respondent has deliberately sought to pass off its goods as those of Petitioner on its website, and in advertising and promotions indicating an association with the founder Atwater Kent and Petitioner itself." Petitioner submitted a declaration of its counsel of record in support of these statements.

In opposition to the motion, respondent argues that petitioner does not explain or specify how the proposed new allegations differ from those in the original petition, or what recently produced material prompted them. Respondent asserts that petitioner has not discovered any new facts, but rather is attempting to belatedly add a claim based on facts that were in its possession at the time the petition was filed. Respondent further asserts that the proposed new paragraph "is a futile ... cumulative re-hash of original paragraph 11," and that petitioner admitted in its responses to written discovery that its alleged predecessor ceased manufacturing certain goods of the type covered in respondent's registration.

Analysis

Pleadings in a cancellation may be amended in the same manner and to the same extent as in a civil action in a United States district court. See Trademark Rule 2.115. Amendments to pleadings in *inter partes* proceedings before the Board are governed by Fed. R. Civ. P. 15, made applicable to Board proceedings by operation of Trademark Rule 2.116(a). After a responsive pleading has been filed, a party may amend its pleading only by written consent of every adverse party, or by leave of the Board. Leave shall be freely given when justice so requires. See Fed. R. Civ P. 15(a). The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. See TBMP § 507.01 (2d

ed. rev. 2004). See also *Hurley International LLC v. Volta*, 82 USPQ2d 1339, 1341 (TTAB 2007). Where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion for leave to amend. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1785 (Fed. Cir. 1990). The timing of a motion for leave to amend under Fed. R. Civ. P. 15(a) is a factor in determining whether the adverse party would be prejudiced by allowance of the proposed amendment. The motion should be filed as soon as any ground for such amendment becomes apparent. See *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993).

Turning to the sufficiency of the proposed allegations, in a cancellation proceeding, misrepresentation of source under Trademark Act Section 14(3) refers to where it is deliberately misrepresented by or with the consent of registrant that goods and/or services originate from a manufacturer or other entity, when in fact those goods and/or services originate from another party. See *Otto International, Inc. v. Otto Kern GMBH*, 83 USPQ2d 1861, 1863 (TTAB 2007). A cancellation claim for misrepresentation requires a pleading that respondent deliberately sought to pass off its goods as those of petitioner. *Id.*, citing McCarthy, J. Thomas, 3 *McCarthy on Trademarks and Unfair Competition*, § 20:60 (4<sup>th</sup> ed. 2007). Petitioner must allege specific acts or conduct on the part of respondent aimed at deceiving the public into thinking that

respondent's goods and/or services actually emanate from petitioner. *Otto International, Inc.*, at 1864.

Turning to the specific merits of petitioner's motion, with respect to respondent's argument that the allegations petitioner seeks to add are a "cumulative re-hash of" allegations in the original complaint, the Board notes that in the original complaint, petitioner 1) listed on the electronic filing ("ESTTA") cover sheet the ground of misrepresentation under Trademark Act Section 14, and 2) included the following:

11. Respondent makes false claims to both an association with both Atwater Kent himself, and Respondent. For instance, Respondent claims on its website that "originally founded in 1895, we still hand-craft specific items for your automotive or radio collection." Respondent also provides a complete history of the founder (including photos) and the company. See accompanying pages from Respondent's website attached hereto as Exhibit 1.<sup>2</sup>

Inasmuch as Paragraph 11 sets forth specific allegations of fact regarding certain activities on the part of respondent, and proposed Paragraph 25 (noted at page 2 above) states the statutory basis for a misrepresentation claim and alleges that

---

<sup>2</sup> The Board notes that the petition does not include any exhibits. The Board also notes that the final paragraph of the petition requests cancellation of a registration that is not involved in this proceeding, namely, Registration No. 2952925, that said registration was the subject of Cancellation No. 92051150, that a Board order issued on January 14, 2010 granting the petition filed therein, and that the proposed amended petition for cancellation filed herein on December 15, 2009 does not include the reference to Registration No. 2952925.

respondent's activities were deliberate in nature and sought to pass off goods as those of petitioner, the Board construes the allegations in Paragraph 25 as serving to add to or amplify those set forth in Paragraph 11.<sup>3</sup> The allegations in Paragraph 25 do not add a new claim altogether, but rather augment the allegations petitioner included in the original complaint. Furthermore, the amended petition serves to place respondent on further notice of a factual basis for petitioner's misrepresentation claim.

Regarding the timing of petitioner's motion, discovery was reset to close on May 7, 2010, and petitioner filed its motion when nearly five months remained in the discovery period. Thus, ample opportunity remains for the parties to conduct discovery related to the allegations petitioner seeks to add to its petition. Finally, nothing in the record indicates that petitioner delayed unnecessarily or in bad faith in moving for leave to amend. In view of these circumstances, the Board finds that minimal potential prejudice to respondent will result from allowing the allegations petitioner seeks to add.

Accordingly, petitioner's motion for leave to file its amended petition is hereby granted. The proposed amended petition for cancellation filed on December 15, 2009 is now the operative pleading in this proceeding. Petitioner is allowed fifteen (15) days from the mailing date of this order in which to file a signed copy of its proposed amended petition, see

---

<sup>3</sup> Moreover, the Board notes that Paragraphs 13 and 14 of the original (and amended) petition allege that consumers in the

TBMP § 507.01 (2d ed. rev. 2004). Respondent is allowed thirty (30) days from the date of service of the signed amended petition in which to file its answer thereto. See Trademark Rule 2.113(a); see also TBMP § 310.03(b) (2d ed. rev. 2004).

Sua sponte review of fraud claim

Fed. R. Civ. P. 9(b) requires that the circumstances constituting an alleged fraud shall be stated with particularity. See also *King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801 (CCPA 1981) (“[t]he pleadings [must] contain explicit rather than implied expressions of the circumstances constituting fraud”). The time, place and contents of the false representations, the facts misrepresented, and identification of what has been obtained, shall be stated with specificity. See *W.R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670 (Comm’r Pat. 1977). To satisfy Rule 9(b), any allegations made upon “information and belief” must be accompanied by a statement of facts upon which the belief is founded. See *Exergen Corp., v. Wal-Mart Stores, Inc.*, 91 USPQ2d 1656 (Fed. Cir. 2009). Recent decisions of the Board, and of its primary reviewing court, have stated that pleadings of fraud which rest on allegations that the trademark applicant or registrant made material representations of fact in connection with its application or registration which it “knew or should have known” to be false or misleading constitute an insufficient pleading of

---

marketplace will be misled as to the authenticity, reliability,

fraud because such allegations imply the possibility mere negligence, which is inadequate to infer fraud or dishonesty. In particular, a pleading of fraud on the USPTO must include an allegation of intent. See *In re Bose Corporation*, 476 F.3d 1331, 91 USPQ2d 1938, 1940 (Fed. Cir. 2009); *Asian and Western Classics B.V. v. Lynne Selkow*, 92 USPQ2d 1478, 1479 (TTAB 2009).

Inasmuch as petitioner listed fraud as a ground for cancellation on the ESTTA filing cover sheet, the Board notes that, to the extent that petitioner intends to set forth a fraud claim by way of Paragraphs 20, 21, 22 and 24 of the original and amended petition, the allegations in said paragraphs fail to sufficiently set forth such a claim in view of prevailing authorities. Hence, the Board does not construe the operative pleading as including a sufficiently pleaded fraud claim.<sup>4</sup>

Schedule

Proceedings are hereby resumed. All remaining dates are reset as follows:

Expert Disclosures Due	5/19/2010
Discovery Closes	6/18/2010
Plaintiff's Pretrial Disclosures	8/2/2010
Plaintiff's 30-day Trial Period Ends	9/16/2010
Defendant's Pretrial Disclosures	10/1/2010

---

and source of goods originating from respondent.

<sup>4</sup> Petitioner is further advised that, under USPTO Rule 11.18, the factual basis for a pleading requires that the pleader know of facts that support the pleading or that evidence showing the factual basis is "likely" to be obtained after a reasonable opportunity for discovery or investigation. See also Fed. R. Civ. P. 11.

Cancellation No. 92051149

Defendant's 30-day Trial Period Ends	<b>11/15/2010</b>
Plaintiff's Rebuttal Disclosures	<b>11/30/2010</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>12/30/2010</b>

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.