

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

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

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Mailed: June 17, 2010

Cancellation No. 92051170

O2Micro International Limited

v.

O2 HOLDINGS LIMITED

**Before Hairston, Kuhlke, and Wellington,  
Administrative Trademark Judges.**

By the Board:

Petitioner seeks to cancel respondent's registration<sup>1</sup> for the mark O2 for "computer hardware and computer operating system software, and instructional manuals therefor sold as a unit therewith" in International Class 9. As grounds for cancellation, petitioner alleges that respondent committed fraud in the procurement of the renewal of its registration and that the mark has been abandoned.

Respondent denied the salient allegations in its answer.

This case now comes up for consideration of petitioner's cross-motion (filed on November 5, 2010<sup>2</sup>) for

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<sup>1</sup> U.S. Registration No. 2231093, issued March 9, 1999, reciting September 28, 1996, as the date of first use and date of first use in commerce.

<sup>2</sup> Such motion was filed in conjunction with petitioner's response brief to respondent's motion for summary judgment on the issue of

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summary judgment on the grounds that the involved registration was fraudulently obtained and that respondent's mark O2 has been abandoned.<sup>3</sup> The motion is fully briefed.<sup>4</sup>

We first turn to petitioner's claim that respondent has abandoned its mark.

Summary judgment is an appropriate method of disposing of any case that has 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). The party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793

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petitioner's lack of standing. Respondent's motion for summary judgment was denied by the Board in its order of April 14, 2010.<sup>3</sup> In its motion, petitioner does not affirmatively state that it served its initial disclosures pursuant to Trademark Rule 2.127(e)(1). See *Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1255 n.7 (TTAB 2009) (if a party moves for summary judgment prior to the deadline for making initial disclosures it should indicate in its motion that the disclosures have been made). We note, however, that in its response brief, respondent does not indicate that petitioner's motion is untimely under Trademark Rule 2.127(e)(1) despite the fact that respondent's own motion for summary judgment was deemed untimely under this same rule in the Board's order of April 14, 2010. We observe that petitioner specifically argued in its response brief to respondent's motion for summary judgment that the motion was untimely because respondent had not filed its initial disclosures prior to filing its motion for summary judgment in accordance with Trademark Rule 2.127(e)(1). Under these circumstances, we presume, therefore, that petitioner served its initial disclosures (which were due by November 9, 2009) prior to filing its cross-motion for summary judgment on November 5, 2009.

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(Fed. Cir. 1987). The evidence must be viewed in a light favorable to the non-moving party, and all justifiable inferences are to be drawn in the non-movant's favor.

*Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 767, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 852, 23 USPQ2d 1471 (Fed. Cir. 1992).

After reviewing the arguments and supporting evidence, we conclude that disposition of this matter by summary judgment is not appropriate with respect to petitioner's abandonment claim because, at a minimum, genuine issues of material fact exist as to when exactly respondent's predecessor-in-interest ceased using the subject mark and as to respondent's continuous use of its mark.<sup>5</sup>

Accordingly, petitioner's cross-motion for summary judgment on the claim of abandonment is denied.

We turn next to the fraud claim and find that such claim is insufficiently pleaded under *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009) and *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478 (TTAB 2009). Petitioner's allegations of fraud regarding respondent's alleged false statements to the Office are based solely upon

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<sup>4</sup> We observe that the Board's order of April 14, 2010, allowed respondent time to file a brief in response to petitioner's cross-motion for summary judgment.

<sup>5</sup> The fact that we have identified and discussed only a few genuine issues of material fact as a sufficient basis for denying the motion for summary judgment should not be construed as a

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information and belief. These allegations fail to meet the Fed. R. Civ. P. 9(b) requirements as they are unsupported by any statement of facts providing the information upon which petitioner relies or the belief upon which the allegation is founded (i.e., known information giving rise to petitioner's stated belief, or a statement regarding evidence that is likely to be discovered that would support a claim of fraud). See *In re Bose*, 91 USPQ2d at 1938 and *Asian and Western Classics B.V.*, 92 USPQ2d at 1479.

Because petitioner's fraud claim was not properly pleaded and is insufficient to state a claim, the cross-motion for summary judgment with regard to the fraud claim is deemed moot. *Intermed Communications, Inc. v. Chaney*, 197 USPQ 501, 503 n. 2 (TTAB 1977) ("If a claim has not been properly pleaded, one cannot obtain summary judgment thereon"). See also *Consolidated Foods Corporation v. Berkshire Handkerchief Co., Inc.*, 229 USPQ 619, 621 (TTAB 1986) (The rule that only properly pleaded issues may be the subject of a grant of summary judgment "is especially important where the asserted ground for summary judgment is fraud since in pleading fraud, 'the circumstances ... shall be stated with particularity.' Fed. R. Civ. P. 9(b)").

We note in any event, that even if we were to consider petitioner's motion for summary judgment on the fraud claim on its merits, the motion would have to be denied because genuine issues remain at least with respect to respondent's

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finding that these are necessarily the only issue which remain

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intent to commit fraud on the USPTO. A party making a fraud claim is under a heavy burden because fraud must be "proven 'to the hilt' by clear and convincing evidence," leaving nothing to speculation, conjecture, or surmise; any doubt must be resolved against the party making the claim. *Smith International, Inc. v. Olin Corp.*, 209 USPQ 1033, 1043-1044 (TTAB 1981). The factual question of intent is particularly unsuited to disposition on summary judgment. *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1299 (Fed. Cir. 1991).

Petitioner is allowed until TWENTY DAYS from the mailing date of this order to file and serve an amended pleading properly alleging fraud, if petitioner has a sound basis for doing so, failing which, the existing allegations regarding fraud are hereby stricken.

If petitioner does file an amended pleading, respondent is allowed until FORTY days from the mailing date of this order to file its answer thereto.

Proceedings are resumed. Dates in this proceeding are reset as follows<sup>6</sup>:

Expert Disclosures Due	8/24/2010
Discovery Closes	9/23/2010
Plaintiff's Pretrial Disclosures	11/7/2010
Plaintiff's 30-day Trial Period Ends	12/22/2010
Defendant's Pretrial Disclosures	1/6/2011

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for trial.

<sup>6</sup> The schedule does not provide for the service of initial disclosures because we note the record indicates that respondent served such disclosures on October 28, 2009 and we, again, presume that petitioner served its disclosures prior to the filing of its cross-motion for summary judgment on November 5, 2010.

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Defendant's 30-day Trial Period Ends	2/20/2011
Plaintiff's Rebuttal Disclosures	3/7/2011
Plaintiff's 15-day Rebuttal Period Ends	4/6/2011

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 of completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.