

TTAB

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

77055550

Baxley

Mailed: February 3, 2011

Cancellation No. 92052657

Frosty King Inc. (Nevada
corporation)¹

v.

Frosty King, Inc. (Florida
corporation)

By the Trademark Trial and Appeal Board:

On February 1, 2011, petitioner filed a motion to compel discovery. Although respondent's time to respond has not lapsed, the Board, in its discretion, elects to decide the motion to compel at this time.

In the interest of narrowing the issues in the motion to compel and in this proceeding in general, the Board reviewed the pleadings herein. In the petition to cancel, petitioner seeks cancellation of respondent's Registration No. 3537613 for the mark FROSTY KING in standard character form for "restaurant services" in International Class 43.²

¹ In the electronic cover sheet of the petition to cancel, petitioner is identified as "Frost King Inc." However, in the text of the petition to cancel and in the motion to compel, petitioner is identified as "Frosty King Inc." Because petitioner clearly intends to identify itself as "Frosty King Inc.," the discrepancy in the caption of this proceeding has been corrected.

² Registration No. 3537613, issued November 25, 2008.



02-07-2011

Cancellation No. 92052657

Petitioner has adequately pleaded its standing to maintain this proceeding by alleging a personal interest in the outcome of the proceeding and a reasonable basis for a belief of damage in paragraph nos. 1, 4-6, and 12-13 of the petition to cancel. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Universal Oil Prod. Co. v. Rexall Drug & Chem. Co.*, 463 F.2d 1122, 1123, 174 USPQ 458, 459 (CCPA 1972). In addition, petitioner has adequately pleaded a claim under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), in paragraph nos. 4-7 and 11 of the petition to cancel, wherein it alleges prior use of an identical mark for identical services. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Although petitioner does not use the word "fraud," the allegations set forth in paragraph nos. 8-10 of the petition to cancel appear intended as a fraud claim. Therein, petitioner alleges "on information and belief," that respondent "should have reasonably known" of petitioner's prior use of the FROSTY KING mark when respondent filed the application for the involved registration and made the statements in that application with the intent of inducing the Office to issue the involved registration.

Fraud in procuring or maintaining a trademark registration occurs when an applicant for registration or a

Cancellation No. 92052657

registrant in a declaration of use or a renewal application knowingly makes specific false, material representations of specific facts in connection with an application to register or in a post-registration filing with the intent of obtaining or maintaining a registration to which it is otherwise not entitled. See *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986).

Because intent is a required element to be pleaded for a claim of fraud, allegations that a party made material representations of fact that it "knew or should have known" were false or misleading are insufficient. See *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009).

Further, pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are also insufficient. See *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478 (TTAB 2009). In addition, a plaintiff claiming that the declaration or oath in defendant's application for registration was executed fraudulently, in that there was another use of the same or a confusingly similar mark at the time the oath was signed, must allege particular facts which, if proven, would establish that: (1) there was in fact another use of the same or a confusingly similar mark at the time the oath was signed; (2) the other user had legal rights superior to applicant's; (3) applicant knew the

Cancellation No. 92052657

other user had rights in the mark superior to applicant's and believed that a likelihood of confusion would result from applicant's use of its mark; and (4) applicant, in failing to disclose these facts to the Patent and Trademark Office, intended to procure a registration to which it was not entitled. See *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1205 (TTAB 1997). Petitioner has not pleaded the required elements for a fraud claim based on false statements in the application declaration for the involved registration. Paragraphs 8-10 of the petition to cancel are therefore *sua sponte* stricken.³ See Fed. R. Civ. P. 12(f); TBMP Section 506.01.

In paragraph 14(b) of the petition to cancel, petitioner appears to intend to set forth a claim of false suggestion under Trademark Act Section 2(a), 15 U.S.C. Section 1052(a), by alleging that respondent's involved FROSTY KING mark "falsely suggests a connection with or authorization by [p]etitioner." A Section 2(a) false suggestion claim is rooted in the right of privacy and is not intended as an alternative means of raising a Section 2(d) claim. See *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F2d 1372, 217 USPQ 505 (Fed.

³ The Board can strike any insufficient claim or defense whenever it has occasion to review the pleadings. See Fed. R. Civ. P. 12(f); TBMP Section 506.01.

Cancellation No. 92052657

Cir. 1983). A claim of false suggestion under Section 2(a) requires allegations that:

- (1) The mark sought to be registered is the same as, or a close approximation of, the name or identity previously used by another person or institution;
- (2) The mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution;
- (3) The person or institution identified in the mark is not connected with the goods sold or services performed by applicant under the mark; and
- (4) The fame or reputation of the named person or institution is of such a nature that a connection with such person or institution would be presumed when applicant's mark is used on its goods and/or services.

Petróleos Mexicanos v. Intermix SA, 97 USPQ2d 1403 (TTAB 2010). Petitioner has not set forth the required elements for a Section 2(a) false suggestion claim in the petition to cancel. Accordingly, paragraph 14(b) of the petition to cancel is *sua sponte* stricken.⁴ See Fed. R. Civ. P. 12(f); TBMP Section 506.01.

In the answer, respondent denies the salient allegations of the petition to cancel and sets forth affirmative defenses of failure to state a claim, laches, estoppel, and unclean hands. Respondent's first affirmative

⁴ If petitioner wants to plead fraud and/or false suggestion claims, it should file a motion for leave to file an amended petition to cancel. See Fed. R. Civ. P. 15(a); TBMP Section 507.02.

Cancellation No. 92052657

defense, failure to state a claim upon which relief may be granted, is solely a test of the sufficiency of petitioner's complaint. See Fed. R. Civ. P. 12(h)(2); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995); TBMP Section 503.01. Respondent cannot prevail on such a defense unless the petition to cancel fails to allege petitioner's standing and/or a ground for cancellation of the involved registration. See TBMP Section 503.02. As noted *supra*, petitioner has adequately pleaded both its standing and a Section 2(d) claim. Respondent's first affirmative defense is therefore *sua sponte* stricken. See Fed. R. Civ. P. 12(f); TBMP Section 506.01.

Regarding respondent's second and third affirmative defenses of laches and estoppel, said defenses are set forth as conclusory allegations. Because respondent has failed to set forth any specific facts which provide the basis therefor, those defenses are insufficiently pleaded.⁵ See

⁵ The Board notes that the application for respondent's involved registration was published for opposition on June 26, 2007 and that petitioner filed the petition to cancel on June 25, 2010, nineteen months after the issuance of the involved registration. Laches begins to run from when a mark is published for opposition and requires both a showing of undue delay in asserting rights against the defendant and prejudice resulting therefrom. See *Nat'l Cable Television Ass'n Inc. v. American Cinema Editors Inc.*, 19 USPQ2d 1424 (Fed. Cir. 1991).

To the extent that respondent's estoppel defense is intended as an equitable estoppel defense, the elements of equitable estoppel are (1) misleading conduct, which may include not only statements and action but silence and inaction, leading another to reasonably infer that rights will not be asserted against it; (2)

Cancellation No. 92052657

Heisch v. Katy Bishop Productions Inc., 45 USPQ2d 1219 (N.D. Ill. 1997); Wright & Miller, *Federal Practice and Procedure: Civil 2d*, Section 1274 (1990 & Supp. 2001). Accordingly, respondent's second and third affirmative defenses are *sua sponte* stricken.⁶ See Fed. R. Civ. P. 12(f); TBMP Section 506.01.

The Board now turns to petitioner's motion to compel. After reviewing petitioner's arguments and exhibits, the Board finds that petitioner did not make a good faith effort to resolve the parties' discovery dispute prior to seeking Board intervention, as required by Trademark Rule 2.120(e)(1). Notably, petitioner served twenty-six interrogatories and twenty-six document requests and now seeks further responses to twenty-one interrogatories and twenty requests for production. Moreover, petitioner has not cited to any case law in its brief to support its contentions that the information and documents sought through the discovery requests at issue are properly discoverable in Board *inter partes* proceedings. The parties are directed to review TBMP Section 414 regarding the discoverability of various types of information in such

reliance upon this conduct; and (3) due to this reliance, material prejudice if the delayed assertion of such rights is permitted. See *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992).

⁶ If respondent wants to file an amended answer, it must file a motion for leave to file an amended answer. See Fed. R. Civ. P. 15(a); TBMP Section 507.02.

Cancellation No. 92052657

proceedings. Most of the problems addressed in the motion to compel should be resolved without Board intervention, and the Board suggests greater effort to avoid or resolve such controversies.⁷

Petitioner is reminded that it must adhere to the strictures set forth in *Sentrol, Inc. v. Sentex Systems, Inc.*, 231 USPQ 666 (TTAB 1986), and repeated below:

[E]ach party and its attorney has a duty not only to make a good faith effort to satisfy the discovery needs of its opponent but also to make a good faith effort to seek only such discovery as is proper and relevant to the specific issues involved in the case. Moreover, where the parties disagree as to the propriety of certain requests for discovery, they are under an obligation to get together and attempt in good faith to resolve their differences and to present to the Board for resolution only those remaining requests for discovery, if any, upon which they have been unable, despite their best efforts, to reach an agreement. Inasmuch as the Board has neither the time nor the personnel to handle motions to compel involving substantial numbers of requests for discovery which require tedious examination, it is generally the policy of the Board to intervene in disputes concerning discovery, by determining motions to compel, only where it is clear that the parties have in fact followed the aforesaid process and have narrowed the amount of disputed requests for discovery, if any, down to a reasonable number.

Further, with regard to respondent's responses to document requests, the Board notes that petitioner's motion to compel is based on an assertion that respondent has

⁷ Because respondent's first, second, and third affirmative defenses were stricken *supra*, respondent need not respond further to petitioner's interrogatory nos. 1-3 and document request nos. 1-3.

Cancellation No. 92052657

failed to produce documents and has failed to respond to petitioner's request to either produce copies of responsive documents at petitioner's expense or to designate a time and location where the documents would be made available for copying. "A response to a request for production ... must state, with respect to each item or category of documents or things requested to be produced, that inspection and related activities will be permitted as requested, unless the request is objected to, in which case the reasons for objection must be stated." TBMP Section 406.04(b). In response to each request at issue, respondent has indicated that, subject to objections, it "will produce non-privileged, non-immune documents in its possession, custody or control." These responses are acceptable.⁸ Nonetheless, the parties are strongly urged to cooperate with regard to arranging for respondent's document production.⁹

At the same time, respondent's discovery responses indicate that respondent has not made a good faith effort to satisfy petitioner's discovery needs. See TBMP Section 408.02. For example, respondent's statements in response to

⁸ Although parties often serve discovery documents concurrently with their responses to document requests, parties frequently produce their discovery documents after serving responses to document requests at a mutually convenient time that allows adequate time for trial preparation.

⁹ The Board expects parties to cooperate in the discovery process and looks with disfavor upon those who do not. See TBMP Section 408.01.

Cancellation No. 92052657

interrogatory nos. 7-10, 12, and 21-26 that it will not respond to those interrogatories "without the entry of a suitable protective order" are improper because the Board's standard protective order has been operative since the commencement of this proceeding. See Trademark Rule 2.116(g). Further, to the extent that respondent contends that, because interrogatory nos. 4 and 11 are "contention interrogatories," it may delay responding to them "until the end of discovery," responses to all interrogatories are due in accordance with Trademark Rules 2.119(c) and 2.120(a)(3).

Respondent is reminded that it has a duty to supplement or correct its earlier responses to discovery requests. See Fed. R. Civ. P. 26(e). Respondent is reminded in addition that, if it fails to provide information that is properly sought during discovery, respondent may be precluded, by way of petitioner's objection, from relying upon that information as evidence at trial. See Fed. R. Civ. P. 37(c).

In view of the foregoing, petitioner's motion to compel discovery is denied without prejudice. The Board will not entertain any further motions to compel unless the movant first receives leave to file such a motion in a telephone conference between the parties' attorneys and the Board attorney assigned to this case.

Cancellation No. 92052657

Dates remain as set in the Board notice instituting
this proceeding.

United States Pa
Commissioner for

P.O. Box 1451

Alexandria, VA. 22313-1451

If Undeliverable Return in Ten Days

OFFICIAL BUSINESS
PENALTY FOR PRIVATE USE, \$300

AN EQUAL OPPORTUNITY EMPLOYER

