

ESTTA Tracking number: **ESTTA680181**

Filing date: **06/25/2015**

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

Proceeding	92057941
Party	Plaintiff Clockwork IP, LLC
Correspondence Address	BRAD R NEWBERG MCGUIRE WOODS LLP 1750 TYSONS BOULEVARD, SUITE 1800 TYSONS CORNER, VA 22102-4215 UNITED STATES bnewberg@mcguirewoods.com, wfederspiel@mcguirewoods.com, adeford@mcguirewoods.com, trademarks@mcguirewoods.com
Submission	Other Motions/Papers
Filer's Name	Brad R. Newberg
Filer's e-mail	bnewberg@mcguirewoods.com, adeford@mcguirewoods.com
Signature	/Brad R. Newberg/
Date	06/25/2015
Attachments	Clockwork - Amendment-Correction to Mem. in Supp. of Mot. for Summ. J.pdf(18466 bytes)

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

CLOCKWORK IP, LLC)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92057941
)	Reg. No. 3,618,331
BARNABY HEATING & AIR, and)	
McAFEE HEATING AND AIR)	
CONDITIONING CO., INC.)	
)	
Respondents.)	

**PETITIONER CLOCKWORK IP, LLC’S AMENDMENT/CORRECTION TO
PETITIONER’S MEMORANDUM OF POINTS AND AUTHORITIES
IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT**

Petitioner Clockwork IP, LLC (“Clockwork”), by counsel, hereby submits this amendment/correction to Petitioner’s Memorandum of Points and Authorities in Support of its Motion for Summary Judgment:

Clockwork’s Memorandum of Points and Authorities in Support of its Motion for Summary Judgment lists several reasons that Petitioner is entitled to judgment as a matter of law on its fraud claim. One of the alternative bases listed is that Respondent Barnaby Heating & Air (“Barnaby”) knew at the time it filed its application to register the COMFORTCLUB Mark and when it submitted the August 2008 response to the office action issued by the United State Patent and Trademark Office that Barnaby’s statements regarding ownership of the COMFORTCLUB Mark and that it knew of no other person, firm, corporation or association with the rights to use an identical, or confusingly similar, mark in commerce were false. (Pet’r’s Mem. in Supp. of Pet’r’s Mot. for Summ. J. (“Pet’r’s Mem.”) at 11–15 [Dkt. # 22].) Clockwork cited *Medinol Ltd. v. Neuro Vasx, Inc.*, 67 U.S.P.Q.2d (BNA) 1205, 1208 (T.T.A.B. 2003), and *Sierra Sunrise*

Vineyards v. Montelvini S.P.A., No. 92048154, 2008 WL 4371318, at *2 (T.T.A.B. Sept. 10, 2008), which follows *Medinol*, and both of which state the standard for fraud as a “knew or should have known” standard. (*Id.* at 11.) Although Clockwork principally relies on Barnaby’s actual knowledge of falsity, as opposed to the “should have known” portion, and so, this amendment/correction does not affect any of Clockwork’s arguments, Clockwork should have cited *In re Bose Corp.*, which held that fraud for purposes of the Lanham Act requires knowledge of falsity and cannot be predicated on merely a “should have known” standard. 580 F.3d 1240, 1245 (Fed. Cir. 2009).

As a result, Clockwork files this amendment/correction to its memorandum, asking the Board to disregard the statement (on page 7 of its memorandum) “[p]ut differently, fraud occurs where the applicant ‘makes material representations of fact in its declaration which it knows or should know to be false or misleading’” and the immediately following citations to *Medinol* and *Sierra Sunrise* on page 7 of Clockwork’s memorandum, as well as the phrase “should have known” that appears on pages 2, 7, 8, and 11. Instead, the Board should apply the knowledge standard set forth in *In re Bose*, when deciding Clockwork’s motion for summary judgment. *See* 580 F.3d at 1245.

All remaining parts of Clockwork’s memorandum – including the substance and merits of all of Clockwork’s other arguments that it is entitled to judgment as a matter of law on its fraud claim due to Barnaby’s failure to respond to ten Requests for Admission and the fact that the record establishes that Barnaby cannot refute that it had actual knowledge of the falsity of both of its fraudulent statements at the time they were made – remain unaffected by this amendment.

Respectfully submitted,

CLOCKWORK IP, LLC

Filed via ESTTA: June 25, 2015

By: /Brad R. Newberg/

Brad R. Newberg
bnewberg@mcguirewoods.com
McGuireWoods LLP
1750 Tysons Boulevard
Suite 1800
Tysons Corner, VA 22102-4215
(703) 712-5061
(703) 712-5187 (fax)

Amanda L. DeFord
adeford@mcguirewoods.com
McGuireWoods LLP
One James Center
901 East Cary Street
Richmond, Virginia 23219
(804) 775-7787
(804) 698-2248 (fax)
Attorneys for Petitioner Clockwork IP, LLC

CERTIFICATE OF SERVICE

On June 25, 2015, in addition to being filed and served via ESTTA, this document was sent by first class mail to the following counsel of record:

Julie Celum Garrigue
Celum Law Firm PLLC
11700 Preston Rd
Suite 660 Pmb 560
Dallas, TX 75230

*Counsel for Respondent Barnaby
Heating & Air*

Melissa Replogle
Replogle Law Office LLC
2661 Commons Blvd.
Suite 142
Beavercreek, OH 45431

*Counsel for Assignee McAfee Heating
& Air Conditioning Co., Inc.*

/Amanda L. DeFord/
Amanda L. DeFord