

This Opinion is not a
Precedent of the TTAB

Mailed: December 16, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Harrison Productions, L.L.C.

v.

Debbie Harris

Cancellation No. 92058758

David L. Oppenhuizen of Oppenhuizen Law PLC
for Harrison Productions, L.L.C.

John A. Thomas of Glast, Phillips & Murray, P.C.
for Debbie Harris.

Before Seeherman, Lykos, and Heasley,
Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

Harrison Productions, L.L.C. (“Petitioner”) has filed a petition to cancel Registration No. 3266757, owned by Debbie Harris (“Respondent”) for AMERICAN BEAUTY in standard characters for “Entertainment in the nature of beauty pageants” in International Class 41.

Although the petition to cancel was brought on the grounds of abandonment and

fraud, and makes a number of allegations with regard to both grounds, Petitioner's trial brief does not discuss its claim that Respondent abandoned use of the AMERICAN BEAUTY mark.¹ We therefore deem this claim to be waived, and need not repeat the allegations regarding it here. *See Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013), *aff'd* 565 F. Appx. 900 (Fed. Cir. 2014). *See also* Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 801.01 (2015) and cases cited therein.

The registration file, which is of record pursuant to Trademark Rule 2.122(b), shows that on December 20, 2013, Respondent filed a Section 8 Declaration of Use, which was accepted by the USPTO on December 24, 2013. It was accompanied by a specimen consisting of a printout from the website www.americanbeautypageant.com. Nearly two months later, Respondent filed a "Request to Correct Deficiency in Renewal Application," with a substitute specimen identified as a webpage from Respondent's website, www.missamericanbeauty.com. On February 22, 2014, the USPTO issued an Action stating, "The substitute specimen submitted on February 18, 2014 for the Section 8 declaration of use filed on December 20, 2013 and previously accepted by the Office is properly verified and acceptable to show current use of the registered mark for the services."

Petitioner's case for fraud, as evidenced in its notice of reliance and as argued in its trial briefs, has narrowed considerably from the allegations in its petition to cancel. Petitioner argues in its main brief that Respondent was not using the mark

¹ Petitioner's trial brief, 15 TTABVUE.

in commerce when she filed her substitute specimen.² It further argues that the substitute specimen Respondent filed in connection with her Section 8 affidavit, a webpage showing use of the AMERICAN BEAUTY mark, was taken from Respondent's website, which advertised a forthcoming beauty pageant that Respondent ultimately did not produce.³ That is the gravamen of its case for fraud.

I. The Parties' Pleadings.

Petitioner made the following relevant allegations in its petition to cancel:

- "Since at least as early as June 13-15, 2012, Petitioner has used its mark AMERICAN BEAUTY in connection with entertainment in the nature of beauty pageants. Specifically, the Petitioner first held a beauty pageant under the trademark AMERICAN BEAUTY in Orlando, Florida on June 13-15, 2012."

"Since 2012, Petitioner has continued to operate an annual beauty pageant under its trademark AMERICAN BEAUTY."⁴

- "The Registrant ... filed a Section 8 Affidavit of Use on December 20, 2013, before the grace period expired on January 17, 2014. The specimen filed by the Registrant was not a specimen of the Registrant's use of the mark. Rather, the specimen filed was a webpage from the *Petitioner's* website."⁵

- "The specimen submitted with the February 14th [2014] filing was a screenshot of the Registrant's webpage. But ... the Registrant was not using the mark as of

² Petitioner's trial brief, p. 8, 15 TTABVUE 9.

³ Petitioner's trial brief, p. 9, 15 TTABVUE 10.

⁴ Petition to Cancel, ¶¶ 1, 3, 1 TTABVUE 4.

⁵ Petition to Cancel, ¶ 24, 1 TTABVUE 8 (emphasis in original).

December 20, 2013, nor was she using the mark as of February 14, 2014.”⁶

- “At some time after February 1, 2014, the Registrant altered her website in a manner to intentionally and knowingly deceive the U.S.P.T.O. into maintaining her trademark registration by giving the false impression that she was actually using the mark in commerce.”⁷ “The Registrant’s current website now states “Join us for the next National pageant November 27-30, 2014 at the Empire Theater in San Antonio, Texas” with the obvious purpose of trying to show that she has resumed use in the mark. However, *there is no such pageant scheduled to take place at the Empire Theater in San Antonio, Texas.* The Registrant simply changed the date on her website in order to give the false impression that she is actually using the mark in commerce.”⁸

- “The Registrant is not using the mark AMERICAN BEAUTY in commerce, nor has she since 2007. The Registrant falsely altered her website to intentionally and knowingly deceive the U.S. Patent and Trademark Office into maintaining the validity of the trademark registration.”⁹

In her answer, Respondent responded to the above allegations as follows:

- Respondent admits filing “an incorrect specimen of use” with her December 20, 2013 Section 8 Declaration of Use, but attributes the error to “inadvertence and excusable neglect, largely caused by Petitioner’s wrongful use of a confusingly similar Mark with knowledge of Registrant’s rights under her

⁶ Petition to Cancel, ¶ 31, 1 TTABVUE 10.

⁷ Petition to Cancel, ¶ 33, 1 TTABVUE 10.

⁸ Petition to Cancel, ¶ 34, 1 TTABVUE 10-11 (emphasis in original).

⁹ Petition to Cancel, ¶ 39, 1 TTABVUE 11.

Registration.”¹⁰

- Respondent “[a]dmitted that Registrant's current website (as of April 3, 2014) states ‘Join us for the next National pageant November 27-30, 2014 at the Empire Theater in San Antonio, Texas.’ Admitted that no such pageant is scheduled now to take place at the Empire Theater in San Antonio, Texas, because Registrant cancelled her original engagement with the Empire Theater for business reasons.”¹¹

- Respondent denies that her February 14, 2014 Request to Correct Deficiency was “in any way fraudulent or made with intent to deceive the U.S. Patent and Trademark Office.”¹²

II. Evidence of Record.

The trial record consists of the following evidence:

A. Petitioner’s Evidence.

Petitioner filed a single notice of reliance with three exhibits: (1) Petitioner’s Application Serial No. 86211524 for AMERICAN BEAUTY, and an Office Action stating that action on the application was suspended during this cancellation proceeding; (2) an Internet printout of Respondent’s website, obtained on February 18, 2014; and (3) Respondent’s responses to four of Petitioner’s Requests for Admission.¹³

¹⁰ Answer, ¶ 24, 5 TTABVUE 5.

¹¹ Answer, ¶ 34, 5 TTABVUE 7.

¹² Answer, ¶ 28, 5 TTABVUE 6.

¹³ 12 TTABVUE.

B. Respondent's Evidence.

Respondent filed a single notice of reliance with two exhibits: (1) a printout of Respondent's website obtained on May 21, 2015; and (2) a printout of two pages from www.PageantryMagazine.com obtained on May 21, 2015, showing a headline and a summary paragraph about a podcast interview the magazine conducted "with the Founder and Director of Miss American Beauty, Debbie Harris."¹⁴

III. Standing.

Petitioner has established its standing to bring this cancellation proceeding. It has introduced in evidence its Application Serial No. 86211524 for the mark AMERICAN BEAUTY in standard characters for "Entertainment in the nature of beauty pageants" in International Class 41,¹⁵ as well as the Office action indicating that action on its application has been suspended pending the disposition of this cancellation proceeding pertaining to Respondent's "registered mark that conflicts with applicants' mark under Trademark Act Section 2(d)...."¹⁶ Thus, Petitioner has shown that it has a reasonable basis for its belief that it will be damaged by the continued registration of Respondent's mark, and has demonstrated a direct and personal stake in the outcome of this proceeding. 15 U.S.C. § 1064. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1028 (Fed. Cir. 1999); *Nationstar Mortgage LLC v. Ahmad*, 112 USPQ2d 1361, 1364 (TTAB 2014) ("Applicant's application for his NATIONSTAR mark has been cited as a potential

¹⁴ 13 TTABVUE.

¹⁵ Petitioner's notice of reliance, exhibit 1, 12 TTABVUE 5.

¹⁶ Petitioner's notice of reliance, exhibit 1, 12 TTABVUE 6.

bar to the registration of the marks in opposer's applications.... This is sufficient to demonstrate that opposer has a real interest in this proceeding.”).

IV. Analysis.

As noted, the issues before us are whether Respondent committed fraud on the Office by averring in her Section 8 affidavit that the AMERICAN BEAUTY mark was in use in commerce, and by filing the February 14, 2014 substitute specimen consisting of a page from her website, which advertised a forthcoming beauty pageant that Respondent was not actually going to produce.¹⁷

“Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application.” *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986) (citations omitted). *Accord In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1939 (Fed. Cir. 2009); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1432 (TTAB 2014). Fraud in obtaining renewal of a registration amounts to fraud in obtaining a registration within the meaning of Section 14(c) of the Lanham Act, 15 U.S.C. § 1064(c). *Torres*, 1 USPQ2d at 1484. *See Bose*, 91 USPQ2d at 1938 (fraud alleged in filing Section 8 affidavit of continued use and Section 9 renewal application). A registrant may commit fraud by filing a false substitute specimen attesting to use of a mark, as is alleged here. *See ShutEmDown Sports, Inc. v. Lacy*, 102 USPQ2d 1036, 1044 (TTAB 2012).

A party seeking cancellation of a trademark registration for fraudulent procurement bears a heavy burden of proof. *E.g.*, *Bose*, 91 USPQ2d at 1939;

¹⁷ Petitioner’s trial brief, p. 9, 15 TTABVUE 10.

Alcatraz Media, 107 USPQ2d at 1767; *Swiss Watch Int'l, Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1745 (TTAB 2012). “Indeed, the very nature of the charge of fraud requires that it be proven ‘to the hilt’ with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.” *Bose*, 91 USPQ2d at 1939 (quoting *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981)).

To carry this burden, the party seeking cancellation must prove that:

- (1) the registrant made a false representation to the USPTO;
- (2) the false representation is material to the registrability of the mark;
- (3) the registrant had knowledge of the falsity of the representation; and
- (4) the registrant made the representation with intent to deceive the USPTO.

Bose, 91 USPQ2d at 1941, *cited in ShutEmDown Sports*, 102 USPQ2d at 1044.

We address each of the four elements in turn.

Falsity

The first element of fraud requires Petitioner to prove, by clear and convincing evidence, that Respondent made a false representation to the USPTO. *Id.* Respondent’s February 14, 2014 “Request to Correct Deficiency in Renewal Application” stated that:

Through inadvertence and excusable mistake, Applicant attached as a specimen a web page from the website <http://www.americanbeautypageant.com>. In fact, Applicant’s website, where the Mark is in actual use, is <http://www.missamericanbeauty.com>. The correct webpage is attached hereto as a substitute specimen.

Petitioner's notice of reliance attached three pages that were printed from Respondent's website on February 18, 2014.¹⁸ These pages included sections that were not in the substitute specimen. One section of these webpages (that was not part of the substitute specimen) stated, "Join us for the next National pageant **November 27-30, 2014 at the Empire Theater In San Antonio, Texas.**"¹⁹

Petitioner also adduced several admissions Respondent made in response to requests for admission:

Request to Admit No. 7:

Harris to admit that, in response to the Petitioner's First Request for the Production of Documents and Things, you did not produce any documents which evidence any communications between you and any employees at the Empire Theater in San Antonio.

Response to Request No. 7:

Admitted.

Request to Admit No. 8:

Harris to admit that, in response to the Petitioner's First Request for the Production of Documents and Things, you did not produce any agreements, contracts, or other documents (either signed or unsigned) between you and the Empire Theater in San Antonio.

Response to Request No. 8:

Admitted.

Request to Admit No. 9:

Harris to admit that you did not make any formal arrangements with the Empire Theater in San Antonio to book that venue for a beauty pageant in November 2014.

¹⁸ Petitioner was evidently monitoring Respondent's website regularly then.

¹⁹ Petitioner's notice of reliance, exhibit 2, 12 TTABVUE 10 (emphasis in original).

Response to Request No. 9:

Admitted.²⁰

It appears from the admissions submitted by Petitioner, and from its arguments, that it believes that the substitute specimen submitted by Respondent in connection with the Section 8 affidavit constituted a false statement because she advertised a pageant that Respondent did not hold, and did not take the necessary steps to produce. While the admissions show, at most, that Respondent did not take the necessary steps to produce one particular pageant she advertised on her website, that falls far short of proving the first element of fraud: a false representation *to the USPTO*. *ShutEmDown Sports*, 102 USPQ2d at 1044 (citing *Bose*, 91 USPQ2d at 1941). The web page Respondent submitted to the USPTO as a substitute specimen in connection with her Section 8 affidavit is shown below:

²⁰ Petitioner's notice of reliance, exhibit three, 12 TTABVUE 15-16.



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It did not contain the advertisement for the pageant at the Empire Theater in San Antonio that Petitioner contends was a false representation. In fact, as Respondent points out, "The page submitted as a specimen (in TSDR) did not contain dates for future pageants...."²² It only contained a display of Respondent's AMERICAN BEAUTY mark, with statements welcoming the viewer to the "official Miss American Beauty Pageant website," giving the mission of the pageant, and telling potential contestants what qualities they would gain from participating in it.

²¹ Feb. 18, 2014 Request to Correct Deficiency in Renewal Application, p. 5.

²² Respondent's trial brief, p. 3, 17 TTABVUE 7.

A false statement appearing on a section of Respondent's website that was not submitted to the U.S. Patent and Trademark Office (USPTO) cannot be treated as a false statement for the purpose of proving fraud, because the statement was never made to the Office.

Respondent did state, as part of the submission accompanying the substitute specimen, that the AMERICAN BEAUTY mark was "in use in commerce on or in connection with all services listed in the existing Registration for this specific class."²³ To prove that this representation to the USPTO was false, Petitioner would have to show cessation of use of the mark in general, not just non-use in one particular instance. This it has failed to do. Petitioner argues that, "In this proceeding, the Registrant did not submit any evidence showing any other use of the mark as of that date, nor has the Registrant even expressly stated that she was using the mark in commerce as of February 14, 2014 other than through the Declaration of Use filed with the USPTO."²⁴ But Petitioner acknowledges that *it* has the heavy burden of proving "to the hilt with clear and convincing evidence," that Respondent's statement in the Section 8 affidavit of continued use in commerce of its mark was false and that any doubt must be resolved against it.²⁵ The mere fact that a single pageant advertised by Respondent did not occur is not proof that Respondent was not using the mark at all, and was not sufficient to show that Respondent's statement that the mark was in use was false. As Respondent puts it,

²³ Feb. 18, 2014 Request to Correct Deficiency in Renewal Application, p. 3.

²⁴ Petitioner's reply brief, pp. 4-5, 18 TTABVUE 5-6.

²⁵ Petitioner's trial brief, p. 8. 15 TTABVUE 9 (citing *Sinclair Oil*, 85 USPQ2d at 1035).

“There is no record evidence of non-use by Registrant for any period....”²⁶

Thus, Petitioner has failed to prove that Respondent’s representation to the USPTO that she was using the AMERICAN BEAUTY mark in commerce was false. “In the absence of such a showing, [its] claim of fraud ... cannot succeed.” *Harry Winston*, 111 USPQ2d at 1435.

Materiality

Although the fraud claim must fail because Petitioner failed to satisfy the falsity element, we address the other elements of fraud for the sake of completeness. With respect to the element of materiality, “An applicant's statements as to its use of a mark for particular goods and services are unquestionably material to registrability.” *Nationstar Mortgage*, 112 USPQ2d at 1365. *See, e.g., Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1035 (TTAB 2007). (“Statements regarding the use of the mark on the identified goods and/or services are certainly material to issuance of a registration.”). As the Federal Circuit has observed:

An essential element of the application for renewal is the registrant's averment that the mark as registered is in current use for the goods covered by the registration or the reasons for the mark's nonuse. The purpose of this requirement, like that in section 8 of the Lanham Act, is “to remove from the register automatically marks which are no longer in use.”

Torres, 1 USPQ2d at 1484 (quoting *Morehouse Manufacturing Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715, 720 (CCPA 1969) (discussing

²⁶ Respondent’s trial brief, p. 2, 17 TTABVUE 6.

the purpose of section 8)) *quoted in Bose*, 91 USPQ2d at 1942.

Here, the USPTO relied on Respondent's Section 8 affidavit averring continued use of her AMERICAN BEAUTY mark in commerce. That statement in the affidavit was unquestionably material to the mark's continued registrability, *see Nationstar Mortgage*, 112 USPQ2d at 1365, but as explained above, Petitioner has failed to show that it was false.

In accepting Respondent's substitute specimen, however, the USPTO did not rely upon Respondent's advertised November 2014 pageant at the Empire Theater because the substitute specimen did not contain that advertisement. As Respondent notes, "Finally, there is no record evidence that the Trademark Office relied on any representation by Registrant that Registrant planned to produce a pageant five months from the renewal application."²⁷ Consequently, Petitioner fails to satisfy the materiality element of fraud with regard to the filing of the substitute specimen.

Knowledge

The third element of fraud requires proof that the respondent had knowledge of the falsity of her representation. *Bose*, 91 USPQ2d at 1941. Petitioner, relying on Respondent's quoted admissions, contends that Respondent "knew that the representation that a pageant would be held at the Empire Theater on November 27-30, 2014 was false."²⁸ Respondent answers, "Registrant nowhere admits that she did not intend to hold a pageant at the Empire Theater some

²⁷ Respondent's trial brief, p. 7, 17 TTABVUE 11.

²⁸ Petitioner's trial brief, p. 11, 15 TTABVUE 12.

five months later.”²⁹

As we have observed, Respondent’s failure to hold a pageant at the Empire Theater is not the issue, as the representation about which Petitioner complains was not made to the USPTO. The larger issue is whether Respondent’s representation that her AMERICAN BEAUTY mark was “in use in commerce on or in connection with all services listed in the existing Registration for this specific class”³⁰ was a knowing falsehood. Petitioner has failed to prove this. As we have already discussed, Petitioner has not even proved that this statement was a falsehood, let alone a *knowing* falsehood. The fact that Petitioner has shown that Respondent did not actually produce a particular pageant that she advertised on her website does not prove that Respondent was not using her mark for the identified services. Petitioner has thus failed to prove the element of knowledge with respect to the statement of continued use in commerce in Respondent’s Section 8 affidavit or her substitute specimen. .

Intent

Proof of subjective intent to deceive the USPTO is an indispensable element of a fraud analysis. *Id. See also Nationstar Mortgage*, 112 USPQ2d at 1374. “Unless a party alleging fraud can point to clear and convincing evidence that supports drawing an inference of deceptive intent, it will not be entitled to judgment on a fraud claim.” *Enbridge, Inc. v. Excelerate Energy Limited Partnership*, 92 USPQ2d 1537, 1540 (TTAB 2009). Such intent can be inferred from indirect and

²⁹ Respondent’s trial brief, p. 4, 17 TTABVUE 8.

³⁰ Feb. 18, 2014 Request to Correct Deficiency in Renewal Application, p. 3.

circumstantial evidence, “[b]ut such evidence must still be clear and convincing, and inferences drawn from lesser evidence cannot satisfy the deceptive intent requirement.” *Bose*, 91 USPQ2d at 1941 (quoting *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 88 USPQ2d 1001, 1007 (Fed. Cir. 2008)).

Petitioner draws its inference of intent to deceive from such “lesser evidence,” relying once again on the advertised Empire Theater pageant that never took place.³¹ While this ancillary advertising may have raised some suspicions in Petitioner’s mind regarding Respondent’s credibility, and her use *vel non* of the AMERICAN BEAUTY mark, speculation, conjecture and surmise cannot substitute for the clear and convincing evidence required to prove fraud. *See Bose*, 91 USPQ2d at 1939. Intent can be inferred from indirect evidence, but the inference of intent to deceive must be the single most reasonable inference, as opposed to other reasonable inferences. *See Star Scientific*, 88 USPQ2d at 1007. Respondent asserts in her brief that “Registrant may not have ultimately held the pageant planned for the Empire Theater five months after her web page announcement, but there are many other possible explanations for this other than fraudulent intent, such as a lack of funding, scheduling conflicts, insufficient interest from potential contestants, or Registrant’s personal difficulties.”³² Although Respondent’s unsupported averments in her brief are not evidence, they show that an intent to deceive is not the only reasonable inference that can be drawn from advertising a pageant that

³¹ Petitioner’s trial brief, pp. 11-12, 15 TTABVUE 12-13, Petitioner’s reply brief, p. 8, 18 TTABVUE 9.

³² Respondent’s trial brief, p. 7, 17 TTABVUE 11.

did not occur. Petitioner fails to prove the element of intentional falsehood, either with respect to the statement of continued use in commerce in her Section 8 affidavit or the filing of her substitute specimen.

Based on the record in this proceeding, we find that Petitioner has failed to prove its claim that Respondent committed fraud in connection with her statement of continued use in commerce and the filing of her substitute specimen with the Section 8 affidavit to maintain her registration.

Decision: The petition for cancellation is dismissed.