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

Proceeding	92059992
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SPOONJACK LLC d/b/a SPOONJACK,

Cancellation No. 92059992

Petitioner,

v.

DONALD J. TRUMP,

Reg. No. 3391095

Mark: TRUMP

Issued: March 4, 2008

Registrant.

**PETITIONER'S MOTION FOR RECONSIDERATION OF THE DECISION
ON REGISTRANT'S MOTION TO DISMISS**

This Motion for Reconsideration under 37 CFR § 2.127(b) is filed by Petitioner Spoonjack LLC d/b/a Spoonjack ("Petitioner") in response to the decision of the Trademark Trial and Appeal Board (the "Board") dated April 1, 2015, which, granted Registrant Donald J. Trump's ("Registrant") Motion to Dismiss.

I. Introduction

Petitioner respectfully requests that the Board reconsider its granting of Registrant's Motion to Dismiss. In its decision, the Board has effectively found that fraud in the filing of a Section 15 declaration for incontestability does not constitute grounds for cancellation of the involved registration. This is inconsistent with binding Board precedent. Accordingly, the Board's decision is in error and warrants reconsideration pursuant to 37 CFR § 2.127(b).

II. Argument

The Board has granted Respondent's Motion to Dismiss for failure to state a claim, on one ground, which it states as follows:

[I]nasmuch as Petitioner's claim goes to the Section 15 Declaration of Incontestability and not Respondent's Section 8 Declaration of Use, the statements made by Respondent did not affect the acquisition or maintenance of the challenged registration as required by *In re Bose*. 91 USPQ2d at 1941. Indeed, the allegations in the petition to cancel fail to sufficiently plead the "materiality" of the false statement with respect to the maintenance of the registration necessary to support a claim of fraud. A cursory reading of Section 15 of the Trademark Act reveals that Section 15 does not concern registrability or the maintenance of a registration, but defines an added protection to an already registered or renewed registration.

In light of the foregoing, Petitioner's fraud claim, based upon false statements made in and concerning Respondent's Section 15 declaration, is insufficiently pleaded.

10 TTABVUE 8-9 (footnote omitted).

Referring to the foregoing, the Board's logic is as follows:

1. "as required *by In re Bose*," to support an adequately pleaded claim of fraud, an allegedly false statement of material fact must "affect the acquisition or maintenance of the challenged registration,"
2. "Section 15 does not concern registrability or the maintenance of a registration..." and
3. therefore, Registrant's false statement in his Section 15 declaration, as the petition to cancel alleges, fails to support a claim of fraud ("[T]he allegations in the petition to cancel fail to sufficiently plead the "materiality" of the false statement with respect to the maintenance of the registration necessary to support a claim of fraud.").

But further, based on the premises of the Board's logic, not only does Registrant's false statement in his Section 15 declaration not support a claim of fraud, but, more generally, a false statement in a Section 15 declaration *cannot* support a claim of fraud. And, therefore, fraud in the filing of a Section 15 declaration *cannot* constitute a ground to cancel.¹

The Board's logic is flawed.

First, *In re Bose* simply *does not* address whether fraud in the filing of a Section 15 declaration constitutes a ground to cancel. *In re Bose* addresses whether "should have known" can be equated to a subjective intent to deceive. *In re Bose Corp.*, 580 F.3d 1240, 1244, 91 USPQ2d 1938, 1940 (Fed. Cir. 2009). To the extent it touches on where fraud constitutes grounds to cancel at all, it merely establishes that fraud in the filing of a combined Section 8 affidavit of continued use and Section 9 renewal application (*at issue in that case*) constitutes a ground to cancel. *In re Bose*, 91 USPQ2d at 1939; *See also infra* at 4. That is *not* to say that fraud in the filing of a Section 15 declaration does not.

¹ It should be noted that the petition to cancel in the present case alleges materiality of Registrant's false statement in its Section 15 declaration by virtue of the fact that the false statement resulted in Registrant's obtaining the right of incontestability for its registration. 1 TTABVUE 3-5, ¶¶ 5, 9-11, 13-14. And, as shown *infra*, pp. 2-4, fraud based on a false statement in a Section 15 declaration does constitute a ground to cancel a registration.

Second, binding Board precedent at the time of *In re Bose* and *still today* is that fraud in the filing of a Section 15 declaration *does* constitute a ground to cancel a registration. *Robi v. Five Platters, Inc.*, 918 F.2d 1439, 1444 (9th Cir. 1990). *See also Crown Wallcovering Corp. v. Wallpapers Manufacturers Ltd.*, 188 U.S.P.Q. 141, 143-44 (TTAB 1975).

As the U.S. Court of Appeals for the Ninth Circuit, states in *Robi*, citing the Board and CCPA,

Any false statements made in an incontestability affidavit may jeopardize not only the incontestability claim, but also the underlying registration. *See Crown Wallcovering Corp. v. Wallpapers Manufacturers Limited*, 188 U.S.P.Q. 141, 143-44 (1975); *Duffy-Mott Co., Inc. v. Cumberland Packing Co.*, 424 F.2d 1095, 57 CCPA 1046 (1970). In particular, **filing a fraudulent incontestability affidavit provides a basis for canceling the registration itself.** *Crown Wallcovering*, 188 U.S.P.Q. at 144.

Robi, 918 F.2d at 1444 (emphasis added).

In *Crown Wallcovering*, the Board provides its rationale. In that case, not unlike here, a registrant moved to dismiss the petitioner's claim of fraud in the registrant's filing of a Section 15 affidavit on the basis that it did not constitute a grounds for cancellation. The Board explains,

As to that portion of petitioner's pleading of fraud predicated upon the alleged false averment under Section 15 of the Act of 1946, neither the Trademark Trial and Appeal Board nor the Court of Customs and Patent Appeals has ever ruled directly upon the question of whether the filing of a fraudulent Section 15 affidavit constitutes a ground for cancellation of the registration in connection with which the affidavit is filed.

As noted above, Section 14(c) of the Act provides in part that a verified petition to cancel a registration of a mark may be filed at any time if its registration was obtained fraudulently. The Board has in the past held that the words "obtained fraudulently" comprehend not only the initial securing of a registration, but also the maintenance thereof, i.e., the securing of continuing rights of registration, by fraud. *See: Volkswagenwerk Aktiengesellschaft v. Advance Welding and Mfg. Corp.*, 184 USPQ 367 (TT& A Bd., 1974). *Cf.*, *G. B. Kent & Sons Ltd. v. Colonial Chemical Corporation*, 162 USPQ 557 (TT& A Bd., 1969), and *Conwood Corporation v. Loew's Theatres, Inc.*, 173 USPQ 829 (TT& A Bd., 1972).

While a Section 15 affidavit is not required for the maintenance of a registration, it must be filed if a registrant wishes to secure that additional right of registration known as incontestability. That is to say, Section 7(b) provides that a certificate of registration of a mark upon the Principal Register shall be *prima facie evidence* (emphasis added) of the validity of the registration, registrant's ownership of the mark, and of registrant's exclusive right to use the mark in commerce in connection with the goods or services specified in the certificate, subject to any conditions and limitations stated therein. Under Section 15, however, the registrant's right to use the registered mark becomes *incontestable*, subject to certain stated exceptions, for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce; and Section 33(b) provides that if the right to use the registered mark has become incontestable under Section 15, the registration shall be *conclusive evidence* (emphasis added) of the registrant's exclusive right

to use the registered mark in commerce on or in connection with the goods or services specified in the affidavit filed under the provisions of Section 15, subject to any conditions or limitations stated therein, except when one of a number of certain specified defenses or defects is established, including that the registration or the incontestable right to use the mark was obtained fraudulently.

In view of the foregoing, **it is clear that the filing of a fraudulent Section 15 affidavit would enable a registrant to obtain a new right, namely, incontestability, to which he would not otherwise be entitled; i.e., to obtain the right to have his registration accepted as conclusive evidence, rather than merely prima facie evidence, of registrant's exclusive right to use the registered mark in commerce. Under such circumstances, it is adjudged that the filing of a fraudulent Section 15 affidavit constitutes a ground for cancelation of the involved registration within the purview of Section 14(c).** Our conclusion is buttressed by *Duffy-Mott Company, Inc. v. Cumberland Packing Company*, 165 USPQ 422 (1970), wherein the Court of Customs and Patent Appeals ruled that an opposer which had filed a fraudulent Section 15 affidavit in connection with its pleaded registration might not rely upon that registration in an attempt to defeat applicant's right to register thus depriving opposer not only of the right of incontestability but also of the presumptions afforded to all registrations of marks upon the Principal Register under Section 7(b) of the Act. [2]

[2] It should be noted that the Court of Customs and Patent Appeals did not rule on the question of whether the filing of the fraudulent Section 15 affidavit constituted a ground for cancelation of opposer's pleaded registration under Section 14 of the Act because applicant did not request that such registration be canceled but rather asked only that opposer be precluded from relying thereon.

Crown Wallcovering, 188 U.S.P.Q. at 143-144 (emphasis added).

Notably, not only is *In re Bose* not the authority on whether fraud in the filing of a Section 15 declaration constitutes a ground for cancelation, but also, *In re Bose* relies on *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 48 (Fed.Cir.1986) as its authority to establish that the words "obtained fraudulently" in 15 U.S.C. § 1064(3) comprehend more than merely initial securing of a registration. *In re Bose*, 91 USPQ2d at 1939. *Torres*, in turn relies in-part on *Crown Wallcovering*, for the same. *In re Bose*, has simply *not* changed the Board's findings in *Crown Wallcovering* with respect to its interpretation of the words "obtained fraudulently" or with respect to fraud in the filing of a Section 15 declaration constituting a ground for cancelation.

III. Conclusion

In view of the foregoing, fraud in the filing of a Section 15 declaration does constitute a ground for cancellation and Petitioner has sufficiently pleaded materiality of Registrant's false

statement. Accordingly, the Board's decision is in error and Petitioner respectfully requests the Board grant Petitioner's Motion for Reconsideration and deny Registrant's Motion to Dismiss.

Dated: May 1, 2015

By: 

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CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of the foregoing PETITIONER'S MOTION FOR RECONSIDERATION OF THE DECISION ON REGISTRANT'S MOTION TO DISMISS was served on this 1st day of May 2015, via first class mail, U.S. postal service, postage prepaid upon:

James D. Weinberger, Esq.
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By:/Tom Scharfeld/