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

Proceeding	92059992
Party	Defendant Donald J. Trump
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IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SPOONJACK LLC d/b/a SPOONJACK, Petitioner, -against- DONALD J. TRUMP, Registrant.	Opposition No. 92059992

OPPOSITION TO PETITIONER'S MOTION FOR RECONSIDERATION

Registrant, Donald J. Trump ("Registrant"), by his attorneys, Fross Zelnick Lehrman & Zissu, P.C., hereby submits this opposition to Petitioner's Motion for Reconsideration (the "Motion") of the Board's April 1, 2015 Order dismissing Petitioner Spoonjack LLC d/b/a Spoonjack's Petition to Cancel (the "Order").

In making the instant motion, Petitioner, acting *pro se*, continues its multi-pronged quest to attack Registrant's TRUMP trademark portfolio, a quest which has now persisted for over three years. Indeed, Petitioner's tactics are nothing but a continued exercise in petty retaliation and harassment born out of a corrected, inadvertent mistake. Here, Petitioner seized on an error in a Section 15 declaration (now withdrawn and accepted by the U.S. Patent & Trademark Office ("PTO")) and sought cancellation of the underlying registration based on fraud. The Petition was properly dismissed with leave to replead. However, instead of repleading, Petitioner has now moved for reconsideration of the ruling, offering no new support for its position and further squandering Board resources.

Based on a plain reading of Sections 14 and 15 of the Lanham Act and the Federal Circuit's landmark decision in *In re Bose Corp.*, 91 U.S.P.Q.2d 1938 (Fed. Cir. 2009), the Board

properly held that the allegedly fraudulent statements contained in the Section 15 declaration in this matter cannot support cancellation of the registration based on fraud. Petitioner does not dispute that a plain reading of the Lanham Act so dictates, nor does it cite to any case in which a registration was cancelled based on a fraudulent Section 15 declaration. Instead, Petitioner marshals case law that is not binding and/or rules against its position. Moreover, Petitioner argues that *Bose* is irrelevant because it does not explicitly address Section 15 declarations – failing to appreciate both the import of *Bose* on fraud claims and that appellate holdings can apply to circumstances beyond the precise facts before the court at the time. None of this justifies reconsideration.

In short, the Motion for Reconsideration should be denied because it merely rehashes an argument that is wrong on the law and has already been soundly rejected by the Board.

DISCUSSION

A. The Motion for Reconsideration Standard

To prevail on a motion for reconsideration under 37 C.F.R. § 2.127(b), a party must show that "based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued." Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 518. Notably, however, a motion for reconsideration "should [not] be devoted simply to a reargument of the points presented in a brief on the original motion." *Id.*; *see also Bassani Mfg. v. Campbell*, Opp. No. 91166939, 2009 WL 4073523, at *1 (T.T.A.B. May 27, 2009) (denying motion for reconsideration because "applicant [was] rearguing points previously made").

B. The Board Has Considered All Relevant Points of Fact and Law

Petitioner's Motion for Reconsideration does not identify – or purport to identify – any evidence or point of law that the Board failed to consider. *See* 11 TTABVUE 2-4. Instead,

Petitioner reargues the same points and cites the same cases that it cited in its original opposition brief, recasting them only in the sense of saying that the Board improperly applied the law. *Id.* Put simply, Petitioner does not like the ruling and is asking for another one. On this basis, Petitioner's Motion for Reconsideration should be denied. *See Amoco Oil Co. v. Amerco, Inc.*, 201 U.S.P.Q. 126, 128 (T.T.A.B. 1978) (denying motion for reconsideration).

C. Petitioner's Arguments are Unavailing in Any Event

1. The Board's Holding is Supported by a Plain Reading of the Lanham Act

Despite this second bite at the apple, Petitioner still fails to offer support for its position that Registrant's TRUMP registration ought to be cancelled. Petitioner devotes its entire Motion to a single, recycled legal argument that the Board has considered and rejected. In the Order, the Board ruled that, because the purportedly fraudulent statement was contained in a Section 15 declaration, it cannot form the basis for cancellation based on fraud. 10 TTABVUE 8-9. The Board based this well-reasoned holding on two principles plainly set forth in Sections 14 and 15 of the Lanham Act, 15 U.S.C. §§ 1064, 1065, namely: (i) cancellation based on fraud under Section 14 requires that a fraudulent statement was made in connection with obtaining or maintaining a registration, and (ii) a Section 15 declaration concerns incontestability status of a registration, not the obtaining or maintaining of a registration. Because the Board is bound by the statute's clear and express language, the Board needed to look no further to hold that a Petition alleging fraud in a Section 15 declaration does not state a claim upon which relief can be granted. *See* TBMP § 101.01.

Although the Board has only rarely confronted this issue, a leading trademark scholar concurs with the Board's reading of the statute described above. *See* 3 J. Thomas McCarthy, *McCarthy on Trademarks & Unfair Comp.* § 20:58 (4th ed. 2013). Professor McCarthy has

opined, "Fraud made in a § 15 affidavit to obtain incontestability status would seem not to go to the continuance of the registration itself and hence would not constitute a ground for cancellation of the registration." *Id.*; *see id.* § 31:80 ("[F]raud in a § 15 incontestability affidavit should only serve to eliminate the incontestable status of the registration and not result in cancellation of the registration as such.").

2. The Board Applied the Federal Circuit's Landmark Holding on Fraud

Not only is the Board's holding supported by the statute itself, it also constitutes an application of the Federal Circuit's landmark decision on fraud, which the Board cited in the Order. 10 TTABVUE 8; *see Bose*, 91 U.S.P.Q.2d at 1941. In *Bose*, the court reiterated the requirement that "[a] third party may petition to cancel a registered trademark on the ground that the '*registration was obtained* fraudulently.'" 91 U.S.P.Q.2d at 1939 (emphasis added). Furthermore, the court explicitly re-examined certain aspects of a fraud claim, raised the bar required to prove fraudulent intent, and cautioned, "an allegation of fraud in a trademark case, as in any other case, *should not be taken lightly*." *Id.* at 1941 (emphasis added). Through its explicit recitation of the law and its overall approach to fraud claims,[1] the court encouraged the Board to rein in previous, overbroad applications of fraud. *Id.* Here, the Board dutifully complied.

In fact, the court in *Bose* relied on the statutory text, even though a previous Board

[1] "A party seeking cancellation of a trademark registration for fraudulent procurement bears a heavy burden of proof. 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.'" *Id.* at 1939 (citations omitted).

decision contradicted the statute and "erroneously lowered the fraud standard." *Id.* at 1940. The Federal Circuit's binding decision dictates that "[a]ny 'duty' owed by an applicant for trademark registration *must arise out of the statutory requirements of the Lanham Act.*" *Id.* at 1939 (emphasis added) (citing *Bart Schwartz Int'l Textiles, Ltd. v. F.T.C.*, 129 U.S.P.Q. 258, 260 (C.C.P.A. 1961)). The court pointed out a precedential decision has no "force," if it is overbroad and conflicts with the statute and binding Circuit case law. *Bose*, 91 U.S.P.Q.2d at 1941 ("The 'should know' language, if it signifies a simple negligence or a gross negligence standard, is not only inconsistent with the framework set out elsewhere in *Torres* [*v. Cantine Torresella S.r.l.*, 1 U.S.P.Q.2d 1483, 1485 (Fed. Cir. 1986)], but would also have no precedential force as it would have conflicted with the precedents from CCPA."). Thus, even if there were technically binding decisions that incorrectly suggested the Petition stated a valid claim, the Board would be obligated, under *Bose*, to follow the plain meaning of the Lanham Act instead. *See id.*

3. Petitioner Cites No Binding Case Law in Which a Registration is Cancelled Due to a Fraudulent Section 15 Declaration

Petitioner in its motion does not point to a single instance in which the Board has cancelled a registration due to a purportedly fraudulent Section 15 declaration. Rather, Petitioner identifies two decisions that it characterizes as "binding" on the Board, one of which is not binding and the other rules against cancellation. 11 TTABVUE 2. The first decision, *Robi v. Five Platters, Inc.*, 16 U.S.P.Q.2d 2015 (9th Cir. 1990), is a ruling by the Court of Appeals for the Ninth Circuit, which is *not* binding authority on the Board, and thus does not warrant discussion. *See* 28 U.S.C. § 1295(a)(4)(B); TBMP §§ 101.03, 801.03. Next, Petitioner relies heavily on (and cites generously from) a ***forty*** year old Board decision that contemplates *in dicta* cancellation on the basis of an allegedly fraudulent Section 15 declaration, but then proceeds to *dismiss* the Petition for failure to allege intent to deceive. 11 TTABVUE 3-4 (citing *Crown*

Wallcovering Corp. v. Wall Paper Mfrs. Ltd., 188 U.S.P.Q. 141 (T.T.A.B. 1975)).[2] Moreover, the dicta itself is not persuasive because, in it, the Board considers extending the meaning of obtaining and maintaining a registration to include obtaining an optional and peripheral "new right" relating to the registration, even though there is no meaningful support for such an extension. *Crown Wallcovering*, 188 U.S.P.Q. at 142. The Board simply "adjudged" on its own that Section 14 could reach statements made in Section 15 declarations. *Id.* at 144. Furthermore, both the *Robi* and *Crown Wallcovering* decisions are prior to the Federal Circuit's decision in *Bose*, and Petitioner can point to no post-*Bose* decision that addresses the issue of cancellation for fraud in a Section 15 filing. And no Board or Federal Circuit decision has ever cancelled a registration based on fraud due to an inaccurate statement regarding *pending litigation* (in particular litigation *at the PTO*), as opposed to statements about which goods or services on which the mark was used or continuous use.

Petitioner maintains that, because the *Bose* court's chief holding did not address the issue of fraud in Section 15 filings specifically, it "has simply not changed the Board's findings in *Crown Wallcovering* with respect to its interpretation of the words 'obtained fraudulently' . . . ." 11 TTABVUE 4. Petitioner is wrong. As noted above, the "findings" in *Crown Wallcovering* were dicta in a decision dismissing the Petition. In addition, Petitioner fails to appreciate: (a) the import of the statutory language itself above and beyond any *unsupported interpretation* of such language in a Board decision, (b) the binding nature of *Bose* – the most significant

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[2] The case *Duffy-Mott Co. v. Cumberland Packing Co.*, 165 U.S.P.Q. 422 (C.C.P.A. 1970), appears within the lengthy quotation from *Crown Wallcovering*. Petitioner does not discuss this case in its brief, presumably because it did not involve the question of whether a registration must be cancelled due to a fraudulent Section 15 filing, but rather whether such a registration can be *relied upon*. Indeed, Petitioner includes in its quotation from *Crown Wallcovering* the Board's footnote acknowledging this distinction. 11 TTABVUE 4 (citing *Crown Wallcovering*, 188 U.S.P.Q. at 144 n.2).

intervening, binding appellate decision regarding fraud – and the manner in which the court decision requires a strict reading of the statute with respect to fraud, and (c) that precedential opinions are routinely applied by lower courts (and their administrative counterparts) to similar or related facts – not merely identical facts – and that our judiciary system could not function if every appellate court had to issue rulings for every possible fact pattern that could conceivably fall thereunder. In other words, regardless of whether *Bose* addressed the precise fact pattern at issue here, the Board's ruling was *compelled* by a proper reading of the Lanham Act and the restated approach to fraud claims set out in *Bose* – any other result would be inconsistent with both.

CONCLUSION

For the foregoing reasons, each of Petitioner's grounds for its Motion for Reconsideration is meritless and the Motion should be denied in its entirety.

Dated: New York, New York
May 22, 2015

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By:_____

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CERTIFICATE OF SERVICE

I hereby certify that, on this 22nd day of May, 2015, a copy of the foregoing OPPOSITION TO PETITIONER'S MOTION FOR RECONSIDERATION was sent by First Class Mail to Spoonjack at its correspondence address of record:

Spoonjack LLC
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San Francisco, CA 94111

Leo Kittay