

ESTTA Tracking number: **ESTTA729643**

Filing date: **02/25/2016**

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

Proceeding	92061951
Party	Plaintiff Chutter, Inc.
Correspondence Address	BRUCE W BABER KING & SPALDING LLP 1180 PEACHTREE STREET ATLANTA, GA 30309 UNITED STATES bbaber@kslaw.com, kmccarthy@kslaw.com, nytrademarks@kslaw.com
Submission	Other Motions/Papers
Filer's Name	Bruce W. Baber
Filer's e-mail	bbaber@kslaw.com, kmccarthy@kslaw.com, nytrademarks@kslaw.com
Signature	/Bruce W. Baber/
Date	02/25/2016
Attachments	02.25 Baber Declaration.pdf(1870780 bytes)

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

CHUTTER, INC.,)	
)	
Petitioner,)	CANCELLATION
)	
v.)	NO. 92061951
)	
GREAT CONCEPTS, LLC,)	
)	
Registrant.)	

DECLARATION OF BRUCE W. BABER

I, Bruce W. Baber, declare and state the following:

1. My name is Bruce W. Baber. I am a partner in the law firm of King & Spalding LLP and am one of the counsel of record for petitioner Chutter, Inc. (“Chutter”) in the above-captioned matter. I give this declaration freely and voluntarily in support of Chutter’s Brief In Opposition To Registrant’s Motion for Summary Judgment, filed on January 25, 2016 (TTABVUE No. 9).
2. I am a member of the bar of the State of Georgia. I have personal knowledge of the facts set forth in the Declaration, and am competent to make this Declaration. I am over 21 years of age and not under any legal disability.
3. Attached hereto as Exhibit A is a true and correct copy of a Trademark Assignment Agreement between Dan Tana and Chutter, Inc., dated as of May 8, 2011, in which Mr. Tana assigned to Chutter all rights in the mark DAN TANA and two registrations thereof, effective as of February 1, 2009.

4. Attached hereto as Exhibit B is a true and correct copy of Application Serial No. 86/452,328, filed by Chutter, Inc. on November 12, 2014, for registration of the mark DAN TANA'S for marinara sauce, which claims dates of first use anywhere on January 5, 2012 and in commerce on August 12, 2013.

5. Attached hereto as Exhibit C is a true and correct copy of the Petition for Cancellation filed on June 6, 2006 in Cancellation No. 92045947 (TTABVUE 1).

6. Attached hereto as Exhibit D is a true and correct copy the Board's Order dated September 7, 2010 in Cancellation No. 92045947 (TTABVUE 22).

7. Attached hereto as Exhibit E is a true and correct copy of the Board's Order dated December 14, 2010 in Cancellation No. 92045947 (TTABVUE 45).

In accordance with 28 U.S.C. § 1746, I declare under penalty of perjury that the foregoing is true and correct.

Executed on this 25th day of February, 2016, in New York, New York.

/s/ Bruce W. Baber
Bruce W. Baber

EXHIBIT A

AGREEMENT

This TRADEMARK ASSIGNMENT AGREEMENT ("Agreement") is made as of this 8 day of MAY, 2011 ("Effective Date") by and between Dan Tana, an individual, ("Assignor") and CHUTTER INCORPORATED ("Assignee"). Each of the parties to this Agreement is individually referred to herein as a "Party" and collectively as the "Parties."

WHEREAS, Assignor is the owner of certain rights, title and interest in and to the DAN TANA'S trademark as applied to the goods recited in the U.S. trademark registrations identified herein, and the goodwill of the business symbolized by such mark therein in the United States of America;

WHEREAS, Assignor is the owner of U.S. Trademark Registration Nos. 3,420,716 and 3,420,717 for the mark DAN TANA'S, ("Registrations");

Now, therefore, for good and valuable consideration, receipt of which is hereby acknowledged, ASSIGNOR agrees that ASSIGNOR hereby assigned unto ASSIGNEE nunc pro tunc effective as of February 1, 2009, all right, title and interest in and to the Registrations, including all goodwill associate therewith, whether based on common law or the laws of the various states, and the right (but not the obligation) to assert such registered trademark and other assigned rights to collect for all past, present and future infringements, and claims for damages and the proceeds thereof.

ARTICLE 1

ASSIGNMENT OF TRADEMARK RIGHTS

1.1 The Assignor hereby assigned and transferred to the Assignee, all of the Assignor's right, title, and interest in and to the Trademark in the U.S., including all common law rights, the goodwill of the business symbolized by the Trademark, and all rights to sue for past, present, and/or future infringements or misappropriations of the Trademark nunc pro tunc effective as of February 1, 2009.

1.2 The Assignor hereby authorizes the Assignee and/or its designated agent to record this Assignment with the United States Patent and Trademark Office. The Assignor shall execute any and all additional instruments, writings and other documents and take any additional steps as may be necessary or proper as determined by the Assignee, at the sole expense of the Assignee, in order to effect the assignment of the Trademark, and will otherwise cooperate with the Assignee to accomplish the purpose of this Agreement.

ARTICLE 2

ASSIGNOR'S REPRESENTATIONS AND WARRANTIES

The Assignor hereby represents and warrants as follows:

2.1 The Assignor has title to the Trademark.

2.2 The Assignor has not granted any liens, mortgages, encumbrances, licenses, or other agreement thereon with respect to the Trademark; that it has the full right, power and authority to grant all of the rights, title and interests granted in this Agreement; and that no dispute exists which challenges the legality, validity, or enforceability of the Trademark to the best knowledge of the Assignor.

2.3 The Assignor has full right, power, authority and capacity to execute and perform this Agreement.

2.4 Once this Agreement has been duly executed by both parties, it will constitute a legal, valid and binding agreement of the Assignor enforceable against it in accordance with its terms upon its execution.

2.5 The Assignor will not engage in any action that will be of detriment to the validity of the Trademark after the completion of the assignment.

ARTICLE 3

ASSIGNEE'S REPRESENTATIONS AND WARRANTIES

The Assignee hereby represents and warrants as follows:

3.1 The Assignee is a company duly registered and validly existing under the laws of the State of California.

3.2 The Assignee has full right, power, authority and capacity to execute and perform this Agreement.

3.3 Once this Agreement has been duly executed by both parties, it will constitute a legal, valid and binding agreement of the Assignee enforceable against it in accordance with its terms upon its execution.

ARTICLE 4

EFFECTIVNESS

4.1 This Agreement shall immediately come into effect upon execution by both Parties.

4.2 This Agreement shall benefit and be binding upon the Parties hereto and their respective successors and assigns.

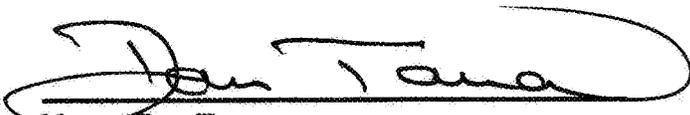
ARTICLE 5

MISCELLANEOUS

5.1 This Agreement may be executed in any number of counterparts, each of which when so executed and delivered to the other Party shall be deemed an original. The executed page(s) from each original may be joined together and attached to one such original and shall thereupon constitute one and the same instrument.

IN WITNESS WHEREOF, the parties hereto have executed this Agreement as of the date first written above.

ASSIGNOR: DAN TANA

By: 
Name: Dan Tana
Its:

ASSIGNEE: CHUTTER INCORPORATED

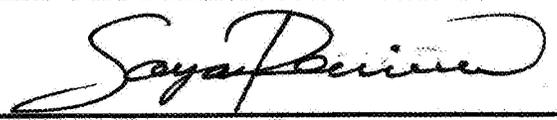
By: 
Name: SONJA PERENGEVIC
Its:

EXHIBIT B

Trademark/Service Mark Application, Principal Register

Serial Number: 86452328

Filing Date: 11/12/2014

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	86452328
MARK INFORMATION	
*MARK	DAN TANA'S
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	DAN TANA'S
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	CHUTTER, INC.
*STREET	9071 Santa Monica Boulevard
*CITY	West Hollywood
*STATE (Required for U.S. applicants)	California
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants only)	90069
LEGAL ENTITY INFORMATION	
TYPE	corporation

STATE/COUNTRY OF INCORPORATION	California
GOODS AND/OR SERVICES AND BASIS INFORMATION	
INTERNATIONAL CLASS	043
* IDENTIFICATION	Marinara sauce
FILING BASIS	SECTION 1(a)
FIRST USE ANYWHERE DATE	At least as early as 01/05/2012
FIRST USE IN COMMERCE DATE	At least as early as 08/12/2013
SPECIMEN FILE NAME(S)	\\TICRS\EXPORT16\IMAGEOUT 16\864\523\86452328\xml1\APP0003.JPG
SPECIMEN DESCRIPTION	The trademark as applied to a jar of marinara sauce
ATTORNEY INFORMATION	
NAME	Maurice B. Pilosof
FIRM NAME	MAURICE B. PILOSOF, ESQ.
STREET	1925 Century Park East, Suite 2300
CITY	Los Angeles
STATE	California
COUNTRY	United States
ZIP/POSTAL CODE	90069
PHONE	310 985-4283
EMAIL ADDRESS	mpilosof@ipbymbp.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
CORRESPONDENCE INFORMATION	
NAME	Maurice B. Pilosof
FIRM NAME	MAURICE B. PILOSOF, ESQ.
STREET	1925 Century Park East, Suite 2300

CITY	Los Angeles
STATE	California
COUNTRY	United States
ZIP/POSTAL CODE	90069
PHONE	310 985-4283
EMAIL ADDRESS	mpilosof@ipbymbp.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
NUMBER OF CLASSES	1
FEE PER CLASS	325
*TOTAL FEE DUE	325
*TOTAL FEE PAID	325
SIGNATURE INFORMATION	
ORIGINAL PDF FILE	hw_17224936130-153918961_.DAN_TANA_S_30_decl_exec.pdf
CONVERTED PDF FILE(S) (1 page)	\\TICRS\EXPORT16\IMAGEOUT16\864\523\86452328\xml1\APP0004.JPG
SIGNATORY'S NAME	/Sonja Perencevic/
SIGNATORY'S POSITION	President

Trademark/Service Mark Application, Principal Register

Serial Number: 86452328

Filing Date: 11/12/2014

To the Commissioner for Trademarks:

MARK: DAN TANA'S (Standard Characters, see [mark](#))

The literal element of the mark consists of DAN TANA'S.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, CHUTTER, INC., a corporation of California, having an address of
9071 Santa Monica Boulevard
West Hollywood, California 90069
United States

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 043: Marinara sauce

In International Class 043, the mark was first used by the applicant or the applicant's related company or licensee or predecessor in interest at least as early as 01/05/2012, and first used in commerce at least as early as 08/12/2013, and is now in use in such commerce. The applicant is submitting one(or more) specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) The trademark as applied to a jar of marinara sauce.

[Specimen File 1](#)

The applicant's current Attorney Information:

Maurice B. Pilosof of MAURICE B. PILOSOFF, ESQ.
1925 Century Park East, Suite 2300
Los Angeles, California 90069
United States

The applicant's current Correspondence Information:

Maurice B. Pilosof
MAURICE B. PILOSOFF, ESQ.
1925 Century Park East, Suite 2300
Los Angeles, California 90069
310 985-4283(phone)
mpilosof@ipbymbp.com (authorized)

A fee payment in the amount of \$325 has been submitted with the application, representing payment for 1 class(es).

Declaration

The signatory believes that: if the applicant is filing the application under 15 U.S.C. Section 1051(a), the applicant is the owner of the trademark/service mark sought to be registered; the applicant or the applicant's related company or licensee is using the mark in commerce on or in connection with the goods/services in the application, and such use by the applicant's related company or licensee inures to the benefit of the applicant; the specimen(s) shows the mark as used on or in connection with the goods/services in the application; and/or if the applicant filed an application under 15 U.S.C. Section 1051(b), Section 1126(d), and/or Section 1126(e), the applicant is entitled to use the mark in commerce; the applicant has a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the goods/services in the application. The signatory believes that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive. The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of the application or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

Declaration Signature

Signature: Not Provided Date: Not Provided

Signatory's Name: /Sonja Perencevic/

Signatory's Position: President

RAM Sale Number: 86452328

RAM Accounting Date: 11/13/2014

Serial Number: 86452328

Internet Transmission Date: Wed Nov 12 15:45:05 EST 2014

TEAS Stamp: USPTO/BAS-XXX.XXX.XX.XXX-201411121545050

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DAN TANA'S

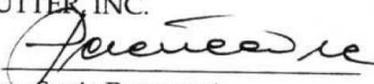


DECLARATION OF APPLICANT

I, Sonja Perencevic, hereby declare that I am the President of CHUTTER, INC., hereinafter the "Applicant", and I am authorized to execute this Declaration on behalf of the Applicant; I believe Applicant to be the owner of the mark sought to be registered, or if the application is being filed under 15 U.S.C. 1051(b), I believe Applicant to be entitled to use such mark in commerce; and to the best of my knowledge and belief, no other person, partnership, firm, corporation, or association has the right to use said mark in commerce, either in the identical form or in such near resemblance thereto as may be likely, when applied to the goods or services of such other person, to cause confusion, or to cause mistake, or to deceive; that all statements made of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or document or any registration resulting therefrom.

Signed this 8 day of NOVEMBER 2014
at _____.

CHUTTER, INC.

By: 

Name: Sonja Perencevic

Title: President

EXHIBIT C

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

DAN TANA

Cancellation No.

Petitioner,

-against-

GREAT CONCEPTS, LLC

Respondent.

PETITION FOR CANCELLATION

Petitioner, Dan Tana ("Petitioner"), believes that he will be damaged by the continued registration of U.S. Trademark Registration Number 2,929,764 for the mark DANTANNA'S for restaurant services in International Class 43 and hereby petitions for the cancellation thereof.

The grounds for cancellation are as follows:

1. Petitioner is an individual with an office and place of business located at Dan Tana's, 9071 Santa Monica Boulevard, Los Angeles, California 90069.
2. Upon information and belief, Respondent, Great Concepts, LLC ("Respondent") is a Georgia limited liability company with an office and place of business located at 10500 NW 5th Manor, Plantation, Florida 33324, is listed with the U.S. Patent & Trademark Office ("PTO") records as the alleged current owner of Registration Number 2,929,764 of March 1, 2005 for the mark DANTANNA'S for restaurant services in International Class 43.
3. Petitioner is the owner of U.S. Application Serial Number 78/648306 for the mark DAN TANA'S for restaurant services in International Class 43, which was filed on June 10, 2005.
4. Petitioner has been operating a restaurant in Los Angeles bearing his name,

DAN TANA, since as early as 1964. Consequently, DAN TANA'S restaurant has not only become an establishment in Los Angeles but it has achieved national and international fame and notoriety as a result of the frequent patronage by celebrities to this restaurant and the unsolicited media coverage Petitioner continuously receives for his restaurant.

5. In fact, the press has referred to Petitioner's restaurant as "a legendary Hollywood hotspot", "a rare place", "the ultimate LA hangout" and a "shrine" and to Dan Tana as a "preeminent restaurateur". Attached hereto and collectively identified as *Exhibit 1* are copies of some of the unsolicited press coverage Petitioner has received for his famous restaurant.

6. Interestingly, by the 1970's Petitioner's namesake restaurant had gained such fame and notoriety, not only in Hollywood, but throughout the country, that Petitioner was approached by the famous producer, Aaron Spelling, seeking to use the DAN TANA name as the name of the lead character for the television series VEGAS.

7. The Vegas television series successfully ran for several years, providing Petitioner and his DAN TANA'S restaurant with even more fame and recognition.

8. There is no doubt that over the years, DAN TANA'S restaurant has become an institution and its owner, Dan Tana, a legend. In fact, Dan Tana is probably as famous as the celebrity stars, such as George Clooney, Matt Damon and Brad Pitt, who frequent his DAN TANA'S restaurant.

9. After 42 years in continuous operation and numerous unsolicited newspaper and magazine articles, consumers and restaurant goers readily identify DAN TANA'S restaurant with its owner and Petitioner herein, Dan Tana.

10. On December 31, 2005, the PTO issued an Office Action in connection with Petitioner's DAN TANA'S Application, which contained a refusal to register the mark under §2 (d) of the Lanham Act, 15 U.S.C. §1052 (d), on the basis of Respondent's Registration Number 2,929,764 for the DANTANNA'S mark for restaurant services.

11. Respondent has claimed a date of first use of September 30, 2003 in connection with use of its mark, almost thirty nine (39) years after Petitioner started its famous

DAN TANA'S restaurant.

**Respondent's Mark Should Not Have Been
Registered Pursuant to Section 2(a) of the Lanham Act**

12. Section 2(a) of the Lanham Act clearly states that:

"No trademark... shall be refused registration ... unless it consists of or comprises ... matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, ...". Lanham Act § 2(a), 15U.S.C.A. § 1052(a).

13. The Trademark Board has further expanded on Section 2(a) by enumerating the following four elements of a successful § 2(a) claim that an applicant's mark falsely suggests a connection with another person. The four elements enumerated by the Trademark Board are: (i) the marks are the same as, or a close approximation of, the name or identity of another person; (ii) the mark points uniquely and unmistakably to the other person; (iii) the person named by the mark is not connected with the activities of applicant; and, (iv) the prior user's name or identity is of sufficient fame or reputation that a connection with such person would be presumed when applicant's mark is used on applicant's goods. In re Wielinski, 49 U.S.P.Q.2d 1754 (T.T.A.B. 1998); In re Sauer, 27 U.S.P.Q.2nd 1073 (T.T.A.B. 1993), *aff'd*, 26 F.3d 140 (Fed. Cir. 1994) ("Bo Jackson has achieved great fame and notoriety, so that when his nickname is used as part of the "Bo Ball" and design mark on applicant's goods, purchasers will likely make a connection between him and applicant's products").

14. In the instant matter, (i) Respondent's DANTANNA'S mark is identical to Petitioner's famous DAN TANA'S mark;¹ (ii) the DAN TANA mark points directly and uniquely to Petitioner since it is his name; (iii) Petitioner is in no way associated with Respondent or its

¹ In fact, Respondent is even using the apostrophe sign to signify its ownership status of the restaurant just as Petitioner does. Furthermore, the only difference between the two marks is that Respondent has connected Petitioner's famous first and last names to most likely, overcome any requirement of having to explain to the PTO whether the mark identifies a living individual.

DANTANNA'S restaurant; and, (iv) as evidenced by the unsolicited press coverage, a fraction of which is submitted herewith, it is clear that Petitioner's person and his restaurant are of sufficient fame and reputation, where any use by Respondent of the DANTANNA'S mark is readily associated with Petitioner.

15. There is no doubt that Respondent's initial application to register the DANTANNA'S mark would have been refused under Section 2(a) had Respondent truthfully listed the source of its mark --- Petitioner's DAN TANA name.

Respondent's Registration Was Obtained Fraudulently

16. As already stated above, a review of the original application filed by Respondent on June 9, 2003 in the U.S. PTO reveals that Respondent did not claim the name DANTANNA'S to identify the name or names of living individuals. In fact, it is evident that Respondent in an attempt to overcome the discovery after a search by the PTO examiner that DAN TANA is the name of a famous restaurant and its owner decided to combine the first and last name of the famous restaurateur to avoid having to state whether or not the mark identifies the name of a living individual.

17. In fact, a cursory search through google by simply searching for the name DAN TANA provides 883,000 hits, all of which concern the famed restaurateur and his famous DAN TANA'S restaurant. Annexed hereto and identified as *Exhibit 2* is a copy of the initial google search pages.

18. Based on the unsolicited press coverage Petitioner has and continues to receive for its famous restaurant, there is no doubt that not only consumers but people in the restaurant business are aware of the origins of DAN TANA'S restaurant and know that it is owned, operated and associated with Petitioner, Dan Tana, only.

19. Consequently and upon information and belief, Respondent tried to benefit from the fame and notoriety associated with Petitioner's name and from the goodwill and fame already associated with the DAN TANA name for a restaurant and filed its application for the

DANTANNA'S name to mislead the public into believing that its restaurant is in some way associated with the famed DAN TANA'S, when in fact it is not.

20. Upon information and belief, there is no other explanation as to why out of a wealth of marks available to be used in connection with the designation of a restaurant, Respondent chose a famed name that was already associated with a well known persona and an established restaurant.

21. Upon information and belief, Respondent committed fraud on the U.S. Trademark Office in obtaining its Registration No. 2,929,764 for the DANTANNA'S mark.

22. It is Petitioner's position that Respondent's initial application for the DANTANNA'S mark should have been refused by the PTO based on Lanham Act § 2(a), 15U.S.C.A. § 1052(a).

23. Since the application mistakenly matured into a registration, Petitioner herein respectfully moves for the cancellation of Respondent's U.S. Registration No. 2,929,764 for the DANTANNA'S mark on the basis that Respondent obtained its Registration fraudulently.

24. Petitioner further maintains that the continued registration of Respondent's Registration No. 2,292,754 will cause injury and damage to Petitioner by confusing consumers into believing that Respondent's restaurant is somehow sponsored by or associated with Petitioner and by barring the registration of Petitioner's rightful name, DAN TANA'S, under its Application Serial No. 78/648306 on the U.S. Trademark Registry.

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WHEREFORE, Petitioner hereby respectfully prays that said Registration Number 2,929,764 be cancelled with prejudice, and for such other and further relief as may be deemed adequate and proper by the Board.

Dated: New York, New York
June 7, 2006

Respectfully submitted,



Afschineh Latifi, Esq.
Tucker & Latifi, LLP
160 East 84th Street
New York, NY 10028
(212) 472-6262
Alatifi@tuckerlatifi.com

Attorneys for Petitioner

Certificate of Service

I hereby certify that two originals of the attached document are being deposited on June 7, 2006 with the U.S. Postal Service as "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 and is addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, Attn: TTAB.



Afschneeh Latifi, Esq.

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EXHIBIT D

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

Mailed: September 7, 2010

Cancellation No. 92045947

Dan Tana

v.

Great Concepts, LLC

Andrew P. Baxley, Interlocutory Attorney:

On September 1, 2010, respondent filed a submission in which it stated that the civil action styled *Dan Tana v. Dantanna's, Great Concepts, LLC, et al.*, Case No. 08-CV-0975, filed in United States District Court for the Northern District of Georgia, which prompted the suspension of this case, has been finally determined with petitioner's claim of false designation of origin under Trademark Act Section 43(a), 15 U.S.C. Section 1125(a), being dismissed.¹ Accordingly, proceedings herein are resumed. Further briefing on respondent's motion for summary judgment is deferred pending resolution of the following.

In view of the decision by the Board's reviewing court in *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed.

¹ Respondent served its submission upon petitioner's former attorney. Respondent is directed to re-serve its submission on petitioner's current attorney, i.e., Brent Blakely, Blakely Law Group, 915 North Citrus Avenue, Hollywood, CA 90038.

Cancellation No. 92045947

Cir. 2009), the Board has *sua sponte* reviewed petitioner's petition to cancel and finds that both of petitioner's claims are insufficiently pleaded.² See Fed. R. Civ. P. 12(b)(6); TBMP Section 503.02 (2d ed. rev. 2004).

Regarding petitioner's claim that respondent's mark falsely suggests a connection with petitioner under Trademark Act Section 2(a), 15 U.S.C. Section 1052(a), such claims evolved out of the right to privacy, as opposed to trademark infringement. See *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 217 USPQ 505 (Fed. Cir. 1983). A claim of false suggestion of a connection under Section 2(a), requires allegation of facts from which it may be inferred: (1) that respondent's mark points uniquely to petitioner, as an entity, i.e., that applicant's mark is opposer's identity or persona; (2) that purchasers would assume that services rendered under respondent's mark are connected with petitioner; and (3) that, prior to respondent's use of its mark, either (a) petitioner used respondent's mark, or an equivalent thereof, as a designation of his identity or persona, or (b) respondent's mark was associated with petitioner. See *Miller Brewing Co.*

² Petitioner has adequately pleaded his standing by alleging facts which demonstrate a real interest in the outcome of this proceeding in paragraphs 1 through 10 of the petition to cancel. See *Ritchie v. Simpson*, 50 USPQ2d 1023 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1028, 213 USPQ 185, 189 (CCPA 1982).

Cancellation No. 92045947

v. Anheuser-Busch Inc., 27 USPQ2d 1711 (TTAB 1993). In the petition to cancel, petitioner alleges that respondent's DANTANNA'S mark is identical to petitioner's DAN TANA mark, instead of his identity or persona.³ Paragraph 14(i). Petitioner also alleges that petitioner's DAN TANA mark, instead of respondent's involved DANTANNA'S mark, points directly and unique to petitioner. Paragraph 14(ii).

In addition, petitioner contends that respondent's application for the involved registration should have been refused under Section 2(a). However, in determining claims in *inter partes* proceedings, the issue is not whether the examining attorney should have refused registration of respondent's mark. The Board does not supervise examining attorneys. See *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034 (TTAB 1989). Rather, Board proceedings are based upon a plaintiff's belief of damage from the registration of a mark and involve determinations of whether cancellation or refusal of a registration is warranted, based on specific pleaded grounds. See Trademark Act Sections 13 and 14, 15 U.S.C. Section 1063 and 1064; Trademark Rules 2.101(b) and 2.111(b). Based on the

³ A claim based on an assertion that respondent's mark is confusingly similar to petitioner's previously used mark is properly raised under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).

Cancellation No. 92045947

foregoing, petitioner's Section 2(a) false suggestion claim is legally insufficient.

Regarding petitioner's pleaded fraud claim, fraud in procuring or maintaining a trademark registration occurs when an applicant for registration or a registrant in a declaration of use or a renewal application knowingly makes specific false, material representations of fact 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.⁴ See *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986).

Petitioner has failed to identify clearly any specific false, material representations of fact that respondent made in the *ex parte* examination of the application for its involved registration with the intent of obtaining a registration to which respondent was not entitled. While the declaration in an application must be truthful,

⁴ 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.*, *supra*.

There is no fraud if a false misrepresentation is occasioned by an honest misunderstanding or inadvertence without a willful intent to deceive. *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981). 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. *In re Bose Corp.*, *supra* at 1942. Any doubt must be resolved against the party making a claim of fraud. *Id.* at 1939.

respondent was not required to investigate and report all other possible users of an identical or confusingly similar mark either as part of its application or during *ex parte* examination of that application.⁵ See *Rosso and Mastracco, Inc. v. Giant Food Inc.*, 219 USPQ 1050 (Fed. Cir. 1983); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355 (TTAB 1989). In addition, a review of the registration file indicates that respondent was not asked during such examination to explain whether its involved DANTANNA'S mark had any meaning or significance in the relevant trade or

⁵ In the declaration contained in the application for respondent's involved registration, respondent's attorney averred that "**to the best of his/her knowledge and belief** no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive." (emphasis added) To the extent that petitioner intends to assert that respondent committed fraud in that declaration, petitioner 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 the applicant's; (3) the applicant knew that the other user had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from the applicant's use of its mark or had no reasonable basis for believing otherwise; and that (4) the applicant, in failing to disclose these facts to the Patent and Trademark Office, intended to procure a registration to which it was not entitled. *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1205 (TTAB 1997). Otherwise stated, petitioner must plead (and later prove) not only that respondent's declaration was literally false (i.e., that respondent did not have superior rights in the mark), but also that respondent knew that its assertion of exclusive rights in the mark was false. *Am. Sec. Bank v. Am. Sec. & Trust Co.*, 571 F.2d 564, 197 USPQ 65, 67 (CCPA 1978) ("Appellant misreads the cited statute and rules. They require the statement of *beliefs* about exclusive rights, not their actual possession.").

Cancellation No. 92045947

industry or whether the mark identifies a living individual. The Board will not penalize respondent for not providing an explanation that the examining attorney did not request. See *Marshall Field & Co. v. Mrs. Fields Cookies*, *supra*. Further, petitioner's fraud allegations are unacceptably made "[u]pon information and belief" without setting forth specific facts upon which the belief is reasonably based. See *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478 (TTAB 2009). Based on the foregoing, petitioner's fraud claim is also legally insufficient.

Notwithstanding the foregoing, the Board generally allows plaintiffs whose pleadings have been found insufficient an opportunity to file a corrected pleading. See TBMP Section 503.03. Therefore, petitioner is allowed until thirty days from the mailing date set forth in this order to file an amended petition to cancel.⁶ Respondent is allowed until sixty days from the mailing date set forth in this order to file an answer to the amended petition to cancel and either a revised motion for summary judgment or a submission indicating that it wishes to go forward with its pending motion for summary judgment.⁷ Petitioner is allowed

⁶ If petitioner does not file an amended petition to cancel, the Board may issue an order to show cause why the Board should not dismiss the petition to cancel with prejudice based on petitioner's apparent loss of interest in this case.

⁷ The revised motion for summary judgment should include all supporting exhibits. If respondent files a revised motion for

Cancellation No. 92045947

until ninety-five days from the mailing date set forth in this order to file a brief in response to respondent's operative motion for summary judgment. Respondent's reply brief in support of its operative motion for summary judgment is due in accordance with Trademark Rules 2.119(c) and 2.127(e)(1).

summary judgment, the revised motion for summary judgment will become the operative summary judgment motion herein, and its pending motion for summary judgment will receive no consideration.

EXHIBIT E

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

Baxley

Mailed: December 14, 2010

Cancellation No. 92045947

Dan Tana

v.

Great Concepts, LLC

By the Trademark Trial and Appeal Board:

In view of petitioner's failure to respond to the order to show cause that the Board issued on October 26, 2010, the petition to cancel is dismissed with prejudice based on petitioner's apparent loss of interest.

CERTIFICATE OF SERVICE

This is to certify that I have this day served the foregoing Declaration Of Bruce W. Baber upon Registrant, by causing a true and correct copy thereof to be deposited in the United States mail, postage prepaid, addressed to Registrant's counsel of record as follows:

Ms. Lisel M. Ferguson
Procopio, Cory, Hargreaves & Savitch LLP
525 B Street, Suite 2200
San Diego, California 92101-4474

This 25th day of February, 2015.

/Bruce W. Baber/

Bruce W. Baber