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

Proceeding	92064179
Party	Defendant Roger D. Popa DBA Petoskey Pete's
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Date	09/16/2016
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration No. 3,962,466
Trademark: NORTH

ASKOW HOLDINGS, LLC

Petitioner,

Cancellation No. 92064179

V.

RESPONSE TO PETITION
FOR CANCELLATION

ROGER D. POPA
d/b/a PETOSKEY PETE'S

Respondent

RESPONDENT'S RESPONSE TO PETITION FOR CANCELLATION

Respondent, Roger D. Popa d/b/a Petoskey Pete's ("Respondent") by its attorneys, for its Response against Askow Holdings, LLC ("Petitioner") shows the Court as follows:

COUNT 1

1. Petitioner is the record owner of two NORTH trademark applications, namely, Application Serial No. 87/002,339, for NORTH in connection with "clothing" in International Class 25 and Application Serial No. 87/000,423 for NORTH (Stylized) & Design in connection with "clothing" in International Class 25 ("Petitioner's NORTH Applications").

ANSWER: ADMIT

2. Upon information and belief, Roger D. Popa d/b/a Petoskey Pete's, a Michigan sole proprietorship having an address of 630 West 10th St., Traverse City, Michigan, 49684 ("Respondent") is listed as the record owner of: US Registration No. 3,962,466 ("Respondent's Registration") for Respondent's Claimed Mark, depicted below, for "Bottoms; Golf shirts; Hats; Hooded sweat shirts; Jogging pants; Long-sleeved shirts; Lounge pants; Pants; Pique shirts; Polo shirts; Shirts; Shirts and short sleeved shirts; Shirts for infants, babies, toddlers and children; Short-sleeved or long-sleeved t-shirts;

Short-sleeved shirts; Sport shirts; Sweat pants; Sweat shirts; T-shirts; Tee shirts; Tops; Yoga pants; Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Capri pants; Cargo pants; Dress shirts; Fleece vests; Knit shirts; Moisture-wicking sports shirts; Rugby shirts; Wind pants; Wind shirts” in International Class 25 (“Respondent’s Claimed Goods”):



ANSWER: ADMIT

3. Petitioner has been and is likely to continue to be damaged by registration of Respondent’s Claimed Mark because Petitioner’s NORTH Applications were issued Office Actions on August 2, 2016, in which the U.S. Patent and Trademark Office refused registration of Petitioner’s NORTH Applications under Section 2(d) of the Lanham Act, relying on the continued registration of Respondent’s Claimed Mark.

ANSWER: DENY

4. Upon information and belief, Respondent has never made use in commerce of Respondent’s Claimed Mark in connection with any goods or services.

ANSWER: DENY

5. Upon information and belief, Respondent has never made use in commerce of Respondent’s Claimed Mark in connection with any goods or services.

ANSWER: DENY

6. Upon information and belief, Respondent has never made use in commerce of Respondent’s Claimed Mark in connection with the goods originally applied-for in U.S. Application No. 77789289, which later matured into U.S. Reg. No. 3,962,466.

ANSWER: DENY

7. Upon information and belief, as of July 24, 2009, Respondent had not made use in commerce of Respondent's Claimed Mark in connection with goods or services.

ANSWER: DENY

8. Upon information and belief, as of July 24, 2009, Respondent had not made use in commerce of Respondent's Claimed Mark in connection with Respondent's Claimed goods.

ANSWER: DENY

9. Upon information and belief, as of July 24, 2009, Respondent had not made use in commerce of Respondent's Claimed Mark in connection with the goods originally applied-for in U.S. Application No. 77/789,289, which later matured into U.S. Reg. No. 3,962,466.

ANSWER: DENY

10. Upon information and belief, as of March 11, 2011, Respondent had not made use in commerce of Respondent's Claimed Mark in connection with goods or services.

ANSWER: DENY

11. Upon information and belief, as of March 11, 2011, Respondent had not made use in commerce of Respondent's Claimed Mark in connection with Respondent's Claimed goods.

ANSWER: DENY

12. Upon information and belief, as of March 11, 2011, Respondent had not made use in commerce of Respondent's Claimed Mark in connection with the goods originally applied-for in U.S. Application No. 77/789,289, which later matured into U.S. Reg. No. 3,962,466.

ANSWER: DENY

13. Upon information and belief, U.S. Reg. No. 3,962,466 was and is void *ab initio*.

ANSWER: DENY

COUNT 2

14. Petitioner hereby restates and realleges allegations 1 through 13 as if made fully herein below.

ANSWER: Respondent incorporates by reference its Answers in paragraphs 1-13, above.

Respondent hereby restates and realleges it's responses to allegations 1 -13 as if made fully herein.

15. Upon information and belief, Respondent has not made use in commerce of Respondent's Claimed Mark in connection with any goods or services for a period of more than three consecutive years.

ANSWER: DENY

16. Upon information and belief, Respondent has not made use in commerce of Respondent's Claimed Mark in connection with Respondent's Claimed Goods for a period of more than three consecutive years.

ANSWER: DENY

17. Upon Information and belief, Respondent has not made use in commerce of Respondent's Claimed Mark in connection with goods originally applied-for in U.S. Application No. 77/789,289, which later matured into U.S. Reg. No. 3,962,466, for a period of more than three consecutive years.

ANSWER: DENY

18. Upon information and belief, any use by Respondent of Respondent's Claimed Mark has been made solely to reserve rights in Respondent's Claimed Mark and does not constitute a bona fide use of Registrant's Claimed Mark in commerce in the ordinary course of trade.

ANSWER: DENY

19. Upon information and belief, Respondent never had and has no bona fide intent to use in commerce or resume use in commerce Respondent's Claimed Mark in connection with any goods or services.

ANSWER: DENY

20. Upon information and belief, Respondent never had and has no bona fide intent to use in commerce or resume use in commerce Respondent's Claimed Mark in connection with Respondent's Claimed Goods.

ANSWER: DENY

21. Upon information and belief, Respondent never had and has no bona fide intent to use in commerce or resume use in commerce Respondent's Claimed Mark in connection with the goods originally applied-for in U.S. Application No. 77/789,289, which later matured into U.S. Reg. No. 3,962,466.

ANSWER: DENY

22. Upon information and belief, Respondent has not made use in commerce and has abandoned Respondent's Claimed Mark within the meaning of Section 45 of the Lanham Act, 15 U.S.C. § 1127, and therefore U.S. Registration No. 3,962,466 should be cancelled.

ANSWER: DENY

COUNT 3

23. Petitioner hereby restates and realleges allegations 1 through 22 above as if made fully herein below.

ANSWER: Respondent incorporates by reference its Answers in paragraphs 1-22, above. Respondent hereby restates and realleges it's responses to allegations 1 -22 as if made fully herein.

24. On July 24, 2009, Respondent filed Trademark Application Serial No. 77/789,289, that later matured into Registration No. 3,962,466, declaring under oath that Respondent's Claimed Mark was currently in use in commerce for each of the following goods: "Golf shirts; Hats; Hooded sweat shirts; Jogging pants; Long-sleeved shirts; Lounge pants; Pants; Pique shirts; Polo shirts; Shirts; Shirts and short sleeved shirts; Shirts for infants, babies, toddlers and children; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sport shirts; Sweat pants; Sweat shirts; T-shirts; Tee shirts; Tops; Yoga pants" to support a filing basis under Section 1(a) of the trademark Act.

ANSWER: Admit that Respondent, pro se, filed Trademark Application Serial No. 77/789,289, that later matured into Registration No. 3,962,466, with the filing bases being section 1(b) and 1(a). Respondent denies any other allegations of paragraph 24.

25. Upon information and belief, on July 24, 2009, Respondent was not using in commerce Respondent's Claimed Mark in connection with "golf shirts."

ANSWER: Respondent admits that Respondent was not using in commerce Respondent's Claimed Mark in connection with "golf shirts" on July 24, 2009, the time of filing Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b) was an Intent to Use application. Respondent denies any other allegations of paragraph 25.

26. Upon information and belief, on July 24, 2009, Respondent was not using in commerce Respondent's Claimed Mark in connection with "hats."

ANSWER: Respondent admits that Respondent was not using in commerce Respondent's Claimed Mark in connection with "hats" on July 24, 2009, the time of filing Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b) was an Intent to Use application. Respondent denies any other allegations of paragraph 26.

27. Upon information and belief, on July 24, 2009, Respondent was not using in commerce Respondent's Claimed Mark in connection with "hooded sweat shirts."

ANSWER: Deny

28. Upon information and belief, on July 24, 2009, Respondent was not using in commerce Respondent's Claimed Mark in connection with "jogging pants."

ANSWER: Respondent admits that Respondent was not using in commerce Respondent's Claimed Mark in connection with "jogging pants" on July 24, 2009, the time of filing Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b) was an Intent to Use application. Respondent denies any other allegations of paragraph 28.

29. Upon information and belief, on July 24, 2009, Respondent was not using in commerce Respondent's Claimed Mark in connection with "long-sleeved shirts."

ANSWER: DENY

30. Upon information and belief, on July 24, 2009, Respondent was not using in commerce Respondent's Claimed Mark in connection with "loung pants."

ANSWER: Respondent admits that Respondent was not using in commerce Respondent's Claimed Mark in connection with "loung pants" on July 24, 2009, the time of filing Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b) was an Intent to Use application. Respondent denies any other allegations of paragraph 30.

31. Upon information and belief, on July 24, 2009, Respondent was not using in commerce Respondent's Claimed Mark in connection with "pants."

ANSWER: Respondent admits that Respondent was not using in commerce Respondent's Claimed Mark in connection with "pants" on July 24, 2009, the time of filing Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b) was an Intent to Use application. Respondent denies any other allegations of paragraph 31.

32. Upon information and belief, on July 24, 2009, Respondent was not using in commerce Respondent's Claimed Mark in connection with "pique shirts."

ANSWER: Respondent admits that Respondent was not using in commerce Respondent's Claimed Mark in connection with "pique shirts" on July 24, 2009, the time of filing Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b) was an Intent to Use application. Respondent denies any other allegations of paragraph 32.

33. Upon information and belief, on July 24, 2009, Respondent was not using in commerce Respondent's Claimed Mark in connection with "polo shirts."

ANSWER: Respondent admits that Respondent was not using in commerce Respondent's Claimed Mark in connection with "polo shirts" on July 24, 2009, the time of filing Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b) was an Intent to Use application. Respondent denies any other allegations of paragraph 33.

34. Upon information and belief, on July 24, 2009, Respondent was not using in commerce Respondent's Claimed Mark in connection with "shirts."

ANSWER: DENY

35. Upon information and belief, on July 24, 2009, Respondent was not using in commerce Respondent's Claimed Mark in connection with "shirts and short-sleeved shirts."

ANSWER: DENY

36. Upon information and belief, on July 24, 2009, Respondent was not using in commerce Respondent's Claimed Mark in connection with "shirts for infants, babies, toddlers and children."

ANSWER: DENY

37. Upon information and belief, on July 24, 2009, Respondent was not using in commerce Respondent's Claimed Mark in connection with "short-sleeved or long-sleeved t-shirts."

ANSWER: DENY

38. Upon information and belief, on July 24, 2009, Respondent was not using in commerce Respondent's Claimed Mark in connection with "short-sleeved shirts."

ANSWER: DENY

39. Upon information and belief, on July 24, 2009, Respondent was not using in commerce Respondent's Claimed Mark in connection with "sport shirts."

ANSWER: DENY

40. Upon information and belief, on July 24, 2009, Respondent was not using in commerce Respondent's Claimed Mark in connection with "sweat pants."

ANSWER: Respondent admits that Respondent was not using in commerce Respondent's Claimed Mark in connection with "sweat pants" on July 24, 2009, the time of filing Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b) as an Intent to Use application. Respondent denies any other allegations of paragraph 40.

41. Upon information and belief, on July 24, 2009, Respondent was not using in commerce Respondent's Claimed Mark in connection with "sweat shirts."

ANSWER: DENY

42. Upon information and belief, on July 24, 2009, Respondent was not using in commerce Respondent's Claimed Mark in connection with "T-shirts."

ANSWER: DENY

43. Upon information and belief, on July 24, 2009, Respondent was not using in commerce Respondent's Claimed Mark in connection with "tee shirts."

ANSWER: DENY

44. Upon information and belief, on July 24, 2009, Respondent was not using in commerce Respondent's Claimed Mark in connection with "yoga pants."

ANSWER: Respondent admits that Respondent was not using in commerce Respondent's Claimed Mark in connection with "yoga pants" on July 24, 2009, the time of filing Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b) was an Intent to Use application. Respondent denies any other allegations of paragraph 44.

45. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when he declared he was using a commerce Respondent's Claimed Mark in connection with the goods identified with a filing basis of current use in commerce under Section 1(a) of the Trademark Act.

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 45, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3(T.T.A.B, Oct. 22, 2009)(opinion attached). *Pro se* Respondent filed on July 24, 2009, Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b) was an Intent to Use application. Respondent denies the allegations of paragraph 45.

46. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "golf shirts."

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 46, and accordingly denies. Pleadings of fraud made "on

information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). *Pro se* Respondent filed on July 24, 2009, Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b), was an Intent to Use application. Respondent denies the allegations of paragraph 46.

47. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "hats."

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 47, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). *Pro se* Respondent filed on July 24, 2009, Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b), was an Intent to Use application. Respondent denies the allegations of paragraph 47.

48. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "hooded sweat shirts."

ANSWER: DENY

49. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "jogging pants."

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 49, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3

(T.T.A.B, Oct. 22, 2009)(opinion attached). *Pro se* Respondent filed on July 24, 2009, Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b), was an Intent to Use application. Respondent denies the allegations of paragraph 49.

50. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "long-sleeved shirts."

ANSWER: DENY

51. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "lounge pants."

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 51, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). *Pro se* Respondent filed on July 24, 2009, Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b), was an Intent to Use application. Respondent denies the allegations of paragraph 51.

52. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "pants."

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 52, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). *Pro se* Respondent filed on July 24, 2009, Trademark

Application Serial No. 77/789,289, as the basis for such filing was section 1(b), was an Intent to Use application. Respondent denies the allegations of paragraph 52.

53. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "pique shirts."

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 53, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). *Pro se* Respondent filed on July 24, 2009, Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b), was an Intent to Use application. Respondent denies the allegations of paragraph 53.

54. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "polo shirts."

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 54, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). *Pro se* Respondent filed on July 24, 2009, Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b), was an Intent to Use application. Respondent denies the allegations of paragraph 54.

55. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "shirts."

ANSWER: DENY

56. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "shirts and short-sleeved shirts."

ANSWER: DENY

57. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "shirts for infants, babies, toddlers and children."

ANSWER: DENY

58. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "short-sleeved or long-sleeved t-shirts."

ANSWER: DENY

59. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "short-sleeved shirts."

ANSWER: DENY

60. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "sport shirts."

ANSWER: DENY

61. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "sweat pants."

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 61, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). *Pro se* Respondent filed on July 24, 2009, Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b), was an Intent to Use application. Respondent denies the allegations of paragraph 61.

62. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "sweat shirts."

ANSWER: DENY

63. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "T-shirts."

ANSWER: DENY

64. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "tee shirts."

ANSWER: DENY

65. Upon information and belief, on July 24, 2009, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "yoga pants."

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 65, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3

(T.T.A.B, Oct. 22, 2009)(opinion attached). *Pro se* Respondent filed on July 24, 2009, Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b), as an Intent to Use application. Respondent denies the allegations of paragraph 65.

66. Respondent's false statements are material because the U.S. Patent and Trademark office detrimentally relied on Respondent's false statements on July 24, 2009, that Respondent's Claimed Mark was being used in commerce in connection with all goods covered by the Section 1(a) basis as of July 24, 2009, and thereby issued Registration No. 3,962,466.

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 66, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). *Pro se* Respondent filed on July 24, 2009, Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b), was an Intent to Use application. Respondent denies the allegations of paragraph 66.

67. Upon information and belief, Respondent knew on July 24, 2009, that he was not using Respondent's Claimed Mark in commerce in connection with all the goods covered by the Section 1(a) basis as of July 23, 2009, in Application Serial No. 77/789,289.

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 67, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). *Pro se* Respondent filed on July 24, 2009, Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b), was an Intent to Use application. Respondent denies the allegations of paragraph 67.

68. Upon information and belief, Respondent knew on July 24, 2009, that he was not using Respondent's Claimed Mark in commerce in connection with all the goods covered by the Section 1(a) basis as of July 23, 2009, in Application Serial No. 77/789,289, and Respondent made the aforementioned material false statements with an intent to deceive the U.S. Patent and Trademark Office.

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 68, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). *Pro se* Respondent filed on July 24, 2009, Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b), was an Intent to Use application. Respondent denies the allegations of paragraph 68.

69. Upon information and belief, Respondent knowingly made false and material representations of fact in connection with Application Serial No. 77/789,289, and fraudulently procured registration of Respondent's Claimed Mark within the meaning of Section 14 of the Lanham Act, 15 U.S.C. § 1064, and therefore U.S. registration No. 3.962,466 should be cancelled.

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 69, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). *Pro se* Respondent filed on July 24, 2009, Trademark Application Serial No. 77/789,289, as the basis for such filing was section 1(b), was an Intent to Use application. Respondent denies the allegations of paragraph 69.

COUNT 4

70. Petitioner hereby restates and realleges allegations 1 through 69 above as if made fully herein below.

ANSWER: Respondent reincorporates its answers to paragraphs 1-69, above.

Respondent hereby restates and realleges it's responses to allegations 1 -69 as if made fully herein.

71. On March 11, 2011, Respondent filed a Statement of Use declaring under oath that Respondent's Claimed Mark was being used in commerce in connection with "Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Capri pants; Cargo pants; Dress shirts; Fleece vests; Knit shirts; Moisture-wicking sports shirts; Rugby shirts; Wind pants; Wind shirts."

ANSWER: Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent denies any further allegations of paragraph 71.

72. Upon information and belief, on March 11, 2011, Respondent was not using in commerce Respondent's Claimed Mark in connection with "athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms."

ANSWER: Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed. Respondent denies any further allegations of paragraph 72.

73. Upon information and belief, on March 11, 2011, Respondent was not using in commerce Respondent's Claimed Mark in connection with "capri pants."

ANSWER: Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent

intended and intends to use the NORTH trademark on all further goods listed. Respondent denies any further allegations of paragraph 73.

74. Upon information and belief, on March 11, 2011, Respondent was not using in commerce Respondent's Claimed Mark in connection with "cargo pants."

ANSWER: Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed. Respondent denies any further allegations of paragraph 74.

75. Upon information and belief, on March 11, 2011, Respondent was not using in commerce Respondent's Claimed Mark in connection with "dress shirts."

ANSWER: Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed. Respondent denies any further allegations of paragraph 75.

76. Upon information and belief, on March 11, 2011, Respondent was not using in commerce Respondent's Claimed Mark in connection with "fleece vests."

ANSWER: Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed. Respondent denies any further allegations of paragraph 76.

77. Upon information and belief, on March 11, 2011, Respondent was not using in commerce Respondent's Claimed Mark in connection with "knit shirts."

ANSWER: Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed. Respondent denies any further allegations of paragraph 77.

78. Upon information and belief, on March 11, 2011, Respondent was not using in commerce Respondent's Claimed Mark in connection with "moisture-wicking sports shirts."

ANSWER: Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use is to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed. Respondent denies any further allegations of paragraph 78.

79. Upon information and belief, on March 11, 2011, Respondent was not using in commerce Respondent's Claimed Mark in connection with "rugby shirts."

ANSWER: Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use is to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed. Respondent denies any further allegations of paragraph 79.

80. Upon information and belief, on March 11, 2011, Respondent was not using in commerce Respondent's Claimed Mark in connection with "wind pants."

ANSWER: Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use is to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed. Respondent denies any further allegations of paragraph 80.

81. Upon information and belief, on March 11, 2011, Respondent was not using in commerce Respondent's Claimed Mark in connection with "wind shirts."

ANSWER: Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use is to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed. Respondent denies any further allegations of paragraph 81.

82. Upon information and belief, Respondent made material false statements to the U.S. Patent and Trademark Office when Respondent declared under oath on March 11, 2011, that he was using in commerce Respondent's Claimed Mark in connection with all the goods identified in the Statement of Use.

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 82, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed. Respondent denies the allegations of paragraph 82.

83. Upon information and belief, on March 11, 2011, Respondent made a material false statement to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms."

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 83, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed. Respondent denies the allegations of paragraph 83.

84. Upon information and belief, on March 11, 2011, Respondent made a material false statement to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "carpi pants."

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 84, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed. Respondent denies the allegations of paragraph 84.

85. Upon information and belief, on March 11, 2011, Respondent made a material false statement to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "cargo pants."

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 85, and accordingly denies. Pleadings of fraud made "on

information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed. Respondent denies the allegations of paragraph 85.

86. Upon information and belief, on March 11, 2011, Respondent made a material false statement to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "dress shirts."

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 86, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed. Respondent denies the allegations of paragraph 86.

87. Upon information and belief, on March 11, 2011, Respondent made a material false statement to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "fleece vests."

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 87, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3

(T.T.A.B, Oct. 22, 2009)(opinion attached). Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed. Respondent denies the allegations of paragraph 87.

88. Upon information and belief, on March 11, 2011, Respondent made a material false statement to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "knit shirts."

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 88, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed. Respondent denies the allegations of paragraph 88.

89. Upon information and belief, on March 11, 2011, Respondent made a material false statement to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "moisture-wicking sports shirts."

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 89, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use

was to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed. Respondent denies the allegations of paragraph 89.

90. Upon information and belief, on March 11, 2011, Respondent made a material false statement to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "rugby shirts."

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 90, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed. Respondent denies the allegations of paragraph 90.

91. Upon information and belief, on March 11, 2011, Respondent made a material false statement to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "wind pants."

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 91, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class

25. Respondent intended and intends to use the NORTH trademark on all further goods listed.

Respondent denies the allegations of paragraph 91.

92. Upon information and belief, on March 11, 2011, Respondent made a material false statement to the U.S. Patent and Trademark Office when Respondent declared under oath that he was using Respondent's Claimed Mark in commerce in connection with "wind shirts."

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 92, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed.

Respondent denies the allegations of paragraph 92.

93. Respondent's false statements are material because the U.S. Patent and Trademark Office detrimentally relied on Respondent's false statements on March 11, 2011, that Respondent's Claimed Mark was being used in commerce in connection with all the goods identified in the Statement of Use for Application Serial No. 77/789,289, as of March 11, 2011, and thereby issued Reg. No. 3,962,466.

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 93, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class

25. Respondent intended and intends to use the NORTH trademark on all further goods listed.

Respondent denies the allegations of paragraph 93.

94. Upon information and belief, Respondent knew on March 11, 2011, that he was not using Respondent's Claimed Mark in commerce in connection with the goods identified in the Statement of Use for Application Serial No. 77.789,289.

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 94, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed.

Respondent denies the allegations of paragraph 94.

95. Upon information and belief, Respondent knew on March 11, 2011, that he was not using Respondent's Claimed Mark in commerce in connection with the goods identified in the Statement of Use for Application Serial No. 77.789,289, and Respondent made the aforementioned material false statements with an intent to deceive the U.S. Patent and Trademark Office.

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 95, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class

25. Respondent intended and intends to use the NORTH trademark on all further goods listed. Respondent denies the allegations of paragraph 95.

96. Upon information and belief, Respondent knowingly made false and material representations of fact in connection with Respondent's Claimed Mark and fraudulently procured registration of Respondent's Claimed Mark within the meaning of Section 14 of the Lanham Act, 15 U.S.C. § 1064, and therefore U.S. Registration No. 3,962,466 should be cancelled.

ANSWER: Respondent lacks knowledge or information sufficient to form a belief about the truth of the allegations of paragraph 96, and accordingly denies. Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Asian and Western Classics B.V. v. Lynne Selkow* at p. 3 (T.T.A.B, Oct. 22, 2009)(opinion attached). Respondent admits that Respondent filed, *pro se*, a Statement of Use on March 11, 2011 in the manner that Respondent understood a Statement of Use was to be filed, as Respondent was using the NORTH trademark on goods in International Class 25. Respondent intended and intends to use the NORTH trademark on all further goods listed. Respondent denies the allegations of paragraph 96.

AFFIRMATIVE DEFENSES

Registrant asserts that the following affirmative defenses bar Petitioner's requested relief in its Petition for Cancellation:

1. Petitioner's Petition for Cancellation fails to state any basis under the Lanham Act to sustain a cancellation of Registrant's registered marks.
2. Petitioner's Petition fails to state with any specificity the allegations of fraud as required by this tribunal.
3. Petitioner is barred from seeking cancellation of the registrant's trademarks under the doctrines of laches, estoppel, waiver, and unclean hands.
4. Petitioner has acquiesced in registrant's adoption, registration, and use of the marks that are the subject of the petition for cancellation.

WHEREFORE, for at least the reasons stated above, Registrant respectfully prays that:

- A. The Board refuse to sustain the Petition for Cancellation;
- B. The Board find that there is no basis in fact to support the Petition for Cancellation;
- C. The Board dismiss this Petition, with prejudice; and
- D. The Board grants such other and further relief as may be appropriate.

Dated: 16 September 2016

RYAN KROMHOLZ & MANION, S.C.

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Attorneys for Respondent

**THIS OPINION IS
A PRECEDENT OF
THE T.T.A.B.**

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

Goodman

Mailed: October 22, 2009

Cancellation No. 92048821

Asian and Western Classics
B.V.

v.

Lynne Selkow

Before Walters, Zervas and Wellington, Administrative
Trademark Judges.

By the Board:

This case now comes up on petitioner's motion, filed May 15, 2009, for summary judgment on its fraud claim as set forth in its amended petition to cancel. Specifically, petitioner's motion argues that there is no genuine issue that "there was no use of the mark on some of the goods [bracelets] set forth in the registration" when respondent filed her Section 8 and 15 declaration. The motion is fully briefed.

A decision on summary judgment necessarily requires a review of the operative pleading in this case, filed on July 17, 2008 and accepted by the Board on December 22, 2008. In view of the recent decision of *In re Bose Corp.*, 580 F.3d

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1240, 91 USPQ2d 1938 (Fed. Cir. 2009), we find the fraud claim insufficiently pleaded.¹

In petitioning to cancel on the ground of fraud, a petitioner must allege the elements of fraud with particularity in accordance with Fed. R. Civ. P. 9(b), made applicable to Board proceedings by Trademark Rule 2.116(a). Under Rule 9(b), together with Fed. R. Civ. P. 11 and USPTO Rule 11.18, "the pleadings [must] contain explicit rather than implied expression of the circumstances constituting fraud." *King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801, 803 (CCPA 1981). See also Wright & Miller, *Federal Practice and Procedure*: 5A § 1296

¹ Petitioner alleges the following with regard to the fraud claim:

3. Petitioner is informed and believes that Selkow did not have bona fide use in commerce of the KL Design Mark at either the time the application for registration was filed or the date of the registration.
4. Petitioner is informed and believes that despite not having any bona fide use of the mark in commerce, Selkow submitted false statements to the trademark office attesting to such use when she filed her application for registration. Selkow knew or should have known that the statements were false, and thus the registration was obtained fraudulently and should be cancelled.
5. Petitioner is also informed and believes that at the time Selkow filed her Declaration under Section 8&15, she did not have bona fide use of the KL Design Mark in commerce.
6. Petitioner is informed and believes that despite not having any bona fide use of the mark in commerce, Selkow submitted false statements to the trademark office attesting to such use when she filed her Declaration under Sections 8&15. Selkow knew or should have known that the statements were false, and thus, the Declaration was submitted fraudulently, and the registration should be cancelled.

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n. 11 (2004) (citing cases that discuss purposes of the Rule 9(b) heightened pleading standard to include providing notice, weeding out baseless claims, preventing fishing expeditions and fraud actions in which all facts are learned after discovery, and serving the goals of Rule 11).

Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are insufficient. *Exergen Corp. v. Wal-Mart Stores Inc.*, 91 USPQ2d 1656, 1670 (Fed. Cir. 2009) and cases cited therein (discussing when pleading on information and belief under Fed. R. Civ. P. 9(b) is permitted); see also *In Re Bose Corp.*, 91 USPQ2d at 1938. Additionally, under USPTO Rule 11.18, the factual basis for a pleading requires either that the pleader know of facts that support the pleading or that evidence showing the factual basis is "likely" to be obtained after a reasonable opportunity for discovery or investigation. Allegations based solely on information and belief raise only the mere possibility that such evidence may be uncovered and do not constitute pleading of fraud with particularity. Thus, to satisfy Rule 9(b), any allegations based on "information and belief" must be accompanied by a statement of facts upon which the belief is founded. See *Exergen Corp.*, 91 USPQ2d at 1670 n.7, citing *Kowal v. MCI Commc'n Corp.*, 16 F.3d 1271, 1279 n.3 (D.C. Cir. 1994) "('[P]leadings on

information and belief [under Rule 9(b)] require an allegation that the necessary information lies within the defendant's control, and ... such allegations must also be accompanied by a statement of the facts upon which the allegations are based')."

In this case, petitioner's allegations in Paragraphs 4 and 6 of the amended petition to cancel regarding respondent's alleged false statements to the Office are based solely upon information and belief. These allegations fail to meet the Fed. R. Civ. P. 9(b) requirements as they are unsupported by any statement of facts providing the information upon which petitioner relies or the belief upon which the allegation is founded (i.e., known information giving rise to petitioner's stated belief, or a statement regarding evidence that is likely to be discovered that would support a claim of fraud).² *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1287 (TTAB 2008) (finding the proposed amended pleading insufficient in part under Fed. R. Civ. P. 9(b) because the false statements that purportedly induced the Office to allow registration were not set forth with particularity). See also Wright &

² Although paragraphs 3 and 5 of the fraud claim assert lack of bona fide use in commerce based on information and belief, the necessary supplementary factual information on which these allegations are based is provided in paragraphs 8, 9 and 10.

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Miller, *supra*, § 1298 (discussing particularity requirement of Fed. R. Civ. P. 9(b)).

A pleading of fraud on the USPTO must also include an allegation of intent. *In re Bose*, 91 USPQ2d at 1939-1940. Moreover, although Rule 9(b) allows that intent may be alleged generally, the pleadings must allege sufficient underlying facts from which a court may reasonably infer that a party acted with the requisite state of mind. *Exergen Corp.*, 91 USPQ2d at 1667, n.4. Pleadings of fraud which rest solely on allegations that the trademark applicant or registrant made material representations of fact in connection with its application or registration which it "knew or should have known" to be false or misleading are an insufficient pleading of fraud because it implies mere negligence and negligence is not sufficient to infer fraud or dishonesty. *In re Bose*, 91 USPQ2d at 1940, quoting *Symbol Techs., Inc. v. Opticon, Inc.*, 935 F.2d 1569, 1582 (Fed. Cir. 1991). Thus under *Bose*, intent is a specific element of a fraud claim and an allegation that a declarant "should have known" a material statement was false does not make out a proper pleading. See also *Media Online*, 88 USPQ2d at 1287 (finding proposed amended pleading insufficient in part because the pleading lacked allegations of scienter); *Crown Wallcovering Corp. v. The Wall Paper Mfrs. Ltd.*, 188 USPQ 141, 144 (TTAB 1975) and cases cited

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therein ("in order to state a claim upon which relief can be granted on the ground of fraud, it must be asserted that the false statements complained of were made willfully in bad faith with the intent to obtain that to which the party making the statements would not otherwise have been entitled").

Petitioner's allegations in Paragraphs 4 and 6 of the amended petition to cancel which state that "registrant knew or should have known..." are insufficient to infer respondent's intent to commit fraud on the USPTO.

In view thereof, petitioner's fraud claim is insufficient.

Because petitioner's fraud claim was not properly pleaded and is insufficient to state a claim, the motion for summary judgment is deemed moot. *Intermed Communications, Inc. v. Chaney*, 197 USPQ 501, 503 n. 2 (TTAB 1977) ("If a claim has not been properly pleaded, one cannot obtain summary judgment thereon"). *See also Consolidated Foods Corporation v. Berkshire Handkerchief Co., Inc.*, 229 USPQ 619, 621 (TTAB 1986) (The rule that only properly pleaded issues may be the subject of a grant of summary judgment "is especially important where the asserted ground for summary judgment is fraud since in pleading fraud, 'the circumstances . . . shall be stated with particularity.' Fed. R. Civ. P. 9(b)").

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We note in any event, that even if we were to consider petitioner's motion for summary judgment on the fraud claim on its merits, the motion would have to be denied because genuine issues remain at least with respect to respondent's intent to commit fraud on the USPTO. A party making a fraud claim is under a heavy burden because fraud must be "proven 'to the hilt' by clear and convincing evidence," leaving nothing to speculation, conjecture, or surmise; any doubt must be resolved against the party making the claim. *Smith International, Inc. v. Olin Corp.*, 209 USPQ 1033, 1043-1044 (TTAB 1981). The factual question of intent is particularly unsuited to disposition on summary judgment. *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1299 (Fed. Cir. 1991).

Petitioner is allowed until TWENTY DAYS from the mailing date of this order to file and serve an amended pleading properly alleging fraud, if petitioner has a sound basis for doing so, failing which, the existing allegations regarding fraud are hereby stricken.³

³ If petitioner repleads the fraud claim consistent with *Bose*, we note that the basis for its summary judgment motion (i.e., fraud based on non-use on one of the goods at the time of filing the Section 8 and 15 declaration) was narrower than the fraud claim petitioner attempted to assert in the operative amended petition to cancel (i.e., fraud based on lack of bona fide use of the mark in commerce at the time of filing the application and at the time of filing the Section 8 and 15 declaration). Therefore, petitioner may wish to narrow the basis for any prospective fraud claim it may replead.

Cancellation No. 92048821

If petitioner does file an amended pleading, respondent is allowed until FORTY days from the mailing date of this order to file its answer thereto.

Proceedings are resumed. Dates in this proceeding are reset as follows:

Discovery Closes	11/4/09
Plaintiff's Pretrial Disclosures	12/19/09
Plaintiff's 30-day Trial Period Ends	2/2/10
Defendant's Pretrial Disclosures	2/17/10
Defendant's 30-day Trial Period Ends	4/3/10
Plaintiff's Rebuttal Disclosures	4/18/10
Plaintiff's 15-day Rebuttal Period Ends	5/18/10

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the Respondent's Response to Petition for Cancellation has been served in its entirety on counsel of record for Petitioner on 16 September 2016 via U.S. Mail.

Attorney Stephen R. Baird
Attorney Wesley D. Anderson
Winthrop & Weinstine, P.A.
225 South Sixth Street Capella Tower, Suite 3500
Minneapolis, MN 55402

Dated: 16 September 2016

RYAN KROMHOLZ & MANION, S.C.

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