

ESTTA Tracking number: **ESTTA68064**

Filing date: **02/24/2006**

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

Proceeding	91168356
Party	Plaintiff Empire Iron Works, Inc.
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Date	02/24/2006
Attachments	Doc001.pdf (7 pages)

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

EMPIRE IRON WORKS, INC.,

Opposer,

Opposition No. 91168356

v.

Serial No. 78/456,640

EMPIRE HOME SERVICES, LLC,

Applicant.

Mark: EMPIRE TODAY

**OPPOSER'S RESPONSE IN OPPOSITION TO APPLICANT'S MOTION
TO AMEND**

In the event that Opposer's co-pending motion to suspend the present opposition proceeding is not granted, Opposer responds to Applicant's motion to amend and the Board's outstanding February 15, 2006 order as follows:

Opposer, Empire Iron Works, Inc. ("Empire") does not consent to the Applicant, Empire Home Services, LLC's ("EHS") proposed amendment, as Empire's Notice of Opposition is based upon fraud and other false statements set forth in EHS's original application and prosecution relating to the same issues which Applicant now seeks to correct as a mere mistake. More particularly, EHS should not be allowed to amend their application in an effort to erase or "diffuse" the present claim of fraud in the original filing given the fact that the Applicant is, in all reality, the party in the best position to know if they are actually using the applied for mark on the goods and services set forth in the application and when such putative use commenced.¹

¹ It is axiomatic that, but for the present Opposition, Applicant would not have brought the putative "mistake" to the attention of the United States Patent & Trademark Office and a registration would have issued with defective dates of first use and a defective services clause.

BACKGROUND

On January 3, 2006, Opposer Empire Iron Works, Inc. ("Empire") filed a Notice of Opposition with the Trademark Trial and Appeal Board ("Board"), opposing EHS's trademark application for EMPIRE TODAY (Ser. No. 78/456,640). Empire's Notice of Opposition alleged confusion under Section 2(d) and fraud based on EHS's failure to use the mark for the services identified in their original application. On February 9, 2006, EHS filed a motion to amend the original application based on what EHS claims was an "unintentional and inadvertent" error of submitting a false recitation of services clause in the original application.² Because this "error" is at the heart of Empire's claim of fraud, Empire respectfully requests that EHS's motion to amend be refused and that registration of the EMPIRE TODAY mark be refused as well. Alternatively, Opposer asks that Applicant's motion be deferred until after the opposition. Opposer submits that this is the process employed by the board in *J.E.M. International Inc. v. Happy Rompers Creations Corp.*, 74 USPQ2d 1526, 1530 (TTAB 2005).³

On February 15, 2006, the Board issued a response to Applicant's motion to amend, requesting that Empire notify the Board in writing as to whether or not they consent to Applicant's proposed amendment. Based on the issues presented in the opposition, Empire elects not to consent to Applicant's proposed amendments. Pursuant to 37 CFR 2.133 and TBMP 514.03, the Board has discretion over whether or not to grant an unconsented motion to amend. Empire respectfully requests that the board deny the Applicant's motion to amend or

² Opposer's counsel is also Defendant's counsel in the Federal district court and no such unintentional and inadvertent error has been cited to the Michigan Federal district court despite the fact that Applicant is now seeking to correct the same alleged "mistake" in all of its EMPIRE TODAY related filings. Opposer submits that this precise issue is the basis of its well-pleaded claim(s) in the Notice of Opposition and Applicant cannot avoid the necessary inquiry of fraud and the false statements by simply, and conveniently referring to these issues as a mistake now that they have been raised in the opposition.

³ Although nonprecedential, the rationale and reasoning behind *J.E.M. International* is highly indicative of the Board's most recent decisions on the issue of allowing such amendments in a case of alleged fraud.

defer determination on the motion to amend until final decision in the opposition matter. More importantly, Applicant's motion is devoid of any type of supporting brief as required under 37 C.F.R. 2.127, which states that a motion "shall embody or be accompanied by a brief."

Applicant has included no support and shown no good cause to warrant an amendment that allows the Applicant to erase the fact that they knew or should have known what services the applied for mark was actually in use with at the time of filing.

REMARKS

Fraud upon the Patent and Trademark Office constitutes the willful withholding of material information which, if disclosed to the Office would have resulted in the disallowance of the registration. *Crown Wallcovering Corp. v. Wall Paper Mfgs. Ltd.*, 188 USPQ 141 (TTAB 1975). Fraud is present when an applicant knew or should have known that the mark being applied for was not actually in use for certain services listed in the recitation of services clause. *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986). While not all incorrect statements amount to fraud, material misrepresentations of fact that were knowingly made will rise to the level of fraud on the Patent and Trademark office. *Medinol Ltd. v. Neuro Vasx Inc.*, 67 USPQ2d 1205 (TTAB 2003). In this regard, Applicant's false statements regarding the scope of its own services – wholly within their control – cannot be said to be a mere mistake since they were filed under oath. The present opposition has a claim to investigate whether these statements amount to fraud.

EHS's application for EMPIRE TODAY listed among other services, cabinetry, closet organizers, doors, fencing, roofing, furniture and home furnishings in the recitation of services clause. As stated in the motion to amend, the EMPIRE TODAY mark is not currently used for the services listed above. EHS's motion to amend cites to confusion between goods and services

currently offered and those which it planned to offer in the future. However, it is a legally insufficient excuse for an applicant to claim an intent to use a mark for services in the future, when those services are listed on an application under Section 1(a). *Medinol Ltd. v. Neuro Vasx Inc.*, 67 USPQ2d 1205 (TTAB 2003). EHS has complete control and knowledge of their current service offerings, rendering it a difficult claim that they did not know, nor should have known that they were not yet offering the services listed in the EMPIRE TODAY application.

If EHS's false recitation of services clause in the EMPIRE TODAY application rises to the level of fraud, their present motion to amend that recitation of services clause should be denied. Allowing EHS to amend the recitation of services clause would in essence allow them to erase the fraud they committed and continue to seek registration as well as deprive the Opposer from pursuing its prior claim in the opposition. Even if the amendment were allowed, "deletion of the goods upon which the mark has not yet been used does not remedy an alleged fraud upon the Office. If fraud can be shown in the procurement of a registration, the entire resulting registration is void." *Medinol Ltd. v. Neuro Vasx Inc.*, 67 USPQ2d 1205, 1208 (TTAB 2003). While Trademark Rules 2.133 and 2.173 allow the Board to grant a motion to amend, it has been common practice to reserve decision on unconsented to amendments until trial or final decision. *Id.* Moreover, since Opposer has already requested suspension of this proceeding in view of the pending civil litigation in the U.S. District Court for the Eastern District of Michigan, it is submitted that the Board should likewise reserve decision on the Applicant's motion to amend.

The recitation of services clause in EHS's application for EMPIRE TODAY lists services for thirteen different categories. In their motion to amend, they remove seven of those. Non-use of a mark for over half of the services listed in an Application under Section 1(a) can hardly be attributed to simple error. By signing the application, EHS agrees that willful false statements

may jeopardize the validity of the application or any resulting registration and may leave them subject to fine or imprisonment. "Statements made with such degree of solemnity clearly are -- or should be -- investigated thoroughly prior to signature and submission to the USPTO. *J.E.M. International Inc. v. Happy Rompers Creations Corp.*, 74 USPQ2d 1526, 1530 (TTAB 2005). In *J.E.M. International*, in accordance with Board practice, the Board deferred consideration of the respondent's proposed amendment until final decision. *Id.* at 1528. The respondent in *J.E.M. International* denied any intent to submit a fraudulent statement to the USPTO, however the appropriate inquiry is not into subjective intent, "but rather into the objective manifestations of that intent." *Id.* at 1529. In *J.E.M. International*, more than 2/3rds of the listed goods were not in use with the mark in question, an objective indication that the fraudulent statement was knowingly made. *Id.* at 1530. In the EMPIRE TODAY application, EHS was not using the mark for half of the services listed in the recitation of services clause, again indicating objective manifestations that EHS knew or should have known that the services clause was fraudulent.

Therefore, Opposer respectfully requests that the Applicant's motion to amend be denied or at least consideration by the Board be deferred until final decision on the Notice of Opposition.

Respectfully submitted,

Dobrusin & Thennisch, PC
Attorneys for Petitioner

Dated: February 21, 2006

By: 
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Mark: EMPIRE TODAY

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Certificate Of Service Under TBMP 113

I hereby certify that a true and correct copy of:


- 1) Opposer's Response in Opposition to Applicant's Motion to Amend

is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Counsel for the Applicant,

Peter N. Lobasso
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Respectfully submitted,

Dated: February 24, 2006

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