ESTTA Tracking number: **ESTTA285959**

Filing date: **05/26/2009**

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

Proceeding	91183857
Party	Plaintiff PREMIUM DENIM, LLC
Correspondence Address	Rod S. Berman Jeffer Mangels Butler & Marmaro LLP 1900 Avenue of the Stars, 7th Floor Los Angeles, CA 90067 UNITED STATES jzb@jmbm.com, trademarkdocket@jmbm.com
Submission	Opposition/Response to Motion
Filer's Name	Jessica C. Bromall
Filer's e-mail	trademarkdocket@jmbm.com
Signature	/jessica c. bromall/
Date	05/26/2009
Attachments	Opp to Motion to Amend.pdf (5 pages)(15529 bytes)

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

Premium Denim, LLC, Opposer, v. Paige Hamilton, United States individual, Applicant.	Opposition No. 91/183,857 Appl. Serial No.: 77/159,559 Mark: PAIGE HAMILTON DESIGN Published for Opposition: April 1, 2008 Atty. Ref. No.: 66884-0021

OPPOSER'S OPPOSITION TO MOTION TO AMEND APPLICATION

I. INTRODUCTION

Applicant Paige Hamilton's ("Applicant") Motion to Divide and Amend Subject Application (the "Motion") is a belated and ineffective attempt to cure the fraudulent statements made to the Trademark Office in the Application. The proposed amendment neither simplifies nor clarifies the issues before the Board as claimed by Applicant. Instead, the proposed amendment complicates the existing issues. Further, the proposed amendment introduces completely new issues despite the late stage in the proceeding and the fact that discovery has closed. In this way, and contrary to Applicant's assertion, the proposed amendment will result in significant prejudice to opposer Premium Denim, LLC ("Opposer"). Applicant's Motion should be denied.

II. THE PROPOSED AMENDMENT DOES NOT CLARIFY EXISTING ISSUES

Opposer opposes registration of Applicant's mark PAIGE HAMILTON DESIGN on two grounds: (1) likelihood of confusion with Opposer's PAIGE, PAIGE PREMIUM, and PAIGE

PREMIUM DENIM trademarks; and (2) fraud on the trademark office resulting from false claims of use.

The proposed amendment would merely distribute the existing goods, with the exception of jeans, between two applications for PAIGE HAMILTON DESIGN, rather than only one. This does nothing to resolve or clarify the question of likelihood of confusion raised by Opposer's Opposition. To the contrary, it complicates the resolution of the issues.

The proposed amendment also seeks to amend the filing basis of the application with respect to numerous goods from actual use to intent to use. Applicant claims that, due to a "misunderstanding regarding the nature of trademark applications," it filed its application based on actual use together with a declaration stating that it was using its mark in commerce in connection with all of the goods in the Application. It appears, however, that contrary to the declaration it submitted to the Trademark Office, Applicant was not using its mark in connection with all of the goods in its application.

Fraud on the Trademark Office exists where an applicant makes statements regarding use of a mark that it "knew or should have known" were false. *Medinol Ltd. v. Neuro VASX Inc.*, 67 U.S.P.Q.2d 1205, 1209-10. (T.T.A.B. 2003). Such fraud cannot be cured by amendment of an application's filing basis or deletion of the offending goods. *See id.* at 1208 ("Most importantly, however, 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.").

Applicant seeks to avoid a finding of fraud by amending the filing basis of its application from actual use to intent to use. Applicant may not, however, amend its application to avoid a fraud. *Hurley International LLC v. Volta*, 82 U.S.P.Q.2d 1339, 1346 (T.T.A.B. 2007)

("Although applicants could have originally based their application on their Australian registration under Section 44(e), the proposed amendment does not serve to cure a fraud that was committed.").

Further, neither mistake nor misunderstanding avoids the fraud. "The fact that applicants allegedly misunderstood a clear and unambiguous requirement for an application based on use . . . does not change our finding of fraud herein." *Id.* at 1345; *see also*, *Medinol*, 67 U.S.P.Q.2d at 1210 ("Respondent's explanation for the misstatement (which we accept as true) – that the inclusion of stents in the notice of allowance was "apparently overlooked" – does nothing to undercut the conclusion that respondent knew or should have known that its statement of use was materially incorrect.").

Applicant's proposed amendment is nothing more than an attempt to avoid rejection of its application due to its fraud. Because neither amendments after the fact nor Applicant's "misunderstanding" can cure Applicant's "fraud" if it is found to exist, Applicant's proposed amendment does nothing to clarify the issues in this matter and should be denied.

III. PROPOSED AMENDMENT INTRODUCES NEW ISSUES

Applicant's proposes to amend its filing basis to "intent to use." Such an amendment must be based on Applicant's *bona fide* intent to use the mark in commerce at the time the application was filed and at all times since.

Applicant's allegation that it has a *bona fide* intent to use raises, for the first time, an entirely new issue. Opposer has had no opportunity to conduct discovery regarding Applicant's alleged *bona fide* intent to use the mark with each of the goods in its application.

For this reason, contrary to Applicant's contention, Applicant's proposed amendment will prejudice Opposer. Accordingly, the Board should deny Applicant's Motion.

If, however, the Board decides to grant Applicant's Motion or to defer decision on Applicant's Motion, Opposer requests that the Board re-open the discovery period and reset the testimony and trial dates to allow Opposer to conduct discovery regarding Applicant's alleged *bona fide* intent to use.

IV. CONCLUSION

For all the foregoing reasons, Applicant's Motion should be denied. Should the Board either grant Applicant's Motion or defer decision on Applicant's Motion, Opposer requests that the Board re-open the discovery period to allow Opposer to conduct discovery regarding Applicant's alleged intent to use.

Dated: May 26, 2009

/S/ JESSICA C. BROMALL

Rod S. Berman
Jessica C. Bromall
JEFFER, MANGELS, BUTLER & MARMARO LLP
1900 Avenue of the Stars, Seventh Floor
Los Angeles, CA 90067
(310) 203-8080
E-mail: trademarkdocket@jmbm.com

Attorneys for Opposer Premium Denim, LLC

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing OPPOSER'S OPPOSITION TO MOTION TO AMEND APPLICATION has been sent by first class mail to the attorney of record for Applicant:

Scott W. Kelley (scott@klkpatentlaw.com)
Michael A. DiNardo (mike@klkpatentlaw.com)
Kelly Lowry & Kelley, LLP
6320 Canoga Ave. Suite 1650
Woodland Hills, California 91367-7704

Dated: May 26, 2009

_____

Jessica C. Bromall