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

Proceeding	91183857
Party	Plaintiff PREMIUM DENIM, LLC
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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:

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**OPPOSER'S OPPOSITION TO MOTION TO DISMISS CLAIM FOR FRAUD**

Opposer Premium Denim, LLC ("Opposer") hereby submits its Opposition to the Motion to Dismiss Opposer's Fraud Claim (the "Motion") filed by applicant Paige Hamilton ("Applicant").

**I. INTRODUCTION**

Applicant seeks dismissal of Opposer's claim for fraud - paragraphs 11-15 of the amended notice of opposition ("Amended Notice") - on the grounds that Opposer has failed to plead fraud with sufficient particularity. Applicant admits that Opposer has adequately alleged three of the four required elements of fraud. Applicant claims, however, that Opposer's claim must fail because its allegations relating to the fourth element of fraud - Applicant's intent to deceive the Trademark Office - is alleged on information and belief. Applicant's motion should be denied.

Opposer has adequately alleged Applicant's intent to deceive the Trademark Office. Further, Opposer's allegation of such intent on information and belief is proper because, here,

any additional information regarding Applicant's intent is within Applicant's exclusive control and Opposer has supported its allegation with specific factual allegations. Under these circumstances, Opposer's allegation on information and belief is sufficient to satisfy Federal Rule of Civil Procedure 9(b).

Additionally, paragraph 15 is not part of Opposer's claim for fraud and should not be dismissed. Paragraph 15 constitutes a separate claim that Applicant lacks the *bona fide* intent to use necessary to support an application under Section 1(b) of the Lanham Act. This is not a claim for fraud, but rather an allegation that Applicant's application is void *ab initio* because it fails to meet the requirements for an intent-to-use application. Therefore, paragraph 15 should not be dismissed.

## **II. PARAGRAPHS 11-14 ALLEGING FRAUD SHOULD NOT BE DISMISSED**

To allege fraud, Opposer must plead facts showing that: (1) Applicant made false material representations of fact to the Trademark Office; (2) the false representations were made in connection with Applicant's application for registration of a trademark; (3) the false misrepresentations were made knowingly; and (4) Applicant intended to deceive the Trademark Office. *In re Bose Corporation*, 580 F.3d 1240, 1243 (Fed. Cir. 2009).

Applicant admits that Opposer has adequately alleged the first three elements of fraud<sup>1</sup> and challenges only the adequacy of the allegations regarding the fourth element - Applicant's intent to deceive. Like Applicant's allegations regarding the first three elements, however, Opposer has adequately alleged intent to deceive the Trademark Office. Amended Notice, ¶ 14.

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<sup>1</sup> Opposer has alleged that Applicant has never used her mark on many of the goods identified in her application and that Applicant knew she never used her mark on many of the goods identified in her application. Amended Notice, ¶¶ 11 & 13. Opposer has also alleged that, notwithstanding the foregoing, Applicant executed a sworn statement to the contrary - claiming that she did in fact use the mark with all the goods identified in her application - and she submitted that sworn statement to the Trademark Office in connection with her application for registration. *Id.* at ¶ 13.

Applicant's principal contention is that Opposer's allegations of intent are necessarily inadequate because they are made on information and belief. Motion, p. 3. This is not the case.

First, intent - like malice, knowledge, and "other conditions of a person's mind" may be alleged generally, and need not be alleged with particularity. Fed. R. Civ. P. 9(b).

Further, Applicant's own authority makes clear that intent may be alleged on information and belief where, as here, "essential information lies uniquely within another party's control" so long as "the pleading sets forth the specific facts upon which the belief is reasonably based."

*Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1330 (Fed. Cir. 2009).

**A. Information Regarding Applicant's Intent is Uniquely Within Applicant's Control**

Here, information regarding Applicant's intent is within the exclusive control of Applicant. Applicant claims that Opposer should be able to allege additional facts regarding Applicant's intent because Opposer has been able to explore the issue of intent through discovery. However, this is not the case. Although Opposer has initiated discovery, it has not yet completed its discovery efforts. Specifically, Applicant objected to Opposer's interrogatories in their entirety and provided no responses. Similarly, Applicant has not yet produced documents in response to Opposer's request for production. This action was suspended just after Opposer received Applicant's discovery responses, and has been suspended for nearly the entire time since - first pending resolution of Applicant's amendment and now pending resolution of this motion. As a result, Opposer has not yet had an opportunity to meet and confer or move to compel further responses to its discovery requests. Such efforts will resume once proceedings resume following resolution of this motion.

Applicant also argues that, notwithstanding the fact that the information regarding Applicant's intent is uniquely within Applicant's control, Opposer's pleading is nonetheless

inadequate because Opposer did not specifically allege that such information is uniquely within Applicant's control. There is no such pleading requirement. As clearly stated in the authority relied on by Applicant, there is no requirement that Opposer *plead* that essential information is uniquely within Applicant's control. All that is required is that essential information actually *be* uniquely within Applicant's control. *Exergen Corp.*, 575 F.3d at 1330.

Further, that Applicant uniquely controls information regarding her own intent is so obvious that it need not be explicitly stated. To the extent Opposer was required to make such an allegation, the Board may simply infer the allegation from the rest of the facts alleged in the opposition. Finally, if necessary, Opposer is willing to amend its opposition to expressly allege that Applicant is a unique source of essential information regarding her own mental state.

**B. Opposer's Allegation of Intent to Deceive is Supported by Factual Allegations**

Opposer's allegation that Applicant intended to deceive the Trademark Office is supported by the other facts alleged in its Amended Notice.

Opposer's allegation on information and belief is supported by at least the following concrete factual allegations: (1) Applicant knew that she was not using her mark in connection with many of the goods in her application (Amended Notice, ¶ 13); (2) Applicant signed a declaration stating that she was using her mark in connection with all of the goods in her application (Amended Notice, ¶ 14); (3) Applicant submitted that declaration to the Trademark Office in order to obtain registration of her mark (Amended Notice, ¶ 12); and (4) Applicant made no effort to correct her representation to the Trademark Office until after Opposer initiated this proceeding (Amended Notice, ¶14).

The foregoing provide more than a sufficient basis for Opposer's allegation of Applicant's intent to deceive.

In light of the foregoing, Applicant's Motion should be denied.

**III. PARAGRAPH 15 ALLEGING LACK OF *BONA FIDE* INTENT SHOULD NOT BE DISMISSED**

Paragraph 15 is not part of Opposer's claim for fraud, is not properly included in this motion, and should not be dismissed. In Paragraph 15, Opposer alleges that Applicant is not entitled to registration because her application does not comply with the requirements of Section 1(b) of the Lanham Act - specifically, that Applicant lacks the *bona fide* intent to use necessary to support an application for registration.

The foregoing is a separate claim from the fraud claim alleged in paragraphs 11-14. It is not a claim for fraud and need not be pleaded with particularity. Rather, Opposer need only to allege facts that, if proven, show that it there exists a statutory ground negating Applicant's entitlement to registration. TBMP 3.09(c); *Young v. AGB Corp.*, 152 F.3d 1377, 1380 & n. 6 (Fed. Cir. 1998). Failure to comply with the requirements of Section 1 of the Lanham Act (15 U.S.C. § 1051(b)) constitutes a statutory ground negating Applicant's entitlement to registration. *Young*, 152 F.3d at 1380 & n. 6.

Here, Opposer has adequately alleged that Applicant lacks the *bona fide* intent to use necessary to support an application for registration under Section 1(b).

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**IV. CONCLUSION**

For all the foregoing reasons, Applicant's Motion should be denied. Should the Board grant Applicant's Motion, Opposer respectfully requests leave to submit an amended notice of opposition.

Dated: December 1, 2009

/S/ JESSICA C. BROMALL  
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**CERTIFICATE OF SERVICE**

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

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Dated: December 1, 2009

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