

Wolfson

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

Mailed: February 19, 2010

Opposition No. 91183857

Premium Denim, LLC

v.

Paige Hamilton

Before Quinn, Zervas and Cataldo,
Administrative Trademark Judges.

By the Board:

On May 1, 2008, opposer Premium Denim, LLC filed a notice of opposition against registration of the mark PAIGE HAMILTON DESIGN,¹ alleging ownership of prior registrations for the marks PAIGE, PAIGE PREMIUM DENIM, and PAIGE PREMIUM

¹ Serial No. 77159559, filed April 18, 2007 for "men's and women's accessories, namely, laptop carrying cases in the nature of laptop bags, eyeglasses, sunglasses; men's and women's accessories, namely, handbags, purses, pocketbooks, wallets, wristlets, tote bags, beach bags, travel bags, cosmetic bags sold empty, coin purses, luggage, backpacks, messenger bags" on the basis under Section 1(a) of applicant's claim of use in commerce as of March 8, 2007. Pursuant to applicant's request, the application was divided on August 5, 2009, and Serial No. 77977668 (child) was created. The following goods were moved from the parent to the child application: "suitcases, garment bags for travel, pet carriers, and umbrellas, men's and women's apparel, namely, shoes, sandals, boots, scarves, hats, gloves, mittens, belts, socks, tights, hosiery, leggings, tank tops, camisoles, tee shirts, pants, trousers, jackets, coats, sweaters, cardigans, dresses, skirts, shorts, loungewear, sleepwear, underwear, bras, lingerie, vests, coats, blouses, shirts," and the application was based on applicant's bona fide intent to use the mark in commerce under Section 1(b).

for clothing and related items.² As grounds for the opposition, opposer alleges a likelihood of confusion between the marks and that applicant committed fraud in the filing of her application. Applicant filed an answer denying the salient allegations of the complaint.

Following division of the application, opposer moved the Board for an order granting it leave to amend its fraud claim to properly assert fraud under the pleading standard recently set forth by the Federal Circuit in *In re Bose*, 580 F.2d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009).³ The fraud claim is intended to apply to both the parent and child applications.

In response, applicant filed a motion to dismiss opposer's amended fraud claim. Applicant does not contest opposer's motion to amend the notice of opposition to assert the claim, however; accordingly, the motion to amend is granted and the amended notice of opposition is considered the operative pleading herein. See Trademark Rule 2.127(a).

² Reg. No. 3308211 for the mark PAIGE for "satchels," registered October 9, 2007; Reg. No. 3301653 for the mark PAGE PREMIUM DENIM for "clothing, namely jeans, pants, overalls, skirts, dresses, shirts, t-shirts, vests, jackets, coats, underwear, loungewear, sleepwear, scarves, belts, all of the foregoing of denim; headwear, namely hats, caps, and visors, all of the foregoing of denim," registered October 2, 2007; Reg. No. 3191044 for the mark PAIGE PREMIUM for "clothing, namely jeans, pants, short pants, skirts, t-shirts, vests and jackets," registered January 2, 2007.

³ As noted by the Board in its September 23, 2009 order, the original fraud claim is insufficient in light of the decision in *In re Bose*.

We now turn to applicant's motion to dismiss opposer's amended fraud claim. The motion is fully briefed. For the reasons stated below, we find opposer's amended fraud claim is still insufficient. However, opposer will be allowed one last opportunity to amend its claim.

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of the pleading. In order to withstand a motion to dismiss a claim of fraud, the alleged fraud must be pleaded with sufficient particularity. See Fed. R. Civ. P. 9(b). At the pleading stage, a plaintiff need allege facts which would, if proven, show that the applicant or registrant has willfully and fraudulently withheld from the Office material information which, if disclosed, would have resulted in the disallowance of the registration sought. See Fed. R. Civ. P. 9(b); *Woodstock's Enterprises Inc. (California) v. Woodstock's Enterprises Inc. (Oregon)*, 43 USPQ2d 1440, 1443 (TTAB 1997), *aff'd mem.*, 152 F.3d 942 (Fed. Cir. 1998).

In the case at hand, the fraud claim is set forth in paragraphs 11-14 of the amended notice of opposition, as follows: that applicant does not use, and has never used, its mark in connection with all of the goods in the application (paragraph 11); that applicant submitted a declaration to the Office in support of its application

claiming that it was using the mark on all of these goods (paragraph 12); that the declaration "contained material statements that were knowingly false" (paragraph 13); and that, on "information and belief," the false statements were made with the intent to deceive the Office (paragraph 14).

The crux of the parties' dispute relates to the sufficiency of the allegations in paragraph 14, which are based on opposer's "information and belief." "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." *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1479 (TTAB 2009). To satisfy Fed. R. Civ. P. 9(b), pleadings of fraud made on "information and belief" require allegations of "specific facts upon which the belief is reasonably based." *Asian and Western Classics*, 92 USPQ2d at 1479, citing *Exergen Corp. v. Wal-Mart Stores Inc.*, 91 USPQ2d 1656, 1670 (Fed. Cir. 2009).

Here, the only specific allegations of fact that have been made are that applicant stated in her declaration that she has made use on all the goods, while allegedly she has made no such use. Moreover, opposer's apparent basis for claiming that applicant has not used her mark in commerce is that she divided the application and amended the filing basis to assert bona fide intent to use the mark in commerce

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under Trademark Act § 1(b). These facts do not plausibly state or even suggest that applicant intended to deceive the Office by way of the division of the application.

Applicant's reasons for amending the basis of its child application and making the allegedly false statements that opposer implies are based thereon, may be the result of inadvertence or negligence, "and negligence is not sufficient to infer fraud or dishonesty." *Asian and Western*, 92 USPQ2d at 1479.

Accordingly, opposer's motion to amend the notice of opposition is denied without prejudice. Opposer is allowed until TWENTY DAYS from the mailing date of this order to further amend its fraud claim to sufficiently allege fraud, failing which the claim will be dismissed with prejudice and this case shall proceed solely on the ground of priority and likelihood of confusion.

Proceedings are otherwise herein suspended.