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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:

April 1, 2008

Atty. Ref. No.: 66884-0021

OPPOSER'S RESPONSE TO BOARD ORDER DATED FEBRUARY 19 & REQUEST
FOR RECONSIDERATION OF DISMISSAL WITHOUT PREJUDICE

Opposer Premium Denim, LLC ("Opposer") hereby responds to the Board's Order dated February 19, 2010.

I. PARAGRAPH 15 SHOULD NOT BE DISMISSED

The Board's Order is unclear. By its explicit terms, it is limited to the claim for fraud alleged in Paragraphs 11 through 14. However, in closing the Board states that the case will move forward solely on the ground of likelihood of confusion and priority. Opposer submits that, even if the claim for fraud is dismissed, Paragraph 15 should remain and the claim stated therein should proceed.

Paragraph 15 is not part of Opposer's claim for fraud. 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. This claim is separate from

both the claim of fraud and the claim for likelihood of confusion and priority. This claim was not the subject of any motion to dismiss, is adequately alleged, and should proceed.

Opposer also notes that it has not yet had an opportunity to conduct discovery on this claim, as this proceeding has been suspended almost the entire time since applicant Paige Hamilton ("Applicant") amended her application to claim a *bona fide* intent to use.

Accordingly, Opposer respectfully requests that this claim proceed and that the Board, in resetting its dates, allow time for Opposer to complete discovery relevant to this claim.

II. FRAUD CLAIM SHOULD NOT BE DISMISSED WITH PREJUDICE

The Board has again deemed Opposer's allegations insufficient to state a claim for fraud on the Trademark Office. Opposer respectfully disagrees with the Board's conclusion. Opposer has alleged specific facts showing that: (1) Applicant made false statements to the Trademark Office; (2) the false statements were material; and (3) the false statements were made in connection with Applicant's application for registration of a trademark. Amended Notice of Opposition, ¶¶ 11-14.

In fact, the Board agreed that all elements of the claim were adequately plead except for Applicant's intent to defraud the Board. Opposer notes that intent may be alleged generally. Fed. R. Civ. P., 9(b). Opposer also notes that intent may be alleged on information and belief where, as here, "essential information lies uniquely within another party's control." *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1330 (Fed. Cir. 2009).

Here, Applicant has exclusive control of evidence regarding her mental state. Although Opposer has initiated discovery, it has not completed its discovery efforts. Applicant objected to Opposer's interrogatories in their entirety and provided no responses. Applicant also 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 then pending resolution of the motion to dismiss and potential amendment. Thus, Opposer has not yet had an opportunity to meet and confer or move to compel further responses to its discovery requests.

Until Opposer completes its discovery, it is unable to allege any additional facts. Nonetheless, it may discover additional facts as it completes the discovery process, at which time, it could move to further amend the Notice of Opposition to re-allege its claim for fraud. Since discovery is incomplete and facts supporting the claim for fraud may still be discovered, dismissal of Opposer's claim with prejudice is believed to be inappropriate.

In light of the foregoing, Opposer respectfully requests that the Board reconsider its decision to dismiss Opposer's claim for fraud with prejudice. If the Board continues to believe dismissal is appropriate, Opposer requests that any dismissal be without prejudice.

Dated: March 11, 2010

/s/ JESSICA C. BROMALL
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CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing RESPONSE TO BOARD ORDER
DATED FEBRUARY 19, 2010 has been sent by first class mail to the attorney of record for

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Dated: March 11, 2010

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