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

Baxley

Mailed: June 25, 2009

Opposition No. **91189412**

Esprit IP Limited

v.

Mellbeck Ltd

Before Seeherman, Grendel and Kuhlke,
Administrative Trademark Judges

By the Board:

Mellbeck Ltd ("applicant") filed an application to register the mark EDZ and design in the following form,

for more than fifty different types of clothing items in International Class 25.[1]

[1] Application Serial No. 77518568, filed July 10, 2008, based on an assertion of use in commerce under Trademark Act Section 1(a), 15 U.S.C. Section 1051(a), with a claim of priority under Trademark Act Section 44(e), 15 U.S.C. Section 1126(e), based on United Kingdom Registration No. 2457518. The application alleges January 15, 1997 as the date of first use anywhere and date of first use in commerce. The identification of goods in the application is "Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Belts; Bibs not of cloth or paper; Caps; Children's and infants' cloth bibs; Children's cloth eating bibs; Cloth bibs; Cloth bibs for adult diners; Cloth bibs for use by senior citizens or physically- or mentally-challenged persons; Cloth diapers; Clothing for wear in judo practices; Clothing for wear in wrestling games; Clothing, namely, arm warmers; Clothing, namely, folk costumes; Clothing,

Espirit IP Limited ("opposer") filed a notice of opposition to registration of applicant's mark on grounds of fraud and likelihood of confusion. In its answer, applicant, appearing *pro se*, admitted, among other things, the following allegations of the notice of opposition:

> 11. The application for the [involved] Mark covers well over 50 individual items of apparel products, including, but not limited to shirts, pants, caps, outerwear and hand-warmers.
>
> ...
>
> 17. Upon information and belief, applicant does not sell in the US all of the apparel products listed in the application for the [involved] Mark.

In addition, in response to paragraph 21 of the notice of opposition, wherein opposer alleges that "at the time of filing its application, Applicant was not, and as of the date of this Notice of Opposition, Applicant is not, using in US commerce the [involved] mark on each and every product

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namely, hand-warmers; Clothing, namely, khakis; Clothing, namely, knee warmers; Clothing, namely, neck tubes; Clothing, namely, throbes (sic); Clothing, namely, wrap-arounds; Corsets; Dusters; Foulards; Hoods; Infant and toddler one piece clothing; Infant cloth diapers; Jerseys; Leather belts; Mantles; Mufflers; Non-disposable cloth training pants; Paper hats for use as clothing items; Parts of clothing, namely, gussets for tights, gussets for stockings, gussets for bathing suits, gussets for underwear, gussets for leotards and gussets for footlets; Perspiration absorbent underwear clothing; Shifts; Short sets; Shoulder wraps; Swaddling clothes; Ties; Tops; Travel clothing contained in a package comprising reversible jackets, pants, skirts, tops and a belt or scarf; Triathlon clothing, namely, triathlon tights, triathlon shorts, triathlon singlets, triathlon shirts, triathlon suits; Underarm clothing shields; Wearable garments and clothing, namely, shirts; Wraps."

listed in its application, in violation of [Trademark Act Section 1(a), 15 U.S.C. Section 1051(a)]," applicant "denies that they have knowingly filed their application in anything other than the correct manner."

This case now comes up for consideration of: 1) opposer's motion (filed May 13, 2009) for judgment on the pleadings on its pleaded fraud claim; and 2) applicant's motion (filed May 27, 2009, concurrently with its brief in opposition to opposer's motion) to amend the identification of goods in its involved application Serial No. 77518568. The motion for judgment on the pleadings has been fully briefed. Opposer, in its reply brief in support of the motion for judgment on the pleadings, includes arguments in opposition to applicant's motion to amend.

We first consider applicant's motion to amend. By such motion, applicant seeks to amend the identification of goods to "Clothing, namely, fleece jackets, t-shirts, ski masks, helmet liners, neck warmers, socks, thermal underwear, windcheaters, base-layers, thermal gloves, undersuits, long-johns, sweaters, [and] hats."

The proposed amendment of the identification of goods is unacceptable because it designates goods that are outside of the scope of the identification as set forth in the application as filed. Trademark Rule 2.71(a); TMEP Section 1402.06 (5th ed. 2007). In particular, the only item in the

identification of goods as filed that is included with identical wording to the proposed amended identification of goods is "hats." The proposed amended identification of goods otherwise is an impermissible enlargement of goods. For example, the proposed identification "thermal underwear" would include more or different items from the original identification "perspiration absorbent underwear clothing." In view thereof, applicant's motion to amend the identification of goods is denied.[2]

We turn next to the motion for judgment on the pleadings. Opposer contends that applicant admitted that it "does not sell in the US" all the goods listed in the application; and that, because applicant's director signed the declaration in the involved application, and thus averred that all statements in the application were true, the Board should enter judgment on the pleadings on the pleaded fraud claim.

In response thereto and in support of the motion to amend, applicant "accept[s]" that most of the goods identified in the application "were listed in error;" and notes that it concurrently filed its motion to amend the identification of goods to delete the erroneously listed

[2] Applicant should also note that a defendant in a Board *inter partes* proceeding cannot overcome a fraud claim by amending its application to delete goods from the identification. See *Medinol Ltd. v. Neuro Vasx Inc.*, 67 USPQ2d 1205 (TTAB 2003).

goods. Applicant further contends that it is not represented by an attorney and has no prior experience in United States trademark matters; and that it would have derived no benefit from the inclusion of the additional goods. Accordingly, applicant asks that the Board deny opposer's motion, grant its motion to amend, and allow this case to proceed on the merits.

In reply, opposer contends that applicant knew or should have known that it was not using its mark in connection with all of the goods identified in its application.

A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice.[3] See *The Scotch Whisky Association v. United States Distilled Products Co.*, 13 USPQ2d 1711, 1714 n.1 (TTAB 1989), *recon. denied*, 17 USPQ2d 1240 (TTAB 1990), dismissed, 18 USPQ2d 1391 (TTAB 1991), *rev'd on other grounds*, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991).

[3] Opposer relies on matters outside of the pleadings in support of its motion. We elect to exclude such matters and thus decline to convert opposer's motion to one for summary judgment. See *Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478, 1479 n.2 (TTAB 1998); TBMP Section 504.03 (2d ed. rev. 2004). We do this because opposer filed its motion for judgment on the pleadings prior to the deadline for the parties' discovery conference and did not indicate therein that such discovery conference had taken place and that opposer has served its initial disclosures. Except in limited circumstances not present here, an opposer may not file a motion for summary judgment until it has served its initial disclosures. See Trademark Rule 2.127(e)(1).

For purposes of the motion, all well-pleaded factual allegations of the nonmoving party must be accepted as true, while those allegations of the moving party which have been denied (or which are taken as denied, pursuant to Fed. R. Civ. P. 8(d), because no responsive pleading thereto is required or permitted) are deemed false. Conclusions of law are not taken as admitted. See *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992). All reasonable inferences from the pleadings are drawn in favor of the nonmoving party. See *Int'l Telephone and Telegraph Corp. v. Int'l Mobile Machines Corp.*, 218 USPQ 1024, 1026 (TTAB 1983); and Wright & Miller, *Federal Practice and Procedure: Civil 2d* § 1367 et seq. (1990).

As an initial matter, applicant admitted in its answer that opposer owns its pleaded registrations and has continuously used its marks since 2004. Thus, opposer's standing, that is, its real interest in this proceeding, has been established. See *Lipton Industries Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Regarding opposer's pleaded fraud claim, fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes false, material representations of fact in connection with an application to register. See *Torres v. Cantine Torresella S.r.l.*, 808 F.2d

46, 1 USPQ2d 1483 (Fed. Cir. 1986). Statements regarding the use in commerce of the mark on identified goods and/or services are material to issuance of a registration.[4] See *Hachette Filipacchi Presse v. Elle Belle LLC,* 85 USPQ2d 1090 (TTAB 2007) (fraud found based on applicant's allegation of use of its mark for a wide variety of clothing items for men, women and children when mark had not been used on any identified items for men or children and only on a limited number of items for women); *Medinol Ltd. v. Neuro Vasx Inc., supra.*

Applicant admits that it filed its application under Trademark Act Section 1(a), 15 U.S.C. Section 1051(a) and that the mark is not in use on all of the more than fifty goods identified in the application. Applicant further clarifies this admission by its statement in response to the motion for judgment on the pleadings that the identification of goods in the application was set forth in error. In view of such error, applicant seeks to amend the identification to a fourteen-item identification "that should have been

[4] Trademark Act Section 45, 15 U.S.C. Section 1127, states in relevant part that

> ... a mark shall be deemed to be in use in commerce ... on goods when ... it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and ... the goods are sold or transported in commerce [that Congress may regulate].

listed at the outset," but which has only a single item in common with the identification of goods set forth in the application, i.e., "hats." By setting forth an identification of goods for more than fifty goods, when applicant was not using the mark on all of these goods, and indeed may have been actually using the mark only on one of those identified goods, applicant made a material misrepresentation of fact that the U.S. Patent and Trademark Office relied upon in determining applicant's right to a registration.[5] The fact that applicant is a foreign entity that is representing itself without previous experience in United States trademark procedure cannot avoid a finding of fraud. See *Hurley International LLC v. Volta*, 82 USPQ2d 1339 (TTAB 2007). Further, inasmuch as applicant knew or should have known that it was not using the involved mark on the vast majority of the identified goods, applicant's assertion that the identification of goods was set forth in error does not avoid a finding of fraud. See *Torres v. Cantine Torresella S.r.l.*, *supra; Herbaceuticals Inc. v. Xel Herbaceuticals Inc.*, 86 USPQ2d 1572 (TTAB 2008).

[5] Applicant's assertion that it would have derived no benefit from by the inclusion of the erroneous goods in the identification is incorrect. Applicant would have been able to obtain improperly a registration of its trademark for goods on which it was not using its mark. See *Medinol Ltd. v. Neuro Vasx Inc., supra.*

Based on the allegations that applicant has admitted, we conclude that opposer is entitled to entry of judgment on the fraud claim as a matter of law. In view thereof, opposer's motion for judgment on the pleadings on its pleaded fraud claim is granted, the opposition is sustained on the fraud claim only, and registration to applicant is refused.