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Filing date: **09/21/2009**

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

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|------------------------|--|
| Proceeding | 91189980 |
| Party | Defendant The Modern Group, Ltd. |
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| Submission | Other Motions/Papers |
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| Date | 09/21/2009 |
| Attachments | supp reply support mtd.pdf (11 pages)(268042 bytes) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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|------------------------------|---|--------------------------------|
| <hr/> | § | |
| NATIONAL OILWELL VARCO, L.P. | § | |
| | § | |
| Opposer, | § | Opposition No. 91189980 |
| | § | Serial No. 77/462,382 |
| v. | § | Mark: CONTINENTAL EMSCO |
| | § | |
| THE MODERN GROUP, LTD. | § | |
| | § | |
| Applicant. | § | |
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**SUPPLEMENT TO APPLICANT’S REPLY IN
SUPPORT OF ITS MOTION TO DISMISS**

Applicant, The Modern Group, Ltd., filed its Reply in Support of its Motion to Dismiss on Wednesday, September 16, 2009. The Trademark Trial and Appeal Board (the “Board”) subsequently issued an order in Opposition No. 91190040 (“Order”), attached as Exhibit A, which is directly on point in the instant opposition and also supports Applicant’s Motion to Dismiss. *Societe Cooperative Vigneronne Des Grandes Caves Richon-Lezion and Zicron-Jacob Ltd. v. Albrecht-Piazza, LLC*, Opposition No. 91190040 (T.T.A.B. September 20, 2009) (order dismissing counterclaim). Relying on Federal Circuit decision *In Re Bose Corporation* No. 2008-1448, slip op. (Fed. Cir. Aug. 31, 2009), this Order specifies that the Board will not accept pleadings of fraud made on “information and belief” when there is no indication that the Pleader knew any specific facts surrounding such activity. Additionally, the Order states that allegations that the Declarant “knew or should have known” the declaration to be false is insufficient to plead fraud. Order p. 5. Opposer based its facts surrounding the alleged fraud on “information and belief.” Notice of Opposition ¶ 11. Opposer also alleges that Applicant “knew or should of

known” of the alleged falsity set forth in Applicant’s Declaration. Notice of Opposition ¶¶ 12-13. Opposer’s pleadings of fraud are undoubtedly deficient. In conjunction with Applicant’s previous arguments, this Order further illustrates the fact that Opposer’s fraud allegations are insufficient to state a claim of fraud and must be dismissed.

DATED: September 21, 2009

Respectfully submitted,


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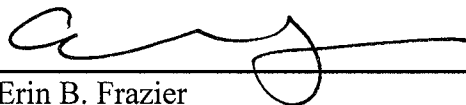
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**ATTORNEYS FOR THE MODERN
GROUP, LTD.**

CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing SUPPLEMENT TO APPLICANT'S REPLY IN SUPPORT OF ITS MOTION TO DISMISS and associated Exhibit A were served by First Class Mail, postage prepaid, on September 21, 2009, upon Opposer's Attorney at the address below:

Gregory L. Maag
Conley Rose, P.C.
P.O. Box 3267
Houston, TX 77253-3267
UNITED STATES



Erin B. Frazier

EXHIBIT A

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

DUNN

Mailed: September 20, 2009

Opposition No. 91190040

SOCIETE COOPERATIVE VIGNERONNE
DES GRANDES CAVES RICHON-LE-
ZION AND ZICRON-JACOB LTD.

v.

ALBRECHT-PIAZZA, LLC

Elizabeth A. Dunn, Attorney (571-272-4267):

This case comes up on opposer's motion, filed July 31, 2009, to amend the notice of opposition. The motion is contested, and the Board held a phone hearing on September 17, 2009. The participants were Douglas Wolf, attorney for opposer, Peter Vergie, attorney for applicant, and Elizabeth Dunn, attorney for the Board.

BACKGROUND

On May 4, 2009, Societe Cooperative Vigneronne des Grandes Caves Richon-Le-Zion and Zicron-Jacob Ltd. filed a notice of opposition to registration of the mark MT. CARMEL VINEYARDS for wines, custom production of wine for others,

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and vineyards and winery services, namely, the cultivation of grapes for others. The notice of opposition lists the grounds for opposition as priority and likelihood of confusion with opposer's mark CARMEL for wine, brandy, vodka, gin and liqueurs, the subject of common law rights and pleaded Registration No. 1362300, dilution, and false suggestion of a connection.

Applicant filed an answer which denied the salient allegations of the notice of opposition and brought a counterclaim to cancel the pleaded registration on the ground of fraud. With its answer to the counterclaim opposer filed the instant motion to amend the notice of opposition to also plead opposer's Registration No. 3046664 for the mark CARMEL WINERY (WINERY disclaimed) for wines.

DECISION: MOTION TO AMEND IS GRANTED

In deciding a motion for leave to amend under Fed. R. Civ. P. 15(a), the Board must consider whether entry of the proposed amendment would violate settled law, would be prejudicial to the rights of the adverse party, or would be futile because the proposed amendment is legally insufficient. *See Leatherwood Scopes International Inc. v. Leatherwood*, 63 USPQ2d 1699, 1702 (TTAB 2002).

Here, the motion was filed eight weeks after the original notice of opposition, the parties have not yet

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conducted their discovery conference, and opposer contends that it brought the motion "immediately upon realization that Registration No. 3046664 was not included ..." As discussed, the proposed amended notice of opposition sets forth a claim of priority and likelihood of confusion which is legally sufficient, and a claim of dilution which is not.¹ As set forth below, the parties stipulated to modify the relevant paragraph of the amended notice of opposition to perfect the dilution claim.² In these circumstances the Board finds no violation of law, prejudice to opposer, or futility, and grants the motion to amend.

AMENDED NOTICE OF OPPOSITION, AS FURTHER AMENDED BY STIPULATION, IS ACCEPTED

Pursuant to stipulation of the parties entered during the conference, the amended notice of opposition (which accompanied opposer's motion to amend) is further amended to replace paragraph 3 with the following (additional language emphasized):

¹ Inasmuch as the original notice of opposition listed a Trademark Act Sec. 2(a) claim on the ESTTA form but provided no details regarding the claim in the numbered allegations, it did not set forth a legally sufficient claim of false suggestion of a connection. *The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). The Board notes that the amended notice of opposition makes no mention of the Sec. 2(a) claim.

² As noted by applicant in its opposition to amendment, the dilution claim failed to specify that opposer's marks were famous as of applicant's constructive use date. See *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798, 1801 (TTAB 2000).

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Vignerrone has created valuable good will in the Vignerrone Marks, the Vignerrone Marks are famous and represent high quality products to consumers throughout the United States and the world, and the Vignerrone Marks have been famous since a date prior to applicant's filing date.

FRAUD COUNTERCLAIM MUST BE AMENDED

On review of the pleadings the Board notes that applicant's counterclaim to cancel opposer's pleaded Registration No. 1362300 does not state a legally sufficient claim of fraud. The counterclaim alleges that opposer filed a registration renewal declaration asserting continued use with all the existing goods but, based on information and belief, at the time the declaration was filed, applicant was no longer selling some of the goods listed in the registration.

Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application. *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 48 (Fed. Cir. 1986). There is no fraud if a false misrepresentation is occasioned by an honest misunderstanding or inadvertence without a willful intent to deceive. *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981). The standard for finding intent to deceive requires more than proof that the trademark applicant should have known of the falsity of

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its material representations of fact. See *In re Bose Corp.*, ___ F.3d ___, ___ USPQ2d ___ (Fed. Cir., August 31, 2009).

Fed. R. Civ. P. 9(b) requires that the pleadings contain explicit rather than implied expression of the circumstances constituting fraud. *King Auto., Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801, 803 (CCPA 1981). The Board will not approve pleadings of fraud which rest solely on allegations that the trademark applicant made material representations of fact in its declaration which it "knew or should have known" to be false or misleading. *In re Bose Corp.*, ___ F.3d ___, ___ USPQ2d ___ (Fed. Cir., August 31, 2009). Pleadings of fraud made "on information and belief" where there is no separate indication that the pleader has actual knowledge of the facts supporting a claim of fraud also are insufficient. *Id.*

Applicant is allowed until thirty days from the mailing date of this order to file an amended counterclaim with a legally sufficient pleading of fraud, failing which the counterclaim will be dismissed and a new schedule will issue.

If an amended counterclaim is filed, opposer has thirty days to file its answer.

DATES ARE RESET

Deadline for Discovery Conference

December 21, 2009

Opposition No. 91190040

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| Discovery Opens | December 21, 2009 |
| Initial Disclosures Due | January 20, 2010 |
| Expert Disclosures Due | May 20, 2010 |
| Discovery Closes | June 19, 2010 |
| Plaintiff's Pretrial Disclosures | August 3, 2010 |
| 30-day testimony period for plaintiff's testimony to close | September 17, 2010 |
| Defendant/Counterclaim Plaintiff's Pretrial Disclosures | October 2, 2010 |
| 30-day testimony period for defendant and plaintiff in the counterclaim to close | November 16, 2010 |
| Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due | December 1, 2010 |
| 30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close | January 15, 2011 |
| Counterclaim Plaintiff's Rebuttal Disclosures Due | January 30, 2011 |
| 15-day rebuttal period for plaintiff in the counterclaim to close | March 1, 2011 |
| Brief for plaintiff due | April 30, 2011 |
| Brief for defendant and plaintiff in the counterclaim due | May 30, 2011 |
| Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due | June 29, 2011 |
| Reply brief, if any, for plaintiff in the counterclaim due | July 14, 2011 |

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

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Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.
