ESTTA Tracking number: **ESTTA601454**

Filing date: **04/30/2014**

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

Proceeding	91215036
Party	Plaintiff Tommie Copper Inc.
Correspondence Address	ANDY I COREA ST ONGE STEWARD JOHNSTON AND REENS LLC 986 BEDFORD STREET STAMFORD, CT 06905 UNITED STATES acorea@ssjr.com, litigation@ssjr.com
Submission	Opposition/Response to Motion
Filer's Name	Andy I. Corea
Filer's e-mail	acorea@ssjr.com, litigation@ssjr.com
Signature	/Andy I. Corea/
Date	04/30/2014
Attachments	91215036 Opposition.pdf(204360 bytes)

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

TOMMIE COPPER, INC.	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91215036
	:	
TRISTAR PRODUCTS, INC.	:	
	:	
Applicant.	:	

Application Serial No. 85826741
Mark: COPPER WEAR and Design

OPPOSER'S RESPONSE TO
APPLICANT'S MOTION TO DISMISS OPPOSITION FOR
FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED

I. INTRODUCTION

Opposer, Tommie Copper Inc., respectfully requests that the Board deny Applicant's Motion to Dismiss and otherwise sustain this Opposition with regards to Counts I and II as referenced in the Notice of Opposition. Opposer withdraws the grounds of priority and likelihood of confusion.[1]

II. STATEMENT OF FACTS

On January 18, 2013, Applicant filed U.S. Trademark Application Serial No. 85826741 on the basis of Section 1(b) seeking to register the mark 

(COPPER WEAR and Design) for use on "clothing, namely, socks, shirts, tights, sleeves, undershorts, shorts, and gloves, all the foregoing goods featuring copper-infused fabric." ("Applicant's Application").

[1] Applicant did not identify priority as grounds for opposition in the body of its Notice of Opposition. The indications of priority and likelihood of confusion as grounds in the cover sheet were inadvertent.

On August 23, 2013, Opposer filed U.S. Trademark Application Serial No. 86046513, for the mark TOMMIE COPPER WEAR for "clothing, namely, athletic sleeves; Footwear; Gloves; Headwear; Hosiery; Socks; Tops; Wristbands; all featuring copper-infused yarn."

On October 3, 2013, Applicant filed an office action response ("Response") stating "No claim is made to the exclusive right to use COPPER WEAR apart from the mark as shown." ("Disclaimer"). The Disclaimer effectively disclaimed the dominant and most prominent feature Applicant's Application. Further, the design element, consisting of: the wording in grey, with a copper-colored paintbrush-style stroke at the diagonal between the two words ("Design Element"), is insignificant in relation to Applicant's Application as a whole.

On the very same day Applicant entered the Disclaimer confirming that it was not claiming exclusive rights in the wording COPPER WEAR, Applicant sent a letter ("Letter") alleging confusion between Opposer's TOMMIE COPPER WEAR Application and Applicant's asserted COPPER WEAR mark. The Letter shows that the Disclaimer was a false statement made to the USPTO in order to procure registration. Therefore, Opposer's rights to use the term TOMMIE COPPER WEAR will be impaired by the registration of a fraudulently obtained trademark registration of Applicant.

III. LEGAL STANDARD FOR A MOTION TO DISMISS

In order to survive respondent's motion to dismiss for failure to state a claim under Fed. R. Civ. P. 12(b)(6), petitioner's complaint must allege facts which would, if proved, establish that: (1) petitioner has standing to maintain the proceeding; and (2) a valid ground exists for denying the registration sought. *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); TBMP §503.02. (3d ed. rev.2 2013). The complaint must provide "sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" *Ashcroft*

v. Iqbal, 556 U.S. 662, 678 (2009) (quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007)). For purposes of a motion to dismiss, all of petitioner's well-pleaded allegations must be accepted as true and the complaint must be construed in a light most favorable to petitioner. *See Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.,* 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993).

Whether a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence in support of their respective positions. *Id.*

With regard to Count I, the Board must assume that "COPPER WEAR" is the dominant and/or most prominent feature of Applicant's Application, which has not become distinctive with respect to Applicant. The Board must also assume that Applicant's Application is dominated by non-registrable matter, including the wording COPPER WEAR. Further, the Board must assume that the Design Element is insignificant in relation to the application as a whole.

With regard to Count II, the Board must further assume that the Disclaimer made in the Response was a false representation made by Applicant with an intent to deceive the USPTO in order to procure registration and that such actions have damaged the Opposer.

In light of these facts and the arguments below, it is submitted that the Board must Deny Applicant's Motion to Dismiss with respect to Counts I and II.

IV. ARGUMENT

Opposer has sufficiently alleged standing and two valid grounds for denying Applicant's Application. Applicant does not contest standing, therefore Opposer provides the following discussion of the legal sufficiency of facts alleged in Counts I and II of the instant Opposition.

A. Count I: Applicant's Application is Unregisterable under Section 1056(a)

Applicant is attempting to obtain registration by attaching an insignificant design element to a mark dominated by unregisterable matter, and therefore Applicant's Application cannot mature to a registration.

In 1962, Congress carefully chose language to codify the traditional PTO disclaimer practice. *Dena Corp. v. Belvedere International Inc.* 21 USPQ 1047, 1051 (Fed. Cir. 1991). Under traditional disclaimer practice, The Commissioner refused to permit applicants to register composite marks dominated by non-registrable matter, even with a disclaimer of nondistinctive portions. *Ex parte American Bearing,* 59 USPQ 166 (Dec. Comm'r Pat. 1943). Further, if the registrable portions of a mark were relatively insignificant next to the nonregistrable portions, a disclaimer would not cure the defect. *Ex parte Wells Lamont Smith Corp.,* 71 USPQ 12 (Dec. Comm'r Pat. 1946); *Ex parte Commercial Solvents Corp.,* 71 USPQ 106 (Dec. Comm'r Pat. 1946). A disclaimer of the most prominent or dominant feature would in effect impart a nonregistrable meaning to the entire mark, and therefore Applicant could not acquire registration by disclaimer. *Dena Corp. v. Belvedere International Inc.* 21 USPQ at 1050.

In *Dena*, the Federal Circuit overturned a Board decision relating to 

. *Id.* at 1048. The Federal Circuit concluded that the Board had not considered whether EUROPEAN FORMULA dominated the mark, nor had the Board considered whether EUROPEAN FORMULA was entirely separate from the rest of the mark. *Id.* at 1052. The Federal Circuit further concluded that the mark was not unitary. *Id.* at 1053.

In comparison, Applicant's 

is also dominated by unregistrable matter, and Applicant cannot cure this defect by attaching an insignificant design element to the dominant and unregistrable COPPER WEAR portion of the mark.

Opposer has alleged that the terms "COPPER" and "WEAR" both individually and when combined are descriptive, and have not become distinctive with respect to Applicant. Also, Applicant has entered a disclaimer to "COPPER WEAR," thus admitting that "COPPER WEAR" is descriptive and not distinctive with respect to Applicant. Opposer has further alleged that "COPPER WEAR" is the dominant and most prominent feature of Applicant's Application. In addition, Opposer has alleged that the Design Element is insignificant in relation to Applicant's Application as a whole, and that Applicant's Application is dominated by unregistrable matter.

Applicant is not entitled to registration if Opposer proves that COPPER WEAR is either the dominant, or the most prominent feature. Alternately, Opposer may prove that the Design Element is insignificant or that Applicant's Application is dominated by unregistrable matter. At minimum, the proof required is an evidentiary issue that may not be decided on a Motion to Dismiss. Accordingly, Opposer has sustained its burden to state a claim to relief that is plausible on its face at least with respect to Count I.

B. Count II: Fradulent Procurement of Registration

An opposition based on a claim of fraudulent procurement of registration by fraudulent disclaimer appears to be an issue of first impression with the Board; however, fraudulent procurement of a registration is an issue the Board has previously adjudicated.

1. The Board May Deny Registration On The Basis Of Fraud

Although fraudulent disclaimer appears to be a matter of first impression, the Board previously denied registration on the grounds of fraudulent procurement. For example, if the registrant uses the mark, but not on the goods listed in the registration, the registration may be cancelled for fraud. *Otis Elevator Co. v. Echlin Mfg.,* 187 U.S.P.Q 310, 1975 WL 21258 (T.T.A.B. 1975). In addition, a registration may be cancelled where applicant does not use the mark on all goods or services registered. *Western Farmers Ass'n v. Loblaw, Inc.,* 180 U.S.P.Q 345, 1973 WL 19717 (T.T.A.B. 1973).

In fact, the USPTO has said it will accept as adequate a pleading that the adverse party "knowingly made" material misrepresentations to procure a registration. *Daimlerchrysler Corporation and Chrysler, LLC v. American Motors Corporation,* 94 U.S.P.Q.2d 1086, 2010 WL 1146943 (T.T.A.B. 2010).

Opposer has alleged that Applicant knowingly made a material misrepresentation to procure a registration, therefore, the Board must deny Applicant's Motion to Dismiss.

2. Opposer Has Established A *Prima Facie* Case Of Fraud

The USPTO required the disclaimer of COPPER WEAR as a condition for approval of the mark. Absent the disclaimer, the mark would not have been published for opposition.

Opposer has alleged that the Disclaimer was a false representation of a material fact made, by a person who knew the representation to be false, in order to deceive the USPTO and procure a registration. Likewise, Opposer has alleged damage resulting from the advancement of Applicant's Application towards registration, at minimum because Opposer received legal harassment in the form of the Letter and Opposer's rights to use TOMMIE COPPER WEAR will be impaired by registration of Applicant's Application.

In order to state a prima facie case of fraud Opposer must allege, (1) The challenged statement was a *false* representation regarding a *material fact.* (2) The person making the representation *knew* that the representation was false. (3) An *intent to deceive* the USPTO. (4) Reasonable *reliance* on the misrepresentation. (5) *Damage* proximately resulting from such reliance. J. THOMAS MCCARTHY, 6 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 31:61 et. seq. (4th ed. 2012) citing *San Juan Products, Inc. v. San Juan Pools of Kansas, Inc.,* 849 F.2d 468, 7 U.S.P.Q.2d 1230, 1234 (10th Cir. 1988).

Opposer has met its burden to allege facts with sufficient particularity in order to sustain the Opposition with respect fraud. As set forth in ¶ 35-51 of the Notice of Opposition, by stating in the Response "no claim is made to the exclusive right to use COPPER WEAR apart from the mark as shown," Applicant has made a false representation as demonstrated by its assertion of exclusive rights to the COPPER WEAR mark in its demand Letter. The false representation was related to a material fact and intentionally made by a person knowing the representation to be false in order to secure registration. The actions by Applicant have and will in the future damage Opposer. The allegations in Notice of Opposition and more specifically Paragraphs 35-51 and the four supporting exhibits are more than sufficient under Fed. R. Civ. P. 9(b).

Accordingly, the Board may not dismiss Count II because it may reasonably be inferred from the content of the Notice of Opposition that Applicant intentionally committed an act of fraud in order to procure a registration.

3. The Purpose Of Disclaimer Practice Is To Prevent The Precise Actions Engaged In By Applicant, That Is, Using A Federal Registration To Claim Exclusive Right To Disclaimed Matter.

Disclaimer practice is in place to prevent the precise actions engaged in by Applicant. Disclaimer practice provides a balance between the benefits of federal registration and the rights of the public to use descriptive and non-distinct terms. According to traditional disclaimer

practice, Applicant's competitors must remain free to use descriptive terms without legal harassment. *DeWalt, Inc. v. Magna Power Tool,* 289 F.2d 656, 662, 129 USPQ 275, 281 (CCPA 1961). Here, Applicant submitted the Disclaimer and thereby intentionally misled the USPTO to believe that Applicant's competitors would remain free to use "COPPER WEAR" without legal harassment.

Notwithstanding its disclaimer, Applicant did use Applicant's Application for the purposes of legal harassment, which is directly contrary to the representation made by Applicant in submission of the Disclaimer in the Response. The Letter is but one piece of evidence that the Disclaimer was a false statement. Not only did Applicant enter the fraudulent disclaimer, but Applicant did so the very same day Applicant sent the harassing Letter. (Paper #1 ¶ 42).

Therefore, Opposer has alleged the circumstances constituting fraud with sufficient particularity, and the Board must deny Applicant's Motion to Dismiss with respect to Count II.

4. The Assertion By Applicant That Opposer's TOMMIE COPPER WEAR Mark Is Likely Confused With Applicant's COPPER WEAR Shows An Intent To Act Opposite With The Disclaimer, Thus Showing The Disclaimer To Be False.

Opposer's TOMMIE COPPER WEAR does not use "COPPER WEAR" with Applicant's Design Element. Applicant's Letter shows an intent to act with flagrant disregard to the representation contained in the Disclaimer. Accordingly an act of fraud has been committed on the USPTO and the Board must deny Applicant's Motion to Dismiss.

Opposer has alleged that the terms "COPPER" and "WEAR" are individually and in combination descriptive and have not acquired any secondary meaning. Further, Applicant has not used Applicant's Application. Therefore, Applicant's Application would not have issued absent the Disclaimer, and Applicant falsely used the Disclaimer in order to obtain a registration.

A disclaimer shows that applicant is merely stating that he is claiming only the whole mark as his property without creating the false impression of the extent of the registrant's right with respect to certain individual elements of the mark. *Schwarzkopf v. John H. Breck, Inc.,* 340 F.2d 978, 144 USPQ 433 (C.C.P.A. 1965) *Emphasis added*. Registration with a disclaimer is intended to prevent any false impression that the registrant owns registered rights to the individual part that is disclaimed. *In re Ebs Data Processing, Inc.,* 212 U.S.P.Q. 964, 966, 1981 WL 40480 (T.T.A.B. 1981) *Emphasis Added*; *See Also* TMEP 1213.

When entering a disclaimer, Applicant is stating that "no rights are being asserted in the disclaimed component standing alone, but rights are asserted in the composite; and the particular registration represents only such rights as flow from the use of the composite mark." *Sprague Electric Co. v. Erie Resistor Corp.,* 101 USPQ 486, 486-87 (Comm'r Pats. 1954). Opposer's TOMMIE COPPER WEAR application does not use the term "COPPER WEAR" in connection with Applicant's Design Element, and therefore Applicant's assertion of a likelihood of confusion shows the Disclaimer is false. Absent the entry of the Disclaimer, Applicant's Application would not register, therefore, Applicant misrepresented a material fact to the USPTO in order to procure a notice of allowance.

5. Disclaimer Practice Is A Statutory Requirement of the Trademark Act And Is Therefore Grounds For Fraud

Applicant argues that disclaimer practice under 15 U.S.C. §1056 is not a statutory ground that can give rise to fraud. This is simply illogical and incorrect. The Trademark Act of 1946 created a statutory basis for the practice of disclaimer in §6, 15 U.S.C. §1056. TMEP 1213.01 *Emphasis added*. The Lanham Act's disclaimer requirement prevents an applicant from claiming exclusive rights to disclaimed portions apart from composite marks. *Dena Corp. v. Belvedere International Inc.* 21 USPQ 1047, 1051 (Fed. Cir. 1991). As acknowledged by Applicant in its

Motion to Dismiss, any claim of fraud must be based in a statutory requirement of the Trademark Act. Since 15 U.S.C. §1056 is a statute, it clearly satisfies the requirements for a Notice of Opposition.

Confusingly, Applicant has acknowledged that disclaimer practice is a statutory requirement (Motion to Dismiss at 10), TMEP 1213.01 states that disclaimer practice is statutory, 15 U.S.C. § 1056 is a statute, but applicant then argues that there can be no fraud because no statutory grounds are implicated (Motion to Dismiss at 12). This simply makes no logical sense. Disclaimer practice under §1056 is a statutory requirement of registration, and therefore the Board must deny Applicant's Motion to Dismiss with respect to Count II.

V. CONCLUSION

Therefore, it is respectfully submitted that Applicant's Motion to Dismiss should be denied with respect to Counts I and II as discussed herein.

Respectfully submitted,

TOMMIE COPPER, INC.

April 30, 2014

/s/ Andy I. Corea

Andy I. Corea
Jonathan A. Winter
ST. ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905
Tel. (203) 324-6155
Fax. (203) 327-1096
Email: litigation@ssjr.com

Attorneys for Opposer

CERTIFICATE OF SERVICE

This is to certify that a true copy of the foregoing **OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO DISMISS OPPOSITION FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED** was served by first class mail, postage prepaid on the Correspondent for the Applicant as follows:

Daniel J. Holmander
Cheryl A. Clarkin
Barlow, Josephs & Holmes Ltd.
101 Dyer Street
5th floor
Providence, RHODE ISLAND 02903-3908

April 30, 2014
Date

/s/ Joan M. Burnett
Joan M. Burnett