

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: May 9, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Tommie Copper IP, Inc.

v.

Gcool-Tech Usa LLC

—
Opposition No. 91223768
to Application Serial No. 86577505

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Andy I. Corea and Alyson J. DiLena of St. Onge Steward Johnston & Reens LLC for
Tommie Copper IP, Inc.

David L. Principe of Phillips Lytle LLP for Gcool-Tech Usa LLC.

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Before Shaw, Goodman, and Larkin, Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

Applicant, Gcool-Tech Usa LLC, seeks registration of the mark



for goods identified as: “Clothing made of fabric containing copper, namely, athletic sleeves, dresses, gloves, hats, hooded sweatshirts, pants, scarves, scrubs not for

medical purposes, shoes, shorts, skirts, socks, T-shirts, underwear,” in International Class 25.¹

The description of the mark states: “The mark consists of a design comprised of four incomplete polygons in orange to the left of the word ‘COPPER’ in black and the number ‘88’ in orange.” The colors orange and black are claimed as a feature of the mark. COPPER 88 is disclaimed apart from the mark as shown.

Opposer, Tommie Copper IP, Inc., has opposed registration of Applicant’s mark on the grounds of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and fraud. Opposer pleaded ownership of the following marks:

1. TOMMIE COPPER, in standard characters, for “Footwear, headwear, and clothing in the nature of compression garments for athletic or other non-medical use, namely, sleeves, gloves, tops, and bottoms, all featuring copper-infused yarn,” in International Class 25;²



2.  for “Footwear, headwear, and clothing, namely, tops, bottoms, gloves, hosiery, jackets, shirts, sleeves, socks, underwear, wristbands,” in International Class 25.³

¹ Application Serial No. 86577505, filed on March 26, 2015 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming a date of first use of September 16, 2013 and a date of first use in commerce of May 19, 2014. The application filing basis was subsequently amended to Section 1(b), 15 U.S.C. § 1051(b), based on a bona fide intent to use the mark in commerce.

² Registration No. 4236726, issued November 6, 2012.

³ Registration No. 4590309 issued August 19, 2014. The description of the mark reads: “The mark consists of four circles connected by short lines forming the general shape of a cross.” Color is not claimed as a feature of the mark.



3. for, inter alia, “Athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms; Men’s socks; Men’s underwear; Women’s hats and hoods; Women’s underwear,” in International Class 25;⁴



4. for “Compression garments for athletic or other non-medical use, namely, sleeves, gloves, tops, bottoms, footwear all made from copper-infused yarn,” in International Class 25;⁵ and

5. **TCC** Tommie Copper Compression for “Footwear, headwear, and clothing, namely, tops, bottoms, jackets, shirts, sleeves, gloves, all made from copper-infused yarn,” in International Class 25.⁶

Applicant denied the salient allegations of the amended notice of opposition.

⁴ Registration No. 4084474, issued January 10, 2012. The description of the mark reads: “The mark consists of a badge design in copper and outlined in black, that includes the letters ‘Cu’ and the number ‘29’ in crinkly copper and white colors, respectively, and the words ‘Tommie Copper’ in a black stylized lettering below.” The colors brown, white, black, and copper are claimed as a feature of the mark.

⁵ Registration No. 4228550, issued October 23, 2012. The description of the mark reads: “The mark consists of a badge design that includes the letters ‘Cu’ and the number ‘29’ within the badge, and the words ‘Tommie Copper’ below the badge.” Color is not claimed as a feature of the mark and “CU” is disclaimed.

⁶ Registration No. 4777624 issued July 21, 2015. The description of the mark reads: “The mark consists of the letters ‘TCC’ with a larger ‘C’ surrounding the center ‘C’ and the words ‘Tommie Copper Compression’ along side, read vertically.” Color is not claimed as a feature of the mark and “COPPER” is disclaimed.

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the involved application. Opposer submitted the following evidence:

1. Status and title copies of Opposer's Registrations;
2. Opposer's file history for Registration No. 4590309;
3. Applicant's answers to Opposer's first and second sets of Requests for Admission;
4. Applicant's answers to Opposer's first and second sets of Interrogatories;
5. Portions of the discovery deposition of Applicant's representative, Aaron Fisher, Brand Manager and son of Applicant's founder; and
6. The testimony declaration of Ms. Kimberly Mallard, Secretary and Senior Vice President of Media, Marketing & Strategy for Opposer.

Applicant submitted the following evidence:

1. Additional portions of the discovery deposition of Aaron Fisher;
2. Applicant's published U.S. patent application, No. 2016/0340809, relating to a method of making antimicrobial yarn embedded with copper; and
3. Applicant's answers and objections to Opposer's first set of interrogatories.

II. Background

Both Applicant and Opposer sell a variety of clothing articles embedded or infused with copper, which has been shown to have antimicrobial properties.⁷ Opposer sells its goods to “consumers of all types” through online outlets such as Amazon.com, as well as via its own website, tommiacopper.com.⁸ Opposer promotes its goods through television advertisements and infomercials.⁹ Applicant has not sold any of its identified goods in the United States, but it has sold some of them in Canada, the United Kingdom, and Chile.¹⁰

Notwithstanding the lack of actual sales of any goods in the United States, Applicant filed its application on March 26, 2015 under Section 1(a) of the Trademark Act claiming a date of first use of September 16, 2013 and a date of first use in commerce of May 19, 2014.¹¹ During this opposition proceeding, Applicant claims it realized that it had not used the mark in the United States and thus amended the application filing basis to Section 1(b), based on a bona fide intent to use the mark in commerce.¹² The amendment to the filing basis was accepted but did not obviate the fraud claim.¹³

⁷ Fisher Dep., pp. 26–29 and 45, 30 TTABVUE 57 and 61; Mallard Dec., para. 9, 31 TTABVUE 3.

⁸ Mallard Dec., paras. 22 and 29, 31 TTABVUE 6 and 7.

⁹ *Id.* at para. 22, 31 TTABVUE 6.

¹⁰ Fisher Dep., pp. 26–29, 30 TTABVUE 57.

¹¹ TSDR March 26, 2015 application.

¹² 20 TTABVUE.

¹³ 21 TTABVUE 2-3.

III. Standing and Priority

Standing is a threshold issue that must be proven by the plaintiff in every inter partes case. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015). Our primary reviewing court, the U.S. Court of Appeals for the Federal Circuit, has enunciated a liberal threshold for determining standing, namely that a plaintiff must demonstrate that it possesses a “real interest” in a proceeding beyond that of a mere intermeddler, and “a reasonable basis for his belief of damage.” *Id.* at 1062 (citing *Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999)). A “real interest” is a “direct and personal stake” in the outcome of the proceeding. *Ritchie v. Simpson*, 50 USPQ2d at 1026.

In this case, Opposer made of record by notice of reliance copies of its pleaded registrations showing their current status and title in Opposer. In view thereof, Opposer has established its standing. In addition, priority is not at issue with respect to the marks and the goods set out in its pleaded registrations. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *King Candy Co. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

IV. Likelihood of Confusion

We begin with likelihood of confusion. Our determination is based on an analysis of all the probative facts in evidence relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any

likelihood of confusion analysis, two key considerations are the similarities between the goods and the similarities between the marks. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

Inasmuch as (1) Opposer admits that the term COPPER is highly descriptive, if not generic, for the parties’ goods,¹⁴ (2) Applicant has disclaimed COPPER 88, (3) Opposer admits that the design element of Applicant’s mark is the most dominant portion,¹⁵ and (4) Opposer focuses its arguments on the likelihood of confusion



between Applicant’s mark and Opposer’s design mark,  , we focus our analysis on this mark as well because it is most similar to Applicant’s mark, as compared to Opposer’s other marks.¹⁶ If we find a likelihood of confusion as to this mark, we need not find it as to the others; conversely, if we do not find a likelihood of confusion as to this mark, then there would be no likelihood of confusion with the marks in the other

¹⁴ Opposer’s Br., pp. 16-17, 37 TTABVUE 23-24. Applicant’s witness testified that the goods are made of 88 percent copper-infused nylon. Fisher Dep., p. 46, 30 TTABVUE 62.

¹⁵ *Id.* at 17, 37 TTABVUE 24.

¹⁶ Opposer also argues that “Applicant’s Mark containing the term COPPER with four intersecting polygons is similar to Opposer’s Tommie Copper Marks, **which are used in conjunction** with the Tommie Copper icon containing four intersecting circles.” Opposer’s Br., p. 16, 37 TTABVUE 23 (emphasis added). However, Opposer has not pleaded or proven that its “copper-formative” marks and its design mark are used conjointly; nor has the issued been tried by consent of the parties. We therefore have considered each of Opposer’s marks individually. *See Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1349 (TTAB 2017) (“[A] likelihood of confusion claim based on the claimant’s use of two marks conjointly must be pleaded clearly enough to provide fair notice of the claim to the defendant.”).

pleaded registrations. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. *The similarity or dissimilarity of the goods, channels of trade, and classes of consumers*

We first consider the similarity of the respective goods, channels of trade, and classes of consumers. It is not necessary that the goods be identical or competitive, or even that they move in the same channels of trade, to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner, or that the circumstances surrounding their marketing are such that they would or could be encountered by the same persons in situations that would give rise, because of the similarity of the marks, to a mistaken belief that they originate from the same source or that there is an association or connection between the sources of the goods. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1635 (TTAB 2009).

The goods of the parties are in part identical. The goods broadly identified in Opposer's design mark registration as "footwear, headwear, and clothing, namely, tops, bottoms, gloves, hosiery, jackets, shirts, sleeves, socks, [and] underwear" are either identical to or encompass Applicant's more narrowly identified "athletic sleeves, . . . gloves, hats, hooded sweatshirts, pants, . . . shoes, shorts, socks, T-shirts, [and] underwear" which are "made of fabric containing copper." Applicant's remaining goods, namely, "dresses," "scarves, scrubs not for medical purposes," and "skirts" are related to Opposer's goods because they are common clothing articles.

Because the parties' goods are in part legally identical, we must presume that the channels of trade and classes of purchasers will be the same for those goods. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (finding Board entitled to rely on this legal presumption in determining likelihood of confusion).

In sum, we find the goods to be identical or related and the channels of trade and classes of consumers to be the same. Thus, the second and third *du Pont* factors support a finding that confusion is likely as to the parties' goods.

B. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression

We next consider the marks, comparing them for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *See Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Similarity in any one of these elements is sufficient to support a determination of likelihood of confusion. *See Krim-Ko Corp. v. The Coca-Cola Co.*, 390 F.2d 728, 156 USPQ 523, 526 (CCPA 1968) ("It is sufficient if the similarity in either form, spelling or sound alone is likely to cause confusion."). The partial legal identity of the goods reduces the degree of similarity between the marks that is necessary for confusion to be likely. *See, e.g., Viterra*, 101 USPQ2d at 1912; *In re Mighty Tea Leaf*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Moreover, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar

in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. *Coach Servs., Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721.



To recap, Applicant's mark is with COPPER 88 disclaimed. The design element of the mark is described in the application as being "comprised of four incomplete polygons." Aaron Fisher, Applicant's Brand Manager, testified that the design is intended to suggest the number "88" and the letter "C":

[I]f you look at the icon, it's actually two 8s on 45-degree angle. And then you have the C for the copper kind of embedded into the logo, kind of off on the side, detached. And then you have the four parts that have to do with the four parts of the heart for circulation.¹⁷



Opposer's design mark, , is described as "consist[ing] of four circles connected by short lines forming the general shape of a cross."¹⁸ Opposer argues that the design element in Applicant's mark and its mark are confusingly similar:

[B]oth utilize an icon containing four intersecting elements that are similar in shape. Opposer's Tommie Copper icon [design mark] consists of four circles that intersect. Applicant's Mark does not utilize circles but rather polygons. . . . However, both shapes present an overall rounded appearance. In addition, both marks intersect the four rounded elements at a central element that takes the form of a cross: Opposer's taking the form of positive space while Applicant's cross is formed by negative space.¹⁹

¹⁷ Fisher Dep., p. 35, 30 TTABVUE 59.

¹⁸ Registration No. 4590309.

¹⁹ Opposer's Br., p. 17, 37 TTABVUE 24.

We do not find these arguments to be persuasive. As Opposer acknowledges, the design element of Applicant's mark comprises polygons whereas Opposer's mark comprises circles. In addition, notwithstanding Opposer's description of its mark, the mark clearly contains five circles, not four. That is, the "short lines" connecting the outer four circles of Opposer's mark terminate at the perimeter of a single large circle in the middle of the mark. Applicant's design element contains no such central circle.

Nor do we find, as Opposer argues, that both marks "take[] the form of a cross: Opposer's taking the form of positive space while Applicant's cross is formed by negative space."²⁰ Rather, if we look at the "negative space" in Applicant design element, it appears to be more like a four-leaf clover, whereas Opposer's mark appears to be a scientific symbol or molecule. This latter impression is consistent with testimony from Opposer's Secretary and Senior Vice President of Media, Marketing & Strategy, Kimberly Mallard, who stated that Opposer's mark "is suggestive of a modern alchemy symbol for copper."²¹

Opposer further argues that the color of the marks are similar: "The color of the two icons is also similar. . . . Though depicted in black, the registration for the Tommie Copper icon indicates that color is not claimed as a feature of the mark. . . . Accordingly, the icon may take any color."²² This argument too is unpersuasive. Even if Opposer's mark was displayed in the color orange, it would not contribute significantly to the similarity of the marks, particularly because, as Opposer admits,

²⁰ *Id.*

²¹ Mallard Test., p. 4, 31 TTABVUE 5.

²² Opposer's Br., p. 18, 37 TTABVUE 25.

the color orange is similar to the color “copper,” which is suggestive of the ingredient copper: “Opposer has been unable to ascertain a detectable difference in the orange depicted in Applicant’s Mark as compared with the copper and brown colors used in its Registration No. 4,084,474.”²³

When Applicant’s mark is viewed as a whole, we do not find it particularly similar to Opposer’s design mark in appearance, connotation and commercial impression. Moreover, since Opposer’s mark is a design mark, there can be no similarity in sound.

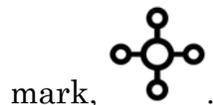
Accordingly, the *du Pont* factor regarding the similarity of the marks does not weigh in favor of finding a likelihood of confusion.

C. Conclusion

After considering the relevant *du Pont* factors, including any factors not discussed herein, despite the identity of the parties’ goods, we find that Applicant’s mark,



, is not likely to cause confusion with Opposer’s design



V. Fraud

Fraud in procuring a trademark registration occurs when an applicant knowingly makes false, material representations of fact in connection with its application with the intent to deceive the USPTO. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009). A party opposing registration of a trademark on the ground of

²³ *Id.* at 19, 37 TTABVUE 25.

fraud bears a heavy burden of proof. *W. D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 377 F.2d 1001, 1004, 153 USPQ 749, 750 (CCPA 1967). Indeed, “the very nature of the charge of fraud requires that it be proven ‘to the hilt’ with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.” *Smith Int’l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981); *see also Asian and W. Classics B.V. v. Selkow*, 92 USPQ2d 1478, (TTAB 2009). Opposer’s fraud claim is based on non-use of the mark as of the filing date of Applicant’s use-based application.

Fisher testified that Applicant was not selling any goods bearing the applied-for mark in commerce in the United States as of the filing date of the application:²⁴

Q: But [the goods] were not sold for money in the United States as of March 26th, 2015?

A: To my knowledge, if anything, it was samples given to reps and other people like that, yes.

Fisher testified further that, at the time of filing, Applicant was in the process of distributing product samples in the United States and developing prototypes, although some prototypes were proving problematic:²⁵

Q: At the time GCool filed the Copper 88 [and] design application, had it sold any of [Applicant’s] goods in the U.S.?

A: That’s a good question. I know that we gave out -- I know that there were samples that were given out to reps. To my knowledge -- like I know there were samples and stuff given out to people. I know my mom gave it to some of her friends.

Q: Right. We talked, there was no payment.

²⁴ Fisher Dep., p. 77, 30 TTABVUE 69.

²⁵ *Id.* at 70-73, 30 TTABVUE 68.

A: Yeah. Yeah. Yeah.

Q: So everything was made. So you -- so Gcool had made, for instance, hooded sweatshirts that contained the copper-embedded nylon.

A: Oh, sorry. No. No. Sorry. The hooded sweatshirts, we haven't created hooded sweatshirts.

* * *

Q: Okay. So as of March 26th, 2015, GCool did not have a hooded sweatshirt, prototype, or plans to make a hooded sweatshirt embedded with copper?

A: It was a sweatshirt, but it was -- we started going to that direction, but the prototypes and everything didn't look -- and it just wasn't what we wanted. So that's why I'm like, No.

Fisher admitted that the specimens submitted with the application were “mock ups” and were created in conjunction with the product samples, but have not been used in commerce anywhere.²⁶ Regarding the claimed dates of use, Fisher testified that those dates incorrectly referred to use of the copper-infused fabric under another brand, “CU COMPRESSION,” which Applicant was selling in the United States at the time of filing:²⁷

Q: Okay. . . . do you see in the bottom paragraph, it says [as read]: The mark was first used by the applicant or the applicant's related company or licensee, predecessor in interest, at least as early as 9/16/2013.

A: Yep.

Q: So can you describe the circumstances around that use [of the mark?]

²⁶ *Id.* at 91, 30 TTABVUE 73.

²⁷ *Id.* at 74-75, 30 TTABVUE 69.

A: So when we're saying "use," because this is under the copper fabric, so we started using the copper fabric as of that time.

Q: What about calling it Copper 88 at that time?

A: Calling Copper 88 at that time, no, we didn't call it. But we had the -- we had CU Compression at that time because it's like Copper 88 by CU Compression by GCool.

Despite admitting that Applicant was not using the mark on any goods sold in the United States, Fisher testified that, at the time of filing, Applicant was selling some of its Chinese-made goods directly to Canada:²⁸

Q: So you believe that as of March 26th, 2015, that you had sold some of these goods to a distributor in Canada?

A: Yeah. Like I know we were developing -- because we had the logo before. We were developing all this stuff and showed -- like brought things for our distributor in Canada. Yeah.

Q: Okay. And those goods were made in China and then they were sold to the distributor in Canada.

A: Yeah. The samples were brought into Canada, yes.

From the foregoing, it is clear that Applicant was not selling any of its goods under the applied-for mark in the United States as of the filing date. Averments and evidence of use of a mark for the goods identified in a use-based application are critical to the approval of a use-based application, and if it had been disclosed to the examining attorney that the mark was not in use for the identified goods (or that the specimen of use was a mock up), registration would have been refused. Thus, the claim that Applicant was using the mark in commerce was a false, material representation of fact to the USPTO. *In re Bose Corp.*, 91 USPQ2d at 1941.

²⁸ *Id.* at 73-74, 30 TTABVUE 68-69.

The only remaining issue is whether Applicant intended to deceive the USPTO in procuring its trademark. Thus, we must look at Applicant's intent. Our primary reviewing court has stated that intent to deceive may be established by direct evidence or inferred from indirect and circumstantial evidence:

Subjective intent to deceive, however difficult it may be to prove, is an indispensable element in the analysis. Of course, "because direct evidence of deceptive intent is rarely available, such intent can be inferred from indirect and circumstantial evidence. But such evidence must still be clear and convincing, and inferences drawn from lesser evidence cannot satisfy the deceptive intent requirement." [Internal citation omitted]. When drawing an inference of intent, "the involved conduct, viewed in light of all the evidence ... must indicate sufficient culpability to require a finding of intent to deceive." (Citation omitted).

In re Bose Corp., 91 USPQ2d at 1941. Opposer, as the party asserting fraud, bears the burden of proof; Applicant is not obligated to rebut allegations of fraudulent intent.

Under questioning by Opposer's counsel, Fisher adopted Applicant's explanation, in its motion to amend its filing basis, for the filing of a use-based application—that Applicant was under the mistaken impression that its use of the mark in other countries constituted use in commerce in the United States.²⁹ And in response to a question in which Opposer's counsel expressly assumed that Applicant had such a mistaken belief, Fisher testified that his father was confused as to whether Applicant's use in Canada and its sale of the copper-embedded fabric under a

²⁹ *Id.* at 88, 30 TTABVUE 72.

different brand name constituted use in commerce at the time it filed the application:³⁰

Q: Right. Okay. So it sounds like you had a mistaken belief at the time you filed the application about what it meant to be using in commerce. You thought you were using -- you were using the trademark in commerce in other countries.

A: So the way that I see it, I think he got confused because he was using it. And I think he was confused. Also, I think he was confused about using CU Compression by GCool as something. So my dad's -- my dad's not a lawyer.

In response to a subsequent question, Fisher expressly denied that Applicant had any intent to deceive the Patent and Trademark Office.³¹ Opposer's counsel's next question expressly posited that Applicant "just didn't really understand legally what it meant to use a trademark in commerce?" Fisher agreed, testifying that "I honestly think there was a lot of confusion. I really think it was just a lot of confusion. So, yeah."³²

We find, based on the record before us, there is no direct evidence of an intent to deceive the USPTO, and insufficient evidence to warrant the inference of an intent to deceive. As established above, at the time of filing the application, Applicant had distributed samples to prospective distributors in the United States, was developing prototype garments including "hooded sweatshirts," was selling copper-embedded fabric under a different brand, and had sold goods in Canada under the applied-for mark. None of these acts are sufficient to establish use in commerce as of the filing

³⁰ *Id.* at 90, 30 TTABVUE 73.

³¹ *Id.* at 92-93, 30 TTABVUE 73.

³² *Id.* at 93, 30 TTABVUE 73.

date, but neither may we infer, on this record, that Applicant had a deceptive intent in filing its application merely because Applicant was wrong in thinking these acts satisfied application filing requirements. *M.C.I. Foods Inc. v. Bunte*, 96 USPQ2d 1544, 1549 (TTAB 2010) (“[W]e will not draw an inference that [a party] acted with the intent to deceive the Trademark Office without some factual basis for drawing such an inference.”). As explained by the Federal Circuit:

There is no fraud if a false misrepresentation is occasioned by an honest misunderstanding or inadvertence without a willful intent to deceive. . . . Unless the challenger can point to evidence to support an inference of deceptive intent, it has failed to satisfy the clear and convincing evidence standard required to establish a fraud claim.

In re Bose Corp., 91 USPQ2d at 1942.

Opposer can point to no “evidence to support an inference of deceptive intent.” *Id.* To the contrary, as noted above, Opposer’s counsel expressly assumed in her examination of Fisher that “it sounds like you had a mistaken belief at the time you filed the application about what it meant to be using in commerce. You thought you were using -- you were using the trademark in commerce in other countries,” and that Applicant “didn’t really understand” the legal concept of use in commerce,³³ and Opposer’s brief concedes that “it is possible that Applicant may have mistakenly believed that its sales in other countries constituted use in commerce for a U.S. trademark application”³⁴

³³ *Id.* at 90, 30 TTABVUE 73.

³⁴ Opposer’s Br., p. 25, 37 TTABVUE 32. Opposer claims that this mistaken belief could not have extended to all of the goods in the application because sweatshirts had not been sold anywhere when the application was filed, but Opposer points to no evidence that shows that Applicant was focused on this fact at the time of filing, much less that Applicant intended to

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Accordingly, we find that Applicant did not commit fraud on the USPTO in filing and prosecuting the application for its mark.

Decision: The opposition is dismissed.³⁵

deceive the USPTO as to these goods.

³⁵ The amendment to the filing basis has been accepted, however, the application will have to be re-published. *See* 37 C.F.R. §§ 2.35(b)(2) and 2.133(a).