

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500  
General Email: [TTABInfo@uspto.gov](mailto:TTABInfo@uspto.gov)

EJW/Bukrinsky/dmd

April 11, 2020

Opposition No. 91253489

*Dan Georges*

*v.*

*Yeluguri Satyanarayana*

**ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:**

**I. Applicant's Motion is Premature**

Answer was due in this proceeding on February 24, 2020. In lieu of filing an answer, on February 22, 2020, Applicant filed a document entitled "Motion to Dismiss Notice of Opposition for Failure to State a Claim under FRCP 12(b)(6)."<sup>1</sup> Although Applicant's submission purports to be a motion to dismiss, it is not such a motion.<sup>2</sup>

---

<sup>1</sup> Applicant's submission did not include a certificate of service. However, in response to the Board's March 2, 2020 order, 5 TTABVUE, Applicant submitted a copy of his certificate of service indicating that he served his submission on Opposer on March 7, 2020. See 6 TTABVUE. Accordingly, the Board will review Applicant's motion. Notably, however, Applicant's submission of March 7, 2020, did not indicate proof of service as required under Trademark Rule 2.116(a). For efficiency, the Board has considered Applicant's March 7<sup>th</sup> submission.

<sup>2</sup> The purpose of a motion to dismiss is to bring to the Board's attention that the plaintiff's (here, Opposer's) pleading fails to state a claim upon which relief can be granted. Whether the plaintiff can prevail on the merits is a matter to be resolved at trial or upon a properly filed motion for summary judgment. *See Prosper Bus. Dev. Corp. v. Int'l Bus. Machs., Corp.*, 113 USPQ2d 1148, 1152 (TTAB 2014); *see also Libertyville Saddle Shop Inc. v. E. Jeffries & Sons, Ltd.*, 22 USPQ2d 1994, 1597 (TTAB 1992) ("A motion to dismiss does not involve a determination of the merits of the case...").

Rather, Applicant is actually arguing the merits of the opposition and has submitted evidence in support of his arguments. As such, Applicant's submission is more akin to a motion for summary judgment, rather than a motion to dismiss.

In order to move for summary judgment, however, a party must have served its initial disclosures prior to its motion for summary judgment, unless the motion is based upon a claim of issue or claim preclusion or lack of jurisdiction. Trademark Rule 2.127(e)(1). In this case, Applicant has not yet filed an answer, his submission was filed prior to the deadline for serving initial disclosures, and there is no indication in the motion that Applicant has already served his initial disclosures. In view thereof, to the extent Applicant's motion can be considered a motion for summary judgment, the Board **DENIES** Applicant's motion as premature. *See id.* Accordingly, Applicant's motion will not be considered and an answer is due, as discussed later in this order.<sup>3</sup>

## **II. Proof of Service is Required on ALL Submissions to the Board**

As noted supra, Applicant did not include proof of service for his submission on March 7, 2020 that provides proof of service for his February 22, 2020 submission. Applicant is reminded that under Trademark Rules 2.119(a) and (b), **ALL** submissions to the Board must be served on Opposer's counsel of record and each submission must show that it has been served on Opposer's counsel. **Proof of such service must be made before any paper will be considered by the Board.** Consequently, copies of all papers which Applicant may file in this proceeding

---

<sup>3</sup> Information regarding an answer may be found at the conclusion of this order.

(including for Applicant, the answer required herein) must be accompanied by “proof of service” of a copy on Opposer’s counsel.

“Proof of service” usually consists of a signed, dated statement attesting to the following matters: (1) the title or nature of the paper being served, (2) the method of service (*i.e.*, electronic mail), (3) the person being served and the email address used to effect service, and (4) the date of service. This written statement should take the form of a “certificate of service” which should read as follows:

The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was served upon Opposer by forwarding said copy, via email to: [insert email address].

The certificate of service must be signed<sup>4</sup> and dated.

### **III. Opposer’s Fraud Claim is Insufficient; Repleading Allowed**

To avoid further motions practice and for judicial efficiency, the Board has reviewed the sufficiency of Opposer’s notice of opposition. *See NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1039 n.19 (TTAB 2014) (Board may *sua sponte* dismiss any insufficiently pleaded claim); *cf. Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1600 n.2 (TTAB 1999) (in view of applicant’s statement that it intended to file another motion to strike, and to avoid a further round of papers, the Board reviewed opposer’s amended pleading and *sua sponte* struck certain paragraphs as failing to state proper grounds for opposition).

---

<sup>4</sup> An electronic signature comprises a forward slash, “/”, placed before and after the typed name of the person actually signing the document. *See* Trademark Rule 2.193; *see also* TBMP §§ 106.02 and 106.03.

### **A. Fraud Claim is Insufficiently Pleaded**

Fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes a false, material representation of fact in connection with an application to register with the intent of obtaining a registration to which it is otherwise not entitled. *See In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1939 (Fed. Cir. 2009); *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986); *Swiss Watch Int’l Inc. v. Fed’n of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1745 (TTAB 2012). Fed. R. Civ. P. 9(b) provides that the circumstances constituting the alleged fraud shall be stated with particularity. *See King Automotive, Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801, 803 (CCPA 1981) (“the pleadings [must] contain explicit rather than implied expressions of the circumstances constituting fraud”); 5A Charles Alan Wright et al., *Fed. Prac. & Proc.* § 1298 (3d ed. Jan. 2018) (discussing particularity requirement of Fed. R. Civ. P. 9(b)). Intent to deceive is an indispensable element of the analysis in a fraud case. *See In re Bose Corp.*, 91 USPQ2d at 1941.

Additionally, under *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010), a plaintiff claiming that the declaration or oath in a defendant’s application for registration was executed fraudulently, as in this case, in that there was another use of the same or a confusingly similar mark at the time the oath was signed, must allege particular facts which, if proven, would establish the following:

- (1) There was in fact another use of the same or a confusingly similar mark at the time the oath was signed;
- (2) The other user had legal rights superior to Applicant’s;

(3) Applicant knew that the other user had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise; and

(4) Applicant, in failing to disclose these facts to the U.S. Patent and Trademark Office, intended to procure a registration to which it was not entitled.

*See Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1205 (TTAB 1997).

Opposer's fraud claim is insufficiently pleaded because its allegation of intent to deceive is ambiguous. Specifically, although Opposer pleads in paragraph 20 that "Applicant made the false Declarations willfully, knowing they were false at the time they were made," 1 TTABVUE 7, Opposer undercuts that allegation by asserting in paragraph 21 that "the only inference from the foregoing is that Applicant made the Declarations to mislead the USPTO ...," ¶ 21, 1 TTABVUE 7. In view thereof, Opposer has failed to plead the required element of intent to deceive. *See King Automotive*, 212 USPQ at 803 ("the pleadings [must] contain explicit rather than **implied** expressions of the circumstances constituting fraud") (emphasis added). Further, the meaning of paragraph 20 is unclear to the extent Opposer alleges "which Applicant signed, acknowledging that Opposer is the owner of the Danny's Mark and that Applicant has no right to use the Danny's Mark." 1 TTABVUE 7. It appears that wording is missing from that phrase. Additionally, Opposer's allegations do not set forth the elements set forth in *Qualcomm* and in *Intellimedia Sports*. Accordingly, paragraphs 19-22, and 26 of the notice of opposition, which comprise the allegations

in Opposer's fraud claim, are hereby **STRICKEN**. See Fed. R. Civ. P. 12(f); Trademark Rule 2.116(a).

It is the general practice of the Board to allow a party an opportunity to correct a defective pleading. See *Intellimedia Sports*, 43 USPQ2d at 1208; *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714 (TTAB 1993); TBMP § 503.03. Accordingly, Opposer is allowed until **THIRTY DAYS** from the mailing date of this order to submit an amended notice of opposition that sets forth a sufficient claim of fraud,<sup>5</sup> failing which the opposition will move forward solely on its claim of likelihood of confusion and the fraud claim will be given no further consideration. If Opposer submits an amended notice of opposition, Applicant is allowed until **THIRTY (30) DAYS** from the date of service of Opposer's amended pleading to submit an answer thereto.<sup>6</sup>

---

<sup>5</sup> Opposer is reminded that our primary reviewing court, the Court of Appeals for the Federal Circuit, has made clear that fraud must be proven to the hilt and that the standard "should have known" for attributing knowledge to the defending party is not the proper one. See *In re Bose Corp.*, 91 USPQ2d 1938, 1939-40 (Fed. Cir. 2009). "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). Therefore, unless a party alleging fraud can point to clear and convincing evidence that supports drawing an inference of deceptive intent, it will not be entitled to judgment on a fraud claim. *Bose*, 91 USPQ2d at 1942. Additionally, any doubt must be resolved against the party making a claim of fraud. *Id.* at 1939; *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1035 (TTAB 2007); *Smith Int'l*, 209 USPQ at 1044.

Further, as regards any amended pleading, Opposer is reminded that under Rule 11 of the Federal Rules of Civil Procedure, Opposer is certifying that all claims and other legal contentions asserted therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law. See Fed. R. Civ. P. 11.

<sup>6</sup> If Opposer does not file an amended notice of opposition containing a proper claim of fraud in addition to the claim of likelihood of confusion, then Applicant must answer the original notice of opposition, not including the stricken paragraphs 19-22 and 26, discussed above.

**B. Likelihood of Confusion Claim is Sufficiently Pleaded**

To plead a sufficient claim under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), only a general allegation of likelihood of confusion is required. *See The Wet Seal, Inc. v. FD Management, Inc.*, 82 USPQ2d 1629, 1640 n.21 (TTAB 2007) (“Opposer is not required to specifically plead every factual component of a likelihood of confusion claim.”). Opposer has met that requirement by alleging in paragraph 25 that “the proposed DANNYS DELI mark set forth in the Challenged Application is barred from registration because it consists of or comprises a mark which so resembles Opposer’s previously used and not abandoned Danny’s Mark as to be likely, when used in connection with the alleged goods and services of Applicant, to cause confusion, mistake, or deception within the meaning of 15 U.S.C. § 1052(d).” 1 TTABVUE 8.

As regards to priority, because Opposer does not plead ownership of a trademark registration, it is sufficient for Opposer to allege that it has a proprietary interest in the mark DANNYS DELI and that it has priority vis-à-vis Applicant. *See* Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d); *see also Herbko Int’l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Otto Roth & Co., Inc. v. Universal Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). Opposer has sufficiently alleged a proprietary interest in its mark and priority by alleging same in paragraphs 3, 5, 7, 8, 11 and 15 of the notice of opposition. *See* 1 TTABVUE 4-6.

#### IV. Proceeding Resumed; Trial Dates Reset

This proceeding is resumed.<sup>7</sup> As discussed, Opposer is allowed until THIRTY DAYS from the mailing date of this order (i.e., May 11, 2020) to submit an amended notice of opposition. Trial dates are reset as shown in the following schedule:

<b>Time to Answer</b>	<b>6/10/2020</b>
<b>Deadline for Discovery Conference</b>	<b>7/10/2020</b>
<b>Discovery Opens</b>	<b>7/10/2020</b>
<b>Initial Disclosures Due</b>	<b>8/9/2020</b>
<b>Expert Disclosures Due</b>	<b>12/7/2020</b>
<b>Discovery Closes</b>	<b>1/6/2021</b>
<b>Plaintiff's Pretrial Disclosures Due</b>	<b>2/20/2021</b>
<b>Plaintiff's 30-day Trial Period Ends</b>	<b>4/6/2021</b>
<b>Defendant's Pretrial Disclosures Due</b>	<b>4/21/2021</b>
<b>Defendant's 30-day Trial Period Ends</b>	<b>6/5/2021</b>
<b>Plaintiff's Rebuttal Disclosures Due</b>	<b>6/20/2021</b>
<b>Plaintiff's 15-day Rebuttal Period Ends</b>	<b>7/20/2021</b>
<b>Plaintiff's Opening Brief Due</b>	<b>9/18/2021</b>
<b>Defendant's Brief Due</b>	<b>10/18/2021</b>
<b>Plaintiff's Reply Brief Due</b>	<b>11/2/2021</b>
<b>Request for Oral Hearing (optional) Due</b>	<b>11/12/2021</b>

---

<sup>7</sup> Whenever a motion to dismiss is filed, the proceeding is automatically suspended pending the Board's disposition of that motion, even if a suspension order is not issued. *See* Trademark Rule 2.127(d).



Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125, 37 C.F.R. §§ 2.121-2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a), 37 C.F.R. § 2.129(a).



**THE FOLLOWING INFORMATION ON BOARD PROCEEDINGS IS PROVIDED AS A COURTESY TO APPLICANT.**

**Nature of an Opposition Proceeding**

An *inter partes* proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions; discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the

presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. **No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.**

### **Legal Representation Is Strongly Encouraged**

It should also be noted that while Patent and Trademark Rule 10.14 permits any person to represent itself, or him or herself, it is generally advisable for a person (including an entity) who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition or cancellation proceeding to secure the services of an attorney who is familiar with such matters. The U.S. Patent and Trademark Office cannot aid in the selection of an attorney.

It is recommended that Applicant obtain a copy of the latest edition of Title 37 of the Code of Federal Regulations, which includes the Trademark Rules of Practice. These rules may be viewed at the USPTO's Trademarks page: <https://www.uspto.gov/trademark/laws-regulations>. The Board's main webpage, <https://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board>, includes information on the Trademark Rules applicable to Board proceedings, on the Board's online systems, Alternative Dispute Resolution (ADR), Frequently Asked Questions about Board proceedings, and a web link to the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP").<sup>8</sup> Further, all Board

---

<sup>8</sup> The TBMP may be accessed at the following URL: <https://tbmp.uspto.gov/RDMS/TBMP/current#/current/tbmpd0e18.html>.

proceedings and other information regarding the Trademark Trial and Appeal Board may be accessed at the following URLs: <http://ttabvue.uspto.gov/ttabvue/> and <http://www.uspto.gov/trademarks/process/appeal/index.jsp>.

### **Applicant is Required to File an Answer**

Applicant must file an answer in response to the notice of opposition. Said answer must comply with Federal Rule of Civil Procedure 8(b). Fed. R. Civ. P. 8(b) provides, in part:

A party shall state in short and plain terms the party's defenses to each claim asserted and shall **admit or deny** the averments upon which the adverse party relies. *If a party is without knowledge or information sufficient to form a belief as to the truth of an averment, the party shall so state and this has the effect of a denial.* Denials shall fairly meet the substance of the averments denied. When a pleader intends in good faith to deny only a part or a qualification of an averment, the pleader shall specify so much of it as is true and material and shall deny only the remainder.

In accordance with Federal Rule 8(b), Applicant must answer the notice of opposition by admitting or denying the allegations contained in each paragraph. Ordinarily, the applicant or respondent (the defending party) will use the same paragraph numbering format found in the complaint (notice of opposition or petition to cancel), that is, if there are 25 paragraphs in the notice of opposition, the answer should also include 25 paragraphs to correspond to each allegation in the notice of opposition. If Applicant is without sufficient knowledge or information on which to form a belief as to the truth of any one of the allegations, he should so state and this will have the effect of a denial.

### **Electronic Submissions to the Board**

All submissions in Board proceedings must be made via ESTTA, the Electronic System for Trademark Trials and Appeals, and must be in compliance with Trademark Rules 2.126(a) and 2.126(b). *See* TBMP § 110.01. The ESTTA user manual, ESTTA forms, and instructions for their use are located at <http://estta.uspto.gov/>.

### **All Parties Must Comply with Board Deadlines**

While it is true that the law favors judgments on the merits wherever possible, it is also true that the Patent and Trademark Office is justified in enforcing its procedural deadlines. *Hewlett-Packard v. Olympus*, 18 USPQ2d 1710 (Fed. Cir. 1991). **Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel.**

### **Applicant's Correspondence Address**

Applicant is reminded that it is his responsibility to ensure that the Board<sup>9</sup> has his current correspondence address, including email address and telephone number. *See* TBMP § 117.07 (If a party fails to notify the Board of a change of address, with the result that the Board is unable to serve correspondence on the party, default judgment may be entered against the party).

---

<sup>9</sup> When an *inter partes* proceeding is not pending before the Board, the registrant must maintain a current address with the Trademark Office.

## **General Information on Discovery Conferences**

Applicant is referred to the Board's institution order in this proceeding and to the following URL:

[http://www.uspto.gov/trademarks/process/appeal/RULES08\\_01\\_07.pdf](http://www.uspto.gov/trademarks/process/appeal/RULES08_01_07.pdf), see, e.g., pp. 42245, 42246, 42248 and 42252.

During the conference, the following topics must be discussed:

- (1) The nature of and basis for their respective claims and defenses;
- (2) The possibility of settling the case or at least narrowing the scope of claims or defenses, and;
- (3) Arrangements relating to disclosures, discovery and introduction of evidence at trial, should the parties not agree to settle the case.

Either party may request the participation of the Board in the discovery conference.

See Trademark Rule 2.120(a)(2), 37 C.F.R. § 2.120(a)(2).

## **Information on Initial Disclosures**

Applicant is referred to TBMP § 401.02 and to the following web addresses to obtain information regarding initial disclosures:

[http://www.uspto.gov/trademarks/process/appeal/RULES08\\_01\\_07.pdf](http://www.uspto.gov/trademarks/process/appeal/RULES08_01_07.pdf) and to

<http://edocket.access.gpo.gov/2006/pdf/06-197.pdf> or to

[http://www.uspto.gov/trademarks/process/appeal/RULES01\\_17\\_06.pdf](http://www.uspto.gov/trademarks/process/appeal/RULES01_17_06.pdf). See Notice

of Final Rulemaking ("Miscellaneous Changes to Trademark Trial and Appeal

Board Rules") in the Federal Register, 72 Fed. Reg. 147 (August 1, 2007) and 71

Fed. Reg. 10, 2501 (January 17, 2006).

