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

Proceeding no.	91278510
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Date	05/10/2023
Attachments	135 147 Memorandum in Opposition to Applicants Motion to Dismiss.pdf(237997 bytes ) 135-147 Exhibit A20230510.pdf(1368268 bytes ) 135-147 Exhibit B20230510.pdf(1065797 bytes ) 135-147 Appendix of Unreported Cases.pdf(2003184 bytes )

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

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**DANIEL BAUM COMPANY,**

**Opposer,**

v.

Opposition No. 91278510

**BENEFICIAL BIOME SOLUTIONS, INC.**  
**Applicant.**

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Application Ser. No. 90/197,510

**MEMORANDUM IN OPPOSITION TO APPLICANT’S MOTION TO DISMISS  
OPPOSER’S NOTICE OF OPPOSITION FOR FAILURE TO STATE A CLAIM UNDER  
FED. R. CIV. P. 12(B)(6)**

Opposer, Daniel Baum Company, hereby submits this Memorandum in Opposition to Applicant’s Motion to Dismiss for Failure to State a Claim as served on April 21, 2023. [16 TTABVUE 1-16]. Specifically, Applicant’s seeks to dismiss the Notice of Opposition on the grounds that Opposer has failed to state a claim (1) for voidance based on a challenge to Applicant’s *bona fide intent* to use the mark FORTITUDE from what was initially described as “processes and products that support human and animal health and wellbeing” to what was later amended to read as “biotechnology derived antimicrobial disinfectants;” (2) for fraud based on Applicant’s allegedly deceitful actions following receipt of Opposer’s cease and desist letter, and

finally, (3) for failure to state a claim for a likelihood of confusion under Section 2(d) of the Trademark Act.

The thrust of Applicant's Motion is that an applicant has the inherent right to drastically change or amend its *bona fide intent* to use from its initial description of goods from one "core" type of product to another "core" type of product. [16 TTABVUE 4]. Further, that Opposer has not "shown" Applicant's "intent" in a "clear and convincing manner" to defraud the Trademark Office and "thus a claim of fraud is far from clear" together with Opposer's failure to plead the requisite particularity required under Fed. Rule Civ. Pro. 9. [*Id.* at 6-7]. And finally, that Opposer fails to state a claim for a likelihood of confusion under Section 2(d) because Opposer "has not shown a buyer would have confusion between Beneficial Biome's product and the product of Daniel Baum and thus a likelihood of confusion is far from possible." [*Id.* at 8].

Applicant's Motion to Dismiss should be denied in its entirety. When construed with the factual background, the Board may properly draw inferences from Applicant's own website pages about the "nutritional" related product it initially intended to be used under the FORTITUDE mark to the "disinfectant" product it now claims – a deceitful "carve out" following (a) the Examining Attorney's 2(d) refusal based on Opposer's previously used and registered mark for FORTITUDE for nutritional supplements for horses and canines and (b) receipt of Opposer's cease and desist letter dated June 18, 2021. [1 TTABVUE 23-26].

Further, Applicant's Motion to Dismiss the claim for a likelihood of confusion should equally fail to the extent Applicant effectively and improperly seeks a Motion for Summary Judgment on the likelihood of confusion claim. Applicant conveniently ignores that its products – whether it is the "nutritional supplement" it initially intended or the "disinfectant" it now claims –

are likely to move within the same channels of trade and are likely to be purchased by the same class of purchaser, all under the identical FORTITUDE mark and name.

In the event the Board should find any merit to Applicant's Motion to Dismiss, then Opposer should be given the opportunity to amend its Notice of Opposition.

### **FACTUAL BACKGROUND**

While detailed in the Notice of Opposition, a summary of the relevant facts and background appears prudent.

In this connection, on September 21, 2020, Applicant filed an application to register the mark FORTITUDE under Section 1(b) of the Trademark Act with a *bona fide intent* to use the mark for "Processes and products that support human and animal health and wellbeing." Shortly before the filing of this intent to use application, Applicant also filed a Non-Provisional U.S. Patent Application No. 17/001,440 on August 24, 2020 entitled "Anti-microbial Amalgamate of Non-Toxic Native Composition." Its abstract reads in relevant part as follows:

"An anti-microbial formulation of native ingredients for human and non-human vertebrate **animal feeds, feed supplements/additives**, or for direct doses to replace in whole or supplement traditional anti-microbial with ...non-toxic, side-effect free native substances amalgamations having anti-microbial properties for **food additives, food supplements**, or direct doses." [See Exhibit A – Abstract for U.S. Patent Appl. Ser. No. 17/001,440 as filed on August 24, 2020].

Consistent with both its trademark application and patent application, Applicant in its website of May 24, 2021 stressed and promoted the "nutritional" mission of Applicant's company:

'Beneficial Biome Solutions, Inc. was formed . . . with a mission to address urgent global health care challenges for people and animals using earth's natural tools. \*\*\* Inspired by the need for quality healthcare and **nutrition for animals** everywhere, he understood that good health, in large part, is indicative of the **nutrition animals** receive. \*\*\* This led to the discovery of a natural and sustainable ingredient formulation that not only supports the **nutritional need of animals**, but has proven in laboratory tests to destroy disease causing

bacteria, yeast and fungi that would normally require antibiotics.” (Emphasis added) [See 1 TTABVUE 21].

In an Official Action dated February 12, 2021, the Examining Attorney in the subject application did initially refuse registration under Section 2(d) finding a likelihood of confusion with Opposer’s previously used and registered mark covering FORTITUDE. On June 18, 2021, Opposer did transmit by certified mail a cease-and-desist letter demanding that Applicant abandon its application and cease and desist from all use and prospective use of the FORTITUDE mark and name in view of Opposer’s prior use and registration, and the closely related nature of the products intended to be covered by the FORTITUDE mark. [*Id.* at 23-26].

Rather than agree to cease and desist use of the FORTITUDE mark and abandon its application as demanded, Applicant instead, embarked upon a course of action to “carve out” or “reinvent” its *bona fide intent* to use and to traverse the Examining Attorney’s refusal under Section 2(d). Specifically, on August 19, 2021 Applicant did submit a response to the Official Action of February 12, 2021, and did amend its description of goods to read:

--Biotechnology derived antimicrobial disinfectant—

Applicant, also proceeded to argue in its response that its “...disinfecting product will be sprayed upon carcasses at slaughterhouses, poultry farms, and processing facilities” and that the “goods at issue, disinfectant, have separate uses and functions than the equine and canine additives and foods supplements of the cited registrations.” [See Applicant’s Response in the subject application dated August 12, 2021 at page 5-6].

Applicant also around this time drastically changed the verbiage of its mission statement on its website at <<https://beneficialbiome.com/about>> to now read as of August 19, 2021 in relevant part:

“Beneficial Biome Solutions, Inc. was formed . . . with a mission to address urgent health challenges impacting the global community by harnessing earth’s natural tools. \*\*\* Inspired by the need for quality healthcare and nutrition everywhere, he understood that fighting disease is key to improving life for the global community. \*\*\* This led to the discovery of a biotechnology that in laboratory tests has proven to destroy disease causing pathogens, including bacteria, yeast and fungi and other microbial organisms without application of manufactured antibiotic or disinfectants.....” [1 TTABVUE 32].

In reliance on Applicant’s amendment to its identification of goods and its representations in its arguments, the Examining Attorney withdrew the refusal under Section 2(d) and passed the application onto publication.

## LEGAL STANDARD

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. *See, e.g., Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). The Supreme Court in *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544 (2007) and *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S. Ct. 1937 (2009), set forth the test to be used to determine the sufficiency of a complaint in the context of a Rule 12(b)(6) motion to dismiss. “To survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Iqbal*, 556 U.S. 662, 129 S. Ct. at 1949 (citing *Twombly*, 550 U.S. at 570)). A claim to relief is “plausible on its face,” if it contains enough facts to raise a reasonable inference that the defendant is liable for the misconduct alleged. *See id.*; *see also Twombly*, 550 U.S. at 556 (stating that a facially plausible complaint “simply calls for enough fact to raise a reasonable expectation that discovery will reveal evidence of [the unlawful conduct alleged].”).

Under this “plausibility standard,” the court is not required to find that the misconduct alleged will be established with probability; rather, the court need only find that the pleaded facts show “more than a sheer possibility that a defendant has acted unlawfully.” *Iqbal*, 556 U.S. 662, 120 S. Ct. at 1949. In identifying facts that are suggestive enough to render a claim “plausible” and not merely “possible,” a court may look to prior rulings finding the misconduct at issue sufficiently alleged. *See Twombly*, 550 U.S. at 556. This is “a context specific task that requires the reviewing court to draw on its judicial experience and common sense.” *Iqbal*, 556 U.S. 662, 129 S.Ct. at 1950.

The “plausibility standard” announced by the Supreme Court in *Twombly* and *Iqbal* has been adopted by the Board. As stated in Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 503.02, “[i]n order to withstand...a motion [to dismiss for failure to state a claim], a complaint need only allege such facts that would, if proved, establish that the plaintiff is entitled to the relief sought.... To survive a motion to dismiss, a complaint must ‘state a claim to relief that is plausible on its face.’” *Id.* (citing *Twombly*, 550 U.S. at 570).

With respect to the procedure by which the Board is to test the legal sufficiency of a pleading, the Supreme Court has provided the following guidance:

a court considering a motion to dismiss can choose to begin by identifying pleadings that, because they are no more than conclusions, are not entitled to the assumption of truth. [However,] [w]hen there are well-pleaded factual allegations, a court should assume their veracity and then determine whether they plausibly give rise to an entitlement to relief. *Iqbal*, 556 U.S. 662, 129 S. Ct. at 1950 (emphasis added).

Moreover, under TBMP Section 503.02, “[w]hensoever the sufficiency of any complaint has been challenged by a motion to dismiss, it is the duty of the Board to examine the complaint in its entirety, construing the allegations therein so as to do justice, as required by Fed. R. Civ. P. 8(e), to determine whether it contains any allegations which, if proved, would entitle the plaintiff to the

relief sought. *See id.* (Citing *IdeasOne Inc. v. Nationwide Better Health*, 89 U.S.P.Q.2d 1952, 1953 (T.T.A.B. 2009)).

## ARGUMENT

### **A. Opposer’s Allegations that Applicant violated Section 1(b) of the Trademark Act are certainly “Plausible”**

When viewed within the factual context as presented in paragraphs 1-14 of the Notice of Opposition, there is certainly a clear question about Applicant’s true *bona fide intent* regarding the products upon which it intends to use the FORTITUDE mark under Section (1)(b) of the Trademark Act. Is it Applicant’s intent to use the mark FORTITUDE for “nutritional products” for animals and livestock when it initially provided the description of “processes and products that support human and animal health and wellbeing? Or is it now Applicant’s *bona fide intent* to use the mark for “disinfectants?” – a product description that appeared only after receipt of Opposer’s cease and desist letter and as an obvious “carve out” of its broad description to traverse the Examining Attorney’s refusal under Section 2(d).

The answer to this question is very important. In order to secure the benefits of the Trademark Act, namely a constructive use date, an applicant must meet certain statutory requirements. In particular, the applicant under Section 1(b)(2) “shall include specification of the .... goods in connection with which the applicant has a bona fide intention to use the mark” and such specification under Section 1(b)(3) “shall be verified by the applicant” under the penalties of perjury. The constructive use date provides, in relevant part, due notice to the public of applicant’s intentions, facilitates proper examination by the PTO, and accords the applicant potential rights of priority.



On the one hand, as evidenced by its website prior to receipt of Opposer’s cease and desist letter, it was clear Applicant had the *bona fide intent* to use the mark for “nutritional” related products. [1 TTABVue 21]. This fact is buttressed by the patent application Applicant filed shortly before filing its trademark application. [See Exhibit A -Abstract for U.S. Patent Appl. Ser. No. 17/001,440 as filed on August 4, 2020]. It is also buttressed by the companion trademark application Applicant filed to register the mark “4 CHIX and Design.” This application initially covered the same description as the subject application, namely, “processes and products that support human and animal health and wellbeing” but was later amended to read as “animal feed additives for use as a **nutritional supplement** for preventive health.” [See Exhibit B - U.S. Trademark Application Ser. No. 90/197,458 “4 CHIX and Design” as filed on September 21, 2020 and amended on August 10, 2021].

Or is it now Applicant’s *bona fide intent* to use the mark for “disinfectants?” – a product description that appeared only after receipt of Opposer’s cease and desist letter and which amendment appears as no more than an obvious “carve out” of its broad description to traverse the refusal under Section 2(d).

As recognized by the TTAB, the realities of the Applicant’s use or intended use should not be ignored. *See In re: The Eyecare Foundations, Inc.*, 2011 TTAB Lexis 65 (TTAB Mar. 10, 2011) (“We agree with the Trademark Examining Attorney that this tribunal should not be required to ignore the realities of use actually made by applicant merely because it made a tactical decision explicitly to carve out from the application’s recitation of services what are arguably its core services – **motivated only by the desire to foil a refusal of mere descriptiveness.**” (Copy attached – Appendix of Unreported Cases); *see also In re DNI Holdings, Ltd.*, 77 USPQ2d 1435 (TTAB 2005) (“Accordingly, despite Applicant’s tactical decision to carve them out of its recitation

of services, we find that the relevant genus of services herein includes wagering on sporting events.”). Similarly, *In re Allied Stores Corp.*, 153 USPQ 84 (TTAB 1967), the Board looked beyond the stated description and reviewed the specimens to determine the actual use of the mark.

“Nutritional supplements” and “disinfectants” are drastically different “core” products that raise a question about Applicant’s true *bona fide intent* at the time it filed its intent to use application under Section 1(b). While an applicant has the right to amend and limit one’s description of goods, one does not have the right to drastically change the true nature of its *bona fide intent* at the time it filed the application without violating Section 1(b)(2) and (3), and without voiding the application *ab initio*.

Under the legal standard, it is incumbent upon the Board to accept Opposer’s well pleaded factual allegations as true, and if the claim is plausible, then the Opposer has stated a claim for relief. In doing so, the Board has the right to consider the website material submitted, Applicant’s companion trademark application, and its related patent application that evidence Applicant’s *bona fide intent*. The only way of establishing Applicant’s true intent in this particular situation, is through the process of formal discovery. Accordingly, the Motion to Dismiss this claim should be denied.

**B. Opposer’s allegations of fraud are certainly plausible and are pled with sufficient particularity.**

As set forth *In re Bose Corp.*, 580 F.3d 1240, 1245, 91 U.S.P.Q. 2d 1938 (Fed. Cir. 2009), the elements of a claim for fraud on the Patent and Trademark Office are as follows:

1. The applicant or registrant must knowingly make a false material representation.

2. That the false material representation was made with the intent to deceive the PTO, and finally,
3. That the PTO relied upon the material false representation.

Applicant contends that the Notice of Opposition should be dismissed because, with respect to the element of Applicant's intent, there are effectively no alleged facts or circumstances by which a finder of fact could affirm the state of mind allegation. Specifically, Applicant alleges in its Motion at page 4 that Opposer "has not yet produced clear and convincing evidence about false material representations of fact by Beneficial Biome in this application" and that Opposer "has not shown Beneficial Biome's intent to defraud the Trademark Office and thus a claim of fraud is far from clear." [16 TTABVUE 5-6].

Fed. R. Civ. P. 9(b) requires that the circumstances constituting the alleged fraud to be stated with particularity, but expressly permits conditions of a person's state of mind, such as "knowledge" and "intent" to be alleged generally. *See* Fed. R.Civ. P. 9(b). Federal Circuit precedent recognizes that under Rule 9(b), the "knowledge" and "intent" elements of a claim sounding in fraud may be alleged generally; however, Federal Circuit precedent also requires that "a pleading must still allege sufficient underlying facts from which a court may reasonably infer that a party acted with the requisite state of mind." *Exergen Corp. v. Wal-Mart Stores, Inc.* 575 F.3d 1312, 1327, n. 4, 91 U.S.P.Q. 2d (BNA) 1656 (Fed. Cir. 2009).

Applicant's attempt to require Opposer, at the pleading stage, to satisfy the clear and convincing standard, which applies to a determination on the merits, is improper. In *Exergen, supra*, the Federal Circuit clearly explained the difference in the inference to be drawn from the facts alleged at the pleading stage versus the facts to be proved on a determination of the merits of a claim sounding in fraud. As stated:

In contrast to the pleading stage, to prevail on the merits, the accused infringer must prove both materiality and intent by clear and convincing evidence . . . Whereas an inference of deceptive intent must be reasonable and drawn from a pleading's allegations of underlying fact to satisfy Rule 9 (b), this inference must be 'the single most reasonable inference able to be drawn from the evidence to meet the clear and convincing standard.'

*Exergen* makes clear that, at the pleading stage, the requirements of Rule 9(b) govern, and not the "clear and convincing" standard which must be met to prevail on the merits. To satisfy Rule 9(b), a complaint need only include sufficient allegations of underlying facts from which a court may reasonably infer the requisite knowledge and intent elements of a claim for fraud. *See Exergen*, 575 F.3d at 1328-29. "A reasonable inference is one that is plausible and that flows logically from the facts alleged, including any objective indications of candor and good faith." *Id.* at 1329 n. 5.

In *Daimlerchrysler Corp. v. American Motors Corp.*, 94 U.S.P.Q. 2d 1086 (TTAB 2010), the Board held that "where a pleading asserts that a known misrepresentation, on a material matter, is made to procure a registration, the element of intent, indispensable to a fraud claim, has been sufficiently pled." In that case, the petitioner pled that the respondent had submitted a Statement of Use and specimens to the PTO in which the respondent represented that it was using its mark in commerce with automobiles and structural parts for automobiles, when, in fact, respondent never offered, advertised or sold automobiles or structural parts under its mark. *Id.* The Board concluded that such allegations, when combined with references to "material misrepresentations" "knowingly made" and "to procure" a registration, constituted sufficient allegations of respondent's intent to deceive the PTO, and satisfied not only the particularity requirements of Rule 9 (b), but also the general pleading requirements for fraud under *In re Bose, supra. Id.*

Contrary to Applicant's attempt to place the burden on Opposer to state "clear and convincing" facts to show material misrepresentations and a clear intent to defraud, Opposer need only allege facts from which the Applicant's state of mind and misrepresentations may be inferred.

As recognized in *Bose Corp.*, because “**direct evidence of deceptive intent is rarely available, such intent can be inferred from indirect and circumstantial evidence.**” 580 F.3d at 1245 (emphasis added and citation omitted).

As stated in paragraphs 22-26 of the Notice of Opposition, Opposer effectively alleges two types of fraud upon the PTO by Applicant: First, that Applicant intentionally misled the Examining Attorney about the true nature of its intended products. And secondly, that Applicant specifically misled the Examining Attorney when it continued to assert that no other persons have the right to use the FORTITUDE mark, when in fact Applicant had received actual and formal notice of Opposer’s exclusive and registered rights to the FORTITUDE mark for closely related products.

In this connection, Opposer’s allegations are not general or conclusory, but rather provide specific facts from which Applicant’s intent may be inferred. *See Meth Lab Cleanup LLC v. Spaulding Decon, LLC*, No. 8:10-cv-2550-T-30TGW, 2011 U.S. Dist. Lexis 14455, \*6 (M.D. Fla. Feb 4, 2011) (defendants had sufficiently alleged a claim of fraud, based on facts that the plaintiffs knowingly submitted false affidavits claiming that the marks at issue had become distinctive through substantial and exclusive use, when they knew that they were not, in fact, the only users of the marks.” (Copy attached - Appendix of Unreported Cases). *Cf. Swiss Watch Int’l, Inc. Federation of the Swiss Watch Indus., 2012 TTAB LEXIS 3*, \*52 (TTAB Jan. 30, 2012) (recognizing that “deliberately omitting relevant portions of a document, or making a statement that, while true, gives only part of the story and therefore is deliberately designed to mislead, may be treated as a false statement in this effect and also show the necessary element of intent.”). (Copy attached- Appendix of Unreported Cases).

Paragraph 24 of the Notice of Opposition specifically alleges that Applicant’s amendment to the description of goods to “disinfectants” was (1) intentionally false and misleading; (2)

purposely misled the Examining Attorney as to the true nature of Applicant's intended products, and (3) through such deceitful actions, prompted the Examining Attorney's reliance to withdraw the refusal under Section 2(d).

Paragraph 25 of the Notice of Opposition specifically alleges that Applicant's amendment and arguments following Opposer's cease and desist letter were (1) intentionally false and misleading; (2) violated Applicant's claims that to the best of its knowledge and belief, "no other persons have the right to use the FORTITUDE mark..." under the penalties of perjury, notwithstanding Opposer's cease and desist letter, and (3) through such deceitful actions, prompted the Examining Attorney's reliance on such representations to withdraw the refusal under Section 2(d).

By any standard, Opposer has alleged each element of its claim for fraud by Applicant. To the extent factual allegations are specifically alleged, it is incumbent upon the Board to make the necessary inferences, accept such allegations as true, and to the extent Applicant's fraudulent actions are plausible, deny Applicant's Motion to Dismiss Opposer's claims for fraud.

**C. Applicant Prematurely seeks a Motion for Summary Judgment on Opposer's Likelihood of Confusion Claim**

In paragraphs 27- 36 of the Notice of Opposition, Opposer alleges a claim for a likelihood of confusion under Section 2(d) of the Trademark Act. Applicant moves to dismiss under Rule 12(b)(6) on the grounds that Opposer "has not shown a buyer would have confusion between Beneficial Biome's product and the product of Daniel Baum and thus a likelihood of confusion is far from possible." [ 16 TTABVUE 8].

Opposer has sufficiently alleged a likelihood of confusion. In paragraph 5 of the Notice of Opposition, Opposer clearly sets forth its prior use and registration of the mark FORTITUDE. In paragraphs 29-31, Opposer alleges that such products are likely to be purchased by the same class of customer (e.g., farmers) and in paragraph 32, that such products are apt to move within the same channels of trade. By reason of such similarity between the identical marks, the class of customer and channels of trade, Opposer has sufficiently alleged that a likelihood of confusion is apt to be created once Applicant commences use of the FORTITUDE mark, regardless of Applicant's real intended product – whether it be the “nutritional supplements” as initially intended, or the “disinfectants” it now claims.

Again, it is incumbent upon the Board to accept the well pleaded facts to be true, and if the claim is plausible, deny the Motion to Dismiss.

### **CONCLUSION**

While its Opposer's position that Applicant's Motion to Dismiss should be denied in its entirety, in the event the Board should decide to grant in whole or in part Applicant's motion, the Opposer should be afforded the opportunity to amend its Notice of Opposition in relevant part. As noted in TBMP Section 503.03 (citing Fed. R. Civ. P. 15(a)(1)(B)), a notice of opposition may be amended by leave of the Board which is freely given when justice so requires. Thus, in the event the Board should find that the Notice of Opposition in whole or in part fails to state a claim, Opposer respectfully requests leave to file an amended Notice of Opposition in accordance with the Board's decision.

Respectfully submitted,

DANIEL BAUM COMPANY

/Barth X. deRosa/

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## **CERTIFICATE OF SERVICE**

Pursuant to TBMP Section 113, TTAB Rule 2.119(a) and the Federal Rule of Civil Procedure 4(h)(1), Attorney for Opposer certifies that a true copy of the foregoing Memorandum in Opposition to Applicant's Motion to Dismiss under Rule 12(b)(6), together with Exhibits A-B and the Appendix of Unreported Cases was served on the below party by email this May 10, 2023:

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

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**DANIEL BAUM COMPANY,**  
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Opposition No. 91278510

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Application Ser. No. 90/197,510

**MEMORANDUM IN OPPOSITION TO APPLICANT'S MOTION TO DISMISS  
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**EXHIBIT A**

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## 17/001,440 | BBS-MC-001 USPTO:

### ANTI-MICROBIAL AMALGAMATE OF NON-TOXIC NATIVE COMPOSITION

PUBLIC VIEW

Application #	Confirmation #	Attorney Docket #	Patent #
17/001,440	6015	BBS-MC-001 USPTO	-
Filing or 371 (c) date	Status		
08/24/2020	Non Final Action Mailed 01/20/2023		

## Application data

Application type	Earliest publication #	Intl. registration # (Hague)
Utility	<a href="#">US 2021-0052689 A1</a> 	-
Examiner	Earliest publication date	Intl. registration publication date
RANDALL O WINSTON	02/25/2021	-
Group art unit	Assignee for publication	
1655	Beneficial Biome Solutions, Inc St. Louis (US)	
Class/subclass	Confirmation #	
424/538.000	6015	
AIA (first inventor to file)		
Yes		
Entity status		
Micro		

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**Abstract:**

An anti-microbial formulation of native ingredients for human and non-human vertebrate animal feeds, feed supplements/additives, or for direct doses to replace in whole or supplement traditional anti-microbial with side-effects such as allergies, microbial-resistance, and drug-interactions with non-toxic, side-effect free native anti-microbial for all vertebrates. The invention comprises of non-toxic, side-effect free native substances amalgamations having anti-microbial properties for food additives, food supplements, or direct doses. Furthermore, these native formulas can be use with or without other prescription or non-prescription anti-microbial medications. We describe the method of manufacture and also the process of use for this amalgamates.

Electronic Acknowledgement Receipt	
EFS ID:	40368907
Application Number:	17001440
International Application Number:	
Confirmation Number:	6015
Title of Invention:	ANTI-MICROBIAL AMALGAMATE OF NON-TOXIC NATIVE COMPOSITION
First Named Inventor/Applicant Name:	Douglas S Pernikoff
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Filer:	Bela Malik
Filer Authorized By:	
Attorney Docket Number:	BBS-MC-001
Receipt Date:	24-AUG-2020
Filing Date:	
Time Stamp:	19:00:28
Application Type:	Utility under 35 USC 111(a)

**Payment information:**

Submitted with Payment	yes
Payment Type	CARD
Payment was successfully received in RAM	\$455

RAM confirmation Number		E20208NJ03186228			
Deposit Account					
Authorized User					
The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:					
<b>File Listing:</b>					
Document Number	Document Description	File Name	File Size(Bytes)/ Message Digest	Multi Part /.zip	Pages (if appl.)
1	Claims	Claims.pdf	97460	no	4
			e8f369446218d780dc589a777536c9f2cd0ae90ce		
<b>Warnings:</b>					
<b>Information:</b>					
2	Drawings-other than black and white line drawings	Drawings.pdf	345760	no	5
			1a9c7ef353dff1e4ca68dccc60d8a98de15791e95		
<b>Warnings:</b>					
<b>Information:</b>					
3	Oath or Declaration filed	Oath.pdf	987120	no	3
			66a06ab338001d225831330f8711a863b3a05d1d		
<b>Warnings:</b>					
<b>Information:</b>					
4	Certification of Micro Entity (Gross Income Basis)	certificate.pdf	817358	no	1
			025d5420c0c6ae97bd3d1c9c7cce1e3dd01c716f		
<b>Warnings:</b>					
<b>Information:</b>					
5	Power of Attorney	PowerOfAttorney.pdf	736913	no	1
			2c37c69f3cd52d3dedd3863158e30e7622fb7a1		
<b>Warnings:</b>					
<b>Information:</b>					

6	Abstract	Abstract.pdf	76462	no	1
			e85297a512fa920519c6e83a5a776e01197cd084		
Warnings:					
Information:					
7	Preliminary Amendment	PreliminaryAmendment.pdf	127399	no	6
			792e96a661ee1219dc520e97f3ce366aca135ff6		
Warnings:					
Information:					
8	Application Data Sheet	ADS.pdf	1822850	no	9
			49133d6ce6d61c699cedb24c0c9b6d9c0d0f3ea8d0		
Warnings:					
Information:					
9	Transmittal Letter	sb0016.pdf	1889294	no	3
			ffb9036efc54121eedf127cd05dcae5e89c4c948		
Warnings:					
Information:					
10	Specification	Specification.pdf	346787	no	19
			acackd54f58a17fc2817c0499e3a92de2ef7355e		
Warnings:					
Information:					
11	Fee Worksheet (SB06)	fee-info.pdf	36430	no	2
			ac3a0aa2313da16c55a8c93ff67c39ca2f10d813		
Warnings:					
Information:					
Total Files Size (in bytes):			7283833		



This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

**New Applications Under 35 U.S.C. 111**

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

**National Stage of an International Application under 35 U.S.C. 371**

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

**New International Application Filed with the USPTO as a Receiving Office**

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

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

---

**DANIEL BAUM COMPANY,**

**Opposer,**

**v.**

Opposition No. 91278510

**BENEFICIAL BIOME SOLUTIONS, INC.**  
**Applicant.**

---

Application Ser. No. 90/197,510

**MEMORANDUM IN OPPOSITION TO APPLICANT'S MOTION TO DISMISS  
OPPOSER'S NOTICE OF OPPOSITION FOR FAILURE TO STATE A CLAIM UNDER  
FED. R. CIV. P. 12(B)(6)**

**EXHIBIT B**

## Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	90197458
LAW OFFICE ASSIGNED	LAW OFFICE 118
MARK SECTION	
MARK FILE NAME	https://tmng-al.uspto.gov/resting2/api/img/90197458/large
LITERAL ELEMENT	4 CHIX
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
COLOR(S) CLAIMED (If applicable)	The color(s) Brown, Teal, Orange, and White is/are claimed as a feature of the mark.
DESCRIPTION OF THE MARK (and Color Location, if applicable)	The mark consists of the number 4 followed by the uppercase letters of "C," "H," lowercase "i," and the uppercase letter X to complete the word "4CHiX" in which above the word is a depiction of a baby chicken with a depiction of an egg on the head of the baby chicken.
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	005
DESCRIPTION	Processes and products that support human and animal health and well being
FILING BASIS	Section 1(b)
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	005
TRACKED TEXT DESCRIPTION	<del>Processes and products that support human and animal health and well being;</del> <u>products that support human and animal health and wellbeing, namely, animal feed additive for use as a nutritional supplement for preventative health</u>
FINAL DESCRIPTION	products that support human and animal health and wellbeing, namely, animal feed additive for use as a nutritional supplement for preventative health
WEBPAGE URL	None Provided
WEBPAGE DATE OF ACCESS	None Provided
FILING BASIS	Section 1(b)
ADDITIONAL STATEMENTS SECTION	
DISCLAIMER	No claim is made to the exclusive right to use FOR CHICKS apart from the mark as shown.
COLOR(S) CLAIMED (If applicable)	The color(s) brown, teal, orange, white, and black is/are claimed as a feature of the mark.

<b>DESCRIPTION OF THE MARK</b> (and Color Location, if applicable)	The mark consists of the number 4 followed by the uppercase letters of "C," "H," lowercase "I," and the uppercase letter X to complete the word "4CHiX" with the "4C" and "X" in brown and "HI" in orange, and above the wording is a depiction of a baby chicken with a teal body, white wing, black eye, and brown legs with a depiction of an orange egg on the head of the baby chicken.
<b>MISCELLANEOUS STATEMENT</b>	Applicant has amended its goods description more definitely and to keep the application within one class.
<b>CORRESPONDENCE INFORMATION (current)</b>	
<b>NAME</b>	Chuck McCloskey
<b>PRIMARY EMAIL ADDRESS FOR CORRESPONDENCE</b>	ccmlaw@socket.net
<b>SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES)</b>	NOT PROVIDED
<b>DOCKET/REFERENCE NUMBER</b>	1510
<b>CORRESPONDENCE INFORMATION (proposed)</b>	
<b>NAME</b>	Chuck McCloskey
<b>PRIMARY EMAIL ADDRESS FOR CORRESPONDENCE</b>	ccmlaw@socket.net
<b>SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES)</b>	NOT PROVIDED
<b>DOCKET/REFERENCE NUMBER</b>	1510
<b>SIGNATURE SECTION</b>	
<b>RESPONSE SIGNATURE</b>	/BBibyCCM/
<b>SIGNATORY'S NAME</b>	Charles McCloskey
<b>SIGNATORY'S POSITION</b>	Attorney of record, MO bar member
<b>SIGNATORY'S PHONE NUMBER</b>	6365279962
<b>DATE SIGNED</b>	08/10/2021
<b>ROLE OF AUTHORIZED SIGNATORY</b>	Authorized U.S.-Licensed Attorney
<b>SIGNATURE METHOD</b>	Signed directly within the form
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Tue Aug 10 11:44:21 ET 2021
<b>TEAS STAMP</b>	USPTO/ROA-XX.XX.XXX.XX-20 210810114421680429-901974 58-78171d1669ee59c2344aa4 d548a3b4fb08eac8d611b43ec 214c7abbb2ae7673ffcb-N/A- N/A-20210810113217190731

## Response to Office Action

### To the Commissioner for Trademarks:

Application serial no. **90197458** 4 CHIX (Stylized and/or with Design, see <https://tmng-al.uspto.gov/resting2/api/img/90197458/large>) has been amended as follows:



## CLASSIFICATION AND LISTING OF GOODS/SERVICES

**Applicant proposes to amend the following:**

### Current:

Class 005 for Processes and products that support human and animal health and well being

**Filing Basis: Section 1(b), Intent to Use:** *For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. *For a collective trademark, collective service mark, or collective membership mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. *For a certification mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

### Proposed:

**Tracked Text Description:** ~~Processes and products that support human and animal health and well being;~~ products that support human and animal health and wellbeing, namely, animal feed additive for use as a nutritional supplement for preventative health

Class 005 for products that support human and animal health and wellbeing, namely, animal feed additive for use as a nutritional supplement for preventative health

**Filing Basis: Section 1(b), Intent to Use:** *For a trademark or service mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. *For a collective trademark, collective service mark, or collective membership mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. *For a certification mark application:* As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

Webpage URL: None Provided

Webpage Date of Access: None Provided

## ADDITIONAL STATEMENTS

### Disclaimer

No claim is made to the exclusive right to use FOR CHICKS apart from the mark as shown.

### Color Claim

The color(s) brown, teal, orange, white, and black is/are claimed as a feature of the mark.

### Description of mark

The mark consists of the number 4 followed by the uppercase letters of "C," "H," lowercase "I," and the uppercase letter X to complete the word "4CHiX" with the "4C" and "X" in brown and "HI" in orange, and above the wording is a depiction of a baby chicken with a teal body, white wing, black eye, and brown legs with a depiction of an orange egg on the head of the baby chicken.

### Miscellaneous Statement

Applicant has amended its goods description more definitely and to keep the application within one class.

### Correspondence Information (current):

Chuck McCloskey

PRIMARY EMAIL FOR CORRESPONDENCE: ccmlaw@socket.net

SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES): NOT PROVIDED

The docket/reference number is 1510.

**Correspondence Information (proposed):**

Chuck McCloskey

PRIMARY EMAIL FOR CORRESPONDENCE: ccmlaw@socket.net

SECONDARY EMAIL ADDRESS(ES) (COURTESY COPIES): NOT PROVIDED

The docket/reference number is 1510.

**Requirement for Email and Electronic Filing:** I understand that a valid email address must be maintained by the owner/holder and the owner's/holder's attorney, if appointed, and that all official trademark correspondence must be submitted via the Trademark Electronic Application System (TEAS).

**SIGNATURE(S)**

**Response Signature**

Signature: /BBibyCCM/ Date: 08/10/2021

Signatory's Name: Charles McCloskey

Signatory's Position: Attorney of record, MO bar member

Signatory's Phone Number: 6365279962 Signature method: Signed directly within the form

The signatory has confirmed that he/she is a U.S.-licensed attorney who is an active member in good standing of the bar of the highest court of a U.S. state (including the District of Columbia and any U.S. Commonwealth or territory); and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S.-licensed attorney not currently associated with his/her company/firm previously represented the owner/holder in this matter: the owner/holder has revoked their power of attorney by a signed revocation or substitute power of attorney with the USPTO; the USPTO has granted that attorney's withdrawal request; the owner/holder has filed a power of attorney appointing him/her in this matter; or the owner's/holder's appointed U.S.-licensed attorney has filed a power of attorney appointing him/her as an associate attorney in this matter.

Mailing Address: Chuck McCloskey  
Charles C. McCloskey, LLC

13321 N. Outer 40 Rd. Ste. 100  
Chesterfield, Missouri 63017

Mailing Address: Chuck McCloskey  
Charles C. McCloskey, LLC  
13321 N. Outer 40 Rd. Ste. 100  
Chesterfield, Missouri 63017

Serial Number: 90197458

Internet Transmission Date: Tue Aug 10 11:44:21 ET 2021

TEAS Stamp: USPTO/ROA-XX.XX.XXX.XX-20210810114421680

429-90197458-78171d1669ee59c2344aa4d548a

3b4fb08eac8d611b43ec214c7abbb2ae7673ffcb

-N/A-N/A-20210810113217190731

## **Appendix of Unreported Cases**



**METH LAB CLEANUP, LLC, Plaintiff, v. SPAULDING DECON, LLC and LAURA SPAULDING, Defendants.**

**Case No. 8:10-cv-2550-T-30TGW**

**UNITED STATES DISTRICT COURT FOR THE MIDDLE DISTRICT OF  
FLORIDA, TAMPA DIVISION**

**2011 U.S. Dist. LEXIS 14455**

**February 4, 2011, Decided  
February 4, 2011, Filed**

**COUNSEL:** [\*1] For Meth Lab Cleanup, LLC, a foreign limited liability company, Plaintiff, Counter Defendant: Robert H. Thornburg, LEAD ATTORNEY, Allen, Dyer, Doppelt, Milbrath & Gilchrist, PA, Miami, FL; Ryan Thomas Santurri, Stephen D. Milbrath, LEAD ATTORNEYS, Allen, Dyer, Doppelt, Milbrath & Gilchrist, PA, Orlando, FL.

For Spaulding Decon, LLC, a Florida limited liability company, Laura Spaulding, Individually, Defendants, Third Party Plaintiffs, Counter Claimants: Enrico A. Mazzoli, Waters Law Group, PLLC, Louisville, KY.

**JUDGES:** JAMES S. MOODY, JR., UNITED STATES DISTRICT JUDGE.

**OPINION BY:** JAMES S. MOODY, JR.

**OPINION**

**ORDER**

THIS CAUSE comes before the Court upon Plaintiff's Motion to Strike Ten Affirmative Defenses and Motion for Rule 12 Dismissal of Defendants' Counterclaim (Dkt. 8) and Defendants' Response in opposition (Dkt. 13). The Court, having reviewed the motion, response, and being otherwise advised in the premises, concludes that the motion should be denied.

**BACKGROUND**

This is a copyright and trademark infringement action brought by Plaintiff Meth Lab Cleanup, LLC ("MLCC") against Defendants. MLCC offers compre-

hensive drug lab decontamination solutions, which includes decontamination for methamphetamine laboratory facilities. [\*2] MLCC offers these services under the mark METH LAB CLEANUP, as well as multiple trademark registrations, including the mark METH LAB CLEANUP LLC.

Defendant Spaulding Decon, a Tampa Bay vendor of drug decontamination services, is a former independent contractor of MLCC. Its owner, Defendant Laura Spaulding, attended one of MLCC's training seminars and was provided a copy of the training materials.

MLCC filed the instant complaint, alleging that Laura Spaulding created a copycat website, which displayed portions of MLCC's copyrighted material, including material from MLCC's website. MLCC asserts five claims of copyright and trademark infringement against Defendants based on Defendants' alleged unlawful acts of using MLCC's marks on their website and via other interstate business channels.

Defendants answered Plaintiff's complaint and asserted affirmative defenses and counterclaims, seeking, in part, cancellation of MLCC's portfolio of registrations for the mark METH LAB CLEANUP LLC based upon MLCC's alleged fraudulent sworn statements made in the applications submitted to the USPTO.

This case is now at issue upon Plaintiff's motion to strike ten of Defendants' affirmative defenses and motion [\*3] to dismiss Defendants' counterclaims related to the allegations of MLCC's purported fraud.

**DISCUSSION**



## I. Plaintiff's Motion to Strike

Rule 12(f) of the Federal Rules of Civil Procedure permits the Court to strike any "insufficient defense"; however, it is well settled among courts in this circuit that motions to strike are generally disfavored and will usually be denied unless it is clear the pleading sought to be stricken is insufficient as a matter of law. *Blanc v. Safetouch, Inc.*, 2008 U.S. Dist. LEXIS 68158, 2008 WL 4059786, \*1-2 (M.D. Fla. Aug. 27, 2008) (citing *Fabrica Italiana Lavorazione Materie Organiche S.A.S. v. Kaiser Aluminum & Chemical Corp.*, 684 F.2d 776 (11th Cir. 1982); *Thompson v. Kindred Nursing Centers East, LLC*, 211 F. Supp. 2d 1345 (M.D. Fla. 2002); *In re Sunbeam Securities Litigation*, 89 F.Supp.2d 1326 (S.D. Fla. 1999)). A "court will not exercise its discretion under the rule to strike a pleading unless the matter sought to be omitted has no possible relationship to the controversy, may confuse the issues, or otherwise prejudice a party." *Id.* (citing *Reyher v. Trans World Airlines, Inc.*, 881 F. Supp. 574 (M.D. Fla. 1995)).

The Court finds Defendants stated their affirmative defenses in short [\*4] and plain terms, and that those affirmative defenses adequately place Plaintiff on notice as to the issues to be litigated. Accordingly, Plaintiff's motion to strike is denied.

## II. Plaintiff's Motion to Dismiss

To survive a motion to dismiss, a complaint must include "enough facts to state a claim to relief that is plausible on its face." *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 127 S.Ct. 1955, 160, 167 L. Ed. 2d 929 (2007). While in the ordinary case a plaintiff may find the bar exceedingly low to plead only more than "a statement of facts that merely creates a suspicion [of] a legally cognizable right of action," it is clear that "a plaintiff's obligation to provide the 'grounds' of his 'entitlement to relief' requires more than labels and conclusions, and a formulaic recitation of the elements of a cause of action will not do." *Id.* at 1959, 1965; see also *Davis v. Coca-Cola Bottling Co. Consol.*, 516 F.3d 955, 974, n.43 (11th Cir. 2008) (noting the abrogation of the "no set of facts" standard and holding *Twombly* "as a further articulation of the standard by which to evaluate the sufficiency of all claims"). Absent the necessary factual allegations, "unadorned, the-defendant-unlawfully-harmed-me accusation[s]" will [\*5] not suffice. *Ashcroft v. Iqbal*, 129 S.Ct. 1937, 1949, 173 L. Ed. 2d 868 (2009).

Plaintiff argues that Defendants' counterclaims (Counts I-IV), which include four declaratory actions

seeking cancellation of MLCC's trademark portfolio, (because they were procured by fraud), must be dismissed because they fail to plead the fraudulent acts with sufficient particularity. The Court disagrees.

A third party may petition to cancel a registered service mark on the grounds that the registration was obtained fraudulently. *Metro Traffic Control, Inc. v. Shadow Network Inc.*, 104 F.3d 336, 340 (Fed. Cir. 1997) (citing *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 47-48, 1 USPQ2d 1483, 1483-84 (Fed. Cir. 1986)). Fraud in procuring a service mark occurs when an applicant knowingly makes false, material representations of fact in connection with an application. *Id.* "[T]he obligation which the Lanham Act imposes on an applicant is that he will not make knowingly inaccurate or knowingly misleading statements in the verified declaration forming a part of the application for registration." *Id.* at 48 (quoting *Bart Schwartz Int'l Textiles Ltd. v. Federal Trade Comm'n*, 48 C.C.P.A. 933, 289 F.2d 665, 669, 129 USPQ 258, 260 (1961) [\*6] (emphasis in original)).

Plaintiff's arguments in favor of dismissal appear to attack the veracity of Defendants' allegations, which would be an issue for summary judgment. Moreover, the Court concludes that Defendants' counterclaims assert sufficient allegations of fraud. Defendants claim that Plaintiff knew that the applications did not qualify under Section 2(f) of the Trademark Act because Plaintiff was not the substantial and exclusive user of the marks during the relevant period of time (five years or more). Specifically, Defendants claim that Joseph and Julie Mazzuca knowingly submitted false affidavits claiming MLCC's marks had become distinctive because of this purported substantial and exclusive use when they knew that they were not the only users of the marks.

The Court also concludes that a general averment of damages is sufficient at this stage. Accordingly, Plaintiff's motion to dismiss is denied.

It is therefore ORDERED AND ADJUDGED that Plaintiff's Motion to Strike Ten Affirmative Defenses and Motion for Rule 12 Dismissal of Defendants' Counterclaim (Dkt. 8) is hereby DENIED.

**DONE and ORDERED** in Tampa, Florida on February 4, 2011.

/s/ James S. Moody, Jr.

**JAMES S. MOODY, JR.**

**UNITED [\*7] STATES DISTRICT JUDGE**



Swiss Watch International, Inc. v. Federation of the Swiss Watch Industry

Cancellation No. 92046786

Trademark Trial and Appeal Board

2012 TTAB LEXIS 3

May 31, 2011, Hearing

January 30, 2012, Decided

**DISPOSITION:**

[\*1]

Decision: We find that petitioner has failed to prove that it is entitled to judgment on any of the pleaded grounds. Accordingly, the petition for cancellation is dismissed. As noted in footnote 12, respondent must submit, within thirty (30) days, a redacted version of the testimony and exhibits of Vincent Stauffer, marking as confidential only material that is truly sensitive, failing which the testimony and exhibits previously submitted under seal will become part of the public record.

We have carefully considered all of petitioner's arguments and evidence, even if not specifically discussed herein, but have not found them persuasive.

**COUNSEL:**

Amaury Cruz and Henry Rodriguez of Amaury Cruz & Associates for Swiss Watch International

Abigail Rubinstein of Steptoe & Johnson LLP for Federation of the Swiss Watch Industry

**JUDGES:** Before Seeherman, Lykos and Kuczma n1, Administrative Trademark Judges.

n1 Judge Walters sat on the panel at the oral argument. She has since retired, and Judge Kuczma has been substituted for her on this decision. The change in composition of the panel does not necessitate a rehearing of the oral argument. *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1560 (TTAB 2011); see also *In re Bose*, 772 F.2d 866, 227 USPQ 1, 4 (Fed. Cir. 1985).

[\*2]

**OPINION BY: SEEHERMAN**

**OPINION:**

**THIS OPINION IS A PRECEDENT OF THE TTAB**

Opinion by Seeherman, Administrative Trademark Judge:

Swiss Watch International, Inc. (petitioner) has petitioned to cancel registrations for two certification marks owned by the Federation of the Swiss Watch Industry (respondent): Registration No. 3047277 for the mark SWISS and Regis-

tration No. 3038819 for the mark SWISS MADE, both in standard character form and both for certifying geographic origin of goods identified as "horological and chronometric instruments, namely, watches, clocks and their component parts and fittings thereof." n2 The certification statement in each registration is: "The certification mark, as used by persons authorized by the certifier, certifies geographical origin of the goods in Switzerland."

n2 Registration No. 3047277 issued on January 24, 2006, and Registration No. 3038819 issued on January 10, 2006.

As for its standing and grounds for cancellation petitioner has asserted, in its amended petition for [\*3] cancellation, that it owns a registration for the mark SWISS WATCH INTERNATIONAL; that it has applied to register the mark SWISS LEGEND for, inter alia, watches, and that this application has been refused registration by the USPTO on the basis of, among other things, likelihood of confusion with respondent's marks; that respondent intentionally misstated matters in the applications that resulted in its registrations or failed to state that it is not a government, a department of a government, or a body operating with governmental authorization; that the registrations were obtained fraudulently; that respondent has no legitimate control of the use of the terms SWISS or SWISS MADE; that respondent has improperly permitted and encouraged use of its marks for purposes other than to certify; that respondent discriminates in the granting of use of its certification marks; and that the terms SWISS and SWISS MADE cannot function as certification marks because they have become generic for horological and chronometric instruments. n3

n3 Petitioner also alleged that respondent has no authority to control the use of the terms SWISS or SWISS MADE, but did not, in its brief on the merits, present arguments regarding this aspect of its claim that respondent has failed to control the use of its marks.

[\*4]

Respondent has admitted that it is an unincorporated association with offices in Switzerland, and otherwise has denied the salient allegations in the petition to cancel. n4

n4 Respondent also asserted certain affirmative defenses, but because it made no mention of them in its trial brief, we deem them to have been waived. See, e.g., *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313, 1314 n.4 (TTAB 2005). In any event, with respect to those defenses, and as discussed herein, petitioner has shown its standing and that its petition to cancel states a claim.

#### The record and objections

By operation of the rules, the record includes the pleadings and the files of the registrations sought to be cancelled. Petitioner listed at page 5 of its trial brief the evidence that is of record:

Respondent's responses to petitioner's interrogatories (Exhibits 88-96);

Respondent's responses to petitioner's requests for admission (Exhibit 87);

Testimony depositions taken by petitioner [\*5] of Lior Ben-Shmuel, Rick Ruz and Henry Rodriguez, with petitioner's exhibits 1-75 and respondent's exhibits 1-4, n5 and testimony depositions taken by petitioner on written questions of respondent's employees Jean-Daniel Pasche, Yves Bugmann and Vincent Stauffer, with petitioner's exhibits 130-137; n6

Excerpts from printed publications, submitted by petitioner (Exhibits 76-78);

USPTO documents, submitted by petitioner (Exhibits 97-129);

Discovery documents (Exhibits 79-86), submitted by stipulation of the parties;

Testimony deposition upon written questions taken by respondent of Vincent Stauffer, with respondent's exhibits 1-8 and petitioner's exhibit 1-3; n7

USPTO documents submitted by respondent (Exhibits A-I);

Dictionary definitions submitted by respondent (Exhibits J-O); and

Printed publications submitted by respondent (Exhibits P-S). n8

n5 Petitioner submitted CD-ROM versions of these testimony depositions, as well as the printed versions. It was not necessary to submit the CD-ROMs and, in fact, the rules no longer provide that testimony can be submitted in this manner. See TBMP § 106.03 (3d ed. 2011).

[\*6]

n6 We find it necessary to comment on the listing of exhibits submitted as part of the testimony deposition of Henry Rodriguez. Approximately 60 exhibits are listed in the index as "The Printout." Trademark *Rule* 2.123(g)(3) provides, inter alia, that each deposition must contain "an index of the exhibits, briefly describing their nature and giving the pages at which they are introduced and offered in evidence." Although each of the exhibits are indeed "printouts," the listing of 60 exhibits in this manner is of almost no help to the Board, as it does not allow the judges reviewing the record to easily find the testimony regarding a particular exhibit.

n7 Although the procedure for taking testimony by written questions is a more cumbersome process than taking depositions upon oral examination, see Trademark *Rule* 2.124, the testimony of Messrs. Pasche, Bugmann and Stauffer was taken by this procedure because these witnesses were located outside of the United States.

n8 Some of the articles are in foreign languages; because respondent did not submit translations, they have no probative value. *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1405 (TTAB 1998)

[\*7]

In its trial brief respondent agreed that "the record consists of the items set forth in Petitioner's Trial Brief." p. 2. We agree that the foregoing evidence is of record. n9 In addition, respondent stated that the record also includes the file history for petitioner's application for the mark SWISS LEGEND, noting that petitioner asserted in the petition to cancel that its application to register this mark was refused by the USPTO, and that petitioner had mentioned in its brief that it had petitioned to cancel respondent's registrations after its application for SWISS LEGEND had been refused. Respondent included with its trial brief a declaration by respondent's attorney to which she attached a copy of an Office action in the SWISS LEGEND application, and copies of certain additional USPTO records. With its reply brief petitioner objected to these exhibits, contending that they were not properly made of record. This presents a somewhat unusual situation. Petitioner is correct that attaching a declaration with exhibits to a trial brief is not an acceptable method for making the evidence of record. At the same time, we have petitioner making statements in its brief about its own application [\*8] that are not supported by any evidence properly of record, and respondent in its brief treating those statements as though they are true. Normally, we would view such actions as a stipulation by the parties that petitioner's application had been refused on the basis of respondent's registrations. n10 However, in this case it appears that respondent would not have made such a stipulation if it could not provide further information about the grounds for refusal of petitioner's application. In these circumstances, we both refuse to consider the improperly submitted evidence and decline to treat the information about petitioner's application as stipulated into the record. We add that, in any case, this does not have an effect on our decision, since petitioner's filing of an application, and the Office's refusal of it, would go

to petitioner's standing, and petitioner has otherwise shown its standing through the evidence of its witness Lior Ben-Shmuel.

n9 To the extent that any evidence submitted under a notice of reliance could not properly be made of record by this procedure, we treat the parties' statements as stipulating to the admission of such evidence.

[\*9]

n10 In point of fact, the September 2, 2004 Office action for petitioner's application that was submitted with respondent's brief advised petitioner of respondent's then-prior pending applications and stated that, if they registered, they might serve as a basis for refusal of petitioner's application.

Petitioner also objected to certain statements made in respondent's brief, contending that they are based on publications and webpages that were never made of record. With the exception of the dictionary definitions, of which we may take judicial notice, these objections are well taken, and no consideration has been given to evidence that was not properly made of record or to statements based on such evidence.

Respondent has raised objections as well, asserting that the deposition testimony of Rick Ruz and Henry Rodriguez consists "of nothing but unreliable hearsay testimony and should be stricken from the record." Brief, p. 2, n.1. Much of this testimony consists of statements made by the witnesses regarding information they received from third parties during telephone conversations with those [\*10] third parties. We agree that this testimony constitutes inadmissible hearsay, as opposed to verbal acts, as petitioner is seeking to use what the third parties said to the witnesses to prove the truth of those statements. The cases that petitioner has cited in arguing that this testimony is not hearsay are inapposite.

Respondent has also objected to the Internet printouts submitted as exhibits to Messrs. Ruz's and Rodriguez's testimony (petitioner's exhibits 3-14 and 18-75), as hearsay. We overrule this objection. Although they do not prove the truth of the statements made therein, the printouts are acceptable to show that the statements were made or the information was reported in the webpages. In fact, printouts from Internet webpages may now be made of record by notice of reliance, without requiring the testimony of the witness printing out the webpages to introduce and authenticate them. See *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031 (TTAB 2010). The benefit to both the parties and the Board of making such evidence of record by notice of reliance is highlighted by the testimony depositions of these witnesses, which consist of page after page in which they [\*11] identify the exhibits as being webpages that they printed.

Respondent also argues that the testimony of petitioner's witnesses Ruz and Rodriguez and the accompanying exhibits lack probative value. We have already ruled that the testimony reporting what third parties told the witnesses in telephone conversations is hearsay and will not be considered. As for the Internet evidence, respondent states that it could not readily verify the veracity of the evidence because Internet postings are transitory. However, the website evidence contains the URLs from which the pages were taken, and therefore respondent could have ascertained whether the webpages were accurate or have been changed. If respondent had shown that the website evidence was no longer accurate, it could have submitted it as a rebuttal to petitioner's evidence. See *Safer*, 94 USPQ2d at 1039 ("The date and source information on the face of Internet documents allow the nonoffering party the opportunity to verify the documents"). Respondent did not submit evidence showing the webpages introduced by petitioner had changed or were no longer accurate, and therefore we give the website evidence the probative value to [\*12] which it is entitled.

Respondent would also have us strike the testimony and accompanying exhibits of Messrs. Ruz and Rodriguez regarding use by third parties of the terms "Swiss" or "Swiss Made" in connection with their watches because the witnesses did not know whether or not the purveyors had been granted a license by respondent, or if respondent was involved in a dispute with the third parties. Although we decline to strike this evidence, to the extent that there is no evidence as to whether the watches satisfy respondent's certification standards, we have considered this in determining the probative weight to be accorded the testimony and exhibits.

The proceeding has been fully briefed, and an oral hearing was held before the Board. n11

n11 It is noted that neither party included parallel cites to The United States Patents Quarterly (USPQ) in their citation of authorities. When cases are cited in a brief, the case citation should include a citation to the USPQ if the case has appeared in that reporter. TBMP §§ 101.03 and 801.03 (3d ed. 2011).

[\*13]

As a preliminary matter, we note that respondent has filed what it has captioned a "Motion to Request Clarification After Oral Argument," a motion that petitioner has opposed. We agree with petitioner that respondent's motion is not seeking clarification of any statement made by the Board during oral argument, but is attempting to submit further comments in answer to questions raised by the judges during oral argument. Accordingly, we have given no consideration to this motion, nor to the statements made by petitioner in its responsive submissions as to what it could have argued if petitioner were to make additional comments. We also point out that Board practice does not allow parties to submit additional comments or clarify their positions after oral hearing, unless specifically requested to do so by the Board. For example, in the present case at the oral hearing the Board, noting that petitioner had submitted all of its evidence under seal, ordered that petitioner resubmit copies of its evidence in which only truly confidential material was redacted. If petitioner had some question about how to comply with the Board's request, perhaps in view of the confidentiality agreements the [\*14] parties had signed, a motion for clarification might have been warranted on this subject.

#### The Parties

The record shows that petitioner is a U.S. company that is a distributor or reseller of various brands of watches. Ben-Shmuel test., p. 6, 40. Petitioner also manufactures and sells watches under its own marks, including SWISS WATCH INTERNATIONAL and SWISS LEGEND. Id., p. 32.

Respondent is a Swiss organization whose purpose is to contribute to the "defense and development of the Swiss watch industry." Stauffer test., response 7. n12 It has a membership of approximately 500 companies or associations linked to the Swiss watch industry; such entities must, with rare exceptions, have their headquarters in Switzerland. Id., 10.1. Respondent visits the premises of applicants for membership in respondent to make sure the watches are produced in compliance with the "Ordinance governing the use of the appellation 'Switzerland' or 'Swiss' for watches." (English translation, hereafter referred to as "the Ordinance.") Id., 10.2. The Ordinance was issued by the Swiss Federal Government. Id., 11.1.2. The Ordinance "provides the conditions under which one may use Swiss names in relation [\*15] with watches and other horological products." Id., 12.2. The Swiss Federal Government, in article 53 of the Ordinance, has entrusted respondent with the task "of attributing identification signs to all producers of Swiss watches and movements and to keep the register thereof." Id., 12.4.1. The bylaws of the Swiss Federal Institute of Intellectual Property (Switzerland's equivalent of the USPTO) entrust respondent with the task of combating infringements of intellectual property rights, including Swiss geographical indications. Id.

n12 Mr. Stauffer's testimony was taken on written questions, and therefore each question and answer was numbered.

We also note that Mr. Stauffer's testimony deposition was marked "confidential" in its entirety, and respondent did not file a redacted copy for the public record. In order to adequately explain our analysis and the facts on which it is based we must refer to some of the testimony and exhibits, although we have tried to be sensitive about revealing anything that may be truly confidential. Further, because proceedings before the Board are public, all papers should be available to the public, except for information that is truly confidential. It is clear that not everything in Mr. Stauffer's testimony fits that description. **Accordingly, respondent is allowed until thirty (30) days after the issue date of this decision to file a redacted version of Mr. Stauffer's testimony, failing which the testimony in its entirety will become part of the public record.**

[\*16]

Standing

Mr. Ben-Shmuel has testified that his company sells, distributes and arranges for the manufacture of watches, including under the trademarks SWISS WATCH INTERNATIONAL and SWISS LEGEND. Therefore, petitioner has shown that it is not an intermeddler, but has a real interest in this proceeding. Accordingly, it has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

#### Certification marks

Because this proceeding involves certification marks, it is useful to review the provisions of the Trademark Act regarding such marks. "Certification mark" is defined in *Section 45* of the Act, 15 U.S.C. § 1127:

The term "certification mark" means any word, name, symbol, or device, or any combination thereof--

(1) used by a person other than its owner, or

(2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this chapter,

to certify regional [\*17] or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

Section 4 of the Trademark Act, 15 U.S.C. § 1054, provides:

Subject to the provisions relating to the registration of trademarks, so far as they are applicable, collective and certification marks, including indications of regional origin, shall be registrable under this chapter, in the same manner and with the same effect as are trademarks, by persons, and nations, States, municipalities, and the like, exercising legitimate control over the use of the marks sought to be registered, even though not possessing an industrial or commercial establishment, and when registered they shall be entitled to the protection provided in this chapter in the case of trademarks, except in the case of certification marks when used so as to represent falsely that the owner or a user thereof makes or sells the goods or performs the services on or in connection with which such mark is used. Applications and procedure under this section [\*18] shall conform as nearly as practicable to those prescribed for the registration of trademarks.

Section 14(5), 15 U.S.C. § 1064(5) provides that a petition to cancel a registration of a mark may be brought:

At any time in the case of a certification mark on the ground that the registrant (A) does not control, or is not able legitimately to exercise control over, the use of such mark, or (B) engages in the production or marketing of any goods or services to which the certification mark is applied, or (C) permits the use of the certification mark for purposes other than to certify, or (D) discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies.

In addition, as with all registrations, a petition to cancel a certification mark registration may be brought under *Section 14(3)* at any time "if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered," or if the registration was obtained fraudulently.

Petitioner has petitioned to cancel respondent's certification marks on grounds [\*19] A, C and D enumerated in Section 14(5), as well as the grounds of genericness and fraud set forth in Section 14(3). The standard of proof for cancelling certification mark registrations is the same as for cancelling a trademark registration, namely, petitioner bears the burden of proving its case by a preponderance of the evidence. *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 906 F.2d 1568, 15 USPQ2d 1359, 1361 (Fed. Cir. 1990).

Claim 1: Respondent permits its marks to be used for purposes other than to certify

The first ground discussed by petitioner in its brief is that respondent has permitted use of its certification marks for purposes other than to certify (Section 14(5)(C)). Petitioner bases this claim on the fact that respondent allows its members and licensees to use trademarks that include the word SWISS. Petitioner points to numerous uses of such marks, including , WENGER SWISS MILITARY, SWISS ARMY, and DAVOSA SWISS.

The problem with petitioner's position is that it treats these third parties' uses of their various marks as though they are using the mark SWISS *per se*, i.e., petitioner views [\*20] the various SWISS formative marks used by the third parties as though they constitute a trademark use of respondent's certification mark SWISS. However, respondent's certification mark is not LEONARD SWISS or WENGER SWISS MILITARY or any of the marks used by respondent's members or licensees. n13 Although a certification mark cannot also be used as a trademark, for that prohibition to apply, the mark must be "identical or substantially or virtually identical." *In re 88Open Consortium Ltd.*, 28 USPQ2d 1314 (TTAB 1993) (88OPEN COMPATIBILITY CERTIFIED and design could be registered as a certification mark despite the applicant's ownership of a trademark registration for 88OPEN). It is clear that all of the third-party marks that are of record contain additional wording and/or design elements such that they cannot be considered identical or substantially or virtually identical to respondent's marks. We are not persuaded by petitioner's argument that respondent's members' and licensees' "trademarks are not sufficiently separate and distinct from Registrant's certification marks to satisfy this Board's requirement that the difference in purpose between the marks 'would be recognized [\*21] by the purchasers of the certified goods'" [quoting *In re Monsanto*, 201 USPQ 864, 869 (TTAB 1978)], and that "[t]he salient and distinguishing feature of these trademarks is the term 'Swiss.'" Reply brief, p. 10. On the contrary, the additional elements in the various marks clearly make these marks different from SWISS and from SWISS MADE.

n13 Petitioner has not pointed to any trademark use by third parties of SWISS MADE, and the record does not reflect any.

We acknowledge that, in general, entities that use a registrant's certification mark do not include the mark as part of their own trademarks, and that there are pitfalls to allowing users of the certification mark to do so. n14 However, trademark law does not prohibit a certification mark owner from permitting such use. Petitioner has quoted language from Section 19.92.50 of 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, 19-277 (4th ed. 2002), to support its claim that a certification mark owner is required to [\*22] protect its mark: "[E]ven where a defendant's product contains ingredients which have been certified by the owner of a certification mark, the defendant's incorporation of that certification mark into its own composite trademark might be likely to cause confusion as to sponsorship, affiliation or connection." The context of the quoted language relates to whether the Board could find *likelihood of confusion* where a certification mark owner brought an action against the user of a mark that, without permission, incorporated the certification mark into its own mark. n15 It does not stand for the proposition that a certification mark owner may not permit an authorized user to include the certification mark within the user's own trademark. n16

n14 For example, if the certifying authority determines that a user of the term is not complying with the certification standards, the certifying authority may have to undertake a cancellation proceeding or court action in order to have that party's registration cancelled. Further, the inclusion by many different entities of a certification mark in their individual trademarks may make it more difficult for the owner of the certification mark to prove likelihood of confusion by a third party that attempts to use that same term in its own mark.

[\*23]



n15 The case cited in McCarthy in support of this statement was *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875 (TTAB 1998), which McCarthy describes as "denying summary judgment of dismissal since it is possible that a likelihood of confusion with opposer's COGNAC certification mark could result from applicant's CANADIAN MIST AND COGNAC trademark for a blend of Canadian whiskey and genine COGNAC brandy."

n16 The other cases cited by petitioner involving likelihood of confusion grounds are similarly inapposite.

Petitioner also argues, in support of this claim, that respondent has allowed the use by non-authorized third parties of marks that incorporate the term SWISS, and also has allowed the use of SWISS and SWISS MADE in a non-trademark fashion to promote the sale of watches. Aside from the fact that none of the third-party uses is for marks that are "identical or substantially or virtually identical" to SWISS or SWISS MADE, the prohibition as to using the same mark as a certification mark and trademark applies to uses that are [\*24] made or authorized by the certification mark owner. Thus, this argument that respondent has "allowed" non-authorized uses is more appropriately considered in conjunction with the claim that respondent does not control use of its certification marks, and in fact petitioner has referred throughout Section B of its brief ("Registrant does not control use of its certification marks") to the facts and arguments it has made here. Therefore, we address it below.

#### Claim 2: Respondent does not control use of its marks

Section 14(5)(A) of the Trademark Act provides that the registration of a certification mark may be cancelled if the registrant does not control, or is not able legitimately to exercise control over, the use of such mark. "The purpose of requiring control over use of a certification mark, as with a trademark, is two-fold: to protect the value of the mark and its significance as an indication of source, and to prevent the public from being misled or deceived as to the source of the product or its genuineness." *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1886 (TTAB 2006), citing *Midwest Plastic Fabricators, Inc. v. Underwriters Labs., Inc.*, 906 F.2d 1568, 15 USPQ2d 1359, 1362 (Fed. Cir. 1990). [\*25] The statute does not define "control." Case law has interpreted this provision in two ways. One is that the owner of the mark has, implicitly or explicitly, given permission to others to use the mark without ensuring that their products or services meet the certification mark owner's standards. For example, in *Midwest Plastic Fabricators*, it was claimed that the certification mark owner, Underwriters Laboratories, did not adequately inspect the products on which it allowed companies to apply the UL certification mark. The second interpretation of this provision is akin to the mark becoming generic, i.e., that the certification mark owner has failed to control use by third parties to the extent that the mark no longer acts as an indicator of source, or more particularly, as an indicator of certification of the products or services. See *Tea Board of India*, 80 USPQ2d at 1886.

Petitioner bases its claim that respondent does not control use of its certification marks on the contention that there is "widespread unauthorized use of the term SWISS by third parties who are not members or licensees of Registrant's organization." Brief, p. 23. Petitioner has listed, at pages 18-21 of [\*26] its brief, approximately 22 trademarks that include the term SWISS. n17 Thus, petitioner's claim is more akin to the second interpretation discussed above, since petitioner does not claim that respondent has failed to ensure that its members and licensees follow its standards. n18 To the extent that petitioner is claiming that the unauthorized uses are so extensive that SWISS and SWISS MADE have ceased to function as certification marks because the words are generic, we will address that subsequently. We confine our comments here to whether respondent has made adequate efforts to control the unauthorized use of its marks.

n17 As part of the record adduced by petitioner, it submitted approximately 75 exhibits consisting of Internet printouts showing the term SWISS used for various watches offered for sale, without making a distinction as to whether the users of the trademarks were members or licensees of respondent, whose use complied with respondent's certification requirements. Respondent had provided such lists to petitioner through discovery, and both petitioner and respondent have made them of record, petitioner through a notice of reliance and respondent as an exhibit to Mr. Stauffer's testimony. We assume that petitioner has listed in its brief all the trademarks it believes are being used without respondent's permission or control.

[\*27]

n18 There is some question about whether one or two of respondent's members may, with particular brands, not have followed all of the requirements of the Ordinance. In any event, not only has this not been clearly proven, but any such misuse is so limited that it would not be a basis for cancelling the registration. As stated *infra*, control does not have to be absolute.

Respondent's witness, Vincent Stauffer, has testified as to respondent's actions with respect to the unauthorized uses asserted by petitioner, and to respondent's policing efforts in general. We are somewhat hampered in our discussion of these activities because, as we stated previously, Mr. Stauffer's testimony has been submitted under seal. n19 We have tried to respect the information in the testimony that is truly confidential, and will refer to it generally.

n19 At the oral hearing, after noting that the entire testimony deposition of petitioner's witness Lior Ben-Shmuel had been marked "confidential," the Board ordered petitioner to submit a redacted version for the public record. We failed to give a similar instruction to respondent regarding Mr. Stauffer's testimony because we were not aware at the time that a redacted version had not been submitted, since the Board generally reviews only the briefs, and not the entire record, prior to oral argument. It was clear from the parties' briefs and the statements made during oral argument that Mr. Ben-Shmuel's entire testimony had been submitted under seal, but the briefs did not similarly reveal that the Stauffer testimony had been marked "confidential" in its entirety. As noted in footnote 12, respondent must now provide a redacted version of Mr. Stauffer's testimony.

[\*28]

Respondent has shown, through the testimony of Mr. Stauffer, that it engages in significant activities to ensure that only companies adhering to its standards (and by extension, the standards of the Swiss Ordinance) use the terms SWISS or SWISS MADE in connection with watches. It monitors all trademark applications in Class 14 worldwide and files opposition proceedings when there are dubious cases, monitors the use of SWISS, SWITZERLAND and SWISS MOVEMENT on watches displayed in watch-specialized magazines, buys or requests watch samples and inspects them, and inspects watches which have been seized by police forces or customs authorities worldwide. (response 15.1.1). In the United States, respondent has filed 25 oppositions against marks incorporating the terms SWISS or SWITZERLAND (response 16.1.3), with six settled via an agreement by which the applicant agreed to comply with the standards of the Swiss Ordinance (16.1.5, 16.1.6), and ten resolved with the withdrawal or abandonment of the application (16.1.7). Respondent also has worked with customs in the United States to prevent the importation of watches bearing the term "SWISS" which did not meet the standards of the Swiss Ordinance. [\*29] (response 15.1.4).

Of the 22 uncontrolled trademark uses asserted by petitioner, Mr. Stauffer has testified that respondent has brought oppositions against six of them, and is involved in actions against two others. n20 Others of the remaining asserted uncontrolled trademark uses do not involve registered marks, while two other applications have been abandoned, and respondent has contacted other companies to determine what actions will be taken.

n20 It is unclear from the wording of the questions in Mr. Stauffer's testimony whether these actions are oppositions.

Although petitioner acknowledges that respondent is not required to exercise absolute control, and that respondent has taken some actions, petitioner asserts that "it is reasonable to expect greater control than demonstrated by Registrant and its predecessor in interest when they have had over 75 years, since the alleged date of first use in 1931, to monitor and limit the unauthorized uses of 'Swiss' and 'Swiss Made' products in the U.S." Brief, [\*30] p. 23. The statute does not define "control" or indicate the degree of control required. As petitioner acknowledges, absolute control is not only not required, but the Board has recognized that absolute control would be impossible. *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d at 1888; see also *Midwest Plastic Fabricators*, 15 USPQ2d at 1362 (the certification mark owner's affirmative duty to control its certification mark does not mean "absolute control" since this would be "impracticable, if not impossible to satisfy"); *Engineered Mechanical Services, Inc. v. Applied Mechanical Technology, Inc.*, 584 F.

*Supp. 1149, 223 USPQ 324 (M.D. La. 1984)* ("The owner of a mark is not required to constantly monitor every nook and cranny of the entire nation and to fire both barrels of his shotgun instantly upon spotting a possible infringer ....").

The question is whether the control is adequate. As stated in *Midwest Plastic Fabricators, 15 USPQ2d at 1363*, "the owner must take reasonable steps, under all the circumstances of the case, to prevent the public from being misled." Respondent has an extensive worldwide monitoring and enforcement [\*31] system in place, including working with U.S. Customs officials. It has, as noted, brought numerous oppositions in the United States, and negotiated the abandonment or withdrawal of numerous applications. It has also filed letters of protest with the USPTO. We find, in the circumstances of this case, that respondent's control is adequate.

We also note petitioner's contention that respondent cannot control use of its certification marks "because of widespread third party use prior to Registrant's date of registration of its Marks, of the designation SWISS in connection with watches that do not originate in Switzerland." Brief, p. 24. It appears that petitioner is arguing that respondent can take no action against such registrations, and therefore, in effect, such third-party uses are permanent. However, petitioner's position is not correct. The date of the registration of respondent's marks is not the operative date for respondent to bring an action, since its rights do not arise only with the issuance of its registrations.

Petitioner has also submitted website evidence in which such terms as "Swiss," "Swiss made," "Swiss quartz," "Swiss movement," and "Swiss collection" have been [\*32] used in the descriptions of watches that are offered for sale on the various webpages. Our review of these exhibits shows that in most cases SWISS is used to identify the movements used in the advertised watches. Mr. Stauffer has also testified, with respect to some of these uses, that he is unfamiliar with them, or could only say that the trademarks used in connection with the watches have not been registered in the United States. n21

n21 Because of the nature of testimony on written questions, it is not possible to pose a follow-up question upon learning of an answer; instead, one must anticipate what the answer will be and submit a follow-up question in advance. As a result, the responses are not as complete as can be obtained through a deposition upon oral examination.

We do not regard accurate statements describing that a watch has a Swiss movement as showing that respondent has allowed uncontrolled use of its marks. Nor are instances of misuse that had not come to respondent's attention, when the record [\*33] shows that respondent has made very clear efforts to monitor third-party uses of SWISS and SWISS MADE. Although we acknowledge that there appear to be instances of misuse of SWISS, the instances that are in the record are not so extensive for us to conclude that the registrations should be cancelled. "[T]he mere fact of misuse ... is not sufficient to raise an inference that the control was not adequate or that [SWISS or SWISS MADE] has lost all significance as a mark. Even if control is not maintained and misuse occurs, it must be shown that the misuse was of such significance to permit an inference that the mark is generic." *Tea Board of India, 80 USPQ2d at 1888*.

### Claim 3: Respondent discriminates

*Section 14(5)(D)* provides for the cancellation of a certification mark if the registrant "discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies." The basis for petitioner's claim of discrimination is not that respondent refuses to certify the goods of those who maintain the standards which its marks certify, but that respondent's standards are wrong. Petitioner [\*34] argues that respondent's requirements that the watch movement be cased up in Switzerland and that the final inspection of the watch take place in Switzerland are unnecessary. This position is not well taken. The statutory provision is not dependent upon whether the Board or a third party likes the standards, or sees the need for them; the statute requires only that the owner of the certification mark allow any entity that meets the standards, whatever the owner determines those standards to be, to use the mark.

Petitioner also argues that respondent discriminates in the approval for use of its certification marks because it may deny membership in its organization. We are not persuaded by this argument. Although members of its organization are permitted to use the certification marks (because to be a member an entity must comply with the standards set forth in the Ordinance), there is no requirement that an entity be a member of respondent in order to use the certification marks.

Indeed, respondent has provided a list of companies that are not members but that are licensed to use its certification marks.

Petitioner has also argued that respondent's standards discriminate against U. S. companies that adhere to U.S. customs regulations. In its main brief petitioner has pointed to the Tariff Act of 1930, which provides that the country of origin of the movement determines the country of origin of the watch, and asserts that therefore U.S. Customs "would recognize 'Swiss Made' as an appropriate marking on the watch." pp. 25-26. Whether or not U.S. Customs would consider a watch to be made in Switzerland for duty purposes, or would consider "Swiss Made" to be acceptable to indicate the country of origin, it does not follow that respondent is discriminating against U.S. companies in terms of the use of its certification marks. Again, the language of the statute is clear: the discrimination contemplated by the statute refers to a refusal by the certification mark owner to certify "the goods or services of any person who maintains the standards or conditions which such mark certifies." n22

n22 In its reply brief, petitioner has asserted a public policy argument based on U.S. customs regulations, stating that U.S. companies cannot simultaneously comply both with U.S. customs regulations and with respondent's certification mark standards. To the extent that there is any conflict (and we do not say that there is), this is not the forum to resolve it. The grounds upon which a petition to cancel a certification mark may be brought have been set out elsewhere in this opinion. "Against public policy" or "conflicts with Customs requirements" are not permissible grounds for a cancellation proceeding. Cf. *The Institut National Des Appellations D'Origine v. Vinters International Company, Inc.*, 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992) ("We deal here only with the issue of registrability and what may be registered in the PTO. It is not our concern or that of the PTO what [the applicant] must do to comply with the BATF labelling requirements.")

[\*36]

In short, petitioner has not submitted any evidence that respondent has refused to permit the use of its certification marks for watches meeting its standards, namely, the watch movement is made in Switzerland, the watch is "cased up" in Switzerland, and the final inspection of the watch takes place in Switzerland. n23

n23 Petitioner has stated that respondent denied petitioner "its certification." Petitioner's arguments in connection with this statement have been marked "confidential," and therefore we cannot discuss them. Suffice it to say that there is no evidence that petitioner requested respondent to allow it to use respondent's certification marks for watches, or that petitioner's watches met respondent's certification mark standards.

#### Claim 4: Genericness

A registration for a certification mark, like other trademarks, may be cancelled at any time if the mark becomes the generic name for the goods or services. Trademark Act *Section 14(3)*. Petitioner claims that respondent's marks are generic [\*37] for watches, clocks and their component parts and fittings because the terms "primarily signify to the American purchaser the type of watch regardless of regional origin." Brief, p. 27. n24

n24 In this section of petitioner's brief, it directs its comments to respondent's mark SWISS, even titling the section "The term SWISS has become a generic term for the goods in question." However, because there are occasional references to SWISS MADE as well, we do not consider petitioner to have waived the ground of genericness with respect to SWISS MADE.

Petitioner's first argument is based on the case *In re Cooperativa Produttori Latte E Fontina Valle D'Acosta*, 230 USPQ 131 (TTAB 1986). An Italian cooperative had applied to register as a certification mark for "FONTINA cheese"

the following design, and the examining attorney required a disclaimer of FONTINA on the ground that it merely described or is the generic name for a type of cheese. The Board found that "fontina" [\*38] is not a certification mark indicating regional origin, but that the lower-case treatment of this word in various references as naming a kind of cheese with certain characteristics, and the evidence showing there is a domestic fontina cheese

demonstrates to us that, to the American purchaser, "fontina" primarily signifies a type of cheese (much like brie, swiss, parmesan or mozzarella) regardless of regional origin, rather than a mark of certification.

*Id.* at 134.

Petitioner argues that similar evidence of record in this proceeding "supports Petitioner's position that, for the goods at issue, "Swiss" and "Swiss made" primarily signify to the American purchaser the type of watch regardless of regional origin." Brief, p. 27. The evidence to which petitioner points is "common usages by the press of the terms "Swiss watch" and "Swiss precision" to convey certain qualities associated with accurate watches." *Id.* at 28. The excerpts submitted by petitioner, as part of its Exhibit 76, include the following:

... who compares the craftsmanship of a car to a fine Swiss watch. *Milwaukee Journal Sentinel*, Sept. 7, 2003;

"It [an airplane] runs like [\*39] a fine Swiss watch," he said, noting that the plane goes about 90 miles per hour. *The Detroit News*, Sept. 5, 2003;

Manhattan is like a fine Swiss watch, the old-fashioned kind that you wind up. They are incredible pieces of precision workmanship ... *Chillicothe Gazette*, August 20, 2003;

Instead of ticking like a Swiss watch, Vanderbilt's offense looked more like Swiss cheese when it first made contact with the Commodores' defense. *The Tennessean*, August 16, 2003. n25

n25 Besides these uses of "Swiss watch" as a simile or metaphor, petitioner also submitted excerpts of articles in which the phrase "Swiss watch" refers to actual Swiss watches, for example, "Swatch, the Swiss watch maker, made a name for themselves in the early '80s ..."; and "For the couple with a taste for classic Swiss watches with beautiful Volunteer faces, there were two ...."

We find this evidence unpersuasive in showing that the term "Swiss watch," when it is used for watches, has the meaning of any precise [\*40] watch, regardless of geographic origin. On the contrary, the use of "Swiss watch" as a metaphor for something of precision workmanship shows the renown of Swiss watches. In no way is this evidence similar to the evidence adduced in the *Fontina* case, where the term "fontina" was shown to refer to a type of cheese.

Petitioner also contends that SWISS and SWISS MADE have become generic for a category of watches, irrespective of where the watch is made, because of the evidence of use of SWISS by third parties that are not respondent's members or licensees and use SWISS as a trademark on goods that do not originate in Switzerland. As we indicated in discussing petitioner's claim that respondent does not control use of its marks, petitioner submitted approximately 75 exhibits consisting of Internet printouts showing the term SWISS used in connection with various watches. The witnesses who authenticated the Internet printout exhibits did not know whether the watches shown therein originated in Switzerland. In addition, during his testimony, Mr. Ben-Shmuel was asked about various third-party SWISS-formative marks for watches. Mr. Ben-Shmuel testified that some of the watches he was asked [\*41] about did not originate in Switzerland. However, because the documents he referred to in his testimony were not made of record, we cannot ascertain in what way SWISS or SWISS MADE was used. n26 Further, the basis for his knowledge was, in most cases, rather vague. For example:

Q: Do their watches [Skagen] meet the Ordinance requirements?

A: I don't know for certain but I don't think so. I don't know for certain.

Test. p. 73

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Q: Have you--do their watches, the Aqua Swiss watches meet the Ordinance requirement?

A: Again, and this is a brand that I have never dealt with, but I am pretty familiar with them; I have seen them advertised, and I have seen them around. I was offered deals with them but I never purchased it. And, from my understanding, not the Swiss Federation, they probably do not abide by the Swiss Federation rules but they do use 100 percent Swiss made movements which would provide by that.

Q: And how would they not meet the Swiss Ordinance?

A: Just the fact that they don't want to assemble the final inspection in Switzerland.

Q: And how do you know that?

A: Just from hearsay when we were discussing on the deal or [\*42] things like that. Now, they may do it on some of their watches. But the particular offer, you know, that I was offered at the time, is going back a few years, from my recollection, that wasn't the case.

Test. p. 75.

n26 There is no indication in the record that the documents reviewed by Mr. Ben-Shmuel in connection with his testimony were the exhibits introduced during the testimony of petitioner's other witnesses. The transcript includes only the statement by petitioner's attorney that "For the following series of questions I am just going to use a document to refresh his memory." p. 15.

This is not to say that all uses of SWISS and SWISS MADE in connection with watches that are of record are authorized or meet respondent's certification requirements. Certainly the testimony of Vincent Stauffer, respondent's employee, shows that there are uses that do not conform to respondent's certification standards and that, while respondent has taken many actions to stop unauthorized uses, it has not prevented [\*43] all of them. The question, though, is whether, as a result of these unauthorized uses, SWISS and SWISS MADE have lost their capacity to function as certification marks indicating geographic origin of the watches in Switzerland, and instead are viewed as generic "indicators of certain qualities or characteristics." Petitioner's Brief, p. 29.

First, we point out that a certification mark that is used to certify geographical origin can also certify certain qualities and characteristics of the product that are due to factors associated with the geographic area. *Tea Board of India, 80 USPQ2d at 1887*. In fact, the very definition of a certification mark is that it can certify quality, or accuracy, or other characteristics. Thus, the terms SWISS and SWISS MADE for watches can certify the quality or characteristic that the watches are timepieces of great precision, without affecting their status as certification marks. On the contrary, the association of Switzerland with precision watches actually enhances the certification mark function of SWISS and SWISS MADE.

We find petitioner has not proved that SWISS and SWISS MADE have lost their significance as indicators of geographic [\*44] source. The issue is not whether the public is expressly aware of the certification function of the marks or the certification process underlying use of the marks, but rather is whether the public understands that goods bearing

the marks come only from the region named in the marks. *Institut National Des Appellations d'Origine v. Brown-Forman Corp.*, 47 USPQ2d 1875, 1885 (TTAB 1998). The relatively small number of clearly unauthorized third-party uses of SWISS or SWISS MADE that are in the record are insufficient to show that these terms, when used in connection with watches, refer to any watch that works with precision, as opposed to indicating their geographic origin. As the Board stated in *Tea Board of India*, 80 USPQ2d at 1893, "even assuming applicant had produced evidence of misuse, that is, use indicating a different geographic source for the tea or use in connection with nongenuine tea, we will not infer that the mark has become generic unless it is also shown by applicant that the misuse is so widespread and of such duration that it has caused DARJEELING to lose all significance as a mark."

Petitioner has also argued that "the terms 'Swiss' and 'Swiss [\*45] made' have become generic for a category of horological instruments, namely watches that incorporate movements in the Swiss style or use Swiss-developed mechanics, irrespective of where the watch is made." Brief, p. 29. It appears to be petitioner's position that SWISS identifies a type of movement, or a watch using such a type of movement. However, the evidence of record does not support such a finding. Certainly we cannot ascertain from the exhibits advertising various watches as having a "Swiss movement" that the movements do not come from Switzerland, or that "Swiss movement" refers to a specific type of movement that was originally developed in Switzerland but is now made throughout the world. As noted, the witnesses who introduced these exhibits during their testimony did not know whether or not the watches had Swiss movements, i.e., movements made in Switzerland. Petitioner cites to the testimony of Mr. Ben-Shmuel, at pages 8-9, in support of its argument, but that testimony is far from clear, and certainly insufficient to meet petitioner's burden of showing that SWISS is a generic term for watch movements, and therefore generic for watches containing a particular type of movement: [\*46]

Q: Based on your knowledge of the industry, and your experience, what is the US consuming public's understanding of the term "Swiss?"

A: You know, again, I guess, you know, the most important aspect of a timepiece, you know, is the brains of the actual timepiece, which is, you know, a movement if it's a quartz or an automatic movement. And, you know, when people look for--when consumers, in my experience, when they're looking into a quality, that they care about those major components which is art--is the Movement.

Q: Based on your knowledge and industry experience, is the term "Swiss" used in connection with watches that are made outside of Switzerland?

A: Yes, definitely. There are many companies out there that builds [sic] watches outside of Switzerland, but import watches into other countries, including the United States and abroad, obviously, that have "Swiss" in their name or somewhere on their watch, that the watches are not [sic] made or assembled in China, or somewhere else around the world.

(objections omitted).

Petitioner also asserts that "certification marks that act as an indicator of geographic origin generally arise due to the use [\*47] of a geographic term in connection with products tied to the land," brief, p. 29, and appears to contend that because respondent's marks SWISS and SWISS made are used in connection with manufactured goods--watches--consumers will not view the terms as indicating goods that invariably come from Switzerland. To the extent that petitioner is suggesting that geographic terms cannot function as certification marks unless they are used to certify goods that come from the land, we are unaware of any case law that would support such a position. Even in those situations where a certification mark is used in connection with products having an agricultural origin, there is a recognition that processing of the product, even when that processing does not have an intrinsic connection with the land, can be an element of the certification standards. See, for example, *Bureau National Interprofessionnel Du Cognac v. International Better Drinks Corp.*, 6 USPQ2d 1610 (TTAB 1988), in which the methods of distillation and aging conditions were, in addition to the grapes grown in the region, part of the standards for the use of the certification mark COGNAC. In this case, the manufacture of watches [\*48] is so closely associated with Switzerland that even Mr. Ben-Shmuel testified that "just like the Swiss are known for chocolate, they are known for old watch making," and that "it's [Swit-

zerland] a region which is known for where the watch industry kind of started," p. 7; "the Swiss are considered legends in the watch industry" and the "Swiss are associated with the watch industry," pp. 50-51.

In short, the evidence shows that the geographic connection between watches and Switzerland is very strong, and that when the terms SWISS and SWISS MADE are used in connection with watches, consumers will understand that they signify the geographic origin of the goods, and will not regard the marks as generic terms.

#### Claim 5: Fraud

Although in its petition for cancellation petitioner did not specify that the ground of fraud was limited to respondent's registration for SWISS MADE, it is clear from petitioner's briefs that this is the case. See Subhead C: "Registrant committed fraud on the PTO in registering SWISS MADE." Brief, p. 24. n27 Petitioner asserts that in response to the Office action dated January 17, 2003, respondent submitted an exhibit containing its certification standards [\*49] coupled with the abstract of the Swiss Ordinance on which its standards are based. Petitioner contends that "registrant's decision to submit both documents was calculated to outfox the examiner" because the certification standards document respondent submitted "provides no description of the standards used by Registrant to determine whether others may use the mark SWISS MADE"; that "[t]he standards speak only of the indicators 'Swiss,' 'Swiss case,' 'Swiss dial,' and 'Swiss parts.'" Id. It is petitioner's position that the submission of the Ordinance, "which does discuss use of 'Swiss made,' was made to confuse the examiner into believing Registrant's standards covered" the mark SWISS MADE in order to overcome the Office action and obtain a registration. Id.

n27 Moreover, the basis for petitioner's fraud claim appears to have changed. In the petition for cancellation petitioner alleged that respondent "intentionally misstated matters in its application or failed to state that it is not a government, one of the departments of a government, or a body operating with governmental authorization ...." Petitioner did not pursue any claim that respondent failed to inform the examining attorney that it is not a government department and, indeed, it appears that respondent does operate with governmental authorization. Although petitioner did not plead, with the specificity required, that its fraud claim was based on misstatements in connection with respondent's certification standards, the parties have proceeded at trial as if that were the claim, and we therefore treat the pleadings as amended to conform to the evidence. See *Fed. R. Civ. P. 15(b)*.

[\*50]

Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with its application with an intent to deceive. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009); *Torres v. Cantine Torresella S.r.l.* 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986). A party seeking cancellation of a trademark registration for fraudulent procurement bears a heavy burden of proof. *W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 377 F.2d 1001, 54 C.C.P.A. 1442, 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).

The file for the registration of SWISS MADE shows that, when the underlying application was being examined, the examining attorney, on January 17, 2003, issued an Office action requiring respondent to "submit a copy of the standards used to determine whether others [\*51] may use the certification mark with their goods or services." In response, respondent submitted "a copy of its standards as well as an abstract of the Swiss Ordinance on which these standards are based." Petitioner is correct that the standards submitted by respondent do not specifically use the term "Swiss made," and state that "A watch is considered to be 'Swiss' if: 1. its movement is made in Switzerland; 2. its movement is cased up in Switzerland; and 3. the manufacturer carries out the final inspection in Switzerland." This is essentially the same wording that appears in Article 1(a) of the Ordinance. It is Article 3, paragraph 4 of the Ordinance that makes reference to the term "Swiss made": "4. The 1st and 3rd paragraphs are also applicable when these appellations are used in translation (in particular "Swiss", "Swiss made", "Swiss movement") with the true indication of origin of the watch or with the addition of words such as 'style', 'type', 'form' or other word combinations." n28



n28 Paragraph 1 of Article 3 states that "The name 'Switzerland', indications such as 'Swiss', 'Swiss product', 'manufactured in Switzerland', 'Swiss quality' or other appellations which contain the name 'Swiss' or 'Switzerland' or which may be confused therewith may be used solely for Swiss watches or watch movements," while paragraph 3 states "The indication 'Swiss movement' may be applied to watches which contain a Swiss movement. The word 'movement' must appear written out in full in the same type-face, dimension and colour as the appellation 'Swiss'."

[\*52]

The fact that the term SWISS MADE does not appear in respondent's "Standards" is not a sufficient basis for us to find fraud. Respondent's response to the Office action was quite clear; it advised the examining attorney that it was submitting "a copy of its standards as well as an abstract of the Swiss Ordinance on which these standards are based." The submissions are also clearly marked. The standards are titled "The Standards," and the Ordinance, which is a separate document, is titled "Ordinance governing the use of the appellation 'Switzerland' or 'Swiss' for watches." Respondent made no false statements to the examining attorney, and a false statement is one of the critical elements in proving fraud. Further, there must be an intent to deceive the USPTO. *Bose, 91 USPQ2d at 1941*. Although deliberately omitting relevant portions of a document, or making a statement that, while true, gives only part of the story and therefore is deliberately designed to mislead, may be treated as a false statement in its effect and also show the necessary element of intent, that is clearly not the case here. Petitioner's assertion that respondent submitted both documents in order to [\*53] "outfox the examiner" is not a substitute for showing that submitting both documents gave an incomplete picture and, in effect, resulted in the withholding of necessary information. The examining attorney was given both the Standards and the Ordinance; both were clearly marked; and respondent clearly stated in its response that it was submitting both, and that the Standards were based on the Ordinance.

We find that petitioner has not proven its asserted ground of fraud.

#### Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawProtection of RightsRegistrationPrincipal RegisterTrademark LawSpecial MarksCertification  
MarksTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsCancellationsStanding



In re The Eyecare Foundation, Inc.

Serial No. 76701339

Trademark Trial and Appeal Board

2011 TTAB LEXIS 65

March 10, 2011, Decided

**DISPOSITION:**

[\*1]

Decision: The refusal to register under Section 2(e)(1) of the Lanham Act is hereby affirmed.

**COUNSEL:**

Myron Amer of Myron Amer, P.C. for The Eyecare Foundation, Inc.

Elissa Garber Kon, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

**JUDGES:** Before Bucher, Cataldo and Mermelstein, Administrative Trademark Judges.

**OPINION BY: BUCHER**

**OPINION:**

**THIS OPINION IS NOT A PRECEDENT OF THE TTAB**

Opinion by Bucher, Administrative Trademark Judge:

The Eyecare Foundation, Inc. seeks registration on the Principal Register of the mark **THE EYE CANCER FOUNDATION** (*in standard character format*) for services recited in the application, as amended, as follows:

"charitable services, namely, charitable fundraising and providing grants to physicians for research on eye diseases" in International Class 36; and

"providing medical information to people with eye diseases and their families about their diseases and possible treatment options via the Internet; providing a charity-based, Internet database of patient medical information in the field of eye diseases where pat[i]ents can inquire about medical issues and procedures from other patients and can [\*2] relay information about their medical experience for support and community" in International Class 44. n1

n1 Application Serial No. 76701339 was filed on January 25, 2010, based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. No claim is made to the exclusive right to use the word "Foundation" apart from the mark as shown.

The Trademark Examining Attorney refused registration on the ground that the term is merely descriptive under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1). The record shows that applicant is also the owner of a registration for the mark **THE EYECARE FOUNDATION** for services similarly recited as

"charitable services, namely, charitable fundraising and providing grants to physicians for research on eye cancer and eye diseases" in International Class 36, and

"charitable services, namely, providing healthcare counseling and support to people with eye cancer and providing medical information to [\*3] people with eye cancer and other eye diseases and their families about their diseases and possible treatment options via the Internet" in International Class 44. n2

n2 Registration No. 2786259 issued on November 25, 2003. Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. No claim is made to the exclusive right to use the word "Foundation" apart from the mark as shown. Section 2(f) showing of acquired distinctiveness as to the mark in its entirety.

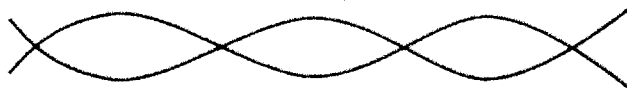
After the Trademark Examining Attorney made the refusal final, applicant appealed to this Board.

We affirm the refusal to register.

As a preliminary matter, although applicant argues against our consideration of some of the Trademark Examining Attorney's dictionary entries for the word "Foundation," we disagree inasmuch as this Board may take judicial notice of dictionary entries. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). [\*4] In any case, the Trademark Rules and United States Patent and Trademark Office practice support our consideration of all of these dictionary entries appropriately placed into the record by the Trademark Examining Attorney.

Despite the fact that applicant earlier disclaimed the generic term "Foundation" in this application, and did so years ago in its earlier registration, applicant appears to be arguing in its most recent submissions that, within this composite mark, the word "Foundation" has source-indicating significance in connection with the recited services. We disagree. The dictionary definitions uniformly support the disclaimer of the word "Foundation" as generic for this organization. Furthermore, the Trademark Examining Attorney placed into the record copies of the following third-party registrations wherein the word "Foundation" is disclaimed by the following array of cancer foundations:

NATIONAL FOUNDATION FOR CANCER RESEARCH<sup>®</sup>    SAMUEL WAXMAN CANCER RESEARCH FOUNDATION<sup>®</sup>    NATIONAL CHILDHOOD CANCER FOUNDATION<sup>®</sup>

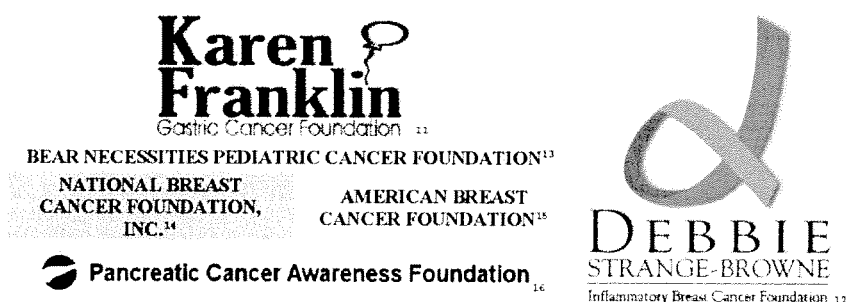


**LUNG CANCER RESEARCH FOUNDATION**

Dedicated to Discovery



n3 n4 n5 n6 n7 n8 n9 n10



n11 n12 n13 n14 n15 n16

n3 Registration No. 1992402 issued on August 13, 1996; renewed. No claim is made to the exclusive right to use the words "Foundation for Cancer Research" apart from the mark as shown.

[\*5]

n4 Registration No. 3397207 issued on March 18, 2008. No claim is made to the exclusive right to use the words "Cancer Research Foundation" apart from the mark as shown.

n5 Registration No. 2597035 issued on July 23, 2002; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. No claim is made to the exclusive right to use the words "Childhood Cancer Foundation" apart from the mark as shown.

n6 Registration No. 3380558 issued on February 12, 2008. No claim is made to the exclusive right to use the words "Lung Cancer Research Foundation" apart from the mark as shown.

n7 Registration No. 3721477 issued on December 8, 2009. No claim is made to the exclusive right to use the terms "Ovarian Cancer" or "Ovarian Cancer Foundation" apart from the mark as shown.

n8 Registration No. 2733684 issued on July 8, 2003; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. No claim is made to the exclusive right to use the words "Cancer Foundation" apart from the mark as shown.

n9 Registration No. 3375185 issued on January 29, 2008. No claim is made to the exclusive right to use the word "Foundation" apart from the mark as shown. Acquired distinctiveness under Section 2(f) as to the words "Skin Cancer."

[\*6]

n10 Registration No. 3380561 issued on February 12, 2008. No claim is made to the exclusive right to use the words "Lung Cancer Research Foundation" apart from the mark as shown.

n11 Registration No. 3663453 issued on August 4, 2009. No claim is made to the exclusive right to use the words "Gastric Cancer Foundation" apart from the mark as shown.

n12 Registration No. 3218985 issued on March 13, 2007. No claim is made to the exclusive right to use the words "Inflammatory Breast Cancer Foundation" apart from the mark as shown.

n13 Registration No. 3417465 issued on April 29, 2008. No claim is made to the exclusive right to use the words "Pediatric Cancer Foundation" apart from the mark as shown.

n14 Registration No. 3222080 issued on March 27, 2007. No claim is made to the exclusive right to use the words "Breast Cancer Foundation, Inc." apart from the mark as shown.

n15 Registration No. 3104009 issued on June 13, 2006. No claim is made to the exclusive right to use the words "Breast Cancer Foundation" apart from the mark as shown.

n16 Registration No. 3084973 issued on April 25, 2006. No claim is made to the exclusive right to use the words "Pancreatic Cancer Awareness Foundation" apart from the mark as shown.

[\*7]

In fact, consistent with the entire thrust of the case proffered by the Trademark Examining Attorney, we see from the registrations referenced above that the additional wording describing the type of cancer to which the respective

foundations are each devoting their efforts (i.e., analogous to applicant's involved "Eye Cancer" designation) is also disclaimed within each of the composite mark also having inherently distinctive matter, or alternatively, is shown to have acquired distinctiveness (e.g., "Skin Cancer Foundation" mark above). n17

n17 While in applicant's extant registration for "The Eyecare Foundation," the word "Eyecare" does not fit this pattern of naming a form of cancer, it is a composite mark totally analogous to the involved mark in the context of an analysis under Section 2(e)(1) of the Act. In that registration, applicant claimed acquired distinctiveness as to the mark in its entirety, while disclaiming the word "Foundation" apart from the mark as shown. Had applicant taken a different tact during the prosecution of the instant application, that too could well have been an option here.

[\*8]

Applicant's original recitations of services used the wording "eye cancer and other eye diseases" in a manner reminiscent of the existing recitation of services in its earlier registration. However, in an attempt to evade the refusal for descriptiveness under § 2(e)(1) of the Act, applicant deleted during the prosecution of this application all the earlier references to "eye cancer" from its recitation of services. Then, applicant argued that this move requires a reversal of the refusal to register:

The Examining Attorney has indicated that the determination of whether a mark is merely descriptive is considered in relation to the identified services. Since the identified services do not make any reference to "eye cancer," the refusal should be withdrawn.

Applicant's response of May 10, 2010, at 2. Furthermore, based upon the evidence of record, applicant now argues that "eye cancer" is so rare that the public in general is unaware that "eye cancer" is classified as an "eye disease." n18

n18 Even if we should conclude that "eye cancers" are rare, if as a matter of fact, "eye cancers" comprise a sub-set of "eye diseases," we would not be constrained to exclude them from this recited category should applicant present a poll reflecting a contrary public opinion on this very point.

[\*9]

As best we can understand it, applicant's position in its appeal brief is that the sole dispositive issue on appeal is whether the term "eye diseases" includes "eye cancer." Then in a confusing summation to its reply brief, applicant's counsel ended with the following *non sequitur*:

It is preliminarily to be noted that the trademark attorney's characterizing of the usage by Applicant of EYECARE and EYECANCER has not stated that EYECARE exceeds the scope of EYECANCER or *vice-versa*, that EYECANCER exceeds the scope of EYECARE.

Accordingly it should be assumed that the connotation of the words EYECARE and EYECANCER or *vice-versa* are broad enough to encompass each other.

For the foregoing reasons the Final Refusal should be overruled.

In fact, applicant's current position seems too clever by half. As argued by the Trademark Examining Attorney, the whole sequence of events surrounding applicant's amendment to the recitation of services undercuts its final arguments:

... The original identification of services included "providing medical information to people with **eye cancer and other eye diseases**." The applicant's prior registration for a related [\*10] mark also included "providing medical information to people with **eye cancer and other eye diseases**." This wording indicates that eye cancer is one of many eye diseases. The applicant would not have used the wording "and other" if eye cancer was not considered an eye disease. It is noted that in [its] amended identification of

services to delete "eye cancer," the applicant also deleted "and other" leaving only "eye diseases." The evidence below, including statements by the applicant ... clearly indicate that the applicant provides these services in connection with eye cancer as well as other eye diseases.

Trademark Examining Attorney's appeal brief at unnumbered 5. *Emphasis* supplied by the Trademark Examining Attorney.

We agree with the Trademark Examining Attorney that this tribunal should not be required to ignore the realities of use actually made by applicant merely because it made a tactical decision explicitly to carve out from the application's recitation of services what are arguably its core services - motivated only by the desire to foil a refusal of mere descriptiveness. This is particularly true where each of the involved websites is offering [\*11] a variety of interrelated services. It seems most appropriate to take all of those largely undifferentiated services into consideration when determining whether the alleged mark still immediately conveys information about the remaining, trimmed-down recitation of services. On the other hand, in this case, turning a blind eye to applicant's actual services would not help applicant's position inasmuch as the named services related to "eye cancers" are deemed still to be included in the pared-down recitation of services.

As noted by the Trademark Examining Attorney, from the time of the first Office action, "[t]his refusal was premised on evidence that the applicant's foundation services provide fundraising and counseling services in the field of 'eye cancer.'" For example, what follows is an excerpt from the undated declaration of applicant's president/chairman, Dr. Paul T. Finger, submitted to the U.S. Patent and Trademark Office during prosecution of this application, on June 9, 2010:

*The Eye Cancer Foundation History*

Established in 1998, The *Eye Cancer* Foundation is an educational and supportive resource for *eye cancer* patients, their families [\*12] and physicians. Our mission is two fold: one part focused on multi-centered research of new diagnostic treatments for *eye cancer* research, the other focused on providing much needed patient support services.

We understand that an *eye cancer* diagnosis can be overwhelming. It is for this reason that we provide two highly utilized web sites for patients and their families: The *Eye Cancer* Network. n19 [*emphasis* supplied by the Trademark Examining Attorney]

n19 On the top of this web page titled "The Eye Cancer Foundation," located at <http://www.eyecarefoundation.org/about.htm> is a letter to "Friends" from Paul T. Finger, MD, chairman of The Eye Cancer Foundation, directly above an email hyperlink to [contactus@eyecancerfoundation.net](mailto:contactus@eyecancerfoundation.net). Identical websites, both known as *eyecancernetwork*, are located at <http://eyecancer.com/> and at <http://www.eyecancer.com/>.

Although applicant's president/chairman referred to the above excerpt as a "now discontinued" description of [\*13] applicant's involved services, the entire evidence of record, to say nothing of common sense, suggests that this very language continues to encapsulate the two-fold purpose at the heart of applicant's mission.

Furthermore, in order to be found to be merely descriptive, it is not necessary that the term describe the totality of the goods or services. Rather, the descriptiveness of the term "Eye Cancer Foundation" is not negated by the fact that applicant, through various related foundations, networks and websites, may also provide fundraising services for medical research and website information for ocular patients and their families in relation to non-cancerous eye disorders or diseases (e.g., benign cysts, macular degeneration, etc.), which may well be more common than eye cancers.

In any case, whether applicant actually continues to perform all of the services included in the latest recitation is largely irrelevant for our purposes herein. n20

n20 Of course, if applicant does not provide any fundraising or patient information services related to eye cancer under this mark, the application may be statutorily infirm as misdescriptive, or deceptive.

[\*14]

Another of Dr. Finger's statements from the same declaration is as follows:

I disagree that the evidence of record would be understood by my peer physicians to believe that "eye diseases" is broad enough to encompass "eye cancer" because eye cancer is rare ... ."

Even if one concludes that this form of cancer is statistically quite rare when compared with the incidence of lung cancer or breast cancer, for example, that fact does not undercut in any way our determination under Section 2(e)(1) of the Lanham Act. The recitation of services still mentions "eye diseases." We find that "eye diseases" encompasses "eye cancer." n21 Accordingly, the suggestion that even other ocular oncologists would not consider "eye cancers" to be included within the category of "eye diseases" does not follow logically from the substantial evidence of record, whether one focuses on applicant's own websites, the cited dictionary definitions, the websites of organizations such as the American Cancer Society n22 or ASCO (American Society of Clinical Oncology), n23 or even the prosecution history revealed in the filewrapper of this application.

n21 *can.cer* -noun 1. Pathology. a. a malignant and invasive growth or tumor, especially one originating in epithelium, tending to recur after excision and to metastasize to other sites. b. *any disease characterized by such growths*. [RANDOM HOUSE DICTIONARY, 2011];

*cancer* A disease characterized by any of various malignant neoplasms composed of abnormal cells that tend to proliferate rapidly and invade surrounding tissue. Our Living Language: "... *Cancer, which represents more than 100 separate diseases*, destroys tissues and organs through invasive growth in a particular part of the body and by metastasizing to distant tissues and organs through the bloodstream or lymph system...." [THE AMERICAN HERITAGE SCIENCE DICTIONARY, 2002]. See *Notre Dame du Lac*, 217 USPQ at 508, footnote 7.

[\*15]

n22 <http://www.cancer.org/Cancer/EyeCancer/DetailedGuide/eye-cancer-diagnosis>

n23 <http://www.cancer.net/patient/Cancer+Types/Eye+Cancer>

In fact, for decades now in the Western world, all forms of cancers have been among the most lethal and feared classes of diseases stalking human kind. Hence, it strains credulity to claim that of all the known conditions and disorders of the eye, eye *cancers* would comprise classes of eye disorders that will *not* be thought of as eye *diseases*.

Moreover, applicant's services (i.e., offered under "The Eyecare Foundation," "The Eye Cancer Foundation," "The Eye Cancer Network," etc.) are clearly not directed to the field of ophthalmology generally (i.e., diagnosis and treatment of all conditions, disorders and/or diseases of the eye, from injuries and infections to tumors, glaucoma, cataracts, keratoconus, etc.). Rather, all of applicant's related websites made a part of the record (e.g., [www.eyecarefoundation.org](http://www.eyecarefoundation.org), <http://eyecancerfoundation.net/>, <http://eyecancer.com>, and <http://www.eyecancer.com/>) point to a narrow sub-specialty. These [\*16] sources identify Dr. Paul T. Finger as an "Eye Cancer Specialist" and Director of Ocular Oncology at The New York Eye Cancer Center. Dr. Finger's practice and foundations are focused on ocular tumors, eye *cancers* and related ophthalmic conditions. The record shows that ocular oncology is the branch of medicine dealing with tumors relating to the eye. Although some eye tumors can be benign, much of the focus of Dr. Finger's practice is actually on eye cancer, and the record shows that he has written numerous scientific articles about intraocular choroidal melanoma - including malignant eye tumors that metastasize to other organs of the body.

Accordingly, we find that applicant's proposed mark is merely descriptive of its services because it conveys information about a significant feature of the recited services. Specifically, the alleged mark tells consumers that applicant's foundation provides charitable fundraising and grants for research on eye diseases, such as eye cancer, and provides medical and patient-related information about eye diseases, including eye cancer.

**Legal Topics:**

For related research and practice materials, see the following legal topics:

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