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

DUNN

Mailed: September 29, 2009

Cancellation No. 92050260

WOK N' ROLL EXPRESS, INC.

v.

STW ACQUISITION CORP.

Before Quinn, Drost, and Mermelstein, Administrative Trademark Judges:

By the Board:

This case comes up on respondent's motion to dismiss for failure to state a claim for which relief could be granted under Fed. R. Civ. P. 12(b). Because respondent submitted matter outside the pleadings, and those matters were specifically addressed by petitioner when responding to the motion, the Board will treat the motion as a motion for summary judgment under Fed. R. Civ. P. 56. Petitioner opposes the motion.

The following facts are undisputed:

On September 3, 1985, Registration No. 1358531 issued for the mark WOK & ROLL for restaurant services to STW

Acquisition Corp., a New York corporation. On June 26, 2002, STW Acquisition Corp. was dissolved by proclamation of the New York Secretary of State pursuant to New York Tax Law for delinquency in tax payment. On May 4, 2005, Ben Wong, President of STW Acquisition Corp., signed a Section 9 renewal declaration averring, among other things, that respondent was using the mark in commerce. The declaration was filed May 23, 2005 and on July 14, 2005, the Office granted renewal of Registration No. 135853.

On November 29, 2009, Wok N' Roll Express, Inc. filed the instant petition to cancel alleging that, because STW Acquisition Corp. was dissolved at the time the renewal declaration was filed, respondent was not using the mark in commerce, Mr. Wong did not have authority to sign the declaration as a corporate officer, and thus the renewal declaration was fraudulent. On December 1, 2008, following payment of its taxes, respondent filed a certificate of consent of the New York Commissioner of Taxation and Finance reflecting such payment in the New York Department of State, and, pursuant to the New York State tax laws, the dissolution proceedings were annulled and the existence of the corporation revived, reinstated and continued.

The Board generally will not treat a motion under Federal Rule 12(b)(6) to dismiss a case as a motion for summary judgment because, in most cases, it would result in

a premature motion for summary judgment. *See Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251 (TTAB 2009). In this case, however, treating the present motion to dismiss as a Fed. R. Civ. P. 56 summary judgment motion does not result in such motion being premature. In essence, respondent argues that because petitioner's claim of fraud is based on respondent's lack of corporate status at the time the Section 9 renewal declaration was filed, and that the lack of status was remedied by the State of New York with retroactive effect, there is no claim on which to proceed. Accordingly, this motion is similar to a motion for summary judgment on lack of jurisdiction based on the question of respondent's legal capacity, with petitioner arguing that no such capacity existed at the time of filing of the renewal application, and respondent arguing that its incapacity was cured retroactively. The motion, therefore, will not be denied consideration on the ground that initial disclosures have not yet been made.[1]

Petitioner's standing to bring this action is not in dispute. The petition to cancel alleges (¶10) that respondent's registration was cited as a Section 2(d) bar to registration of petitioner's application Serial No.

[1] Pursuant to Trademark Rule 2.127(e)(1), "A party may not file a motion for summary judgment until the party has made its initial disclosures, except for a motion asserting claim or issue preclusion or lack of jurisdiction by the Trademark Trial and Appeal Board."

77236212, and respondent's answer, filed concurrently with its motion to dismiss, admits that fact. *See Cerveceria Modelo S.A. de C.V. v. R.B. Marco & Sons, Inc.*,55 USPQ2d 1298, 1300 (TTAB 2000).

Fraud in procuring a trademark registration occurs when an applicant knowingly makes false, material representations of fact in connection with his application. *In re Bose Corp.*, __ F.3d __, 91 USPQ2d 1938, 1939 (Fed. Cir. 2009). The petition to cancel fails to state a claim for relief inasmuch as petitioner alleges that respondent made false statements regarding its corporate status but does not allege that those statements were known by the declarant to be false at the time made. *Id.* at 1940 (citations omitted)("there is a material legal distinction between a 'false' representation and a 'fraudulent' one, the latter involving an intent to deceive, whereas the former may be occasioned by a misunderstanding, an inadvertence, a mere negligent omission, or the like."). While the Board generally is liberal in permitting amendment of defective pleadings, amendment does not appear to be appropriate in this case. Neither the petition nor petitioner's response to respondent's motion indicates that petitioner has any knowledge regarding respondent's intent on May 4, 2005, when Ben Wong signed the Section 9 renewal declaration with the

allegedly false statement regarding respondent's use in commerce.[2]

Further, the central fact underlying the petition to cancel – the corporate dissolution in effect at the time the Section 9 renewal declaration was filed - does not offer support for any additional claim under the Trademark Act. There is no allegation that respondent ceased use of the mark during the period of dissolution to support a potential claim of abandonment.[3] Because the New York Tax Law (NY CLS Tax §203-a) under which respondent's corporate status was revived specifies that the effect of revival is retroactive, there is no factual support for a claim that respondent's use during the period of dissolution was unlawful.[4]

In view of the foregoing, the Board grants respondent's motion for summary judgment on the pleaded claim of fraud, and judgment is entered for respondent.

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[2] Inasmuch as the petition to cancel states (¶5) "provided the information on the website is accurate, and the information conveyed in telephone calls is accurate", it appears that petitioner's sole source of information regarding the facts underlying the instant petition to cancel is the Corporations Division for the State of New York, and its website.

[3] In fact, petitioner's motion concedes that respondent may not have been aware of the corporate dissolution stating (p. 4) "What has not been determined is whether Respondent and/or Mr. Wong knew whether Respondent had been administratively dissolved at that time."

[4] We find unpersuasive respondent's contention that the Board can choose to recognize the authority of the New York State tax law for the purpose of finding that the respondent was dissolved but can refuse to recognize the retroactive effect of the corporate reinstatement under the same law.