

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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CME/LTS

February 16, 2019

Cancellation No. 92068091

Usina Sao Francisco S.A.

v.

Tile World Corporation d/b/a TWCorp

Christen M. English, Interlocutory Attorney:

Petitioner's motion, filed October 18, 2018, will be given no consideration because Petitioner moves for summary judgment on a time-barred claim.

Petitioner asserts that it seeks summary judgment on Count III in its petition to cancel, which it frames as a claim that the registration is "void ab initio" because it "issued based on ownership and use claims made by a party who did not own the mark." 5 TTABVUE 3. When the petition to cancel was filed on March 12, 2018, the involved registration was more than five years old. The available claims against a registration that is more than five years old are limited to those claims set out in Section 14(3) of the Trademark Act. *See* 15 U.S.C. § 1064(3). The claim that a registration is "void ab initio" because it "issued based on ownership and use claims made by a party who did not own the mark or subject application at the time" is not a claim enumerated in Section 14(3).

Perhaps recognizing that the void ab initio claim is time-barred, Petitioner did not plead Count III solely based on allegations that the involved registration issued based on ownership and use claims made by a party who did not own the mark or subject application. Instead, Petitioner pleaded fraud, alleging that Respondent made “false material statements ... with the intent to procure registration” to which Respondent was not entitled and made those allegedly false material statements “knowingly.” 1 TTABVUE 10-11, ¶¶ 37-38.

Fraud is one of the claims enumerated in Section 14(3), and therefore, may be asserted against a registration more than five years old. Petitioner, however, does not move for summary judgment on the basis of fraud as it has not argued or offered evidence that Respondent **knowingly** made a false statement with an **intent** to deceive the Office.¹

Because the Board may not grant summary judgment on a time-barred claim, Petitioner’s motion for summary judgment will be given no consideration.

Proceedings are **resumed**. Dates are reset as follows:

Expert Disclosures Due	3/4/2019
Discovery Closes	4/3/2019
Plaintiff’s Pretrial Disclosures Due	5/18/2019
Plaintiff’s 30-day Trial Period Ends	7/2/2019
Defendant’s Pretrial Disclosures Due	7/17/2019

¹ Petitioner is advised that the factual question of intent, which is an element of a fraud claim, “is particularly unsuited to disposition on summary judgment.” *Copelands’ Ents. Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1299 (Fed. Cir. 1991) (emphasis added); see also *Asian and W. Classics B.C. v. Selkow*, 92 USPQ2d 1478, 1480 (TTAB 2009). Moreover, “[a] party making a fraud claim is under a heavy burden because fraud must be proven to the hilt by clear and convincing evidence, leaving nothing to speculation, conjecture, or surmise....” *Asian and W. Classics*, 92 USPQ2d at 1480.

Defendant's 30-day Trial Period Ends	8/31/2019
Plaintiff's Rebuttal Disclosures Due	9/15/2019
Plaintiff's 15-day Rebuttal Period Ends	10/15/2019
Plaintiff's Opening Brief Due	12/14/2019
Defendant's Brief Due	1/13/2020
Plaintiff's Reply Brief Due	1/28/2020
Request for Oral Hearing (optional) Due	2/7/2020

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