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PRECEDENT OF THE TTAB

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

JK

Mailed: October 30, 2008

Cancellation No. 92032447

MARC MATHERS

v.

YSHHEYNA HAMILLA

Before Holtzman, Cataldo and Ritchie de Larena:
Administrative Trademark Judges.

By the Board:

This proceeding is before the Board for consideration of respondent's motion (filed May 15, 2008 via Certificate of Mailing) for summary judgment under Fed. R. Civ. P. 56. The motion is fully briefed.

On August 26, 2001, petitioner filed a petition to cancel respondent's Registration No. 1855708.¹ The petition alleges, *inter alia*, that respondent committed fraud in the execution of her Combined Declaration of Use and Incontestability under Sections 8 and 15 of the Trademark Act ("declaration of use" or "declarations of

¹ Registration No. 1855708 registered on September 27, 1994, for the mark RAINBOW in standard characters, for "educational and informational cards and charts in the field of physical, mental, and emotional health," alleging a date of first use and first use in commerce of November 31, 1989, Section 8 and 15 declaration accepted on June 7, 2001, first renewal March 23, 2007.

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use") filed with the USPTO on September 28, 2000.

Specifically, petitioner alleges that respondent committed fraud by (1) using a false name when signing her declaration of use, and (2) falsely withholding information regarding a legal challenge to her registration in an infringement action in a United States District Court.

The operative facts are not in dispute. On September 27, 1994, Registration No. 1855708 issued in the name of Janet Zupcsics, an individual United States citizen. On November 10, 1997, respondent, as plaintiff, filed a federal trademark infringement action in the United States District Court for the Middle District of Florida, Case No. 8:97-2725-CIV-T-26A, against petitioner; in July and August of 2001, said Court denied petitioner's two respective motions to add a counterclaim to invalidate respondent's U.S. Registration No. 1855708.

On January 4, 2000, a Final Judgment of Change of Name was granted in the Circuit Court of the Fifth Judicial Circuit for Lake County, Florida, Case No. 99-3284CA, changing respondent's name from Janet Zupcsics to Yshheyne Hamilla.² On September 28, 2000 respondent filed her declaration of use, having executed said declaration on September 22, 2000 using her former legal name, Janet

²On September 13, 2007, the change of name dated January 4, 2000 was recorded with the Assignment Branch records for the subject registration at Reel/Frame 3620/0514.

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Zupcsics. On June 7, 2001, the USPTO issued a notice of acceptance of the declaration of use. Petitioner filed this cancellation proceeding on August 26, 2001.

Respondent moves for summary judgment on petitioner's fraud claims, Counts I and II of the petition to cancel. With respect to petitioner's claim of fraud in the execution of the declaration of use, respondent asserts that her declaration of use satisfied all of the requirements for such a filing and does not form the basis for a fraud claim as a matter of law. Specifically, she asserts that signing her former legal name was not a false material representation, but "simply a mistake in the manner in which her name was set out," that she was still the owner of the registration at the time of signing and filing the declaration of use, and that had the USPTO questioned her ownership she could have readily provided documentation to correct the oversight. In support thereof, respondent submitted her declaration of May 15, 2008, which introduced and included (1) a certified copy of the petition for change of name filed in Lake County, Florida; and (2) the final judgment thereon dated January 4, 2000.

With respect to petitioner's claim of fraud alleging that respondent falsely withheld information that her trademark was under challenge in a U.S. District Court, respondent asserts that when she filed her declaration of

use, there was no counterclaim in the District Court action challenging her rights in the mark, and explains that the District Court, in 2001, denied two motions filed by petitioner as defendant therein to add a counterclaim to invalidate her mark. In support thereof, respondent submitted a declaration of May 15, 2008, which introduced and included (1) the complaint respondent filed in the District Court and petitioner's answer thereto; (2) petitioner's July 3, 2001 motion to amend its answer therein to add a counterclaim for mere descriptiveness, and the District Court's July 25, 2001 denial of said motion; and (3) petitioner's August 20, 2001 motion to amend its answer therein to add a count for declaratory judgment, and the District Court's August 30, 2001 denial of said motion. Further, respondent relies on TMEP § 1605.04, which states that the USPTO does not consider a proceeding involving the mark in which the owner is the plaintiff, where there is no counterclaim involving the owner's rights in the mark, to be a proceeding that would preclude the filing or acknowledgment of a Section 15 affidavit.

In response to the motion for summary judgment, petitioner argues that (1) respondent "falsely executed" her September 22, 2000 declaration of use "in a name which she knew to be false;" (2) such "false statement" was not due to mere inadvertence or mistake; (3) such "false statement" was

material; (4) the USPTO "was induced to accept material documents required to maintain the validity of the trademark in a false and nonexistent name;" (5) the USPTO required respondent to provide change of name or assignment documentation before accepting her September 2004 renewal application which she signed in her new legal name; and (6) respondent's declaration of use "concealed" knowledge that her trademark rights were under legal challenge by virtue of petitioner's filing, in the District Court civil case, of a challenge to her trademark as merely descriptive.

In support of his assertions, petitioner submitted a copy of respondent's renewal application filed on September 23, 2004, and supporting documentation associated therewith, and a September 17, 2007 request for a new certificate of registration in the owner's new name.

Analysis

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material facts, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

A party seeking summary judgment bears the initial burden of demonstrating the absence of genuine issue of material fact, and of informing the Board of the basis for its motion by identifying those portions of the record which it believes demonstrates the absence of a genuine issue of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986). When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely disputed facts which must be resolved at trial. The nonmoving party may not rest on mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record, or produce additional affidavit evidence, showing the existence of a genuine issue of material fact for trial. If the nonmoving party does not so respond, summary judgment, if appropriate, shall be entered in the moving party's favor. See Fed. R. Civ. P. 56(e).

Fraud occurs when an applicant knowingly makes false, material representations of fact in connection with an application to register. The obligation to refrain from knowingly making false, material statements applies with equal force to renewal applications. See *Torres v. Cantine*

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Torresella S.r.l., 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986). See also *Herbaceuticals Inc. v. Xel Herbaceuticals Inc.*, 86 USPQ2d 1572 (TTAB 2008). A party asserting a fraud claim is under a heavy burden of proof because fraud must be proved by clear and convincing evidence, leaving nothing to speculation, conjecture, or surmise. The very nature of the charge of fraud requires that it be proven "to the hilt" with clear and convincing evidence. Any doubt must be resolved against the party making the claim. *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1035 (TTAB 2007); *Smith International, Inc. v. Olin Corporation*, 209 USPQ 1033, 1043 (TTAB 1981).

To the extent that petitioner's fraud claim is predicated on the allegation that respondent's signing of her former name on the declaration of use constitutes fraud on the USPTO, we agree with respondent that the facts presented cannot support a finding of fraud. Specifically, while respondent's signing of her former name eight months after entry of the court decree changing her legal name was technically in error, the record is devoid of evidence that such action constituted a knowingly false, material statement of a fact on which the USPTO relied in accepting respondent's declaration of use. A trier of fact could not conclude, on the facts before us, that respondent made a misrepresentation that rises to the level of or supports a

finding of fraud in the maintenance of respondent's registration. Respondent was the owner of the subject registration at the time of filing the declaration of use, and her legal change of name did not effectuate a change in which person or legal entity owned that registration.

Moreover, we will not substitute our judgment for that of the examiner in the Post-Registration Division. As the Board has previously held, an allegation of the sufficiency of what was submitted in an application is a technical question which is within the province of the examiner to determine and cannot form the basis of a proceeding before the Board. *Cf. Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989) (the issue of the adequacy of the specimens is solely a matter of *ex parte* examination and is not a ground for an opposition). See also *Granny's Submarine Sandwiches v. Granny's Kitchen Inc.*, 199 USPQ 564, 567 (TTAB 1978) (the Board will not substitute its judgment for that of the examiner); *Hyde Park Footwear Co., Inc. v. Hampshire-Designers, Inc.*, 197 USPQ 639, 642 (TTAB 1977) (it is not the Board's function to review or supervise the work of the examiner).³

³Moreover, the purpose of Section 8 affidavits is to remove from the register automatically marks which are no longer in use. The significant facts, therefore, are that an affidavit is filed and that a mark is actually still in use. Given the fact of continuing use, from which practically all of the user's substantive trademark rights derive, nothing is to be gained from and no public purpose is served by cancelling the registration of

Furthermore, we find unpersuasive petitioner's argument that the USPTO's examination of respondent's renewal application filed on September 23, 2004 sets forth facts from which we can conclude that respondent's September 2000 declaration of use included a material misrepresentation. We find untenable petitioner's argument that "error" and "falsehood" in respondent's September 28, 2000 declaration amounted to fraud because respondent's later-filed renewal application, which respondent executed using her changed name, prompted the USPTO to require that Yshheyra Hamilla establish ownership of the registration. Further, inasmuch as petitioner commenced this cancellation proceeding in 2001 alleging fraud in the declaration of use filed in 2000, petitioner's argument regarding the examination of the 2004 renewal application is based on facts not pleaded in and thus irrelevant to the fraud claims in the petition to cancel. Finally, as we have stated hereinabove, respondent's execution of the declaration of use in her former name does not amount to a false material representation regarding ownership of the registration.

To the extent that petitioner's fraud claim is predicated on the allegation that respondent's declaration

a technically good trademark because of a minor technical defect in an affidavit. It is in the public interest to *maintain* registrations of technically good trademarks on the register so long as they are still in use. See *Morehouse Mfg. Co. v. J. Strickland and Co.*, 407 F.2d 881, 160 USPQ 715, 720 (CCPA 1969).

of use knowingly withheld information that a proceeding involving respondent's rights in the mark was pending in the U.S. District Court for the Middle District of Florida, we similarly find said claim to be unpersuasive. Respondent has been forthcoming with documentation demonstrating that, when she filed her declaration of use, no proceeding involving her rights in the mark was pending in a court of law. Specifically, the pleadings and subsequent filings pertaining to the referenced District Court infringement action indicate that respondent filed as plaintiff in said civil action for infringement, that no counterclaim existed in September 2000 when respondent filed her declaration of use, that there was no final decision adverse to respondent's ownership of the mark when respondent filed her declaration of use, and that petitioner's two unsuccessful attempts to add a counterclaim in the District Court case to invalidate the registration did not occur until July and August of 2001, well after respondent filed her declaration of use. Thus, respondent did not make a false representation of fact, in her declaration of use, with respect to whether an adverse decision was pending against the registration at issue.

To summarize, on the record before us, we find that petitioner cannot prevail on his claim that respondent committed fraud on the USPTO in the September, 2000 filing

of her declaration of use. Respondent has met her burden of demonstrating that there is no genuine issue of fact with respect to whether said declaration of use includes a false representation of a material fact. We thus conclude that respondent is entitled to judgment as a matter of law with respect to the fraud claims.

In view thereof, respondent's motion for summary judgment is hereby granted.

Inasmuch as the Board, on November 23, 2007, struck Count III of the petition to cancel on the ground that said count, alleging that the mark is merely descriptive, was time-barred under Trademark Act Section 14(3), the petition to cancel is hereby dismissed in its entirety.