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OF THE TTAB

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

BUTLER

Mailed: June 26, 2008

Cancellation No. 92046815

THE INSTITUTE OF CHARTERED
FINANCIAL ANALYSTS OF INDIA

v.

CFA INSTITUTE

Before Seeherman, Grendel and Kuhlke, Administrative Trademark
Judges.

By the Board:

Petitioner (hereinafter sometimes "ICFAI") seeks to cancel respondent's registration for the mark ICFA for "printed publications in the field of financial analysis and in support of the interests of financial analysts."¹

As grounds for cancellation, petitioner alleges that 1) respondent committed fraud in procuring the registration because the specimen submitted does not show use of the ICFA designation as a trademark in interstate commerce in the United States² and 2) that respondent has abandoned its mark because it has not used the mark in commerce for "well in excess of three years prior to the filing

¹ Registration No. 2497589, issued on October 16, 2001, claiming a date of first use anywhere and a date of first use in commerce of March 4, 1997. Trademark Act §8 affidavit accepted.

² Paragraph No. 7 of the petition to cancel.

date" of the petition to cancel.³ Petitioner alleges that it has adopted and is using the mark ICFAI for providing educational, research and publishing services in a wide range of disciplines, including finance; and that it has adopted and continuously used its mark for publishing since April, 2001 and for research since November, 2003.⁴ Petitioner alleges that it intends to file an application for the mark ICFAI reciting a date of first use in interstate commerce of August, 2000.⁵ Petitioner further alleges its belief that it is damaged by the continued registration of respondent's mark because such registration may constitute a barrier for petitioner's registration of its ICFAI, ICFAI University, ICFAI University Press, ICFAI Books, ICFAI Center for Management Research, and ICFAI Business School Case Development Center marks, thus damaging petitioner's current and future business.⁶

In its answer, respondent denies the salient allegations of the petition to cancel. Respondent asserts that, should petitioner's allegations of use of the mark ICFAI for publishing since April, 2001 and for research since November, 2003 be true, such use violates the final order, dated October 9, 1998, of the United States District Court for the Eastern District of Virginia. Respondent also asserts numerous affirmative defenses.

³ Paragraph No. 8 of the petition to cancel.

⁴ Paragraph Nos. 2-4 of the petition to cancel.

⁵ Paragraph No. 5 of the petition to cancel.

⁶ Paragraph No. 9 of the petition to cancel.

This case now comes up on respondent's fully briefed motion, filed March 26, 2007, for judgment on the pleadings on the basis that petitioner does not have standing, and on petitioner's fully briefed motion, filed October 11, 2007, for leave to file an amended petition to cancel with respect to its allegation of standing.

Both parties have submitted matters outside the pleadings (*i.e.*, rulings made by the district court and filings submitted to the district court). Thus, the motion for judgment on the pleadings is being treated as one for summary judgment. See TBMP §504.03 (2d ed. rev. 2004). Insofar as our determination of the motion for summary judgment is dependent solely on the court rulings, no additional briefs or submissions are necessary.

Summary of the civil litigation

On October 9, 1998, the court entered default judgment against ICFAI in *The Institute of Chartered Financial Analysts and Association for Investment Management and Research v. Institute of Chartered Financial Analysts of India*, Civil Action No. 3:98CV417 (EDVA 10/9/1998),⁷ and entered an order enjoining and restraining ICFAI from, among other things:

(2)b. using the names or marks cfa, CFA, C.F.A., ICFA, I.C.F.A., CCFA, C.C.F.A., CHARTERED FINANCIAL ANALYST, FINANCIAL ANALYSTS JOURNAL, INSTITUTE OF CHARTERED FINANCIAL ANALYSTS, and any other names or marks that are likely to cause confusion with these names and marks, in the United States and Canada.⁸

⁷ Respondent explains the "The Institute of Chartered Financial Analysts" is its former name.

⁸ With respect to the listed designations, "and any other names or marks that are likely to cause confusion with these names and marks," the court's injunction further prohibited activities outside the United States and Canada that promote or authorize use of the designations inside the United States or

Respondent separately submitted the court's "Findings of Facts and Conclusions of Law," also dated October 9, 1998. The court specifically found as follows:

Trademark Infringement

26. ICFAI's use of the marks C.F.A., cfa, CFA and similar colorable imitations of plaintiffs' marks has caused and is likely to cause confusion among the investing public, regulators, actual and potential CFA candidates, and potential employers of CFA charterholders ...

False Designation of Origin

32. ICFAI's use of the marks C.F.A., cfa, CFA, CHARTERED FINANCIAL ANALYST, **ICFAI**, and similar colorable imitations of plaintiff's marks is likely to cause confusion among consumers, including the investing public, regulators, employers and actual and potential CFA candidates, and other consumers of [plaintiffs'] goods and services.... (Emphasis added.)

Prior to respondent's filing of its motion for judgment on the pleadings on March 26, 2007, ICFAI filed a motion with the district court to reopen the civil case and to vacate the 1998 default judgment, which the district court granted. Respondent informed the Board on May 25, 2007 that it filed a motion for reconsideration with the court on or about May 23, 2007. On September 21, 2007, respondent submitted to the Board a copy of the district court's "Final Order," dated September 5, 2007, granting plaintiffs' (respondent in this cancellation proceeding) motion for reconsideration and denying ICFAI's motion to dismiss for lack of personal jurisdiction. The court reinstated the October 9, 1998 order entering default judgment in favor of plaintiffs.

Canada. Paragraph No. 2(c) of the court's order. The court expressly prohibited use of the aforementioned designations with "any educational

Petitioner's motion for leave to amend the petition to cancel

By the proposed amendment, petitioner is no longer seeking to rely, as the basis for its standing, on its use of the mark ICFAI in commerce and its prospective filing of a trademark application for which it anticipates a refusal in view of the existence of respondent's registration. Thus, petitioner appears to acknowledge that its originally pled allegations for standing are no longer tenable in view of the district court's reinstatement of the October 9, 1998 default judgment.

Petitioner now seeks to substitute the following allegation of standing:⁹

4. Registrant is trying to enforce an injunction based on the trademark reflected in Registration No. 2,497,589 against Petitioner, and has moved for a finding that Petitioner is in contempt of that injunction. Because Registrant is trying to enforce an injunction based on the trademark reflected in Registration No. 2,497,589 against Petitioner, Petitioner has a real interest in whether the registration is valid and should be cancelled.

As a general proposition, the Board liberally grants amendments to the pleadings. See Fed. R. Civ. P. 15(a); and TBMP §507.02 (2d ed. rev. 2004). However, where the proposed amendment to the pleading would be futile, the Board will not grant the motion. TBMP §507.02.

Thus, the question now before the Board is whether, with the district court's injunction in effect, petitioner's proposed allegation regarding respondent's attempt to enforce the injunction

programs" and any "internet web page or electronic resources accessible within the United States...." Paragraph Nos. 2(d), (e) and (f).

⁹ The fraud and abandonment claims remain unchanged.

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is sufficient to confer standing upon petitioner in this cancellation proceeding or whether such proposed amendment is futile.

We are cognizant that, because the district court imposed an injunction which remains in effect, it is incumbent upon the Board to give deference to the determinations of the court, including the remedy entered in the order, and consider the terms of the injunction and how it applies to the facts of this cancellation proceeding. *See Daimler Chrysler Corp. v. Keith Maydak*, ___ USPQ2d ___, Opposition No. 91153172 (TTAB 4/4/2008).

The October 9, 1998 injunction does not expressly reference the mark ICFAI. However, paragraph No. 32 of the district court's "Findings of Facts and Conclusions of Law," *supra*, expressly references the ICFAI mark as one that is likely to cause confusion with plaintiffs' mark (*i.e.*, the mark of respondent herein). Consequently, the ICFAI mark is included in the provisions of paragraph Nos. 2(b)-(f) and (i) of the October 9, 1998 injunction, which lists specific marks and further states "... and any other names or marks that are likely to cause confusion with theses names and marks..." Petitioner, then, under the terms of the injunction, is prohibited from using such mark in the United States and Canada and in other ways specifically addressed in paragraph Nos. 2(c)-(f) and (i) of the injunction.

We find that, in view of the continued existence of the injunction issued by the district court, petitioner's proposed amendment to its pleading to allege standing based on the

purported enforcement of the injunction is futile. Because of the Court's order, petitioner is legally prohibited from using its claimed mark. Therefore, it cannot be damaged by respondent's attempts to enforce the injunction.

Accordingly, petitioner's motion for leave to amend the petition to cancel is denied.

Summary judgment

On a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

As a preliminary matter, the Board notes that respondent's motion is not premised on either *res judicata* or collateral estoppel. *Res judicata*, or claim preclusion, is not applicable here because the claims presented in this cancellation proceeding (*i.e.*, fraud in the procurement and abandonment) are not the same

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as the claims adjudicated in the court case.¹⁰ See *Lawlor v. National Screen Service Corp.*, 349 U.S. 322, 75 S.Ct. 865, 99 L.Ed. 1122 (1955); and *Chromalloy American Corp. v. Kenneth Gordon, Ltd.*, 736 F.2d 694, 222 USPQ 187 (Fed. Cir. 1984). Although the court made some findings of fact, discussed *supra*, that have a bearing on this cancellation proceeding, collateral estoppel, or issue preclusion, is not applicable here because the requirements have not been met. See *Mayer/Berkshire Corp. v. Berkshire Fashions Inc.*, 424 F.3d 1229, 76 USPQ2d 1310 (Fed. Cir. 2005); *Jet Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1854 (Fed. Cir. 2000); and *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840, 1843-1844 (TTAB 1995).

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). The purpose of the standing requirement, which is directed solely to the interest of the plaintiff, is to prevent litigation when there is no real interest or controversy between the parties. *Lipton Industries, Inc.*, 213 USPQ at 189. In the case of a petition to cancel, the standing requirement of a plaintiff has its statutory basis in Section 14 of the Trademark Act which provides that "any person who believes he is or will be damaged ... by the registration

¹⁰ The claims before the court were trademark infringement under Section 32(a) of the Trademark Act, federal unfair competition under Section 43(a) of the Trademark Act, and breach or anticipatory breach of contract. "Findings of Fact and Conclusion of Law," October 9, 1998, p. 14.

of a mark on the principal register ..." may file a petition to cancel. To establish standing, it must be shown that the plaintiff has a "real interest" in the outcome of the proceeding; that is, plaintiff must have a direct and personal stake in the outcome of the cancellation. *Ritchie*, 50 USPQ2d at 1023. Facts regarding legitimate personal interest are part of the plaintiff's case and must be proved. *Lipton Industries*, 213 USPQ 189.

In view of the district court's final order, dated September 5, 2007, reinstating the October 9, 1998 default judgment; the existence of the injunctions; petitioner's apparent acknowledgement that it can no longer base its standing in this cancellation proceeding on its originally pled allegations; and the Board's determination, *supra*, that petitioner's proposed amendment to its pleading with respect to its allegations of standing is futile, there exists no genuine issue of material fact that petitioner lacks a real interest to seek to cancel respondent's registration and, thus has no standing herein.¹¹

Accordingly, respondent's motion for summary judgment is granted and the petition to cancel is dismissed with prejudice.

¹¹ Should the district court modify or revoke the injunction, that may constitute a change in the circumstances upon which petitioner may rely for standing. We note, too, that the injunction issued long before respondent's mark was registered and even prior to the filing date, August 30, 1999, of the underlying application. Thus, in imposing the injunction, the court did not, and could not, rely on the registered status of respondent's ICFA mark and, instead, may have relied on any common law uses plaintiffs (respondent herein) may have shown.