

Hearing:
January 8, 1998

Paper No. 19
PTH

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 9/23/98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

International Association of Sufism
v.
Nader Angha

Cancellation No. 24,510

Michael B. Newman of Buchman & O'Brien for International Association of Sufism.

Joseph D. Lewis of Cleary, Komen & Lewis, LLP for Nader Angha.

Before Hanak, Quinn and Hairston, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

The International Association of Sufism has filed a petition for partial cancellation (Class 41) of the registration of the mark depicted below,

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for "educational services, namely, providing courses of Islamic Sufism instruction, seminars, lectures, workshops, at all educational levels."¹

As grounds for cancellation, plaintiff alleges that it is a worldwide membership association of Sufi schools, orders, and students that practice and study Sufism; that many of its members practice and study Islamic Sufism; and that defendant obtained the involved registration fraudulently because (1) neither defendant nor his predecessor-in-interest used the mark as of the dates of first use set forth in the application which matured into the registration; and (2) defendant falsely represented to the Patent and Trademark Office that the mark had no significance in the field.

Defendant, in his answer, has denied the salient allegations of the petition to cancel.

The record consists of the pleadings; the file of the involved registration; plaintiff's notices of reliance on (1) defendant's responses to plaintiff's first set of interrogatories and (2) excerpts taken from printed publications on Sufism and symbols; and the testimony

¹ Registration No. 1,440,550 issued May 26, 1987; Sections & 15 affidavit filed. The registration also covers goods and services in Classes 14, 16, 24, 26 and 42. 8

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deposition of defendant's witness with exhibits. Both parties filed briefs on the case and were represented at the oral hearing.

At the outset, we note that the record in this case provides no information about plaintiff. As indicated above, plaintiff offered into evidence only defendant's responses to interrogatories and excerpts from printed publications.

We do, however, have some information about defendant's use of the involved mark from his responses to plaintiff's interrogatories. Defendant indicated therein that the mark was first used in 1922 in Tehran, Iran by a predecessor, and as early as 1978 in the United States by another predecessor. According to defendant, the mark was first used on printed publications such as books. Further, defendant indicated that the mark is intended to convey to consumers:

The 1400 years of goodwill established by Respondent and his predecessors is symbolized in the mark. "Infinity" relates to the open heart as shown in the mark; it suggests the eternal and infinite aspects of the human being--the spiritual, and the physical--each originating in the source of life in the heart.

Also, defendant stated that the mark is subject of an unwritten license agreement between defendant and one of his predecessors. Defendant stated that he exercises control

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over the quality of the goods and services provided under the mark by serving as religious leader for the predecessor organization.

As stated by the Board in *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1328 (TTAB 1992):

Fraud in procuring a registration occurs when an applicant for registration knowingly makes false, material representations of fact in connection with an application to register. A party making a claim of fraud is under a heavy burden since fraud must be proved by clear and convincing evidence, leaving nothing to speculation, conjecture or surmise. Should there be any doubt, it must be resolved against the party making the claim.
(citations omitted)

We turn first to plaintiff's allegation that the registration was obtained fraudulently because neither respondent nor his predecessor used the mark as of the dates of first use set forth in the application which matured into the registration. In support of this allegation, plaintiff relies on defendant's response to plaintiff's Interrogatory No. 1(c) which requests that defendant identify the documents relating to his first use of the involved mark. In response to this interrogatory, defendant stated that "[n]o such documents showing the first use are available." The mere fact, however, that no such documents are available is not clear proof that the mark was not in use as of the claimed dates of first use. More importantly, even if plaintiff had shown that the mark was not in use as of the

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claimed dates of first use, this would not prove that the registration was obtained fraudulently. The concept of fraud upon the Office signifies an intent to deceive the Office; that is, a willful withholding from the Office by an applicant of material information or facts which, if transmitted to the Office, would have resulted in the refusal of the registration sought. An erroneous date of first use could not result in the allowance of a registration which would otherwise not be allowed, as long as there was technical trademark or service mark use prior to the filing of the application. The only fraud that can be perpetuated on the Patent and Trademark Office with respect to false dates of first use in an application is where no use of the mark was made as of the filing date of the application. See *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73 (TTAB 1973). Thus, in order for plaintiff to prevail on its claim, it would have to prove that the mark was not in use as of July 8, 1986, the filing date of the application.

We turn next to plaintiff's allegation that defendant falsely represented to the Patent and Trademark Office that the mark had no significance in the field. Plaintiff maintains that the involved mark is a representation of a double-bladed ax, a well-known symbol of Sufism. However, it is not clear to us that defendant's mark is indeed a

representation of a double-bladed ax. There is no handle in defendant's mark², and there is at least a question as to whether double blades are depicted. While not controlling on this question, we note that defendant, in his application, described the mark as the "Infinity Design." Further, we note that nowhere in the materials made of record by plaintiff does it indicate that a double-bladed ax is a symbol of Sufism.³ On the contrary, defendant's witness, Professor Sulayman S. Nyang, an author of publications in the fields of Islam and Sufism, testified that a double-bladed ax is not a symbol of Sufism. Also, while the materials made of record depict what plaintiff purports are representations of double-bladed axes, these axes differ substantially in appearance from defendant's mark. Examples of these axes are set forth below.

² The American Heritage Dictionary (1975) defines the word "ax" as "a tool with a bladed head mounted on a handle, used for felling or splitting lumber."

³ We should note that the materials contain limited references to a double-bladed ax. In Sufi Expressions of the Mystic Quest, (1976) it is stated that "[t]he double axe symbolizes the individual's active nature as agent." In Fundamental Symbols (1995), in the section titled "Some Symbolic Weapons," it is stated that the double ax "pertains particularly, though not exclusively, to Aegean and Cretan symbolism."

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In view of the foregoing, we find that plaintiff's claim that defendant falsely represented to the Patent and Trademark Office that his mark had no significance in the field is without merit.

In sum, plaintiff has simply failed to demonstrate that defendant fraudulently obtained his registration.

Decision: The petition to cancel is denied.

E. W. Hanak

T. J. Quinn

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial and
Appeal Board