



# Bulletin

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## **UNITED STATES: Rebuttable Presumption Against Fraud When Application Is Amended Before Publication**

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In a precedential decision, the U.S. Patent and Trademark Office's (USPTO's) Trademark Trial and Appeal Board (TTAB) held that where the identification of goods in a trademark application is amended prior to publication, the applicant is entitled to "a rebuttable presumption that [the applicant] lacked the willful intent to deceive the Office." *University Games Corp. v. 20Q.net Inc.* (Opp. Nos. 91168142, 91170668, T.T.A.B. May 2, 2008).

20Q.net Inc. filed two applications to register the mark 20Q for online computer games. University Games Corporation, the owner of a federal registration for the mark TWENTY QUESTIONS for a board game, opposed 20Q.net's applications. 20Q.net filed a counterclaim requesting cancellation of the TWENTY QUESTIONS mark.

20Q.net discovered that the identification of goods in University Game's original use-based application to register TWENTY QUESTIONS included T-shirts, paper products and videos. In response to an office action, University Games had removed those goods from its application. 20Q.net alleged that University Games committed a fraud on the USPTO by misrepresenting the goods it was selling in its original application. It sought summary judgment on its counterclaim requesting cancellation of the TWENTY QUESTIONS registration, asserting that the misrepresentation by University Games in its original application could not be cured by the subsequent amendment deleting the goods.

The TTAB cited *Hurley International LLC v. Volta*, 82 U.S.P.Q.2d 1339 (T.T.A.B. 2007) for the proposition that "a misstatement in an application as to the goods or services on which a mark has been used does not rise to the level of fraud where an applicant amends the application prior to publication." It held that University Games was entitled to a rebuttable presumption that it had no willful intent to deceive the USPTO because it amended its application prior to publication.

One TTAB judge, concurring in part and dissenting in part, expressed the view that corrective action taken by an applicant prior to registration and prior to any actual or threatened challenge to the application or registration should preclude a fraud claim.

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