

1 **UNITED STATES COURT OF APPEALS**
2 **FOR THE SECOND CIRCUIT**

3
4 September Term 2015

5
6 (Submitted: January 11, 2016 Decided: June 27, 2016)

7
8 No. 15-717-cv
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12 MPC FRANCHISE, LLC; MP CLEARY, INC.,
13 *Plaintiffs-Appellees,*

14
15 -v.-

16
17 BRENT TARNTINO,
18 *Defendant-Appellant.*¹
19

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21
22 Before: STRAUB, LIVINGSTON, and CHIN, *Circuit Judges.*
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24 Appeal from a judgment of the United States District Court for the
25 Western District of New York (Siragusa, J.), granting summary judgment to
26 Plaintiffs-Appellees, companies that own pizza restaurants in Elmira, New York,
27 by the general name of “Pudgie’s,” on their Lanham Act claim seeking
28 cancellation of Defendant-Appellant Brent Tarantino’s (“Tarantino”) federal
29 trademark registration for the PUDGIE’S mark in connection with pizza
30 restaurants, on the ground that Tarantino obtained the mark by fraud. Because
31 we find no genuine issue of material fact that Tarantino fraudulently procured his

¹ The Clerk of the Court is directed to amend the caption as above.

1 mark, we conclude that summary judgment to Plaintiffs-Appellees was
2 appropriate, and therefore **AFFIRM** the judgment of the district court cancelling
3 Tarantino's mark.

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5 JEFFREY ZUCKER, Fischer Zucker, LLC; Philadelphia,
6 P.A., *for Plaintiffs-Appellees*.

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8 MICHAEL H. ZHU, Michael H. Zhu, Esq. PC; New York,
9 N.Y., *for Defendant-Appellant*.

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11 DEBRA ANN LIVINGSTON, *Circuit Judge*:

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13 This case involves a dispute over the mark for a chain of pizza restaurants
14 by the general name of "Pudgie's," which started out as a small family business,
15 but waxed and waned over the decades as the original founders passed their
16 interests on to subsequent generations and once-convivial family relationships
17 soured. Defendant Brent Tarantino ("Tarantino") appeals from a judgment of the
18 United States District Court for the Western District of New York (Siragusa, J.),
19 granting summary judgment to Plaintiffs-Appellees MPC Franchise, LLC ("MPC
20 Franchise") and MP Cleary, Inc. ("MP Cleary") (collectively, "Plaintiffs") —
21 entities owned principally by Tarantino's cousins, David Cleary and Robert
22 Cleary — on Plaintiffs' claim that Tarantino fraudulently obtained his federal
23 trademark registration for the PUDGIE'S mark in connection with restaurants
24 that principally serve pizza, pasta, and submarine sandwiches.

I. Background

A. Facts

The dispute over the PUDGIE’S mark traces back more than fifty years to the town of Elmira, New York, just north of the Pennsylvania border. In 1963, three brothers — Charles “Pudgie” Cleary, Francis Cleary, and Michael Cleary, Sr. — opened up a pizza parlor on the north side of Elmira and named it Pudgie’s, after one of the three brothers. The following year, the three brothers opened a second Pudgie’s location, this time on the south side of Elmira. The two locations came to be known as “Pudgie’s Northside” and “Pudgie’s Southside,” respectively. Pudgie’s Northside and Pudgie’s Southside experienced continued success, prompting the three brothers in 1972 to form the Pudgie’s Pizza Franchising Corporation (“PPFC”) for the purpose of offering and selling franchises for additional Pudgie’s pizza parlor locations. PPFC then registered the PUDGIE’S mark with the United States Patent and Trademark Office (“PTO”). *See* PUDGIE’S, Registration No. 1,102,421 (Sept. 12, 1978).

The three brothers had a sister, Bernadette Tarantino, who, in 1973, purchased a franchise from PPFC and opened a Pudgie’s location in Horseheads, New York, located several miles north of Elmira. The location came to be known

1 as “Pudgie’s Horseheads.” To manage Pudgie’s Horseheads, Bernadette
2 Tarantino formed a corporation named Pudgie’s Pizza Corporation —
3 Horseheads (“PPCH”).

4 In 1985, the PTO cancelled PPFC’s federal trademark registration of the
5 PUDGIE’S mark after PPFC failed to file a required declaration. For several
6 years, however, PPFC continued to operate its franchises as before.

7 In 1990, Michael Cleary, Sr. died owning 50% of the stock in PPFC, as well
8 as all of MP Cleary, which in turn owned Pudgie’s Southside and another
9 Pudgie’s location in Pennsylvania. These interests passed on to his sons, David
10 and Robert Cleary, as well as his wife, Rosa Cleary. PPFC began to deteriorate,
11 however, sometime in the early 1990s. On September 29, 1993, PPFC officially
12 dissolved, and another franchisor did not immediately take its place. As a result,
13 the restaurants that were operating as franchisees of PPFC just prior to PPFC’s
14 dissolution became independently run operations.

15 The chain of Pudgie’s pizza restaurants that got their start in Elmira, New
16 York, was not the only chain of restaurants in the nation to use the name
17 “Pudgie’s” in connection with restaurants and food services. In the New York
18 City metropolitan area, there was a chain of restaurants principally serving fried

1 chicken that also went by the name of “Pudgie’s” (or, more specifically,
2 “Pudgie’s Famous Chicken”). In 2002, Arthur Treacher’s, Inc. (“Arthur
3 Treacher’s”), the entity that operated the Pudgie’s Famous Chicken restaurants at
4 the time, obtained a federal trademark registration for the “PUDGIE’S” mark in
5 connection with “[r]estaurant[s] and carry[-]out restaurant services.” PUDGIE’S,
6 Registration No. 2,565,298 (April 30, 2002). Arthur Treacher’s later assigned its
7 interest in the PUDGIE’S mark to PAT Franchise Systems, Inc. (“PAT”). MP
8 Cleary learned of PAT’s mark in 2004, when it looked into obtaining a new
9 federal trademark registration for the PUDGIE’S mark. Shortly thereafter, MP
10 Cleary and PAT reached an agreement regarding the mark, pursuant to which
11 PAT granted MP Cleary a “non-exclusive, perpetual and transferable license to
12 use and display the PUDGIE’S mark . . . in connection with MP Cleary’s existing
13 and future restaurants,” while PAT “retain[ed] the right to use the [PUDGIE’S
14 mark] solely in connection with its ‘Pudgie’s Famous Chicken’ business.” J.A.
15 196. PAT then assigned its interest in the PUDGIE’S mark to TruFoods, LLC
16 (“TruFoods”) in 2008. In 2009, David and Robert Cleary formed MPC Franchise
17 to begin franchising Pudgie’s pizza restaurants.

1 Meanwhile, Bernadette Tarantino died in 2007, leaving a one-third stake in
2 PPCH to each of her three children, one of whom is Defendant-Appellant
3 Tarantino. On July 12, 2010, Tarantino filed an application with the PTO seeking a
4 federal trademark registration for a mark “consist[ing] of the word ‘Pudgie’s’
5 displayed in a custom font,” for use in connection with “[p]izza parlors” and
6 “[r]estaurant services featuring pizza, pasta, and subs.” J.A. 526–27 (emphasis
7 omitted). Tarantino certified in his application that “[t]o the best of his[]
8 knowledge and belief[,] no other person, firm, corporation, or association has the
9 right to use the [PUDGIE’S] mark,” either in “identical form” or “in such near
10 resemblance . . . as to be likely . . . to cause confusion, or to cause mistake, or to
11 deceive.”² J.A. 531. Because applicants for federal trademark registrations
12 generally must include a “specimen” representative of the mark’s actual use in
13 the marketplace, *see* 37 C.F.R. § 2.56, Tarantino also submitted with his application
14 a photograph of a Pudgie’s pizza box that he obtained from Pudgie’s

² Specifically, Tarantino attested that “[t]o the best of his[] knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive.” J.A. 531; *see also* 15 U.S.C. § 1051(a)(3) (listing the general verification requirements for a trademark application based on use in commerce); 37 C.F.R. § 2.33(b)(1) (setting forth the oath enshrining the statutory requirements).

Horseheads, where he worked at the time. Displayed beneath the PUDGIE'S mark on the pizza box were the words "® Pudgie's Pizza Franchising Corporation 1972." J.A. 378; J.A. 602, ¶ 54.

On February 22, 2011, the PTO issued Tarantino a federal trademark registration for the PUDGIE'S mark. *See* PUDGIE'S, Registration No. 3,922,745 (Feb. 22, 2011). By letters dated March 30, 2011, Tarantino informed all owners of Pudgie's pizza establishments, including MPC Franchise, that, among other things: he was the registered owner of the PUDGIE'S mark, as "used in the operation of food establishments"; the mark entitled him to "nationwide priority with respect to use of the 'Pudgie's' logo in the operation of pizza parlors and the provision of restaurant services featuring pizza, pasta, and submarine sandwiches"; and Pudgie's pizza establishments could not use the mark beyond the geographic regions they currently served without first obtaining Tarantino's written permission. J.A. 549. Failure to obtain such permission, Tarantino warned, could prompt him to file a trademark-infringement lawsuit. Following this letter, Tarantino also called at least one Pudgie's pizza establishment reiterating his rights in the PUDGIE'S mark, and touted his sole ownership of the PUDGIE'S mark on Facebook.

1 *B. Procedural History*

2 On June 21, 2011, Plaintiffs filed suit against Tarantino in the United States
3 District Court for the Western District of New York, alleging various violations
4 of the Lanham Act, 15 U.S.C. §§ 1051 *et seq.* Relevant here is Plaintiffs' second
5 cause of action, seeking cancellation of Tarantino's mark pursuant to 15 U.S.C.
6 § 1064(3), principally on the grounds that Tarantino fraudulently obtained the
7 mark. In response, Tarantino, along with PPCH, counterclaimed, alleging, *inter*
8 *alia*, federal trademark infringement, common-law trademark infringement, and
9 federal unfair competition.

10 After Tarantino moved for summary judgment, Plaintiffs cross-moved for
11 partial summary judgment, including with regard to their claim seeking
12 cancellation of Tarantino's mark due to fraudulent procurement. In a ruling dated
13 May 13, 2014, the district court (Siragusa, J.) granted Plaintiffs' motion for partial
14 summary judgment insofar as it relied on fraud as a basis for cancellation of
15 Tarantino's mark, finding that the record clearly demonstrated, *inter alia*, that
16 Tarantino "knew that Plaintiffs were already franchising pizzerias, using the very
17 same mark that he was attempting to register for that same purpose." *MPC*
18 *Franchise, LLC v. Tarantino*, 19 F. Supp. 3d 456, 480–81 (W.D.N.Y. 2014). The

1 district court canceled Tarantino's registration, dismissed Tarantino and PPCH's
2 counterclaim for federal trademark infringement, granted Tarantino and PPCH's
3 motion for summary judgment on Plaintiffs' federal unfair-competition claim,
4 and denied Tarantino and PPCH's motion for summary judgment on several
5 other counterclaims. *See id.* at 484–86. Tarantino and PPCH thereafter voluntarily
6 dismissed their remaining counterclaims. This appeal followed.

7 II. Discussion

8 “We . . . review *de novo* a district court's grant of summary
9 judgment, . . . drawing all factual inferences in favor of the non-moving party.”
10 *Chabad Lubavitch of Litchfield Cty., Inc. v. Litchfield Historic Dist. Comm'n*, 768 F.3d
11 183, 192 (2d Cir. 2014). We affirm when “we are able to conclude . . . that there is
12 no genuine issue of dispute as to any material fact and the movant is entitled to
13 judgment as a matter of law.” *Ne. Research, LLC v. One Shipwrecked Vessel*, 729
14 F.3d 197, 207 (2d Cir. 2013) (alteration in original) (quoting *Costello v. City of*
15 *Burlington*, 632 F.3d 41, 45 (2d Cir. 2011)).

16 * * *

17 On appeal, Tarantino principally contests the district court's grant of
18 summary judgment to Plaintiffs on their claim seeking cancellation of Tarantino's

1 PUDGIE’S mark on the grounds that Tarantino procured the mark by fraud.
2 Under the Lanham Act, “any person who believes that he is or will be damaged”
3 may file a “petition to cancel a registration of a mark,” for which “registration
4 was obtained fraudulently.” 15 U.S.C. § 1064(3); *see also* 15 U.S.C. § 1119. “Fraud
5 in procuring a trademark registration . . . occurs when an applicant knowingly
6 makes false, material representations of fact in connection with his application.”
7 *In re Bose Corp.*, 580 F.3d 1240, 1243 (Fed. Cir. 2009) (quoting *Torres v. Cantine*
8 *Torresella S.r.l.*, 808 F.2d 46, 48 (Fed Cir. 1986)); *see also Orient Express Trading Co.*
9 *v. Federated Dep’t. Stores, Inc.*, 842 F.2d 650, 653 (2d Cir. 1988) (specifying that a
10 plaintiff seeking cancellation of a trademark on the basis of fraudulent
11 procurement must point to a “knowing misstatement . . . with respect to a
12 material fact” (emphasis omitted)). “A party seeking cancellation of a registered
13 trademark on grounds of fraud must demonstrate the alleged fraud by ‘clear and
14 convincing evidence.’” *Orient Express*, 842 F.2d at 653 (quoting *Beer Nuts, Inc. v.*
15 *Clover Club Foods Co.*, 711 F.2d 934, 942 (10th Cir. 1983)).

16 Here, Tarantino applied for the PUDGIE’S mark in his individual capacity
17 and signed an oath attesting, *inter alia*, that: (1) he believed himself to be “the
18 owner of the . . . mark”; and (2) “[t]o the best of his[] knowledge and belief[,] no

1 other person, firm, corporation, or association has the right to use the [Pudgie's]
2 mark," either in "identical form" or "in such near resemblance . . . as to be
3 likely . . . to cause confusion, or to cause mistake, or to deceive." J.A. 531.
4 Tarantino does not dispute the materiality of these representations, but argues
5 that he lacked fraudulent intent with respect to them. Specifically, Tarantino
6 argues that the Federal Circuit's 2009 decision in *Bose* makes clear that the
7 scienter standard for fraud on the PTO is met only when an applicant *actually*
8 *knew* that material statements in the trademark application were false, and that it
9 is not enough that the applicant *should have known* about such falsity. Under that
10 heightened standard, Tarantino urges, Plaintiffs failed to show by clear and
11 convincing evidence that he had sufficient scienter with respect to the above
12 statements. According to Tarantino, the district court, in concluding otherwise,
13 misapplied the scienter standard and effectively held Tarantino liable for
14 misstatements in his trademark application simply because he *should have known*
15 that they were false. We agree with Tarantino about the degree of scienter
16 required for a plaintiff successfully to allege fraudulent trademark procurement,
17 but nevertheless find no genuine issue of material fact that Tarantino fraudulently
18 obtained his mark.³

³ Tarantino also disputes Plaintiffs' contention that his statement in his

1 In *Bose*, the Federal Circuit rejected the federal Trademark Trial and
2 Appeals Board's ("TTAB") scienter standard for claims alleging fraudulent
3 trademark procurement, under which "[a] trademark applicant commits fraud in
4 procuring a registration when it makes material representations of fact in its
5 [trademark application] which it knows or *should know* to be false or misleading."
6 580 F.3d at 1244 (first alteration in original) (quoting *Medinol Ltd. v. Neuro Vaxx,*
7 *Inc.*, 67 U.S.P.Q.2d 1205, 1209 (T.T.A.B. 2003)). As the Federal Circuit clarified, "a
8 trademark is obtained fraudulently under the Lanham Act only if the applicant
9 or registrant *knowingly* makes a false, material representation with the intent to
10 deceive the PTO." *Bose*, 580 F.3d at 1245 (emphasis added). We agree with the
11 Federal Circuit in *Bose* that "[m]ere negligence is not sufficient to infer fraud" on
12 the PTO. *See id.* at 1244 (alteration in original) (quoting *Symbol Techs., Inc. v.*
13 *Opticon, Inc.*, 935 F.2d 1569, 1582 (Fed. Cir. 1991)). That is, to succeed on a claim
14 that a trademark holder procured the mark by fraud, a plaintiff cannot merely

application that the date of the mark's first use was in 1980 was fraudulent. Notwithstanding the fact that in 1980, Tarantino was, by his own admission, seven years old and "not directly using the mark," J.A. 104, Tarantino argues that his statement of first use was not material. We need not address Tarantino's statement of first use here, as we conclude on other grounds that Plaintiffs established by clear and convincing evidence that Tarantino fraudulently obtained his mark.

1 show that the trademark holder “should have known” that the application
2 contained false statements of material fact. *See id.*

3 Tarantino asserts that *Bose* reflects a paradigm shift as to the scienter
4 required to show fraudulent trademark procurement, which raises the question
5 whether this Circuit’s case law is consistent with *Bose*. We conclude that it is. To
6 be sure, we stated in *Patsy’s Italian Rest., Inc. v. Banas*, 658 F.3d 254 (2d Cir. 2011)
7 — in the routine course of reciting the general elements of a claim alleging
8 fraudulent trademark procurement — that one of the requirements of such a
9 claim was that “[t]he person making the representation knew *or should have*
10 *known* that the representation was false (‘scienter’).” *Id.* at 270 (emphasis added)
11 (quoting 6 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR
12 COMPETITION § 31:61 (4th ed.), Westlaw (database updated Dec. 2009)).⁴ But any
13 suggestion in *Patsy’s* that the scienter element is satisfied when a plaintiff shows

⁴ At the time we heard argument in *Patsy’s*, McCarthy’s treatise still reflected the pre-*Bose* TTAB standard, and had not yet been updated to take into account the Federal Circuit’s decision in *Bose*. *See* 6 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:61 (4th ed.), Westlaw (database updated Dec. 2009) (“The person making the representation knew or should have known that the representation was false (‘scienter’)[.]”). McCarthy’s treatise now states that scienter requires that “[t]he person making the representation *knew* that the representation was false.” 6 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:61 (4th ed.), Westlaw (database updated Mar. 2016).

1 merely that an applicant “should have known” the falsity of a representation is
2 dicta. After the district court in *Patsy’s* canceled a mark held by one of the
3 parties, the issue on appeal, as framed by the parties, was whether there was
4 sufficient evidence that the mark holder “*knew* that [a certain statement about the
5 duration and continuity of its use of the mark] was a misrepresentation” at the
6 time the mark holder submitted its allegedly fraudulent application. *Id.* at 271
7 (emphasis added). We concluded that there was ample evidence to support the
8 jury’s conclusion that the mark holder “had to have known” that the statement
9 was false, *id.*, not simply that it “should have known.”

10 *Patsy’s* thus did not alter the law of this Court, stated in prior cases such as
11 *Orient Express*, that for a plaintiff to show that a trademark holder fraudulently
12 obtained her trademark, the “allegedly fraudulent statements [in the application]
13 may not be the product of mere error or inadvertence.” *Orient Express*, 842 F.2d
14 at 653. Rather, they must be “knowing misstatement[s]” of material fact that
15 “indicate a ‘deliberate attempt to mislead the [PTO].’” *Id.* (second alteration in
16 original) (quoting *Money Store v. Harriscorp Fin., Inc.*, 689 F.2d 666, 670 (7th Cir.
17 1982)). This standard is consistent with *Bose*, and with all other Circuits to have
18 considered the question post-*Bose*. See *Hokto Kinoko Co. v. Concord Farms, Inc.*, 738

1 F.3d 1085, 1098 (9th Cir. 2013) (concluding that a counterclaim defendant seeking
2 cancellation of plaintiff's mark did not satisfy the scienter standard because the
3 defendant "put forth no evidence suggesting that the false statement [in the
4 plaintiff's application] was anything other than the result of a simple mistake,"
5 and "adduced no evidence that [the plaintiff] *knew* of the
6 misstatement . . . or intended to defraud the [PTO]" (emphasis added)); *Sovereign*
7 *Military Hospitaller Order of Saint John of Jerusalem of Rhodes & of Malta v. Fla. Priory*
8 *of the Knights Hospitallers of the Sovereign Order of Saint John of Jerusalem, Knights of*
9 *Malta, the Ecumenical Order*, 702 F.3d 1279, 1289 (11th Cir. 2012) (stating that "[a]n
10 applicant commits fraud when he '*knowingly* makes false, material
11 representations of fact in connection with an application for a registered mark'"
12 and requiring a "purpose or intent to deceive the PTO in the application for the
13 mark" (emphasis added) (quoting *Angel Flight of Ga., Inc. v. Angel Flight Am., Inc.*,
14 522 F.3d 1200, 1209 (11th Cir. 2008)); *Fair Isaac Corp. v. Experian Info. Solutions*, 650
15 F.3d 1139, 1148 (8th Cir. 2011) ("Fraud in procuring a trademark registration or
16 renewal occurs when an applicant *knowingly* makes false, material
17 representations of fact in connection with his application." (emphasis added)
18 (quoting *Bose*, 580 F.3d at 1243)).⁵

⁵ Because we conclude that there is no genuine issue of material fact as to

1 Nevertheless, while we agree with Tarantino that it is insufficient for a
2 claim of fraudulent procurement of a mark that the applicant “should have
3 known” about the falsity of a representation in the application, Tarantino’s
4 arguments about the requisite degree of scienter do not aid him. As an initial
5 matter, it is plain that the district court did not rely on an incorrect scienter
6 standard in determining that Tarantino fraudulently obtained his mark. To be
7 sure, the district court quoted *Patsy’s* for the general elements of a claim for mark
8 cancellation based on fraudulent procurement, and thus included the language
9 from *Patsy’s* that the applicant “should have known” the falsity of alleged
10 misrepresentations. *MPC Franchise*, 19 F. Supp. 3d at 478 (quoting *Patsy’s*, 658
11 F.3d at 270). But the district court unequivocally found that no material issue of
12 fact existed as to Tarantino’s *actual knowledge* of falsity with respect to the

whether Tarantino possessed actual knowledge with respect to false representations of material fact in his application, we need not address whether a somewhat less stringent standard than actual knowledge — such as “reckless disregard,” see *Bose*, 580 F.3d at 1246 n.2, or the “willful blindness” standard that applies to claims of induced patent infringement, see *Glob.-Tech Appliances, Inc. v. SEB S.A.*, 563 U.S. 754, 766–68 (2011) — may satisfy the scienter requirement for fraudulent procurement of a mark, cf. *Bose*, 580 F.3d at 1246 n.2 (“The PTO argues that . . . making a submission to the PTO with reckless disregard of its truth or falsity satisfies the intent to deceive requirement. We need not resolve this issue here . . . [because] even if we were to assume that reckless disregard qualifies, there is no basis for finding [the applicant’s] conduct reckless.”).

1 misrepresentations alleged by Plaintiffs. *See, e.g., id.* at 480–81 (“Tarantino . . .
2 *knew* that Plaintiffs were already franchising pizzerias, using the very same mark
3 that he was attempting to register for that same purpose.” (emphasis added)); *see*
4 *also id.* at 480 (“Tarantino was *well aware* that he was merely a one-third owner of
5 the [corporation that in turn owned Pudgie’s Horseheads]. Tarantino’s
6 misstatement of ownership was not a mistake. . . . Tarantino was not attempting to
7 register the mark on behalf of the corporation in which he was a part owner; he
8 registered it for himself.” (emphasis added)).

9 Indeed, it is beyond question that Tarantino possessed the requisite degree
10 of scienter, even under the more stringent standard for which Tarantino
11 advocates. Even though Tarantino applied individually and personally for the
12 mark, Tarantino admits — as he must — “that [he] did not individually or
13 personally use the [PUDGIE’S m]ark” at any point in time. Appellant’s Br. 42.

14 Further, there is abundant evidence that Tarantino knew that others had
15 rights to use the mark that were at least equal, if not clearly superior, to his own.
16 Most importantly, Tarantino was well aware of multiple other Pudgie’s locations
17 that were using the mark in the precise same capacity in which he applied for the
18 mark, including the very first Pudgie’s locations, Pudgie’s Northside and

1 Pudgie's Southside, located mere miles away from Pudgie's Horseheads.
2 Unsurprisingly, Tarantino was familiar with the beginnings of the original
3 Pudgie's locations, which his uncles (one of whom Tarantino described as "the
4 godfather . . . of the family") started, and which grew into a family business
5 involving many of Tarantino's close relatives. J.A. 384. In a deposition, Tarantino
6 admitted that he knew that when his mother opened Pudgie's Horseheads, she
7 operated the restaurant as a franchisee. He even had a copy of a franchise
8 agreement between his mother and PPFC defining, *inter alia*, the scope of his
9 mother's rights to use the PUDGIE'S mark.

10 The district court correctly concluded that no material issue of fact existed
11 as to whether Tarantino knowingly made false, material representations in his
12 application. Indeed, the specimen that he included with his application
13 exhibited that the PUDGIE'S mark originally came from PPFC, as it was an
14 image of a pizza box displaying the words "® Pudgie's Pizza Franchising
15 Corporation 1972" beneath the PUDGIE'S mark. J.A. 378. And when asked in a
16 deposition whether these words "signif[ied] to [Tarantino] that someone other
17 than [him] owned [the PUDGIE'S mark]," Tarantino conceded that the words

1 indicated to him that someone else “ha[d] the rights to” the mark “[a]long with
2 [him].” *See id.*

3 Given these facts, it cannot be gainsaid that Tarantino knew fully well that
4 other Pudgie’s locations used the PUDGIE’S mark even before Pudgie’s
5 Horseheads existed, in the same general area as Pudgie’s Horseheads and for use
6 in connection with pizza restaurants. Thus, even setting aside the fact that
7 Tarantino applied for the PUDGIE’S mark in his individual capacity despite only
8 having acquired in 2007 a one-third share in the corporation that owned Pudgie’s
9 Horseheads, Tarantino could not have believed earnestly that “no other person,
10 firm, corporation, or association ha[d] the right to use the [PUDGIE’S] mark,”
11 either in “identical form” or “in such near resemblance . . . as to be likely . . . to
12 cause confusion, or to cause mistake, or to deceive.” J.A. 531. No genuine issue
13 of material fact exists as to whether Tarantino knew that other entities had rights
14 to use the mark in the very manner in which he sought to use the mark, and
15 whether he intended to mislead the PTO by attesting otherwise in his trademark
16 application.⁶ Accordingly, we **AFFIRM** the district court’s grant of summary
17 judgment to Plaintiffs on their claim seeking cancellation of Tarantino’s mark.

⁶ Given that Tarantino unquestionably knew of other Pudgie’s pizza restaurants that were using the PUDGIE’S mark in the same capacity as Pudgie’s

Horseheads, we need not consider whether Tarantino's knowledge of TruFoods's mark, which Tarantino alleges could be used only in connection with restaurants serving chicken, might also satisfy the scienter element of Plaintiffs' claim.