

Oral Hearing:
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THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 8/7/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Miss Asia Beauty Pageant Association (U.S.A.), Inc.
v.
A.L. Models, Inc.

Cancellation No. 25,433

Albert Robin and Howard B. Barnaby of Robin Blecker & Daley
for Miss Asia Beauty Pageant Association (U.S.A.), Inc.

George R. Baldwin, Esq. for A.L. Models, Inc.

Before Hohein, Chapman and Rogers, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Miss Asia Beauty Pageant Association (U.S.A.), Inc.
has petitioned to cancel the registration owned by A.L.
Models, Inc. for the mark "MISS ASIAN WORLD BEAUTY PAGEANT"
for the services of "business management consulting in the

field of beauty pageants".¹ As a ground for cancellation, petitioner alleges that, since long prior to respondent's alleged date of first use of January 4, 1992, petitioner, "either [by] itself or through those acting pursuant to its authorization, has been and now is engaged in the business of promoting and presenting beauty pageants"; that since long prior to such date, petitioner's beauty pageants have been identified by its service mark "MISS ASIAN WORLD BEAUTY PAGEANT"; that, in 1991, respondent "was selected by Petitioner to sponsor the 1991 MISS ASIAN WORLD BEAUTY PAGEANT" and, "pursuant to an agreement with Petitioner," respondent "sponsored such a pageant on January 4, 1992"; that, in 1995, respondent "was again selected by Petitioner to sponsor the 1995 MISS ASIAN WORLD BEAUTY PAGEANT" and, "pursuant to [a] written agreement with Petitioner," respondent "sponsored such a pageant on June 17, 1995; that since June 17, 1995, petitioner "has not authorized" respondent "to promote, sponsor, present or conduct any pageant under the MISS ASIAN WORLD BEAUTY PAGEANT name or mark"; and that respondent's "MISS ASIAN WORLD BEAUTY PAGEANT" mark, when used in connection with business management

¹ Reg. No. 1,995,350, issued on August 20, 1996 from an application filed on August 1, 1995, which sets forth dates of first use of January 4, 1992. The words "ASIAN WORLD BEAUTY PAGEANT" are disclaimed.

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consulting services in the field of beauty pageants," so resembles petitioner's previously used "MISS ASIAN WORLD BEAUTY PAGEANT" mark for its services of promoting and presenting beauty pageants as to be likely to cause confusion, mistake and deception.

As an additional ground for cancellation, petitioner alleges that, at the time respondent filed the application which matured into the registration sought to be canceled, respondent "knew of Petitioner's prior and superior rights in the service mark MISS ASIAN WORLD BEAUTY PAGEANT"; that notwithstanding such knowledge, respondent "falsely or fraudulently represented in its application that it believed itself to be the owner of the service mark and that no one else had a right to use the service mark in commerce"; and that, if respondent had "not made the false or fraudulent representations referred to ..., the Patent and Trademark Office would not have issued ... the registration herein sought to be canceled."

Respondent, in its answer, has denied the salient allegations of the petition to cancel.

The record consists of the pleadings; the file of the involved registration; and, as petitioner's case-in-chief, the testimony, with exhibits, of petitioner's president, Ben John Chen. Respondent, as its case-in-chief, submitted the

testimony, with exhibits, of its vice president, Guangliu Ling.² As rebuttal thereto, petitioner furnished the testimony, with exhibits, of Mr. Chen³ and that of his wife and secretary, Pikna Leung Chen. Only petitioner filed a brief, although both parties were represented at the oral hearing held before the Board.⁴

The issues to be determined are whether petitioner has priority and, if so, whether contemporaneous use of the parties' marks is likely to cause confusion; and whether respondent fraudulently obtained its registration.

According to the record, petitioner is in the business of "[s]electing Asian beauties"; that is, it conducts beauty pageants in which the contestants are of Asian descent

² Although Anna Ling, whom the record reflects is the president of respondent, not only attended such deposition but was duly sworn and testified therein, her testimony has not been considered inasmuch as there is no indication that respondent gave petitioner notice that she would appear as a witness on behalf of respondent. However, even if her testimony were to be considered, it would make no difference in the outcome of this proceeding.

³ While, at Mr. Chen's rebuttal deposition, an interpreter, although duly sworn, also presented testimony concerning certain exhibits, such testimony has not been considered in the absence of any indication that petitioner provided respondent with notice that the interpreter, Frank P. Wen, would be called as a witness on behalf of petitioner. Nevertheless, even if the interpreter's testimony were regarded as properly forming part of the record, it would make no difference in the result herein.

⁴ Respondent's appearance, at the oral hearing, was by Mr. Ling rather than by counsel. Mr. Ling indicated, however, that respondent is still represented by its counsel of record, who had no objection to Mr. Ling making an appearance on respondent's behalf.

or heritage. (Ben John Chen dep. at 6.) Petitioner's pageants are not intended to be profit-making ventures; rather, their purpose is to promote Asian (principally Chinese) culture, encourage Asian youth, foster unity among Asian people and promote communication between eastern and western cultures. Petitioner presented its first pageant, called the "MISS ASIA BEAUTY PAGEANT (USA)," at the Tropicana Hotel & Casino in Atlantic City, New Jersey on or about October 12 and 13, 1984. Petitioner's president, Mr. Ben John Chen, is listed in the souvenir program for the pageant as the chairman of the Miss Asia 1984 Pageant Organizing Committee and described his involvement with such pageant as that of being "the initiator, establisher, as well as the chairman." (Id. at 8.)

A year later, petitioner presented its second beauty pageant, advertised in a flyer as the "MISS ASIA PAGEANT '86" and referred to in a printed program for the event as the "MISS ASIA BEAUTY PAGEANT," at Felt Forum, Madison Square Garden, in New York, New York on October 5, 1985. As was the case with its first Miss Asia Pageant, the program, entitled "THE SECOND MISS ASIA BEAUTY PAGEANT JOURNAL," lists Ben John Chen as the chairman of the event. (Petitioner's Ex. 5; Respondent's Ex. 5.)

Petitioner next held its third pageant, under the mark "MISS ASIAN WORLD BEAUTY PAGEANT" (a change from its "MISS ASIA BEAUTY PAGEANT" mark), in Taipei, Taiwan, sometime during 1988. According to Mr. Chen, he "authorized a company in Taiwan to run this pageant" on behalf of petitioner. (Id. at 11.) The pageant was televised in Taiwan but not in the United States, although a videotape of such broadcast was shown by Mr. Chen, after his return from Taiwan, at the Chinese Culture Center in Flushing, New York. The printed program for the pageant, which is principally written in Chinese, features a prominent picture of Mr. Chen and bears the following logo on the front cover thereof:

There is no indication in the record, however, of any involvement by respondent with such pageant nor is there any evidence thereof with respect to either of the two earlier pageants presented by petitioner in the 1980s.

The next "MISS ASIAN WORLD BEAUTY PAGEANT" took place at the Trump Plaza Hotel and Casino in Atlantic City,

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New Jersey on January 4, 1992. Preliminarily thereto, petitioner and respondent executed an authorization letter on May 7, 1991 which, as the purpose thereof, provides that "Miss Asia Beauty Pageant Associating [sic] (U.S.A.) Inc. (hereinafter known as MABPA) ... is to authorize A.L. Model[s, Inc.] (hereinafter known as ALM) ... to sponsor the 4th Worldwide Asia Beauty Pageant during 1991 in Atlantic City, NJ, U.S.A." (Petitioner's Ex. 9; Respondent's Ex. 6.) The letter, which states that it is "[s]igned by the authorizing party" above the signature for petitioner of Mr. Chen and "[s]igned by the authorized party" above the signature of "Anna Ling, President of" respondent, further provides among other things that "ALM agrees to follow the Chapters & By-laws of MABPA and accept guidance from persons designated by MABPA"; that "MABPA will use its best effort to assist ALM in the Beauty Pageant Competition so that the incident will have a successful result"; and that "ALM also agrees ... to protect the reputation of MABPA and indemnify and save harmless MABPA ... against and from any and all claims, ... costs, liability or responsibility of whatever nature arising from hosting the 1991 Beauty Pageant Contest." (Id.)

Such letter, however, was superseded by a contract signed by the parties on September 10, 1991. The contract, which is principally written in Chinese, is on the letterhead

of the "Miss Asian World Beauty Pageant" and displays the "MISS ASIAN WORLD BEAUTY PAGEANT" logo of petitioner as well as the address, telephone number and fax number for respondent. As set forth in the English translation thereof, the contract provides in relevant part that (highlighting in original):

Miss Asian World Beauty Pageant

(hereinafter called Party A) and **A L Models** (hereinafter called Party B) have entered the following contract and made it effective from the date signed by both parties.

- I. Party A has authorized Party B to organize and conduct **the 4th Miss Asian World Beauty Pageant 1992** at GENTLEMAN HOTEL in Atlantic City, USA --- within the year of 1992. And all necessary preparations shall be performed by Party B.
- II. Party A shall supply Party B with the data and related materials for selection --- for Miss Asian World Beauty Pageant
- III. Both parties agree to invite some famous persons --- who enjoy high prestige both at home and abroad and who are warm-hearted to be sponsors -- - to be members of the Selection Committee

....

And ... in accordance with the regulations set forth by US government, the same amount of all monetary donations shall be deducted from the personal tax report of the individual's annual income --- with

the approved tax number of **Miss ASIA
Beauty Pageant Associating** [sic] **(USA)
Inc.**

For all the above donations, if the amount is obtained by Party A from overseas, ... Party A shall inform Party B the exact amount, of which Party a [sic] shall have 50% for commission ..., the remaining 50% shall be handed over to Party B (within one week after receiving the money) for its expenses on beauty selection planning and administrative activities.

....

Party A shall help Party B with selling the ticket for the contest, and 15% shall be withdrawn from the total amount of tickets sale for commission, the remaining part shall be used for Party B's expenses on the beauty selection activities.

- IV. Party B shall observe the stipulations in the Authorization Certificate and shall be responsible for all preparatory, administrative work, and shall also assume sole responsibility for its own financial matters, either profits or losses.
- V. Party B shall inform Party A in advance, for caution's sake, on all matters concerning **Miss Asian World Beauty Pageant** programs, members of the Committee, names of the candidates and of the distinguished guests to be invited, etc.
- VI. Party B shall take special care of all the candidates for **Miss Asian World Beauty Pageant**, either in the reception of them or during the period of the event, with the purpose to

avoid all possible accidents, and to protect the reputation and the image of **Miss Asian World Beauty Pageant**.

- VII. Party A shall inform Party B: the exact amount of donations from sponsors ..., the income from advertising, etc. and the funds shall be used by Party B for its expenditure.
- VIII. Party A shall be the founder and Honorary Chairman of **Miss Asian World Beauty Pageant**.
- IX. During the whole period of the beauty contest, Party B shall be in charge of the accommodations and reception of the candidates, also of the commemorative picture-taking with the candidates.
- X. Within fifteen (15) days after the event, Party B shall send Party A : 10 copies of the Special issue of the Contest together with 2 copies of the video tapes, for Party A to keep for commemorative purposes. Party B shall also give Party A the summary report of the event and the final accounting of revenue and expenditure for the whole event, which shall be submitted for examination by the government. Party B shall be cooperative with the accountants.
- XI. The previous Contact [sic] is void.
....

(Petitioner's Ex. 23.)

In seeking contributions prior to the presentation of the 1992 pageant, respondent's president, Anna Ling, distributed a letter, written in English, on the stationery of

"Miss Asian World Beauty Pageant" which is dated "1992" and which states, inter alia, that (highlighting in original):

We are now preparing our "**Miss Asian World Beauty Pageant 1992**," at the Trump Plaza Hotel and Casino. The date is January 4, 1992.

Our pageant is the largest Asian beauty contest in the world. The first contest was held on October 5 [sic], 1984 at the Tropicana Casino and Hotel in Atlantic City. The second contest on October 5, 1985 was at Madison Square Garden, New York City. The third contest was held from October to November 1988, Tai Pei, China. This event will be the fourth contest.

Anna Ling, of A.L. Models New York City is organizing this pageant as it's [sic] President. Most recently, Miss Ling conducted two similar, successful pageants at the Sands Hotel and Casino in Atlantic City.

The candidates will come from different parts of U.S.A., Europe and many countries in Asia to vie for the coveted title of Miss Asian World 1992.

(Petitioner's Ex. 17.) The letter prominently displays, in the upper left hand corner thereof, the "MISS ASIAN WORLD BEAUTY PAGEANT" logo utilized by petitioner in connection with the pageant it held in 1988 in Taiwan, but also lists, in the upper right hand corner thereof, respondent's address and its telephone and fax numbers. However, as noted earlier, respondent had no role or association with any of the prior pageants presented by petitioner.

Another letter utilized for soliciting financial sponsorship for the 1992 pageant, but which is written in Chinese, uses the identical "Miss Asian World Beauty Pageant" stationery for its letterhead, including the same "MISS ASIAN WORLD BEAUTY PAGEANT" logo utilized by petitioner in connection with its 1988 pageant as well as the address and telephone and fax numbers for respondent. The letter, which the English translation thereof indicates is under the name of Ben John Chen, refers to Mr. Chen as both "Founder, Miss Asian World Beauty Pageant" and member of "The Preparatory Committee". (Petitioner's Ex. 8.) The letter states in part that (highlighting in original):

It has been decided that **Miss Asian World Beauty Pageant 1992** will have its grand opening at Trumpet [sic] Palace Hotel ... in the evening of January 4th, 1992.

As always known to the public that you have been enjoying high respect and prestige, both at home and abroad, for your wise leadership, ... you are now requested to accept the honor of (title) and it is the sincere hope that you could be generous enough to give your financial sponsorship to the funds of the Beauty Pageant, and to make joint efforts for its success.

....

The total amount of your contributions ... will be deducted from your annual personal income tax. Your photo will also be carried in the Special issue of Miss

Asian World Beauty Pageant --- to honor
your good deeds.

(Id.)

The event's printed program, entitled "Miss Asian World Beauty Pageant 1992," also states on the cover thereof that the pageant is "Presented by JIANLIBAO," the principal sponsor thereof, "In Association with A.L. Models Inc." (Petitioner's Ex. 10; Respondent's Ex. 2.) A photograph of "Ben John Chen Ph.D.," who is identified among other things as the "Funder [sic] of Miss Asia Beauty Pageant Association," is prominently featured inside the program, but Mr. Chen is not listed among the names comprising the "Miss Asian World Beauty Pageant 1992 Committee," nor is he mentioned elsewhere in the program. (Id.) Instead, such program features a full-page picture of respondent's president and lists her as both "President of Miss Asian World Beauty Pageant 1992" and "Director". (Id.)

Petitioner, based upon a statement of income and loss furnished by respondent as its final accounting of revenues and expenditures for the 1992 "MISS ASIAN WORLD BEAUTY PAGEANT," filed a tax return with respect to such event as a tax-exempt organization.⁵ The statement of income and

⁵ Curiously, as shown by Petitioner's Ex. 12, the copy of the return, which is not signed by any officer of petitioner, is for the year 1991 even though the pageant took place in early 1992 and the

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loss, Mr. Chen testified, represents "the income and expenses of the beauty pageant run by Miss Ling and she present this in accordance with the contract." (Ben John Chen dep. at 17.)

The next "MISS ASIAN WORLD BEAUTY PAGEANT," which also is referred to as the "5th Miss Asian World Beauty Pageant 1995" as well as the "Miss Asian World Beauty Pageant 1995," occurred at the Sands Hotel & Casino in Atlantic City, New Jersey on June 17, 1995. Once again, petitioner and respondent entered into a contract, on May 10, 1995, formalizing their relationship with respect to "the 5th Miss Asian World Beauty Pageant 1995". (Petitioner's Ex. 13; Respondent's Ex. 8.) The contract, written primarily in Chinese on stationery bearing the letterhead "Miss ASIA Beauty Pageant Associating [sic] (USA) inc.," is in relevant part basically identical, as indicated by the English translation thereof, to the contract executed by the parties in connection with the 1992 "Miss Asian World" beauty pageant. In particular, it provides that petitioner authorizes respondent to organize and conduct "the 5th Miss Asian World Beauty Pageant 1995"; that petitioner is to supply respondent with information and assistance with respect to the members of the selection committee for such pageant; that, in terms of

signature of the accountant signing as the preparer thereof is dated May 7, 1993.

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quality control, respondent is to inform petitioner in advance as to "all matters concerning **Miss Asian World Beauty Pageant** programs, members of the Committee, names of the candidates and of the distinguished guests to be invited, etc." and is to "take special care of all the candidates ... to protect the reputation and the image of **Miss Asian World Beauty Pageant**," that petitioner shall assist respondent "in selling the tickets, which should be at preferential prices in favor of" petitioner; that petitioner "shall be the founder of **Miss Asian World Beauty Pageant**, while respondent "shall be in charge of the accommodations and reception of the candidates" along with "the commemorative picture-taking with the candidates"; and that respondent is obligated, within 15 days of the event, to furnish petitioner with, inter alia, "the summary report of the event and the final accounting of revenue and expenditure for the whole event". (Id.)

Mr. Chen testified with respect to such contract as follows:

Q. This contract was signed by whom?

A. I and Anna Ling.

Q. What was the purpose of the contract?

A. Authorizes her to run the World Beauty Pageant for 1995.

Q. Was that the Miss Asian World Beauty Pageant?

A. Correct.

(Ben John Chen dep. at 19.) After identifying an exhibit as the printed program for the 1995 "Miss Asian World Beauty Pageant," Mr. Chen further testified as follows:

Q. Was that run by Miss Ling pursuant to the contract which is Exhibit 13?

A. Yes, yes.

(Id. at 20.)

The printed program for such event is entitled "Miss Asian World Beauty Pageant 1995" and, besides listing on the cover thereof "Knorr" and "Kamable" as, respectively, the "General Sponsor" and "Special Sponsor" of the pageant, states that the event is "[p]roduced by A. L. Model's [sic] Inc."

(Petitioner's Ex. 14; Respondent's Ex. 9.) As in the program for 1992, the inside of the 1995 program features a photograph of "Ben John Chen Ph.D.," who is identified among other things as the "Funder [sic] of Miss Asia Beauty Pageant Association".

(Id.) However, unlike the 1992 version, the 1995 program also lists Mr. Chen among the names comprising the "Miss Asian World Beauty Pageant 1995 Committee" and identifies him as "Funder [sic] of the Pageant". (Id.) Such program also features, as in 1992, a full-page picture of respondent's

president and lists her as both "President of Miss Asian World Beauty Pageant" and "Event Director". (Id.)

Petitioner, however, did not receive from respondent the contractually required final accounting of revenues and expenditures for the 1995 "MISS ASIAN WORLD BEAUTY PAGEANT". In view thereof, petitioner, by an authorization letter made on July 1, 1995, "authorize[d] Premier Entertainment (NY) Inc. (hereinafter known as PEI) ... to sponsor the Asia Beauty Pageant during 1996 in U.S.A." (Petitioner's Ex. 15.) The letter provides among other things that "PEI acknowledges and agrees to introduce Mr. Ben John Chen as the Founder and First Honorable Chairman at the Miss Asia Beauty Pageant." (Id.) Such a pageant, however, was never held and no pageants have been presented under the designation "MISS ASIAN WORLD BEAUTY PAGEANT" since the event held in 1995. In particular, according to the following testimony by Mr. Chen:

Q. Mr. Chen, have there been any Miss Asian World Beauty Pageants since 1995?

A. No.

Q. Have you authorized A.L. Models or Miss Ling to run any additional Miss Asian World Beauty Pageants since 1995?

A. In 1995 Anna Ling ... did not submit the figures to me in accordance with the contract.

Q. So have you authorized her to run anymore [sic] pageants?

A. No.

(Id. at 21-22.)

Respondent, on the other hand, claims to have "been using Miss Asian World Beauty Pageant since 1991" and to have held "our own beauty pageant named Miss Asian World Beauty Pageant in 1992." (Ling dep. at 5.) Respondent insists that it "create[d] the name Miss Asian World Beauty Pageant by ourself" and that, contrary to what is shown by Petitioner's Ex. 14 and respondent's own Ex. 9 (such exhibits being copies of the program for the 1995 "MISS ASIAN WORLD BEAUTY PAGEANT), "[t]here's no one, no one person, from the committee from Miss Asia Beauty Pageant [Association] (USA) join our beauty pageant." (Id. at 5-6.) While respondent's witness, Mr. Ling, indicated that respondent "had already prepared our beauty pageant" by the first time he encountered a representative from petitioner "[i]n early 1991 regarding the beauty pageant business and that he brought in Mr. Chen as a sponsor "around March 1991" after having created "my beauty pageant's title," respondent notably offered no documentary evidence to support his assertions. (Id. at 7.)

Respondent further claims that Mr. Chen failed to live up to a promise to contribute \$10,000.00 as a sponsor of the 1992 pageant run by respondent. According to Mr. Ling, Mr. Chen "did not do anything"; specifically, "[h]e did not

provide \$10,000 to be an honorary president, not one of his committee members provided a penny to our beauty pageant or provide some assistance or help our beauty pageant, and they refuse to sell tickets." (Id. at 9.) In addition, respondent maintains that pursuant to a verbal agreement reached around November 1991, Mr. Chen agreed to find sponsors for respondent's pageant and, for each sponsor he found, he would be paid by respondent a commission of 50% of the donated amount in addition to putting "his picture on our programs as the honorary mention without any position." (Id. at 10.) As to such verbal agreement, Mr. Ling conceded that, with respect to the "MISS ASIAN WORLD BEAUTY PAGEANT" held in 1992, Mr. Chen "found a few sponsor[s] for my beauty pageant" and that respondent paid him his 50% commission. (Id. at 13.) Respondent insists, however, that it owned such pageant and that, despite the May 7, 1991 authorization letter, it did not at any point in time receive any authorization from either petitioner or Mr. Chen to use the name "MISS ASIAN WORLD BEAUTY PAGEANT". Instead, and completely at odds with what the English translation of such letter shows on its face, Mr. Ling stated on cross-examination that the letter "is the invitation of offer to Mr. Ben John Chen" to sponsor respondent's 1992 "MISS ASIAN WORLD BEAUTY PAGEANT". (Id. at 22.)

Respondent admits that it had no connection with either of the pageants presented by petitioner in 1984 and 1985. As to petitioner's 1988 "MISS ASIAN WORLD BEAUTY PAGEANT" held in Taiwan, Mr. Ling indicated on cross-examination that respondent had no knowledge thereof, prior to selecting such name in 1991 for the pageants it produced in the United States in 1992 and 1995. On direct examination, however, Mr. Ling conceded that, for the 1992 pageant, respondent furnished petitioner, as well as other sponsors, with a statement of income and loss, and that "Mr. Ben John Chen use this paper, the information, as his tax return form". (Id. at 25.) Mr. Ling added, however, that respondent paid all the bills for the pageant's expenses, rather than petitioner, and that consequently Mr. Chen "couldn't use this statement to be his company's tax return form, and only he should report his income because he get 50 percent [commission]." (Id.) Yet, when asked on cross-examination whether respondent is a tax exempt organization, Mr. Ling answered only that "you have to ask the accountant" who "handle[s] our business." (Id. at 35.)

With respect to the contract (which is Petitioner's Ex. 13 and Respondent's Ex. 8) executed on May 10, 1995, Mr. Ling testified that respondent did not sign such agreement and that petitioner, rather than authorizing respondent to conduct

the 1995 pageant, had no role other than finding a single sponsor. Specifically, according to Mr. Ling:

Q I show you this document, and I ask you to explain to us what it is and what it represents, as far as you know (handing).

A This one no one in our office to sign this agreement.

Q What is the nature of the agreement?

A It's 100 percent handwriting by Ben John Chen. He make it. And take a look at the date the document shows is on the 1995 May 10. Our 1995 Miss Asian World Beauty Pageant was held on June 1995. On this time we have already prepare everything.

....

Q Was there any discussion about the substance and the subject matter of that agreement between you and/or your organization and Ben John Chen?

A (Through the interpreter) We have discussed something, some content inside, but we did not sign this agreement. Okay? This time Ben John Chen still want to do the same way as the 1992 beauty pageant. He want to find a sponsor to make some commission, and he still wants us to put his name on the beauty pageant program, and then we tell him, Okay, this time there will be no 50 percent commission. And you have to help sell ticket. He said, Okay, I agree to help you sell ticket, and he agree he's not going to take 50 percent commission. Okay? We did not sign this. We just have telephone conversation. He agree, but in fact he did not sell even one ticket. He found

one sponsor, and he got very small amount commission.

Q So he participated on a very limited amount for that year, 1995?

A Yes.

(Id. at 27-29.)

However, when again shown the 1995 contract on cross-examination and referred to the signature portion of the Chinese version, Mr. Ling refused, after being directed by counsel not to answer, to say whose signatures were on such document even though respondent had offered the document, testifying as follows:

Q Let me show you Registrant's Exhibit 8. On the last page on the bottom, are there any (handing) --

MR. BALDWIN: May I see that?

THE WITNESS: (Handing)

MR. BALDWIN: I object to it.
Not in English.

Q Are there any signatures?

MR. BALDWIN: I object and --

A Objection. My lawyer objects.

MR. BALDWIN: And I direct him not to answer.

(Id. at 38-39.)

In rebuttal, however, Mr. Chen testified that the contract between the parties for the 1995 "MISS ASIAN WORLD

BEAUTY PAGEANT" was indeed signed by both himself and Anna Ling, and pointed out where each of their signatures appears on the Chinese version of such document. Mr. Chen, in particular, testified that he signed the contract, had it sent to Ms. Ling for her signature, and received it back from her with her signature. Mr. Chen's wife, and the secretary of petitioner, Pikna Leung Chen, corroborated Mr. Chen's testimony, stating that the original of the contract for the 1995 pageant is in petitioner's files; that she sent the contract to Anna Ling; and that Ms. Ling "faxed to us after she signed it." (Pikna Leung Chen dep. at 8.) Mrs. Chen, who noted that she has been involved since 1990 in the "MISS ASIAN WORLD BEAUTY PAGEANTS" run by her husband, also vouched for the authenticity of the contract between the parties, signed on September 10, 1991, for conducting the 1992 "MISS ASIAN WORLD BEAUTY PAGEANT".

Turning first to the ground of priority of use and likelihood of confusion, we find that the services set forth in respondent's involved registration, namely, "business management consulting in the field of beauty pageants," consist of the organizing, conducting and presenting of beauty pageants and that such services are identical to those rendered by petitioner, who has likewise held beauty pageants. The issue of priority of use in this case, in light of the

symbiotic relationship between the parties, consequently turns on which party is in fact the owner of the "MISS ASIAN WORLD BEAUTY PAGEANT" mark for the services of holding or conducting beauty pageants.

We find from the credible evidence of record that it is petitioner, rather than respondent, who is and at all relevant times has been the owner of the "MISS ASIAN WORLD BEAUTY PAGEANT" mark as used in connection with the services of holding or presenting beauty pageants. Petitioner itself conducted beauty pageants in the United States in 1984 and 1985 under the similar marks "MISS ASIA BEAUTY PAGEANT (USA)" and "MISS ASIA BEAUTY PAGEANT," respectively, and was the first to use the mark "MISS ASIAN WORLD BEAUTY PAGEANT" in connection with such services. Although petitioner's initial use of the "MISS ASIAN WORLD BEAUTY PAGEANT" mark occurred abroad rather than in the United States, petitioner continued its practice, which started with the 1988 pageant it held in Taiwan, of engaging another firm to do the actual organizing and running of its pageants under the "MISS ASIAN WORLD BEAUTY PAGEANT" mark.

Here, the record is clear that petitioner authorized respondent to conduct, for petitioner, the beauty pageants presented in 1992 and 1995 under the "MISS ASIAN WORLD BEAUTY PAGEANT" mark. Respondent's characterization of the initial

authorization letter from petitioner, dated May 7, 1991, as respondent's invitation to Mr. Chen to be a sponsor of the pageant present by respondent on January 4, 1992 is simply not credible. Nor is the assertion credible, in light of the terms of both the September 10, 1991 contract superseding petitioner's May 7, 1991 letter and the provisions of the May 10, 1995 contract, that respondent never received any authorization from petitioner or Mr. Chen to use the "MISS ASIAN WORLD BEAUTY PAGEANT" mark. The May 10, 1995 contract is essentially identical in substance to the parties' September 10, 1991 agreement and, while it is disputed as to whether respondent executed such contract, we find from both the preponderance of the evidence as well as Mr. Ling's failure to answer a proper question on cross-examination⁶ that

⁶ As noted by the Board in *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1466-67 (TTAB 1993), recon. denied, 32 USPQ2d 1328 (TTAB 1994):

[T]here is no mechanism for obtaining from the Board, prior to final hearing, a ruling on the propriety of an objection to a question propounded during a testimony deposition. This is because, unlike the practice in Federal district courts, where testimony is given before a judge who can immediately rule on objections, in Board proceedings testimony is submitted in the form of a deposition transcript, and the Board panel does not review the testimony until final hearing. It is therefore the general, and as far as the Board is concerned, favored practice that questions are answered subject to any objection which has been made. Although a party's witness may refuse to answer a question or, as in the present case, be instructed by the party's attorney not to answer, a refusal to answer may, if the objection is not well

respondent, by its president, Anna Ling, did indeed sign the contract by which petitioner again authorized it to produce a beauty pageant under the "MISS ASIAN WORLD BEAUTY PAGEANT" mark.⁷ Moreover, not only did petitioner file a tax return with respect to the income and expenses of the 1992 pageant, but only petitioner, following respondent's failure to provide petitioner with an accounting for the 1995 pageant, thereafter endeavored to conduct a beauty pageant by authorizing another party in 1996 to do so (even though such a pageant was not held). The sole beauty pageants organized and presented by respondent under the "MISS ASIAN WORLD BEAUTY PAGEANT" mark, however, were held in 1992 and 1995 in association with petitioner and were under the quality control of petitioner as

taken, be construed against the non-answering party. *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409 (TTAB 1990). In this case, rather than simply stating his objection and permitting an answer, opposer's attorney instructed its witnesses not to answer most of applicant's questions on cross-examination. Because we find opposer's objections to be not well taken, we must presume that the answers would have been adverse to opposer's position.

See also TBMP §§404.02, 713.08 and 718.03(d). Likewise, in this case, we find the objection interposed by respondent's counsel was not well taken and that Mr. Ling's answer to the question of whether the document had any signatures would have been adverse to respondent's position.

⁷ While we note Mr. Ling's testimony that the date of the 1995 contract is only a little more than one month before the pageant was held on June 17, 1995, we also observe that the parties had previously worked together in 1991 to present the 1992 pageant and thus were experienced in organizing and running beauty pageants together.

specified in the authorizing contract provisions for such events. No other pageants were conducted by respondent, either under such mark or any other mark.

Moreover, that respondent, prior to an apparent falling out with petitioner after the 1995 pageant (as evidenced by respondent's failure to furnish a final accounting to petitioner and by petitioner's authorizing of a third-party to produce a pageant in 1996), understood its role to be that of the producer of petitioner's pageants, rather than the owner of the mark therefor, is clearly shown by the 1992 fundraising letter distributed by respondent. Such letter, bearing the logo utilized by petitioner in conjunction with its 1988 pageant in Taiwan, not only belies respondent's contention that it created the "MISS ASIAN WORLD BEAUTY PAGEANT" mark, but clearly acknowledges that the 1992 version thereof, scheduled to be held January 4, 1992 at the Trump Plaza Hotel and Casino, was to be "the fourth contest," of which the first three had been presented by petitioner with no involvement whatsoever by respondent. (Petitioner's Ex. 17.) Respondent's role, as stated in the letter, was that "Anna Ling, of A.L. Models New York City is organizing this pageant as it's [sic] President." (Id.)

As to respondent's assertion, both in the testimony of its witness and at oral argument, that petitioner's role

and that of Mr. Chen was limited to soliciting financial sponsorship for the 1992 and 1995 pageants, it is clear that, in those instances where Mr. Chen is referred to as the "Funder" of the "Miss Asian World Beauty Pageant," such term is simply a misspelling of the word "Founder". We judicially notice, in this regard, that there is no such word as "funder" in the English language.⁸ Moreover, another letter, which was also used for soliciting sponsorship of the 1992 pageant and which likewise bears the "MISS ASIAN WORLD BEAUTY PAGEANT" logo utilized by petitioner in connection with its 1988 pageant, reference is made to Mr. Chen by the title "Founder, Miss Asian World Beauty Pageant," thereby dispelling respondent's contention that Mr. Chen had no association with the 1992 and 1995 pageants other than as a sponsor.⁹

⁸ It is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 (TTAB 1981) at n. 7. It follows, in view thereof, that the Board may also judicially notice that a term is absent from a dictionary listing. In the present case, for example, neither Webster's Third New International Dictionary (3rd ed. 1993) at 921 nor The Random House Dictionary of the English Language (2d ed. 1987) at 776 contains a definition of the term "funder".

⁹ As even a cursory reading of the record in this case reveals, the documents introduced contain numerous spelling and grammatical errors. For example, in addition to Mr. Chen being referred to in various instances as "Funder," petitioner is on occasion referenced as "Miss ASIA Beauty Pageant Associating (USA) inc." while respondent is set forth as "A. L. Model's Inc." Clearly, however, such

(Petitioner's Ex. 8.) It is thus plain that respondent knew, or at the very least should have known, that it was not the originator of the "MISS ASIAN WORLD BEAUTY PAGEANT" mark and that such mark, instead, belonged to petitioner.

Accordingly, just as a party may properly claim ownership of a mark when the mark is applied to goods at the party's instruction,¹⁰ the same is true when a party contracts with another to provide services on the party's behalf. While respondent plainly incurred and paid the expenses for the pageants it organized and presented, and received contributions from sponsors and income from ticket sales, such activities were under the auspices of petitioner who, rather than running the pageants itself under the "MISS ASIAN WORLD BEAUTY PAGEANT" mark, authorized respondent to do so by written agreements under which petitioner retained control over the nature and quality of the services rendered. Respondent, in short, was simply hired to conduct the 1992 and 1995 pageants for petitioner, who retained ownership of the

references are typographical errors which are of no legal significance.

¹⁰ For instance, if a party contracts with a manufacturer to have goods produced for the party and instructs the manufacturer to place the mark on the goods, that is the equivalent of the party itself placing the mark on its own goods. See, e.g., Target Stores, Inc. v. Trupp, 158 USPQ 614, 614-15 (TTAB 1968).

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"MISS ASIAN WORLD BEAUTY PAGEANT" mark and, in effect, may be said to have "licensed" it to respondent.

Therefore, inasmuch as petitioner, being the owner of the "MISS ASIAN WORLD BEAUTY PAGEANT" mark, has priority of use thereof, we find that the contemporaneous use by the parties of such mark in connection with the beauty pageant services rendered by petitioner and the equivalent thereof provided by respondent, namely, "business management consulting in the field of beauty pageants," would be likely to cause confusion as to source or sponsorship of their services.

This brings us to consideration of the issue of fraud. Section 1(a)(1)(A) of the Trademark Act provides, in pertinent part, that an application for registration "must be verified by the applicant" and must include "a statement to the effect that the person making the verification believes himself, or the firm, corporation, or association in whose behalf he makes the verification, to be the owner of the mark sought to be registered" As our principal reviewing court has noted in *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986):

Fraud in procuring a trademark registration ... occurs when an applicant knowingly makes false, material representations of fact in connection with his application. See *Le Cordon Bleu*, [S.A.

v. BPC Publishing Ltd.,] 451 F.Supp. [63,] ... 72 n.14, 202 USPQ [147,] ... 154 n.14 [(S.D.N.Y. 1978)]; *Schwinn Bicycle Co. v. Murray Ohio Manufacturing Co.*, 339 F.Supp. 973, 983, 172 USPQ 14, 21 (M.D. Tenn. 1971), *aff'd*, 470 F.2d 975 [176 USPQ 161] (6th Cir. 1972). "[T]he obligation which the Lanham Act imposes on an applicant is that he will not make *knowingly* inaccurate or *knowingly* misleading statements in the verified declaration forming a part of the application for registration." *Bart Schwartz International Textiles, Ltd. v. Federal Trade Commission*, 289 F.2d 665, 669, 129 USPQ 258, 260 (CCPA 1961) (emphasis in original).

Here, for the reasons previously indicated, it is clear from the record that respondent knew or at the very least should have known the material fact that the "MISS ASIAN WORLD BEAUTY PAGEANT" mark was the property of petitioner and that respondent, rather than being the owner of the mark as required by the statute, was instead under contractual agreements with petitioner to produce beauty pageants under such mark for petitioner, whose financial obligation extended no further than endeavoring to secure sponsors and sell tickets for the pageants. Respondent, nevertheless, willfully claimed in the application which matured into the involved registration to be the owner of the mark.

While the record does not reveal whether respondent was aware, at the time it filed the underlying application for its involved registration on August 1, 1995, of petitioner's

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having authorized a third party on July 1, 1995 to sponsor or conduct a beauty pageant for petitioner in 1996, it is clear that relations between the parties had deteriorated, with respondent having failed to provide petitioner with a final accounting for the "MISS ASIAN WORLD BEAUTY PAGEANT" held on June 17, 1995 by the contractually agreed date of July 2, 1995. Irrespective thereof, by falsely representing to the Patent and Trademark Office under oath that it was the owner of the "MISS ASIAN WORLD BEAUTY PAGEANT" mark, when in fact it knew or at the very least should have known that it was not the owner of such mark since its function was limited to organizing and presenting for petitioner the fourth and fifth pageants in a series of pageants conducted or authorized by petitioner, respondent induced the Patent and Trademark Office to issue the involved registration. Such registration was accordingly procured by fraud.

Decision: The petition for cancellation is granted and Reg. No. 1,995,350 will be canceled in due course.

G. D. Hohein

B. A. Chapman

G. F. Rogers

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Judges,
Board

Administrative Trademark
Trademark Trial and Appeal