

This Opinion Is Not a
Precedent of the TTAB

Mailed: June 4, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

AD5, Inc.

v.

Jennifer M. Estes DBA #SELFiE T's

Cancellation No. 92064555

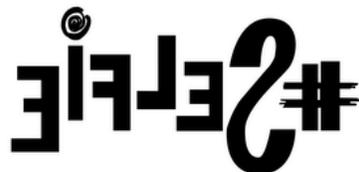
Alain Villeneuve of Vedder Price P.C.,
for AD5, Inc.

Jennifer M. Estes DBA #SELFiE T's,
pro se.

Before Kuczma, Hightower, and Larkin,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

Petitioner AD5, Inc. petitions to cancel a registration on the Principal Register owned by Respondent Jennifer M. Estes DBA #SELFiE T's on the ground of abandonment. The subject registration is for the mark



for the following goods in International Class 25:

Hats; Hooded sweat shirts; Hooded sweatshirts; Infant and toddler one piece clothing; Shirts and short-sleeved shirts; Short-sleeved or long-sleeved t-shirts; Short-sleeved shirts; Sweat shirts; T-shirts; Tops; Wearable garments and clothing, namely, shirts.¹

We dismiss the petition for cancellation.

I. Record and Briefing

The record consists of the pleadings and, without any action by the parties, the file of the involved registration. Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1). The parties submitted no other evidence. Respondent attached five exhibits to her Answer, but – subject to certain exceptions inapplicable here – such exhibits are not evidence. Trademark Rule 2.122(c), 37 C.F.R. § 2.122(c); *see also* Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 317 (June 2017).²

Only Petitioner filed a trial brief. We deny as moot Petitioner’s request to take judicial notice of a dictionary definition of the term “selfie” attached to its brief. 5 TTABVUE 17.

II. Petitioner’s Standing

Standing is a threshold issue that must be proven by the plaintiff in every inter partes case. In a cancellation proceeding, a petitioner bears the burden of

¹ Registration No. 4642072, issued November 18, 2014. The registration matured from an application filed July 5, 2013 on an intent-to-use basis under Trademark Act Section 1(b), 15 U.S.C. § 1051(b). The registration includes the following description of the mark: “The mark consists of a hash-tag symbol before the word ‘SELFIE’ as a mirrored reverse image with a spiral for the dot of the lowercase letter ‘I.’” Color is not claimed as a feature of the mark.

² Petitioner writes: “Petitioner may assume the kindness of the Board may force it to extend a courtesy to this Registrant and look and consider Exhibits entered with the Answer to see if the above argument suggesting abandonment for lack of use of a mark is founded.” Brief at 8, 5 TTABVUE 9. This sentence is unintelligible. Trademark Rule 2.122(c) clearly states that these types of exhibits are not evidence, as Petitioner itself recognizes. *See* Brief at 1 n.1, 8, 5 TTABVUE 2, 9. We have given the exhibits to the Answer no consideration.

proving standing as an essential element of its case in chief. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (“The facts regarding standing, we hold, are part of a petitioner’s case and must be affirmatively proved.”); *Nobelle.com LLC v. Qwest Commc’ns Int’l Inc.*, 66 USPQ2d 1300, 1303 (TTAB 2003). To establish its standing, Petitioner must prove that it has a “real interest,” i.e., a “reasonable” basis for its belief of damage. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

In its petition for cancellation, Petitioner alleged that it

has filed for U.S. Application No. 86/872,117, for the mark SELFIE UNDERWEAR with the United States Trademark Office. This pending application currently stands rejected under Section 2(d) of the Trademark Act based on the existence and registration of U.S. Registration No. 4,642,072 for the mark #SELFIE & Design.

Petition ¶ 2, 1 TTABVUE 3. Standing may be established through evidence that a petitioner’s trademark application has been refused due to a likelihood of confusion with the mark in the subject registration. *See, e.g., Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1532 (TTAB 2018). Unless they are admitted by a party opponent, however, statements made in pleadings cannot be considered as evidence on behalf of the party making them; such statements must be established by competent evidence at trial. *Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723, 1725 n.7 (TTAB 2010). Petitioner submitted no evidence that it owns an application that has been refused or otherwise establishes its interest in this proceeding.

In her Answer, Respondent denied the alleged grounds for cancellation, but did not address the allegation in ¶ 2 of the Petition for Cancellation. Petitioner does not contend that Respondent should be deemed to have admitted Petitioner's standing in her Answer; indeed, Petitioner does not address standing in its brief at all. Although FED. R. CIV. P. 8(b) provides that an answer that fails to deny a portion of an allegation may be deemed admitted as to that portion, we exercise our discretion to interpret Respondent's Answer as denying all of the salient averments in the Petition for Cancellation. *See* FED. R. CIV. P. 8(e) ("Pleadings must be construed so as to do justice.").³ Respondent's Answer was sufficient to put Petitioner on notice that its claims were being challenged and that Petitioner would be required to prove its case.

In the absence of an admission or stipulation, it is incumbent on Petitioner to establish its standing. We find that Petitioner has not done so. Petitioner's failure to prove its standing is a sufficient basis on which to dismiss the proceeding, and we dismiss Petitioner's claim on that basis. *See Lumiere Prods., Inc. v. Int'l Tel. & Tel. Corp.*, 227 USPQ 892, 893 (TTAB 1985).

III. Petitioner's Abandonment Claim

Although we have dismissed the petition for lack of proof of standing, even were we to exercise our discretion to find that Respondent admitted Petitioner's standing in her Answer, we still would dismiss the petition on the merits. Section 45 of the Trademark Act, 15 U.S.C. § 1127, provides in pertinent part that a mark shall be deemed to be "abandoned":

³ The Federal Rules of Civil Procedure are made applicable to Board proceedings by Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a).

When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

There are two elements to a nonuse abandonment claim: nonuse of the mark and intent not to resume use. *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1180 (TTAB 2017); *see also Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1131 (Fed. Cir. 2015). Because registrations are presumed valid under Trademark Act Section 7, 15 U.S.C. § 1057, the party seeking cancellation based on abandonment bears the burden of proving a prima facie case by a preponderance of the evidence. *Quality Candy Shoppes/Buddy Squirrel of Wisconsin Inc. v. Grande Foods*, 90 USPQ2d 1389, 1393 (TTAB 2007).

Introduction of evidence of nonuse of a mark for three consecutive years constitutes a prima facie showing of abandonment and triggers a rebuttable presumption that a mark was abandoned without intent to resume use. *Rivard v. Linville*, 133 F.3d 1446, 45 USPQ2d 1374, 1376 (Fed. Cir. 1998). The presumption shifts the burden to the party contesting the abandonment to produce evidence of either (1) use of the mark during the statutory period, or (2) an intent to resume use. *Id.* The burden of persuasion, however, always remains with the party asserting abandonment to prove it, by a preponderance of evidence. *See Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309-12 (Fed. Cir. 1989).

Petitioner contends that Respondent admitted abandonment by stating in her Answer that: “The last date of official online purchase of merchandise using the mark is dated March 5th, 2014.” Answer ¶ 1, 4 TTABVUE 2. We disagree. First, Petitioner cannot assert that a period of nonuse began prior to Respondent’s filing of her statement of use because an intent-to-use applicant need not use its mark until it files a statement of use. *Consolidated Cigar Corp v. Rodriguez*, 65 USPQ2d 1153, 1155 (TTAB 2002). Respondent filed her statement of use on September 7, 2014.

Moreover, Respondent stated in ¶ 2 of the Answer that she has maintained her website <http://www.selfiets.com>, and stated in ¶ 1 that: “Guerilla marketing methods have been used in 2016 that involved donating merchandise using the mark to potential marketplace customers.” 4 TTABVUE 2. The Answer thus alleged ongoing marketing efforts apparently involving transport of goods bearing the mark during 2016, the year before trial of this proceeding. Respondent did not admit a three-year period of non-use. See Trademark Act Section 45 (providing that “use in commerce” means a mark is placed on the goods and “the goods are sold **or transported** in commerce”) (emphasis added); *Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 USPQ2d 1413, 1418 (TTAB 2016) (“[N]onuse due to lack of demand may not constitute abandonment if the trademark owner continues its marketing efforts.”) (citing *American Lava Corp. v. Multronics, Inc.*, 461 F.2d 836, 174 USPQ 107, 110-11 (CCPA 1972) and *Daybrook-Ottawa Corp. v. F.A.B. Mfg. Co.*, 152 USPQ 441 (TTAB 1966)); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 30 cmt. b (1995) (“[N]onuse caused by a lack of demand for the goods or services ordinarily can be overcome by evidence of continuing marketing efforts on the part of the trademark

owner.”). For these reasons, Petitioner has not met its burden to prove by a preponderance of the evidence a prima facie case that Respondent abandoned her mark through nonuse.

Petitioner also argues in its brief that Respondent’s specimens are insufficient and her mark ornamental. These arguments are unavailing. The ex parte question of sufficiency of specimens is not grounds for cancellation. *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1358 (TTAB 1989); *Century 21 Real Estate Corp. v. Century Life of Am.*, 10 USPQ2d 2034, 2035 (TTAB 1989). Rather, “the proper ground for cancellation of an existing registration is that the term for which registrant obtained registration has not been used as a trademark or service mark.” *Marshall Field*, 11 USPQ2d at 1359. Petitioner pleaded and alleges only abandonment, not non-use or failure to function as a mark, and there is no basis to find that any additional claims were tried by consent.

Decision: The petition to cancel is dismissed with prejudice.