

THIS OPINION IS NOT A
PRECEDENT OF THE
TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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mbm

February 13, 2019

Cancellation No. 92068333

Bonehead Brands, LLC

v.

Direct Impulse Design, Inc.

Before Wellington, Lykos, and Heasley,
Administrative Trademark Judges.

By the Board:

Direct Impulse Design, Inc. (“Respondent”) has moved for summary judgment on Bonehead Brands, LLC’s (“Petitioner”) pleaded claim of abandonment. 7 TTABVUE.

The motion is fully briefed.

I. Background

Respondent owns Registration No. 3182681 for the mark BONE HEAD OUTFITTERS and Design, as shown below, for “Men’s, women’s and children’s clothing and sportswear, namely, sweatshirts, T-shirts, polo shirts, jackets, caps, sweaters and shorts” in International Class 25:



Respondent's involved registration issued on December 12, 2006 on the Principal Register. On October 17, 2012, Respondent filed a combined declaration under Sections 8 and 15 of the Trademark Act, 15 U.S.C. §§ 1058, 1065. The USPTO issued a notice of acceptance and acknowledgement of the combined Section 8 and 15 declaration on November 6, 2012. On May 11, 2016, Respondent filed a combined declaration under Sections 8 and 9 of the Trademark Act, 15 U.S.C. § 1058, 1059. On August 2, 2016, Post Registration issued an Office Action accepting the Section 9 portion of the combined filing but rejecting the specimen submitted in support of the Section 8 declaration on the grounds that it is a printer's proof and therefore does not show use of the registered mark in commerce. Respondent had six months to file a response submitting a substitute specimen and verification, but did not file a response to the August 2, 2016 Office Action.¹

On April 3, 2018, Post Registration issued another Office Action, reiterating its rejection of the Section 8 declaration on the basis that the specimen constitutes a printer's proof and giving Respondent six months to file a response submitting a substitute specimen and verification, failing which the registration would be cancelled. On April 11, 2018, eight days after the second Office Action issued,

¹ In its motion for summary judgment, Respondent maintains that it has no record of ever receiving the August 2, 2016 Office Action. 7 TTABVUE 17.

Petitioner filed a petition to cancel Respondent's registration on the ground of abandonment, based on Respondent's failure to file a timely, acceptable Section 8 declaration. Two days later, on April 13, 2018, Respondent filed a combined Section 8 and 9 declaration with a substitute specimen and verification, which the USPTO accepted on April 17, 2018, issuing a notice of renewal for the involved registration.

Petitioner's claim of abandonment in the petition to cancel is predicated on the above-identified registration history. In its May 22, 2018 answer to the petition to cancel, Respondent denied the salient allegations therein.

II. Respondent's Summary Judgment Motion

In support of its motion for summary judgment, Respondent submitted the affidavit of Vernon P. Squires, counsel for Respondent; a copy of the April 3, 2018 Office Action and Respondent's response thereto; and a copy of the USPTO's April 17, 2018 notice of acceptance of Respondent's combined Section 8 and 9 declaration. 7 TTABVUE 7-29.

In opposition to Respondent's motion for summary judgment, Petitioner submitted the following: excerpts from the August 2, 2016 and April 3, 2018 Office Actions; correspondence sent from Respondent to Petitioner and Respondent's response thereto;² and a copy of the TSDR prosecution timeline for Respondent's registration. 8 TTABVUE 9-20.

² Any materials that are not considered self-authenticating under Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e), must be properly authenticated by an affidavit or declaration. Inasmuch as Petitioner did not submit an accompanying affidavit or declaration, the Board gives the correspondence no consideration.

For purposes of this order, we presume the parties' familiarity with the pleadings, the history of the proceeding and the arguments and evidence submitted with respect to Respondent's motion for summary judgment.

A. Summary Judgment Standard

Summary judgment is appropriate where the movant shows that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). A party asserting that a fact cannot be or is genuinely disputed must support its assertion by either (1) citing to particular parts of materials in the record, or (2) showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact. Fed. R. Civ. P. 56(c).

A movant for summary judgment must bear the burden of proof in regard to its motion. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986). In deciding the motion, the function of the Board is not to try issues of fact, but to determine if there are any genuine disputes of material fact to be tried. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 528.01 (2018) and cases cited therein. When the moving party has supported its motion with a sufficient showing that, if unopposed, indicates there is no genuine dispute of material fact and that the moving party is entitled to judgment as a matter of law, the burden then shifts to the non-moving party to demonstrate the existence of a genuine dispute of material fact to be resolved at trial. *Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1540 (TTAB 2009).

The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. *See Opryland USA, Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992).

B. Decision

The petition for cancellation is predicated on the allegation that the registration has been technically cancelled due to Respondent's failure to file a timely response to the August 2, 2016 Office Action or otherwise file an acceptable Section 8 declaration before the expiration of the grace period. 1 TTABVUE, 8 TTABVUE 2. It is Respondent's contention that Petitioner's abandonment claim is now moot, as the USPTO accepted Respondent's April 13, 2018 Section 8 and 9 declaration. 7 TTABVUE 2. It is Petitioner's contention that the second Office Action never should have been issued and should be "nullified."³ 8 TTABVUE 4.

Respondent's registration was renewed on April 17, 2018. Contrary to Petitioner's assertion, a registration is not considered "technically" or automatically cancelled or "abandoned" by virtue of a registrant's purported failure to file a timely or acceptable Section 8 declaration. Section 8 of the Trademark Act, 15 U.S.C. § 1058, provides that "[e]ach registration shall remain in force for 10 years, except that the registration of

³ Petitioner further argues that the USPTO should not have accepted a renewal declaration during the pendency of this cancellation proceeding. On the contrary, a respondent is required to maintain its registration throughout the pendency of a cancellation proceeding and failure to do so could result in judgment being entered against the respondent. Trademark Rule 2.134(b), 37 C.F.R. § 2.134(b).

any mark shall be canceled by the Director unless the owner of the registration files in the United States Patent and Trademark Office affidavits that meet the requirements of subsection (b)....” Failure to file a timely Section 8 declaration does not result in an automatic cancellation of the registration; rather, an action must be taken by the Director of the USPTO for the registration to be cancelled. In this case, the Director did not cancel the involved registration, but rather accepted the April 13, 2018 filing and renewed the registration.

There is no mechanism under Section 8 by which a third party can seek the cancellation of a registration in an inter partes proceeding based on an allegedly deficient or untimely filing. Nor does the Board have jurisdiction to review the acceptance of the April 13, 2018 filing or the purported failure of the Director of the USPTO to cancel the registration pursuant to Section 8. *Cf. Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989) (a plaintiff may not base a claim on purported error by the examining attorney reviewing an application). Rather, any petition to cancel a registration more than five years old must be based on one of the specifically enumerated grounds of Section 14(3) of the Trademark Act, 15 U.S.C. § 1064(3). Section 14(3) provides, in pertinent part, that a petition to cancel may be filed:

At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsection (a), (b), or (c) of section 1052 of this title for a registration under this chapter, or contrary to similar prohibitory provisions of such said prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of,

the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.

15 U.S.C. § 1064(3).

An allegation that a registrant made an untimely or deficient declaration under Section 8, or that the USPTO should not have renewed a registration, is not an available ground for cancellation under Section 14(3).

Petitioner couches its claim as one of abandonment, which is an available claim against a registration more than five years old under Section 14(3) of the Trademark Act; however, Petitioner's allegations do not constitute abandonment as defined by Section 45 of the Trademark Act, 15 U.S.C. § 1127. Section 45 provides, in pertinent part, that a mark is deemed to be abandoned when one of the following occurs: "(1) When its use has been discontinued with intent not to resume such use...; (2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark." 15 U.S.C. § 1127.

Here, Petitioner has made no allegations that Respondent abandoned its mark due to nonuse or loss of significance as a trademark. Petitioner has therefore not pleaded or presented a proper claim of abandonment.

In view of the foregoing, the Board finds that there is no genuine dispute of material fact remaining for trial; Petitioner's allegations do not constitute a viable claim for abandonment or state any other ground for cancellation under the

Cancellation No. 92068333

Trademark Act. Accordingly, Respondent's motion for summary judgment is **granted** and the petition to cancel is **denied** with prejudice.