

**THIS DISPOSITION IS
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TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Essence Communications, Inc.

v.

The Cato Corporation

Opposition No. 118,596
to application Serial No. 75/721,195

Robert L. Sherman of Paul, Hastings, Janofsky & Walker LLP
for Essence Communications, Inc.

W. Thad Adams, III of Adams, Schwartz & Evans, P.A. for The
Cato Corporation.

Before Cissel, Walters, and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

The Cato Corporation (applicant) applied to register
the mark BLACK ESSENCE in typed form on the Principal
Register for "cosmetics, namely, lipstick and nail polish"
in International Class 3.¹

¹ Serial No. 75/721,195, filed June 3, 1999. The application
contains an allegation of a date of first use and a date of first
use in commerce of May 1, 1999.

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Essence Communications, Inc. (opposer) has opposed registration on the ground that it "used the mark 'ESSENCE' as the title of magazine devoted to chronicling issues and concerns of black women[,] ... for the sale of various retail products that are targeted to women of African descent ... and the mark 'ESSENCE AWARD.'" Notice of Opposition at 2-3. Opposer attached soft copies of seven registrations to its Notice of Opposition. The first is for the mark ESSENCE in typed form for a "magazine concerning matters of interest to women" in International Class 16.² The second registration is for the mark shown below for "retail mail order services for women's clothing and accessories, jewelry, and home furnishing accessories" in International Class 42.³

ESSENCE
Style

The third registration is for the mark ESSENCE BY MAIL in typed form for "retail mail order services for clothing and accessories, shoes, jewelry and home furnishing accessories" in International Class 42.⁴ The fourth and fifth registrations are both for the mark ESSENCE in typed form

² Registration No. 1,131,774, issued March 11, 1980.

³ Registration No. 1,235,902, issued April 26, 1983.

⁴ Registration No. 1,373,090, issued November 26, 1985.

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for "women's sportswear, namely, pants, skirts, blouses, shirts, knit tops, jackets and sweaters" in International Class 25⁵ and for "jewelry" in International Class 14.⁶ The sixth registration is for the mark ESSENCE ART shown below for "providing art prints through wholesale distribution services and through mail order services" in International Class 42.⁷



The seventh registration is for the mark ESSENCE AWARD in typed form for "entertainment and educational services; namely, promoting, encouraging and recognizing exceptional achievements and excellence of black women through the presentation of an award" in International Class 41.⁸

Applicant filed an answer and denied the salient allegations of opposer's notice of opposition. Specifically, the answer sets out that applicant acknowledges "that Exhibits C through I [including copies of trademark registrations] are attached to the Notice of

⁵ Registration No. 1,485,362 issued April 19, 1988.

⁶ Registration No. 1,508,051 issued October 11, 1988.

⁷ Registration No. 1,641,629 issued April 16, 1991.

⁸ Registration No. 1,712,328 issued September 1, 1992.

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Opposition but otherwise denies any of the allegations" in that paragraph. Answer at 2.

The record consists of the file of the involved application; the trial testimony deposition, with accompanying exhibits, of David Allan Slack, applicant's buyer; applicant's notice of reliance on status and title copies of third-party registrations, a December 2001 issue of *Essence* magazine, and Internet printouts of websites that use the term "essence"; and opposer's notice of reliance on TESS printouts of seven registrations, pages from *Essence* magazine and other publications and Audit Bureau of Circulations Reports on *Essence* magazine.

The issues have been briefed⁹ and an oral hearing was held on January 14, 2003.

Discussion

We dismiss the opposition.

Initially, we must address whether opposer has standing to bring this opposition. "[A] party opposing a registration pursuant to Section 13 of the Lanham Act must show (1) that he has standing and (2) a statutory ground which negates the applicant's entitlement to registration." Young v. AGB Corp., 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998). Opposer has submitted seven registrations

⁹ Opposer did not timely submit its main brief so the only brief opposer was able to file was its reply brief. See Orders dated May 31 and July 11, 2002.

with its notice of opposition. Establishing ownership of an allegedly confusingly similar registration is sufficient to prove standing. Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) ("In this case, as stated earlier, Laser Golf owns two prior registrations. These registrations and the products sold under the mark they register suffice to establish Laser Golf's direct commercial interest and its standing to petition for cancellation of Cunningham's LASERSWING mark"). While opposer has alleged ownership of seven trademark registrations, its evidence is not sufficient to establish the status and title of these registrations.¹⁰

There are several ways for a party to introduce registrations it owns into evidence in a Board proceeding. The most common way is to attach to the notice of opposition two copies of the registration prepared and issued by the U.S. Patent and Trademark Office showing both current status

¹⁰ Opposer's Reply Brief (the only brief it filed) refers to the first six registrations discussed earlier. Opposer also attempted to submit status and title copies of these six registrations in a "Request to Allow Cure of Procedural Defects in Notice of Reliance." Opposer's motion was denied as untimely and because opposer's "notice of reliance can be viewed as not defective at all, since the copies are admissible, albeit not to demonstrate the ownership or status of the registrations... opposer's failure is not procedural, but evidentiary." Order dated May 31, 2002, pp. 3-4. In addition, we note that the Order held that opposer "has not sought to reopen its testimony period, nor has it provided any reason (let alone met the 'excusable neglect' standard) for its failure to timely submit the proffered documents during its testimony period." Id. at 4.

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and title or to submit such copies under notice of reliance. 37 CFR § 2.122(d). Opposer has not provided such copies.

Other ways a party's registration will be considered to be of record include by identification and introduction during the testimony period by a qualified witness who testifies concerning the status and title of the registrations; by admission in the applicant's answer; or by the applicant treating the registration as being of record in its brief. TBMP § 702.03(a). Inasmuch as opposer took no testimony in this case and applicant's witness, applicant's buyer, did not testify about the status and title of the registrations, and because applicant did not admit the status and title of these registrations in its answer, in its admissions, or in a brief, the registrations were not made of record by any of these means.¹¹

Opposer argues that cases should be decided on the merits; that it has attached copies of its registrations (albeit not status and title copies); and that it has presented Office website printouts showing the status and title of these registrations. These arguments are not persuasive.

The Trademark Rules provide a means for implementing this proof of a prima facie case. They require that,

¹¹ Applicant indicates that "[t]o the extent this brief refers to any mark for which Opposer has presented a TESS printout as evidence of ownership, the reference is made for the purpose of thoroughness only and Applicant does not thereby concede the validity or ownership of the mark referred to." Brief at 14.

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in an opposition proceeding, registrations may be entered into evidence by (1) furnishing two copies of each registration prepared and issued by the Patent and Trademark Office showing both the *current status* of and *current title* to the registration; (2) appropriate identification and introduction of the registrations during the taking of testimony; or (3) filing a notice of reliance on the registrations during Opposer's testimony period. 37 C.F.R. § 2.122(d) (emphasis added). These rules are simple and clear, but Hewlett did not follow them.

Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) (Federal Circuit affirmed the Board's dismissal of an opposition for failing to present a prima facie case of likelihood of confusion when opposer failed to submit current status and title copies of its registrations).

Applicant's self-generated copies of registrations are not status and title copies prepared by the Office. See 37 CFR §§ 2.122(d) and 2.6(b)(4) (Cost of status and title copies of registration). "When a party seeks to introduce its own registrations under a notice of reliance, so as to benefit from the evidentiary presumptions that attach thereto pursuant to Trademark Act Sections 7(b) or 15, soft copies or T-Search printouts may not be used. Instead, the notice of reliance must be accompanied by copies of the registrations, prepared and issued by the Patent and Trademark Office, showing both current status and title to the registrations." Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230, 1232 n.2 (TTAB 1992). Also, "[w]hile it is true that

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the law favors judgments on the merits whenever possible, it is also true that the Patent and Trademark Office is justified in enforcing its procedural deadlines." Hewlett-Packard, 18 USPQ2d at 1713. Similarly, even if there were a lack of prejudice to applicant as opposer alleges, that would not excuse opposer's failure to submit the required evidence of ownership and title of the registrations on which it is attempting to rely.

Therefore, the registrations to the extent that they are in the record do not establish opposer's ownership and status of these registrations. Because there is no evidence of record regarding opposer's standing either based on its ownership of a federal registration, common law rights, or any other reason, we hold that opposer has failed to prove its standing to oppose this application and therefore, we must dismiss this opposition. See Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co., 204 USPQ 76, 81 (TTAB 1979) (The exhibits "do not show ownership of or title to the registrations as of the date of attestation ... and therefore do not serve as evidence in support of opposer's claim of damage").¹²

Decision: The opposition is dismissed.

¹² Because opposer has not proven that it has standing, we have not addressed any other issues raised by this proceeding.