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OF THE T.T.A.B.

Oral Hearing
October 26, 2006

Mailed:
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

BioScan, Inc.

v.

Biolight Patent Holding AB

Cancellation No. 92027044

Scott W. Johnston and Heather J. Kliebenstein of Merchant & Gould P.C. for BioScan, Inc.

Mark Lebow of Young & Thompson for Biolight Patent Holding AB.

Before Quinn, Grendel and Zervas, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

On December 12, 1997, BioScan, Inc. ("petitioner") filed a petition to cancel Trademark Registration No. 1943458 for the mark BIOLIGHT (in typed form) for "light generating apparatus and light applicator for medical treatment and healing" in International Class 10. Biolight Patent Holding AB ("respondent") is the owner of record of this registration, which issued on December 26, 1995 as a

result of an application filed on March 9, 1994 based on Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e). The registration has been renewed.

In its petition to cancel, petitioner claims that it has filed an application to register the mark BIOLIGHT for "light and magnetic energy generating equipment for healing bone and tissue lesions and related accessories and equipment"; and that its application has been refused registration because of a likelihood of confusion in view of respondent's registration. Petitioner further claims that respondent's mark should be cancelled because petitioner has used its mark long prior to the filing date of respondent's application; and that respondent's mark as used on its goods create a likelihood of confusion with petitioner's mark as used on its goods. Respondent, in its answer, has denied the salient allegations of the petition to cancel.

Both parties have filed briefs. The Board held an oral hearing on October 26, 2006.

The Record

In addition to the pleadings, the record includes evidence submitted by petitioner, namely, the testimonial depositions of Nadine Donahue, president and chief executive officer of petitioner, and Dr. Lawrence J. Hutti, who, according to petitioner, is a predecessor in interest to petitioner, along with the exhibits to their testimonial

depositions; and petitioner's notice of reliance making of record (i) the affidavit of Hilmer C. Lindahl, manufacturer of petitioner's BIOLIGHT product (filed pursuant to a stipulation between the parties), (ii) various invoices regarding petitioner's goods (filed pursuant to a stipulation between the parties), (iii) respondent's answers to petitioner's first set of interrogatories and exhibits attached to the interrogatory answers, and (iv) respondent's responses to petitioner's requests for admissions.¹

The record also includes evidence submitted by respondent, namely, the testimony upon written questions of Rolf Thiberg, respondent's founder and current research and development manager; and respondent's first notice of reliance consisting of the file history for the application underlying respondent's BIOLIGHT registration and various dictionary definitions and articles.

Preliminary Matters

Petitioner has raised several objections to the evidence submitted by respondent. Each of petitioner's objections is discussed below.

¹ While petitioner submitted respondent's answers to petitioner's first set of interrogatories, petitioner did not submit the interrogatories. To the extent that we can obtain any information from the interrogatory answers, we have done so.

We have not been able to obtain any information from respondent's responses to petitioner's requests for admissions because petitioner has not submitted the requests; petitioner has only submitted the responses, e.g., "Admitted."

First, petitioner argues that we must exclude part of Mr. Thiberg's testimony. Specifically, petitioner argues that Mr. Thiberg's testimony in his deposition upon written questions relating to "Registrant's Exhibit 1" must be excluded because respondent did not file Exhibit 1 with the Board or serve it on petitioner and because petitioner could not determine what Mr. Thiberg was testifying about in his deposition upon written questions. Exhibit 1 consists of respondent's answers to petitioner's interrogatories, which respondent had served on petitioner on August 4, 1998, well before Mr. Thiberg's deposition. Although respondent has not filed Exhibit 1 with the Board, because respondent has served respondent's answers to petitioner's interrogatories on petitioner, and because it is apparent from Question 12 in Mr. Thiberg's deposition that Exhibit 1 consists of interrogatory answers, petitioner's objection is overruled. Petitioner's objection to Mr. Thiberg's testimony as it pertains to Exhibit 1 because it assumes facts not in evidence is also overruled - petitioner introduced the interrogatory answers into evidence with its notice of reliance filed during its earlier testimony period and hence the interrogatory answers were already in evidence.

Second, petitioner has objected to respondent's use of various exhibits to respondent's answers to petitioner's interrogatories. Specifically, in answering various

interrogatories, respondent provided a narrative and referred to various exhibits comprising copies of correspondence, agreements and a brochure. Petitioner maintains that the copies are inadmissible because they (i) lack authentication and a proper foundation, and (ii) violate the best evidence rule. Brief at pp. 18 - 19. Additionally, petitioner objects to the admission of the correspondence on the basis that they contain hearsay statements. Brief at pp. 19 - 20.

Because it was petitioner that submitted these documents into evidence, petitioner has waived any objections it may have to such documents. Petitioner's objections on the grounds of authenticity, foundation, the best evidence rule and hearsay to such documents - and to Mr. Thiberg's testimony relating to such documents - are hence overruled. However, while we have not excluded these documents, we have considered the hearsay nature of various statements in such documents and have given them the weight that they are due. See discussion *infra*.

Third, petitioner has objected to the admission of Exhibits 1-7 to respondent's notice of reliance comprising printouts from Internet websites defining the term "lite."²

² Petitioner did not object to Exhibits 8 - 10 which consist of one dictionary definition of "lite" and two articles taken from the Internet, submitted with respondent's notice of reliance. Thus, to the extent that the same objections apply to Exhibits

According to petitioner, "the documents constitute hearsay" and respondent did not properly authenticate the printouts, which was necessary because they do not qualify as "printed publications" that may be introduced by a notice of reliance. Petitioner is correct. Internet evidence is not self-authenticating. It must be authenticated by the person with first-hand knowledge who searched for and downloaded the information. *Starbucks U.S. Brands LLC v. Ruben*, 78 UPSQ2d 1741 (TTAB 2006); *Raccioppi v. Apogee, Inc.*, 47 USPQ2d 1368 (TTAB 1998). See also TBMP § 704.08 (2d ed. rev. 2004). Inasmuch as respondent has not provided any testimony of the person with first-hand knowledge who searched for and downloaded the Internet material, respondent has not authenticated these exhibits and they hence are given no further consideration.

Likelihood of Confusion

Both petitioner's and respondent's marks are identical and their goods are virtually identical. When identical terms are used on virtually the same goods, there is no dispute that confusion is likely. Respondent itself at p. 1 of its brief has conceded that there is a likelihood of confusion. Therefore, the only issue remaining for decision is priority.

8 - 10 as to Exhibits 1 - 7, petitioner has waived such objections by failing to raise them.

Priority

Petitioner and respondent both claim priority. As noted above, respondent filed its Section 44(e) application on March 9, 1994. Respondent does not rely exclusively on the filing date of its application but rather contends that it is entitled to a priority date of January 30, 1991 based on earlier use of its mark in the United States. Petitioner disagrees, and maintains that it is entitled to a priority date as least as early as 1993, if not earlier.

It is well established that a registrant may rely on the filing date of its application or, if it submits testimony or evidence of an earlier first use date, on such earlier date. See Trademark Act §§ 2(d), 7(c) and 45, 15 U.S.C. §§ 1052(d), 1057(c) and 1127; *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996); *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154 (TTAB 1985). This also applies to a Section 44(e) registrant who seeks to rely on a use date in the United States earlier than its underlying application filing date.

We thus consider whether respondent has established that it used its mark in U.S. commerce prior to the filing date of its underlying application.

Respondent's interrogatory responses and Mr. Thiberg's testimony reflect that on January 30, 1991, Mr. Thiberg sent

a letter to Eva Marklund in Florida concerning the marketing of its BIOLIGHT apparatus in the United States. Answer to Interrogatory Nos. 8 and 9. Mr. Thiberg testified that he sold a BIOLIGHT apparatus to Ms. Marklund "sometime in February or March ... [but] did not receive payment until May 26 of the same year," that is, in 1991. Thiberg dep. question 12. Ms. Marklund's sister "collected" the apparatus in Sweden and transported it back to the United States. Thiberg's dep. question 14.

Although Mr. Thiberg testified that he sold a BIOLIGHT apparatus to Ms. Marklund in 1991, he has not stated that such a sale occurred in the United States. Mr. Thiberg testified that the apparatus "was collected" by Ms. Marklund's sister in Sweden; there is no evidence that respondent transported the apparatus in commerce with the United States. Further, there is no non-hearsay evidence regarding how Ms. Marklund paid for the apparatus and that payment was not made in Sweden.³ Mr. Thiberg's testimony, even when considered in combination with his letter to Ms. Marklund, and the correspondence of record regarding the operation of the BIOLIGHT apparatus from Ms. Marklund back

³ A handwritten note entered into the record by petitioner bearing a facsimile transmittal date of May 26, 1991 from Ms. Marklund to Mr. Thiberg states: "My sister leaves for home today, so I sent the money with them. They will deposit the money on your account tomorrow." This statement, of course, is hearsay.

to Mr. Thiberg, are simply not sufficiently probative and do not establish that respondent sold its apparatus in the United States.

In addition to corresponding with Ms. Marklund, Mr. Thiberg corresponded from Sweden with a gentleman in Florida named William Runnstrom about marketing the BIOLIGHT product in the United States. The first record of Mr. Runnstrom's involvement with BIOLIGHT is in a letter dated July 30, 1991 in which Mr. Runnstrom inquired of Ms. Marklund about cooperating in connection with products originating from Mr. Thiberg. In a letter dated one week later, on August 7, 1991, Mr. Runnstrom asked Mr. Thiberg whether Ms. Marklund had any business relationship with Mr. Thiberg. Almost two years later, on June 15, 1993, Mr. Runnstrom sent a draft exclusive distributorship and marketing agreement for the United States to Mr. Thiberg.⁴ There is no indication that Messrs. Thiberg and Runnstrom ever entered into a written agreement. Subsequent correspondence to or from Messrs. Thiberg and Runnstrom, including correspondence dated after the filing date of respondent's application, do not reflect any sales of respondent's goods or any significant efforts to expose the consuming public to respondent's goods.

⁴ Respondent has not explained what, if anything, transpired in the two year period between the August 7, 1991 letter and the June 15, 1993 letter.

Respondent also included various letters to and from other individuals regarding the BIOLIGHT product with its exhibits to its interrogatory responses. Many of such letters are dated after the filing date of respondent's application. In its brief, respondent has only commented as follows regarding these letters; "During the next several years, and continuing beyond Registrant's filing date, efforts were made to establish the BIOLIGHT apparatus in the U.S. market. Appendix I ... provides copies of correspondence between Mr. Thiberg and others, including an FDA expert, during this period to try and obtain FDA approval for the widespread use of the goods in the United States under the BIOLIGHT mark." From these few letters - which are replete with hearsay statements - we are unable to determine what respondent and its contacts had achieved in attempting to develop a market for respondent's goods in the United States. We also are unable to determine what efforts were undertaken in connection with seeking FDA approval.

Respondent has also contended that it sought to "place the mark in use in the United States" through an individual named Konny Soderman, of Freeport, Bahamas. In February 1991, Mr. Soderman sent Mr. Thiberg a letter asking for a "cooperation" with Mr. Thiberg. Mr. Soderman and Mr. Thiberg communicated through the Fall of 1991 regarding marketing of the BIOLIGHT product in the United States, with

Mr. Soderman repeatedly requesting brochures in English. The record does not reflect that respondent ever received any orders for, or made any sales of, the BIOLIGHT apparatus as a result of Mr. Soderman's efforts. Also, because Mr. Soderman was not located in the United States, the communications to and from him are not evidence of attempts to market the goods in the United States, and the statements in those letters regarding Mr. Soderman's efforts in the United States are hearsay.

The parties have not cited any reported cases which set the standard of proof a party must meet in establishing a use in commerce date prior to the filing date of its Section 44(e) application. Even if the standard is the lower preponderance of the evidence standard rather than the higher clear and convincing evidence standard, see, e.g., *George Putnam & Co., Inc. v. Hydro-Dynamics Inc.*, 228 USPQ 951 (TTAB 1986), *aff'd*, 811 F.2d 1470, 1 USPQ2d 1772 (Fed. Cir. 1987), we find that respondent has not shown by a preponderance of the evidence that it has sold or transported goods bearing the mark in U.S. commerce or in commerce with the United States, or that it has used the mark in a manner analogous to trademark use, earlier than the filing date of its application.

We now consider petitioner's evidence in support of its contention that it has priority. If the evidence shows that

petitioner has had use or analogous use of BIOLIGHT prior to March 9, 1994, petitioner must be awarded priority.

Petitioner maintains that it has actively and continuously sold its goods using the BIOLIGHT mark since at least as early as 1992. Ms. Donohue incorporated petitioner in 1993 and became its president and chief operating officer. Donohue dep. at pp. 104 and 106. Petitioner has introduced invoices dated March 25, 1993, January 10, 1994, February 17, 1994 and February 23, 1994 showing the sale of a BIOLIGHT product on each invoice. Exhibit 23 to Donohue Dep. Also, Ms. Donohue has testified that petitioner has sold BIOLIGHT devices continuously since its first sale of a BIOLIGHT device. Donohue dep. at pp 74 - 75. In view of her testimony and the documentary evidence of record, we find that petitioner has clearly and convincingly established use of its mark in the United States prior to the filing date of respondent's application. See *Oland's Breweries [1971] Limited v. Miller Brewing Company*, 189 USPQ 481, 483 (TTAB 1975) ("... the burden of ... plaintiff herein to establish by clear and convincing evidence that it has used the mark 'SCHOONER' in commerce which may lawfully be regulated by Congress since a time prior to" the filing date of defendant's application.) We hence award priority to petitioner and need not consider the evidence and arguments

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regarding earlier use of the same or similar marks by petitioner's predecessor(s) in interest.

Because petitioner has priority, the marks are identical and the goods are virtually identical, and because respondent has conceded likelihood of confusion, we find that the continued registration of respondent's mark is barred by Section 2(d).

DECISION: The petition for cancellation is granted and respondent's Registration No. 1943458 shall be cancelled in due course.