

7/31/01

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

omelko

Cancellation No. 29,146

**Bentwood Television  
Corporation**

v.

**American Theatre Wing, Inc.**

Before **Quinn, Hairston** and **Rogers**, Administrative Trademark Judges.

By the Board:

Bentwood Television Corporation ("petitioner") seeks to cancel the registration of **American Theatre Wing, Inc.** ("respondent") for the mark "*Tony Awards*" for "giving of dinners and the making of telecasts in connection with the recognition of distinguished achievement in the theatre."<sup>1[1]</sup> In its petition to cancel, petitioner asserts that respondent has abandoned its mark "by failure to use it and by otherwise nakedly licensing any and all uses thereof, including many commercial uses that are outside the scope

of its registrations." Specifically, petitioner asserts that respondent has used the mark without the quotation marks; in a typeface different from the one appearing on the registration certificate; and without the "S" in "AWARDS".

Respondent, in its answer, denies the salient allegations of the petition to cancel and includes affirmative defenses.

This case now comes up for consideration of (a) respondent's contested motion (filed October 29, 1999) for a protective order;<sup>2[2]</sup> (b) petitioner's motion (filed April 21, 2000) for summary judgment on the ground of abandonment; and (c) respondent's cross motion (filed June 5, 2000) for summary judgment on the ground of abandonment.

We turn first to the petitioner's motion for summary judgment exclusively<sup>3[3]</sup> on the ground of abandonment. In support of its motion for summary judgment, petitioner cites an out-of-date version of the Lanham Act, and argues that respondent "has not made any use of the mark, at all.

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<sup>1[1]</sup> Registration No. 979,150 issued on February 19, 1974; renewed February 19, 1994.

<sup>2[2]</sup> Petitioner inappropriately objected to the motion by filing a motion for sanctions requesting the Board to strike respondent's answer. See Fed. R. Civ. P. 11(c) and Trademark Rule 2.120(g).

<sup>3[3]</sup> In a footnote at page 6 of its affidavit in support of its motion for summary judgment, petitioner asserts that "[t]he evidence of abandonment is so pervasive that petitioner need not raise issues such as naked licensing and fraud in this motion." Moreover, petitioner argues the claims of naked licensing and fraud as tangential to the abandonment claim, rather than as separate claims.

Moreover, it has not done so for more than two<sup>4[4]</sup> years. Obviously [respondent] has abandoned its registered mark and has no intention of making any use of it now or in the foreseeable future.”

In support of its motion, counsel for petitioner states in an affidavit that:

Commencing on February 3, 2000, a hearing was held on the dispute between petitioner and Alexander H. Cohen on the one hand and League on the other respecting ownership of the programs [previously mentioned].

...[the president of respondent] testified...that he has “rarely seen it [i.e., the words “Tony Awards”] in Coronet type. Elsewhere he stated that the words “Tony Awards” “had been done various ways. In addition, Mr. Somlyo admitted that the registered mark was not used on [respondent’s] letterhead. The relevant pages of [the president of respondent’s] arbitration hearing testimony are annexed as Exhibit 8.”<sup>5[5]</sup>

As exhibits to its motion, petitioner has attached a copy of the petition to cancel; a copy of the Board’s scheduling order; a copy of petitioner’s first demand for production of documents; a copy of respondent’s answer; a copy of petitioner’s letter to respondent alleging respondent’s failure to engage in

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<sup>4[4]</sup> The minimum period of **nonuse** was extended to **three** consecutive years to establish a prima facie case of abandonment. 108 Stat. 4809, 4981-82 (1994). Respondent in its response to petitioner’s motion also references the outdated law.

<sup>5[5]</sup> This arbitration has been terminated. The arbiter determined that the “Lanham Act claim was not timely asserted, and even if it were, no violation has been shown by the way which the League asserted its consent right.”

discovery; a copy of the involved registration certificate; and copies of two transcripts from the arbitration hearing.<sup>6[6]</sup>

In its cross motion for summary judgment, respondent argues that none of these minor variations have altered the overall impact of the mark or the public's ability to associate it with respondent. These variations are intended to update the appearance of the mark to maintain its aesthetic appeal to consumers. Further, respondent argues that "[I]n the instant case, petitioner has not even alleged that the mark has lost its significance as an indication of origin (and certainly it has not offered a shred of proof to support any such allegation)." In support of its position, respondent has submitted the declarations of respondent's counsel and respondent's president. The pertinent paragraphs of the respondent's president's declaration read as follows:

It is conceded that Registrant has used minor variations of the form of the mark in the registration. These variations include: (i) using the Mark in block letters and in a type face different from that in the registration; (ii) using the Mark without the quotation around the word "Tony"; (iii) omitting the final "s" from the word "Awards"; and (iv) using the registration symbol after the word "Tony" or after the word "Awards". However, none of these variations have significantly altered the form of the Mark as registered, either aurally or visually. Further, none of these variations

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<sup>6[6]</sup> In the Board's order of March 29, 2001, the parties were asked to refrain from filing multiple copies of documents that are already of record.

has in anyway changed the fact that the public: (i) continues to associate the Tony Awards with excellence in Broadway theater, just as it did when the Mark was first used in 1947 or when it was registered in 1974; and (ii) continues to associate the Mark with Registrant.

Registrant has elected to make minor alterations to the Mark in order to maintain the aesthetic appeal of the Mark with the consuming public. Quite simply, we believed that the Mark, as registered, appeared dated and was in need of updating.

Evidence that the significance of the Mark to the consuming public has remained unchanged and undiminished is seen in the tremendous volume of unsolicited press coverage relating to Registrant and the Mark.

In further support of its cross motion, respondent has included a copy of another registration indicating ownership in respondent for the mark TONY for "entertainment services, namely providing dinners, dances and entertainment in connection with the recognition of distinguished achievement in the theatre; the presentation of awards in recognition of distinguished achievement in the theatre; television show production; and educational services, namely, conducting seminars in the field of the theatre."

Additional exhibits include: an agreement dated June 19, 1975 between The League of New York Theatres and Producers, Inc. and Bentwood Television Corporation; a publication titled "Tony Award Productions: Rules for Use of the Tony Awards® Trademarks and Materials"; copies of

advertisements displaying the mark; various other examples of use of the mark; a copy of the American Theatre Wing's Tony Awards Website; and a selection of articles from newspapers and websites discussing production of the television awards programs and the awards recipients.

Petitioner, in response to respondent's cross motion, asserts that there are three flaws with respondent's arguments:

(1) The generic words "Tony Awards" are not a variation on the registered mark—"Tony" Awards.

(2) Respondent has not tacked on an additional distinctive mark or used only part of a distinctive mark, it has abandoned all precept [sic] of distinctiveness and claims rights to a generic name.

(3) It proposes to retain registration of a distinctive, albeit never used mark, so as to stake out a claim in a generic proper name "Tony."

Petitioner also attached a copy of the arbitration award.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine,

if, on the evidence of record, a reasonable finder of fact could resolve the matter in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992), and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993), and *Opryland USA, supra*.

We find that there are no genuine issues of material fact as to the claim of abandonment. Petitioner argues that respondent is using the mark without the quotation marks; in a typeface different from the one appearing on the registration certificate; and without the "S" in "AWARDS". Respondent admits these facts but argues that the differences are not significant enough to deem the registered mark abandoned.

Having determined that there is no question of material fact in dispute, we must now decide whether registrant has abandoned its registered mark because it has used the mark (1) without the quotation marks; (2) in a type face different from the one appearing on the registration certificate; and (3) without the "S" in "AWARDS."

The principal case pertinent to this issue is *Ilco Corp. v. Ideal Security Hardware Corp.*, 527 F.2d 1221, 188 USPQ 485 (CCPA 1976). In *Ilco*, the court stated that "the law permits a user who changes the form of its mark to retain the benefit of its use of the earlier form, without abandonment, if the new and old forms create the same, **continuing commercial** impression." 527 F.2d at 1224, 188 USPQ at 487.

If the new form of the mark creates a different **commercial impression** from that of the original mark, it is deemed to be a **material alteration** of the character of the mark. *In re Holland American Wafer Co.*, 737 F.2d 1015, 222 U.S.P.Q. 273 (Fed. Cir. 1984)

Petitioner's allegation that the variations of the mark used by respondent, i.e., those without the quotation marks or in a typeface different from the one appearing on the registration certificate, are so different from the registered mark as to constitute an abandonment of the registered mark is in error. The commercial impression of the registered mark is not changed by the presence or absence of quotation marks or the use of difference typeface. *Cf. In re Ervin*, 1 USPQ2d 1665 (TTAB 1986) (use of slanting script and **quotation marks** do not render laudatory matter a registrable mark); *In re Burlington Industries, Inc.*, 196 USPQ 718 (TTAB 1977) (exclamation point in CHAMPAGNE! fails to change connotation of term alone). *See also Ex parte Hanna Paint Mfg. Co.*, 103 USPQ 217 (Comm'r Pats. 1954) (change of words in mark from arcuate

display in “fancy capital letters” to “block letters in a straight line” a mere modernization); and *Ex parte Petersen & Pegau Baking Co.*, 100 USPQ 20 (Comm'r Pats. 1953) (change in type face held not a material difference).

We turn finally to petitioner’s concern about respondent’s sometime deletion of the “s” in “awards”. Contrary to petitioner’s argument, there is no material difference, in a trademark sense, between the **singular** and the plural form of a word. See *Wilson v. Delaunay*, 245 F.2d 877, 114 USPQ 339, 341 (CCPA 1957); *In re Sarjanian*, 186 USPQ 307 (TTAB 1962).

Accordingly, we find that respondent’s registered mark “Tony” Awards has not been abandoned merely because of respondent’s occasional use of the mark without quotation marks, without the “s” in “awards” or in a font other than Coronet. These minor changes do not alter the commercial impression of the mark; rather, the forms create the same, continuing commercial impression.

In view thereof, petitioner’s motion for summary judgment is denied; respondent’s cross motion for summary judgment is granted;<sup>7[7]</sup> and the petition to cancel is dismissed with prejudice.

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<sup>7[7]</sup> Because granting of respondent’s cross motion for summary judgment dispenses with this proceeding, the contested motion for a protective order is hereby denied as moot.