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April 25, 2003
Paper No. 6
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Farrah Alexander
v.
Hot Spots, Inc.,
substituted for Wilshire House Publications Inc.¹

Cancellation No. 32,008

Lawrence D. W. Graves of Fierst & Pucci LLP for Farrah Alexander.

Edward A. Sokolski, Esq. for Hot Spots, Inc., substituted for
Wilshire House Publications Inc.

Before Quinn, Hohein and Chapman, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Farrah Alexander has petitioned to cancel the
registration, originally issued to Wilshire House Publications
Inc. and, by assignment, now owned by Hot Spots, Inc., of the
mark "HOT SPOTS" for a "magazine featuring articles about
nightclubs, bars, restaurants, music and the lives of movie,

¹ Inasmuch as it has come to the attention of the Board that the
registration sought to be cancelled herein has been assigned by the
original registrant, Wilshire House Publications Inc., to Hot Spots,
Inc. and the assignment has been recorded in the United States Patent
and Trademark Office on September 10, 2001 at reel 2366, frame 0491,
Hot Spots, Inc. is accordingly substituted for Wilshire House
Publications Inc. as the respondent in this proceeding. See Fed. R.
Civ. P. 25(c) and TBMP §512.01.

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musical and television stars."² As grounds for cancellation, petitioner alleges, among other things, that since February 1998, she "has continuously used the mark CITY HOT SPOTS on a magazine in the field of current events, entertainment[,] health, lifestyle, fashion, sports, and general interest topics"; that her "continued and legal use of said mark will be impaired by the continued registration" of respondent's "HOT SPOTS" mark; that respondent "has not used said mark, nor does respondent show any intention of using the mark for its registered purpose in the future"; that petitioner "has been unable to find any copies of any periodical published by respondent under the name HOT SPOTS"; and that respondent "has abandoned said registered mark by discontinuing use of said mark since [the date of] registration with no intent to resume said use."

Respondent, in the answer to the petition to cancel, has denied the salient allegations thereof.

The record consists of the pleadings;³ the file of the involved registration; and the notice of reliance timely filed by

² Reg. No. 2,315,217, issued on February 8, 2000 from an application filed on May 12, 1997, which sets forth a date of first use anywhere of March 15, 1989 and a date of first use in commerce of September 15, 1991.

³ It is noted that petitioner, with the petition to cancel, attached as an exhibit thereto a copy of a "CERTIFICATE OF FILING AND SUSPENSION" issued with respect to the corporate status of respondent's assignor by the California Secretary of State. Respondent, with the answer filed by its assignor, attached as exhibits thereto copies of the assignor's articles of incorporation and the front covers of several editions of "HOT SPOTS" magazine (ranging from the July/August 1992 issue to the Spring 2001 issue). It is pointed out, however, that Trademark Rule 2.122(c) provides in relevant part that "an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony."

petitioner during its initial testimony period on copies of various covers of respondent's "HOT SPOTS" magazine.⁴ Neither party took testimony and, although respondent also submitted a notice of reliance, it did not do so in a timely manner and, thus, failed to present any evidence at trial on its behalf.⁵

⁴ Specifically, petitioner states in her notice of reliance that:

Notice is hereby given that [petitioner] ... offers into evidence, and will rely upon, the copies of covers of Hot Spots magazine provided ... by Respondent during discovery. Relevance is as follows: Petitioner is seeking cancellation based upon abandonment, and the copies provided by Respondent were provided as evidence of use of the mark. Petitioner does not stipulate to the genuineness of the copies submitted.

While Trademark Rule 2.120(j)(3)(ii) provides that "[a] party which has obtained documents from another party under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of §2.122(e)," we observe that because the documents submitted with petitioner's notice of reliance appear to be copies excerpted from a printed publication in general circulation as provided by Trademark Rule 2.122(e), such evidence is accordingly admissible by means of a notice of reliance. Moreover, while we note that petitioner's notice of reliance is deficient on its face in that it fails to specify, as required by Trademark Rule 2.122(e), "information sufficient to identify the ... date[s] of the publication," we have nevertheless considered the evidence inasmuch as the edition or issue dates are discernable from each of the "HOT SPOTS" magazine covers submitted. Finally, we additionally note that, in any event, such evidence appears to be identical to the copies of magazine covers attached as exhibits to the answer filed in this proceeding (even though, as indicated previously in footnote 3, those exhibits do not form part of the record herein).

⁵ In particular, respondent states in its notice of reliance that:

Notice is hereby given that Respondent ... offers into evidence and will rely on exhibits presented with the Response to the Petition for Cancellation. These include covers of Hot Spot [sic] magazine to show continued publication thereof and a copy of the articles of incorporation [of respondent's assignor] ... to show that [such firm] ... was fully owned by Michael S. Wilson. It was erroneously assumed by Respondent's attorney that as these exhibits were submitted with the Response to the Petition for Cancellation that they would be automatically entered as evidence and therefore a Notice of Reliance was not submitted until this time. As the failure to admit this

Each party has filed a brief,⁶ but neither party has requested an oral hearing.

Petitioner, in its brief, correctly notes that Section 45 of the Trademark Act defines abandonment of a mark in relevant part as follows:

Abandonment of mark. A mark shall be deemed to be "abandoned" when ... the following occurs:

- (1) When its use has been discontinued with intent not to resume such use.

evidence would prejudice Respondent's position in an inequitable manner, it is respectfully requested that this evidence be entered. Petitioner's brief has not yet been filed so that it is not believed that the admission of this evidence would prejudice Petitioner.

Insofar as respondent requests a reopening of its testimony period, which closed on July 9, 2002, so that its notice of reliance, which it filed with a certificate of mailing dated September 17, 2002, would be timely, the request is denied since respondent has failed to show excusable neglect as required by Fed. R. Civ. P. 6(b)(2). The Supreme Court, in *Pioneer Investment Services Co. v. Brunswick Associates Limited Partnership*, 507 U.S. 380, 392 (1993), has stated that "inadvertence, ignorance of the rules, or mistakes construing the rules do not usually constitute 'excusable' neglect." Here, moreover, while petitioner obviously would not be prejudiced by allowing respondent to rely on copies of various covers of its "HOT SPOTS" magazine inasmuch as such evidence is identical to that submitted with petitioner's notice of reliance, petitioner plainly would be prejudiced, since her rebuttal testimony period closed on August 23, 2002, by permitting respondent to rely additionally on a copy of the articles of incorporation of respondent's assignor. Nevertheless, except for such additional evidence, it is pointed out that in any event the notice of reliance filed by respondent is superfluous inasmuch as the copies of the covers of respondent's "HOT SPOTS" magazine have already been properly made of record by the notice of reliance thereon timely filed by petitioner. The latter evidence, therefore, may be referred to by respondent in its brief in support of any argument which (subject to the provisions of Fed. R. Civ. P. 11) it believes is to its advantage. See TBMP §801.01.

⁶ It appears necessary to point out that, as stated in TBMP §801.01: "[T]he facts and arguments presented in the brief[s] must be based on the evidence offered at trial. A brief may not be used as a vehicle for the introduction of evidence." Accordingly, as set forth in TBMP §706.02: "Factual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial."

Intent not to resume may be inferred from circumstances. Nonuse for three consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in the mark.

Petitioner asserts, in view thereof, that "[t]he evidence produced by Respondent ... indicates that the mark is no longer in use" because "[t]he last actual issue of Respondent's magazine was apparently published in the Spring of 1999." Petitioner additionally contends that, while the evidence shows "what appears to be an advertising proof for a 'Spring 2000 issue'" of respondent's "HOT SPOTS" magazine, "there is no evidence that such issue was actually published." Consequently, according to petitioner, respondent has prima facie abandoned its mark since it "ceased using the mark ... over three years ago" and has "introduced no evidence of any other use in commerce that would rebut the statutory presumption."

The period for the trial of this case closed on August 23, 2002. The evidence of record introduced at trial shows, on the face thereof, a partial front cover of a "Spring 2000 Issue" of respondent's "HOT SPOTS" magazine as well as the full front covers of the following editions of such magazine: "QUARTERLY/-FEBRUARY-APRIL 1999"; "BIMONTHLY/JULY 1997"; "BIMONTHLY/APRIL 1996"; "MAY/JUNE 1995"; "AUGUST/SEPTEMBER 1994"; "WINTER 1994"; "SUMMER 1993"; "FEBRUARY 1993"; "JULY/AUGUST 1992"; "JUNE 1992"; and "FEBRUARY/MARCH 1992." Thus, as of the close of trial herein, there not only is no evidence of an intention on the part

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of respondent to abandon its "HOT SPOTS" mark, but there is no three-year period of nonuse of such mark which would constitute a showing of prima facie abandonment thereof. As respondent argues in its brief, "there is no basis whatsoever to conclude that the reduced size front cover of the magazine for the Spring of 2000 is not a reproduction of the cover of a magazine which was issued," particularly when, "[a]s can be noted, there are also reduced size pictures of the covers of previous editions of the magazine on this cover which were submitted as ... actual full size covers in the exhibits." Stated somewhat differently, there simply is nothing from the fact that a copy of only half of the cover for a "Spring 2000 Issue" was made of record which should result in an assumption that such an issue was not produced in the ordinary course of trade but, rather, was made merely to reserve a right in the mark.

We further observe that, in any event, there is no proof by petitioner of her standing to bring this proceeding. Specifically, there is no evidence in the record which, as alleged in the petition to cancel, establishes that since February 1998, petitioner "has continuously used the mark CITY HOT SPOTS on a magazine in the field of current events, entertainment[,] health, lifestyle, fashion, sports, and general interest topics" and that her "continued and legal use of said mark will be impaired by the continued registration" of respondent's "HOT SPOTS" mark.

None of petitioner's allegations, therefore, is supported by any of the evidence which is properly of record in

this proceeding. Petitioner has neither established her standing to be heard that she is being damaged by the continued existence of the involved registration, nor has she shown that the mark which is the subject of the petition to cancel has been abandoned by respondent. Such proofs are essential elements of petitioner's case-in-chief and, in the absence thereof, she cannot prevail.

Accordingly, because petitioner, as the party who bears the burden of proof in this proceeding, has failed to present any evidence which supports the allegations of the petition to cancel which have been denied by respondent, it is adjudged that the petition to cancel must fail.

Decision: The petition to cancel is denied.