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Mailed: August 17, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Born Again Clothing, Inc.
v.
Richard C. Reilly

Cancellation No. 92032516

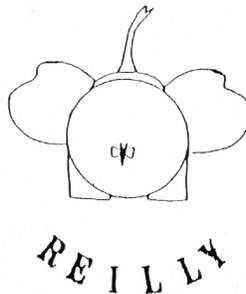
Stewart J. Neuville of Law Office of Stewart J. Neuville for
Born Again Clothing, Inc.

Robert W. Beattie of Beattie & Murray for Richard C. Reilly.

Before Chapman, Bucher and Rogers, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Richard C. Reilly (U.S. citizen residing in New Jersey)
is the owner of Registration No. 1913419 for the mark shown
below



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on the Principal Register for "footwear, headwear and clothing, namely, shirts, shorts, pants and jackets" in International Class 25 and for various building construction services (e.g., excavation, paving, coating, sealing and stone-laying of roadways, driveways, walkways, parking lots, patios; repair and maintenance of buildings and houses; repair and maintenance of roadways, driveways, walkways, parking lots, patios) in International Class 37.¹

Born Again Clothing, Inc. (a California corporation) has filed a petition to partially cancel Registration No. 1913419, specifically, to cancel the registration only as to the goods in International Class 25. As grounds for cancellation, petitioner alleges that it is a manufacturer and wholesaler of vintage or used clothing; that since about August 2, 1999, petitioner has used the mark shown below

The image shows the word "Riley" written in a casual, handwritten style. The letters are black and the word is enclosed within a simple, hand-drawn rectangular border with rounded corners.

for a line of used or vintage clothing; that on September 20, 1999 petitioner filed application Serial No. 75802726 for the mark RILEY for "used clothing, namely, pants, skirts, shirts, blouses, jackets, shorts, socks, and hats"; that petitioner's application has been refused registration

¹ Registration No. 1913419, issued August 22, 1995, Section 8 affidavit accepted. The claimed date of first use for both classes of goods and services is January 1973.

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by the Examining Attorney pursuant to Section 2(d) of the Trademark Act based on respondent's Registration No. 1913419; that respondent has abandoned his mark REILLY and design for the International Class 25 goods; and that respondent has made no use of the mark with regard to clothing for a period of three years and "Registrant has demonstrated an intent to relinquish trademark rights by such nonuse" (petition to cancel, paragraph 10).²

Respondent, in his answer, denies the salient allegations of the petition to cancel the International Class 25 goods from his registration, and he states that "Respondent has continually used the mark."

The record consists of the pleadings;³ and the file of the involved registration.⁴ During its testimony-in-chief period, petitioner filed the declaration testimony, with exhibits, of (i) Derek Banton, petitioner's president, and (ii) Stewart J. Neuville, petitioner's attorney; and the

² Petitioner alleged (and proved) that it is the owner of a California state registration for the mark RILEY and design for clothing. However, a state registration has very little, if any, probative value in a proceeding before the Board. See TBMP §§704.03(b)(1)(A) and 704.03(b)(1)(B) (2d ed. rev. 2004).

³ Exhibits attached to a pleading (with one exception which is not relevant herein) are not evidence on behalf of the party to whose pleading they are attached, unless the exhibits are properly made of record during trial. See Trademark Rule 2.122(c). See also, TBMP §704.05(a) (2d ed. rev. 2004).

⁴ Informationally, the parties are advised that the file of the involved registration is of record to the extent provided in Trademark Rule 2.122(b).

amended declaration testimonies, with exhibits, of both Mr. Banton, and Mr. Neuville.⁵ During defendant's testimony period, respondent submitted the declaration testimony, with exhibits, of (i) Richard C. Reilly, respondent, and (ii) Robert W. Beattie, respondent's attorney. Petitioner submitted the rebuttal declaration of Stewart J. Neuville.⁶

Petitioner did not file an opening brief on the case pursuant to Trademark Rule 2.128(a)(1), resulting in the Board issuing an order to show cause under Trademark Rule 2.128(a)(3).⁷ Petitioner responded to the show cause order stating that it had not lost interest in the case; that the testimony filed by both parties should have been titled "Testimony and Brief"; and that "it is evident that both parties acted upon their believe [sic] that the briefing was contained in their respective Testimony." (Petitioner's response to show cause order, p. 1). Respondent did not challenge or object to this characterization of the parties'

⁵ The twelve exhibits to petitioner's declarations include petitioner's first set of interrogatories (Nos. 1-16) and respondent's response and supplemental response thereto, and petitioner's first set of requests for documents (Nos. 1-27) and respondent's response and supplemental response thereto.

⁶ In inter partes Board proceedings, testimony is generally taken upon oral examination pursuant to Trademark Rule 2.123 or upon written questions pursuant to Trademark Rule 2.124. However, parties may stipulate by written agreement that the testimony of a witness may be submitted in the form of an affidavit (or declaration) pursuant to Trademark Rule 2.123(b). See TBMP §703.01(b) (2d ed. rev. 2004).

Here, although there is no written agreement of record, both parties have submitted witness testimony in declaration form; and we find that the declarations of all four witnesses were tacitly stipulated into the record by the parties.

filings. The Board held the show cause order to be discharged and explained that the case would proceed to final decision on the merits. We treat the testimony declarations from both parties as including their respective briefs on the case.

Neither party requested an oral hearing pursuant to Trademark Rule 2.129. See TBMP §802 (2d ed. rev. 2004).

According to Mr. Derek Banton, Born Again Clothing, Inc.'s president, petitioner was founded in 1993 by himself and his brother Greg Banton; petitioner "originally re-manufactured vintage and used clothing into specialized and trendy fashions," and as the company grew, the line of clothing was expanded to include the "manufacturing of new clothing style lines" (amended declaration, paragraph 22); all of its lines of clothing are sold under its RILEY mark, which is named after Derek Banton's daughter Riley; petitioner sells its clothing throughout the United States and in various countries around the world; petitioner has grown to employ 39 people and its 2002 revenue was \$10 million; and petitioner applied to register the mark RILEY for clothing items, but its application has been refused registration based on respondent's registration for goods in the clothing class.

⁷ See TBMP §§801 and 536 (2d ed. rev. 2004).

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According to respondent, Richard Reilly, "my family founded my company in 1925" (declaration, paragraph 6)⁸; he obtained a registration for his REILLY and design mark in 1995; the trademark is used extensively in his business; and he is using the trademark correctly and displaying it in the sale and advertising of his business including for clothing.

Petitioner's position is essentially that respondent "mistakenly and inadvertently" registered his mark for clothing when respondent's "only business is as a 'paving contractor'" (Banton declaration, paragraph 8; amended declaration, paragraph 13); that "By Respondent's own admission he is clearly a paving contractor who affixes his service mark in the form of embroidered emblems on hats or printed on tee shirts (as well as calculators or and [sic] watches) that he gives out but he does not sell" (Banton declaration, paragraph 31, amended declaration, paragraph 41, emphasis in originals); that in advertisements and on his stationery business items, respondent always refers to himself only as a paving contractor; and that because respondent does not manufacture clothing nor does he apply labels to clothing items, and because his mark is applied only to goods used as promotional items for his paving contracting business, there is a "complete lack of use" of his mark in connection with clothing which requires that his

⁸ The Board presumes respondent means his family's building

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registration be cancelled for the International Class 25 goods (Banton declaration, paragraph 37, amended declaration, paragraph 48).

Respondent's position is that he properly registered the mark REILLY and design for both clothing and building construction services; that his mark is in use in interstate commerce; that his mark "certainly has not been 'abandoned'" (Reilly declaration, paragraph 19); and that his mark "is used correctly and is displayed in [the] sale and advertising of my business including clothing" (Reilly declaration, paragraph 22).

Petitioner bears the burden of proof in this case, and must establish both its standing and any pleaded ground by a preponderance of the evidence. See *On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000). See also, *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000); *Martahus v. Video Duplication Services Inc.*, 3 F.3d 417, 27 USPQ2d 1846, 1850 (Fed. Cir. 1993); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1554 (Fed. Cir. 1991); *Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989); and 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §20:41 (4th ed. 2001).

construction business was founded in 1925.

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There is no question that petitioner, a manufacturer of clothing, whose application has been refused registration based on respondent's registration for clothing items, has standing to be heard on the question of cancellation of the registration for those goods. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); and *Rail-Trak Construction Co., Inc. v. Railtrack, Inc.*, 218 USPQ 567, 571 (TTAB 1983). Petitioner has established its standing.

Turning to the pleaded ground for cancellation, the Trademark Act provides for the cancellation of registrations if use of the registered mark has been abandoned. See Section 14(3) of the Trademark Act, 15 U.S.C. §1064(3). Section 45 of the Trademark Act, 15 U.S.C. §1127, defines one type of abandonment of a mark as "when its use has been discontinued with intent not to resume such use."

The evidence before us does not establish respondent's abandonment of his mark REILLY and design for goods; and, to the contrary, it establishes that respondent uses his mark on various clothing items, such as hats and tee shirts. For example, reproduced below are some of petitioner's discovery requests, and respondent's answers thereto (made of record by petitioner):

- (1) First Set of Interrogatories, No. 2 --
IDENTIFY the GOODS put into COMMERCE by
YOU upon which the TRADEMARK was affixed

during the period of January 1, 1997 through January 1, 2002.

Answer -- With respect to goods, this would include without limitation, hats, tee shirts, sweatshirts, watches, coffee mugs, key rings and calculators.

- (2) First Set of Interrogatories, Nos. 4 and 5 -- 4. State any and all facts, in detail and with particularity, which YOU believe support Paragraph 10 of YOUR ANSWER. 5. State any and all facts, in detail and with particularity, which YOU believe support Paragraph 11 of YOUR ANSWER. (Paragraphs 10 and 11 of respondent's answer were denials of petitioner's allegations of abandonment, along with the statement "Respondent has continually used the mark.")

Answer -- 4. Objection. It is Petitioner's burden of proof on this issue. However, without waiving said objection, Respondent has been continually using the mark on stationary [sic], business cards, advertising, hats, tee shirts, sweatshirts, watches, coffee mugs, key rings, and calculators in interstate commerce including New Jersey, Massachusetts, Maryland, Delaware, New York State and elsewhere. 5. See 4.

In view of petitioner's failure to prove abandonment of the mark by respondent with respect to the goods in International Class 25, the petition to partially cancel Registration No. 1913419 must fail.

By way of further explanation in this case, it appears that petitioner misapprehends the legal effect of certain manners of "use" of a trademark. Section 45 of the

Trademark Act, 15 U.S.C. §1127, reads, in pertinent part, as follows:

Use in commerce. The term "use in commerce" means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this Act, a mark shall be deemed to be in use in commerce--

- (1) on goods when--
 - (A) it is placed in any manner on the goods... and
 - (B) the goods are sold or transported in commerce...

Thus, there is nothing in the statute that requires a party be the original manufacturer of the goods. Nor does the statute require either that the mark be affixed to a label attached to goods,⁹ or that the party *sell* the goods in order to be "using" the mark within the meaning of the Trademark Act.

Moreover, the mere fact that a collateral product serves the purpose of promoting a party's primary goods or services does not mean that the collateral product is not a good in trade, where it is readily recognizable as a product of its type (as tee shirts and hats would be) and is sold or *transported* in commerce. See *NASDAQ Stock Market Inc. v. Antarctica S.r.l.*, 69 USPQ2d 1718, 1731 (TTAB 2003); and

⁹ We acknowledge that a label attached to the goods is a common method of affixing a mark to items of clothing, but it is not the only method of use of a mark on clothing and it is not a statutorily required method.

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Paramount Pictures Corp. v. White, 31 USPQ2d 1768, 1773
(TTAB 1994), and cases cited therein.

Decision: The petition to partially cancel
(specifically to cancel the registration as to the
International Class 25 goods) is denied.