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August 18, 2004
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Ryan Takahashi
v.
Bradley Imports, Ltd.

Cancellation No. 92040069

Peter E. Nussbaum of Wolff & Samson PC and Matthew R. Miller of Law Offices of Matthew Miller for Ryan Takahashi.

Ezra Sutton of Ezra Sutton, P.A. for Bradley Imports, Ltd.

Before Hohein, Bucher and Bottorff, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Ryan Takahashi, a United States citizen, has petitioned to cancel the registration, issued to Bradley Imports, Ltd., of



the mark "WEST SIDE" and skyline design, as reproduced below,
for "women's, men's, children's and infants' underwear, jeans,
pants, shorts, jackets, swimwear, sweaters, shirts, vests, tank

tops, sweatshirts, and outerwear and rainwear, namely, vests, jackets, coats, snowsuits and snowpants; children's scarves, gloves and knickers; children's and infants' hats, overalls and rompers; children's and women's leg warmers, body stockings, leotards, skirts, tube tops and halter tops; women's, children's and infants' blouses and dresses; infants' legging sets; and children's and men's outerwear and rainwear shirt jackets."¹

As grounds for cancellation, petitioner alleges that he "has been continuously using the Trademark WESTSIDE in commerce in connection with Clothing, namely, jackets, sweaters, sweatshirts, pants, shorts, sweatpants, T-shirts, shirts, tank tops, polo shirts, woven and knit shirts, socks, underwear, overalls, dresses, skirts, vests, pajamas, jumpsuits, track suits, bathing suits, belts, suspenders, neck ties, bandannas, wrist bands, head bands and outerwear, namely, snow pants, snow jackets, ski bibs, snow suits, gloves, insulated and thermal pants[,] jackets and shirts; headgear, namely, hats, caps, [and] sun visors; and footwear, namely[,] shoes since at least as early as October 1998"; that petitioner "is informed and believes that the Registrant is not using the Trademark WEST SIDE in the United States"; that, on information and belief, "the Trademark WEST SIDE ... is no longer being used by the Registrant or any assignee or transferee thereof in connection with the goods recited in the [involved] registration or in connection with any other goods or services"; that "[t]he Trademark WEST SIDE has

¹ Reg. No. 1,414,282, issued on October 21, 1986 from an application filed on May 23, 1983, which sets forth a date of first use anywhere

been abandoned by the Registrant within the meaning of Section 14 of the 1946 Lanham Trademark Act, 15 U.S.C. § 1064(c)"; that, accordingly, the involved registration "for the Trademark WEST SIDE should be canceled because the Trademark has been abandoned in the United States by the Registrant"; that "[o]n February 14, 2001[,] Petitioner filed an Application in the United States Patent and Trademark Office to register the Trademark WESTSIDE for [the above noted items of] Clothing ..., which ... has been assigned Serial No. 76/209257"; that [o]n June 26, 2001[,] the United States Patent and Trademark Office mailed an office action refusing registration of Petitioner's Application Serial No. 76/209257, for the mark WESTSIDE, indicating, *inter alia*, that Petitioner's mark was likely to be confused with Registrant's ... mark WEST SIDE"; and that "[i]f Registrant's Registration No. 1,414,282 is permitted to remain on the Register, Petitioner may be unable to overcome the aforementioned refusal of registration."

Respondent, in its answer, has denied the salient allegations thereof.

The record consists of the pleadings; the file of the involved registration; and notices of reliance timely filed by petitioner² on (1) respondent's answers (dated July 19, 2002) to

and in commerce of October 1975; combined affidavit §§8 and 15.

² It is noted that the Board's March 4, 2003 order, which suspended proceedings for six months in view of an indication that the parties were negotiating for a settlement of this case, crossed in the mail with a stipulated motion, which was timely received on February 28, 2003, to go forward herein and extend all testimony periods, beginning with petitioner's initial testimony period. Accordingly, the Board's March 4, 2003 suspension order is vacated and the parties' February

(a) petitioner's Interrogatory Nos. 6 (including the documents submitted in response thereto), 11, 13 and 16, (b) petitioner's Requests for Admissions Nos. 7 and 8, and (c) petitioner's Requests for Production of Documents Nos. 3 through 8, 11, 13 through 16, and 18 through 22;³ and (2) official records of the United States Patent and Trademark Office ("USPTO") with respect to application Serial No. 76209257 for registration of the mark "WESTSIDE." Neither party, however, took testimony or submitted any other evidence. Only petitioner filed a brief, and neither party requested an oral hearing.

According to the record, petitioner filed application Serial No. 76209257 on February 14, 2001 seeking to register the mark "WESTSIDE" for various items of apparel. Registration thereof was refused, in an Office action issued on June 26, 2001, on the ground that petitioner's mark is likely to cause confusion with the "WEST SIDE" and skyline design mark which is the subject of respondent's involved registration. Such application is currently suspended pending the disposition of this proceeding.

As to respondent, the record shows that its sole use of the term "WEST SIDE" is in connection with swimwear, which bears the mark "WEST SIDE" and floral design, as shown below,



28, 2003 stipulated motion for initial testimony period

³ While, in light of Trademark Rule 2.120(j)(3), it is pointed out that answers to requests for production of documents are not proper subject matter for a notice of reliance, such answers have been considered herein inasmuch as respondent has not objected thereto. See TBMP §704.11 (2d ed. rev. 2004).

resetting petitioner's 2003.

rather than the "WEST SIDE" and skyline design mark which is the subject of its involved registration. In particular, while Interrogatory No. 6 requests that, "[f]or each product bearing or sold under the mark WEST SIDE," respondent "describe in detail how the mark WEST SIDE appears on each such product ... and how it is used in connection with the sale, offering for sale, distribution, or manufacture of each such product," respondent has not indicated any products in its answer thereto other than referring to the swimwear which it offers under the "WEST SIDE" and floral design mark illustrated above. Furthermore, with respect to its "WEST SIDE clothing," respondent indicates in answer to Interrogatory No. 11 that it has not attended any trade shows where such clothing "was displayed, sold, offered for sale, and/or promoted." Moreover, as to "the mark WEST SIDE," respondent confirms in answer to Interrogatory Nos. 13 and 16 that it has not placed any "advertisements ... which were distributed, aired or otherwise disseminated" using such mark or otherwise spent any amount on advertising any "products bearing or sold under" such mark. Likewise, in answer to Requests for Admissions Nos. 7 and 8, respondent admits that it does not display "the mark WEST SIDE" in connection with clothing at trade shows and that it does not advertise such mark.

In a similar vein, respondent reveals in its answers to various Requests for Production of Documents that, other than the documents showing use of the above noted "WEST SIDE" and floral design mark in connection with hang tags for swimwear, it has no

labels, invoices, packing slips, tags, markings or advertising for "the mark WEST SIDE"; and it has no catalogs, brochures, fliers, sales meeting materials or descriptive materials in general which relate to any product sold or distributed under such mark. Also, other than likewise referring to documents indicating the use of the above noted "WEST SIDE" and floral design mark in connection with hang tags for swimwear, respondent answered "none" in response to requests that it produce representative documents reflecting both the total number of units of "WEST SIDE clothing" manufactured by or on behalf of respondent and the total number of such units sold by respondent, and representative specimens of each type of label, container, carton, tag, invoice, sticker, box, bag, packaging, silkscreen, and/or any other means by which respondent has applied or used "the mark WEST SIDE" on or in connection with any products.

Respondent, in addition, unequivocally answered "none" in response to requests that it produce the following: all advertisements placed either by respondent or on its behalf with respect to each of the products on which it uses "the mark WEST SIDE"; photocopies of all periodical publications, including magazines, newspapers, trade publications and catalogs, in which products bearing or sold under such mark have been advertised, promoted or featured; all documents which relate to the method of marketing and distribution of its products sold under "the mark WEST SIDE"; all documents relating to the actual and intended channels of distribution of each of the products bearing or sold under such mark; all sales reports and royalty payment reports

for each product bearing or sold by or on behalf of respondent under "the mark WEST SIDE"; all documents identifying or listing each outlet or store in the United States which sells, offers for sale, promotes or advertises any product manufactured, distributed or sold by respondent under such mark; all contracts between respondent and its distributors of, manufacturers of and customers for any products bearing or sold under such mark; all documents and things relating to respondent's attendance at any trade shows and exhibitions of goods bearing or sold under "the mark WEST SIDE"; all documents relating to and/or identifying the retail price of each of the products bearing or sold under such mark; representative documents reflecting respondent's total gross sales "for WEST SIDE clothing"; and all documents relating to the date respondent first became aware or acquired knowledge of petitioner and/or its use of "the mark WESTSIDE."

Turning to the merits of this proceeding, petitioner has clearly established his standing to be heard on the claim of abandonment by having proven that his application, Serial No. 76209257, to register the mark "WESTSIDE" for various items of apparel has been refused on the basis that such mark is likely to cause confusion with respondent's "WEST SIDE" and skyline design mark for certain articles of clothing, which is the subject of the registration involved herein. See, e.g., Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) [to have standing in a cancellation proceeding, "it would be sufficient that appellee prove that it filed an

application and that a rejection was made because of appellant's registration"].

As to petitioner's claim that respondent has abandoned its registered "WEST SIDE" and skyline design mark, Section 45 of the Trademark Act, 15 U.S.C. §1127, 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. 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, noting that "much of the focus of Petitioner's written discovery requests was to determine the extent to which, if at all, Respondent is using the [registered] mark," argues in his brief that the sole use shown by respondent in answer thereto "consist[s] of hang tags that were attached to four women's bathing suits produced by Respondent" and that "none of these ... bear[s] the mark covered by the subject registration."

Petitioner asserts that, "[b]ased upon Respondent's responses to Petitioner's written discovery requests [as] discussed above, Respondent has not demonstrated any use whatsoever of the mark covered by the registration sought to be cancelled in this proceeding, either through use on the goods themselves or through any advertising or marketing materials."

In view thereof, and citing Rivard v. Linville, 133 F.3d 1446, 45 USPQ2d 1374, 1376 (Fed. Cir. 1998) for the proposition that "[a] prima facie showing of abandonment eliminates a challenger's burden to establish the intent element of abandonment as an initial part of its case and creates a rebuttal presumption that the registrant abandoned the mark without intent to resume use under the statute," petitioner contends that (emphasis in original):

The evidence presented by Petitioner demonstrates that Respondent has abandoned the mark **WEST SIDE and design** covered by the subject registration due to a period of non-use [sic] for at least three years. In fact, Respondent has produced no evidence whatsoever of use of the subject mark **WEST SIDE and design** and therefore has not, and cannot, rebut the presumption that the mark has been abandoned.

....

Since Petitioner expressly requested through its written discovery requests that Respondent produce evidence to demonstrate its use of the mark, and Respondent has completely failed to do so, it must be presumed that Respondent has abandoned the mark.

In addition, petitioner maintains that respondent may not rely upon its limited use of the "WEST SIDE" and floral design mark to avoid the presumption of abandonment of its registered "WEST SIDE" and skyline design mark. Specifically, citing Van Dyne-Crotty Inc. v. Wear-Guard Corp., 926 F.2d 1156, 17 USPQ2d 1866, 1868 (Fed. Cir. 1991), petitioner correctly observes that for tacking to be permissible, "the two marks must create the same *continuing commercial impression* and the

previously used mark must be the *legal equivalent* of the mark in question or indistinguishable therefrom[,] such that consumers should consider the marks to be the same" (emphasis by petitioner). Thus, as to respondent's registered "WEST SIDE" and skyline design mark and its "WEST SIDE" and floral design mark, petitioner argues that (footnote omitted):

There can be no argument that the two marks ... are legally equivalent or create the same commercial impression. The use of two completely different design elements serves to drastically alter the commercial impressions created by the respective marks. The mark covered by the subject registration includes a design element of the New York City skyline connoting the impression of the "west side" of Manhattan and its famous skyline. In contrast, the only mark that Respondent produced [evidence of use] in response to Petitioner's discovery requests features a design element comprised of stylized flowers and an entirely different stylized format for the words "west side." This new mark has no connection whatsoever to New York City or its well-known skyline, and therefore has an entirely different commercial impression than the mark covered by the subject registration. [Here] ..., a simple visual inspection of the two marks ... clearly demonstrates that the mark covered by the subject registration and the mark that Respondent has produced evidence of use of are not "legally equivalent." Accordingly, Respondent cannot possibly rely upon the use of this entirely different mark to avoid the presumption that it has abandoned the mark covered by the subject registration, especially since Respondent has produced no evidence whatsoever of use of the subject mark.

We agree with petitioner that the discovery answers made of record are sufficient to establish a prima facie case of abandonment. In particular, the record demonstrates that not only does respondent admit that it has not advertised and does

not advertise any products under its registered "WEST SIDE" and skyline design mark and that, similarly, it has not promoted and does not promote any items of clothing under such mark at trade shows, but the only documentation which respondent has provided regarding goods which it has for sale and any sales of clothing are a few items of swimwear which bear hang tags displaying the significantly different "WEST SIDE" and floral design mark. We concur with petitioner, moreover, that for the above mentioned reasons stated in his brief, the "WEST SIDE" and floral design mark does not create the same continuing commercial impression, and thus is not the legal equivalent of, respondent's registered "WEST SIDE" and skyline design mark. Respondent, therefore, may not tack its use of the "WEST SIDE" and floral design mark so as to avoid a finding of abandonment of its registered "WEST SIDE" and skyline design mark.

In short, despite petitioner's various discovery requests therefor, respondent furnished no evidence showing that, during a period extending for more than three years prior to the date it furnished its answers to such requests, it had made any sales or other use of its "WEST SIDE" and skyline design mark in connection with any of the clothing items set forth in its involved registration. While, of course, respondent had the opportunity to explain its nonuse of its "WEST SIDE" and skyline design mark, it offered no testimony or other evidence in its behalf during its testimony period.⁴ Respondent's failure to

⁴ Cf. *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993) ["we hold that absent other facts which

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rebut petitioner's prima facie showing of abandonment accordingly entitles petitioner to cancellation of the involved registration.

Decision: The petition to cancel is granted and Reg. No. 1,414,282 will be canceled in due course.

adequately explain or outweigh the failure of an applicant to have any documents supportive of or bearing upon its claimed intent to use its mark in commerce, the absence of any documentary evidence on the part of an applicant regarding such intent is sufficient to prove that the applicant lacks a bona fide intention to use its mark in commerce" and, thus, "[a]n allegation to such effect ... states a claim upon which relief can be granted"]. *A fortiori*, absent a satisfactory explanation thereof, respondent's lack of any documents showing actual use of its registered mark in connection with advertising, trade show promotions and/or product sales suffices to demonstrate a prima facie case of abandonment.