

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
April 23, 2008  
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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Choice First Distribution, LLC

v.

John L. Brown  
\_\_\_\_\_

Cancellation No. 92044116  
against Registration No. 2780780  
\_\_\_\_\_

Request for Reconsideration  
\_\_\_\_\_

Michael Cerrati and John Alumil of Patel & Alumil, PC for  
Choice First Distribution, LLC.

John L. Brown, *pro se*.  
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Before Bucher, Zervas and Kuhlke, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

The Board, in a final decision dated December 21, 2007,  
dismissed the petition of Choice First Distribution, LLC  
(petitioner) to cancel the registration owned by John L.  
Brown (respondent) for the mark **CHRONIC 187** for "non-  
alcoholic carbonated and non-carbonated beverages, namely  
soda and energy drinks" in International Class 32.<sup>1</sup> In the  
final decision, the Board gave no consideration to

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<sup>1</sup> Registration No. 2780780 issued November 4, 2003.

petitioner's three notices of reliance filed on June 15, 2006, stating that they had not been timely filed with the Board.

Petitioner timely requested reconsideration of the dismissal, pointing out that the submission of its three separate notices of reliance were actually within petitioner's testimony period as set out by the Board on May 9, 2006. Petitioner is correct in that the three notices of reliance were indeed timely filed with the Board. We therefore vacate our earlier decision and issue the present decision in its place.

As grounds for cancellation, petitioner asserts: (i) that respondent fraudulently submitted a Statement of Use in order to induce the Trademark Examining Attorney to approve his mark for registration; (ii) that any use of respondent's mark prior to filing his Statement of Use was merely "token use" of the mark, and not in fact a *bona fide* use in the ordinary course of trade, making the registration void *ab initio*; and (iii) that respondent's nonuse of the mark for at least three years created a rebuttable presumption that respondent had abandoned his mark.

Respondent, in his answer, denies the salient allegations in the petition for cancellation.

The evidence of record includes: the pleadings; the file of respondent's registration sought to be cancelled, Registration No. 2780780; petitioner's Registration No. 2886508, respondent's responses to petitioner's first set of admissions to respondent,<sup>2</sup> the documents produced under respondent's responses to petitioner's first request for production of documents, including copies of two different versions of respondent's labels for **Chronic 187** soda,<sup>3</sup> and respondent's responses to petitioner's first set of interrogatories to respondent, all submitted by petitioner under a notice of reliance; and copies of relevant pages of the printed publication *Wheels Magazine: The Original Urban Automotive Magazine*, from years 2000, 2002, 2003, 2004 and 2005 submitted under respondent's notice of reliance.<sup>4</sup>

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<sup>2</sup> Including Response No. 1, wherein respondent admits each document that respondent has produced in discovery as authentic for purposes of admission into evidence during petitioner's testimony period. See Trademark Rule 2.120(j); TBMP § 704.10 (2d ed. rev 2004).

<sup>3</sup> Ordinarily, responses to document productions and documents produced in response to document productions may not be made of record pursuant to the notice of reliance procedure. However, in this case, because respondent has admitted that the documents produced in response to petitioner's document requests are authentic, such documents are in evidence. See TBMP § 704.11.

<sup>4</sup> As indicated in the Board's interlocutory decision of March 20, 2007, the declarations of Kevin Childs and James Tucker, filed by respondent under a notice of reliance on September 1, 2006, have not been considered inasmuch as petitioner never stipulated to the introduction of testimony in the form of affidavit or declaration.

## Standing

It is clear from the record that petitioner is engaged in the sale of fruit-flavored energy drinks in the United States under the mark **KRONIK** and respondent has admitted that petitioner owns a registration for the mark **KRONIK** for non-alcoholic beverages like soda and energy drinks. Thus, the record sufficiently shows that petitioner has a real interest in canceling respondent's registration of the **Chronic 187** mark. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). In fact, the entire record herein supports the proposition that petitioner has pleaded and demonstrated facts sufficient to show a personal interest in the outcome of the case, and hence its standing.

## Petitioner's burden of proof

Because respondent's certificate of registration is "*prima facie* evidence of the validity of the registration" and continued use of the registered mark, the burden of proof is placed upon Choice First Distribution, LLC, the petitioner who seeks cancellation herein. 15 U.S.C. § 1057(b) (1988); and *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 962-63, 144 USPQ 435, 437 (CCPA 1965). In any cancellation proceeding, the petitioner bears the burden of

proof by a preponderance of the evidence, whatever the alleged grounds for cancellation.

### **The evidence of record as to respondent's use on goods**

Respondent, John L. Brown, filed an application for trademark registration on June 10, 2002. The application shows that respondent was earlier operating another business out of this same address, EOEO Clothing. The record demonstrates that respondent's intentions were to sell a premium soft drink as a mixer for alcoholic cocktails.

During discovery, respondent produced documents purporting to show that he has used the applied-for mark on sodas continuously between 2000 and the point at which the record in the case closed. These are documents introduced at trial via notice of reliance which are the subject of the request for admission. Respondent claims that during the period focused on by petitioner (early 2000 to early 2004), he had regular, on-going sales of his **Chronic 187** sodas, that he did not fraudulently submit a Statement of Use, and that he has never had any intention of abandoning this mark. Accordingly, we turn to the evidence made a part of the record during the course of this proceeding.

### Invoices (2000 to 2003)

In response to petitioner's Request for Production, respondent submitted multiple, unnumbered, generic invoices for supplies allegedly shipped to him, as well as for beverages that were allegedly then shipped on to his customers. These generic invoices included only sketchy information about the nature of the items supplied to respondent, their quantities and pricing. In the case of invoices purporting to be from suppliers, not one contained a single identifier (e.g., name, address or telephone number) of the supplying company.

**INVOICE**

DATE	INVOICE#
1-8-06	

SHIP TO:  
CHRONIC 187

ITEM	QTY	DESCRIPTION
	24	DRANGE
	20	ENERGY

**INVOICE**

DATE	INVOICE#
8-10-00	

SHIP TO:  
John Brown  
CHRONIC 187

ITEM	QTY	DESCRIPTION
	11	ENERGY D
	10	ORANGE

**INVOICE**

DATE	INVOICE#
9-2-01	

SHIP TO:  
CHRONIC 187

ITEM	QTY	DESCRIPTION
	30	ORANGE
	10	ENERGY

**INVOICE**

DATE	INVOICE#
7-7-02	

SHIP TO:  
CHRONIC 187

ITEM	QTY	DESCRIPTION	RATE	AMOUNT
	10	ENERGY	24.00	240.00

PO#      TERMS      DUE DATE  
COD      COD

CASH PAID 240.00

**INVOICE**

DATE	INVOICE#
3-9-03	

SHIP TO:  
CHRONIC 197

ITEM	QTY	DESCRIPTION	RATE	AMOUNT
	18	ENERGY DRINK	24.00	432.00
	20	ORANGE	18.00	360.00

PO#      TERMS      DUE DATE  
COD      COD

CASH PAID 792.00

See Bates Nos. R00002, R00020, R00022, R00024 and R00026.

The information on his generic, unnumbered invoices about the purported customers ranged from single names ("Hopple," "Jerry" or "Smoke") to a descriptive designation ("New York store") to others having only the state in addition to a customer's name (e.g., "Joe Reed, Ohio.").

**INVOICE**

SOLD TO <i>HOPPLE</i>		SHIP TO			
ADDRESS		ADDRESS			
CITY, STATE, ZIP		CITY, STATE, ZIP			
CUSTOMER ORDER NO.	SOLD BY	TERMS	F.O.B.		
			DATE <i>1-22-02</i>		
ORDERED	SHIPPED	DESCRIPTION	PRICE	UNIT	AMOUNT
	<i>5</i>	<i>ORANGE</i>	<i>20<sup>00</sup></i>		<i>100</i>
	<i>5</i>	<i>ENERGY</i>	<i>27<sup>00</sup></i>		<i>135</i>

**INVOICE**

SOLD TO <i>JERRY</i>		SHIP TO			
ADDRESS		ADDRESS			
CITY, STATE, ZIP		CITY, STATE, ZIP			
CUSTOMER ORDER NO.	SOLD BY	TERMS	F.O.B.		
			DATE <i>8-30-00</i>		
ORDERED	SHIPPED	DESCRIPTION	PRICE	UNIT	AMOUNT
	<i>1</i>	<i>ENERGY</i>	<i>28<sup>00</sup></i>	<i>1</i>	<i>28<sup>00</sup></i>
	<i>2</i>	<i>ORANGE</i>	<i>20</i>	<i>2</i>	<i>40<sup>00</sup></i>

**INVOICE**

SOLD TO <i>JOE REED</i>		SHIP TO			
ADDRESS		ADDRESS			
CITY, STATE, ZIP <i>DND</i>		CITY, STATE, ZIP			
CUSTOMER ORDER NO.	SOLD BY	TERMS	F.O.B.		
			DATE <i>11-2-00</i>		
ORDERED	SHIPPED	DESCRIPTION	PRICE	UNIT	AMOUNT
	<i>10</i>	<i>ENERGY</i>	<i>24<sup>00</sup></i>		<i>240</i>
	<i>5</i>	<i>ORANGE</i>	<i>18<sup>00</sup></i>		<i>90</i>

**INVOICE**

SOLD TO <i>SMOKE</i>		SHIP TO			
ADDRESS		ADDRESS			
CITY, STATE, ZIP		CITY, STATE, ZIP			
CUSTOMER ORDER NO.	SOLD BY	TERMS	F.O.B.		
			DATE <i>7-15-02</i>		
ORDERED	SHIPPED	DESCRIPTION	PRICE	UNIT	AMOUNT
	<i>10</i>	<i>ENERGY</i>	<i>27<sup>00</sup></i>	<i>10</i>	<i>270<sup>00</sup></i>

**INVOICE**

SOLD TO <i>NEW YORK STORE</i>		SHIP TO			
ADDRESS		ADDRESS			
CITY, STATE, ZIP		CITY, STATE, ZIP			
CUSTOMER ORDER NO.	SOLD BY	TERMS	F.O.B.		
			DATE <i>3-20-03</i>		
ORDERED	SHIPPED	DESCRIPTION	PRICE	UNIT	AMOUNT
	<i>9</i>	<i>ORANGE</i>	<i>20<sup>00</sup></i>	<i>9</i>	<i>180<sup>00</sup></i>

Additionally, none of these purported invoices contains the designation **Chronic 187**. See Bates Nos. R00006, R00008, R00009, R00013 and R00014.

Inasmuch as respondent has made no claim that these invoices have been redacted to protect confidential information, and because these invoices are sparse, generic invoices, we find that these invoices allegedly representing transactions between January or February of 2000 and the end of calendar year 2003 are highly questionable.

### **Balance of the Record**

At a time when respondent was still represented by counsel, petitioner was clearly attacking the authenticity of the documents reviewed above, taking the position that these particular invoices that respondent produced during discovery were fabricated for the purposes of the present proceedings. In spite of petitioner's posture, respondent did not attempt to have representatives of any of these alleged suppliers, for example, corroborate the authenticity of this documentation to show that respondent had manufactured, ordered or purchased for retail distribution any sodas or energy drinks between the beginning of 2000 and the end of 2003.

We find in the context of the total record herein, that respondent's entire collection of bills and bank withdrawal forms, as well as the alleged customer invoices comprising respondent's evidence of sales of **Chronic 187** sodas from 2000 to late-2003 are suspicious at best. Respondent specifically denied engaging a bottling company from the years 2000 to 2003, and admits that he did not use a distribution company from 2000 to 2003.

Despite the rather large record created during the instant proceeding,<sup>5</sup> there is nothing else in the way of business records or testimony to convince us that during this critical period respondent actually had any *bona fide* use in the ordinary course of trade of the **Chronic 187** mark in connection with sodas or energy drinks.

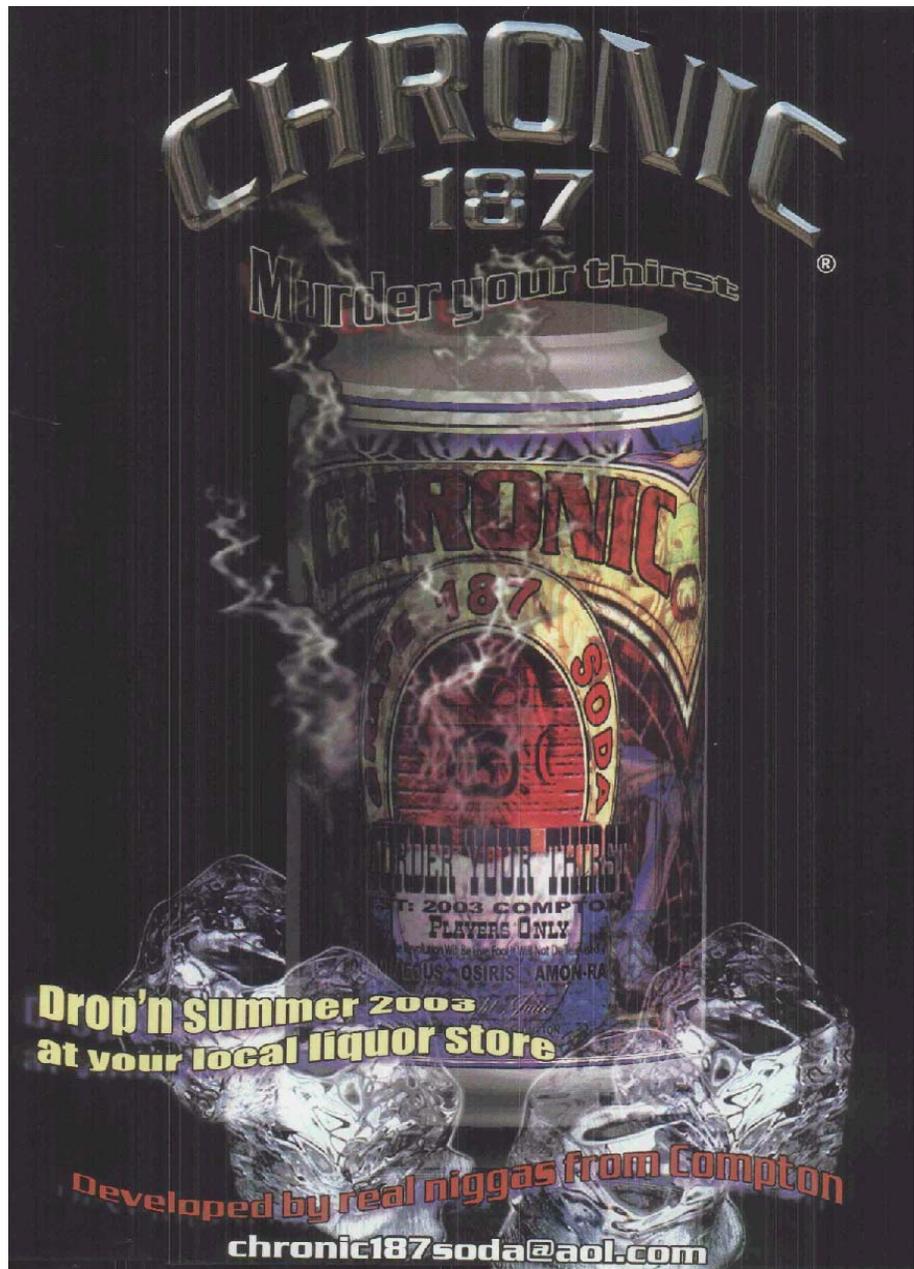
In July 2003, respondent submitted to the United States Patent and Trademark Office the following alleged specimen of use. This advertisement reflects respondent's most visible public exposure of the **CHRONIC 187** brand. The Trademark Examining Attorney apparently accepted the advertisement as a specimen of use for the involved Registration No. 2780780, for the goods identified in the

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<sup>5</sup> See footnotes 2 and 3 *supra*.

Notice of Allowance (i.e., sodas and energy drinks), because it has a picture of a soda container having the mark on it.

We note that the slogans on this print advertisement reflect the edgy, urban message that respondent has directed to the young, hip-hop crowd to whom he is targeting his beverages. However, inasmuch as the beverage was not yet

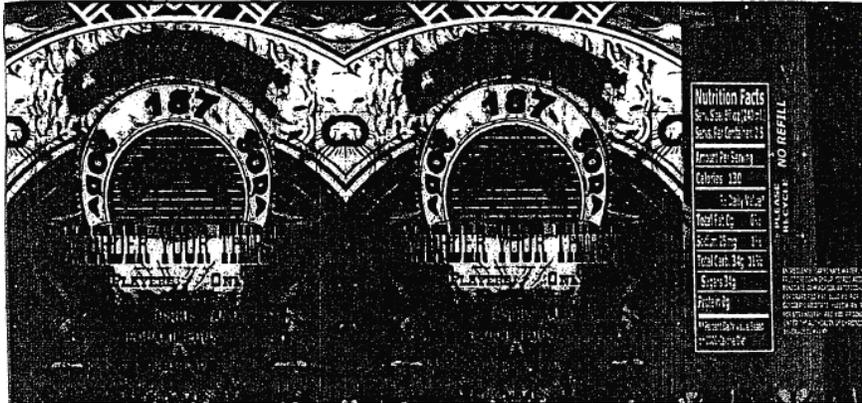


available to the public, this promotion was not actually focused on selling sodas, but was designed, at best, to create a "buzz" among the targeted demographic.

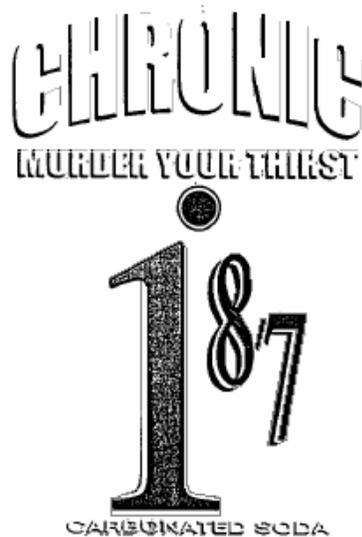
According to respondent's evidence from his notice of reliance, this advertisement appeared in at least two different editions of *Wheels Magazine* - a glossy magazine highlighting trick wheels for low-rider enthusiasts. See *Wheels 2000* (Issue #16) and *Wheels 2002* (Issue #17) <http://ttabvueint.uspto.gov/ttabvue/v?pno=92044116&pty=CAN&eno=20>.

As seen in somewhat squeezed lettering on the lower left-hand side of this specimen of record, respondent's advertisement in the *Wheels 2002* publications announced that his product would be "Drop'n Summer 2003 at your local liquor store." As petitioner asks in its brief at p. 12, "... if Respondent's Mark was continuously used on sodas and energy drinks beginning in February of 2000, then it is unclear as to why Respondent was publicly proclaiming that the product would not be available until the summer of 2003." Actually, we find no probative evidence in the record that respondent even met his target date of summer 2003 for getting his sodas into the local liquor stores.

The soda container pictured in this 2002-03 advertisement appears to have on it a label similar to the label respondent claims to have been using between 2000 and 2003 (see Bates No. R00003):



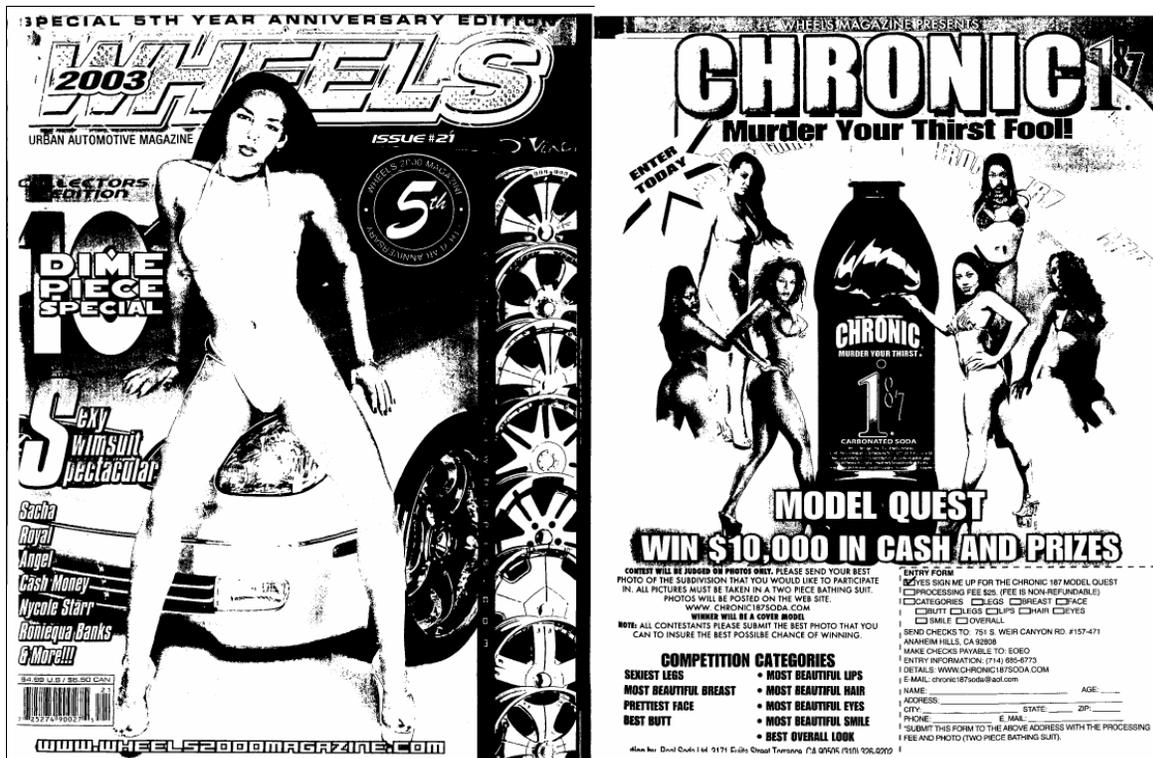
According to respondent's responses to petitioner's request for production of documents, respondent designed, adopted and put into circulation in 2004 and 2005 a new label for his bottles of soda (see Bates No. R00086).



This label was used on soda containers depicted in respondent's advertisements featured in at least three subsequent publications of *Wheels Magazine*: *Wheels 2003* (Issue #21), *Wheels 2004* (Issue #22) and *Wheels 2005* (Issue #30). Yet, according to the totality of this record, we are

not persuaded that at the time that *Wheels 2003* was published, that respondent had yet made any *bona fide* use of the mark on sodas in the ordinary course of trade.

Rather, in cooperation with the publisher of *Wheels* magazine, scantily-clad models were urged to submit photographs and a fee (e.g., checks payable to "EOEO") to compete for a chance to appear as "eye candy" on the cover of future editions of *Wheels Magazine*. Categories of the competition included "sexiest legs," "most beautiful breast[s]" and "best butt."



< <http://www.chronic187soda.com/chronicContestEntryForm.htm> >:

In addition to automotive services and pictures of "sexy girls," the magazine's list of advertisers included

entertainment companies, fashions such as hip-hop, urban and/or casual gear, swimwear, lingerie and a single listing for "Chronic Candy" (see *Wheels 2003*, *Wheels 2004* and *Wheels 2005*, pp. 21 - 32 of prosecution history entry #20).

Hence, the totality of the record - the purported business records, including questionable invoices, the content of the advertisements, combined with the later documents supporting commercial usage in late-2004 and 2005 - leads inexorably to several conclusions. First, that up until the time the record in this case closed, respondent had never sold commercial quantities of isotonic energy drinks. Second, respondent did actually manage to begin commercial shipments of his orange-flavored soda product in the summer or fall of 2004. This time-line is consistent with evidence that in February 2004 respondent ordered ten-thousand labels for his soda bottles (see Bates Nos. R00072 - R00075), that between March and June 2004 respondent ordered empty boxes and bottles from JANDR Bottling and Distributing, Inc. (see Bates Nos. R00027-30, R00032, R00033) and orange fruit flavoring from Essential Flavors and Fragrances, Inc. (see Bates No. R00067). At this time, he began issuing invoices pre-printed with "**CHRONIC 187 SODA**" and for the first time having complete customers' addresses, telephone numbers, etc. See Bates Nos. R00034 -

R00042 There are also in the record what appear to be internal business records ("CHRONIC 187 SODA CUSTOMERS") initiated for the first time in July and August of 2004 (see Bates Nos. R00077-83).

Later, in November 2004, respondent received two additional fruit flavorings (strawberry and grape, in addition to the earlier orange) from Essential Flavors and Fragrances, Inc. (see Bates Nos. R00031 and R00068), and twenty-one thousand additional bottle labels (see Bates No. R00076). While the record reveals none of the operational details of respondent's purchase and/or manufacture of these sodas, it does appear that by late 2004, respondent was selling directly to retailers cases of soda comprising twenty-four 12 oz. glass bottles for \$15 to \$18 per case. *Id.*

Invoices without the pre-printed header of "**CHRONIC 187 SODA**" reappeared in the time frame of March/April 2005. Some are undated and some are indecipherable. Nonetheless, unlike the earlier generic invoices that were unnumbered, respondent apparently issued thirty-two sequentially-numbered invoices (#341201 to #341232), for example, between March 15 and April 12, 2005. Some customers are listed with complete addresses and phone numbers, and other notations make these invoices appear to be of a type produced in the

normal course of operating such a business. Many of respondent's customers during this time-frame were receiving sodas of all three, newly-available soda flavors (see Bates Nos. R00043 - R00066).

Of course, while we conclude that by mid-2004 and 2005, respondent was actually marketing sodas, all of this activity was subsequent to July 9, 2003, the date respondent signed the allegation that his mark was being used on all the goods identified in the Notice of Allowance (i.e., sodas and energy drinks).

Petitioner correctly points out that "Use" as contemplated by section 45 of the Lanham Act requires more than mere token use. 15 U.S.C.S. § 1127.

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 chapter, 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 or their containers or the displays associated therewith or on the tags or labels affixed thereto, ... and (B) the goods are sold or transported in commerce ....

### **Conclusion as to use**

Based upon this record, we find that prior to the date respondent filed his Statement of Use, respondent had not made use in commerce as required by 15 U.S.C. § 1127. Trying to create a buzz, as seen in several issues of *Wheels*

*Magazine*, in the absence of a saleable product, does not suffice. Generic invoices from unnamed suppliers are not at all probative. Even if we conclude that respondent may have made a few token shipments to friends of prototype beverages having his mark on them, this level of activity (prior to July 2003) is certainly not sufficient to meet the standard of 15 U.S.C. § 1127. We find that because there was not use in commerce at the time respondent filed his Statement of Use, the resulting registration is void *ab initio*. 5 J. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 31:72 (4<sup>th</sup> Ed. 2005). Having found that respondent did not have use in commerce at the time respondent filed his Statement of Use, the petition to cancel this registration is granted.

### **Allegations of Fraud and Abandonment**

In light of this disposition, we need not reach the claims petitioner has raised about respondent's alleged fraud in the procurement of the registration or alleged abandonment of his mark.

*Decision:* The petition to cancel is granted.