

**THIS OPINION IS NOT A
PRECEDENT OF THE T.T.A.B.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Brad Frank
v.
This Way Up, L.L.C.

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Cancellation No. 92046007
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Robert Sperry, Esq. for Brad Frank.

Jonathan A. Bay, Esq. for This Way Up, L.L.C.

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Before Holtzman, Cataldo and Bergsman, Administrative
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

This Way Up, L.L.C. ("respondent") is the owner of Registration No. 2269641 for the mark BAND-BOX for "musical amusement machines which are similar to a juke box, namely, machines combining loudspeakers with miniature, automated, electro-mechanical musician figurines, and replacement parts therefore."¹

Brad Frank ("petitioner") filed a petition to cancel respondent's registration on the ground that the mark BAND-

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¹ Registration No. 2269641, issued August 10, 1999; Section 8 affidavit accepted.

BOX for a musical amusement machine similar to a juke box is a generic term. Respondent denied the salient allegation in the petition for cancellation.

Preliminary Issues

A. Issues to be decided.

During the prosecution of this cancellation proceeding, petitioner filed a motion for summary judgment arguing that respondent's mark is generic, that respondent wrongly obtained the registration through fraud, that respondent is not using the mark as shown in the subject registration, and that respondent is misusing the registration. In the March 19, 2007 Order denying the motion for summary judgment, the Board specifically noted that it would not consider unpleaded grounds. Despite this warning, petitioner failed to file a motion to amend its petition for cancellation, and, in his brief on the case, asserted the same unpleaded grounds. Respondent objected to petitioner's assertion of the unpleaded grounds.²

Because petitioner may not rely on unpleaded claims, we must determine whether petitioner's attempt to argue that respondent wrongly obtained the registration through fraud, that respondent is not using the mark as shown in the registration, and that respondent is misusing the registration were tried by implied consent.

² Respondent's Brief, p. 28.

Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue.

TBMP §507.03(b) (2nd ed. rev. 2004). *See also* Fed. R. Civ. P. 15(b). Because respondent lodged an objection to the unpleaded claims, they were not tried by implied consent. *Long John Silver's, Inc. v. Lou Scharf Inc.*, 213 USPQ 263, 266 n.6 (TTAB 1982).

In view of the foregoing, the only issue to be decided in this cancellation proceeding is whether the mark BAND-BOX used in connection with a musical amusement machine similar to a juke box is generic.

B. Evidentiary issues.

To support his claim that respondent's mark BAND-BOX is generic, petitioner submitted a notice of reliance with the following documents:³

1. Exhibits A - S appear to be excerpts from a website (marvin3m.com/arcade/bandbox.htm).
2. Exhibit T appears to be an email between petitioner and a potential customer.

³ Petitioner did not identify any of the documents. In addition, petitioner did not label many of the documents.

3. Exhibit U appears to be an advertisement for "Chicago Coin's Bandbox Puppets" from a third party in an unidentified source.
4. Exhibits V-Z are excerpts from the eBay website advertising "Band Box" devices.
5. Exhibit AA is a "cease and desist" letter from respondent to petitioner.
6. Exhibit BB appears to be an advertisement for respondent's product dated May 2006 from an unidentified source.
7. Exhibit CC appears to be a quote for an unidentified product by respondent.
8. There were two unlabeled third-party registrations on the Principal Register for the mark BAND BOX printed from the Trademark Office electronic database:
 - a. Registration No. 0743452 for "grooved phonograph records"; and,
 - b. Registration No. 0800703 for "accessory instruments for organ, namely, percussive instruments actuated by organ controls" (expired).

9. Exhibit 1F appears to be an email from petitioner to a potential vendor of parts.⁴

Respondent lodged objections to the admissibility of the documents in petitioner's notice of reliance on the grounds that the documents are not self-authenticating and, therefore, they are not properly admitted through a notice of reliance and that the documents are hearsay because petitioner is relying on them for the truth of the matter asserted therein. Petitioner did not address respondent's objections in its Reply Brief.

Trademark Rule 2.122(e) provides, so far as pertinent that "[p]rinted publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records . . . may be introduced in evidence by filing a notice of reliance on the material being offered." Only the two third-party trademark registrations (public records) fall within the category of documents that may be introduced into evidence by filing a notice of reliance. *See also Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998).

⁴ There were several other unlabeled documents that were cumulative or duplicates of other previously identified documents.

With the exception of the third-party trademark registrations, respondent's objection to the admissibility of the documents in petitioner's notice of reliance is sustained and the documents in the notice of reliance will be given no consideration.

Standing

"The facts regarding standing . . . are part of a petitioner's case and must be affirmatively proved. Accordingly, [petitioner] is not entitled to standing solely because of the allegations in its petition." *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Because the only evidence of record is two third-party trademark registrations, petitioner has failed to prove that it has standing to challenge the validity of respondent's registration.⁵

⁵ Petitioner submitted his declaration attesting to the fact that petitioner "has been in the business of reproducing and manufacturing parts for replicas of Chicago Coin Machine Co. 'Band-Box' machines" as an attachment to the petition for cancellation. However, exhibits attached to a pleading are not evidence on behalf of the party to whose pleading the exhibit is attached unless it is identified and introduced into evidence as an exhibit during the period of the taking of testimony. Trademark Rule 2.122(c). To the extent that we may treat petitioner's declaration as the operative petition for cancellation as we did in determining petitioner's motion for summary judgment, petitioner still failed to take any testimony or introduce any other evidence to prove its standing. Moreover, in this regard, we note that in the March 19, 2007 Order, the Board advised petitioner that the materials attached to the pleading would not be considered as evidence unless timely and properly introduced in evidence during petitioner's testimony period. See the March 19, 2007 Order, p. 4 n.3.

Genericness

The registration of respondent's mark on the Principal Register is *prima facie* evidence of the validity of that registration and that the mark identified in the registration is not generic. Accordingly, petitioner has the burden of proving that respondent's mark is invalid because it is generic. *Stocker v. General Conference Corp.*, 39 USPQ2d 1385, 1392 (TTAB 1996) ("the burden of proof rests squarely on petitioners who are asserting invalidity").

There is a two-part test used to determine whether a designation is generic: (1) what is the class of goods or services at issue? and (2) Does the relevant public understand the designation primarily to refer to that class of goods or services? *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986). The test turns upon the primary significance that the term would have to the relevant public. Our primary reviewing court has stated that a party asserting genericness must prove its claim by a preponderance of the evidence. Therefore, petitioner has the dual burden of overcoming the registration's validity and he must also prove by a preponderance of the evidence that the term BAND-BOX is used or understood by the relevant class of consumers primarily to refer to the class of goods

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with which the term is registered. *Stocker v. General Conference Corp.*, 39 USPQ2d at 1392.

Because the only admissible evidence petitioner introduced into the record were the two third-party trademark registrations, petitioner failed to meet its burden of proving that BAND-BOX is generic.

Decision: The petition for cancellation is dismissed with prejudice.