

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

Mailed: June 19, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

—————
Trademark Trial and Appeal Board

—————
Berta Hesen-Minten

v.

Emma Lee Petersen and Susan Lynn Aucoin

—————
Cancellation No. 92046025

—————
Julie K. Morriss of Morriss O'Bryant Compagni, P.C. for
Berta Hesen-Minten.

Emma Lee Petersen and Susan Lynn Aucoin, appearing *pro se*.

—————
Before Grendel, Rogers, and Wellington,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Berta Hesen-Minten, an individual, has petitioned to cancel a registration owned by Emma Lee Petersen and Susan Lynn Aucoin, individuals and joint-owners, for the mark THREAD BEARS ("BEARS" disclaimed) covering "dolls and soft sculpture figures made of textiles" in International Class 28.¹ The registration issued based on a claim of acquired

—————
¹ Registration 2146208 issued on March 24, 1998 to Our Secrets, Ltd., a New Mexico corporation. An assignment of the registration to Emma Lee Petersen and Susan Lynn Aucoin was recorded with the USPTO on April 10, 2003 (recorded at reel 2943, frame 0326).

distinctiveness under Section 2(f) of the Trademark Act. Petitioner's ground for cancellation is that respondents' mark has "always been generic for miniature bears made of thread" and, "to the extent that the [registered mark] might have ever been considered other than generic, the [registered mark] has now become generic through wide, non-exclusive and unpoliced use of the term "thread bears."²

In their answer, respondents admitted several allegations but denied the salient allegations regarding genericness of the mark. As to the allegations admitted, respondents admit that petitioner "is a designer and maker of miniature bears and other animals made out of thread and similar fiber materials" (Answer, para. 1); that petitioner "sells her miniature bears made from thread under the mark ThReAdTeDs (upper and lower case lettering used), which is the subject of pending [application] Serial No. 78573528, filed February 23, 2005" (Answer, para. 2); and that respondents filed a Section 15 declaration for the subject registration which was not approved by the USPTO, and that they have not re-filed a Section 15 declaration (Answer, paras. 7 and 8).

² Petitioner also states that the registered mark should be cancelled "under the equitable principles of laches, estoppel and acquiescence." The grounds for cancellation in a Board proceeding are limited solely to those based in the Trademark Act. See TBMP § 309.03 (2d ed. rev. 2004) and authorities cited therein. Equitable defenses are not grounds for cancellation.

The Record

By rule, the record consists of the pleadings and the file of the registration sought to be cancelled. Petitioner has filed several notices of reliance in order to introduce evidence and respondents filed a communication with attached materials during their testimony period. The timing and manner in which these submissions were filed requires some discussion.

On June 6, 2007, the Board issued an order that, *inter alia*, denied petitioner's summary judgment motion as untimely (it was filed during petitioner's testimony period) and rescheduled the remaining five days of petitioner's main trial period for June 25-29 of 2007. The first 25 days of the trial period had previously passed without any apparent action by petitioner. When the Board issued the June 6 order, petitioner's trial period was not then open and running. Following issuance of the Board's June 6 order, but well prior to the opening of its rescheduled testimony period, petitioner filed four notices of reliance on June 8, 2007.³ Thus, these were prematurely filed outside of petitioner's testimony period.

Trademark Rule 2.122(e) requires that notices of reliance be filed during the filing party's testimony

³ We note these notices of reliance are, in part, redundant inasmuch as petitioner identified the same materials or documents in more than one of the notices of reliance.

period. In addition, the Board expressly informed the parties in the June 6 order that "the summary judgment evidence may not form part of the evidentiary record to be considered at trial unless it is properly introduced during the appropriate testimony period. Evidence not obtained and filed in compliance with the rules of practice governing inter partes proceedings before the Board will not be considered." (Emphasis added here, citations to authorities were provided in order as well as an address for the USPTO's website where the rules are available.) Because petitioner did not heed our warning and filed the notices of reliance outside the testimony period, they have not been considered and the materials identified therein do not form part of the record.⁴

Even if we were to consider petitioner's notices of reliance as timely filed, we note that nearly all of the documents and materials identified in these notices of reliance are not of a type that may be introduced into evidence by notice of reliance alone. By way of her notices of reliance, petitioner submitted copies of three affidavits that were originally filed by petitioner on April 26, 2007 in support of her motion for summary judgment. In each

⁴ In one notice of reliance, petitioner identified materials from the subject registration file. These materials are unaffected because, as noted, the registration file forms part of the record by rule. Thus, no action by the parties was necessary to make any of its contents of record. Rule 1.122(e).

affidavit, the particular affiant identifies various materials (also submitted with the notice of reliance) that were collected by the affiant and that, for the most part, were obtained from websites or other internet postings.

Trademark Rule 2.122(e), 37 CFR §2.122(e), provides that a party may introduce into evidence through a notice of reliance "printed 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." Also, public records may be introduced through a notice of reliance. On the other hand, internet evidence such as website printouts, E-Bay auction website listings, chat room communication printouts, etc., are not self-authenticating and may not be introduced into evidence by way of a notice of reliance, even if identified in a supporting affidavit. TBMP § 704.08 (2d ed. rev. 2004) and authorities cited therein. Rather, the Board has held that internet evidence may only be introduced by proper testimony of the individual that conducted the search for the documents. See authorities collected in *Id.*; in particular, see *Raccioppi v. Apogee, Inc.*, 47 USPQ2d 1368 (TTAB 1998). In addition, declarations of individuals cannot be introduced by notice of reliance, in the absence of a stipulation of the parties allowing such submissions. See Trademark Rule 2.123(b). Testimony of

individuals otherwise is to be provided through testimony depositions. Trademark Rule 2.123(a). In view thereof, even if we were to consider petitioner's notices of reliance, the declarations and the associated materials submitted through these notices have not been properly submitted into evidence and, accordingly, would not have been accorded any probative value.

Aside from website materials, petitioner identified the following materials in her notices of reliance that she seeks to rely on: a copy of respondents' response (dated February 27, 2007) to petitioner's interrogatories;⁵ copies of excerpts from "Teddy Bear and Friends" (dated "December 2004" and "February 2005" on the covers); and a copy of the file for respondents' application Serial No. 78553324. Generally, these types of materials may be introduced by notice of reliance alone under Trademark Rules 2.120(j) [interrogatory answers] and 2.122(e) [printed publications and official records]. However, even if we were to consider these materials, they have very little probative value in this proceeding.

First, respondents' discovery response contains very little in substance and merely states that they've already

⁵ Petitioner characterizes the response as "respondents' answers to petitioner's interrogatories and requests for production of documents"; however, the response is a one page letter that only makes reference to petitioner's interrogatories with no mention of document production requests.

provided the information requested and as to "any information about Our Secrets, Ltd. business you [petitioner] will have to contact them about their products and how they produced them." The probative value and weight that we may accord the "Teddy Bear and Friends" publication evidence is unclear inasmuch as there is no evidence or testimony as to circulation or availability of this publication. In addition, there is no statement of relevance of the article excerpts in the notice of reliance. As to the file of respondent's application (which is not the subject of this proceeding), such applications are "generally of very limited probative value." TBMP § 704.03(b)(2) (2d ed. rev. 2004). The truth of any facts stated within the contents of the file are subject to proof in this proceeding. For example, to the extent the file includes a claim of acquired distinctiveness for the registered mark, the evidence of distinctiveness submitted to the examining attorney is not evidence in this proceeding. Likewise, any statements made by the Office employees regarding registrability are not probative on the question of registrability. The Board must make its own findings of fact, and that duty may not be delegated by adopting the conclusions reached by the Trademark Office examining operation. *In re Sunmarks, Inc.*, 32 USPQ2d 1470,

Opposition No. 92046025

1472 (TTAB 1994); *In re BankAmerica Corp.*, 231 USPQ 873, 876 (TTAB 1986).

During their testimony period, respondents filed a communication with the Board which begins "[t]his response is our testimony as to the matter of our trademark...not being a generic term." The communication is signed by both respondents and includes an unsigned certificate of service indicating a copy of the communication was mailed to petitioner's counsel. Attached thereto is a paper titled "List of Inclosed (sic) Documents" with copies of a variety of documents.

Respondents' submission and the exhibits thereto do not form part of the record. Respondents' signed statement is not proper trial testimony. Rule 2.123(a); see also TBMP § 703 (2d ed. rev. 2004) regarding trial testimony in general. To the extent that respondents' submission may be considered a notice of reliance for the documents attached thereto, we note that, as with petitioner's notices of reliance, a majority of the documents are internet printouts or email communications which have not been properly authenticated. Accordingly, these documents have not been considered. The other documents attached thereto are copies from the file of the subject registration which, as previously stated, are already of record by rule.

In view of the above, neither party has properly introduced any evidence and the record only consists of the pleadings and file of the subject registration. And, even if we were to consider petitioner's notices of reliance as timely filed, the only additional evidence which would be allowed into the record by way of these notices of reliance would be respondents' response to petitioner's interrogatories, the file of respondents' application Serial No. 78553324, and several pages from a "Teddy Bear and Friends" publication.

Only petitioner filed a trial brief.

Burden of Proof

Although respondents did not file a trial brief, we are cognizant of their position as defendants herein and that they are not required to file a brief. Their registration on the Principal Register of the mark THREAD BEARS is *prima facie* evidence of the validity of that registration, "and that includes the presumption that the mark subject thereof is not generic in relation to the goods [or services listed in the registration]". *Editorial America, S.A. v. Gruner & Jahr AG & Co.*, 213 USPQ 498, 504 (TTAB 1982); see also *Coca-Cola Co. v. Overland, Inc.* 692 F.2d 1250, 216 USPQ 579, 582 (9th Cir. 1982). Ultimately, it is petitioner who, as plaintiff, has the burden of establishing by a preponderance of the evidence her standing and her ground

for cancellation, namely, that the mark THREAD BEARS is generic, or that the mark has become generic. *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991).

Standing

Based on the previously noted admissions in respondents' answer, we find no issue as to petitioner's standing to bring this proceeding inasmuch as petitioner is a potential competitor of respondents in the same market for the goods identified in the registration. *Plyboo America, Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633 (TTAB 1999).

Genericness

The critical issue in determining genericness is whether members of the relevant public primarily use or understand the designation sought to be registered or that is already registered to refer to the genus or category of goods in question. *H. Marvin Ginn Corp. v. Int'l Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Making this determination "involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?" *Marvin Ginn, supra*, 228 USPQ at 530. The correct legal test for genericness, as set forth in *Marvin Ginn*, "requires evidence

of 'the genus of goods or services at issue' and the understanding by the general public that the mark refers primarily to 'that genus of goods or services'." *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999). That is, do the members of the relevant public understand or use the term sought to be protected to refer to the genus of the goods and/or services in question?

The genus or category of goods involved in this proceeding is that set forth in the subject registration's identification of goods. *Magic Wand, supra*, 19 USPQ2d at 1552. Again, the goods, as identified in the subject registration, are "dolls and soft sculpture figures made of textiles."

The next question we must address is whether the relevant purchasers for the registration's identified goods would understand THREAD BEARS to refer only to the genus.

"Evidence of purchaser understanding may come from direct testimony of consumers, consumer surveys, dictionary listings, as well as newspapers and other publications." *Magic Wand, supra*, 19 USPQ2d at 1553. See also *In re Merrill Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987), and *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985).

As already discussed, the record before us is limited to the pleadings and file of the subject registration. And, based on this record, we cannot conclude that petitioner has met her burden in establishing that the relevant purchasers of respondents' identified goods would understand THREAD BEARS as only referring to dolls and soft sculpture figures made of textiles. Even if we were to deem petitioner's notices of reliance as timely filed and consider the limited evidence that could permissibly be introduced via these notices of reliance, the additional evidence has such limited probative value that we would not change our conclusion.

Unpleaded Claim

In her trial brief, petitioner argues an unpleaded ground for cancellation, namely, that respondents' registered mark has not acquired distinctiveness and, therefore, registration of the mark is unsupportable. Brief, pp. 16-17. Petitioner may not rely on an unpleaded claim. See TBMP § 314 (2d ed. rev. 2004) ("Plaintiff's pleading must be amended (or deemed amended) pursuant to Fed. R. Civ. P. 15(a) or (b), to assert the matter.") In this proceeding, allowing an amendment (or deeming the complaint amended) would be pointless in view of the fact that the subject registration is over five years old. As such, any allegation that the registered mark has not

Opposition No. 92046025

acquired distinctiveness and is merely descriptive is not available as a ground for cancellation. See Section 14(1) of the Trademark Act, 15 U.S.C. §1064(1); see also TBMP § (2d ed. rev. 2004) regarding grounds available for Principal Register registrations over five years old.

DECISION: Petitioner's petition for cancellation of Registration No. 2146208 is denied.