

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

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

Faint

Mailed: June 9, 2008

Cancellation No. 92046172

Total Window, Inc.

v.

Arlee Home Fashions, Inc.

**Before Quinn, Rogers and Cataldo,
Administrative Trademark Judges.**

By the Board:

By its order of December 18, 2008 the Board deferred its ruling on petitioner's motion for summary judgment, and allowed petitioner time in which to file a supplemental brief on and support for its claim of priority of use of its mark. Respondent was allowed time in which to respond to petitioner's filing or to file a motion under Fed. R. Civ. P. 56(f). This case now comes up on petitioner's supplemental brief filed January 17, 2008. No responsive brief or motion from respondent appears to have been filed, as none is of record.

In its prior order the Board noted that there were no genuine issues of material fact as to the identical nature of the marks of petitioner and respondent, TOTAL WINDOW; as to petitioner's use of the mark at least in relation to

custom window treatments; and as to petitioner's commencement of use of the mark, at least as a trade name, in 1993, while respondent did not begin use of the mark on goods until November 2003. The Board also found that no genuine issue existed regarding whether petitioner's custom window treatments were similar or related to respondent's goods, and that the evidence attached to the motion for summary judgment clearly showed use of the mark for petitioner's asserted services.

The Board did find, however, that the issue of petitioner's priority of use of the mark needed to be examined more closely, in particular as to petitioner's use of the mark on goods. Petitioner does not own an existing registration for the mark TOTAL WINDOW, but alleged in its pleading that it commenced use of the mark TOTAL WINDOW on July 19, 1993 for both custom window treatments and various related goods.

A party seeking to cancel a registered mark may do so by claiming prior use of a mark pursuant to Section 14 of the Trademark Act, 15 U.S.C. § 1064. As we noted previously, where the party seeking to establish prior use is basing its claim on its common law rights, it may establish prior use through use analogous to trademark use. *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996). The prior use may, but need

not be, technical trademark use. Use analogous to trademark use "is non-technical use of a trademark in connection with the promotion or sale of a product under circumstances which do not provide a basis for an application to register, usually because the statutory requirement for use on or in connection with the sale of goods in commerce has not been met." *Shalom Children's Wear Inc. v. In-Wear A/S*, 26 USPQ2d 1516, 1519 (TTAB 1993).

While a presumption of validity attaches to respondent's registered mark, petitioner may rebut this presumption by proving its priority of use by a preponderance of the evidence. *West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1662 (Fed. Cir. 1994); *Martahus v. Video Duplication Services Inc.*, 3 F.3d 417, 421, 27 USPQ2d 1846, 1850 (Fed. Cir. 1993); *Cerveceria Centroamericana S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 1023, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989).

To support its contention that it has priority, petitioner attached additional evidence to its supplemental brief.¹ The declaration of Jesse Stolow, Marketing Director

¹ As we noted in our previous order, petitioner attached the declaration of Stephen Stolow, President of Total Window, Inc. to its motion for summary judgment. In that declaration petitioner stated that it "commenced use of the mark TOTAL WINDOW for custom window treatments, including blinds, shades, draperies, and shutters, and for services related to window treatment, in 1993."

of Total Window, Inc., states that "Total Window has used TOTAL WINDOW as a trademark, trade name and a service mark (collectively, 'mark'), continuously and without interruption, since at least as early as 1993 in connection with the custom manufacture of window treatments, blinds and shades and related products." Petitioner argues that this shows that it has used the mark as a trademark in connection with related products such as window coverings and window screens continuously and without interruption since 1993, and that petitioner has never abandoned or ceased using the TOTAL WINDOW mark.

Petitioner also provided evidence to show that its website has been in continuous use since January 25, 2002 to the present, and its annual reports, filed with the Florida Secretary of State, to show that its business has been existing and active since 1995 to the present.

Petitioner also attached purchase orders and a warranty to show use of the mark with goods, in addition to services. Petitioner argues that the purchase orders show use of the mark on goods because, "Exhibit H refers to the sale in September 1999 of a product identified as 'TOTAL WINDOW BLACKOUT: WHITE Clutch Roller Shade.' The use of the words 'TOTAL WINDOW' or 'TOTAL WINDOW BLACKOUT' (as an adjective) to modify the product item (noun), 'White Clutch Roller Shade' as a description of products sold on one of

Petitioner's own invoices very clearly indicate that TOTAL WINDOW is being used as a trademark to designate the origin of the goods."

The totality of this evidence has a cumulative effect establishing petitioner's claim of prior use. The items of evidence, taken together, show that petitioner has been using the mark on goods prior to the date of first use claimed by respondent, and that use has been continuous and uninterrupted. *West Florida Seafood*, 31 USPQ2d at 1663 ("whether a particular piece of evidence by itself establishes prior use is not necessarily dispositive. . . . one should look at the evidence as a whole, as if each piece of evidence were part of a puzzle, which, when fitted together, establishes prior use."). Further, petitioner's evidence is uncontroverted and has not been rebutted by respondent. After a careful review of the record in this case, we find that there are no genuine issues of material fact and that petitioner is entitled to judgment as a matter of law.

Accordingly, petitioner's motion for summary judgment is granted, judgment is entered against respondent, and Registration No. 2913716 will be cancelled in due course.
