

**THIS OPINION
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THE TTAB**

Mailed: October 30, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Get It In Writing Inc. (Arizona Corporation)
v.
IQ in Tech, Inc.
and
Get It In Writing, Inc. (Florida Corporation)¹

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Cancellation No. 92046274
to
Registration No. 3116100
—————

Daniel P. Keller, *Pro Se* as president and CEO of Get It In Writing Inc. (Arizona)

Daniel S. Polley, Esq. for IQ in Tech, Inc. and Get It In Writing, Inc. (Florida)

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Before Hairston, Walters and Bucher, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

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¹ In the Board's order of May 28, 2008, Get It In Writing, Inc. (Florida) was joined as a party respondent due to the assignment, after the commencement of this proceeding, of respondent IQ Tech's mark and registration to Get It In Writing, Inc. (Florida). While there are two respondents herein, the subject mark and registration have been owned by each party consecutively. Therefore, we refer to respondent in the singular form.

Get It In Writing Inc. (Arizona) filed a petition to cancel the registration of respondent IQ in Tech, Inc. ("IQ Tech") for the mark GET IT IN WRITING for "custom writing, text adaptation, proofreading and language interpreting." As grounds for cancellation, petitioner asserts that respondent's mark, when applied to respondent's services so resembles petitioner's previously used mark GET IT IN WRITING for custom writing services as to be likely to cause confusion, under Section 2(d) of the Trademark Act. Petitioner also asserts fraud as a ground for cancellation, alleging that respondent IQ Tech willfully made a materially false statement in its application declaration to the effect that its mark was in use in connection with "text adaptation" and "language interpreting" when, in fact, the mark was not in such use.

Respondent IQ Tech, in its answer, denied the salient allegations of the claims and asserted affirmatively that

it is the senior user of the mark² and that petitioner's claims are barred by estoppel and unclean hands.³

In an order dated May 28, 2008, the Board denied the parties' cross motions for summary judgment on petitioner's claims of priority and likelihood of confusion and on the above-noted basis for petitioner's claim of fraud.⁴ On June 27, 2008, the parties submitted a joint stipulation to "the pre-trial determination of this case on its merits by the Board's accelerated case resolution procedure." They further stipulated that "their cross motions for summary judgment shall be treated as the briefs herein and the evidence of record in such cross-motions for summary judgment shall be deemed properly of record for purposes of trial."

² Respondents' mark was registered on January 18, 2006, based on an application filed September 14, 2004. The date of first use and first use in commerce listed therein is August 1, 2002. In response to petitioner's interrogatories and in their cross motion for summary judgment, respondents assert a date of first use of the mark in connection with the identified services of September 4, 2001.

³ Respondent did not again raise the equitable issues of estoppel and unclean hands. Therefore, we consider these defenses to have been waived and we have not considered them.

⁴ Petitioner pleaded a second ground of fraud, alleging that prior to registration, respondent IQ Tech intentionally did not disclose material information about its knowledge of petitioner's senior use of the same mark for the same services. In its May 28, 2008 order, the Board granted respondent's motion for summary judgment on this particular ground of fraud.

Issues

The issues for final determination are whether petitioner has established its standing; whether petitioner has established its priority and that a likelihood of confusion exists; and whether petitioner has established its allegation that, at the time of filing its application, respondent IQ Tech was not using its mark in connection with all of the services identified therein and, if not, whether it knew or should have known of this non-use, and, if so, whether this constitutes fraud.

While the record herein is the same record submitted in connection with the parties' cross motions for summary judgment, the standard for the Board's final determination is different from the standard for a determination upon summary judgment. In connection therewith, we found that there were genuine issues of material fact in dispute and, thus, the case could not be resolved as a matter of law. Fed. R. Civ. P. 56(c). In so concluding, we did not resolve issues of material fact; rather we viewed the evidence in a light most favorable to the respective non-movants and drew all justifiable inferences in the non-movant's favor with respect to each cross motion.

In issuing its decision herein, the Board has considered the same record and made both findings of fact

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and a final determination. We have considered whether petitioner established its case by a preponderance of the evidence. *Hydro-Dynamics Inc. v. George Putnam & Company Inc.*, 811 F.2d 1470, 1 USPQ2d 1772 (Fed. Cir. 1987). To the extent that respondent has claimed a first use date earlier than the date listed in its registration, we have considered whether respondent established the earlier use date by clear and convincing evidence. See *Martahus v. Video Duplication Services Inc.*, 3 F3d 417, 27 USPQ2d 1846 (Fed. Cir. 1993) and cases cited therein.

The Record

We note that, in connection with its motion for summary judgment, petitioner objected to consideration of the two third-party declarations submitted by respondent. Although evidentiary objections may be permitted in a case submitted for Accelerated Case Resolution, in the case before us, the parties have stipulated that "the evidence of record in such cross-motions for summary judgment shall be deemed properly of record," and this includes the two client declarations. Therefore, we have considered the two client declarations to be properly in the record for this final decision and we have accorded them whatever probative value they warrant.

Additionally, we note that both parties have submitted declarations by their principals in support of their respective dates of first use. While, as we stated in our denial of summary judgment, these declarations are self-serving, we accept these declarations for whatever probative value they may have.

Therefore, the record consists of the pleadings; the file of the involved registrations; the declaration of respondent's principal, Allison Nazarian, with several exhibits, the declarations of two clients, and copies of print and website articles written by Daniel Keller, all submitted by respondent; and the declaration of petitioner's principal, Daniel Keller, with several exhibits, a copy of petitioner's 2002 sole proprietor tax filing, and an excerpt from petitioner's website containing a list of clients, all submitted by petitioner.

Factual Findings

1. Petitioner

Petitioner's president and CEO, Daniel Keller, began using the mark GET IT IN WRITING in California as an individual and sole proprietor on April 30, 2002 (motion for summary judgment "MSJ" Exh. A, Keller Decl.). Mr. Keller filed a 2002 Schedule C tax form identifying his principal business as "public relations" and his "dba" as

"GET IT IN WRITING" (MSJ Exh. 1). Mr. Keller moved his GET IT IN WRITING business from California to Arizona and, on March 4, 2004, incorporated and transferred all of his business assets, including the mark, to petitioner herein (MSJ Exh. A). Petitioner operated a website, www.Get-It-In-Writing.net, beginning in April 2002, and promoted petitioner's services thereon (id.); on June 14, 2004, petitioner transferred its website to www.GetItInWriting.net (id.); and this later domain name was created on July 15, 2002 (MSJ Exh. 5). Petitioner has copies of invoices from itself to third parties - an invoice dated June 14, 2002, for services specifically identified as "product sheet - sounding board" and "presentation script - anima speakers" (MSJ Exh. 6) and an invoice dated July 22, 2002, for services specifically identified as "on tour with Shure Weezer interview." Petitioner's use of its mark since its first use has been continuous (MSJ Exh. A). In a March 21, 2007 excerpt from petitioner's website, petitioner identifies numerous prior and existing projects, which involve writing for third parties, and clients (MSJ Exh. 8). In this website excerpt, petitioner also includes the following promotional statements:

Offering Public Relations and Marketing
Communications Services to the Professional
Music, Audio, Video and Multimedia Industries ...

We can help you get your message across and
increase product and brand visibility by
providing:
Marketing and Promotional Copy, Ad Copy ..., Press
Releases, Articles and Interviews, ... White Papers
and Case Studies, Product Manuals.

Contact
Want to Get It In Writing?
Please call or email us for a quote on your next
project.

Daniel Keller wrote numerous articles that appear both
in print and online during the period from at least January
2002 to December 2008. Several of these articles identify
Mr. Keller as the author and as "a writer and independent
producer and engineer." None of these articles contain any
reference to petitioner, Get It In Writing, Inc. (Arizona).

On January 8, 2007, petitioner filed application
Serial No. 77078350 (MSJ Exh. 12) under Section 1(a) to
register the standard character mark GET IT IN WRITING for
"custom writing services." The application has been
suspended pending the outcome of this proceeding.⁵

⁵ On July 16, 2005, petitioner filed application Serial No. 78671862
(MSJ Exh. 10) under Section 1(b) to register the standard character
mark GET IT IN WRITING for "custom writing services." The application
was abandoned on March 2, 2007, for failure to respond to an office
action.

2. *Respondent*

Allison Nazarian registered the domain name GetItInWriting.biz on March 16, 2003 (MSJ Petitioner's Reply Exh. 1). Ms. Nazarian is an officer of respondent IQ Tech and president of respondent Get It In Writing (Florida) (MSJ Respondent's Response "Resp." Exh. 1 - Declaration of Ms. Nazarian). Ms. Nazarian began offering writing services under her individual name and "Get It Write" in approximately 1995 (id. and MSJ Resp. Exh. B). Respondent has a copy of an invoice to a third party, dated March 31, 1996, in the name of "Get It Write" for services identified as "essay writing, editing, typing" (MSJ Resp. Exh. A). Respondent has distributed a promotional sheet identifying its writing services company as Get It In Writing Inc. (MSJ Resp. Exh. E) since at least as early as January 2005 (MSJ Resp. Exh. 1).

In April 2003, Ms. Nazarian registered Get It In Writing as a fictitious name of IQ Tech (MSJ Resp., Exh. 1). In 2007, the Florida Division of Corporations listed IQ TECH as a corporation for which Ms. Nazarian was the registered agent and officer, with annual reports filed in 2003 through 2007 and a "domestic profit" reported for 2002 (MSJ, Exh. 14, respondent's discovery responses). Also in 2007, the Florida Division of Corporations listed Get It In

Writing, Inc. (Florida) as a corporation for which Ms. Nazarian was the registered agent and officer, with annual reports filed in 2005 through 2007 and a "domestic profit" reported for 2004 (MSJ, Exh. 14). On December 20, 2004, Get It In Writing, Inc. (Florida) was incorporated (MSJ Resp., Exh. 1).

Clients of respondent's writing services under the mark GET IT IN WRITING are primarily businesses, including, Cleveland Clinic Florida, Office Depot, American Bancard, Arizona State University and Worldwide Financial (id.). Respondent promotes its services through its website, www.getitinwriting.biz, its blog, www.getitinwriting.biz/blog/, in local and online directories, magazines, and through conducting seminars and distributing electronic newsletters (id. and MSJ, Exh. 14). Ms. Nazarian also attends trade shows and networking events on respondent's behalf (id.). Respondent does not license its mark to others (MSJ, Exh. 14, Interrogatory Response No. 19).

Analysis

A. Standing

Because petitioner has properly submitted evidence of its use of the mark GET IT IN WRITING in connection with custom writing services, and because petitioner has a

pending application for the same that is suspended, we find that petitioner has established its standing in this cancellation proceeding. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

B. *Priority and Likelihood of Confusion*

The record clearly establishes that "custom writing services" encompass preparing text and written materials for marketing, communications and sales purposes (MSJ Resp. Exh. 1); that "marketing and promotional services" utilize custom writing services (MSJ Exh. 8); and that both parties' services include custom writing services in the context of business marketing and promotion. Thus, there is no question that the parties' marks, GET IT IN WRITING, and their custom writing services are identical. There is no need to further consider respondent's other identified services in this context. Thus, the resolution of this claim turns on which party can demonstrate priority of the mark GET IT IN WRITING in connection with "custom writing services."

Petitioner has established April 2002 as its date of first use by a preponderance of the evidence. Mr. Keller's statement in his declaration that petitioner first used the

mark GET IT IN WRITING in connection with custom writing services in April 2002 is further supported by petitioner's additional evidence. Moreover, the fact that Mr. Keller may have written articles under his own name rather than under petitioner's corporate name, does not contradict his statement that petitioner first used the mark GET IT IN WRITING for custom writing services in April 2002.

As previously noted, respondent supports its claim of use as of September 4, 2001 with a statement in the declaration of respondent's principal, Allison Nazarian, and statements in the declarations of two clients. The evidence submitted in addition to these declarations, including the evidence regarding both respondents' corporate status and annual reports, does not support these individual's statements of use in 2001 of GET IT IN WRITING by respondent in connection with custom writing services. We find it odd that, while respondent retained and submitted an invoice showing use of its earlier mark, GET IT WRITE, for custom writing services in 1996, it submitted no invoices for its services rendered under its current mark, GET IT IN WRITING. Moreover, Ms. Nazarian did not register GET IT IN WRITING as a fictitious name until 2003 and did not incorporate in this name until 2004. The Florida Division of Corporation reports show business

activity under either the fictitious name or corporate name only as far back as 2002; and respondent's domain name has been registered only since 2003. Respondent's promotional sheet in the record has been in use only since 2005.

It is very possible that the two clients whose declarations are in the record may be mistaken about exactly when they remember Ms. Nazarian first identifying herself as GET IT IN WRITING, particularly in view of the similarities between GET IT IN WRITING and Ms. Nazarian's earlier mark, GET IT WRITE, and the fact that the first use date originally claimed by respondent, August 1, 2002, and the earlier first use date respondent asserts in this proceeding, September 4, 2001, are similarly situated in the past, i.e., approximately a year apart in the late summer. Therefore, in the absence of any independent evidence, such as invoices or promotional materials evidencing dates of origin, to corroborate the first use assertions of Ms. Nazarian and her two clients, we conclude that respondent has not met its burden of establishing by clear and convincing evidence a first use date of its mark in connection with custom writing services as early as September 4, 2001.

Thus, petitioner has established its priority in this case. We conclude that in view of the identity of the

marks, their contemporaneous use on the same custom writing services involved in this case is likely to cause confusion as to the source or sponsorship of such services.

Fraud

The question herein is whether petitioner has established that, at the time of filing its application, respondent IQ Tech was not using its mark in connection with "text adaptation services" and/or "language adaptation services," and, if not, whether respondent knew or should have known of this non-use. As noted by the Board in its order of December 5, 2006, fraud may lie where a registrant knew or should have known that its mark was not in use on all of the goods and/or services recited in a use-based application when it filed that application. See *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986); and *Medinol Ltd. v. Neuro Vasx Inc.*, 67 USPQ2d 1205 (TTAB 2003).

Fraud must be proven with clear and convincing evidence, and any doubt must be resolved against a finding of fraud. *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 962 (TTAB 1986) and cases cited therein. Furthermore, fraud will not lie if it can be proven that the statement, though false, was made with a reasonable and honest belief that it was true. See

Woodstock's Enterprises Inc. (California) v. Woodstock's Enterprises Inc. (Oregon), 43 USPQ2d 1440 (TTAB 1997).

Respondent contends that "text adaptation" and "language adaptation" services are encompassed within "custom writing services" and, moreover, that, as specifically defined, respondent renders these services and has done so since prior to the filing date of its application. In her declaration, Ms. Nazarian described "text adaptation" services as "taking pre-written text supplied by clients and adapting it to fit new formats (e.g., print to web, book to letter, electronic to print, audio to written, etc.)" and "language adaptation" services as "taking or translating foreign language marketing/sales materials into English for business and business owners and vice versa. I speak Hebrew fluently ... [and] include[ing] ... working with a [UK] business to 'translate' documents from UK English to American English." (MSJ Resp., Exh. 1.)

Without offering different definitions of these services, petitioner merely disagrees with Ms. Nazarian's characterization of these services and argues that these services must be different from custom writing services or respondent would not have listed them separately in the identification of services. We do not find this reasoning convincing. Petitioner has provided no evidence that these terms are not defined as indicated by Ms. Nazarian.

Moreover, Ms. Nazarian's definitions of these services are not inconsistent with the likely ordinary meanings of the individual terms "text adaptation" and "language adaptation." Further, petitioner has not provided any evidence indicating that respondent has not used its mark GET IT IN WRITING in connection with these services prior to the September 14, 2004, filing date of the application.

Therefore, we conclude that petitioner has not met its burden of proof in establishing its claim of fraud.

Decision: The petition to cancel is granted with respect to petitioner's claim of priority and likelihood of confusion, and denied with respect to petitioner's claim of fraud. The registration will be cancelled in due course.