

2017 WL 3718281 (Trademark Tr. & App. Bd.)

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Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

MAJOR LEAGUE BASEBALL PROPERTIES, INC.

v.

CHRISTOPHER WEBB

Cancellation No. 92060903

July 26, 2017

\*1 Before Richey, Deputy Chief Administrative Trademark Judge, Mermelstein, and Shaw  
Administrative Trademark Judges

**By the Board:**

On February 19, 2015, Major League Baseball Properties, Inc. (“Petitioner”) filed a petition for cancellation of the following registered word and design mark



for “clothing, namely, short and long sleeve t-shirts, sweatshirts, jackets, baseball hats, and beanies” in International Class 25.<sup>1</sup> In its amended petition, filed October 5, 2016, Petitioner claims the following grounds for cancellation: (1) lack of bona fide use in commerce; (2) fraud; (3) likelihood of confusion; and (4) dilution by blurring.<sup>2</sup>

Respondent denied the salient allegations in the amended petition.

This case now comes before the Board for consideration of Petitioner's motion (filed March 9, 2017) for partial summary judgment on the grounds of lack of bona fide use and fraud. The motion is fully briefed.

**The Pleadings**

As an initial matter, a decision on summary judgment necessarily requires a review of the operative pleadings to determine the legal sufficiency of the asserted claims. See *Fed. R. Civ. P. 56(a)*; *Asian & Western Classics B.V. v. Lynne Selkow*, 92 USPQ2d 1478, 1478 (TTAB 2009). Upon review of the amended petition for cancellation, we find that the amended pleading is legally sufficient to the extent that it contains allegations which, if proven, would establish the claims pursued in the motion for partial summary judgment, namely, lack of bona fide use and fraud. In addition, we find that the allegations in the amended petition for cancellation are sufficient to support Petitioner's asserted claims of likelihood of confusion and dilution by blurring.

### **Standing**

Standing is a threshold issue that must be pleaded and proven by the plaintiff in every *inter partes* case. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015); *Ritchie v. Simpson*, 171 F.3d. 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999); see also *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1037 (TTAB 2007).

Here, Petitioner has asserted a *prima facie* claim of likelihood of confusion based on prior use in commerce and ownership of existing registrations. In addition, Petitioner has introduced status and title copies of pleaded registrations with its motion. Thus, Petitioner has demonstrated a belief in likely damage by establishing a direct commercial interest in the proceeding and, therefore, has established its standing to maintain the proceeding. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Research in Motion Ltd. v. Defining Presence Mktg. Grp. Inc.*, 102 USPQ2d 1187, 1190 (TTAB 2012) (standing established by pleaded registrations of record). Moreover, once standing is established as to one ground, the Petitioner may pursue any legally sufficient claim which negates Respondent's right to the subject registration. *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2024 (Fed. Cir. 1987); see also *Corporacion Habanos SA v. Rodriguez*, 99 USPQ2d 1873, 1877 (TTAB 2011) (because petitioners alleged standing as to at least one ground, they may assert any other legally sufficient claims).

### **The Record**

\*2 For purposes of the summary judgment motion, the evidentiary record includes the pleadings and, by rule, the file of the involved registration. *Trademark Rule 2.122(b)*. In support of the claims in its motion for partial summary judgment, Petitioner introduced Respondent's written responses to Petitioner's first set of requests for production<sup>3</sup> and first set of interrogatories along with the declaration of Petitioner's counsel.<sup>4</sup> In addition, Petitioner submitted an article published in *Bloomberg Businessweek* regarding the sales of a San Francisco T-shirt maker.<sup>5</sup>

In response to the motion, Respondent submitted a declaration in which he testifies that he was not aware that the mark must be used on all of the goods in the application at the time of filing the amendment to allege use. In addition, Respondent has introduced documents as evidence of sales of his products.<sup>6</sup>

### **Summary Judgment**

We turn next to the merits of Petitioner's motion for summary judgment. Petitioner argues that based on Respondent's responses to Petitioner's interrogatories and requests for production, Respondent has not used its mark on or in connection with "sweatshirts, jackets, baseball hats, and beanies." In addition, because Respondent has only sold a total of thirty-three T-shirts (short and long-sleeve) since he began selling the goods in 2012, Petitioner contends that Respondent's use of the mark is not "typical use" in the T-shirt industry and is insufficient to constitute bona fide use of the mark in the ordinary course of trade for purposes of trademark registration.

With respect to the fraud claim, Petitioner argues that given the small number of sales of Respondent's products, he "must have known exactly what goods he had sold (and not sold) at the time he signed his Amendment to Allege use." 23 TTABVUE

17. Thus, according to Petitioner, Respondent knowingly made a false representation of a material fact when he averred in his amendment to allege use that he was using the mark in connection with all of the goods in the application. Petitioner further argues that Respondent made the misrepresentation with the specific intent to induce the USPTO into approving his application for registration.

In response to the motion, Respondent argues that his discovery responses alone are insufficient to conclude that there is no genuine dispute of material fact that he did not use his mark on the majority of the goods in the application because he reserved the right to amend his responses to include additional discovery responses in the event that such information was uncovered.<sup>7</sup>

With respect to the fraud claim, Respondent argues that, unlike the case cited by Petitioner in its motion, Respondent never testified orally or attested in writing regarding his knowledge of the verification in the document he signed. Thus, according to Respondent, there is insufficient evidence that he knowingly misrepresented facts or that he intended to deceive the USPTO.

\*3 In its reply in support of the summary judgment motion, Petitioner argues that despite Respondent's statement that he may amend his responses to include additional information or documentary evidence, Respondent has failed to cite to or provide any evidence showing use of his mark on any of the goods in the application other than T-shirts. Petitioner further argues that there is no factual dispute regarding Respondent's level of use in commerce on T-shirts; thus the Board should conclude that, in view of his *de minimus* sales, Respondent has not made bona fide use in connection with T-shirts.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to any material facts and the moving party is entitled to judgment as a matter of law. *Fed. R. Civ. P. 56(a)*. In reviewing a motion for summary judgment, the evidentiary record and all justifiable inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the non-moving party. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029-30 (Fed. Cir. 1993); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1546 (Fed. Cir. 1992). In addition, the Board may not resolve disputes of material fact; it may only ascertain whether a genuine dispute regarding a material fact exists. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1544.

A party moving for summary judgment has the burden of demonstrating a particular fact cannot be disputed by citing to particular parts of materials in the record, including affidavits or declarations, admissions or interrogatory answers; or showing that the cited materials do not establish the absence or presence of a genuine dispute, or that the adverse party cannot produce admissible evidence to support the fact. *Fed. R. Civ. P. 56(c)(1)*. *See generally Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). When the moving party has supported its motion with sufficient evidence that, if unopposed, indicates there is no genuine dispute of material fact, the burden of production shifts to the non-moving party to demonstrate the existence of a genuine dispute of material fact to be resolved at trial. *Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1540 (TTAB 2009).

#### A. No Bona Fide Use in Commerce

We first consider Petitioner's argument that Respondent's registration is void *ab initio* because, based on Respondent's discovery responses, Respondent has not used the mark in commerce in connection with “sweatshirts, jackets, baseball hats, and beanies.” Petitioner relies on Respondent's responses to several discovery requests as evidence of Respondent's lack of bona fide use of the mark in commerce. The relevant portions of the the specific discovery requests and responses are set forth below:

##### *Interrogatory No. 5*

\*4 State whether Registrant has made use of any marks comprising or containing any of Registrant's Marks ... in the United States or in commerce as of the present date, and if so, identify each product or service on or in connection with which Registrant (or any person or entity authorized by Registrant) has made such use.

Respondent's response: "Christopher Webb has used the MAJOR LEAGUE ZOMBIE HUNTER trademark in connection with the following goods: T-shirts - short sleeve and T-shirts - long sleeve."<sup>8</sup>

*Interrogatory No. 6(d)*

For each of Registrant's products identified in response to Interrogatory No. 5, identify the annual volume of sales for each year to the present, both by dollar amounts and unit amount, for each of Registrant's products/services.

Respondent's response: "2012: \$699.60 - 23 shirts, 2013: \$141.70 - 5 shirts, 2014: \$82.75 - 5 shirts."<sup>9</sup>

In addition, Petitioner's counsel averred that in response to a request for documents evidencing use of Respondent's mark in connection with each of the identified goods in the application at the time Respondent filed his amendment to allege use, Respondent only produced documents that showed use of his mark in connection with T-shirts and did not produce any documents indicating use in connection with the other identified goods in the registration.<sup>10</sup>

Based on the foregoing, we find that Petitioner has met its burden of demonstrating that there is no genuine dispute of material fact that Respondent was not using the mark in commerce in connection with "sweatshirts, jackets, baseball hats, and beanies" prior to filing his amendment to allege use. *See* Trademark Act Section 1(a), 15 U.S.C. § 1051(a).

Respondent, on the other hand, does not argue that he actually used the mark in connection with any of the goods other than T-shirts prior to the filing date of his amendment to allege use.<sup>11</sup> Respondent merely contends that the discovery responses do not prove that he "may not have uncovered information or documentary evidence of other uses or sales with the remaining goods"<sup>12</sup> because Respondent reserved the right to amend his responses in the event additional information is uncovered.

Timely supplementation of discovery responses under Fed. R. Civ. P. 26(e) is the duty of the responding party. It is not a right that the responding party may reserve until trial. *See* TBMP § 408.03 (June 2017); *see, e.g., Galaxy Metal Gear Inc. v. Direct Access Tech. Inc.*, 91 USPQ2d 1859, 1861 (TTAB 2009) (Rule 26(e) is not an invitation to hold back material items and disclose them at the last minute). Further, to the extent that documentary evidence exists with respect to Respondent's use on goods other than shirts, Respondent must produce such evidence in response to the motion for summary judgment in order to demonstrate that a genuine dispute remains. Fed. R. Civ. P. 56(c)(1); *see also Venture Out Props. LLC v. Wynn Resort Holdings LLC*, 81 USPQ2d 1887, 1890 (TTAB 2007) ("The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial."). The mere possibility that Respondent might at some unspecified time uncover further evidence of his own use is insufficient to avoid summary judgment.

\*5 In this case, Respondent has failed to produce any evidence in response to the motion for summary judgment that would raise a genuine dispute of material fact regarding his use of the mark on sweatshirts, jackets, baseball hats, and beanies.

In view of the foregoing, Petitioner's motion for partial summary judgment is **GRANTED** with respect to the asserted claim of lack of bona fide use in commerce in connection with the aforementioned goods.

B. Bona Fide Use with T-Shirts

With regard to the remaining goods in the registration, namely, "short and long sleeve T-shirts," there is no factual dispute between the parties regarding Respondent's volume of T-shirt sales (28 T-shirts between 2012 and 2013) bearing the involved mark.<sup>13</sup> Thus, according to Petitioner, the only disagreement between the parties is "a question of law," namely, whether Respondent's

*de minimus* use constitutes bona fide use in commerce. Petitioner argues that Respondent's "miniscule amount"<sup>14</sup> of sales is not typical for the apparel industry and is insufficient to constitute bona fide use for purposes of trademark registration. Although Petitioner characterizes what we must resolve on summary judgment as a question of law, Petitioner's argument makes clear that the question is factual in nature, i.e., whether Respondent's level of sales amounts to the typical level of sales that we would expect to see from a T-shirt merchant.

Under the Trademark Law Revision Act of 1988 ("TLRA"), Congress amended the definition of "use in commerce" to add the wording "bona fide use of a mark in the ordinary course of trade, and not merely to reserve a right in a mark."<sup>15</sup> Trademark Act Section 45, 15 U.S.C. § 1127. This language was intended to eliminate "token uses," which occur when applicants use a mark for the sole purpose of obtaining a registration with no intention of legitimate use in commerce until a later date. *Aycock Eng'g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 90 USPQ2d 1301, 1306 (Fed. Cir. 2009). The report of the House Judiciary Committee on the TLRA stated that "'the ordinary course of trade' varies from industry to industry." H.R. Rep. No. 100-1028, at 15 (1988); see also Senate Judiciary Committee Report, S. Rep. No. 100-515, at 44-45 (1988) ("The committee intends that the revised definition of 'use in commerce' be interpreted to mean commercial use which is typical in a particular industry.")

In support of its argument that Respondent's volume of use is not typical in the ordinary course of the T-shirt trade, Petitioner has submitted a single article from an online business magazine about the business practices of "one of the top T-shirt sellers in the U.S."<sup>16</sup> We find the evidence regarding the extraordinary success of a single entity in the industry insufficient to demonstrate what is typical in "the ordinary course of trade" in the field of retail T-shirt sales. Cf. *Automedx Inc. v. Artivent Corp.*, 95 USPQ2d 1976, 1981 (TTAB 2010) (Board considered testimony evidence that sale of demonstration unit constitutes sale in the ordinary course of trade).<sup>17</sup>

\*6 Based upon the record herein and the applicable law, we find that Petitioner has failed to carry its burden of showing that there is no genuine dispute of material fact that Respondent's sales volume and manner of use of its mark in commerce on T-shirts does not rise to the level of bona fide use of the mark in the ordinary course of trade in the T-shirt industry and that such use is merely for the purpose of reserving a right in his mark. Accordingly, Petitioner's motion for partial summary judgment on the asserted claim of lack of bona fide use on short and long sleeve T-shirts is **DENIED**.

### C. Fraud

We turn next to Petitioner's asserted claim that Respondent committed fraud by falsely representing in his amendment to allege use that his mark was in use in commerce on all of the goods in the application. Fraud in procuring or maintaining a trademark registration may occur when an applicant for registration or a registrant in a declaration of use knowingly makes specific false, material representations of fact in connection with an application to register or in a post-registration filing with the intent of obtaining or maintaining a registration to which it otherwise is not entitled. See *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1942 (Fed. Cir. 2009). The evidence of deceptive intent must be clear and convincing. *Id.* at 1941 (citing *Star Sci., Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.2d 1357, 1366, 88 USPQ2d 1001, 1007 (Fed. Cir. 2008)).

In this case, while the evidence indicates that Respondent's statements in the amendment to allege use were false, Petitioner has not introduced any direct evidence of Respondent's intent to deceive the Office, and Respondent has denied any such intent.<sup>18</sup> Thus, Petitioner has failed to show the absence of a genuine dispute regarding Respondent's intent to deceive the Office. Additionally, we note that the factual question of intent is particularly unsuited to disposition on summary judgment. See, e.g., *Copelands' Enters. Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1298-99 (Fed. Cir. 1991).

Accordingly, Petitioner's motion for partial summary judgment on the asserted claim of fraud is **DENIED**.

In summary, we find that, at a minimum, genuine disputes of material fact remain with respect to the asserted claims of lack of bona fide use of the mark in commerce in connection with “short and long sleeve T-shirts” and Respondent's intent to deceive the USPTO.<sup>19</sup>

### **Decision**

In view of the foregoing, Petitioner's motion for partial summary judgment is **granted** with respect to the asserted claim of lack of bona fide use in commerce in connection with “sweatshirts, jackets, baseball hats, and beanies.” Accordingly, the petition for cancellation is granted with respect to the foregoing goods.<sup>20</sup> See *Grand Canyon West Ranch, LLC v. Hualapai Tribe*, 78 USPQ2d 1696, 1697-98 (TTAB 2006) (application not void in its entirety if mark in use on some of the goods).

\*7 Petitioner's motion for partial summary judgment is **denied** with respect to the asserted claim of lack of bona fide use in connection with “short and long sleeve T-shirts.” Petitioner's motion for partial summary judgment on the claim of fraud is also **denied**.

Proceedings herein are resumed. Trial dates are reset as follows:

Plaintiff's Pretrial Disclosures	8/1/2017
Plaintiff's 30-day Trial Period Ends	9/15/2017
Defendant's Pretrial Disclosures	9/30/2017
Defendant's 30-day Trial Period Ends	11/14/2017
Plaintiff's Rebuttal Disclosures	11/29/2017
Plaintiff's 15-day Rebuttal Period Ends	12/29/2017

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. [Trademark Rule 2.125](#).

Briefs shall be filed in accordance with [Trademark Rules 2.128\(a\) and \(b\)](#). An oral hearing will be set only upon request filed as provided by [Trademark Rule 2.129](#).

### **Footnotes**

- 1 Registration No. 4472701 registered on the Supplemental Register on January 21, 2014. Respondent filed an amendment to allege use on November 26, 2013 claiming December 1, 2012 as the date of first use anywhere and the date of first use in commerce.
- 2 On November 14, 2016, the Board granted as conceded Petitioner's motion (filed October 5, 2016) for leave to amend its pleading.
- 3 23 TTABVUE 46-66.
- 4 23 TTABVUE 68-86.

- 5 23 TTABVUE 1357-1362.
- 6 We note that none of the documents identifies the year the sale was made. The second document indicates a transaction on September 8, 2014, which is after the filing date of Respondent's amendment to allege use.
- 7 Respondent notes that his discovery responses include objections. However, because Respondent's general and boilerplate objections to the discovery requests do not state with any specificity the grounds for the objections to each interrogatory, the objections are overruled. See *Medtronic, Inc. v. Pacesetter Sys., Inc.*, 22 USPQ 80, 83 (TTAB 1984) (burden is on objecting party to show that interrogatories should not be answered); see also *Covington v. Sailormen*, 274 F.R.D. 692, 693 (N.D. Fla. 2011) (boilerplate “shotgun-style” objections incorporated into every answer are not consistent with Fed. R. Civ. P. 33(b)(4)'s directive for specificity); *Sanchez-Medina v. UNICCO Serv. Co.*, 265 F.R.D. 24, 27 (D.P.R. 2009) (mere statement that interrogatory was overly broad, burdensome, oppressive, and irrelevant is not an adequate objection).
- 8 23 TTABVUE 74.
- 9 *Id.* at 74-76.
- 10 *Id.* at 21-22.
- 11 Respondent testifies in his declaration that he was unaware of the requirement that the mark be used in connection with all of the goods at the time of filing the AAU and that he believed that his “actual sale of shirt products were [sic] sufficient for the Amendment to Allege Use.” 29 TTABVUE 3.
- 12 27 TTABVUE 6.
- 13 See Petitioner's reply brief, 30 TTABVUE 5 (“the parties agree on Registrant's sales volume”).
- 14 23 TTABVUE 13.
- 15 Trademark Law Revision Act of 1988, [Public Law 100-667](#), 102 Stat. 393.
- 16 23 TTABVUE 1359
- 17 In support of its position that Respondent's *de minimus* use is insufficient to establish bona fide use in commerce, Petitioner relies heavily on the Board's decision in *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768 (TTAB 1994), *aff'd.*, 108 F.3d 1392 (Fed. Cir. 1997). In *Paramount*, the Board found that applicant's advertising and distribution of his “connect the dot game” were *de minimus*. The Board also found, among other things, that the game was not recognizable as a game; that the game was actually an advertising flier primarily used for the purpose of promoting applicant's band; and that the flier/game had no real utilitarian function as a game. *Id.* at 1775. In this case, however, there is no dispute regarding the manner of use of Applicant's mark as a trademark or whether he is actually using the mark in connection with T-shirts. The only dispute is whether the volume of use is sufficient to establish bona fide use in the ordinary course of trade.
- 18 As noted *supra* at n. 11, Respondent testifies that that he was unaware of the requirement that the mark be used in connection with all of the goods at the time of filing the AAU.
- 19 The fact that we have identified only certain genuine disputes as to material facts should not be construed as a finding that these are necessarily the only disputes which remain for trial. In addition, the evidence submitted in connection with a motion for summary judgment or opposition thereto is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

20 This decision is interlocutory in nature. Appeal may be taken within sixty-three days after the entry of a final decision resolving the remaining issues in the case.

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