

**This Opinion is Not a  
Precedent of the TTAB**

Mailed:  
December 23, 2013

**United States Patent and Trademark Office**  
Trademark Trial and Appeal Board

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*Donald A. Gange*

*v.*

*Agility Sports LLC*

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Opposition No. 91194831  
to application Serial No. 77885955

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Donald A. Gange, appearing *pro se*.<sup>1</sup>

Terence J. Linn of Gardner Linn Burkhardt & Flory LLP for Agility Sports  
LLC.

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Before Mermelstein, Lykos and Adlin, Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On December 4, 2009, Agility Sports LLC (“applicant”) filed an application to register the mark SUN BUM in standard character format for “stickers” in International Class 16, “footwear; headwear; shorts; sweat shirts; t-shirts” in International Class 25 and “toy animals” in International Class 28,<sup>2</sup>

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<sup>1</sup> Opposer was previously represented by legal counsel in this proceeding. On September 30, 2012, following his counsel’s death, opposer informed the Board he would act *pro se* in this case.

<sup>2</sup> Application Serial No. 77885955.

alleging a bona fide intent to use the mark in commerce pursuant to Section 1(b) of the Trademark Act.

Donald A. Gange (“opposer”), by his first amended notice of opposition, opposed the registration of applicant’s mark for the goods listed in International Class 25 only on the grounds of priority of use and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), with opposer’s previously used mark SUNBUM. In addition to pleading ownership of a federal registration for the mark SUNBUM in typed characters<sup>3</sup> for “lounge chairs” in International Class 20,<sup>4</sup> opposer also alleged prior common law usage of the mark SUNBUM in connection with lounge chairs and shirts since 1993 as well as ownership of a Michigan trademark registration for the mark SUNBUM for clothing. Opposer’s Amended Notice of Opposition, ¶¶ 2, 3 and 5.<sup>5</sup> Opposer further alleged that he markets and sells SUNBUM lounge chairs and shirts via Facebook as well as two web sites he owns and operates,

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<sup>3</sup> In 2003, Trademark Rule 2.52(a) was amended to refer to “typed” drawings as “standard character” drawings. *See* Trademark Rule 2.52(a). A typed mark is the legal equivalent of a standard character mark. TMEP § 807.03(i) (Oct. 2013).

<sup>4</sup> Registration No. 1958322, registered on February 27, 1996 on the Principal Register. The registration alleges April 8, 1993, as the date of first use anywhere and July 18, 1993, as the date of first use in commerce; renewed.

<sup>5</sup> To the extent, if any, that opposer was attempting to assert a claim of dilution pursuant to Section 43(c) of the Trademark Act of 1946, 15 U.S.C. § 1125(c), the claim was neither properly pled nor tried by implied consent, and therefore has not been considered. *See* Opposer’s Amended Notice of Opposition, ¶ 13; *Polaris Indus., Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000).

www.sunbum.net and www.sunbum.biz, and that he has marketed and sold his products via the web sites “during the last 10 years.” *Id.* at ¶ 4.

In its answer to the amended notice of opposition, applicant denied the salient allegations therein, and asserted various affirmative defenses<sup>6</sup> including that “[o]pposer has abandoned any rights he may have had in the mark SUNBUM for clothing and/or lounge chairs.” Answer to Opposer’s Amended Notice of Opposition ¶17. To the extent that applicant has argued in its brief that opposer’s pleaded federal registration should be cancelled based on abandonment, we have not considered this argument. An attack on the validity of opposer’s pleaded registration is a compulsory counterclaim that will not be heard unless a counterclaim or separate petition seeking the cancellation of such registration is filed. *See* Trademark Rule 2.106(b)(2). Applicant may not collaterally attack opposer’s federal registration via this opposition proceeding. That being said, applicant’s assertion of abandonment as an affirmative defense to opposer’s pleaded prior common law rights in the mark SUNBUM was properly pled. Both opposer and applicant filed briefs.

The record includes the pleadings, and pursuant to Trademark Rule 2.122(b), applicant’s application file. Applicant introduced the testimony depo-

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<sup>6</sup> Applicant asserted as its first affirmative defense failure to state a claim upon which relief may be granted. Insofar as applicant neither filed a formal motion to dismiss pursuant to Fed R. Civ. P. 12(b)(6) during the interlocutory phase of this proceeding, nor argued this asserted affirmative defense in its brief, it is hereby deemed waived. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1752 n.6 (TTAB 2013).

sition of Thomas Edward Rinks, President of Sun Bum LLC (applicant's affiliated distributor company) with exhibits attached thereto. Applicant also submitted a notice of reliance on March 6, 2013, consisting of (1) a certified report from the State of Michigan Department of Licensing and Regulatory Affairs showing opposer's state trademark registration for the mark SUNBUM as cancelled, (2) a printout from the United States Patent and Trademark Office ("USPTO") Trademark Electronic Search System ("TESS") database showing the current status of opposer's Registration No. 1278996 for the composite mark SUN BUM and design for "portable beach lounge chairs" as cancelled, and (3) printouts from the USPTO TESS database showing the current status of three third-party registrations incorporating the term SUN BUM or a plural version thereof as cancelled.

Opposer did not take any testimony in this proceeding. Rather, opposer submitted via notice of reliance the following:

Notice of Reliance No. 1 (filed December 11, 2012) comprised of a photocopy of opposer's pleaded Registration No. 1958322, a photocopy of papers from the *ex parte* prosecution file of said registration, a printout from the USPTO assignment database of said registration; and a copy of the certificate of registration for Michigan Trademark Registration No. M06860 with a copy of the prosecution file history and status pages;

Notice of Reliance No. 2 (filed December 19, 2012) comprised of the proceeding history of Cancellation No. 92024493 in which opposer was in the position of plaintiff in the proceeding; a printout of the assignment records for U.S. Patent Registration No. 5322342; and documents from the file for opposer's application Serial No. 85185645 (filed November 27, 2010) for the mark SUNBUN for "athletic apparel, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms" in International Class 25;

Notice of Reliance No. 3 (filed December 24, 2012) comprised of copies of the articles of incorporation for Gako, Inc., a company affiliated with opposer as well as copies of five newspaper articles from the years 1992-94 discussing opposer's apparel and chair;

Notice of Reliance No. 4 (filed December 31, 2012) comprised of copies of photographs and transcripts from radio and television shows featuring opposer's SUNBUM chair and apparel obtained from opposer's Facebook page in 2012; a copy of a contract with a third-party obtained from opposer's Facebook page in 2012;

Notice of Reliance No. 5 (filed January 1, 2013) comprised of archived screenshots from opposer's web sites [www.sunbum.net](http://www.sunbum.net) and [www.sunbum.biz](http://www.sunbum.biz) from the years 2001, 2002, 2005, 2007, and 2008, then serving as opposer's "placeholder" and later displaying information about opposer's chair; and a screenshot from [www.godaddy.com](http://www.godaddy.com);

Notice of Reliance No. 6 (filed January 6, 2013) comprised of copies of opposer's Facebook and Twitter fan pages, eBay store page, Facebook Internet Twitter link, and opposer's Twitter advertisements; and

Notice of Reliance No. 7 (filed January 7, 2013) comprised of consumer posts on opposer's Facebook and Twitter pages as well as Google and Internet search engine results for "SUNBUM."

Applicant has objected to substantially all of the evidence submitted by opposer on numerous grounds such as hearsay, opposer's failure to produce the information during discovery, failure to comply with the Trademark Rules governing the submission of evidence via notice of reliance, and failure to comply with the guidelines for submission of evidence obtained from the Internet as set forth in the case of *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031 (TTAB 2010) ("*Safer*"). We need not address each and every objection specifically, but instead only address applicant's objections to the extent it is necessary to do so. Except as otherwise explained below, we have considered the entire record, keeping in mind applicant's various objections,

and have accorded the evidence whatever probative value it merits. In reaching our decision, we have not considered the statements made by either opposer or applicant in their respective briefs that are not supported by evidence in the record.

To prevail on a likelihood of confusion claim brought under Trademark Act Section 2(d), a party must first prove that it owns “a mark registered in the Patent and Trademark Office or a mark or trade name previously used in the United States ... and not abandoned....” Trademark Act § 2, 15 U.S.C. § 1052. In the absence of a registration, a party must establish its prior proprietary rights in a mark through actual use or through use analogous to trademark use, such as use in advertising brochures, trade publications, catalogues, newspaper advertisements and Internet web sites, which create a public awareness of the designation as a trademark identifying the party as a source. *See* Trademark Act §§ 2(d) and 45, 15 U.S.C. §§ 1052(d) and 1127; *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), *vacating* *Pactel Teletrac v. T.A.B. Systems*, 32 USPQ2d 1668 (TTAB 1994); and *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). A plaintiff seeking to prove priority via analogous use must plead such use in its complaint. *See Cent. Garden & Pet Co. v. Dorskocil Mfg. Co.*, 108 USPQ 1134, 1142 (TTAB 2013); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1537-38 (TTAB 2007).

Opposer, in his amended notice of opposition, did not plead priority by analogous use. Furthermore, the issue of analogous use was not tried by implied consent. Thus, in order for opposer to prevail on his Section 2(d) claim, he must first either introduce his pleaded registration in evidence or prove by a preponderance of the evidence that he has a proprietary interest in his pleaded common-law SUNBUM mark and that he obtained that interest, i.e. used his pleaded mark in interstate commerce, prior to the actual or constructive first use by applicant, in this case applicant's filing date of December 4, 2009. *See Herbko International Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Otto Roth & Co., Inc. v. Universal Corp.*, 209 USPQ at 43.<sup>7</sup>

Typically, when an opposer in a Board proceeding pleads ownership of a federal registration, it establishes its priority by properly making of record either (1) a printout obtained from a USPTO database showing that it is the owner of its pleaded registration and that the registration is valid and subsisting or (2) an "original or photocopy of the registration prepared and issued by the United States Patent and Trademark Office showing both the current status and current title to the registration." *See* Trademark Rule 2.122(d)(1). *See King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In this instance, opposer did neither. Instead, opposer sub-

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<sup>7</sup> Applicant is entitled to rely on the filing date of its application as its constructive date of first use. *See Syngenta Crop. Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009)

mitted a copy of its federal registration as originally issued and the *ex parte* prosecution history thereof. Although opposer's evidence shows that a registration was issued to it in 1996, opposer has not offered evidence to establish the *current* status of the pleaded registration and thus this evidence does not satisfy opposer's initial burden.<sup>8</sup> *See id.* *See also Syngenta Crop. Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1116-17 (TTAB 2009) (copy of the original certificate of registration issued by the USPTO is not competent evidence to show the current status of and current title to the registration).<sup>9</sup>

Furthermore, applicant's answer does not include any admissions regarding opposer's ownership of its pleaded federal registration or the validity thereof. Nor does applicant's answer include any admissions regarding opposer's alleged common law use of the mark SUNBUM. In addition, we have no testimony from opposer in this case. We must therefore examine the remaining evidence submitted by opposer under notice of reliance to ascertain whether opposer has proven priority through its asserted use of its mark.

First we consider the newspaper articles as well as the radio and television transcripts featuring opposer's SUNBUM products. Although these mate-

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<sup>8</sup> Nonetheless, opposer's submission of printouts from the USPTO assignment database for his pleaded registration suffices to establish his current ownership thereof. *See Notice of Reliance No. 1.*

<sup>9</sup> Even assuming that opposer's Michigan state trademark registration remained active, a state registration by itself is insufficient to establish priority since it does not carry the same presumptions as a federal registration. *See Faultless Starch Co. v. Sales Producers Assocs., Inc.*, 530 F.2d 1400, 189 USPQ 141, 142 n.2 (CCPA 1976). *See also W. Fla. Seafood Inc. v. Jet Rests. Inc.*, 31 USPQ2d 1660, 1664-65 (Fed. Cir. 1994).



rials are admissible for what they show on their face, they constitute hearsay as per Federal Rules of Evidence 801 and 802, if they are offered for the truth of the matter asserted, i.e., that opposer was using its pleaded mark SUNBUM on the dates that the articles were written or the dates that the television or radio shows were broadcasted. *See Syngenta Crop.*, 90 USPQ2d at 1117 n.7 (printed publications made of record by notice of reliance are admissible and probative only for what they show on their face, not for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters). The rule against hearsay mandates that an out-of-court statement cannot be offered as evidence of the truth of the matter asserted in that statement. Insofar as none of the exceptions to the hearsay rule apply, we cannot consider the submissions to prove the truth of any matter stated therein. *See id.*

Similarly, opposer's remaining evidence obtained from the Internet (for example, opposer's Twitter advertisements and archived web sites), although admissible for what they show on their face under *Safer*, also constitute hearsay and may not be relied upon for the truth of the matter asserted, i.e., that opposer was using its pleaded SUNBUM mark in commerce. As further explained in Trademark Board Manual of Procedure ("TBMP") Section 704.08(b) (3d ed. rev. 2013) discussing *Safer, supra*, the seminal case on Internet evidence:

The probative value of Internet documents is limited. They can be used to demonstrate what the documents show on their face;

however, documents obtained through the Internet may not be used to demonstrate the truth of what has been printed. A printout from a webpage may have more limitations on its probative value than traditional printed publications. A party may increase the weight the Board will give website evidence by submitting testimony and proof of the extent to which a particular website has been viewed. Otherwise, the document may not be considered to have much probative value.

*See also 7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1717 n.2 (TTAB 2007) (materials made of record by notice of reliance under 37 C.F.R. § 2.122(e) not admissible for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters); *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 12 USPQ2d 1267, 1270 n.5 (TTAB 1989) (annual report in evidence only for what it showed on its face), *aff'd*, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990). Under the hearsay rule, we cannot accept as true any of the dates associated with opposer's materials submitted under notice of reliance to prove opposer's priority. Thus, in the absence of credible testimony from opposer, he has failed to establish, through competent, admissible evidence, use of his pleaded word mark SUNBUM in connection with lounge chairs or apparel prior to applicant's constructive use date.

Opposer could have testified as to his use of his pleaded mark to establish priority, preferably corroborated with documentary evidence authenticated by opposer (for example, sales figures or invoices). *See e.g., National Bank Book Co. v. Leather Crafted Products, Inc.*, 218 USPQ 826, 828 (TTAB 1993) (oral testimony may be sufficient to prove the first use of a party's mark when

it is based on personal knowledge, it is clear and convincing, and it has not be contradicted); *Liquacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305, 316 (TTAB 1979) (oral testimony may be sufficient to establish both prior use and continuous use when the testimony is proffered by a witness with knowledge of the facts and the testimony is clear, convincing, consistent, and sufficiently circumstantial to convince the Board of its probative value); *GAF Corp. v. Anatox Analytical Services, Inc.*, 192 USPQ 576, 577 (TTAB 1976) (oral testimony may establish prior use when the testimony is clear, consistent, convincing, and uncontradicted). Opposer neglected to do so. Thus, the record is devoid of evidence establishing opposer's prior rights in the mark SUNBUM. Accordingly, the opposition must be dismissed for opposer's failure to establish priority. *See e.g., Lumiere Productions, Inc. v. International Telephone and Telegraph Corp.*, 227 USPQ 892, 893 (TTAB 1985).

We acknowledge that opposer entered the trial phase of this proceeding without the benefit of legal counsel. Nonetheless, the rule against hearsay is a long-established safeguard of the common-law system, serving to exclude evidence which cannot be tested by cross-examination. *Olson v. Ford Motor Co.*, 410 F. Supp. 2d 855, 860 (D.N.D. 2006).

**Decision:** The opposition is dismissed.