

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: March 31, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*J-Lynn Entertainment, LLC*

*v.*

*William T. Odonnell d/b/a Odonnell Entertainment*

\_\_\_\_\_  
Opposition No. 91211530  
against Serial No. 85785996

Cancellation No. 92056491  
against Registration No. 3682041

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J-Lynn Entertainment, LLC, *pro se*.<sup>1</sup>

Matthew H. Swyers of The Trademark Company PLLC for William T. Odonnell  
d/b/a Odonnell Entertainment.

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Before, Shaw, Adlin and Hightower, Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

William T. Odonnell d/b/a Odonnell Entertainment (“Odonnell,” or Respondent) is the owner of Application Serial No. 85785996<sup>2</sup> and Registration No. 3682041<sup>3</sup> for the mark:

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<sup>1</sup> J-Lynn Entertainment, LLC acted in this proceeding through its member, Neadom T. Medina. *See* Patent and Trademark Office Rule 11.14(e)(3), 37 CFR § 11.14(e)(3); TBMP § 114.01.

<sup>2</sup> Filed November 22, 2012, based on Section 1(a) of the Trademark Act, with a claim of first use anywhere on June 21, 2007 and a claim of first use in commerce on August 29, 2007.

<sup>3</sup> Issued September 15, 2009; Section 8 accepted.



The mark is described as follows:

The mark consists of the realistic depiction of a dog above the words "ADVENTURES OF SHADOW"; the dog has a body of the colors light brown, tan, red brown and brown, with the neck, and nose area of the dog appearing in white, the color brown appears in the nose and eyes of the dog; the color red appears in the dog's tongue and collar; the color green appears in the background foliage and in a strip on the left of the circular portion of the mark; the color grey appears in a rectangle shape to the left of the dog; the color white also appears in the inner outline of the mark; the color blue appears in the outer outline of the mark; the wording "ADVENTURES OF SHADOW" appears in white at the top, fading to yellow in the middle and then to orange at the bottom, with a white outline of each letter and a black outer outline and shadow.

The colors dark brown, light brown, tan, red brown, white, black, yellow, orange, green, blue, grey and red are claimed as features of the mark.

The goods identified in the registration are:

Motion picture films relating to a dog character and her adventures; Entertainment motion picture films featuring a dog character and her adventures, documentaries, documentaries on dogs, comedy, variety, drama, family drama; pre-recorded entertainment, namely, films, downloadable audio and video recordings, video cassettes, video tapes, DVDs, high definition digital discs, and video discs featuring a dog character and her adventures, documentaries on dogs and documentaries, in International Class 9;

Series of fiction books; series of fiction books featuring the adventures of a dog character; non-fiction books in the field

of dogs and historical landmarks; photo books; photo books, namely, books featuring photographs, lithographs, prints and pull-out posters; coloring books; children's activity books; children's activity books with stickers; comic books; greeting cards, post cards and picture postcards; magazines concerning dogs; and calendars, in International Class 16; and

Purified bottled drinking water, in International Class 32.

The goods identified in the application are:

Combinations clothing [sic], namely, tee shirts, sweatshirts, jackets, aprons, tank tops, long sleeve t-shirts, sweaters, baseball jerseys, polo shirts, muscle t-shirts, toddler t-shirts, and hooded shirts; headwear, in International Class 25.

By way of a Petition to Cancel, J-Lynn Entertainment, LLC (“J-Lynn” or Petitioner) seeks to cancel Odonnell’s registration on the grounds of nonuse, abandonment, and fraud. In addition, J-Lynn opposes registration of the applied-for mark on the ground that the mark is not in use as claimed in the application.<sup>4</sup> Odonnell denied the salient allegations of the Petition to Cancel and the Notice of Opposition.<sup>5</sup>

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<sup>4</sup> Petitioner also alleges as grounds for opposition that “the sole motivation for the Applicant filing for the mark was to strengthen his case in trying to file a lawsuit . . .” and “that another motivation . . . is to strengthen a case for opposition of our mark.” 1 TTABVUE. These are not cognizable grounds for opposition and have not been considered. Additionally, Petitioner was advised by the Board on August 19, 2014 that only the ground of nonuse of the mark had been properly pleaded in both the opposition and cancellation petitions. Nevertheless, Respondent has addressed abandonment and fraud in his brief. We therefore treat these issues as tried by consent of the parties. See TBMP § 507.03(b).

<sup>5</sup> Proceedings in the opposition and cancellation were consolidated by order of the board on September 26, 2013.

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the involved registration and application. In addition, Petitioner sought to introduce the following items into evidence, either by stipulation or by notice of reliance:

1. The deposition of a private investigator, Robert Holmes, Jr., with exhibits, dated December 3, 2014;<sup>6</sup>
2. The deposition of Petitioner, Tamar Medina, with exhibits, dated June 12, 2015;<sup>7</sup>
3. The deposition of Respondent, William Odonnell, with exhibits, dated May 26, 2015;<sup>8</sup>
4. Petitioner's Notice of Reliance (Exhibit 1) on email correspondence from Respondent to a third-party bottled water vendor;<sup>9</sup>
5. Petitioner's Notice of Reliance (Exhibit 2) on email correspondence from Respondent to a third party potential customer;<sup>10</sup>
6. Petitioner's Notice of Reliance (Exhibits 3 and 4) purporting to show two of Respondent water bottle labels;<sup>11</sup>
7. Petitioner's Notice of Reliance (Exhibit 5) consisting of a report by IPCybercrime.com LLC, a private investigative firm;<sup>12</sup>
8. Petitioner's Notice of Reliance (Exhibit 6) on Respondent's written responses, with objections, to Petitioner's written discovery requests;<sup>13</sup>

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<sup>6</sup> 47 TTABVUE.

<sup>7</sup> 55 TTABVUE.

<sup>8</sup> 56-58 TTABVUE.

<sup>9</sup> 37 TTABVUE.

<sup>10</sup> 38 TTABVUE.

<sup>11</sup> 39 TTABVUE.

<sup>12</sup> 40 TTABVUE.

<sup>13</sup> 42 TTABVUE.

9. Petitioner's Notice of Reliance (Exhibit 7) on email correspondence between Respondent and Petitioner;<sup>14</sup>
10. Petitioner's Notice of Reliance (Exhibits 8 to 11) on: a cease and desist letter from Petitioner's attorney to Respondent; a copy of the report by IPCybercrime.com LLC, a private investigative firm (the same as No. 7 above); and printouts from the internet, purportedly from Respondent's web sites;<sup>15</sup> and
11. Petitioner's Notice of Reliance (Exhibit 15) on the deposition of Robert L. Holmes of IPCybercrime.com LLC, a private investigative firm.<sup>16</sup>

Respondent did not submit any testimony or other evidence.

## II. Evidentiary Objections

Respondent first moves to strike the deposition of Robert Holmes, Jr. on the ground that it was taken outside of Petitioner's testimony period, as required under TBMP § 703.01(c), because proceedings had been suspended. The Holmes deposition was scheduled to be taken on December 3, 2014, during Petitioner's assigned testimony period. Two days earlier, on December 1, 2014, Odonnell's counsel, Matthew H. Swyers, filed a motion to withdraw from representation. On December 3, 2014 the Board acted on the motion to withdraw by suspending proceedings for 30 days to allow Odonnell to appoint new counsel. The deposition was taken, as scheduled, on the same day the Board acted on the motion to withdraw and suspended the proceedings. On December 31, 2014, Odonnell reappointed the same counsel, Matthew H. Swyers, as his attorney.

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<sup>14</sup> 43 TTABVUE.

<sup>15</sup> 44 TTABVUE.

<sup>16</sup> 45 TTABVUE.

The filing of a motion to withdraw from representation does not automatically suspend proceedings. 37 CFR § 2.19(b). Rather, suspension only occurs if the Board grants the motion and allows the moving party a stated period of time in which to appoint a new attorney. TBMP § 513.01. Neither Petitioner nor Odonnell could have known when the Board was going to act on the motion to withdraw. Therefore, we see no reason why Petitioner was obliged to cancel a previously-scheduled deposition on the off-chance that the Board would in fact suspend proceedings within two days of receiving the motion. Accordingly, we find that the Holmes deposition was not taken outside of Petitioner's testimony period and the motion to strike is denied.<sup>17</sup>

Odonnell next objects to the introduction of Petitioner's exhibits 1-5, 7-12, and 14 on the ground that the exhibits are not entitled to introduction via notices of reliance, and also on the grounds that the evidence is hearsay, was not properly authenticated, or was without foundation.

Trademark Rule 2.122(e) addresses the introduction of printed publications and official records and, generally, provides that they may be introduced in evidence by filing a notice of reliance. In *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031 (TTAB 2010), the Board liberalized the practice and interpretation of Rule 2.122(e) by "expanding the types of documents that may be introduced by notice of reliance to include not only printed publications in general circulation, but also documents such as [printouts from] websites, advertising, business publications . . . prepared for or by

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<sup>17</sup> Having discharged his attorney, Respondent had several options. He could have attended the deposition himself, re-authorized his attorney to appear, or moved to cross-examine the witness after the hearing. See TBMP § 404.

a party or non-party, if, and only if, they can be obtained through the Internet as publicly available documents.” *Safer* at 1039.

None of exhibits 1-5 and 7-11 may be properly introduced via notices of reliance. These exhibits comprise emails, sample product labels, non-public investigative reports, cease and desist letters, or other documents which are not printed publications or official records as contemplated by Rule 2.122(e). Exhibits 9, 10, and 11 appear to be internet printouts which are permitted under Rule 2.122(e), but they are nevertheless inadmissible via notice of reliance because they lack the necessary dates that the web sites were accessed and printed, their source (URL), or both. Accordingly, the objection to these exhibits is sustained and they have been given no consideration.<sup>18</sup> Exhibits 12 and 14 were submitted as exhibits to the Odonnell deposition and are properly of record. The objection to these exhibits is overruled.

### III. Standing

A plaintiff must show that it has a “real interest” in the outcome of a proceeding in order to have standing. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). A “real interest” in the proceeding is a legitimate personal interest in the opposition or cancellation. *Id.*, citing *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Petitioner argues that Respondent has objected, by means of cease-and-desist letters, to Petitioner’s use of the mark “Adventures of Shadow Cat.”<sup>19</sup> Respondent concedes that he sought to

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<sup>18</sup> Many of Petitioner’s exhibits were submitted more than once, e.g., via notice of reliance as well as with a deposition. Exhibits properly submitted with depositions have been considered.

<sup>19</sup> Petitioner’s Br. at 4; 59 TTABVUE 5.

“enforce his valid and subsisting trademark rights” against Petitioner.<sup>20</sup> In view of the foregoing, we find that Petitioner has established a real interest in the outcome of this proceeding and, therefore, has standing.

IV. Opposition of Application Serial No. 85785996

We begin with Petitioner’s allegation of nonuse of the mark on the goods identified in the application:

Combinations clothing [sic], namely, tee shirts, sweatshirts, jackets, aprons, tank tops, long sleeve t-shirts, sweaters, baseball jerseys, polo shirts, muscle t-shirts, toddler t-shirts, and hooded shirts; headwear, in International Class 25.

Petitioner pleads, *inter alia*, that Respondent “was not selling or had ever created shirts or clothing using his mark on the filing date of November 22, 2012 or in prior dates [sic].”<sup>21</sup>

An application filed under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), is void *ab initio* when an applicant has not used its mark on any of the goods or services identified in the application prior to the filing of the application. Trademark Rule 2.34(a)(1)(i); see *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1036 n.7 (TTAB 2007); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 (TTAB 2012). Nonuse in connection with some, but not all, of the identified goods and services as of the filing date of a Section 1(a) application is a basis for denial of registration only as to those goods and services on which the mark was not in use. See *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 78 USPQ2d 1696, 1697-98 (TTAB 2006).

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<sup>20</sup> Respondent’s Br. at 4; 64 TTABVUE 5.

<sup>21</sup> 1 TTABVUE 4.

Petitioner has the initial burden of demonstrating by a preponderance of the evidence that Respondent had not used the mark on the identified goods as of the filing date of the application.

Use of a mark in commerce is defined by Section 45 of the Trademark Act:

[A] mark shall be deemed to be in use in commerce—

(1) on goods when—

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods of their sale, and

(B) the goods are sold or transported in commerce. . . .”

15 U.S.C. § 1127.

The filing date of Application Serial No. 85785996 is November 22, 2012. Thus, in order to avoid a finding that the application is void, Respondent must have used the mark on the goods prior to November 22, 2012. Respondent, during his deposition, admitted that he had not sold any t-shirts bearing the applied-for mark prior to the filing of the opposition proceeding on July 12, 2013:

Q Mr. Odonnell, prior to the opposition proceeding and the cancellation proceeding for your mark, did you sell T-shirts prior to that date using your mark in commerce?

A I had T-shirts made, that is correct. And you see one on the picture of me at the lighthouse.

\* \* \*

Q Did it have your actual mark Adventures of Shadow on that T-shirt?

A No. . . .

\* \* \*

Q But your application says that you -- the first use of commerce for a T-shirt was August 29, 2007.

A When I applied for that, I just put that. I thought that -- I'm not a trademark lawyer and I never profess to be one. I put that date because I thought that's what they were requesting.

Q So it's safe to say that you actually weren't using your mark of [sic] commerce for a classification of T-shirts prior to the filing of the cancellation and opposition proceedings; is that your answer, if I'm understanding correctly?

A It's the date that was put there, but actually the -- I ordered T-shirts for Adventures of Shadow, the early version, back in 2006. But the company I was using, called Gabriel in New York, they never produced the -- I sent them four slides --

Q You never sold any commerce [sic] prior to the file of the opposition and cancellation proceedings?

A That's correct, but it was also -- that was the very first thing I was considering doing way back then.<sup>22</sup>

From this testimony we find that, at least as of July 12, 2013, the filing date of the opposition and more than 7 months after the filing date of the application, Respondent had not used his mark in commerce on t-shirts. Although some t-shirts had been made, they did not bear the "actual mark Adventures of Shadow."<sup>23</sup> Similarly, t-shirts with the applied for mark were ordered but, according to Respondent's own admission, they were "never produced."<sup>24</sup> Respondent admits that even as late as the filing of this opposition, he has not sold any t-shirts in commerce.<sup>25</sup> Indeed, the specimens of record in the application include a photograph of what appears to be a simulated "mock-up" of a proposed t-shirt, not an actual t-shirt.<sup>26</sup>

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<sup>22</sup> Odonnell deposition, pp. 29-31; 62 TTABVUE 30-32.

<sup>23</sup> *Id.*

<sup>24</sup> *Id.*

<sup>25</sup> *Id.*

<sup>26</sup> Application Ser. No 85785996 filed November 22, 2012, p. 3.

With regard to the other articles of clothing identified in the application, we find there is no evidence supporting Respondent's use of the mark on these goods either. Petitioner requested, by way of document requests, documentation showing that Respondent actually manufactured and sold "Adventures of Shadow products," including clothing.<sup>27</sup> Despite objecting to the requests on the grounds that they were "overly broad and burdensome," Respondent stated in response that it had either attached responsive documents or would provide additional responsive documents "prior to trial."<sup>28</sup> But Respondent did not provide any such documentation relating to clothing except for the single photograph of the digital mock-up of a t-shirt filed with the application.<sup>29</sup> Such a mock-up of the goods without any corresponding sales of the goods does not support use in commerce as contemplated by Section 45.

Based on the foregoing, we find that Respondent had not used his mark as of the filing date of his use-based application. Accordingly, Respondent was not entitled to registration under Trademark Act Section 1(a) and the application is void *ab initio*. See *ShutEmDown Sports*, 102 USPQ2d at 1045.

#### V. Cancellation of Registration No. 3682041

Petitioner seeks to cancel Respondent's registration on the grounds of nonuse, abandonment and fraud. A petitioner seeking cancellation of a registration on the

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<sup>27</sup> 42 TTABVUE 5-6.

<sup>28</sup> *Id.*

<sup>29</sup> 58 TTABVUE 14. Respondent claims that "many of the records ordinarily kept in the course of business for the Registrant were destroyed during a move and destruction of a hard drive." Respondent's Br, p. 10, n.4. Such events do not excuse Respondent from submitting other evidence of use such as actual articles of clothing, paper invoices, or the like. Moreover, Respondent could have contacted his suppliers for copies of documents relating to the manufacture of any clothing articles.

ground of nonuse or abandonment bears the burden of proving such nonuse or abandonment by a preponderance of evidence. *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989). A party alleging fraud in the procurement of a registration bears the heavy burden of proving fraud with clear and convincing evidence. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1939 (Fed. Cir. 2009) (quoting *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981)). With these guidelines in mind we turn to the individual grounds for cancellation.

A. Nonuse

As discussed *supra*, Petitioner must show that Respondent had not used his “Adventures of Shadow” mark prior to the filing of the application underlying Registration No. 3682041. The goods identified in the registration are:

Motion picture films relating to a dog character and her adventures; Entertainment motion picture films featuring a dog character and her adventures, documentaries, documentaries on dogs, comedy, variety, drama, family drama; pre-recorded entertainment, namely, films, downloadable audio and video recordings, video cassettes, video tapes, DVDs, high definition digital discs, and video discs featuring a dog character and her adventures, documentaries on dogs and documentaries, in International Class 9;

Series of fiction books; series of fiction books featuring the adventures of a dog character; non-fiction books in the field of dogs and historical landmarks; photo books; photo books, namely, books featuring photographs, lithographs, prints and pull-out posters; coloring books; children's activity books; children's activity books with stickers; comic books; greeting cards, post cards and picture postcards; magazines concerning dogs; and calendars, in International Class 16; and

Purified bottled drinking water, in International Class 32.

As an initial matter, much of Petitioner's inquiry is focused on showing that Respondent had not used his mark as of the claimed date of first use of the mark in commerce identified in the application, namely, August 29, 2007. But Petitioner is focusing on the wrong date. Nonuse of the mark as of the claimed first use date does not render a registration void *ab initio*. Rather, the statutory basis for a claim of nonuse under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), is that there was no use of the mark *prior to the filing date of the application*. See *ShutEmDown Sports*, 102 USPQ2d at 1045. Accordingly, Petitioner's arguments relating to no *bona fide* use of the mark as of the claimed first use dates in the application will be given no consideration. Instead, we will determine whether Respondent used the mark in commerce on the goods prior to the filing date of the application, April 30, 2008.

Regarding the goods, in Class 9, Odonnell testified that the mark was first used on covers for video recordings about ceremonies involving the issuance of a "lighthouse" postage stamp.<sup>30</sup> However, there is no testimony or evidence showing that these goods were, in fact, in use prior to the filing date of the application. The video cover in evidence was not submitted to the Office as a substitute specimen in the underlying application until February 28, 2009, nearly 10 months after the filing date of the application; and Respondent's supporting declaration that the specimens were in use as of the filing date carries no evidentiary weight.<sup>31</sup> See 37 C.F.R.

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<sup>30</sup> Odonnell deposition, pp. 52-53; 62 TTABVUE 53-54.

<sup>31</sup> Response to Office Action, February 28, 2009, p. 9.

§ 2.122(b)(2) (“The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence.”). Neither was any other documentation provided by Respondent, in response to Petitioner’s document requests, showing use of the mark on goods in class 9 as of the filing date of the application.<sup>32</sup> Odonnell testified that his documentaries were broadcast on regional television stations as well as on the internet,<sup>33</sup> but these uses do not appear to be before the filing date of the application nor can they support use of the mark in commerce for goods in class 9 inasmuch as they do not show use of the mark on any goods. We find that nonuse is established by the complete lack of documentation such as sales records, bank records, sales receipts, invoices, bills of service, advertising or promotional materials showing that the mark was in use on any class 9 goods as of the filing date of the application.

Regarding the goods in class 16, there is no testimony or evidence that any of the goods were made or sold on or before the filing date of the application. Only two calendar pages are of record. The first calendar page bearing the mark shows the month of January 2008 and was submitted to the Office as a substitute specimen on February 28, 2009, again, nearly 10 months after the filing date of the application.<sup>34</sup> The second calendar page appears to be from a 2012 calendar, but the mark is not

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<sup>32</sup> 42 TTABVUE 5-6.

<sup>33</sup> Odonnell deposition, pp. 15 and 56-60; 62 TTABVUE 17, 57-61.

<sup>34</sup> Response to Office Action, February 28, 2009, p. 5.

visible anywhere on the calendar.<sup>35</sup> Odonnell provided no testimony to explain when or how the calendars were produced and sold. Neither was any other documentation provided by Respondent, in response to Petitioner's document requests, showing use of the mark on goods in class 16, namely, books, cards or magazines, as of the filing date of the application.<sup>36</sup> We find that nonuse of the mark on any goods in class 16 is established by the complete lack of documentation showing that the mark was in use in commerce as of the filing date of the application.

Based on our finding that the record supports the conclusion that Respondent's mark was not in use on any goods in classes 9 or 16 at the time of filing of his application, we hold the application was void *ab initio* as to these classes and grant the petition for cancellation as to these classes. *See Grand Canyon West Ranch*, 78 USPQ2d at 1698.

Regarding the bottled water in class 32, the Odonnell deposition introduced photographs of the water bottle bearing the mark<sup>37</sup> and emails to a water supplier from 2007 indicating that Odonnell had sold 350 and 600 water bottles in the preceding two years.<sup>38</sup> We find this evidence is sufficient to support Respondent's use of the mark on bottled water at least as early as the filing date of the application.

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<sup>35</sup> 57 TTABVUE 30.

<sup>36</sup> 42 TTABVUE 5-6.

<sup>37</sup> 58 TTABVUE 32.

<sup>38</sup> 57 TTABVUE 67-70.

B. Abandonment

Since we have found the registration to be void *ab initio* as to Classes 9 and 16, we will consider abandonment only with regard to the goods in Class 32 for “purified bottled drinking water.”

Section 45 of the Act, 15 U.S.C. § 1127, in pertinent part, defines “abandonment” of a mark as follows:

When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

There are two elements to an abandonment claim: (1) discontinuance of use; and (2) an intent not to resume use. A plaintiff must show both of these elements unless it can show three years of nonuse, which prima facie establishes abandonment, in which case the burden shifts to the defendant to show either that it has used the mark, or that it has an intent to resume use. *See Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 13 USPQ2d at 1309.

The record evidence regarding Respondent’s use of the mark on water bottles includes, *inter alia*: emails from 2007 discussing the manufacture of the water bottles by the McClellan Spring Water company;<sup>39</sup> labels for water bottles submitted with the underlying application and with the Odonnell deposition;<sup>40</sup> Respondent’s product inventory list dated February 28, 2009 showing Respondent had \$221.00 worth of

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<sup>39</sup> 57 TTABVUE 67-70.

<sup>40</sup> Application Ser. No. 77461457, filed April 30, 2008, p. 3; 57 TTABVUE 29.

“Adventure of Shadow water” on hand;<sup>41</sup> testimony by Odonnell that between 2008 and October 15, 2012, he sold water bottles at regional events and “always had [bottled water] in stock” and available for sale;<sup>42</sup> and photographs of a water bottle showing the mark on the label.<sup>43</sup>

Petitioner argues that the testimony of his private investigator, Robert Holmes, Jr., supports the conclusion that the mark has been abandoned:

There was [sic] clear case for abandonment and non-use when there was no evidence found by Mr. Holmes of water bottles for sale using the Applicant’s mark, no evidence of any type of film or video for sale, no evidence of t-shirts for sale, and no evidence of any printed goods such as books or calendars for sale by the Applicant. During Mr. Holmes’ investigation he tells Mr. Holmes that “We don’t have DVD’s at the moment.”<sup>44</sup>

We do not find the Holmes testimony persuasive. Much of Holmes’ testimony is hearsay and the rest merely shows that Respondent may not have been selling water bottles at the time Holmes contacted Respondent.<sup>45</sup> At best, the Holmes testimony shows a temporary discontinuance of sales which is insufficient to prove abandonment of the mark.

Taken as a whole, we find that the evidence fails to show that Respondent discontinued use of the mark on water bottles with no intent to resume use and Petitioner’s claim of abandonment fails. *See West Fla. Seafood Inc. v. Jet Rests. Inc.*,

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<sup>41</sup> 57 TTABVUE 81.

<sup>42</sup> Odonnell deposition, pp. 16-17; 62 TTABVUE 17-18.

<sup>43</sup> 57 TTABVUE 72-73.

<sup>44</sup> Petitioner’s Br. at 13; 65 TTABVUE 14

<sup>45</sup> 47 TTABVUE.

31 F.3d 1122, 31 USPQ2d 1660, 1662 (Fed. Cir. 1994) (“[O]ne should look at the evidence as a whole, as if each piece of evidence were part of a puzzle. . .”).

C. Fraud

Fraud in procuring a trademark registration occurs when an applicant knowingly makes false, material representations of fact in connection with its application with intent to deceive the USPTO. *See In re Bose Corp.*, 91 USPQ2d at 1941.

Because we have found that Respondent’s allegation of use of the mark in commerce at the time of filing of his application was false as to the goods in Classes 9 and 16, we have held that the application was void *ab initio*. Thus, we need not decide the fraud claim as to these classes. *See ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d at 1045.

Regarding the goods in Class 32, because we have found that Respondent’s goods were, in fact, in use at least as early as of the filing date of the application, we find that Respondent did not make a false, material representations of fact in connection with his application with intent to deceive the USPTO. *See In re Bose Corp.*, 91 USPQ2d at 1941. Thus, Petitioner’s claim of fraud fails as to the goods in class 32.

**Decision:** The opposition to Application Serial No. 85785996 is sustained and registration is refused. The petition for cancellation of Registration No. 3682041 is granted, in part, as to Classes 9 and 16, and these classes will be cancelled in due course. The petition for cancellation Registration No. 3682041 is denied, in part, as to Class 32.