

This Order is Citable as
Precedent of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mermelstein

Mailed: January 16, 2003

Cancellation No. 92032146

BOYDS COLLECTION, LTD

v.

HERRINGTON & COMPANY

Before Simms, Bottorff, and Rogers, Administrative Trademark
Judges.

By the Board:

This case now comes up on respondent's motion to strike petitioner's notice of reliance, filed September 10, 2002, and petitioner's motion to suspend, filed December 11, 2002. The motion to strike has been fully briefed,¹ and respondent filed a response to the motion to suspend.

Procedural History

The record herein indicates that on April 22, 2002, petitioner filed a notice of reliance. The notice, filed on the last day of petitioner's testimony period, was not accompanied by a certificate of service of the same upon respondent, and was apparently not in fact served.

¹ Respondent filed a reply brief, which we have considered. Trademark Rule 2.127(a)(consideration of reply brief discretionary).

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Having not received a service copy of petitioner's notice of reliance - or any notice of a testimonial deposition - respondent moved to dismiss the petition to cancel pursuant to Trademark Rule 2.132(a). Petitioner responded, noting that it had indeed filed a notice of reliance, although it admitted that the notice was not served. (At this point, petitioner sent a copy of the notice of reliance to respondent.) In its reply brief, respondent raised several issues relating to the propriety of the notice of reliance itself, and argued that judgment should be entered against petitioner, notwithstanding petitioner's timely filing of its (late-served) notice of reliance.

By order dated October 1, 2002, the Board denied without prejudice respondent's motion to dismiss under Trademark Rule 2.132, and reset respondent's testimony period to avoid prejudice. As for respondent's argument that the notice itself was improper, the Board found that such issues were inappropriately raised in a reply brief, to which petitioner had no right to respond.

By motion filed September 27, 2002, (but not associated with the file prior to mailing of the Board's October 1, 2002, order), respondent filed the instant motion to strike. Proceedings have been suspended pending resolution of the motion.

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Finally, it appears that on December 5, 2002, petitioner filed a complaint against respondent in the United States District Court for the Middle District of Pennsylvania.² On December 11, 2002, petitioner filed a motion with the Board seeking suspension of this proceeding pending final determination of the civil proceeding pursuant to Trademark Rule 2.117(a).

Motion to Suspend

Petitioner filed its motion to suspend with a certificate alleging service of the motion upon respondent on December 9, 2002. A response to the motion was thus due to be filed on or before December 30, 2002.³ Respondent's opposition to the motion to suspend, filed by express mail pursuant to Trademark Rule 1.10 on January 3, 2003, is

² *The Boyds Collection, Inc. v. Herrington & Co.*, 1:CV 02-2221. The complaint alleges infringement of petitioner's registered trademark, unfair competition under § 43 of the Lanham Act, dilution under § 43(c) of the Lanham Act, and dilution and unfair competition under state law, and seeks both injunctive relief and damages.

³ Trademark Rule 2.127(a)(fifteen days allowed for response to motion); Trademark Rule 2.119(c)(five additional days allowed after service by mail); Patent and Trademark Rule 1.7(when a date for taking action falls on a Saturday, Sunday, or holiday, action may be taken on the next business day).

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untimely, and will not be considered.⁴

Nonetheless, we do not consider the motion conceded.

Trademark Rule 2.117 provides in pertinent part:

(a) Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

(b) Whenever there is pending before the Board both a motion to suspend and a motion which is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered regardless of the order in which the motions were filed.

As petitioner correctly argues, it would appear that the civil action in question "may have a bearing on [this] case," inasmuch as it involves the same parties and the same marks. Further, it is generally the Board's policy to suspend when the parties are engaged in such a civil action.⁵

Nonetheless, both the permissive language of Trademark Rule 2.117(a) ("proceedings ... may be suspended..."), and the

⁴ Even if timely, respondent's paper would not be considered because it was not accompanied by a certificate of service as required by Trademark Rule 2.119(a) ("Proof of ... service must be made before the paper will be considered by the Office."). Additionally, we note that respondent's paper is signed "P. Craig Cardon/EM." "[E]ach piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature, personally signed by such practitioner..." Patent and Trademark Rule 10.18(a)(emphasis added). Signature by one person on behalf of another is thus inappropriate.

⁵ See generally, TBMP § 510.02.

explicit provisions of Trademark Rule 2.117(b) make clear that suspension is not the necessary result in all cases.

In the case at bar, suspension is neither necessary nor appropriate. The Board's discretion to consider a dispositive motion pending at the same time as a motion to suspend, codified in Trademark Rule 2.117(b), developed "to prevent a party served with a potentially dispositive motion from escaping the motion by filing a civil action and then moving to suspend before the Board has decided the potentially dispositive motion. TBMP § 510.02(a), *citing* David B. Allen, *TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse-Gaston Act*, 74 Trademark Rep. 180 (1984). In this case, there is not only a potentially dispositive motion pending, but trial is over. Petitioner should not be allowed to delay the outcome of this proceeding when there would be little or nothing to resume upon conclusion of petitioner's civil suit.

Accordingly, we exercise our discretion to consider the motion to strike prior to the motion to suspend.

Petitioner's Notice of Reliance

Petitioner's notice of reliance indicates that petitioner seeks to rely on the twelve documents attached, labeled A-L. Exhibit A is described as the "Declaration of Petitioner Employee Kelly S. Auscherman." Exhibits B and E-L are each identified as single pages of catalogs, while

Exhibits C and D each purport to be "one-page price sheet[s]."

Arguments

Respondent's motion points out that petitioner's notice of reliance consists of a declaration of an employee of petitioner, and eleven documentary exhibits. Respondent states that the parties have not entered into a stipulation to submit testimony by affidavit or declaration, see Trademark Rule 2.123(b), and argues that the remaining exhibits to the notice of reliance lack proper foundation in that they are not printed publications subject to introduction under a notice of reliance.⁶ See Trademark Rule 2.122(e). Accordingly, respondent argues that petitioner's notice of reliance should be stricken in its entirety.

⁶ Respondent also argues - at some length - that the "Evidence Declaration" is neither a testimonial deposition nor any type of discovered material which may be submitted into evidence by a notice of reliance. Petitioner does not dispute this point, and in any event, we agree with respondent.

Respondent further argues that the exhibits to the notice of reliance are not properly numbered and labeled as required by Trademark Rule 2.123(g)(2). However, we agree with petitioner that if this rather insignificant problem were the only deficiency in petitioner's notice of reliance, we would allow petitioner an opportunity to cure this defect.

Although not raised by respondent, we note that a notice of reliance on printed publications or official records under Trademark Rule 2.122(e) must "includ[e] information sufficient to identify the source and the date of the publication" and must "indicate generally the relevance of the material being offered." Petitioner's notice of reliance appears deficient in both respects.

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In response, petitioner argues that respondent's motion is "untimely," because it constitutes a substantive objection to the evidence which should be reserved until final hearing, and that its documentary evidence has a proper foundation and is in proper form. Specifically, petitioner argues that exhibits B-L to its notice of reliance are printed publications which may be submitted under notice of reliance pursuant to Trademark Rule 2.122(e).

Discussion

In a Board *inter partes* proceeding, a party has several options for introduction of evidence into the record. Certain documents may be introduced under a "notice of reliance" by filing (and serving) a copy thereof during the party's testimony period. Alternatively, documents and testimony may be introduced by having a competent witness answer appropriate questions and identify documents during a testimonial deposition, held during the party's testimony period.⁷ It is undisputed that petitioner did not conduct any testimonial depositions.

⁷ While exhibits to pleadings are generally not considered in evidence, if the plaintiff submits two "title and status" copies of its pleaded registration, prepared by the USPTO, they will be considered part of the evidentiary record at trial. Trademark Rule 2.122(d)(1). Parties may also stipulate to or admit certain facts. Likewise, the parties may stipulate to the presentation of testimony by affidavit or declaration. See Trademark Rule 2.123(b). In this case, no evidence was attached to the petition to cancel and the parties have not made any stipulations regarding evidence.

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As a threshold matter, we disagree with petitioner's argument that the motion to strike is "untimely" because it raises substantive objections to the notice of reliance, questions which petitioner says should be reserved for a panel of the Board considering this matter after briefing (and argument, if requested). Respondent's objections are not substantive, but procedural in nature. In considering respondent's motion, it is not necessary to consider the substance of the evidence offered under petitioner's notice of reliance. We are not concerned here with what petitioner's price sheets, catalogs or the Auscherman Declaration actually say, but rather with whether such documents may properly be submitted under a notice of reliance - whatever they may say. Thus construed, it is clearly not necessary to read petitioner's documents in order to rule on respondent's motion to strike, and for purposes of the motion, we need look no further than the notice of reliance itself. *See generally*, TBMP §§ 533, 718.02(b).

Turning first to the Auscherman "Evidence Declaration," we note that the parties may stipulate to the entry of testimony by affidavit. Trademark Rule 2.123(b); TBMP § 713.02. However, in the absence of such a stipulation, an affidavit or declaration is not admissible under a notice of reliance. *See, e.g., Sports Authority Michigan Inc. v. PC*

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Authority Inc., 63 USPQ2d 1782, 1801, n. 20 (TTAB 2001); *Order Sons of Italy in America v. Memphis Mafia Inc.*, 52 USPQ2d 1364, 1365 n. 3 (TTAB 1999); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1403 (TTAB 1998). There is no record of any such stipulation in this case, and the Auscherman declaration is therefore inadmissible.

We turn next to Exhibits B-L to the notice of reliance. Petitioner asserts that its catalogs and price sheets are "printed publications." However, not all printed matter is a "printed publication" within the meaning of Trademark Rule 2.122(e). Under that rule,

[p]rinted publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered.

Trademark Rule 2.122(e).⁸ Documents which constitute printed publications are essentially self-authenticating, eliminating the usual requirement that evidence be authenticated prior to admission. See *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1403-05 (TTAB 1998).

⁸ Note that documents submitted under notice of reliance pursuant to Trademark Rule 2.122(e) are generally admissible and probative only for what they show on their face, and not as proof of the matters asserted therein. See TBMP § 708 (and cases cited therein).

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The Board has previously held that promotional material, catalogs, and the like are not admissible as printed publications, unless a foundation has been laid - by testimony, unless otherwise stipulated - demonstrating that the materials sought to be introduced are generally available to the public. See, e.g., *Glamorene Products Corp. v. Earl Grissmer Co.*, 203 USPQ 1090 (TTAB 1979); TBMP § 708; 3 J.T. McCarthy, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 20:125 (4th ed. 2001). As noted, however, petitioner has submitted no testimony, and the Auscherman declaration is inadmissible for this or any other purpose.⁹

In view of the foregoing, respondent's motion is GRANTED. Petitioner's notice of reliance is stricken and will be given no further consideration in this matter.

Finally, we note that on October 4, 2002, petitioner filed a brief on the merits of the case. However, inasmuch as petitioner's only proffered evidence has been stricken, we find it unnecessary to resume the briefing schedule or to consider petitioner's brief on the merits. Because petitioner bears the burden of proof, it is axiomatic that

⁹ Even if we were to consider the Auscherman declaration, it would not be sufficient to establish that the price sheets and catalogs at issue are printed publications. There is no indication, for instance, of if or when (other than the year, which is hand-written on some of the documents) the catalogs or price sheets were actually circulated or how many were mailed and to whom in each relevant year, or whether petitioner's catalogs and price sheets are available to the general public in libraries.

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without admissible evidence, it cannot prevail.¹⁰ See Trademark Rule 2.132(a).

Returning to the question of suspension, inasmuch as there is nothing left to try or argue in this proceeding, petitioner's motion to suspend is DENIED. Trademark Rule 2.117(b).

Accordingly, the petition to cancel is DENIED with prejudice.

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¹⁰ Conspicuously missing from petitioner's pleadings and the record is proof of petitioner's ownership of either a trademark registration or of a common-law mark. The grounds for cancellation set out in the petition are likelihood of confusion and false suggestion of a connection with petitioner's marks.

Although petitioner pleaded ownership of common-law marks in the petition to cancel, such matters were denied in respondent's answer, and are therefore subject to proof. Without such evidence, petitioner can prove neither its standing nor its substantive claims. Even if the documents attached to petitioner's notice of reliance were admissible (which they are not), they would not be sufficient to establish petitioner's ownership and prior use of the asserted marks. The documents are not admissible to prove the truth of any matters asserted therein and, in any event, there is no clear indication of whether they were ever circulated to the public (and if so, when) in such a manner as to create the prior trademark rights asserted in the petition.