

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Paul G. Connors
v.
Perfect Partners, Inc. and Vodka Perfect, Inc., joined as
party defendants¹

Cancellation No. 92043707

Carl J. Spagnuolo of McHale & Slavin, P.A. for Paul G.
Connors.

Jean S. Perwin for Perfect Partners, Inc. and Vodka Perfect,
Inc.

Before Quinn, Kuhlke and Walsh, Administrative Trademark
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Paul G. Connors has petitioned to cancel the following
registration on the Supplemental Register owned by Vodka
Perfect, Inc., assignee of Perfect Partners, Inc., for the
mark VODKA PERFECT (in typed form, Vodka disclaimed) for

¹ Joined by Board order on December 22, 2005.

"vodka" in International Class 33.² As grounds for cancellation petitioner asserts the claim of nonuse.³ More specifically, petitioner alleges that respondent "never had such goods" and that respondent is not using its mark in interstate commerce. Petition to Cancel ¶8.

Respondent, in its answer, admits to periods of nonuse between 2002 and 2003 and denies the remaining salient allegations in the petition for cancellation.

The record includes the pleadings; the file of the registration sought to be cancelled; respondent's responses to petitioner's first requests for admissions and first, second and third set of interrogatories, respondent's pending application for registration of the mark VODKA PERFECT and the discovery deposition of Russ Kramer with accompanying exhibits made of record by petitioner's notice of reliance; and respondent's pending application for registration of the mark PEUREUX PERFECT 1864, the discovery

² Registration No. 2468574, issued July 10, 2001. As noted in the Board's December 22, 2005 order, although a data processing error at the USPTO resulted in issuance of Registration No. 2468574 with the goods listed as "mark sought to be registered is in lawful use in interstate commerce in connection with the services," the goods in the underlying application are listed as vodka.

³ Although it was not clear in the petition if petitioner was also asserting a claim of abandonment, petitioner clarified in its brief that the only claim in issue is nonuse. Reply Br. p. 13.

deposition of Paul G. Connors, and a settlement agreement made of record by respondent's notice of reliance.⁴

Standing

It is clear from the record that petitioner is engaged in efforts to import vodka for sale in the United States under the mark PERFECT VODKA and respondent has admitted that petitioner has filed an application for the mark PERFECT VODKA for alcoholic beverages. Thus, the record sufficiently shows that petitioner has a real interest in canceling respondent's registration of the mark. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999).

NONUSE

A "mere token sale or shipment of the goods does not constitute 'use' under the Trademark Act." *Westrex Corp. v. New Sensor Corp.*, ___ USPQ2d ___, Opp. Nos. 91168152 and 91170940 (TTAB May 11, 2007). See also *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1774 (TTAB 1994). We look

⁴ Included in respondent's notice of reliance under Trademark Rule 2.122(e) were various invoices objected to by petitioner in its brief as not qualifying for inclusion into evidence by notice of reliance. Petitioner's objections are well taken, these items do not fall into either the category of printed publications or official records under Trademark Rule 2.122(e) and have not been considered. *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 74 n. 2 (TTAB 1983). We note that the settlement agreement submitted therewith also is not proper matter to be made of record by notice of reliance. Trademark Rule 2.122(e). However, inasmuch as petitioner has not objected to the settlement agreement, we have considered it for whatever probative value it may have. See TBMP §704.08 (2d ed. rev. March 2004) and cases cited therein.

to the circumstances surrounding the alleged first use in commerce and subsequent sales or activities in determining whether or not respondent's use was sufficient to support a registration.

The underlying application of the subject registration was originally filed based on an intention to use the mark in commerce under Section 1(b) of the Trademark Act. On November 17, 2000, respondent filed an Amendment to Allege Use claiming January 29, 2000 as the date of first use. Based on this record, it is established that the Millennium Spirits Company, respondent's assignor, on January 29, 2000, prior to the November 7, 2000 filing date of the Amendment to Allege Use, sold a single bottle of vodka through an importer to a company named Canal Discount Liquors. The record is unclear as to the nature of that sale inasmuch as it appears that labels for alcohol must receive approval from the Department of the Treasury Bureau of Alcohol, Tobacco and Firearms and the application for certificate of label approval that is of record was filed after the "sale" on February 4, 2000, and was apparently for a slightly different label than the one involved in the January 29, 2000 sale. There is nothing in the record regarding approval of the label used in the first sale. Kramer Dep. pp. 89-93. In addition, the record is not clear as to which mark was used in connection with that sale: MILLENIUM VODKA

PERFECT, VODKA PERFECT, or some combination thereof, and if VODKA PERFECT appeared with the word MILLENIUM, how it appeared, e.g., was the word MILLENIUM set apart or in smaller letters. Although the specimen of use submitted with the Amendment to Allege Use clearly shows the mark VODKA PERFECT on the front label the record is unclear as to whether that was the label on the bottle that was sold on January 29, 2000. Kramer Dep. pp. 91-93.

The settlement agreement assigning rights in the VODKA PERFECT mark from the Millennium Spirits Company to respondent was executed on March 14, 2000. There have been no further sales of vodka under the mark VODKA PERFECT until 2005. The record reveals, in addition to the sale of the single bottle of vodka, the following activities respondent has put forth as use to support its registration:

- 1) respondent entered into an agreement with a distillery on July 3, 2000;
- 2) respondent entered into a marketing agreement with an importer on February 23, 2001;
- 3) respondent entered into a supplier agreement with a distiller on July 3, 2002;
- 4) respondent entered into an agreement with another distributor on March 11, 2004;
- 5) respondent entered into an agreement with another company on September 7, 2004; and
- 6) respondent has used the mark in presentations directed to distributors and potential investors, developed marketing materials and created a website in 2004.

Kramer Dep. Exh. C.

Even assuming that respondent enjoys any benefits the January 29, 2000 sale may confer, that sale, of a single

bottle of vodka, clearly is not sufficient technical trademark use to support a registration. Further, the subsequent actions do not serve to bolster that sale in such a manner to constitute use to support registration.

The list of sporadic activities undertaken by respondent after the January 29, 2000 "sale" are more in the nature of evidence to support analogous use in a priority battle, which is not relevant here inasmuch as no such claim is at issue. We further note that we render no opinion as to whether the proffered evidence would be adequate to support such a claim. While use analogous to trademark use is sufficient use to establish priority rights against subsequent users of a mark, it is not sufficient to establish use as a basis for an application to register. *Shalom Children's Wear, Inc. v. In-Wear A/S*, 26 USPQ2d 1516, 1519 (TTAB 1993). Thus, respondent's reliance on the cases that discuss analogous trademark use is misplaced. Those cases involved priority disputes in which analogous trademark use is relevant. For example, *Miller Brewing Company v. Oland's Breweries*, 548 F.2d 349, 192 USPQ 266 (CCPA 1976) involved a priority dispute and a question of abandonment, neither of which is present in this case. In *Marvel Comics Ltd. v. Defiant*, 837 F.Supp. 546, 28 USPQ2d 1794 (SDNY 1993), the court noted that pre-sale use can provide a basis for priority and the "procedure for

submitting specimens in support of applications for trademark registration, has little to do with commercial use which is determined as a matter separate from and independent of trademark registration with the Patent and Trademark Office, and is based entirely on association of the mark in the public mind with a particular product, regardless of how that association is achieved." *Marvel, supra*, 28 USPQ2d at 1796.

Therefore, to the extent respondent's activities would serve to explain respondent's interruption of use to rebut an allegation of abandonment, that issue is not before us, and to the extent they are presented as evidence of ongoing use they are not sufficient because it is not technical trademark use. In short, the technical trademark use needed to support registration of a mark based on use did not occur prior to the filing of the Amendment to Allege Use. Respondent's "use" simply does not rise to the level of a "bona fide use of a mark in the ordinary course of trade." 15 U.S.C. 1051(a). The sale of a single bottle to one retailer certainly alone does not constitute "use," and respondent's subsequent sporadic activities and eventual sales more than five years later do not imbue this "sale" with the technical trademark use necessary to support registration.

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In view of our determination that only token use was made prior to the November 7, 2000 filing of the Amendment to Allege Use, petitioner has proven the claim of nonuse.

Decision: The petition to cancel Registration No. 2468574 based on the claim of nonuse is sustained.