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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92044571
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Petitioner submits this reply brief in further support of its Petition to Cancel Registrant's U.S. Trademark Registration Nos. 549,924 and 937,651 for the mark JONATHAN LOGAN for use in connection with women's clothing in Int'l Class 25, and in further support of Petitioner's motion to strike all of Registrant's trial evidence.

### **I. Registration No. 549,924 Must Be Cancelled**

As set forth in Petitioner's moving papers, Registrant failed to produce in discovery or introduce at trial a single document that references or confirms the sale of JONATHAN LOGAN brand women's dresses in U.S. commerce at any point after the registration was renewed on December 13, 2001. (Pet. Br. at 13). As a result, there is no evidence of record to support Registrant's use of the JONATHAN LOGAN mark in connection with women's dresses at any point from December 13, 2001 to the date Petitioner commenced the instant proceeding on May 31, 2005 – a period in excess of three years. Pursuant to 15 U.S.C. § 1127, “non-use for 3 consecutive years shall be *prima facie* evidence of abandonment.” *See also Emergency One, Inc. v. American FireEagle, Ltd.*, 56 U.S.P.Q.2d 1343 (4th Cir. 2000) (“Non-use for three consecutive years alone, however, constitutes *prima facie* evidence of abandonment”).

Registrant fails to address this issue in its trial brief and, as such, has utterly failed to meet its burden of producing evidence to rebut the claim of abandonment.<sup>1</sup> Indeed, all of Registrant's arguments are directed to evidence in support of the goods identified in Registration No. 937,651.<sup>2</sup> In light of the complete absence of proof without explanation by Registrant, Petitioner respectfully submits that Registration No. 549,924 must be cancelled.

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<sup>1</sup> Once a *prima facie* case of abandonment is established, the burden of production shifts to Registrant to rebut the claim. Of course, the ultimate burden of proof remains with Petitioner at all times. *See Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 13 U.S.P.Q.2d 1307 (Fed. Cir. 1989).

<sup>2</sup> For example, Exhibits 2-4 and 11-12 reference pants and/or pant suits, while Exhibit 10 is for men's clothing. None of Registrant's trial exhibits reference “women's dresses” in any respect.

Accordingly, the lone remaining issue for the Board's consideration is whether Petitioner has satisfied its burden to demonstrate a *prima case* of abandonment of Registration No. 937,651, and, if so, whether Registrant has come forward with evidence sufficient to rebut the *prima facie* case of abandonment.

**II. Petitioner Has Satisfied Its Burden to Show  
Prima Facie Abandonment of Reg. No. 937,651**

Registrant criticizes the testimony of Petitioner's trial witness, Michael Reich, for his supposed lack of detail regarding the non-use of Registrant's marks after the year 2000. (Reg. Tr. Br. at 2-5). In response, it is important to clarify at the outset that to establish a *prima facie* case of abandonment, Petitioner need only show non-use of Registrant's mark for three consecutive years. 15 U.S.C. § 1127; *Emergency One, Inc.*, 56 U.S.P.Q.2d at 1346. To that end, Petitioner has the difficult task of proving a negative, *i.e.*, that Registrant failed to "use" the mark in commerce for three consecutive years during the relevant time period.<sup>3</sup> Against this backdrop, and placed into proper context, it is evident that Petitioner has satisfied its burden to establish a *prima facie* case of abandonment through proof of non-use of the mark for three years.

Petitioner's witness, Mr. Reich, testified based on his own personal observation and investigation that he did not see any indication that JONATHAN LOGAN brand product was offered for sale in the U.S. after the year 2000 – he did not see apparel product in retail stores, nor did he see the brand advertised during that time. (Reich Test. Dep. at 10; 15-17; 26-28). Mr. Reich is an experienced businessman, with a long history of manufacturing and selling licensed goods and a familiarity with the apparel industry. (*Id.* at 6-8). As such, his testimony regarding his own personal observations regarding the absence of JONATHAN LOGAN apparel in the U.S. from

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<sup>3</sup> The parties are in agreement that the relevant period is the three-year period prior to the filing of the Petition for Cancellation on May 31, 2005.

2002 to 2005 should be credited and should serve to establish a *prima facie* case of non-use.

### **III. Registrant Failed to Rebut the Prima Facie Case of Abandonment**

As a threshold matter, Registrant failed to rebut Mr. Reich's testimony with testimony from any of its own witnesses. Indeed, Registrant did not put forward a single witness to testify based on personal knowledge that JONATHAN LOGAN brand clothing was sold in the U.S. from 2002 to 2005. Under cross-examination, both Stacy Haigney and Harry Adjmi conceded that they had no personal knowledge of any sales of JONATHAN LOGAN brand product in the U.S. from 2002 to 2005. (Haigney Test. Dep. at 53-54; Adjmi Test. Dep. at 18-19, 20).

With respect to the documents that Registrant sought to introduce at trial, the following points serve to undermine Registrant's arguments in its trial brief and in opposition to Petitioner's motion to strike:

First, Registrant concedes that Exhibits 6 – 8 were first given to Registrant's counsel just prior to Mr. Haigney's testimonial deposition on October 2, 2007. (Reg. Tr. Br. at 18). While that may serve to explain why the documents were not produced to Petitioner during discovery in response to Petitioner's First Set of Document Requests to Applicant, it does not mean that Registrant should nevertheless be permitted to rely on the documents at trial under the governing law. The Board is clear in this regard – if the documents or information are not produced during discovery in response to a due demand therefor, they may not be introduced and relied upon at trial by the non-producing party on grounds of equitable estoppel. *See, e.g., Weiner King, Inc. v. Weiner King Corp.*, 204 U.S.P.Q. 820, 829 (C.C.P.A. 1980) and cases cited at page 6 of Petitioner's Trial Brief. Petitioner respectfully asks for strict enforcement of this well-settled procedural rule in this regard.

Second, Registrant responds to Petitioner's motion to strike Exhibits 2 - 8 and 11 - 14 on the grounds of lack of foundation, hearsay and improper authentication by claiming that Messrs. Haigney and Adjmi were proper record custodians in accordance with Fed. R. Evid. 803(6). (Reg. Tr. Br. at 15-16). The evidentiary record, the text of Rule 803(6) and the very case that Registrant relies upon all belie Registrant's argument, however.

As a threshold matter, Rule 803(6) requires business records to be introduced by "the custodian or other qualified witness ...." The Rule also requires that: (1) it was the regular practice of Registrant to make the document; and (2) it was Registrant's "regular practice to get information from" the person who actually created the records" *Saks Int'l v. M/V Export Champion*, 817 F.2d 1011, 1013 (2d Cir. 1987).

It is clear that Messrs. Haigney and Adjmi were not proper custodians of Exhibits 2 - 8 or 11 - 14. Mr. Adjmi conceded that he was not the custodian of records and Mr. Haigney testified that the documents were created by and maintained by others at Burlington Coat Factory. (See Pet. Tr. Br. at 8-9). As a result, the issue is whether they nevertheless may be considered qualified witnesses in accordance with Rule 803(6). Registrant relies on *Saks Int'l v. M/V Export Champion*, 817 F.2d 1011, 1013 (2d Cir. 1987) to support the proposition that the documents must have "sufficient indicia of trustworthiness to be considered reliable." (Reg. Tr. Br. at 15). While this general statement of law is correct, the case actually supports the plain language of Rule 803(6) that a witness with knowledge of the documents is required. Indeed, the Second Circuit permitted introduction of the documents specifically because they were introduced by a witness with knowledge, as follows:

In the present case, the African tallies were prepared by unidentified employees of the company that provided stevedoring services at Abidjan and San Pedro. No employee of that company testified. ***Rather, the foundation for introduction of the African tallies was***

*provided by the testimony of the EXPORT CHAMPION's chief mate, whose responsibilities included supervising the loading of the cargo and whose knowledge of the workings of the tally system apparently was unchallenged by Maher at trial.* The mate testified, *inter alia*, that it is the customary course of business in the cargo trade for shore-side stevedores to prepare loading tallies and for the ship to retain them and to rely on them to establish the actual loading count; that there is no custom or practice requiring that these tallies be signed; that it is customary for ship personnel to do only a spot check for accuracy; and that the results of his spot checks on the loading of the coffee in this case were consistent with the loading tallies. In light of this testimony, we see no abuse of the court's discretion in concluding that the African tallies were sufficiently reliable to be admitted as business records.

*Saks Int'l v. M/V Export Champion*, 817 at 1013 (emphasis added).

Here, in sharp contrast, the Exhibits at issue were introduced by witnesses with no knowledge of the contents of the documents or the circumstances surrounding their creation. Mr. Adjmi confirmed on cross-examination that he had no knowledge of any matter pertaining to the JONATHAN LOGAN brand prior to the date his company acquired the marks in April, 2006. (Adj. Test. Dep. at 19-20). The documents were created by Registrant's predecessor and Registrant had no involvement with, or knowledge of, their creation or with the business of manufacturing and selling JONATHAN LOGAN apparel at that time. (*Id.*)

Similarly, Mr. Haigney, the General Attorney for Burlington Coat Factory, had little more than "informed speculation" about how the documents were created (*Id.* at 13).

Hence, Registrant has utterly failed to lay a proper foundation for introduction of Exhibits 2-8 and 11-14 at trial.

Finally, Registrant is simply mistaken that the records at Exhibits 11 and 12 "show use of the Trademarks during the Relevant Period ...." (Reg. Tr. Br., at 16). A close examination of the documents shows that they are dated after May 31, 2005 and/or contemplate shipment of the merchandise after that date.

**CONCLUSION**

For the reasons stated herein and in Petitioner's Opening Trial Brief and Motion to Strike, Petitioner respectfully urges the Board to sustain this cancellation proceeding, to cancel Registration Nos. 549,924 and 937,651 for the mark JONATHAN LOGAN, and for such other and further relief as the Board deems just and proper.

Dated: Norwalk, Connecticut  
April 22, 2008

Respectfully submitted,

THE PETITIONER,

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**CERTIFICATE OF SERVICE AND FILING**

This certifies that a copy of the foregoing Reply Brief was served on the Registrant on the date indicated below by placing an envelope and depositing same with the United States Postal Service as First Class Mail, Postage Prepaid, addressed to Registrant's counsel of record:

Harlan Lazarus, Esq.  
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and further certifies that the Trial Brief and Motion to Strike were filed with the Trademark Trial and Appeal Board via the Board's electronic filing system on the date indicated below.



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Edmund J. Ferdinand, III

Dated: April 22, 2008