

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

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March 10, 2010

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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The North Face Apparel Corp.

v.

Gerald L. Baranzyk

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Cancellation No. 92046488

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Susan M. Kayser of Howrey, LLP for The North Face Apparel Corp.

Gerald L. Baranzyk, pro se.

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Before Seeherman, Kuhlke and Walsh, Administrative Trademark Judges.

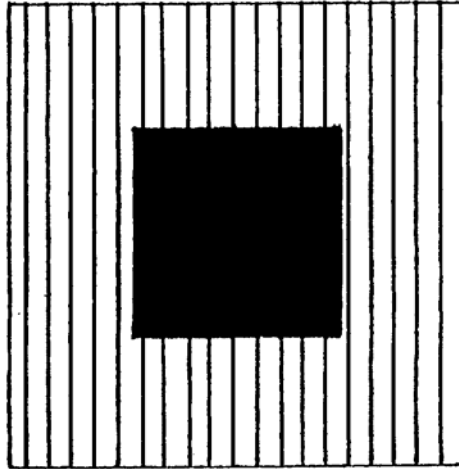
Opinion by Seeherman, Administrative Trademark Judge:

This is a cancellation proceeding in which The North Face Apparel Corp. (petitioner) seeks to cancel Registration No. 2310097, owned by Gerald L. Baranzyk (respondent), for the design mark shown below, for "clothing, namely caps, shirts and jackets." The registration, which issued on the Supplemental Register on January 18, 2000,<sup>1</sup> describes the

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<sup>1</sup> A Section 8 affidavit of use has been accepted.

mark as being "lined for the color red. The black square center is also a trademark feature."



The grounds for cancellation, in the petition as amended, are abandonment and fraud. Petitioner has alleged that its application, Serial No. 78797195, has been refused registration on the ground of likelihood of confusion in view of respondent's registration; that, upon information and belief, respondent no longer uses his mark in commerce and that he has abandoned his registration; that upon information and belief respondent's mark has not been in use in commerce on all the goods identified in his registration for the three years preceding the filing of the petition for cancellation; that on April 14, 2005 respondent submitted a Section 8 Statement of Use representing that he was using his mark in commerce in connection with clothing, namely caps, shirts and jackets, the goods identified in his

registration; that upon information and belief respondent's mark was not in use in commerce on April 15, 2005 on all the goods identified in the registration; that upon information and belief respondent's representations to the Trademark Office regarding the use of the mark in his Section 8 Statement of Use were false at the time respondent made them; that upon information and belief respondent knew that his representations were false at the time he made them; that upon information and belief, respondent made such representations with the intent that the Trademark Office would rely on them in accepting the Section 8 declaration; that upon information and belief respondent made each such representation willfully, knew that they were false, and/or made them with the intent that the Trademark Office would rely on them (§ 12);<sup>2</sup> and that respondent's representations were material to the Office's acceptance of the Section 8 declaration and the Trademark Office relied on respondent's representations in connection with its acceptance of the Section 8 declaration.

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<sup>2</sup> Paragraph 12 of the pleading originally included the language "knew or should have known." In its brief petitioner has requested that we strike the phrase "should have known," pointing out that this standard was correct at the time it filed its amended petition, under the Board's decision in *Medinol v. Neuro Vasx, Inc.*, 67 USPQ2d 1205 (TTAB 2003), but that, as a result of the Federal Circuit's decision in *In re Bose Corp.*, 91 USPQ2d 1938 (Fed. Cir. 2009), the "should have known" standard is no longer correct. In view of the Federal Court's decision, and because respondent has not objected to the motion and therefore it is appropriate for us to treat it as conceded, we have struck "should have known" from the pleading.

With respect to respondent's "answer" to the amended petition to cancel, the following quote from the Board's May 6, 2009 order gives a concise summary of what transpired:

On December 16, 2008 the Board acknowledged the amended petition to cancel filed on October 15, 2008 as the operative pleading in this proceeding. Beginning with its December 16, 2008 order, the Board has provided respondent three successive opportunities in which to properly answer the allegations contained in the amended petition to cancel. Respondent's most recent two communications, filed on April 17, 2009 and April 24, 2009 in response to the Board's April 13, 2009 order, again fail to constitute a proper answer to the amended petition to cancel, and again fail to indicate proof of service on counsel for petitioner as required under Trademark Rule 2.119 and as explained in previous orders in this proceeding.

Although not in compliance with Fed. R. Civ. P. 8(b) or Trademark Rule 2.114(b), the substance of respondent's filings indicates a good faith attempt to controvert the allegations contained in the amended petition to cancel, and indicates that respondent does not admit or concede the grounds stated therein. In view thereof, the Board construes respondent's papers as a general denial of the salient allegations set forth in the amended petition to cancel.

Accordingly, we treat applicant as having answered the petition to cancel by denying the allegations therein. As for any statements made by respondent in these "answering papers" that discuss any of the evidence submitted by

petitioner,<sup>3</sup> those assertions, and the exhibits accompanying the paper filed on January 15, 2009, cannot be treated as proof. Allegations in pleadings do not constitute evidence, and exhibits attached to pleadings, with the exception of a petitioner's registrations, are not of record unless properly made of record during a party's testimony period.

Only petitioner has submitted any evidence, consisting of a notice of reliance by which it made of record respondent's responses to its interrogatories; its requests for admission, to which respondent did not respond;<sup>4</sup> a copy of the Office action refusing registration to petitioner's

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<sup>3</sup> Petitioner filed its motion to amend its pleading on October 15, 2008, the opening day of its testimony period, and the Board granted the motion on December 16, 2008. During the intervening time petitioner's testimony period was open, and petitioner took testimony depositions and filed a notice of reliance. Consequently, when the Board set a date for respondent to file his answer to the amended petition to cancel, respondent was already aware of petitioner's testimony, which had been submitted in November 2008.

<sup>4</sup> Petitioner also submitted a copy of its request for production of documents which it served on respondent, and to which it states respondent did not respond. Documents produced in response to a request for production of documents cannot be made of record by notice of reliance, see Trademark Rule 2.120(j)(3)(ii). While a party may show through a notice of reliance that its adversary stated in response to a document production request that it had no documents, the fact that respondent did not file any response whatsoever to the document production request is neither proper subject matter for a notice of reliance nor does it have any probative value. That is, the failure to respond to a document production request does not result in our deeming respondent to have no documents applicable to the request, as we would have if the respondent had answered "none" or "no such documents." The proper procedure, if petitioner wanted respondent to respond to a document production request, would have been to file a motion to compel.

mark; and a copy of a filing in the instant proceeding.<sup>5</sup>

Petitioner also took the testimony of Lisa Leonard, Kimberly McCarthy and William O'Brien, third-party witnesses who are private investigators.

The only filing by respondent subsequent to the Board's May 6, 2009 order (which, as noted, construed prior filings as respondent's denial of the allegations in the amended petition to cancel) is entitled "The Registrant's Response to the Letter of Suspension to TNFAC" (petitioner). This paper was filed on July 9, 2009, during respondent's testimony period. However, it consists only of a statement by respondent which is essentially argument about why his mark and the petitioner's mark are different, and why there is no likelihood of confusion (which is not a ground in this proceeding). This paper in no way meets the requirement for an evidentiary submission. The statements were not provided through a testimony deposition, nor did the parties stipulate that respondent could submit his testimony in the form of an affidavit or declaration and, in any case, the submission is not in that form. Throughout this proceeding the Board has indicated to respondent, who has been acting pro se, that it is advisable for those who are unfamiliar

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<sup>5</sup> Petitioner also submitted a copy of the Section 8 declaration that respondent submitted in connection with the maintenance of the registration that is the subject of this proceeding. Because the registration file is automatically part of the record, there was no need to submit this under a notice of reliance.

with Board practice to secure the services of an attorney who is familiar with such matters, and that "strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel." Board order mailed May 16, 2007. Because respondent's July 9, 2009 filing does not meet the requirements for the submission of testimony or evidence, it has been given no consideration.

Only petitioner filed a brief.

Standing

Petitioner has made of record an Office action issued in connection with application Serial No. 78797195 showing that it is the applicant and that its application has been refused registration because of a likelihood of confusion with the mark in Registration No. 2310097, which is the subject of this proceeding. Because respondent's registration has been cited as a bar to the registration of petitioner's mark, petitioner has shown that it has a real interest in this proceeding, and that it is not a mere intermeddler. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Accordingly, petitioner has established its standing.

Abandonment

Section 24 of the Trademark Act, 15 U.S.C. §1092, provides, in part, that a person who believes that he is or will be damaged by a registration on the Supplemental Register may, for any grounds other than dilution, file a petition for cancellation at any time. Section 14(3) of the Act, (15 U.S.C. §1064(3)), lists, as one of the grounds for cancellation, abandonment, and Section 45 of the Act, 15 U.S.C. §1127, defines "abandonment" of a mark in pertinent part 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.

To show nonuse of the mark, petitioner has submitted the testimony of three private investigators. Lisa Leonard prepared a report on an investigation on October 13, 2006 (five days before petitioner filed its petition to cancel respondent's registration), in which she stated that, on October 10, 2006, she was unable to locate any apparel featuring respondent's design mark. Ms. Leonard and her colleague, Kimberly McCarthy, undertook an additional investigation at the end of August 2008, and continuing to September 5, 2008, in which they again tried to determine



whether respondent's mark was being used, and again found no information. During that same time period, over Labor Day Weekend 2008, William O'Brien, another investigator, personally visited over 30 retail outlets in Hayward, WI, the town where respondent lives, and did not find any clothing bearing respondent's mark, or anyone who was aware of such clothing.

We have some concerns about the probative value of these investigations. In view of the fact that respondent stated, in answer to petitioner's interrogatories, that the channels of trade for his goods were "mail, phone," Interrogatory No. 6, it is not particularly noteworthy that Mr. O'Brien was unable to discovery any clothing bearing respondent's mark in retail stores in Hayward, WI. And since respondent answered "no" to whether he promoted his mark online, Interrogatory No. 11, the 2008 investigation retrieving no information about respondent or sales of his clothing at various online websites is also not particularly surprising. As for the investigation in September and October 2006, Ms. Leonard's report stated that she began conducting research on respondent himself through public and private databases, and through them found a home address on West Second Street in Hayward, WI; that the telephone number for this address was issued to Leo G. Baranzyk; that she could not determine whether respondent and Leo G. Baranzyk

were the same person; that when she called this number there was no answer; that there was a company, Gerald L. Baranzky, located at the post office box address given by respondent in this proceeding; and that she was unable to find any evidence of use of respondent's mark on clothing, although she provided no other details regarding her efforts.

However, as previously noted, respondent did not respond to petitioner's requests for admission, duly served on May 6, 2007, during the discovery period. Accordingly, we must deem these requests to be admitted. Fed. R. Civ. P. 36(a)(3). Thus, respondent has admitted that he does not use his mark on shirts, jackets and caps.<sup>6</sup>

We treat respondent's admissions as evidence that he was not using his mark on the clothing items as of May 6, 2007 through July 10, 2009, the last day of respondent's testimony period and therefore the last point at which respondent could have controverted that admission. Thus, any deficiencies in the investigations ordered by petitioner in 2008 are of no moment, since the deemed admissions are sufficient to show respondent was not using his mark for clothing items during this time period. As for the 2006 investigation, even if we accept that Ms. Leonard's findings

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<sup>6</sup> The specific requests read: 1. Admit that Registrant does not use the mark on shirts. 2. Admit that Registrant does not use the mark on jackets. 3. Admit that Registrant does not use the mark on caps.

are sufficient to prove that respondent was not using his mark on clothing on October 10, 2006, as stated in the report, the period of nonuse shown by petitioner is less than three years.

Because a trademark owner's certificate of registration is "prima facie evidence of the validity of the registration" and continued use of the registered mark, the burden of proof is placed upon those who seek cancellation. *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989). In order to prove abandonment, one must show nonuse of the mark and an intent not to resume use. However, because of the difficulty in proving the second element, a plaintiff may rely on the statutory presumption that three years of nonuse is evidence of abandonment.

In the present case, however, petitioner has failed to show nonuse of the mark for three consecutive years, nor has it otherwise met its burden of showing that respondent had no intent to resume use of the mark.<sup>7</sup> As a result, respondent was under no obligation to submit evidence to

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<sup>7</sup> For example, petitioner, in its interrogatories, did not ask for information regarding respondent's sales of his goods under the mark for each of the three years prior to the filing of the petition to cancel, nor did respondent request that respondent admit that he did not use his mark on each category of his goods for each of the years prior to the filing of the petition to cancel. Such information might have been probative of nonuse of the mark for three consecutive years, or of minimal or token use that would not meet the statutory requirement of bona fide use of such mark made in the ordinary course of trade.

either rebut petitioner's evidence of nonuse or to demonstrate his intention to resume use of his mark, such as by evidence to explain any nonuse. We find that petitioner has failed to prove the ground of abandonment, and the petition to cancel on this basis is dismissed.

Fraud

The second ground for cancellation is fraud in the maintenance of respondent's registration, and specifically that respondent made an intentionally false statement in his Section 8 declaration of use by stating that the mark was in use on the goods identified in his registration.

The Court in *In re Bose Corp.*, 91 USPQ2d 1938, 1939 (Fed. Cir. 2009), set out the relevant standard for proving fraud:

"Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application." *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 48 [1 USPQ2d 1483] (Fed. Cir. 1986). A party seeking cancellation of a trademark registration for fraudulent procurement bears a heavy burden of proof. *W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 377 F.2d 1001, 1004 [153 USPQ 749] (CCPA 1967). Indeed, "the very nature of the charge of fraud requires that it be proven 'to the hilt' with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party." *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981).

Respondent executed and filed his Section 8 declaration of use on April 14, 2005, stating that the mark was in use in commerce on the goods identified in his registration. Petitioner has not submitted any evidence that shows respondent's mark was not in use on his goods on that date; as previously discussed, the earliest point that petitioner has submitted any evidence whatsoever that respondent was not using his mark is October 2006. Because petitioner has failed to show that any statements made in respondent's Section 8 declaration were false, let alone proving this to the hilt, petitioner's claim of fraud must fail.

Decision: The petition to cancel is dismissed with respect to both the ground of abandonment and the ground of fraud.