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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

*Playdom, Inc.*
*v.*
*Couture*

Cancellation No. 92051115

Linda K. McLeod of Kelly IP, LLP for Playdom, Inc.

Richard N. Foley of the Law Offices of Richard Foley for David Couture.

Before Grendel, Bergsman and Gorowitz, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

David Couture ("respondent") is the owner of Registration No. 3560701 for the mark PLAYDOM, in standard character form, for the following services:

> Entertainment and educational services, namely, providing advice and information for music, video and film concept and script development; entertainment services, namely, a multimedia program series featuring comedy, action and adventure distributed via various platforms across multiple forms of transmission media; motion picture film production; production of television

programs; script writing services; scriptwriting services, in Class 41.[1]

Playdom, Inc. ("petitioner") filed a petition to cancel the registration on the grounds that respondent's application for registration was void *ab initio* because respondent had not rendered any services on or before the filing date of the application, abandonment, and, in the alternative, to restrict respondent's registration to "script writing services for television live action short videos" because that is the only service that respondent has actually rendered in connection with his mark.[2]

Respondent, in his answer, denied the salient allegations in the petition for cancellation.

The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), respondent's registration file. In addition, the parties introduced the following testimony and evidence:

A. Petitioner's evidence and testimony.

1. Notice of reliance on the prosecution file of petitioner's application Serial No. 77666627 for the mark PLAYDOM (TTABVue 35);

[1] Registered on January 13, 2009. Respondent's application for registration was based on an application filed under Section 1(a) of the Trademark Act of 1946, 15 U.S.C. § 1051(a), on May 30, 2008. Respondent claimed first use of his mark anywhere and first use of his mark in commerce on May 30, 2008.

[2] Petitioner withdrew its fraud claim. (Petitioner's Brief, p. 3 n.1). We construe petitioner's alternative claim to restrict respondent's registration under Section 18 of the Trademark Act, 15 U.S.C. § 1068, as an abandonment claim, not a claim under Section 18. *See* TBMP § 309.03(d) (TBMP June 2013).

2. Notice of reliance on excerpts from the discovery deposition of David Couture with attached exhibits (TTABVue 36);

3. Notice of reliance on respondent's responses to petitioner's Interrogatory Nos. 5-12 and 15 in accordance with Trademark Rule 2.120(j) (TTABVue 37); and

4. Notice of reliance on respondent's responses to petitioner's request for production of documents Nos. 11 and 12 to show that no documents exist in accordance with Trademark Rule 2.120(j) (TTABVue 38).

B. Respondent's evidence and testimony.[3]

1. Notice of reliance on excerpts from the discovery deposition of David Couture with attached exhibits which should in fairness be considered so as to make not misleading what was offered by petitioner in accordance with Trademark Rule 2.120(j)(4) (TTABVue 39);

2. Notice of reliance on petitioner's first requests for production of documents (TTABVue 40);

3. Notice of reliance on petitioner's objections and responses to respondent's first set of requests for the production and documents (TTABVue 41); and

4. Notice of reliance on petitioner's objections and responses to respondent's first of interrogatories (TTABVue 42).

[3] In the June 18, 2013 Order, the Board granted petitioner's motion to strike Exhibits 3, 4, 5 and 7 attached to respondent's first notice of reliance and Exhibits A and B attached to respondent's second notice of reliance.

Standing

On February 9, 2009, petitioner filed an application (Serial No. 77666627) to register the mark PLAYDOM, in standard character form, for goods in Class 9 and services in Classes 41, 42 and 45.[4] Respondent's previously registered mark PLAYDOM, Registration No. 3560701, involved herein, was cited as a Section 2(d) bar to registration.[5] In an Office action dated November 24, 2009, action on petitioner's application was suspended pending the disposition of this cancellation proceeding.[6] Petitioner has proven its standing by introducing evidence showing that it filed an application and that a rejection to register was made because of respondent's registration. *See Lipton Industries, Inc. v. Ralston Purina Company,* 670 F.2d 1024, 213 USPQ 185, 190 (CCPA 1982).

Whether respondent's application for registration is void *ab initio* because applicant failed to use the mark before he filed his use-based application?

A. Use in commerce.

In an application based on use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), the applicant must use the mark in commerce on or in connection with all the goods and services listed in the application as of the application filing date. *See* Trademark Rule 2.34(a)(1)(i), 37 CFR § 2.34(a)(1)(i).

Section 45 of the Trademark Act, 15 U.S.C. § 1127, provides that a service mark is used in commerce "on services when it is used or displayed in the sale or

[4] TTABVue 35, pp. 97 – 103.

[5] TTABVue 35, pp. 28 – 33.

[6] TTABVue 35, pp. 11 – 12.

advertising of services and the services are rendered in commerce, or the services are rendered in more than one State."

The services identified in a use-based service mark application must be rendered before the filing of a service mark application.

> [A] service mark applicant seeking to meet the use requirements of Section 1(a) of the Trademark Act of 1946, 15 U.S.C. § 1051(a), must (1) use the mark in the sale or advertising of a service and (2) show that the service was either rendered in interstate commerce or rendered in more than one state or in this and a foreign country by a person engaged in commerce.

*Aycock Engineering Inc. v. Airflite Inc.,* 560 F.3d 1350, 90 USPQ2d 1301, 1306 (Fed. Cir. 2009). *See also, Gay Toys, Inc. v. McDonald's Corporation,* 585 F.2d 1067, 199 USPQ 722, 723 (CCPA 1978) (because applicant did not use the mark in commerce in association with the goods at the time it filed the application, its application was void); *In re Cedar Point, Inc.,* 220 USPQ 533, 535 (TTAB 1983) (rights in mark arise through its use in connection with existing services); *Greyhound Corp. v. Armour Life Insurance Co.,* 214 USPQ 473, 474 (TTAB 1982) (application was void because at the time it was filed the mark had not been used in the sale or advertising of existing services); *Intermed Commc'ns, Inc. v. Chaney*, 197 USPQ 501, 507-08 (TTAB 1977) ("The statute requires not only the display of the mark in the sale or advertising of services but also the rendition of those services in order to constitute use of the service mark in commerce.").

Advertising must relate to "an existing service which has already been offered to the public." *Greyhound Corp. v. Armour Life Ins. Co.,* 214 USPQ at 474. The Board explained that "it is well settled that advertising of a service, without

performance of a service, will not support registration. … The use in advertising which creates a right in a service mark must be advertising which relates to an existing service which has already been offered to the public." *Id.* The mere use of a trademark in the advertising or promotion of services in the United States is insufficient to constitute use of the mark in commerce, within the meaning of the Trademark Act, where the advertising or promotion is unaccompanied by any actual performance of the services in commerce here. *Clorox Co. v. Salazar,* 108 USPQ2d 1083, 1086 (TTAB 2013).

B. Respondent had not rendered its services when it filed his application.

Based on the record in this case, we find that respondent did not use the mark PLAYDOM to identify the services listed in his application prior to the May 30, 2008 filing date. "Registrant's first use of the PLAYDOM mark was on May 30, 2008. Registrant purchased the website www.Playdom.com (and eventually www.PlaydomEntertainment.com) and published a website which contained a legitimate and valid offer of entertainment services, listed therein, in interstate commerce."[7] Respondent stated that his "[f]irst customer is pending" in response to Interrogatory No. 15 asking respondent to "[s]tate the number of customers annually for the past five years to whom Registrant has provided services bearing the PLAYDOM mark."[8]

[7] Respondent's response to petitioner's Interrogatory No. 5 requesting respondent to "[d]escribe in detail the facts and circumstances relating to Registrant's first use anywhere of the PLAYDOM mark." (TTABVue 37, p. 5).

[8] (TTABVue 37, p. 5).

Respondent's discovery deposition testimony failed to prove that respondent had rendered its services prior to the filing date of his application.

Q. Does Playdom Entertainment, Inc., have any customers? [9]

A. I have had a customer, yes.

Q. How many customers have you had?

A. One.

Q. Okay. And who was that customer at Playdom Entertainment, Inc.?

A. It was lagoon [sic].[10]

* * *

Q. So Lagoon Productions is the only customer that Playdom Entertainment, Inc. has ever had; correct?

A. Correct

Q. And I am seeing an invoice dated March 17th 2010.

A. Correct.

Q. What service did Playdom Entertainment provide to Lagoon Productions?

A. I provided writing and some production services for a digital medium.[11]

* * *

Q. When did you provide these services to Lagoon Productions?

[9] Playdom Entertainment, Inc. is respondent's dba. (Couture Dep., p. 22 (TTABVue 39, p. 18)). "Playdom Entertainment, Inc. is really [respondent]." (Couture Dep., p. 76 (TTABVue 39, p. 69)).

[10] Couture Dep., pp. 24 – 25 (TTABVue 39, pp. 20 – 21).

[11] Couture Dep., pp. 25-26 (TTABVue 39, pp. 21 – 22).

A. I - - do not recall. It was - - it was an ongoing - - it was a project; so I discussed it days before, and I might have finished it the first - - I finished one draft, I believe, on the 18th.

Q. The 18th of what?

A. Of March. It is March, yes.

Q. The 18th of March 2010?

A. 2010.[12]

* * *

Q. Besides Lagoon Productions, has Playdom Entertainment, ever provided services to any other customer?

A. I have offered writing services with scripts that had my trademark on it since May of - - May 30th, 2008.

Q. I am going to ask the question again. Have you actually provided services as Playdom Entertainment, Inc., to any other customer besides Lagoon Productions?

A. No.[13]

* * *

Q. Do you have any specific recollection of providing unpaid services as Playdom Entertainment, Inc., before July 22nd, 2008?

* * *

A. I do not have a specific recollection.[14]

* * *

Q. Had you offered Playdom Entertainment, Inc., services of any kind in any other way prior to May 30th [2008]?

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[12] Couture Dep., p. 29 (TTABVue 39, p. 25).

[13] Couture Dep., pp. 29 – 30 (TTABVue 39, pp. 25 – 26).

[14] Couture Dep., p. 36 (TTABVue 39, p. 31).

A. Not prior, no.[15]

Respondent filed a use-based application instead of an intent-to-use application based on his misunderstanding of the technical definition of use in commerce. Respondent thought that the offering of the services was sufficient to establish that he was rendering the services.

> Q. Please explain to me your understanding of the difference between a use application and an intent-to-use application at the time you filed this application on May 30th, 2008.
>
> A. Okay. I'll – Use in commerce must have - - you must advertise for services. You must advertise services and offer them for consideration in interstate commerce.
>
> Technically, it's advertising and rendering. It must be advertised and rendered in interstate commerce, and "rendered" is, from my research, is accepted as either an exchange of money for services or the legitimate offering of services for consideration in interstate commerce.[16]
>
> * * *
>
> Q. And it is your understanding of advertising and offering to render services - - is that your understanding of why you satisfied that requirement [using the mark in commerce]?
>
> A. My understanding is that - - this is from the - - verbatim from the U.S. PTO website. "Offering services via the Internet has been held to constitute use in commerce since the services are available to a national and international audience who must use interstate telephone lines to access a website."[17]

Respondent's argument that his "website, business cards, email addresses, scripts, and rendering of speculative/free services under the PLAYDOM Mark, prior

[15] Couture Dep., p. 50 (TTABVue 39, p. 43).

[16] Couture Dep., pp. 46- 47 (TTABVue 39, pp. 39 – 40).

[17] Couture Dep., pp. 48 (TTABVue 39, p. 41).

to Petitioner's use of the Infringing Mark anywhere, establishes Registrant's Priority over the PLAYDOM Mark" fails to address whether respondent had actually made technical use of his service mark sufficient to support registration as of the filing date of his application.[18]

The evidence of record shows that respondent had not rendered his services as of the filing date of his application. Respondent had merely posted a website advertising his readiness, willingness and ability to render said services. In view thereof, we find that respondent's mark PLAYDOM was not in use in commerce for the listed services at the time respondent filed its application, that the registration is therefore void *ab initio* and the petition to cancel is granted on this ground.

Whether respondent has abandoned his mark?

For purposes of completeness, we address the issue of whether the respondent has abandoned the use of his mark. This scenario presupposes that the Board's decision is appealed and the reviewing court finds that respondent rendered his services before or at the time he filed his application for registration and therefore respondent's application for registration is not void *ab initio*.

Under Section 45 of the Trademark Act of 1946, 15 U.S.C. 1127, a mark shall be deemed abandoned *inter alia*:

> (a) 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 abandonment. "Use" of a mark means the bona fide use of such mark made in the ordinary course of

[18] Respondent's Brief, p. 13.

> trade, and not made merely to reserve a right in the mark.

Under the Trademark Act, *prima facie* abandonment is established by proof of its nonuse for three consecutive years. To overcome that *prima facie* case, the respondent must come forth with evidence that it did not "discontinue" use of the mark, or if such use had been discontinued, the nonuse of the mark was without "an intent not to resume" use. *Imperial Tobacco Ltd. v. Philip Morris Inc.,* 899 F.2d 1575, 14 USPQ2d 1390, 1393 (Fed. Cir. 1990).

The record as noted above shows that respondent rendered script writing services to Lagoon Productions in March 2010. Because trial periods closed on January 21, 2013, petitioner failed to show three years of nonuse. Also, respondent testified that he has advertised his services through his website, the distribution of business cards and the submission of scripts to studios and production companies.[19] Respondent's website uses the URLs PLAYDOMINC.com[20] and PLAYDOMENTERTAINMENT.com.[21] Respondent's websites have been active without interruption, except for brief periods due to technical problems, since June 15, 2009.[22] In this regard, we note that respondent's website advertises that respondent uses the mark PLAYDOM to identify "writing and production services for motion picture film, television, and new media."[23] Respondent also offers

[19] Couture Dep., p. 47 (TTABVue 39, p. 40).

[20] Couture Dep., p. 49 (TTABVue 39, p. 42).

[21] Couture Dep., p. 58 (TTABVue 39, p. 51).

[22] Couture Dep., pp. 100 – 101 (TTABVue 39, pp. 86 – 87).

[23] Couture Dep., Exhibit 6 (TTABVue 39, p. 114).

"other services" – film, television, & new media," which he describes as "general consulting," namely, "development, production, post production, distribution."[24]

On the other hand, respondent testified that as Playdom Entertainment, Inc., he has not provided motion picture, television program, or multimedia program services.[25] In fact, respondent testified that his plans are limited to writing and production.

> Q. What are the plans for Playdom Entertainment, Inc., in the future?
>
> A. They are to sell services to - - writing and produce – producing services to networks, studios for television, film and Internet/new media.[26]

Furthermore, in response to petitioner's interrogatory No. 7 regarding respondent's use of PLAYDOM in connection with entertainment services, namely, a multimedia program series featuring comedy, action and adventure distributed via various platforms across multiple forms of transmission media, respondent replied that he "has completed scripts that are easily adapted to multimedia platforms and are available by request at [his website]."[27] In other words, because he has not yet adapted any scripts, he has not rendered those services and he has not provided any evidence that he is advertising those services.

With respect to whether respondent's alleged nonuse was without an intent not to resume use, respondent testified that he has "discussed possible other

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[24] Couture Dep., Exhibit 6 (TTABVue 39, p. 117).

[25] Couture Dep., p. 37 (TTABVue 39, p. 32).

[26] Couture Dep., p. 84 (TTABVue 39, p. 74).

[27] TTABvue 37, p. 5.

projects" with Lagoon Productions[28] and that his prospective customers include Twentieth Century, Fox, and ABC.[29] This testimony coupled with respondent's continuous advertising, albeit on a small scale, is sufficient to demonstrate that if respondent's lack of commercial success constitutes nonuse, that nonuse was without an intent not to resume use.

In view of the foregoing, we find that respondent has not abandoned his mark for "providing advice and information for music, video and film concept and script development" and "motion picture film production, production of television programs, and script writing services." However, respondent has abandoned his mark for "entertainment services, namely, a multimedia program series featuring comedy, action and adventure distributed via various platforms across multiple forms of transmission media."

The petition to cancel on the ground of abandonment is denied in part and granted in part. If on appeal, the finding that respondent's application for registration is void *ab initio* is reversed, then respondent's registration will be restricted by deleting "entertainment services, namely, a multimedia program series featuring comedy, action and adventure distributed via various platforms across multiple forms of transmission media."

**Decision**: The petition for cancellation is granted.

[28] Couture Dep., p. 29 (TTABVue 39, p. 25).

[29] Couture Dep., p. 69 – 71 (TTABVue 39, pp. 62 – 64).