

THIS OPINION
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Ronald W. Fontaine

v.

Light My Fire, AB

Cancellation No. 92051304
to Registration No. 2870820

Melissa A. Simola of Halberstadt Curley, LLC for Ronald W. Fontaine.

Andrea Anderson and Tyler J. Davis of Holland & Hart, LLP for Light My Fire, AB.

Before Quinn, Bergsman and Lykos, Administrative Trademark Judges.

Opinion by Lykos, Administrative Trademark Judge:

On August 3, 2009, Ronald W. Fontaine ("petitioner") filed a petition to cancel Light My Fire, AB's ("respondent") registration for the mark SWEDISH FIRESTEEL, in standard character format, for the goods listed in International Class 13: "hand-operated fire igniter in the form of metal sticks with

a holder and a tin, and hand-operated fire strikers."¹

Petitioner asserted as the sole ground for cancellation that respondent's mark is primarily geographically deceptively misdescriptive of respondent's identified goods pursuant to Section 2(e)(3) of the Trademark Act, 15 U.S.C.

§ 1052(e)(3). Respondent, in its answer, denied the salient allegations in the petition for cancellation.

I. The Record

Pursuant to Trademark Rule 2.122(b), the record includes respondent's registration file and the pleadings. In addition, the parties introduced the following:

A. Petitioner's Evidence

1. Petitioner's Notice of Reliance comprising the following items:
 - a. Petitioner's requests for admission nos. 6, 7 and 11 and respondent's responses thereto;
 - b. Petitioner's first set of interrogatory nos. 1, 3, and 4 and respondent's responses thereto;

¹ Registration No. 2870820, filed December 14, 2001 pursuant to Sections 1(b) and 44(d). The registration was issued on August 10, 2004 pursuant to both Sections 1(a) and 44(e) with a disclaimer of SWEDISH. "[A] registration more than five years old can be cancelled on the ground of geographic deceptiveness if a registrant, through its own actions, causes its mark to become geographically deceptive subsequent to the issuance of the registration". *K-Swiss Inc. v. Swiss Army Brands, Inc.*, 58 USPQ2d 1540, 1542-1543 (TTAB 2001). A partial Section 8 was filed and accepted for respondent's International Class 8 and 13 goods; respondent's International Class 6 goods were cancelled under Section 8.

- c. Petitioner's second set of interrogatory nos. 1-3 and respondent's responses thereto; and
- d. Petitioner's third set of interrogatory no. 4 and respondent's response thereto.

- 2. Declaration of Ronald W. Fontaine ("Fontaine Declaration"), petitioner, and Exhibits A-C.²

B. Respondent's Evidence

- 1. Respondent's amended notice of reliance comprising the following items:
 - a. Respondent's first set of interrogatories and petitioner's responses thereto;
 - b. Respondent's requests for admission and petitioner's responses thereto; and
 - c. Respondent's request for production of documents and things and petitioner's responses thereto.
- 2. The amended Declaration of J. Michael Odqvist ("Odqvist Declaration"), an owner and founder of respondent, with Exhibits A-J attached thereto.

II. Evidentiary Issues

Respondent has made the following evidentiary objections discussed below.

A. Respondent objects to portions of the Fontaine Declaration (§§ 14-19; 25-26) as well as Exhibits A and C attached thereto on relevancy grounds under Fed. R. Evid. 402. Specifically, respondent maintains that insofar as the statements and exhibits pertain to the issue of whether the term

² The parties stipulated to submit the testimony of their trial witnesses by declaration in lieu of oral deposition.

FIRESTEEL is generic, and because genericness is not a claim in this proceeding, the evidence is irrelevant. We disagree. The issue of whether the term FIRESTEEL is generic is relevant in determining the primary significance of respondent's mark. Accordingly, respondent's objection is overruled.

B. Respondent objects to the following articles submitted under Notices of Reliance Nos. 6-9 on the grounds that they are irrelevant because they pertain to the unpleaded issue of genericness:

-Ken Drouillard, *A Primer to Ignition and Tinder Sources for Basic Fire Starting, Forest and Stream*, <http://www.forestandstream.com>;

-"Ferrocerium," obtained from Wikipedia.com; and

-Schwert, *Ben's Backwoods Mini Firesteel*, *Outdoors-Magazine.com*, March 10, 2008.

Respondent, relying upon *In re IP Carrier Consulting Group*, 84 USPQ2d 1028, 1032 (TTAB 2007), also objects to the "Ferrocerium" entry from Wikipedia.com due to the collaborative nature of the web site.

For the same reasons articulated above, we overrule respondent's relevancy objections. As to the objection regarding the entry for "Ferrocerium" from Wikipedia.com, "the Board will consider evidence taken from Wikipedia so long as the non-offering party has an opportunity to rebut that evidence by submitting other evidence that may call into question the

accuracy of the particular Wikipedia information." *Id.* at 1032. In addition, "the better practice with respect to Wikipedia evidence is to corroborate the information with other reliable sources, including Wikipedia's sources." *Id.* Because respondent has not submitted evidence challenging the accuracy of the entry, and also petitioner has provided corroborative testimony on the subject of ferrocium, respondent's objection is overruled. Fontaine Declaration, ¶¶ 15-21, 23-24.

C. Respondent objects to the supplemental declaration of Ronald L. Fontaine (petitioner) submitted with petitioner's trial brief as untimely. It is well settled that evidence submitted outside of a party's assigned trial period, including evidence submitted with a brief, is untimely and will not be considered. *See* Trademark Rule 2.121(a). *See also* *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008). As such, respondent's objection is sustained; petitioner's supplemental declaration has been given no consideration.

III. **Standing**

To establish standing to petition to cancel respondent's registration, petitioner must prove that he has a real interest in the outcome of this proceeding and, thus, a reasonable basis for his belief that he would be damaged by the registration. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999).

Petitioner alleges in the petition to cancel that an attorney representing respondent sent petitioner a cease and desist letter stating the belief that petitioner's use of the mark FIRESTEEL was "infringing" upon respondent's SWEDISH FIRESTEEL mark; that in the letter, respondent demanded, among other things, that petitioner immediately cease "all marketing and sale of fire igniters under the FIRESTEEL mark...;" and that if petitioner refused to comply with respondent's demands, respondent would file an infringement lawsuit relying upon its registration. Petition to Cancel, ¶¶ 13-21. In addition, the complaint alleges that petitioner and respondent sell competing products. Petition to Cancel, ¶ 22.

Based on the record before, petitioner has standing to bring the instant case. A credible threat of litigation may constitute a basis for standing. See *Syntax U.S.A. Inc. v. E.R. Squibb & Sons, Inc.*, 14 USPQ2d 1879 (TTAB 1990). See also *Ipco Corp. v. Blessings Corp.*, 5 USPQ2d 1974 (TTAB 1988) (cease and desist letter coupled with plaintiff's use of mark sufficient to establish standing). Although not entered into the record by petitioner, the cease and desist letter referred to in petitioner's complaint submitted by respondent as Exhibit H to the Odqvist Declaration establishes petitioner's "real interest" in this proceeding. Once testimony or any other evidence is

introduced, it is of record for any purpose, and the adverse party need not take any action in order to rely on it.

In addition, "a party need not be a manufacturer or seller of the goods in connection with which a descriptive, misdescriptive, or merely ornamental designation is used in order to object to the registration thereof. It is sufficient that the party objecting to such registration be engaged in the manufacture and/or sale of the same or related goods and that the product in question be one that could be produced in the normal expansion of that person's business." *Federal Glass Co. v. Corning Glass Works*, 162 USPQ 279, 282-83 (TTAB 1969). See also *Corporacion Habanos S.A. v. Empresa Cuban del Tabaco, d.b.a. Cubatabaco*, __ USPQ2d __ (August 1, 2011, Cancellation No. 92052146) ("where... the pleaded ground is that the mark sought to be cancelled is deceptive under Section 2(a), or primarily geographically deceptively misdescriptive under Section 2(e)(3), petitioners do not need to own a pending application for the mark, do not have to be using the term as a mark, or even use the term at all, in order to establish their standing"). The averments in the Fontaine Declaration that petitioner sells fire starter devices and other wilderness-related products through his website are sufficient to establish petitioner's standing to bring this case. Fontaine Declaration, ¶¶ 3, 14-16.

IV. **Geographically Deceptively Misdescriptive**

As set forth in the case of *In re California Innovations, Inc.*, 329 F.3d 1334, 66 USPQ2d 1853, 1858 (Fed. Cir. 2003) the elements of a Section 2(e)(3) geographically deceptively misdescriptive claim are as follows:

- (1) the primary significance of the mark is a generally known geographic location;
- (2) the consuming public is likely to believe the place identified by the mark indicates the origin of the goods bearing the mark (i.e., that a goods/place association exists), when in fact the goods do not come from that place; and
- (3) the misrepresentation would be a material factor in the consumer's decision to purchase the goods.

With regard to the first prong, petitioner merely asserts that "the country of Sweden is known generally to the consuming public in the United States." Petitioner's Brief, p. 5. More specifically, petitioner failed to present any arguments or evidence regarding the "primary significance" of the mark SWEDISH FIRESTEEL. To state the obvious, Sweden is a generally known geographic location. See definition of Sweden from www.merriam-webster.com.³ In addition, we find that the word

³ The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002). See also *University of Notre Dame du Lac v. J. C. Gourmet Foot Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

FIRESTEEL does not detract from the primary geographic significance of the mark. *See, e.g., In re Wada*, 194 F.3d 1297, 52 USPQ 1539 (Fed. Cir. 1999) (the mark NEW YORK WAYS GALLERY projects a primarily geographic significance and the addition of WAYS GALLERY to NEW YORK does not detract from the primary significance of the mark); *In re Boyd Gaming Corp.*, 57 USPQ2d 1944 (TTAB 2000) (the primary significance of the marks ROYAL HAVANA RESORT & CASINO and HAVANA RESORT AND CASINO is geographic and the additional wording in the marks does not detract from the geographic meaning).

The second prong of the test involves two inquiries (1) whether there is a goods/place association; and (2) whether or not the goods come from the place named. The first inquiry requires proof that the public is likely to believe that respondent's goods originate in Sweden or in other words "whether the public would reasonably identify or associate the goods sold under the mark with the geographic location contained in the mark." *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778, 1783 (Fed. Cir. 2001). To establish such an association, petitioner may submit evidence showing that the area identified in the mark has, as one of its principal product, respondent's goods or related goods. Such evidence may include gazetteer or dictionary entries, news stories, expert testimony, consumer surveys, or consumer affidavits. *See*

Corporacion Habanos S.A. v. Anncas Inc., 88 USPQ2d 1785 (TTAB 2008). Cf. *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894, 1901 (TTAB 1992). In this case, petitioner has not proved that consumers associate the country of Sweden with the type of goods of respondent. The sole evidence petitioner can point to in the record is respondent's admission that the Swedish military uses fire starter devices.⁴ This, by itself, is insufficient to establish a goods/place association.

As to the second inquiry, petitioner, relying on the principle that "[a] product might be found to originate from a place where the main component or ingredient was made in that place," argues that respondent's finished products do not originate from Sweden. *Corporacion Habanos*, 88 USPQ2d at 1791 , citing *In re Joint-Stock Co. "Baik,"* 80 USPQ2d 1305 (TTAB 2006). Specifically, respondent contends that the flint rod is the "only essential part" of respondent's fire starter device because it is impossible to produce a spark in the absence of pyrophoric metals or ferrocium. Fontaine Declaration, ¶ 2. Respondent takes the position that because this main component is not produced in Sweden, respondent's finished goods do not originate from Sweden. Fontaine Declaration, ¶ 21.

⁴ As noted above, the supplemental declaration of petitioner submitted with his main brief was not properly made of record.

We find, however, that the record reflects otherwise, namely that each component part of respondent's goods plays an equally important and essential role in the proper functioning of the devices. While it is true that the flint is purchased from a vendor located outside of Sweden, respondent's fire starter products are comprised of five other component parts, all of which are manufactured in Sweden: (1) striker, (2) striker handle, (3) flint handle, (4) lanyard, and (5) lock. Odqvist Declaration, ¶¶ 12, 15. 18. Respondent manufactures the striker and flint handles in its production facility in Vastervik, Sweden. Odqvist Declaration, ¶ 14. The striker, lanyard, and lock are purchased from outside vendors all located in Sweden. *Id.* Respondent's testimony contradicts petitioner's assertion that the flint alone is the main component. As explained by one of respondent's founders:

13. The [fire starter] is an "all-in-one" product with the lanyard connecting both the flint and the striker so that the small components are always located together, and do not become separated. To make a fire, the user strikes the striker and flint together to create a spark. The handle allows the user to hold the flint comfortably, firmly, and steadily to create a spark with the striker. The lock and lanyard keep the striker together with the handle.
18. The SWEDISH FIRESETEEL fire starters are a "luxury grade" outdoor product, designed to provide superior functionality and ease of use over most common "flint and striker" fire starters. As such, there is no single component of our SWEDISH FIRESTEEL devices that is the main or primary

component of the product. Rather, all components of the product are necessary to the superior functioning of the product. For example, the lanyard is essential to keeping the striker together with the flint. In addition, the handles of the striker and the flint are necessary for maintaining a proper and comfortable grip on the tool, particularly in adverse weather conditions. Without either of these features, the product would not function as intended.

Odqvist Declaration.

Respondent has submitted documentary evidence to corroborate its testimony. Respondent's advertising brochure confirms the importance of other component parts such as the striker:

A flash of genius takes fire making to the next level. Originally developed for the Swedish Department of Defense, our legendary Swedish FireSteel® is the original fire starter. Being the best, however, means always having to push the envelope. The result is a new generation with an improved striker that makes it even easier to build a fire in any weather, at any altitude. *We Sell Fire*, 2010/2011.

Furthermore, when asked to "admit that the flint rod is the main component of the fire starter devices" sold under the SWEDISH FIRESTEEL mark, respondent responded with a denial. Response to Request for Admission No. 9.

Notwithstanding the above, the point of origin of a product may be determined in a number of other ways, including the place of packaging and distribution, *see e.g., In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001), or the location of the party's headquarters, research and development facilities, or place of

distribution, *see e.g., In re Nantucket Allserve Inc.*, 28 USPQ2d 1144, 1146 (TTAB 1993). Applying any of the above criteria, respondent's goods originate from Sweden. Respondent is a privately held company, organized under the laws of Sweden and headquartered in Mamo, Sweden. Odqvist Declaration, ¶ 2. Respondent's research and development center is located in Malmo, Sweden and its production facility is located in Vastervik, Sweden. Odqvist Declaration, ¶ 3. Respondent contracts with a Swedish state-owned company to assemble and package the firestarters from these component parts in Vastervik, Sweden. Odqvist Declaration, ¶ 16. The finished product is distributed from Sweden. Odqvist Declaration, ¶ 17. Hence, we find that respondent's goods do indeed originate from Sweden.

Accordingly, petitioner cannot prevail on its geographically deceptively misdescriptive claim, and we need not consider the third prong, i.e., whether the mark's misrepresentation is a material factor in the consumer's decision to purchase the goods.⁵

Decision: The petition to cancel is dismissed with prejudice.

⁵ Even if we were to consider the third prong, petitioner failed to submit any admissible evidence, other than respondent's admission that the Swedish military uses fire starter devices discussed above. Such evidence is insufficient to establish the final element of petitioner's claim.