

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

Mailed: September 28, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

St. Denis Parish

v.

Diana Van Straten

Cancellation No. 92051378

Anthony M. Verna III of Law Offices of Anthony Verna, for
Diana Van Straten.

Thomas J. Connelly of Wilhelm Law Service S.C., for St.
Denis Parish.

Before Walters, Cataldo and Ritchie, Administrative
Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

This is a cancellation proceeding in which St. Denis
Parish (petitioner) seeks to cancel Registration No.
3552280, owned by Diana Van Straten (respondent), for WORLD
CHAMPIONSHIP CABBAGE CHUCK, for "charitable fund raising by

means of an entertainment event where competitors throw cabbages.”¹

In the petition for cancellation, petitioner asserts various grounds. These include fraud on the PTO. (petition at Para. 10). Petitioner further asserts priority and likelihood of confusion with petitioner’s prior common-law rights in the mark “WORLD CHAMPIONSHIP CABBAGE CHUCK” for “charitable fund raising.” *Id.* at Para. 12. A third claim asserted by petitioner is nonuse. In Paragraph 4 of the petition, petitioner asserts that “there has been no lawful use by Respondent of ‘WORLD CHAMPIONSHIP CABBAGE CHUCK’ for charitable fund raising as a trademark in the United States.” *Id.* at Para. 4. In Paragraph 6, petitioner asserts, “Petitioner is informed and believes, and on that basis alleges that Respondent has never used the mark ‘WORLD CHAMPIONSHIP CABBAGE CHUCK’ in commerce for charitable fund raising apart from volunteering her time to Petitioner.” *Id.* at Para. 6. In Paragraph 7, petitioner asserts, “Petitioner is informed and believes, and on that basis alleges that Respondent is not the owner of the mark ‘WORLD CHAMPIONSHIP CABBAGE CHUCK’ and is not [sic] and never has used the mark in commerce.” *Id.* at Para. 7. We construe

¹ Registered on the Supplemental Register on December 23, 2008, with a Statement of Use filed September 17, 2008, alleging first use on February 15, 2006, and first use in commerce on September 30, 2006.

these "nonuse" claims in Para. 6 and 7 as setting forth claims of lack of ownership of the mark based on nonuse.

Respondent filed an answer denying the salient allegations of the petition. Petitioner filed a brief. Respondent did not.

The record in this case includes the pleadings and the file of the involved registration as well as the two testimonial depositions submitted by petitioner, of Gene Gerald Diermeier, "plumber" and "lifelong member of the parish" of petitioner as well as of Laura Tews, "Business Manager" of the parish for petitioner, along with the exhibits thereto. Both depositions were taken on September 22, 2010. Respondent did not submit any evidence or testimony.

Standing

Petitioner's business manager testified that petitioner has been running an annual charitable event called the WORLD CHAMPIONSHIP CABBAGE CHUCK since 2006, with the fifth event taking place in 2010 (Tews depo. at 8). The exhibits to the Tews depo confirm the continuity of the event. *Id.* at Exs. H, T, AB, BB, CC. We therefore consider that the record provides a sufficient showing of petitioner's standing. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Cerveceria Modelo S.A. de C.V. v. R.B. Marco & Sons Inc.*, 55 USPQ2d 1298 (TTAB 2000);

and *Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990). Accordingly, we find that petitioner here has shown that it has a reasonable belief of damage and a real interest in this proceeding. Therefore it is not a mere intermeddler, and has established its standing. 15 U.S.C. §1064.

Lack of Ownership Based on Nonuse

Petitioner asserts a claim of lack of ownership based on nonuse. In particular, petitioner pleaded an allegation that "Respondent is not the owner of the mark 'WORLD CHAMPIONSHIP CABBAGE CHUCK' and is not [sic] and never has used the mark in commerce." (Petition at Para. 7). The genesis of this claim is petitioner's allegation that petitioner is the true owner of the mark and that respondent has never used the mark outside the auspices of the control of petitioner. In this regard, as petitioner alleges, respondent should never have filed a trademark registration in her name, since the ownership of the mark rests with petitioner. See *In re Wella A.G.*, 858 F.2d 725, 8 USPQ2d 1365, 1368 (Fed. Cir. 1988), where the Court of Appeals for the Federal Circuit, our primary reviewing court, noted "the right to register these marks is a statutorily conferred right that may only be exercised by the owner of the mark sought to be registered." Accordingly, to show lack of ownership and nonuse by respondent of the mark, petitioner submitted the deposition testimony of two persons familiar

with the relationship between petitioner and respondent and with the origin of the mark WORLD CHAMPIONSHIP CABBAGE CHUCK, as used for charitable fund raising.

Petitioner is the Catholic church in Shiocton Wisconsin, a rural town of about 1,000, with a parish of about 240 families. (Diermeier depo. at 11). Respondent had been a member of the parish. *Id.* at 4. Every year, the parish had an annual picnic fundraiser. *Id.* Respondent approached the fundraising committee in 2005 and suggested a new idea for the annual fundraiser, "throwing cabbage." *Id.*; (Tews depo at 8). The committee liked the idea and added respondent to the committee. (Diermier depo. at 5-6). At first, the church was going to call it the "cabbage chunk." *Id.* at 13. Within a few months, during the committee planning for the 2006 event, however, with input from various committee members, the name evolved. *Id.*

We were going to originally call it the cabbage chunk, and at one of the very first meetings I know Laura Tews, she takes care of our finances, she made a mistake and it was spelled cabbage chuck . . . they decided this has a nice ring to it. . . . As far as the world championship, that just got added in through further meetings. It just got added in there, and that's how it evolved.
(Diermier depo. at 13)

This testimony on the evolution of the name WORLD CHAMPIONSHIP CABBAGE CHUCK as having been created by group participation of various members of the church committee was echoed by Ms. Tews.

In the midst of these meetings, actually, I made a mistake, and I called it cabbage chuckin. And I did that a couple of times, and members of the committee were correcting me, it's not chuckin, it's chunkin. Somebody said, well, why don't we call it chucking, because we are throwing, chucking cabbages. That's how I remember it evolving into cabbage chucking.
(Tews depo. at 15, Ex G2)

Petitioner adopted the mark WORLD CHAMPIONSHIP CABBAGE CHUCK for its annual charitable fund raiser in 2006.
(Diermeier depo. at 13); (Tews depo. at 15; Ex. G2; Ex H).
Petitioner has been using the mark continuously since then, and has held annual fundraisers in 2006, 2007, 2008, 2009, and 2010 using the mark. (Tews depo. at 8; Exs. H; T; AB; BB; CC). There is no question that petitioner is the party responsible for all aspects of the annual WORLD CHAMPIONSHIP CABBAGE CHUCK, held in Shiocton, Wisconsin from 2006 continuously through 2010. Petitioner's witnesses testified, with exhibits, that although numerous volunteers (such as respondent, on several occasions) participated, petitioner was the party responsible for paying for costs associated with each such event. (Tews depo at 11 and Ex. G7). All of the advertisements tout respondent, "St. Denis Parish," as the host of the event. (Tews depo., Ex. H, Ex T, AB, BB, Ex CC). Ms. Tews has also sent out, on behalf of petitioner, letters thanking people for their participation, after each event, and begun preparations for the following year. (Tews depo. at 11, and Ex. I).

Respondent suggested the event to petitioner and participated as a volunteer helper in the first three of petitioner's annual fundraisers that used the mark WORLD CHAMPIONSHIP CABBAGE CHUCK, in 2006, 2007, and 2008. (Diermier depo. at 8-9); (Tews depo. at 45). However, there is no evidence that respondent ever independently adopted or used the mark WORLD CHAMPIONSHIP CABBAGE CHUCK for the services for which she registered it, "charitable fund raising by means of an entertainment event where competitors throw cabbages." Rather, petitioner's witness testified that he did not "know" of respondent having used the mark for these services apart from the auspices of petitioner's event.

Q: Okay. Do you know if Diana Van Straten ever put on another cabbage tossing event anyplace?

A: Not that I know of.
(Diermier depo. at 10)

To the contrary, the specimen submitted by respondent in support of her application for registration of the mark is a flyer showing "St. Denis Parish" as the host of the 2006 WORLD CHAMPIONSHIP CABBAGE CHUCK.

WORLD CHAMPIONSHIP



*St. Denis
Parish*

Cabbage Chuck

**Saturday, Sept. 30, 2006
Shiocton Lake Park**

Enjoy Food, Drinks and Live Entertainment

Featuring **"Ned the Dead"**

Catapults ● Trebuchets ● Air Cannons

Cabbage Chuck 11:00 am-?

Largest Cabbage Contest

Kraut Wrestling 2:00-4:00 pm

World Record Cabbage Toss Attempt 5:00 pm

Live Music by "FORCE OF HABIT" 6:00-10:00 pm

Cash Raffles

**\$3.00
Admission
(under 15yrs free)**

Contact acencookie2@yahoo.com or 920-986-3887, 920-757-5090 for more information.

This is the same flyer submitted as Ex T to the Tews depo., which Ms. Tews attested to being an advertisement

prepared by petitioner for the first annual WORLD CHAMPIONSHIP CABBAGE CHUCK held by petitioner for its charitable fund raising in 2006.

Accordingly, we find that petitioner has set forth a *prima facie* case that respondent does not render and has never rendered the services identified in its registration in commerce under the mark 'WORLD CHAMPIONSHIP CABBAGE CHUCK.' We further find on this basis that respondent was not the owner of the mark at the time of filing her application or any time thereafter.

We further find that respondent has failed to present any evidence sufficient to rebut petitioner's *prima facie* showing of lack of ownership based on nonuse. As noted above, respondent did not present any evidence at all at trial. Respondent's statements in its answer to the petition for cancellation, and its exhibits to the answer, are not evidence of record. See TBMP § 704.06(a) (3rd ed. 2011); Trademark Rule 2.122(c).

For these reasons, we grant the petition for cancellation on this ground.²

Decision: The petition to cancel is granted on the ground of lack of ownership based on nonuse.

² Since we have granted the petition on the ground of lack of ownership based on nonuse, we do not find it necessary to discuss the pleaded grounds of "fraud" or "priority and likelihood of confusion."