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THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

GCP

Mailed: March 1, 2012

Cancellation No. 92052572

Alco Electronics Limited

v.

Rolf Strothmann

**Before Kuhlke, Wellington, and Wolfson,  
Administrative Trademark Judges.**

**By the Board:**

On June 14, 2010, Alco Electronics Limited ("petitioner") filed a petition for cancellation that seeks to partially cancel the registration owned by Rolf Strothmann ("respondent") for the mark E-MOTION in standard character format for "golf carts, shopping carts, mail delivery carts, industrial trucks, baby carriages, hand trucks, bicycles, wheel chairs, rikshaws [sic], and carts for suitcases, all with auxiliary motors" in International Class 12.<sup>1</sup>

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<sup>1</sup> Reg. No. 2700612, issued on March 25, 2003 on the Principal Register, claiming August 29, 2002, both as the date of first use anywhere and the date of first use in commerce.

As grounds for cancellation, petitioner alleges that respondent has abandoned his E-MOTION mark by never using, and having no intent to begin use, of his mark on some of the goods identified in the subject registration, namely, shopping carts, mail delivery carts, industrial trucks, baby carriages, hand trucks, bicycles, wheel chairs, rickshaws, and carts for suitcases (collectively, the "Extra Goods.")

Respondent, in his answer, has denied the essential allegations of the petition to cancel.

This case now comes before the Board for consideration of petitioner's motion (filed August 8, 2011) for summary judgment for partial cancellation on its asserted claim of abandonment. The motion is fully briefed.

In support of its motion, petitioner contends that, although respondent's subject registration issued over eight years ago, respondent has never used his E-MOTION mark in commerce in connection with the Extra Goods. Following the taking of discovery in this matter, petitioner maintains that respondent has admitted, under oath, that (1) he is not currently selling the Extra Goods under the E-MOTION mark and (2) he has never sold or used the Extra Goods under the E-MOTION mark at any time since his registration issued. Furthermore, petitioner argues that respondent has no intent to resume or, more accurately, begin use of his E-MOTION mark in connection with the Extra Goods. In support of respondent's alleged lack of intent to commence use of his

E-MOTION mark in association with the Extra Goods, petitioner maintains that in response to petitioner's discovery requests:

(1) respondent has not produced any documents which evidence any advertisements or promotion of the Extra Goods in connection with his E-MOTION mark;

(2) respondent has not produced any documents evidencing communications with any advertising agency or public relations firm relating to, or referencing, the E-MOTION mark in connection with the Extra Goods;

(3) respondent has not produced any documents evidencing advertising and promotional channels through which respondent intended to offer for sale the Extra Goods using the E-MOTION mark;

(4) respondent has not produced any documents that show projected advertising and promotional costs in connection with the E-MOTION mark in association with the Extra Goods or any documents that show monthly projected sales of the Extra Goods using the E-MOTION mark;

(5) respondent has not produced any exemplars of the E-MOTION mark used in connection with any of the Extra Goods; and

(6) respondent has not produced a single document showing a business plan, marketing plan, operational plan, or financial plan relating to the sale or planned sale of the Extra Goods using the E-MOTION mark.

Further, petitioner argues that, even assuming that respondent can somehow "resume" use of his never used E-MOTION mark on the Extra Goods, respondent still cannot meet his burden and overcome the presumption of abandonment. To prove intent to resume use, petitioner maintains that respondent must present documentary evidence showing specific actions taken for the resumption of use of the E-MOTION mark on the Extra Goods such that his intent to

resume use may be reasonably inferred. Petitioner contends, however, that the sum total of the evidence of respondent's intent to "resume" use is a single meeting that he had with his wife and Mr. John Peirarndozzi in Saarbrücken, Germany. Petitioner maintains that this meeting was held in May of 2008, more than five years after the subject registration for the mark E-MOTION issued, and during which respondent did not discuss any commercial level use of the Extra Goods at any defined point in the future.

Finally, petitioner argues that even if respondent's single meeting with his wife and colleague in May of 2008 was sufficient to show intent to commence commercial-scale use within a specified and reasonable time, respondent will nevertheless be unable to show intent to commence use between September 2002 and February 2008, which is a period of nonuse of at least three years and constitutes a *prima facie* showing of abandonment.

In view of the foregoing, petitioner requests that the Board grant its motion for summary judgment and strike the Extra Goods from the subject registration.

As evidence in support of its motion, petitioner has submitted the declaration of Jerry S. Podkopacz, one of the attorneys representing petitioner, which introduces, among other things, the following exhibits: (i) a copy of respondent's registration; (ii) a copy of the statement of

use filed by respondent on September 10, 2002 during the prosecution of the underlying application of the subject registration, declaring use only for golf carts, (iii) a combined Declaration under Section 8 and 15 of the Lanham Act for the subject registration signed by respondent on February 10, 2009 and filed with the USPTO on March 16, 2009, declaring use of the mark on all the goods identified in the underlying application, (iv) copies of respondent's responses and supplemental responses to petitioner's written discovery requests, including responses to petitioner's requests for admission, (v) copies of petitioner's pleaded pending application Serial Nos. 77830956 and 77830959, (vi) copies of office actions that show that petitioner's pleaded pending applications were refused registration under Trademark Act Section 2(d) based on respondent's involved registration and (vii) documents produced by respondent in discovery and filed under seal by petitioner which constitute the meeting notes of the May 2008 meeting held in Saarbrücken, Germany between respondent, his wife and a colleague.

In response, respondent argues that petitioner's motion for summary judgment is based on the erroneous premise that respondent allegedly abandoned his E-MOTION mark with respect to the Extra Goods, based on respondent's discovery responses which petitioner interprets as a concession or

admission that respondent has no intention to use the mark on the Extra Goods. Respondent contends, however, that since the mid-1990s he has been developing and has been granted several U.S. patents concerning a muscle/motor power drive technology which has already been applied to golf carts, one of the goods identified in the subject registration. Respondent also maintains that he has always intended to apply this technology to the Extra Goods, as clearly explained at his website [www.human-mobility.com](http://www.human-mobility.com). As an example of his efforts to apply this muscle/motor drive technology for vehicles other than the identified golf carts, respondent further contends that he has tailored this technology for bicycles, which has already come into the market in Germany, and plans to export this product to the United States shortly.

With regard to petitioner's argument that respondent has not produced documents evidencing projected advertising costs, marketing plans and communications with advertising agencies as "conclusive" evidence of respondent's lack of the requisite intent to commence use, respondent argues that, over the course of many years, respondent has developed a dependable and valuable business relationship with a U.S. distributor and has accordingly dedicated his valuable financial resources to developing this relationship, as well as to technical aspects of product

development, instead of spending money on business planning and advertising agencies.

Respondent maintains that the above facts demonstrate that respondent has not abandoned the E-MOTION mark for the Extra Goods, and such facts are more than sufficient to rebut petitioner's contention that respondent has abandoned his mark. Respondent also contends that petitioner has not met its burden to show that there is an absence of material fact which would entitle petitioner to the summary judgment relief it seeks.

As evidence in support of his opposition to petitioner's motion, respondent has submitted his declaration which introduces the following exhibits: (i) copies of U.S. patents issued to respondent for a muscle/motor power drive technology and (ii) copy of a booklet evidencing the muscle/motor power drive system.

In reply, petitioner contends that respondent makes no attempt to refute the fact that he has never used the E-MOTION mark in commerce in the United States in connection with the Extra Goods. Further, petitioner maintains that respondent has not identified any evidence disclosed in his discovery responses that demonstrates or even suggests an "intent to use" the mark during the nonuse period. Instead, petitioner argues that respondent's discovery responses establish the absence of his intent to commence use.

Moreover, rather than relying upon the evidence in the record, petitioner argues that respondent relies upon unidentified evidence that he might present at some future date, as well as a few unsupported self-serving statements set forth in his declaration in an effort to continue warehousing his E-MOTION mark. Finally, petitioner maintains that respondent, in his opposition to petitioner's motion for summary judgment, introduces new information regarding U.S. patents that he did not identify or produce in his discovery responses compelled by the Board's June 3, 2011 discovery order. Notwithstanding, petitioner argues that this previously withheld information does not reference the E-MOTION mark or the Extra Goods and, therefore, the introduction of this information does not create a genuine dispute of material fact, and does not overcome the presumption of respondent's intent not to "resume" use of the E-MOTION mark on the Extra Goods.

A party is entitled to summary judgment when it has demonstrated that there are no genuine disputes as to any material facts, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).



Based on the submissions of the parties, we find that petitioner has met its burden of demonstrating that there are no genuine disputes of material fact, and that petitioner is entitled to judgment, as a matter of law, on its claim of abandonment.

### Standing

As a threshold matter, we note that respondent has not challenged petitioner's standing. Notwithstanding, for the Board to grant summary judgment, petitioner must establish that there is no genuine dispute as to its standing as well as to the ground on which it seeks entry of summary judgment. *See Fed. R. Civ. P. 56(a)*. *See also Cunningham v. Laser-Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). Such standing is established by petitioner's submission, as exhibits to its brief in support of its motion for summary judgment, of copies of its pleaded pending application Serial Nos. 77830956 and 77830959 for the marks EMOTION and E-MOTION, respectively, both for use in connection with "automobiles, scooters and bicycles," as well as copies of office actions that show that such applications were refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on respondent's involved registration. *See Weatherford/Lamb Inc. v. C&J Energy Services Inc.*, 96 USPQ2d 1834 (TTAB 2010). By virtue of the refusals to register petitioner's pleaded pending

applications, there is no genuine dispute that petitioner has standing to bring the current proceeding.

Abandonment

A party may seek partial cancellation of a registration on the ground that the registrant has abandoned use of the mark in connection with certain of its goods or services.

*DAK Industries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1437 (TTAB 1995). Section 45 of the Trademark Act provides that a mark is abandoned when "its use has been discontinued with intent not to resume use. Nonuse for three consecutive years shall be *prima facie* evidence of abandonment." 15

U.S.C. § 1127. In order to prevail on a claim for cancellation on the ground of abandonment, a party must allege and prove, in addition to its standing, abandonment of the mark as the result of nonuse or other conduct by the registrant. See *On-Line Careline, Inc. v. Am. Online*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000). Evidence of nonuse of the mark for three consecutive years constitutes a *prima facie* claim of abandonment and shifts the burden to the party contesting abandonment to show either: (1) evidence to disprove the underlying fact triggering the presumption of nonuse, or (2) evidence of an intent to resume use to disprove the presumed fact of no intent to resume use. 15 U.S.C. § 1127. See also, *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390

(Fed. Cir. 1990); and, generally, 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 17:18 (4<sup>th</sup> ed. database updated 2012). In order to establish an intent to commence use, a respondent must put forth evidence with respect to either specific activities undertaken during the period of nonuse or special circumstances which excuse nonuse.<sup>2</sup> See *Cerveceria India Inc. v. Cerveceria Centroamerica, S.A.*, 10 USPQ2d 1064 (TTAB 1989), *aff'd*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989); see also, *On-Line Careline, Inc.*, *supra*.

As noted above, in support of its *prima facie* case of abandonment, petitioner relies primarily on respondent's responses to petitioner's discovery requests, particularly respondent's responses to petitioner's requests for admission.

Respondent's admissions establish the following:

Respondent has made no use in commerce of his E-MOTION mark in the United States with any of the Extra Goods at any time before June 15, 2010. (Admission Nos. 21-29).

Thus, in view of the above admissions and the statutory presumption with regard to a claim of abandonment, we find

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<sup>2</sup>In general, the concept of "intent to commence use" in the context of an abandonment claim comes up in cases involving registrations issued under Sections 44 or 66 of the Trademark Act, wherein a showing of use is not required prior to registration. However, this concept also arises in cases involving Section 1 registrations where, as here, a simple claim of nonuse is time-barred. See Section 14(3) of the Trademark Act, 15 U.S.C. § 1064.

that, as a matter of law, petitioner has established, at a minimum, a *prima facie* case of abandonment based upon three consecutive years of nonuse from the date of issuance of respondent's involved registration.

Such a *prima facie* case of abandonment eliminates petitioner's burden of establishing the intent element of abandonment as an initial part of the case and creates a rebuttable presumption that respondent abandoned his E-MOTION mark without any intent to commence use. *See Rivard V. Linvell*, 133 F.3d 1446, 45 USPQ2d 1374, 1376 (Fed. Cir. 1998); *Imperial Tobacco Ltd. v. Philip Morris, Inc.*, 899 F.2d 1575, 14 USPQ2d 1390, 1393 (Fed. Cir. 1990). The presumption shifts the burden to respondent to produce evidence that he intended to commence use of his E-MOTION mark on the Extra Goods. *See Rivard V. Linvell, supra*; *Cerveceria India Inc. v. Cerveceria Centroamerica, S.A., supra*.

Thus, in the case of a motion for summary judgment, when the moving party supports its position by evidence sufficient to indicate that there is no genuine dispute of material fact, and that the moving party is entitled to judgment as a matter of law, the burden shifts to the nonmoving party to demonstrate the existence of specific, genuinely-disputed facts that must be resolved at trial. In

this case, the question is whether respondent, like any other registrant who has not made use for at least three years, has put forth sufficient evidence to at least raise a genuine dispute of material fact of intent to commence use. *Imperial Tobacco Ltd. v. Philip Morris Inc.*, supra.

After reviewing the evidence in a light most favorable to respondent, we conclude that respondent has not raised a genuine dispute of material fact to rebut the presumption that respondent abandoned his E-MOTION mark in connection with the Extra Goods without an intent to commence use.

We also note that respondent's statements set forth in his declaration regarding his intention to apply his muscle/motor power drive technology to the Extra Goods and that such plans have never been abandoned are insufficient to excuse the period of nonuse of his E-MOTION mark on the Extra Goods or to show respondent's intent to commence use of the E-MOTION mark on those goods in the United States. As is explained by our reviewing court in *Imperial Tobacco v. Philip Morris*, 899 F.2d at 1581; 14 USPQ2d at 1394:

"[A]n affirmative desire by registrant not to relinquish a mark is not determinative of the intent element of abandonment under the Lanham Act. Nothing in the statute entitles registrant who has formerly used [or never used] a mark to overcome a presumption of abandonment arising from subsequent nonuse by simply averring a subject affirmative 'intent not to abandon.'"

Moreover, the mere submission of respondent's U.S. patents for a muscle/motor power drive technology without

any further corroborating evidence on what activities respondent has undertaken to apply this technology since the issuance of the patents to the Extra Goods is also insufficient to rebut the presumption of lack of intent to commence use.<sup>3</sup> While respondent, by his declaration, declares that he has applied the muscle/motor power technology to bicycles which have come into the market in Germany and which he intends to shortly market in the United States, respondent has not submitted any documentary evidence to demonstrate his commencement of use of the technology on bicycles in Germany or the sale of such bicycles under the E-MOTION mark.<sup>4</sup> Additionally, respondent has not submitted any documentary evidence demonstrating any activities regarding his intended marketing, advertising, and/or eventual sale of the bicycles in the United States under his E-MOTION mark. Moreover, while respondent relies on his website [www.human-mobility.com](http://www.human-mobility.com) to demonstrate his intent to commence use of his E-MOTION mark on the Extra Goods, we note that respondent failed to submit copies of

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<sup>3</sup>We note that the U.S. patents submitted by respondent do not reference respondent's E-MOTION mark or how the patented technology applies to any of the Extra Goods.

<sup>4</sup>Even if respondent had submitted documentary evidence demonstrating use of his E-EMOTION mark on bicycles in Germany such evidence would not overcome the presumption of no intent to commence use in the United States inasmuch as use in a foreign country is nondispositive. *Imperial Tobacco Limited v. Philip Morris*, 14 USPQ2d at 1393.

any of the webpages of his site which evidences his alleged intent to commence use. Mere reference to the website alone does not make the contents of record and, as such, does not constitute evidence of a continuing intent to commence use of respondent's mark. We also find little value in the booklet submitted by respondent as an exhibit to his declaration which allegedly shows use of his muscle/motor power drive technology because (1) the booklet is in German without an English translation and (2) it does not appear to demonstrate use of respondent's E-MOTION mark as a source indicator for bicycles.

Notwithstanding the foregoing, evidence of use or an intent to commence use of a mark subsequent to the period of three years of nonuse (in this instance, the first three years from the registration date of respondent's registration) is irrelevant and does not cure a *prima facie* case of abandonment. See *Auburn Farms Inc. v. McKee Foods Corp.*, 51 USPQ2d 1439 (TTAB 1999); *Stromgren Supports Inc. v. Bike Athletic Co.*, 43 USPQ2d 1100 (TTAB 1997). See also *Mission Dry Corp. v. Seven-Up Co.*, 193 F.2d 201, 86 USPQ 263 (CCPA 1951) (once a trademark is abandoned, its registration may be cancelled even if the registrant resumes use). Accordingly, even if we were to consider respondent's declaration, and attached exhibits, as well as the meeting notes of the meeting held in Germany in May 2008 between

respondent, his wife and a colleague, as evidence of respondent's intent to commence use of his E-MOTION mark on the Extra Goods, other than the submitted U.S. patents which do not specifically concern any of the Extra Goods, such evidence does not serve to rebut the *prima facie* case of abandonment of three years of nonuse since the issuance date of respondent's registration, i.e., March 25, 2003, inasmuch as this evidence concerns activities following the three years of nonuse established by petitioner. Simply put, respondent has not presented any evidence regarding his intention to commence use of his mark on the Extra Goods for the first three-year period following registration of his mark.

In view of the foregoing, we find that respondent has not put forth sufficient evidence to raise a genuine dispute of material fact to overcome the presumption of no intent to commence use of his E-MOTION mark on the Extra Goods during the three years of established nonuse of his mark.

Thus, petitioner's motion for summary judgment on its only asserted claim of abandonment is granted and judgment for partial cancellation is hereby entered against respondent with respect to the Extra Goods. The Extra Goods will be deleted from respondent's involved registration in due course.