ESTTA Tracking number: **ESTTA591422**
Filing date: **03/07/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92053298
Party	Plaintiff Tyler Perry Studios, LLC
Correspondence Address	VICTOR K SAPPHIRE MICHELMAN ROBINSON LLP 15760 VENTURA BLVD., 5TH FLOOR ENCINO, CA 91436 UNITED STATES vsapphire@mrllp.com,glangton@novakdruce.com
Submission	Brief on Merits for Plaintiff
Filer's Name	Victor K. Sapphire, Esq.
Filer's e-mail	vsapphire@mrllp.com
Signature	/vsapphire/
Date	03/07/2014
Attachments	20140307162813732.pdf(496770 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Tyler Perry Studios, LLC, Petitioner, v. Kimberly Kearney, Registrant	Cancellation No. 92053298 Registration No. 3,748,123 Mark: WHAT WOULD JESUS DO

PETITIONER'S BRIEF

Victor K. Sapphire, Esq.
Michelman & Robinson, LLP
15760 Ventura Blvd., 5th Floor
Encino, California 91436
(818) 783-5530
Attorneys for Petitioner

TABLE OF CONTENTS

I. Preliminary Statement.....1

Introduction.....1

The Standard of "Use In Commerce".....2

II. Description of the Record.....4

III. Statement of the Issue.....4

IV. Recitation of the Facts.....4

A. *Petitioner*.....4

B. The Fraudulent '123 Registration and Respondent's Non-Use of the Subject Mark.....5

V. Argument.....7

A. The Registration Was Fraudulently Obtained and the Mark is Not in Use by Respondent, Thus the Registration Should be Canceled.....7

B. Respondent Has No Rights in the Subject Mark.....7

1. *Respondent Has Not Used the Mark in Commerce*.....7

2. *Respondent's Declaration of Use is Fraudulent*.....8

VI. Summary.....9

TABLE OF CASES

Cases

American Vitamin Products, Inc. v. Dowbrands Inc.,
22 USPTO2d 1313 (TTAB 1992) 5

Automedx Inc. v. Artivent Corp.,
95 USPQ2d 1976 (TTAB 2010) 3

Bart Schwartz Int'l Textiles, Ltd. V. Federal Trade Comm.,
129 USPQ 258 (CCPA 1961); 8

Ets. Lardenois v. Lazarus,
168 USPQ 604 (TTAB 1970) 9

Bonaventure Associates v. Westin Hotel Company,
218 USPQ 537, 543 (TTAB 1983) 7

Clorox Co. v. Salazar,
108 USPQ2d 1083, 1086 (TTAB 2013) 3

Compton v. Fifth Avenue Ass'n,
7 F.Supp.2d 1328, 47 USPQ2d 1300 (M.D. Fla. 1998) 7

Statutes

§1(a) of the Trademark Act, 15 U.S.C. §1051(a) 2

37 C.F.R. §2.20 3

37 C.F.R. §2.34(a)(1)(i) 3, 8

Fed. R. Civ. P. 36(a)(3) 4

Trademark Rules 2.119© and 2.120 4

I. PRELIMINARY STATEMENT

Introduction

This Cancellation Proceeding involves the fraudulent registration of the mark WHAT WOULD JESUS DO in connection with entertainment services in the nature of a television program. The mark is the subject of US Registration No. 3,748,123 ("the '123 Reg."). Kimberly Kearney ("Kearney", "Respondent") has never used the subject mark in connection with the services identified in the '123 Reg. The Declaration of Use filed at the time of filing the application under Section 1(a) is based on a specimen web page that was created for the sole purpose of obtaining a registration, and does not reflect commercial use of the mark. As a result, the '123 Reg. is *void ab initio* and should be canceled.

During these proceedings, Respondent provided no evidence of commercial use of the services specified in the registration as of the time of filing, and failed to rebut charges that she has never used the mark in commerce, admitting same. In fact, the record shows that she filed no evidence of any type during the testimonial and trial periods of the instant proceeding.

At the time Respondent filed the federal use-based trademark application that eventually matured into the '123 Reg., she sought registration of the mark in connection with "entertainment services in the nature of an on-going reality based television program". The Section 1(a) Declaration of Use in the application, and supporting specimen, were fraudulent: she knowingly alleged use even though she had not actually produced, sold, distributed, exhibited, or had exhibited by a broadcaster, any television program in connection with the subject mark. Rather, she merely created a web page advertising purported auditions for a *proposed* television show in connection with the subject mark that has *never* been produced, solely for the purpose of obtaining the registration. Respondent has *not* used the subject mark in connection with television show production.

The specimen of use in the application, an "audition" web page Kearney created for the proposed program, featured contact email addresses that were and continue to be nonfunctional.

She did not update the homepage at the audition web site for several years after her claimed first-use date of November 21, 2007. The specimen web page has thus remained in its non-functional state, as a casting call with non-functional contact information for auditions whose dates have never been specified, for an "upcoming" show that never occurred, in the seven years since the alleged date of first use in commerce. Although the '123 Reg. was granted in connection with an *on-going* television show, Kearney had not even begun to produce a television program in connection with the WHAT WOULD JESUS DO mark when she filed the application. Contrary to the false and deceptive testimonial declaration of use in the application, she had not used the subject mark in commerce in connection with any of the subject services as of November 21, 2007, nor as of the filing date.

Since the registration was thus fraudulently obtained and has never been used by Respondent in connection with the subject services, there can be no question that allowing the registration to remain in good standing would be a grave miscarriage of justice, and a disservice to the public interest. Continued registration in good standing would also cause grave injury to Petitioner Tyler Perry Studios, LLC ("TPS"), as it would affect Petitioner's ability to use and register the WHAT WOULD JESUS DO mark that is also the subject of Petitioner's pending federal trademark application, which covers overlapping services in overlapping channels of trade.

Petitioner seeks cancellation of the '123 Registration. Although any single basis alleged in the Petition is sufficient to grant the relief sought, the undisputed facts clearly and overwhelmingly support cancellation of the '123 Registration on all of the bases set forth in the Petition and herein.

The Standard of "Use In Commerce"

In an application based on use in commerce under §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* 37 C.F.R.

§2.34(a)(1)(i). The application must include a statement that the mark is in use in commerce, verified in an affidavit or declaration under 37 C.F.R. §2.20. If the verification is not filed with the original application, it must also allege that the mark was in use in commerce on or in connection with the goods or services listed in the application as of the application filing date. 37 C.F.R. §2.34(a)(1)(i).

Section 45 of the Trademark Act, 15 U.S.C. §1127, defines "commerce" as "all commerce which may lawfully be regulated by Congress." Section 45 defines "use in commerce" as follows:

> The term "use in commerce" means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this Act, a mark shall be deemed to be in use in commerce--
> (1) on goods when—
> (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and
> (B) the goods are sold or transported in commerce, and
> (2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

Use made "merely to reserve a right in a mark" will not meet the foregoing standard. *See* Trademark Law Revision Act of 1988 (TLRA), Public Law 100-667, 102 Stat. 3935, *Legislative history*. Factors that may be considered when determining compliance with the statutory requirement for a "bona fide use of a mark in the ordinary course of trade" are: (1) the amount of use; (2) the nature or quality of the transaction; and (3) what is typical use within a particular industry. *See Automedx Inc. v. Artivent Corp.*, 95 USPQ2d 1976 (TTAB 2010) (finding sales of demonstration models of portable medical ventilators to military constituted bona fide use of mark in commerce); *see also Clorox Co. v. Salazar*, 108 USPQ2d 1083, 1086 (TTAB 2013) (finding that applicant had not made bona fide use of its mark in commerce, as applicant had not sold or transported goods bearing the mark in commerce as of the application filing date).

II. DESCRIPTION OF THE RECORD

The evidence of record consists of evidence introduced by Petitioner, and the file histories for the '123 Reg., and Petitioner's U.S. Appl. Serial No. 77/477,214.

Petitioner's Notice of Reliance contained the following evidence:

Description:	Exhibit
A copy of Petitioner's Requests for Admission[1]	Exh. A
Mailing receipts showing timely service to Respondent via FedEx.	Exh. B

III. STATEMENT OF THE ISSUE

Whether Respondent's registration for the mark WHAT WOULD JESUS DO in connection with certain entertainment services in the nature of an ongoing reality based television program should be cancelled because Registrant has never used the subject mark, the registration was fraudulently obtained, or has discontinued use of the subject mark with no intent to resume said use, thus abandoning the mark.

IV. RECITATION OF THE FACTS

A. Petitioner

TPS is a creator and producer of motion pictures and television programming and live theatrical shows. TPS has produced a catalog of several highly successful feature films that have been widely exhibited throughout the United States and internationally, and several television series that are exhibited on first-run and syndicated bases on network and cable television

---

1 The Requests for Admission were timely served upon Respondent. Respondent, upon whom the Requests were served, failed to respond to the Requests, timely or otherwise. The requested responses should have been served within 30 days after service of these Requests in accordance with Trademark Rules 2.119(c) and 2.120. Because responses were not thusly served, the Requests for Admission are deemed Admitted. Fed. R. Civ. P. 36(a)(3) ("A matter is admitted unless, within 30 days after being served, the party to whom the request is directed serves on the requesting party a written answer or objection addressed to the matter and signed by the party or its attorney."). Petitioner may therefore rely on Respondent's Admissions entered pursuant to Respondent's failure to respond to the discovery requests served upon it by Petitioner.

throughout the United States. Many of TPS' features and television series have gone on to great success in the home video market following their theatrical release or television exhibition. The company has earned hundreds of millions of dollars from the production and sale of entertainment content that it has produced.

Petitioner has standing to bring this action, as it has filed an intent-to-use application to register the mark WHAT WOULD JESUS DO in connection with various entertainment production services in connection with film and television programming and ancillary services. The application has been blocked by the '123 Reg. As a result, following investigation of the '123 Reg., Petitioner filed the instant Petition to Cancel. See *American Vitamin Products, Inc. v. Dowbrands Inc.*, 22 USPTO2d 1313 (TTAB 1992) (ITU application to register identical mark for similar goods/services sufficient to provide a real commercial interest, granting standing).

B. The Fraudulent '123 Registration and Respondent's Non-Use of the Subject Mark

On January 14, 2008, Respondent filed an application to register the mark WHAT WOULD JESUS DO, Appl. Ser. No. 77/371,640, claiming first use and first use in commerce at least as early as November 21, 2007. The mark was granted registration on February 16, 2010 in connection with "entertainment services in the nature of an on-going reality television program" in Class 41.

In support of the registration, Respondent filed a specimen of use comprising a screen shot of a web page at whatwouldjesusdo.tv, calling for auditions for a proposed reality television show. *See* '123 Reg., *file history*. Respondent created the web page to advertise auditions for a proposed show in connection with the WHAT WOULD JESUS DO mark. *Admissions* at 21. However, the contact email addresses on the specimen web page were and are nonfunctional, and have never been functional, and the site does not display telephone contact information, rendering the web page itself useless as no one interested in the purported auditions would be able to contact Respondent through the site. *Admissions* at 28, 29, 30.

The contact email addresses on the specimen web page resolve to the email address info@coolexample.com. *Admissions* at 29. Respondent does not own, administer, or have access to an email account at that email address, and the info@coolexample.com email address is not affiliated with or otherwise associated with Respondent. *Admissions* at 38, 39. Respondent is not the owner of the "coolexample.com" domain name registration. *Admissions* at 37. She has not updated the contact information or other portions of the homepage at "whatwouldjesusdo.tv" since 2007. *Admissions* at 40.

Thus, the contact email addresses for the specimen filed in support of the application's Section 1(a) in-use basis at the time of filing have always resolved to an unaffiliated, unrelated email account throughout the existence of the specimen from the application filing date through at least as late as late 2012. *Admissions* at 40.

Respondent has not produced a television program in connection with the WHAT WOULD JESUS DO mark, nor has she sold, distributed, or caused to have broadcast such a television program. *Admissions* at 14-18, 27. The foregoing is contrary to the Declaration of Use in the subject registration, in which Respondent alleged that the mark was already in use at the time of filing. Respondent has no rights in the subject mark based on use in commerce. *Admissions* at 19. Moreover, she had no rights prior to the application filing date of January 14, 2008. *Admissions* at 20. Respondent also admits that funds sufficient to produce a television show in connection with the WHAT WOULD JESUS DO mark have not been raised, *Admissions* at 25, and that she only began soliciting funds online at the specimen web page's URL subsequent to the filing of the instant cancellation proceeding by Petitioner. *Admissions* at 26.

At the time of filing the '640 Appl., Respondent did not intend to produce a television program in connection with the subject mark. *Admissions* at 28. Moreover, she had not begun production of a television program in connection with the mark as of the first use or the filing date, which followed the declared date of first use by several months. *Admissions* at 33. Since 2007, prior to the filing date of the subject application, Respondent has not taken meetings in

connection with the production of a television program in connection with the subject mark. *Admissions* at 43.

Petitioner is desirous of using the mark WHAT WOULD JESUS DO in connection with entertainment services in a variety of formats and has filed a federal trademark application to that effect. However, Respondent's registration is blocking Petitioner's application from advancing. *Petition to Cancel* at 1, 8.

V. ARGUMENT

A. The Registration Was Fraudulently Obtained And The Mark Is Not In Use By Respondent, Thus The Registration Should Be Canceled.

To prevail in the instant cancellation proceeding, Petitioner must show that the subject Registration was fraudulently obtained by demonstrating that Respondent's Declaration of Use in the subject registration was fraudulent. Respondent has, by her own admission, demonstrated as much, since the mark was not in use in connection with the subject services as of the alleged first-use dates, nor the time of filing the Declaration of Use, and it has not been used since that time. As a result, Respondent's mark is not entitled to registration, and cancellation is appropriate and necessary. *Compton v. Fifth Avenue Ass'n*, 7 F.Supp.2d 1328, 47 USPQ2d 1300 (M.D. Fla. 1998)(even if the petitioner has not proven prior use, the claim of non-use in commerce is a proper ground for cancellation; registration was canceled for lack of use at any time); *Bonaventure Associates v. Westin Hotel Company*, 218 USPQ 537, 543 (TTAB 1983)("It is, of course, a statutory mandate that only a trademark or service mark 'used in commerce' is entitled to registration under the Lanham Act...." Petition was dismissed on the merits).

B. Respondent Has No Rights In The Subject Mark

1. *Respondent Has Not Used the Mark in Commerce*

The '123 Reg. is void because Respondent has not used the mark in connection with the subject services identified therein. Absent use of a trademark, no rights may inure, and a registration granted in the absence of genuine use in commerce subject to the regulation of

Congress is void and subject to cancellation. In an application based on use in commerce under §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* 37 C.F.R. §2.34(a)(1)(i). Respondent has not used the subject mark in connection with the subject services, including as of the claimed dates of first use, the filing date of the subject registration, and currently. She has not taken even exploratory initial meetings in connection with the subject services identified in the '123 Reg., much less produced, sold, distributed or exhibited television programs in connection with the mark. Because the WHAT WOULD JESUS DO mark has not been used by Respondent in commerce, the '123 Reg. should be canceled.

2. *Respondent's Declaration of Use is Fraudulent*

Respondent's material misstatements in the application that resulted in the '123 Reg. concerning use in commerce are fraudulent and necessitate cancellation of the registration. It is settled that fraud made in the original application papers relates to fraudulently obtaining a registration and is grounds for cancellation at any time. *Bart Schwartz Int'l Textiles, Ltd. V. Federal Trade Comm.*, 129 USPQ 258 (CCPA 1961); *Ets. Lardenois v. Lazarus*, 168 USPQ 604 (TTAB 1970). At least as significant as Respondent's admitted and demonstrated lack of use of the mark is the fact that she materially misstated the status of use in the initial application. Respondent has not used the mark in commerce in connection with the subject services, and has not used the mark as of the first-use dates alleged in the application. Indeed, she has not used the mark in commerce in connection with the subject services as of the filing date, nor since the application was filed. Such misrepresentation, where the Declaration of Use clearly alleges use in commerce that commenced prior to the filing date of the application, renders the registration *void ab initio*.

Moreover, even if merely creating a fake "audition" web page like the specimen of use submitted in support of the '123 Reg. were sufficient to support use in commerce under the

Lanham Act, which Petitioner does not concede, the specimen created and filed by Respondent is fatally flawed. It contains no contact information – no means to effect the purported "auditions" in connection with the subject services – other than fictitious email addresses that resolve to an email address not owned or used in any way by the Respondent. Thus, Respondent's claims of use in commerce in the application - made under oath - are clearly bogus and do not describe any *bona fide* use in the ordinary course of trade, and the registration must therefore be canceled.

VI. SUMMARY

Wherefore, Petitioner the Board find non-use of the WHAT WOULD JESUS DO mark and/or fraud in obtaining the '123 Registration, and that this Cancellation Proceeding be sustained, and the subject registration be canceled and/or take any other appropriate action the Board deems just and proper.

Respectfully Submitted,

Tyler Perry Studios, LLC

Dated: March 6, 2014

By:_____

Victor K. Sapphire, Esq.
Michelman & Robinson, LLP
15760 Ventura Blvd., 5th Floor
Encino, California 91436
(818) 783-5530
vsapphire@mrllp.com

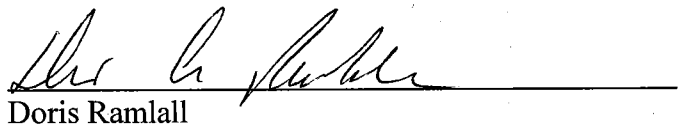
ATTORNEYS FOR PETITIONER

CERTIFICATE OF SERVICE

I hereby certify that on this 7th day of March 2014 a true and correct copy of the foregoing document was caused to be served on the following party as indicated:

VIA FIRST CLASS MAIL

Kelly J. Adams, Esq.
3826 Rotherfield Ln
Chadds Ford, Pennsylvania 19317
Attorney for Respondent



Doris Ramlall