

**This Opinion is Not a  
Precedent of the TTAB**

Mailed: June 20, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Tyler Perry Studios, LLC*

*v.*

*Kimberly Kearney*  
—

Cancellation No. 92053298  
to Registration No. 3748123  
registered on February 16, 2010  
—

Victor K. Sapphire of Michelman Robinson LLP  
for Tyler Perry Studios, LLC

Kelly J. Adams of Alpha Omega Law Firm, LLC  
for Kimberly Kearney  
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Before Kuhlke, Ritchie and Hightower,  
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Tyler Perry Studios, LLC (Petitioner) seeks to cancel Kimberly Kearney's  
(Respondent) registration for the mark WHAT WOULD JESUS DO in standard

characters for “Entertainment services in the nature of an on-going reality based television program,” in International Class 41.<sup>1</sup>

As grounds for cancellation, Petitioner alleges that Respondent “has never used or has discontinued use of the mark WHAT WOULD JESUS DO with no intent to resume said use, thus abandoning the mark... ” Pet. ¶ 2. Petitioner further alleges that it will be damaged because Respondent’s “registration is blocking Petitioner’s Application.” Pet. ¶ 8. Thus, Petitioner pleaded the claims of nonuse or in the alternative abandonment.<sup>2</sup>

In her answer, Respondent admits that “the trademark attorney ... refused their mark because [her] application proceeded theirs and their similarity to [her] mark in name and use, and the fact [hers] was already in process” (Answer ¶ 6) and otherwise denies the salient allegations.

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<sup>1</sup> Registration No. 3748123, filed on January 14, 2008, under Section 1(a), 15 U.S.C. § 1051(a), claiming a date of first use and first use in commerce on November 21, 2007, issued on February 16, 2010.

<sup>2</sup> Petitioner also presents argument in its brief that Respondent committed fraud in her procurement of the registration; however, this claim was not pleaded and has not been tried by implied consent. *Productos Lacteos Tocumbo S.A. de C.V. v. Paletteria La Michoacana Inc.*, 98 USPQ2d 1921, 1927 (TTAB 2011) (petitioner’s “family of marks” claim, raised for the first time in its brief not considered because it was neither pleaded nor tried by the parties). *See also Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1929 (TTAB 2006). To the extent Respondent’s arguments in her brief could be construed as implied consent to add this claim, the evidence of record is not sufficient to establish the intent element of fraud which must be “proven to the hilt.” *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1939 (Fed. Cir. 2009), *quoting, Smith Int’l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981). Respondent’s admissions that she “has not produced a television program in connection with the WHAT WOULD JESUS DO Mark” (Admission No. 27) and that she “did not intend to produce a television program in connection with the WHAT WOULD JESUS DO Mark in January, 2008” (Admission No. 28) do not conclusively establish that she made false statements in the procurement of her registration with the subjective *intent to deceive*. *Bose*, 91 USPQ2d at 1941 (evidence of intent to deceive must be clear and convincing).

## RECORD

By operation of the Trademark Rules, the pleadings herein and the file of the subject registration are of record. Trademark Rule 2.122, 37 C.F.R. § 2.122. Petitioner submitted under Notice of Reliance a copy of its Requests for Admissions and the mailing receipts showing timely service thereof on Respondent.<sup>3</sup> Respondent did not submit any testimony or other evidence.

## STANDING

As noted above, Respondent by her answer admits that Petitioner's application for a similar mark has been refused registration in view of Respondent's registration. In addition, as discussed *infra*, Respondent admits that Petitioner is a competitor and that they offer services through "some of the same trade channels." Admission Nos. 11 and 44. In view thereof, Petitioner's standing is established. *See Saddlesprings Inc. v. Mad Croc Brands Inc.*, 104 USPQ2d 1948, 1950 (TTAB 2012); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012). *See also Jeweler's Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987).

## NONUSE

Under Section 1(a) of the Trademark Act, a mark may not be registered unless it is "used in commerce." 15 U.S.C. § 1051(a)(1). "The term 'use in commerce'

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<sup>3</sup> Although Petitioner asserts in its brief that "Petitioner's U.S. Appl. Serial No. 77/477,214" is of record, Petitioner's application is not of record by operation of Trademark Rule 2.122(b) because it is not the subject of the cancellation petition, and this is not an interference or concurrent use proceeding. In addition, Petitioner did not submit its application under Notice of Reliance during its trial period. Therefore, this application is not of record.

means the bona fide use of a mark in the ordinary course of trade ... 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.” 15 U.S.C. § 1127. “The word ‘commerce’ means all commerce which may lawfully be regulated by Congress.” 15 U.S.C. § 1125.

Where it is found that there has been no use of the mark in commerce in connection with any of the applied-for services prior to the filing of an application under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), the application is void *ab initio*. *ShutEmDown Sports*, 102 USPQ2d at 1045 (nonuse by respondent at the time of filing the underlying application, cancellation granted). *See also Clorox Co. v. Salazar*, 108 USPQ2d 1083, 1086 (TTAB 2013). In this case, the operative date is January 14, 2008, the filing date of the application which issued into the subject registration.

Petitioner argues that Respondent has not used the mark in connection with the identified services, “as of the claimed dates of first use, the filing date of the subject registration and currently.” Pet. Br. p. 8. Petitioner relies on its Requests for Admission which are deemed admitted to satisfy its burden of proof.<sup>4</sup> The most pertinent are set forth below:

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<sup>4</sup> Petitioner served the Requests for Admissions on October 10, 2012. On January 30, 2013, after the close of Petitioner’s trial period, Respondent moved to reopen her time to respond. On June 27, 2013, the Board denied Respondent’s request to have her late-filed responses accepted or the admissions withdrawn.

Admit that Respondent and Petitioner offer competing products and are competitors. (Admission No. 11);

Admit that Respondent has not produced a television program in connection with the WHAT WOULD JESUS DO Mark. (Admission No. 14);

Admit that Respondent has not sold a television program in connection with the WHAT WOULD JESUS DO Mark. (Admission No. 15);

Admit that Respondent has not distributed a television program in connection with the WHAT WOULD JESUS DO Mark. (Admission No. 16);

Admit that Respondent has not had exhibited by a television broadcast or cable network a television program in connection with the WHAT WOULD JESUS DO Mark. (Admission No. 17);

Admit that Respondent has no rights in the WHAT WOULD JESUS DO Mark based on use in commerce. (Admission No. 19);

Admit that Respondent has not produced a television program in connection with the WHAT WOULD JESUS DO Mark. (Admission No. 27);

Admit that Respondent did not intend to produce a television program in connection with the WHAT WOULD JESUS DO Mark in January, 2008. (Admission No. 28);

Admit that Respondent's contact email addresses on the "whatwouldjesusdo.tv" web site are nonfunctional and resolve to info@coolexample.com. (Admission No. 29);

Admit that Respondent's contact email addresses on the "whatwouldjesusdo.tv" web site have never been functional. (Admission No. 30);

Admit that Respondent's "whatwouldjesusdo.tv" web page that was used as a specimen of use in the instant application was created for the sole purpose of securing the instant registration. (Admission No. 31);

Admit that Respondent had not begun to produce a television program in connection with the WHAT WOULD JESUS DO Mark at the time of filing the instant application. (Admission No. 33);

Admit that Respondent does not own, administer or have access to an email account at the info@coolexample.com” address. (Admission No. 38);

Admit that Respondent has taken no meetings in connection with the production of a television program in connection with the WHAT WOULD JESUS DO Mark. (Admission No. 42); and

Admit that Petitioner sells Petitioner’s Services and Respondent sells Respondent’s Services through at least some of the same trade channels. (Admission No. 44).

Because Respondent did not timely answer Petitioner’s Requests for Admission the facts included are deemed admitted and are “conclusively established.” Fed. R. Civ. P. 36(b). *See Fabriko Acquisition Corp. v. Prokos*, 536 F.3d 605, 607 (7th Cir. 2008); *Fram Trak Industries, Inc. v. Wiretracks LLC*, 77 USPQ2d 2000 (TTAB 2006). Despite Respondent’s denials in her answer to the petition, the deemed admissions supersede those denials and we are bound by them. *In re Corporation of Windham College*, 34 B.R. 408, 411 (Bankr., Vt. 1983) (“An admission under the rule is comparable to an admission in pleadings; but where a denial contained in the pleadings is inconsistent with an admission under the rule, the admission under the rule supersedes the denial contained in the pleadings.”). Thus, it is conclusively established that Respondent did not use the phrase WHAT WOULD JESUS DO for “entertainment services in the nature of an on-going reality based television program” as of the filing date of her application.

Respondent asserts in her brief that:

[She] first used this mark in November 2007 at which time she initiated the beginning stages of her reality based television program. During the initial stage of production, Respondent shared her television program and title with Tyler Perry Studios (“Petitioner”). Subsequently, Respondent filed for an application to register the mark. Not many months after sharing this program and soliciting the Petitioner for financial support of this program, Petitioner filed to register this mark ... .

Resp. Br. p. 4.

As noted above, Respondent did not submit any testimony or evidence during trial. Therefore, even if such activities could constitute use sufficient to support a use-based application or her pleading could be viewed as including a defense of unclean hands, these allegations are unsupported and we may not adduce any facts from them.

Respondent also appears to rely on the use statements and specimens in the file history of her registration; however, “[t]he allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence. Specimens in the file of an application for registration, or in the file of a registration, are not evidence on behalf of the applicant or registrant unless identified and introduced in evidence as exhibits during the period for the taking of testimony.” Trademark Rule 2.122(b)(2). Although the file is of record under Trademark Rule 2.122(b)(1), as dictated by Trademark Rule 2.122(b)(2), the statements and documents appearing therein, may not be relied upon as evidence to establish facts.

Respondent's registration is, of course, afforded protection under Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b), by presumption of validity and ownership. However, once a petitioner sufficiently rebuts that presumption, a respondent must introduce such testimony and evidence sufficient to rebut petitioner's prima facie case. Here, Petitioner has established its prima facie case and it was incumbent on Respondent to identify and introduce such evidence, including its specimens of use, under testimony in order to support her various assertions.

In addition, Respondent's assertions regarding what constitutes bona fide use in the ordinary course of trade in the entertainment industry are similarly unsupported by any evidence.<sup>5</sup>

In view of the above, Petitioner has satisfied its burden to establish the claim of nonuse and it stands un rebutted.

**Decision:** The petition to cancel Registration No. 3748123 is granted on the ground of nonuse. The registration will be cancelled in due course.

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<sup>5</sup> Respondent's request in the alternative "to amend her application to an 'Intent to Use' application" is denied. There is no provision for "reopening" a registration to amend to seek registration on another basis.