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

Proceeding	92053501
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration No. 1043729  
Date of Registration: July 13, 1976

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CHRISTIAN M. ZIEBARTH  
Petitioner,

Cancellation No.: 92053501

v.

DEL TACO, LLC  
Registrant.

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Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

**PETITIONER'S TRIAL BRIEF IN SUPPORT OF PETITION FOR CANCELLATION**

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### **STATUTES**

15 U.S.C. § 1052(d)

15 U.S.C. § 1064(3)

15 U.S.C. § 1127

### **TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE**

§ 704.04

§ 704.08(b)

### **TREATISES**

3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 17:3 (4<sup>th</sup> Ed. 2012)

Siegrun D. Kane, Kane on Trademark Law, A Practitioner's Guide. (Practicing Law Institute), § 12:2:3 (5<sup>th</sup> Ed. 2007)

## **DESCRIPTION OF THE RECORD**

### Evidence Submitted by Petitioner:

1. Affidavit of Petitioner Christian M. Ziebarth and Exhibits A-Q thereto; Confidential Exhibit R to Ziebarth Affidavit (hereinafter “Ziebarth Aff.”); (Docs. 57, 58)
2. Affidavit of Rob Hallstrom and Exhibit H thereto (Doc. 59) (hereinafter “Hallstrom Aff.”)
3. Affidavit of Daniel Dvorak (Doc. 60) (hereinafter “Dvorak Aff.”)
4. Cross-Examination Testimony of Noah Chillingworth and Exhibits; Confidential portion of Cross-Examination Testimony of Noah Chillingworth and Exhibits 30-31 (Docs. 85, 86) (hereinafter “Chillingworth Cross-Exam Test.”)
5. Del Taco’s Answers to Interrogatories and Del Taco’s Answers to Requests for Admissions (Docs. 50-54)
6. “Adios to Naugles” Orange County Register Newspaper Article (Doc. 55)

### Evidence Submitted by Del Taco:

1. Cross-Examination Testimony of Petitioner and Exhibits thereto; Confidential portion of Cross-Examination Testimony of Petitioner and Exhibit R thereto (Docs. 76, 77) (hereinafter “Ziebarth Cross-Exam Test.”)
2. Cross-Examination Testimony of Rob Hallstrom and Exhibits thereto (Doc. 64) (hereinafter “Hallstrom Cross-Exam Test.”)
3. Cross-Examination Testimony of Daniel Dvorak and Exhibits thereto; Confidential portion of Cross-Examination Testimony of Daniel Dvorak and Exhibit R thereto (Docs. 73, 74) (hereinafter “Dvorak Cross-Exam Test.”)
4. Affidavit of Noah Chillingworth and Exhibit 29 thereto; Confidential portion of Cross-Examination Testimony of Noah Chillingworth and Exhibits 30-31 thereto (Docs. 78, 79) (hereinafter “Chillingworth Aff.”) (portions subject to objection by Petitioner)
5. NAUGLES Trademark Registration No. 4,261,951 for clothing (Doc. 63) (hereinafter “Del Taco’s clothing registration”)

6. Petitioner's Discovery Responses: Answers to Interrogatories and Request for Production of Documents (Doc. 65); Petitioner's Answers to Requests for Admissions (Doc. 66); Petitioner's Supplemental Answers to Interrogatories and Request for Production of Documents (Doc. 67); Petitioner's Confidential Answers to Interrogatories and Request for Productions of Document (Doc. 68); Petitioner's Supplemental Answers to Requests for Admissions (Doc. 69); Petitioner's Rule 26(e) Supplemental Answers to Requests for Admissions (Doc. 70); Petitioner's Rule 26(e) Answers to Interrogatories and Request for Productions of Document (Doc. 71); Petitioner's Rule 26(e) Confidential Answers to Interrogatories and Request for Productions of Document (Doc. 72)
7. Del Taco's Wayback Machine webpages (Doc. 77)

Evidence Automatically of Record:

1. The complete file for trademark Registration No. 1043729 for the mark NAUGLES, owned by Del Taco, for restaurant services (hereinafter "Del Taco's Registration")

## I. STATEMENT OF ISSUES

The only issues before the Board are:

1. Whether Del Taco's Registration No. 1043729 for NAUGLES for "restaurant services" has been abandoned under 15 U.S.C. § 1127 and should therefore be cancelled.
2. Whether Petitioner has standing to seek cancellation of Registration No. 1043729.

## II. RECITATION OF THE FACTS

On May 17, 2010, Petitioner CHRISTIAN M. ZIEBARTH ("Petitioner") filed application serial No. 85040746 (hereinafter "Petitioner's ITU application") to register the mark NAUGLES in standard characters in connection with restaurant and cafeteria services. Ziebarth Aff., ¶ 4, Ex. A. In an Office Action dated January 10, 2011, Petitioner's ITU application was given a final refusal based on an alleged likelihood of confusion with Registration No. 1043729 for the mark NAUGLES for restaurant services ("Del Taco's registration"), which is owned by Registrant DEL TACO, INC. ("Del Taco"). Ziebarth Aff., ¶ 4, Ex. B.<sup>1</sup> Petitioner filed a petition to cancel Del Taco's registration on December 20, 2010. His sole ground for seeking cancellation of Del Taco's registration is abandonment.

### A. THE HISTORY OF NAUGLES RESTAURANTS

In the 1970's and 1980's, Naugles was a quality, Mexican, fast-food chain, established by its original owner Dick Naugle. Wayback Machine webpages (Doc. 77); Ziebarth Aff., ¶ 9. In 1988, Del Taco acquired the small chain of Naugles restaurants and, approximately one year

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<sup>1</sup> Petitioner acknowledges that an additional ground for refusal other than § 2(d) was cited by the examining attorney, a ground which Petitioner intends to deal with in due course but is not the subject of this proceeding.

later in 1989, Del Taco began phasing them out by either turning them into Del Taco restaurants or shutting them down altogether. Ziebarth Cross-Examination Test., p. 106, lines 7-17; Ziebarth Aff., ¶¶ 19-20, Ex. M; “Adios to Naugles” newspaper article (Doc. 55).

On or about October 25, 1995, Del Taco closed the last Naugles restaurant. Del Taco’s Answers to RFAs Nos. 1-17, 22 and 23, (Docs. 53, 54); Chillingworth Cross-Exam Test., p. 54, lines 1-24. From October 25, 1995 to the present date, Del Taco has not opened or operated any Naugles restaurants. Del Taco’s Responses to Interrogs., Nos. 1-17 (Docs. 50-52); Del Taco’s Answers to RFAs, Nos. 1-17, 22 and 23, (Docs. 53, 54); Chillingworth Cross-Exam Test., p. 55, lines 2-6. Del Taco has no plans to resume operations of any Naugles restaurants in the future. Del Taco’s Answers to RFAs No. 23 (Doc. 54); Chillingworth Cross-Exam Test., p. 55, lines 8-24.

Noah Chillingworth is Del Taco’s Vice President of Marketing and the company’s one and only witness in this proceeding. [REDACTED]

[REDACTED]  
[REDACTED] [REDACTED]  
[REDACTED]

[REDACTED] Del Taco has produced no testimony nor documentary evidence establishing that it has made any attempt to incorporate the brand NAUGLES into its current restaurants or restaurant services. Mr. Chillingworth testified that, if he did have any documents evidencing any kind of NAUGLES campaign, he would have produced it. Chillingworth Cross-Exam Test., p. 75, line 12 through p. 76, line 17; p. 77, lines 20-23.

## **B. PETITIONER'S STANDING TO FILE HIS INTENT-TO-USE APPLICATION FOR THE NAUGLES TRADEMARK**

From approximately 2008 to 2010, prior to filing his ITU application for the NAUGLES mark, Petitioner developed the idea to open his own NAUGLES restaurants. Ziebarth Aff., ¶¶ 2, 3, 5, 8, 9, 10-18. At first, Petitioner was under the misconception that Del Taco owned the NAUGLES trademark indefinitely. Thinking he could not use the mark himself, he attempted to take his idea of creating a NAUGLES sub menu to one of Del Taco's Public Relations Representatives, Barbara Caruso. Ziebarth Aff., ¶¶ 3, 5, 6. Ms. Caruso expressed interest in Petitioner's idea and even apparently attempted to set up meetings between Petitioner and a Del Taco executive. Ziebarth Aff., ¶ 6, Ex. D. It was not until approximately Summer of 2009 that Petitioner learned about the legal concept of abandonment. He then determined that Del Taco had abandoned the NAUGLES trademark through its nonuse of over a decade. Petitioner's Response to Interrog. No. 4 (Doc. 67). After learning these facts and having made a sincere effort to help Del Taco profit from the NAUGLES brand, then and only then, after seeing Del Taco's apparent disinterest in any sort of NAUGLES revival, did Petitioner move forward with his idea of using the mark himself and opening his own restaurants. Petitioner's Response to Interrog. No. 4 (Doc. 67)

Petitioner took multiple, concrete steps to get his idea for his NAUGLES restaurants off the ground prior to filing his ITU application. Petitioner reached out to several members of the original Naugle family in an effort to obtain information, recipes and backing to open his restaurants. Ziebarth Aff., ¶¶ 9, 10, 15, 16, Ex. F, G, I, and J. In particular, Petitioner initiated a relationship with Jeff Naugle, who owns and runs a restaurant himself in Visalia, California and utilizes the recipes from the original Naugles restaurants. Ziebarth Aff., ¶ 9. Petitioner met with Jeff Naugle for the first time in February 2010, and Jeff was supportive of Petitioner's efforts to

open Naugles restaurants. Ziebarth Aff., ¶¶ 9-11; Ziebarth Cross-Exam Test., p. 38, line 3 through p. 40, line 9. Petitioner and Jeff discussed allowing Petitioner to use the original Naugles restaurant recipes (Ziebarth Cross-Exam Test., p. 128, lines 7-12), possible locations for Petitioner's first restaurant, potential operators for Petitioner's first restaurant (Ziebarth Aff., ¶ 9; Ziebarth Cross-Exam Test., p. 35, lines 16-24), capital and funding sources to get Petitioner's idea off the ground (Ziebarth Cross-Exam Test., p. 33, lines 2-5), and other specifics about starting a food establishment under the NAUGLES mark. Ziebarth Aff., ¶ 9; Ziebarth Cross-Exam Test., p. 32, lines 6-16. Petitioner introduced emails exchanged between Mr. Naugle and himself, as well as a page out of his personal calendar from February 2010 where he documented the meeting to support his testimony regarding that first meeting and those initial discussions. Ziebarth Aff., ¶¶ 9, 10, Ex. F, G.

In addition to Jeff Naugle, Petitioner shared his intention of opening his NAUGLES restaurants with friend and restaurateur Rob Hallstrom, who provided an affidavit in support of Petitioner's case. Halstrom Aff., ¶¶ 2, 3; Ziebarth Aff., ¶¶ 12-14. Between January of 2010 and May 2010, prior to filing his ITU application, Petitioner and Mr. Hallstrom had in-person meetings and exchanged numerous emails about making Petitioner's NAUGLES restaurants idea a reality. Ziebarth Aff., ¶ 13, Ex. H; Halstrom Aff., ¶¶ 2, 3. Petitioner and Mr. Hallstrom discussed who would hold which positions in any future corporation that was formed and where additional capital would be sought. *Id.* The two men also looked at a few properties, hoping to find a location for Petitioner's first NAUGLES restaurant. Ziebarth Aff., ¶ 14, Ex. H; Halstrom Aff., ¶ 3; Ziebarth Cross-Exam Test., p. 45, lines 4-21 and p. 46, lines 5-12 (Petitioner identifies a specific building location).

Prior to filing his ITU application, Petitioner also discussed his intention of opening NAUGLES restaurants with a business associate, Daniel Dvorak, who has also submitted an affidavit in support of Petitioner's case. Mr. Dvorak is now a business partner with Petitioner in his NAUGLES venture. Dvorak Aff., ¶ 1. Petitioner and Mr. Dvorak discussed Petitioner's concept for opening NAUGLES restaurants and Mr. Dvorak testified to the fact that Petitioner was actively seeking financial backing for his NAUGLES venture, as well as scouting locations for potential NAUGLES restaurants prior to filing his ITU application. Dvorak Aff., ¶¶ 2, 3. In or about May of 2010, Mr. Dvorak offered to handle marketing for Petitioner's NAUGLES venture. Dvorak Aff., ¶ 4.

Also prior to filing his ITU application, Petitioner registered the domain name [www.nauglestacos.com](http://www.nauglestacos.com) and was using this website as advertising to promote his intentions to open NAUGLES restaurants. Ziebarth Cross-Exam Test., p. 84, lines 20-25; p. 85, line 6 through p. 86, line 14; Ziebarth Aff., ¶ 17, Ex. K, L. Petitioner still keeps this website active to date in furtherance of his efforts to open NAUGLES restaurants. *Id.* Petitioner also created the "Señor Naugles" twitter account "@Naugles" prior to filing his ITU application and still operates it today. Ziebarth Aff., ¶ 18. He also helps administer the NAUGLES Facebook page. Ziebarth Aff., ¶ 18.

Prior to filing his ITU application, Petitioner researched and experimented with recipes for his intended NAUGLES restaurants menu items and held at least one "preview meal" using those recipes. Ziebarth Cross-Exam Test., p. 149, line 20-p. 150, line 13. Prior to filing his ITU application, Petitioner had a good grasp of what menu items he wanted served in his restaurants. Ziebarth Cross-Exam Test., p. 152, line 19 through p. 153, line 5.

### C. SUMMARY OF DEL TACO'S EVIDENCE

The last Naugles restaurant closed on or about October 25, 1995. To support its position that use of the NAUGLES mark for restaurant services never ceased after 1995, Del Taco submitted the following evidence:

1. A one-page food menu containing the phrase “Viva Naugles” (Chillingworth Aff., Ex. 11);<sup>2</sup>
2. Webpages taken from the Wayback Machine which purport to show that, at least sporadically from February 2003 to October 2006, Del Taco used the phrase “Viva Naugles” on the “History” page of its www.deltaco.com website (Doc. 77);
3. Slides from two, internal marketing meetings which took place in April 2009 and June 2010. Chillingworth Aff., Ex. 30 and 31 (Doc. 79);
4. A NAUGLES trademark registration for clothing, Registration No. 4,261,951 (“Del Taco’s clothing registration”), alleging sales began September 15, 2011 (Doc. 63); and
5. Testimony from Del Taco’s Vice President of Marketing, Noah Chillingworth (Doc. 78).

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<sup>2</sup> This document is the subject of an objection/motion to strike by Petitioner because Del Taco was unable to lay any foundation for this document. The admissibility of this page has been objected to in detail in Petitioner’s Separate Statement of Objections.

### III. ARGUMENT: DEL TACO ABANDONED THE NAUGLES MARK

Under the Lanham Act, Del Taco has abandoned the NAUGLES trademark in connection with restaurant services.

#### A. LEGAL STANDARD FOR ABANDONMENT

Abandonment is a statutory ground for cancellation of a federal trademark registration at any time. 15 U.S.C. § 1064(3). A mark shall be deemed abandoned when 1) its use has been discontinued for three consecutive years, and 2) there is no intent to resume such use. 15 U.S.C. § 1127. “Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. ‘Use’ of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in the mark.” 15 U.S.C. § 1127.

In inter-partes proceedings, the challenger must prove abandonment by a “preponderance of the evidence.” Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc., 13 U.S.P.Q.2d 1307 (Fed. Cir. 1989). Once a petitioner presents a prima facie case that trademark use has ceased in connection with the claimed services at a certain date in the past and the nonuse presumption is triggered, the registrant must present some evidence in rebuttal. Auburn Farms, Inc. v. McKee Foods Corp., 51 U.S.P.Q.2d 1439 (T.T.A.B. 1999) [not precedential]. “Although the ultimate burden of proof as to abandonment remains with the party asserting this [claim], where non-use gives rise to the statutory presumption of abandonment, the trademark owner must come forward with evidence that the “circumstances do not justify the inference of an intent not to resume use.” ITC Ltd. v. Punchgini, Inc., 373 F. Supp. 2d 275, 280 (S.D.N.Y. 2005), aff’d, 482 F. 3d 135 (2d Cir. 2007); Emmpresa Cubana del Tabaco v. Culbro Corp., 213 F. Supp. 2d 247, 268 (S.D.N.Y. 2002) (citing Exxon Corp. v. Humble Exploration Co., 695 F. 2d 96, 99 (5th Cir. 1983)).

## **B. DEL TACO DISCONTINUED USE OF THE NAUGLES MARK FOR WELL OVER THREE CONSECUTIVE YEARS**

Taken from any angle, abandonment is the inevitable conclusion in this proceeding. Del Taco abandoned the NAUGLES mark in 1995 when it closed its last restaurant, and the record is devoid of any use by Del Taco from 1995 through Present.<sup>3</sup> As such, the presumption of abandonment was triggered October 25, 1998. Even if all of Del Taco's evidence is considered evidence of "use for restaurant services," abandonment is still the only available outcome given the sporadic and sparse amount of evidence of "use" offered. Any way it's sliced, the conclusion of abandonment is inescapable, as detailed below.

### **1. Del Taco discontinued use of the NAUGLES mark.**

Based on the evidence Del Taco presented, it is indisputable that it abandoned the NAUGLES mark from at least October 2006 through the present, as Del Taco has produced no evidence of "use" more recent than its October 2006 "History" webpage. Do. 77. Irrespective of this fact, Petitioner maintains that abandonment actually occurred in the 1990's.

Del Taco openly admits that the last Naugles restaurant closed on October 25, 1995. Del Taco's Answers to RFAs, Nos. 1-17, 22 and 23 (Docs. 53, 54); Chillingworth Cross-Exam Test., p. 54, lines 1-24. After 1995, the record in this proceeding is thin when it comes to Del Taco's efforts to establish any use of the NAUGLES mark for restaurant services. In fact, for the years of 1995 through 2003, the record is completely devoid of any documents or witnesses that can

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<sup>3</sup> While Petitioner acknowledges that Del Taco has introduced its "History" webpages (Doc. 77) alleging use at least sporadically from February 2003 through October 2006, Petitioner contends that these pages do not equate to use for restaurant services and do not cure Del Taco's past abandonment.

support Del Taco's claim that the mark was in use at all. In such cases, the Board is justified in drawing the logical inference that there was, in fact, no use of the mark during this time frame.

**2. Del Taco's nonuse of the NAUGLES mark has persisted for approximately 19 years.**

Del Taco has never resumed use of the NAUGLES mark for restaurant services. From October 25, 1995 to the present, Del Taco has not opened or operated any Naugles restaurants. Del Taco's Responses to Interrogs., Nos. 1-17 (Docs. 50-52); Del Taco's Answers to RFAs, Nos. 1-17, 22 and 23 (Docs. 53, 54); Chillingworth Cross-Exam Test., p. 55, lines 2-6. Del Taco offered no evidence that it utilized the NAUGLES trademark between October 25, 1995 and February 2003. The only evidence presented to argue "use" by Del Taco after 1995 took place between February 2003 and October 2006, as is discussed in detail throughout. First, this "use" cannot cure the past abandonment. Second, this "use" does not rise to the level of concrete, commercial use for restaurant services. As such, Del Taco's challenge to Petitioner's abandonment claim must fail.

**a. Del Taco's use of the NAUGLES mark on its "History" webpage is not "concrete, commercial use."**

To support its position that it has consistently used the NAUGLES mark, Del Taco submitted webpages taken from the Wayback Machine which purport to show that, at least intermittently from February 2003 through October 2006, Del Taco used the NAUGLES mark on its website. Wayback Machine Pages (Doc. 77). Although Del Taco submitted 13 separate exhibits, each exhibit is exactly the same<sup>4</sup>: a one-page screenshot from Del Taco's website entitled "History."

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<sup>4</sup> During the cross-examination testimony of Del Taco's witness Mr. Chillingworth, counsel for both parties stipulated that Del Taco's Exhibits 16-28 were all identical in content substantively, the only difference being that the Wayback Machine from which they appear to be taken reflects

Del Taco hangs its case on the fact that this “History” webpage recites the fact that Del Taco acquired the Naugles restaurant chain in 1998 and contains the phrase “Viva Naugles” in small font.

**i. The “use” on Del Taco’s “History” webpage was a mere recital of Del Taco’s history.**

Del Taco’s “History” webpage does nothing more than give a “history” lesson to viewers, explaining that, in 1988, the Del Taco and Naugles chains merged. Wayback Machine Pages (Doc. 77). Mr. Chillingworth testified that the word “Naugles” cannot be found anywhere else on the Del Taco website except for the “History” page. Chillingworth Cross-Exam Test., p. 78, lines 3-16. No Del Taco menus, including those located inside Del Taco restaurants and online, contain the word “Naugles” anywhere on them. Chillingworth Cross-Exam Test., p. 72, line 24 through p. 73, line 21.

Del Taco’s “use” on its “History” webpage is a mere recital of the facts, not trademark use for restaurant services. The Seventh Circuit ruling in American Photographic Publishing Co. v. Ziff-Davis Publishing Co., 57 U.S.P.Q. 362 (7<sup>th</sup> Cir. 1943) is illustrative on this point. In the American Photographic case, the title of a monthly magazine, POPULAR PHOTOGRAPHY, was discontinued after four years of use, and the publication was combined into another magazine called AMERICAN PHOTOGRAPHY. The successor magazine continued to carry the statement “American Photography incorporating Popular Photography” for twenty years. The Seventh Circuit, however, found that the discontinuance was strong evidence of abandonment, and the statement in the new magazine was simply a description of its history. Id.

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that they were available online on different dates ranging between February 2003 and October 2006. Chillingworth Cross-Exam Test., p. 69, line 2 through p. 71, line 15.

Like the statement in the magazine in American Photographic, Del Taco’s “History” webpage functioned the same way: it was simply a description of the restaurant’s history and does not rise to the level of trademark use for restaurant services. Further, one solitary use of the phrase “Viva Naugles” on this page is not enough elevate its use to trademark use for restaurant services. In this proceeding, Del Taco’s historical reference evidence was only introduced for a brief span from 2003 to 2006, with no further references thereafter. This further illustrates the strength of Petitioner’s assertion of abandonment. Del Taco has not provided any credible evidence to cure the abandonment from 1995 through the date of Petitioner’s ITU application filing.

**ii. Del Taco’s “History” webpages have limited probative value.**

Del Taco’s “History” webpages have little probative value.

The probative value of Internet documents is limited. . . . A printout from a webpage may have more limitations on its probative value than traditional printed publications. A party may increase the weight the Board will give website evidence by submitting testimony and proof of the extent to which a particular website has been viewed. Otherwise, the document may not be considered to have much probative value.

T.B.M.P. § 704.08(b).

Del Taco offered no additional testimony or evidence to increase the weight that could be given to these webpages. In fact, Del Taco’s one and only witness testified that he had never seen these “History” webpages prior to this proceeding. Chillingworth Cross-Exam Test., p. 71, 17 through p. 72, line 7. As such, Del Taco’s “History” webpages should be granted limited probative value.

**iii. At best, Del Taco’s “History” webpages establish Token Use.**

If the Board disagrees with Petitioner’s position and concludes that the “use” demonstrated by Del Taco from February 2003 through October 2006 on its “History” webpages does constitute concrete, commercial trademark use, at the most, this use was token use, a weak attempt to keep rights in an unused mark, not meaningful, commercial-scale use contemplated by the Lanham Act. Westrex Corp. v. New Sensor Corp., 83 U.S.P.Q.2d 1215, 1219 (T.T.A.B. 2007) [precedential] (“[A] mere token sale or shipment of the goods does not constitute ‘use’ under the Trademark Act”). Additionally, should the board give credence to Del Taco’s 2003-2006 history reference, there is still no evidence to cure the abandonment thereafter, as detailed below.

**b. In the alternative, Del Taco’s 2003 use of the NAUGLES mark on its “History” webpages cannot cure past abandonment.**

Del Taco’s notice of reliance only claims that this version of its “History” webpage appeared on the www.deltaco.com website from February 2003 through October 2006. Wayback Machine Pages (Doc. 77). Even if Del Taco’s “History” webpages were accepted as trademark use, they only establish use seven and one-half years after the last Naugles restaurant closed. This falls short of the requisite, continuous use needed to prevent a triggering of the presumption of abandonment back in 1998.

“Once a period of nonuse results in abandonment, a resumption of use thereafter cannot cure the preceding abandonment. Such a separate resumption represents a new and separate use with a new date of first use. Once a trademark is abandoned, its registration may be cancelled even if the registrant subsequently resumes use of the mark.” 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 17:3 (4<sup>th</sup> Ed. 2012), citing Cerveceria Centroamericana,

S.A. v. Cerveceria India, Inc., 13 U.S.P.Q.2d 1307 (Fed. Cir. 1989); Stromgren Supports Inc. v. Bike Athletic Co., 43 U.S.P.Q.2d 1100 (T.T.A.B. 1997) (registration was cancelled for abandonment; evidence of intent to resume, which intent occurred after abandonment, is evidence of a possible new use which cannot cure the abandonment). Given the foregoing, at best, the 2003 use of the NAUGLES mark as seen on Del Taco’s “History” webpages constitutes a possible new use which cannot cure the 1990’s abandonment.

**c. In the alternative, Del Taco abandoned the NAUGLES mark a second time.**

Finally, even if the 2003 use did constitute a “new use” of the NAUGLES mark by Del Taco,<sup>5</sup> a second abandonment occurred, because Del Taco has offered no evidence of use after October 2006. The void of evidence of use between October 2006 and October 2009, again, creates a presumption of abandonment that must be rebutted by showing of an intent to resume use in the ordinary course of trade. Del Taco has offered no credible evidence that it intended to resume use during the period of nonuse, as discussed in detail below. As such, even if the Board believes Del Taco’s “History” webpages constitute a second, “new” trademark use for restaurant services, a second abandonment occurred, giving rise to the legal presumption of abandonment, and thus shifts the burden to Del Taco to again refute such presumption.

In sum, under no scenario can Del Taco defeat Petitioner’s claim of abandonment.

Abandonment is presumed as of October 25, 1998, after three years of consecutive nonuse. Del Taco’s “History” webpages from February 2003 to October 2006 do not rise to the level of trademark use, but, instead, are merely a recital of the history of Del Taco restaurants. In the alternative, if the Board finds Del Taco’s “History” webpages do constitute trademark use for

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<sup>5</sup> Petitioner does not concede that the 2003-2006 “History” webpages constitute a “new use,” as illustrated in greater detail throughout this brief.

restaurant services, this “use” cannot cure the past abandonment, and, thus, constitutes a second, new use as of February 2003. Del Taco offered no evidence of its “History” webpage after October 2006. As such, another presumption of abandonment arose in October 2009 after another three years of consecutive nonuse. Del Taco has not offered any credible evidence of an intent to resume use during the nonuse period and, as such, a second abandonment can be established. Anyway it’s sliced, the conclusion that Del Taco abandoned the NAUGLES trademark for restaurant services is inevitable. Absent evidence sufficient to cure abandonment, Petitioner’s petition to cancel should be granted.

### **3. Del Taco’s clothing registration offers no support to its case.**

The next alleged commercial use by Del Taco was in 2011, after Petitioner filed his ITU application. Del Taco offered its NAUGLES clothing registration in support of that position. Doc. 63. Del Taco’s clothing registration does not support its position because 1) offering two items of clothing for sale does not equate to use for restaurant services; 2) even assuming it shows use for restaurant services, it cannot cure past abandonment; 3) Del Taco offered no independent evidence to establish the truth of the facts contained in its clothing registration; and 4) at best, Del Taco’s clothing registration establishes nothing more than token use.

#### **a. Del Taco’s offer for sale of clothing items does not equate to use for restaurant services.**

Del Taco’s clothing registration does not establish use by Del Taco for restaurant services. While not binding on the Board, Emergency One, Inc. v. American FireEagle, Ltd., 56 U.S.P.Q. 2d 1343 (4<sup>th</sup> Cir. 2000) is instructive on this point. In Emergency One, the court held that, for the purpose of maintaining rights in a mark for fire trucks, neither a continuing use on

promotional items of clothing nor use on one recycled fire truck in three years, constituted use in the ordinary course of trade. Id. (“Thus, neither promotional use of the mark on goods in a different course of trade nor mere token use constitutes ‘use’ under the Lanham Act”).

Like in the Emergency One case, Del Taco is making a failed attempt to show that its use of the NAUGLES mark on clothing constitutes “use” in the ordinary course of trade for restaurant services. Any use by Del Taco on clothing is strictly promotional and constitutes use in a different course of trade, not restaurant services. As such, Del Taco’s clothing registration cannot help it establish continuing use of the NAUGLES mark for restaurant services.

**b. Del Taco’ use on clothing in 2011 cannot cure past abandonment.**

If the Board disagrees that Del Taco’s clothing registration cannot help establish continuing use for restaurant services, in the alternative, Petitioner asserts that this use cannot cure Del Taco’s past abandonment. Del Taco’s clothing registration alleges a first use in commerce date of September 15, 2011. Doc. 63; T.B.M.P. § 704.04 (“The allegations and statements made . . . in a registration may be used as evidence *against* the . . . registrant, that is, as admissions against interest and the like”). While Petitioner disagrees that the clothing registration serves the function Del Taco may claim, regardless, Del Taco’s use as of September 15, 2011 cannot cure Del Taco past abandonment, whether presumed in 1998 after a period of nonuse from October 25, 1995 through October 25, 1998 or, in the alternative, occurring in 2009 after a period of nonuse from October 2006 through October 2009. See Section III, B, supra.

As such, Del Taco’s clothing registration still cannot offer support for its allegation of continued use of the NAUGLES mark.

**c. At best, Del Taco's clothing registration evidences Token Use.**

Del Taco has offered no evidence to support the conclusion that its offer for sale of promotional clothing items is anything more than mere token use. General Motors Corp. v. Aristide & Co., Antiquaire de Marques, 87 U.S.P.Q.2d 1179 (T.T.A.B. 2008) [precedential] (because no information was offered about the number of items made or sold bearing the LASALLE mark, the Board concluded that, even if there was actual use, there was no basis to assume it was anything beyond "token" use). Although Del Taco's clothing registration lists a string of products in its identification of goods, in reality, Del Taco has, at best, offered two items for sale: one shirt and one hat. Chillingworth Cross-Exam Test., p. 34, lines 10-19. Del Taco does not sell any clothing items bearing the NAUGLES mark inside any brick and mortar stores or restaurants; sales are offered exclusively online and always have been. Chillingworth Cross-Exam Test., p. 14, lines 16-24. This further illustrates abandonment as the offer to sell online is in no way linked or tied to Del Taco's restaurant services.

Although Del Taco's clothing registration purports that Del Taco sold clothing bearing the NAUGLES mark, Del Taco cannot rely on the statements contained in the registration without independent evidence to establish them as fact. Osage Oil & Transportation, Inc. v. Standard Oil Co., 226 U.S.P.Q. 905, 906 n.4 (T.T.A.B. 1985) (statements and materials in registration file bearing on respondent's dates of use not evidence on behalf of respondent unless properly introduced). Del Taco offered no independent evidence pertaining to its sale of clothing. Although questioned at length on the subject during his cross-examination, Mr. Chillingworth could offer very little information about Del Taco's sale of clothing items. Mr. Chillingworth had no knowledge of how many shirts have been sold (Chillingworth Cross-Exam Test., p. 29, lines 19-21), no knowledge of how many hats have been sold (Chillingworth Cross-Exam Test.,

p. 32, lines 10-13), and no knowledge of where the clothing was produced, nor whether it was even produced in the United States (Chillingworth Cross-Exam Test., p. 19, line 23 through p. 20, line 1).

Based on the record in this proceeding, the Board has no information as to the volume of production or sales for Del Taco's promotional shirt and hat, and it has offered no independent evidence to establish when and if any sales were actually made. In short, it is simply unclear whether or when and on what goods the NAUGLES mark has actually been used. As such, under General Motors Corp., even if there was actual use by Del Taco, there is no basis to assume it was anything beyond "token" use.

### **C. DEL TACO'S CONDUCT EVIDENCES IT HAD NO INTENT TO RESUME USE OF THE NAUGLES MARK**

Under the second prong of the abandonment inquiry, Del Taco is unable to rebut the presumption of abandonment, because it cannot show that it had an intent to resume use of the NAUGLES mark. Once discontinuance of use has been established, the question of whether a trademark holder intends to resume use in commerce depends on more than a "purely subjective intention in the abandoner's mind to re-engage in a former enterprise at some indefinite future time." Specht v. Google, Inc., 758 F. Supp. 2d 570, 595 (N.D. Ill. 2010). "The registrant must put forth evidence with respect to what activities it engaged in during the nonuse period or what outside events occurred from which an intent to resume use . . . could reasonably be inferred." Imperial Tobacco Ltd. v. Phillip Morris, Inc., 899 F.2d 1575, 1581 (Fed. Cir. 1990). Such evidence should include specific plans to use the mark in commerce. See Specht, 758 F. Supp. 2d at 595.

In order to defeat the presumption of abandonment, Del Taco must have formulated an intent to resume use of its mark during the period of non-use. The Federal Circuit has specified that the registrant “must put forth evidence with respect to what activities it engaged in *during the nonuse period* or what outside factors occurred from which an intent to resume use *during the nonuse period* may reasonably be inferred.” Imperial Tobacco Ltd. v. Philip Morris, Inc., 899 F.2d 1575, 1581 (Fed. Cir. 1990) (emphasis added). As outlined in detail below, Del Taco has not put forth sufficient evidence to rebut the presumption. As such, Del Taco’s challenge must fail.

**1. Del Taco had no intent to resume concrete, commercial use in the reasonably foreseeable future.**

It is the intent to resume “commercial” use that is critical to rebutting a prima facie case of abandonment. Exxon Corp. v. Humble Exploration Co., 695 F.2d 96, 102 (5<sup>th</sup> Cir. 1983). “The importance of intent to resume commercial use was confirmed by the definition of abandonment under the 1988 revision (to the Lanham Act), which requires intent not to use in the ordinary course of trade.” Siegrun D. Kane, Kane on Trademark Law, A Practitioner’s Guide. (Practicing Law Institute), § 12:2:3 (5<sup>th</sup> Ed. 2007). An intent to resume commercial use must contemplate use in the reasonably foreseeable future. Emergency One, Inc. v. American FireEagle Ltd., 56 U.S.P.Q. 2d 1343 (4<sup>th</sup> Cir. 2000); Roulo v. Russ Berrie & Co., 886 F. 2d 931 (7<sup>th</sup> Cir. 1989).

Del Taco offered slides from two, internal marketing meetings to support its position that it still intends to resume use of the NAUGLES mark. Ex. 30 and 31 (Doc. 79). Both of these documents were produced to Petitioner confidentially and submitted to the Board confidentially, further supporting the fact that the public was never exposed to the ideas contained within.







two food items available at Del Taco were once sold at Naugles restaurants, especially when Del Taco actively markets those items as “Classic Del Taco” items. Ex. 30, p. 38. The more logical conclusion, given the lack of evidence to the contrary, is that Del Taco customers simply view those menu items as Del Taco menu items, nothing more.

■ [REDACTED]



connection with which the mark is employed.” United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90 (1918).

Del Taco offered no customer surveys, polls, or social media posts to support its position that customers still, or ever did, associate the NAUGLES mark for restaurant services with Del Taco. The only place in the record where there is evidence of consumers discussing NAUGLES took place within the last year, in 2013, on Petitioner’s own Twitter feed. Ziebarth Cross-Exam Test., Ex. 5-10.<sup>6</sup> Petitioner, not Del Taco, has generated some recent excitement amongst consumers for his own NAUGLES restaurants, and none of those consumers posted “tweets” as a result of any action taken by Del Taco. As such, Del Taco does not get credit, so to speak, for Petitioner’s actions and efforts behind generating recognition for his NAUGLES mark.

Further, the continued existence of fans of a product has failed to impress the Board in past cases. “The simple fact that there are collectors of an item, or that clubs exist for enthusiasts of a certain item . . . does not, by itself, defeat the statutory presumption of abandonment by the mark’s owner after almost forty years of nonuse in the ordinary course of trade.” Chrysler LLC v. Pimpo, 2008 T.T.A.B. LEXIS 619 (T.T.A.B. 2008) [not precedential]; *see also* General Motors Corp. v. Aristide & Co., Antiquaire de Marques, 87 U.S.P.Q.2d 1179 (T.T.A.B. 2008) [precedential] (“[R]esidual goodwill is not sufficient to avoid a finding of abandonment where the goodwill is generated through subsequent sales of a product by distributors or retailers”).

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<sup>6</sup> Del Taco’s Exhibits 5-10, introduced during the cross-examination of Petitioner, are the subject of objections by Petitioner, as briefed fully in Petitioner’s Separate Statement of Objections.

**3. The cessation of Naugles Restaurants was publicly declared, which presumes no intent to resume.**

Even if Del Taco were to claim residual goodwill, a finding of abandonment should not be staved off where the owner unequivocally declared its intention to discontinue use. While not binding on the Trademark Board, the 8th Circuit ruled on an instructive case wherein it held that unequivocal public declaration of intent to discontinue sales was a circumstance from which intent not to resume use could be inferred. Hiland Potato Chip Co. v. Culbro Snack Foods, Inc., 720 F.2d 981, 983 (8<sup>th</sup> Cir. 1983). In this case, Del Taco publicly announced its intent to phase out all Naugles restaurants in 1989. See “Adios to Naugles” newspaper article (Doc. 55); Ziebarth Aff., ¶ 19, Ex. M. An article entitled “Adios to Naugles” was published in the Orange County Register Newspaper on May 17, 1989, which quoted the NAUGLES owner,<sup>7</sup> who stated that the company was phasing the Naugles restaurants out.

The public announcement in 1989 that Naugles restaurants will be phased out and eliminated in favor of Del Taco restaurants is persuasive evidence that there was no intention to resume use of the NAUGLES mark. Del Taco’s concession that the last Naugles restaurant closed in October of 1995 further supports the assertions made in this newspaper article. As such, this public announcement presumes no intent to resume use of the NAUGLES mark and favors the presumption of abandonment.

**4. Del Taco is not permitted to “warehouse” the NAUGLES mark.**

Del Taco is not permitted to “warehouse” the NAUGLES mark. Abandonment cannot be avoided by the intent to retain a mark merely to prevent its use by others, an activity known as “warehousing.” ITC Ltd. v. Punchgini, Inc., 373 F. Supp. 2d 275, 283-84 (S.D.N.Y. 2005),

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<sup>7</sup> At the time of publication of the article “Adios to Naugles,” both the Del Taco and Naugles chains were owned by Anwar Soliman. Ziebarth Cross-Exam Test., p. 108, lines 12-22.

aff'd, 482 F. 3d 135 (2d Cir. 2007). “Use” of a mark means “the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.” 15 U.S.C. § 1127; General Motors Corp. v. Aristide & Co., Antiquaire de Marques, 87 U.S.P.Q.2d 1179 (T.T.A.B. 2008) [precedential], citing Silverman v. CBS, Inc., 9 U.S.P.Q.2d 1778, 1783 (2d Cir. 1989) (“[A] proprietor may not protect a mark if he discontinues using it for more than 20 years and has no plans to use or permit its use in the reasonably foreseeable future. A bare assertion of possible future use is not enough”).

While not binding on the Trademark Board, the ITC Ltd. case is instructive because it concerns a trademark for restaurant services. In ITC Ltd., intent to resume use of the mark BUKHARA for restaurant services was not shown by the appearance of BUKHARA food products at two U.S. trade shows, two shipments of produced in the United States, and an unsubstantiated distribution agreement postdating commencement of instant litigation. ITC Ltd. v. Punchgini, Inc., 373 F. Supp. 2d 275, 283-84 (S.D.N.Y. 2005), aff'd, 482 F. 3d 135 (2d Cir. 2007). The court reasoned,

For the abandonment doctrine to have any teeth at all, however, more is required than simply the owner's inchoate wish to keep the mark for some vague, unspecified future use; this would constitute precisely the impermissible “warehousing” of the mark against which the doctrine guards. On this record, while reasonable people could differ about whether ITC had a purely subjective desire to retain rights to the BUKHARA mark in the United States and an inchoate willingness to consider using it again here if the right opportunity came along, no reasonable fact finder could conclude that ITC had taken any action-or even conceived any concrete plan-evidencing an intent to resume use in the reasonably foreseeable future. The statutory presumption of abandonment accordingly stands un rebutted.

ITC Ltd. at 283; See Empresa Cubana, 213 F.Supp.2d at 270.

Like in ITC Ltd., Del Taco has demonstrated no more than an inchoate wish to keep the NAUGLES mark in case the right opportunity arises. This does not amount to the concrete, commercial use that must be planned for the reasonably foreseeable future in order to rebut the presumption of abandonment. Del Taco has taken no action nor conceived of any concrete plan to use the NAUGLES mark.

Del Taco's claim that it has used the NAUGLES mark through marketing efforts does nothing to disturb the conclusion that the statutory presumption of abandonment stands un rebutted. A single use of the phrase "Viva Naugles" on the "History" webpage of the Del Taco website during a three-year span from February 2003 to October 2006, plus offering for sale a promotional hat and shirt are nothing more than minor activities insufficient to "rekindle the public's identification of the mark with the proprietor" almost two decades after the cessation of restaurant services. See Silverman, 870 F.2d at 48. Del Taco has provided nothing to suggest that the sale of promotional items bearing the NAUGLES mark was somehow intended to herald its return to the restaurant services market. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Therefore, on this record, it is not possible to conclude that Del Taco's "use" of the mark establishes continued goodwill or Del Taco's intent to resume use of the NAUGLES mark for restaurant services.

#### **D. DEL TACO'S SELF-SERVING STATEMENTS DO NOT REBUT THE PRESUMPTION OF ABANDONMENT**

When faced with the presumption of abandonment, the burden then shifts to Registrant to offer more than a conclusory statement that there was no intent to abandon the mark. ShutEmDown Sports, Inc. v. Lacy, 102 U.S.P.Q.2d 1036 (T.T.A.B. 2012) [precedential] (self-serving interrogatory responses as to intent do not rebut presumption of abandonment). While Del Taco alleges in discovery that it has continuously used the NAUGLES mark for advertising its restaurant services, the evidence does not factually support this conclusion. Del Taco has submitted no credible evidence that could convince the Board that, after almost a 20-year hiatus, it has any genuine intent to resume use of the NAUGLES mark for restaurant services. Further, Del Taco's sole witness testified that, if other advertising examples of the so-called "continuous use" existed, he would have produced it. Chillingworth Cross-Exam Test., p. 75, line 12 through p. 76, line 17; p. 77, lines 20-23. The absence of evidence in the record speaks volumes, and Del Taco is left with nothing but self-serving statements, none of which rebut the presumption of abandonment.

##### **1. Del Taco's responses to interrogatories 18 and 24 have no evidentiary support.**

Del Taco's interrogatory responses claim, "[During 1995-2006], the NAUGLES mark was used on signage for restaurants, on point of sale advertising for the restaurants, in marketing for the restaurant on [Del Taco's] website, and in merchandising of NAUGLES goods featuring the mark and iconic NAUGLES brand." Del Taco's Supplemental Responses to Petitioner's Interrogs. Nos. 18 and 24 (Doc. 52). In reality, Del Taco cannot substantiate any portion of this

self-serving statement. Absent any substantiating evidence, the Board can and should see Del Taco's responses for what they are – self-serving and without merit.

**a. No evidence of signage for restaurants**

Del Taco has produced no evidence of signage for restaurants between 1995 to the present.

**b. No credible nor admissible evidence of point of sale advertising for the restaurants**

As an exhibit to Mr. Chillingworth's affidavit, Del Taco produced a one page document, purporting to be a food menu, which contains the phrase "Viva Naugles." Chillingworth Aff., Ex. 11. Mr. Chillingworth's affidavit states that this document "was previously used by Del Taco." Chillingworth Aff., ¶ 3. However, when questioned about this document, Mr. Chillingworth was unable to lay any kind of foundation for the document or speak about it with any personal knowledge.<sup>8</sup>

During Mr. Chillingworth's cross-examination, he admitted that he did not supply this page for his affidavit, he does not know who supplied the page, he does not know whether this document can be found online, and he is not even sure he ever saw this document prior to it being shown to him in connection with his affidavit. Chillingworth Cross-Exam Test., p. 56, line 3 through p. 57, line 15. Mr. Chillingworth could not supply even a rough time frame as to when this document was used, and **even his own counsel objected that questions on this subject called for testimony "outside of his personal knowledge."** Chillingworth Cross-Exam Test., p. 57, lines 19-25. Mr. Chillingworth cannot testify whether this document was used by Del Taco before or after the last Naugles restaurant closed on October 25, 1995. Id. at p. 63, line 21

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<sup>8</sup> Del Taco's Exhibit 11 is the basis of an objection/motion to strike by Petitioner and said objections are fully briefed in Petitioner's Separate Statement of Objections.

through p. 64, line 10; p. 67, lines 2-16. Mr. Chillingworth cannot testify how this document was used by Del Taco (handouts to customers as flyers, digitally distributed, etc.). *Id.* at p. 65, lines 3-10. Mr. Chillingworth has no knowledge of when this document was created. *Id.* at p. 66, lines 2-8. The only thing Mr. Chillingworth was able to testify to with certainty was that Del Taco has not utilized this document since he began working for the company in February 2009. *Id.* at p. 60, lines 11-14. Due to its lack of foundation, this document offers no evidentiary support for Del Taco's argument.

**c. Del Taco's alleged marketing use is not trademark use.**

As discussed in detail above, Del Taco's only evidence offered to supports its alleged marketing use between 1995 and 2006 was on its "History" webpage. Del Taco hangs its case on the fact that the phrase "Viva Naugles" is seen towards the top of this page. Petitioner hereby incorporates his argument contained in Section III.B.2 a., above, to show how Del Taco's alleged marketing use is not trademark use.

**d. Del Taco's claim that it used the NAUGLES mark in merchandising from 1995-2006 is unsupported by any evidence.**

Del Taco's response to interrogatory No. 18 and, by reference No. 24, which states that "[from 1995-2006], the NAUGLES mark was used . . . in merchandising of NAUGLES goods featuring the mark and iconic NAUGLES brand," is unsupported. Del Taco's Response to Interrogs., Nos. 18 and 24 (Doc. 52). First, as outlined in detail above, the only "NAUGLES merchandising" Del Taco alleges did not begin until September of 2011. Doc. 63; T.B.M.P. § 704.04 ("The allegations and statements made . . . in a registration may be used as evidence *against* the . . . registrant, that is, as admissions against interest and the like"). As such, Del

Taco's assertion in its interrogatory responses that it used the NAUGLES mark in merchandising from 1995 through 2006 is completely unsupported and lacks merit.

**2. Del Taco's responses to interrogatories 19 and 25 have no evidentiary support.**

Del Taco's response to Interrogatory No. 19 and, by reference, No. 25, claims that, "[From 2006 to the present], the mark has been used on marketing for the restaurant on Respondent's website, in merchandising of NAUGLES goods featuring the mark and iconic NAUGLES brand, and is part of a planned marketing campaign to be run throughout all Del Taco locations entitled 'Naugles Secret Menu' that is currently postponed in light of this proceeding but has been in planning stages long before this proceeding was filed." Del Taco's Response to Interrogs. Nos. 19 and 25 (Doc. 52). In reality, again, not one of these elements in this statement has been shown to be supported by any credible or actual evidence.

**a. No "usage" on Del Taco's website after October 2006**

Del Taco offered no evidence of usage of the NAUGLES mark on its website after 2006. Ex. 28 (Doc. 77). If it had used the NAUGLES mark on its website after 2006, it would have been easy for Del Taco to produce evidence of such. The lack of evidence speaks volumes.

**b. No "NAUGLES merchandising" until at least 2011**

Again, in direct contradiction to Del Taco's assertion in its discovery responses, Del Taco did not begin selling a promotional hat and a shirt with the word "Naugles" on it until at least 2011, as testified to by its sole witness, Mr. Chillingworth, and as reflected in the first use date shown in Del Taco's clothing registration. Chillingworth Cross-Exam Test., p. 14, line 4 - 24; p. 19, lines 10-21; p 23, line 22 – p. 24, line 2; p. 45, lines 5-6. Doc. 63. As such, Del Taco's interrogatory responses are inaccurate and unsupported by any evidence.

**c. No “Naugles Secret Menu” exists**

Del Taco’s Responses to Interrogatories 19 and 25 claim that the NAUGLES mark is “part of a planned marketing campaign to be run throughout all Del Taco locations entitled ‘Naugles Secret Menu’ that is currently postponed in light of this proceeding but has been in planning stages long before this proceeding was filed.” (Doc. 52). First, as was outlined and established above, there is not, and has never been, a “Naugles Secret Menu.” [REDACTED]

[REDACTED]. Second, the statement that any such campaign has been “postponed in light of this proceeding but has been in planning stages long before this proceeding was filed” is disingenuous, at best. [REDACTED]

[REDACTED]. Given the foregoing, Del Taco’s Responses to Interrogatories 19 and 25 are unsubstantiated, self-serving statements which lack any evidentiary support. As such, Del Taco’s arguments should fail.

**E. DEL TACO CANNOT RELY ON THE STATEMENTS IN ITS REGISTRATION AND SUBSEQUENT RENEWALS TO DEFEAT PETITIONER’S ABANDONMENT CLAIM**

An abandoned mark does not block an application for a federal registration of a mark which is confusingly similar. 15 U.S.C. § 1052(d). Del Taco cannot rely on its federal registration that should have been cancelled or allowed to lapse for abandonment but nonetheless remained in force because the registrant filed affidavits of use. Toro Co. v. GrassMasters, Inc.,

66 U.S.P.Q. 2d 1032 (T.T.A.B. 2003) [precedential] (mark abandoned for over 20 years; holding that “opposer is prohibited from relying on the presumption of validity of its registration . . . and, therefore, we need not consider it as a basis for its claim of likelihood of confusion”). As such, Del Taco’s NAUGLES registration sitting on the USPTO Register is not presumed valid just because it exists.

Further, the use dates contained in Del Taco’s NAUGLES registration file are not “evidence” in and of themselves. Independent evidence is required to prove the truth of the assertions made therein. “The allegation in . . . a registration of a date of use is not evidence on behalf of . . . the registrant; a date of use of a mark must be established by competent evidence. Specimens on the file of . . . a registration are not evidence on behalf of . . . the registrant unless identified and introduced in evidence as exhibits during the period for the taking of testimony.” 37 CFR § 2.122(b)(2); Osage Oil & Transportation, Inc. v. Standard Oil Co., 226 U.S.P.Q. 905, 906 n.4 (T.T.A.B. 1985) (statements and materials in registration file bearing on respondent’s dates of use not evidence on behalf of respondent unless properly introduced).

In sum, based on the record in this proceeding, the presentation of evidence, and case law, it is evident that Del Taco has not offered competent evidence sufficient to support a finding that its NAUGLES registration should not be deemed abandoned and cancelled. Del Taco offered no competent evidence to support a find that the use dates and renewals contained in its NAUGLES registration file are valid. The lack of independent evidence proves that Del Taco’s registration was capable of challenge on the ground of abandonment as early as 1998.

#### **IV. ARUGMENT: PETITIONER HAS STANDING TO SEEK CANCELLATION OF DEL TACO'S NAUGLES REGISTRATION**

Petitioner has standing to seek cancellation. Standing is a threshold issue that must be proved in every inter partes case. See Lipton Industries, Inc. v. Ralston Purina Co., 213 U.S.P.Q. 185, 189 (C.C.P.A. 1982) (“The facts regarding standing . . . must be affirmatively proved”). To establish standing in a cancellation proceeding, petitioner must show facts that establish both “a real interest” in the proceedings as well as a “reasonable” basis for its belief of damage. Ritchie v. Simpson, 50 U.S.P.Q.2d 1023, 1025 (Fed. Cir. 1999).

Through Petitioner’s own affidavit testimony, he introduced evidence of his pending application which has been refused registration based on a likelihood of confusion with the mark in Del Taco’s registration. Ziebarth Aff., ¶ 4, Ex. A-B. As such, Petitioner has a real interest in this proceeding and, therefore, has standing. Lipton, 213 U.S.P.Q. at 189 (“Thus, to have standing in this case, it would be sufficient that [plaintiff] prove that it filed an application and that a rejection was made because of [defendant’s] registration”); Fiat Group Automobiles S.p.A. v. ISM Inc., 94 U.S.P.Q.2d 1111, 1112 (T.T.A.B. 2010); citing Life Zone Inc. v. Middleman Group Inc., 87 U.S.P.Q.2d 1953, 1959 (T.T.A.B. 2008).

Further, because the Board ruled early on in this proceeding that, “[b]ecause petitioner bears the ultimate burden of proof on the standing issue, petitioner may be required to go beyond the mere pendency of his applications and establish his entitlement to file the application upon which his standing claim is based” (Doc. 16, pp. 3-4), Petitioner hereby incorporates by reference all of the facts detailed above in the Recitation of the Facts, Section II.B., to establish that his intent to use was genuine as of the time of his filing. Given the foregoing, Petitioner has

more than adequately proven that he had a genuine intent to use the NAUGLES mark prior to filing his ITU application.

## V. SUMMARY

This is classic case of trademark abandonment by an owner who is fighting for the right to warehouse a mark. In short, Naugles restaurants do not exist anymore and have not for approximately 19 years. Del Taco has not offered concrete evidence that it has any plans to utilize the NAUGLES mark in connection with restaurant services in the reasonably foreseeable future. The record is simply devoid of evidence, and Del Taco cannot credibly rebut the statutory presumption of abandonment.

To quickly recap Del Taco’s “evidence” of use:<sup>9</sup>

October 25, 1995	Del Taco closes last Naugles restaurant
February 2003-October 2006:	Del Taco recites on its “History” webpage that Del Taco and Naugles merged in 1988; the phrase “Viva Naugles” appears on this page
April 2009	   

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<sup>9</sup> Petitioner acknowledges that Del Taco also produced a one page menu (Exhibit 11) containing the phrase “Viva Naugles,” but Del Taco was unable to give any information as to when, how, or by whom this document was used. As such, it has no foundation and it cannot be incorporated into a timeline. Furthermore, Petitioner objects to this document’s use as evidence as fully briefed in Petitioner’s Separate Statement of Objections.

June 2010

[REDACTED]

September 2011

Del Taco alleges it began sales of two promotional NAUGLES items: one shirt and one hat; no evidence of sales is offered.

The record is beyond thin which, in and of itself, speaks volumes about a mark that has supposedly been in continuous use by Del Taco since 1995. If Del Taco truly had been using the NAUGLES mark continuously for restaurant services, the record would be filled with years' worth of evidence over the 19-year span. Based on the reasons presented above, coupled with the lack of evidence provided by Del Taco, Petitioner respectfully requests that the Board grant his petition to cancel Del Taco's NAUGLES registration for restaurant services on the ground of abandonment.

Respectfully submitted,

CHRISTIAN M. ZIEBARTH

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**APPENDIX A**

**PETITIONER'S SEPARATE STATEMENT OF  
OBJECTIONS AND MOTIONS TO STRIKE**

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

In the Matter of Registration No. 1043729  
Date of Registration: July 13, 1976

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CHRISTIAN M. ZIEBARTH  
Petitioner,

Cancellation No.: 92053501

v.

DEL TACO, LLC  
Registrant.

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Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

**PETITIONER'S SEPARATE STATEMENT OF OBJECTIONS AND  
MOTIONS TO STRIKE**

Petitioner herein makes his separate statement of objections to Del Taco's evidence and relevant motions to strike.

**1. MOTION TO STRIKE ALL TESTIMONY OF NOAH CHILLINGWORTH  
REGARDING EVENTS PRIOR TO FEBRUARY OF 2009.**

Petitioner objects to the testimony of Noah Chillingworth, Del Taco's Vice President of Marketing, regarding all events and actions taken by Del Taco prior to February of 2009, the time at which Mr. Chillingworth began work for Del Taco, because Mr. Chillingworth has no personal knowledge of Del Taco's business prior to that time. Petitioner moves to strike paragraphs 2-6 from Mr. Chillingworth's affidavit, and all related exhibits thereto.

“A witness may testify to a matter only if evidence is introduced sufficient to support a finding that the witness has personal knowledge of the matter.” F.R.E. 602. Thus, the testimony of any witness, other than an expert witness, must be based upon what the witness saw and heard or otherwise experienced through his or her own senses. See F.R.E. 602, Adv. Comm. Notes (1972). Under Federal Rule of Evidence 701(a), lay witnesses may give opinion testimony only if it is “rationally based on the witness's perception.” The testimony of a lay witness must be based on what he or she *actually observed or perceived* through his or her own senses. The witness must have *first-hand* knowledge acquired by *directly perceiving* the event that is the subject of his or her testimony. See F.R.E. 602, Adv. Comm. Notes (1972).

In City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc., 106 U.S.P.Q.2d 1668, 1674-75 (T.T.A.B. 2013) [precedential], the Board sustained an objection to testimony offered by a witness on matters that took place prior to the witness’ employment with respondent. In the instant case, we have the same situation. Mr. Chillingworth testified that he has only been working for Del Taco since February of 2009. Chillingworth Cross-Exam Test., p. 8, line 24 through p. 11, line 5. Mr. Chillingworth testified that, prior to working for Del Taco, he worked for Taco Bell from 2004-2009. Chillingworth Cross-Exam Test., p. 10, line 24 – p. 11, line 5.

Mr. Chillingworth’s affidavit states, “[T]he NAUGLES brand has been owned and used by Del Taco and its predecessors since 1988 in connection with Del Taco’s restaurant services.” Chillingworth Aff., ¶ 2. However, when questioned at length on who informed him of this information and why he believes it, Mr. Chillingworth was unable to name even one person who informed him of this information, outside of his own legal counsel in this proceeding. Chillingworth Cross- Exam Test., p. 40, line 7 through p.43, line 22.

To establish a proper foundation, the source of the witness' personal knowledge must be disclosed (e.g., personal observation, a written directive, direct conversation, etc.). Although Mr. Chillingworth was questioned at length, he could not give a single name of someone who told him the information contained in his affidavit. As such, Mr. Chillingworth has no personal knowledge of Del Taco's actions and business decisions prior to February of 2009. Mr. Chillingworth cannot speak with personal knowledge as to whether Del Taco did or did not utilize the NAUGLES mark prior to February of 2009. As such, Petitioner moves to strike Mr. Chillingworth's testimony and all related exhibits on all matters prior to February of 2009 because it is not based upon the witness' personal knowledge.

## **2. MOTION TO STRIKE DEL TACO'S EXHIBIT 11**

Petitioner seeks to strike Del Taco's Exhibit 11 from the record because 1) Mr. Chillingworth lacks personal knowledge of the exhibit, and 2) because he cannot authenticate the exhibit, and therefore is unable to lay the foundation for it. Mr. Chillingworth's affidavit incorporates Exhibit 11 and he describes it as "an example of advertising previously used by Del Taco in connection with its restaurant services prominently featuring the NAUGLES mark." Chillingworth Aff., ¶ 3. However, when questioned about this document, Mr. Chillingworth was unable to lay any kind of foundation for the document or speak about it with any personal knowledge.

Evidence has no probative value if it is not what the proponent claims it to be. Ricketts v. City of Hartford, 74 F.3d 1397, 1409–1410 (2nd Cir. 1996). "Authentication" means the introduction of evidence sufficient to sustain a finding that the item is what the proponent claims

it is. F.R.E. 901. The party offering the evidence has the burden of presenting sufficient evidence of authenticity to sustain a finding that the evidence is what it is purported to be. Id.

During Mr. Chillingworth's cross-examination, he admitted that he did not supply this page for his affidavit, he does not know who supplied the page, he does not know whether this document can be found online, and that he is not even sure he ever saw this document prior to it being shown to him in connection with his affidavit. Chillingworth Cross-Exam Test., p. 56, line 3 through p. 57, line 15. Mr. Chillingworth could not supply even a rough time frame as to when this document was used, and **even his own counsel objected that questions on this subject called for testimony "outside of his personal knowledge."** Chillingworth Cross-Exam Test., p. 57, lines 19-25. Mr. Chillingworth cannot testify whether this document was used by Del Taco before or after the last Naugles restaurant closed on October 25, 1995. Id. at p. 63, line 21 through p. 64, line 10; p. 67, lines 2-16. Mr. Chillingworth cannot testify how this document was used by Del Taco (handouts to customers as flyers, digitally distributed, etc.). Id. at p. 65, lines 3-10. Mr. Chillingworth has no knowledge of when this document was created. Id. at p. 66, lines 2-8. The only thing Mr. Chillingworth was able to testify to with certainty was that Del Taco has not utilized Exhibit 11 since he began working for the company in February of 2009. Id. at p. 60, lines 11-14.

The Exhibit, itself, states at the bottom of the page that these menu "items are available in Naugles restaurants," and Del Taco freely admits that no Naugles restaurants have existed since October 25, 1995. This statement on the face of the document strongly indicates that it was created and used prior to October 25, 1995. Petitioner asserts that Mr. Chillingworth cannot

testify with any personal knowledge about Del Taco's action prior to February of 2009, and therefore his testimony on these matters should not be permitted.<sup>1</sup>

Given the foregoing, Petitioner moves to strike Del Taco's Exhibit 11 from the record because Mr. Chillingworth has no personal knowledge of the document, he cannot authenticate it, and therefore he cannot lay any foundation for it.

### **3. MOTION TO STRIKE EXHIBIT 29 FROM NOAH CHILLINGWORTH'S AFFIDAVIT.**

Petitioner hereby moves to strike Exhibit 29 from the affidavit of Noah Chillingworth because 1) Mr. Chillingworth lacks personal knowledge of the exhibit, and 2) because he cannot authenticate the exhibit, and therefore is unable to lay the foundation for it.

Mr. Chillingworth's affidavit incorporates Exhibit 29, which he contends are pictures of articles of clothing sold by Del Taco. Chillingworth Aff., ¶ 5, Ex. 29. During Mr. Chillingworth's live cross-examination testimony, he bluntly admitted that he did not take either of the two pictures seen in Exhibit 29, he does not know who took the pictures, when they were taken, and that, prior to executing his affidavit, he had never seen the pictures before. Mr. Chillingworth does not even know who gave him the pictures in the first place. Chillingworth Cross-Exam Test., p. 15, line 15 through p. 16, line 18.

Evidence has no probative value if it is not what the proponent claims it to be. Ricketts v. City of Hartford, 74 F.3d 1397, 1409–1410 (2nd Cir. 1996). “Authentication” means the introduction of evidence sufficient to sustain a finding that the item is what the proponent claims

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<sup>1</sup> See Motion to Strike No. 1, above.

it is. F.R.E. 901. The party offering the evidence has the burden of presenting sufficient evidence of authenticity to sustain a finding that the evidence is what it is purported to be. Id.

Mr. Chillingworth has no personal knowledge of these pictures and cannot authenticate them under Federal Rule of Evidence 901. He is unable to properly lay a foundation for them. As such, they should not be allowed to be introduced as evidence for Del Taco. Petitioner hereby moves to strike Exhibit 29 from the record.

**4. OBJECTION TO TESTIMONY ELICITED DURING PETITIONER’S CROSS-EXAMINATION REGARDING DEL TACO’S CLOTHING REGISTRATION AND DEL TACO’S OFFER FOR SALE OF NAUGLES CLOTHING**

Petitioner objects to all testimony elicited during his cross-examination on the subject of Del Taco’s clothing registration and Del Taco’s contention that it is offering for sale NAUGLES clothing on the ground that this subject matter was not included in Petitioner’s direct testimony affidavit (Doc. 57) and, therefore is outside the scope of direct examination. This objection was initially raised initially during Petitioner’s live cross-examination and is hereby renewed.

Ziebarth Cross-Exam Test., p. 112, lines 7-12, lines 22-23; p. 113, line 25 through p. 114, line 1; p. 114, lines 17-18; p. 115, lines 11-12 and 19-20.

Federal Rule of Evidence 611(b) states, “Cross-examination should not go beyond the subject matter of the direct examination. . . .” Via stipulation by the parties, direct testimony was allowed to be introduced by affidavit. Doc. 56. Petitioner did not testify in his affidavit about Del Taco offering clothing for sale and made no mention of Del Taco’s contention that it was offering clothing for sale; Petitioner never raised the issue or fact at all. Doc. 57.

Petitioner’s affidavit also makes no mention of the fact that Del Taco owns a NAUGLES

registration for clothing. As such, counsel's questions to him on these issues are improper subject matter for cross-examination because they are outside the scope of his direct testimony. Petitioner moves to strike p. 112, line 7 through p. 116, line 5 from his cross-examination testimony on these grounds.

**5. OBJECTION TO ALL TESTIMONY ELICITED DURING PETITIONER'S CROSS-EXAMINATION CONCERNING THE CONTENT OF TWITTER POSTS MADE AFTER PETITIONER FILED HIS ITU APPLICATION**

Petitioner objects to the relevancy of all testimony elicited from Petitioner during his live cross-examination on the subject of posts made to Petitioner's "Señor Naugles" twitter account after Petitioner filed his ITU application. Petitioner's counsel initially raised this objection during cross-examination and hereby renews the objection. Ziebarth Cross-Exam Test., p. 92, line 21 through p. 93, line 4; p. 94, line 15 through p. 95, line 21; p. 100, line 25 through p. 101, line 5; p. 104, lines 9-12.

Federal Rule of Evidence 401 states, "Evidence is relevant if (a) it has any tendency to make a fact more or less probable than it would be without the evidence; and (b) *the fact is of consequence in determining the action*" (emphasis added). The only issue pleaded in this case is abandonment. The only subject matter relevant to petitioner is his standing and his entitlement to file his ITU application. His actions on his Twitter account that counsel questioned him about took place in 2013, well after the May 10, 2010 filing date of Petitioner's ITU application. As such, said Twitter posts have no bearing on whether Petitioner had standing to file his ITU application prior to May 10, 2010.

The prejudicial effect of this testimony and exhibits to Petitioner far outweighs any probative value this testimony and exhibits could possibly offer. By allowing this testimony to be introduced, Del Taco will essentially be given permission to raise arguments about Petitioner's use of the NAUGLES mark **three years** after he filed his ITU application, a subject matter that is entirely irrelevant to the issues in this proceeding. Any negative arguments against Petitioner's actions or character could be prejudicial to Petitioner.

Given the foregoing, Petitioner moves to strike as irrelevant the following testimony from his cross-examination on the ground that it is irrelevant: Ziebarth Cross-Exam Test., p. 88, line 23 through p. 96, line 8, p. 100, line 10 through p. 106, line 6, and strike exhibits 5-10.

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I certify that a copy of the foregoing **PETITIONER'S TRIAL BRIEF IN SUPPORT OF PETITION FOR CANCELLATION WITH APPENDIX A: PETITIONER'S SEPARATE STATEMENT OF OBJECTIONS AND MOTIONS TO STRIKE** was served upon April L. Besl, DINSMORE & SHOHL, LLP, attorney of record for the Registrant in this action by depositing one copy thereof in the United States mail, first-class postage prepaid on August 28, 2014 and addressed as follows:

April L. Besl, Esq.  
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