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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Cleveland State University

v.

CampusEAI Consortium

Cancellation No. 92053509

Jude A. Fry and Colleen F. Goss of Fay Sharpe LLP for Cleveland State University.

Michael C. DeJohn for CampusEAI Consortium.

Before Lykos, Adlin and Hightower, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

CampusEAI Consortium (“respondent”) owns a Supplemental Register registration for the mark UNIVERSITY OF CLEVELAND, in standard characters and with UNIVERSITY disclaimed, for “educational services, namely, providing seminars, workshops, classes, and lecture in the fields of postsecondary and higher education in the field of information technology” in International Class 41 (the

“Registration”).¹ In its second amended petition to cancel the Registration, Cleveland State University (“petitioner”) alleges prior use and registration of: (1) the mark CLEVELAND STATE UNIVERSITY, in standard characters, with STATE UNIVERSITY disclaimed and a claim of acquired distinctiveness as to the entire mark under Section 2(f); and (2) the mark shown below



also with STATE UNIVERSITY disclaimed, and a claim of acquired distinctiveness as to CLEVELAND STATE UNIVERSITY 1964. Both marks are registered for “... educational services, namely, providing courses at the undergraduate and graduate university level and distributing course material therewith ...”² As grounds for

¹ Supplemental Register Registration No. 3735435, issued January 5, 2010 from an application filed October 16, 2008 and amended to allege first use dates of September 20, 2005.

² Registration Nos. 3671697, issued August 25, 2009 from an application filed June 18, 2008, and 3694718, issued October 13, 2009 from an application filed June 19, 2008, respectively. The identification of services for both registrations, in its entirety, is: “lending libraries; publication of books; publication of electronic books and journals on-line; educational services, namely, providing courses at the undergraduate and graduate university level and distributing course material therewith; extension, continuing and community educational services, namely, conducting classes, public lectures, workshops, seminars, conferences and exhibitions in the fields of engineering, law, business, arts and humanities, natural and physical sciences, architecture, journalism, education, international and public affairs, public health, social work, behavioral sciences, and mathematics and distributing course material therewith; educational research; entertainment services, namely, arranging and conducting athletic events and tournaments, exhibitions, conferences, live performances and festivals.”

cancellation, petitioner alleges that use of respondent's mark in connection with respondent's services would be likely to cause confusion with, and dilute, petitioner's marks, and that respondent has abandoned the mark in its Registration. In its answer, respondent denies the salient allegations in the second amended petition for cancellation, and asserts several affirmative defenses which it failed to pursue or prove and which are therefore waived and will be given no further consideration. *Miller v. Miller*, 105 USPQ2d 1615, 1616 n.3 (TTAB 2013); *Baroness Small Estates Inc. v. American Wine Trade Inc.*, 104 USPQ2d 1224, 1225 n.2 (TTAB 2012).

The Record

The record consists of the pleadings; the file of the involved Registration; petitioner's notice of reliance ("NOR") (TTABVue Dkt. # 18) on Internet printouts and respondent's responses to petitioner's interrogatories, document requests and requests for admission; and the testimonial deposition of Robert Spademan (TTABVue Dkt. #'s 19-21), petitioner's Assistant Vice-President-Marketing ("Spademan Tr.") and the exhibits thereto.

Respondent took no testimony and submitted no evidence.³ Both parties filed trial briefs but respondent's was 35 days late and in its order of February 13, 2014

³ In its December 20, 2012 order, the Board sanctioned respondent for violating a prior order relating to discovery. Pursuant to the sanctions order, petitioner was permitted to introduce by notice of reliance alone documents produced by respondent during discovery. In addition, respondent was required to "advise petitioner in writing" in the event it had no documents responsive to petitioner's document requests and respondent was precluded from introducing or relying on information or documents requested in discovery but not produced as required by the sanctions order. Petitioner does not rely on any documents which respondent produced during discovery, but we will consider responses

the Board denied respondent's motion to reopen its time to file its brief. We have therefore not considered respondent's trial brief, but point out that even if we had, the brief would not have changed the outcome because respondent introduced no evidence and its brief is therefore necessarily comprised of mere argument.

Standing

Petitioner made its pleaded registrations of record by attaching to its second amended petition for cancellation printouts obtained from the Office's TARR database showing the registrations' current status and title. Trademark Rule 2.122(d)(1). The registrations establish petitioner's standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

Abandonment

The Trademark Act provides for the cancellation of a registration if the registered mark has been abandoned. *See* Section 14 of the Trademark Act, 15 U.S.C. §1064. Under Section 45 of the Act, 15 U.S.C. §1127, a mark is considered abandoned when "its use has been discontinued with intent not to resume such use," and "[n]onuse for 3 consecutive years shall be prima facie evidence of abandonment." That is, "[i]f plaintiff can show three consecutive years of nonuse, it has established a *prima facie* showing of abandonment, creating a rebuttable presumption that the registrant has abandoned the mark without intent to resume use." *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1042 (TTAB 2012). Furthermore, "[u]se' of a mark means the bona fide use of such mark made in the

to petitioner's document requests which indicate that respondent does not have any documents responsive to particular requests.

ordinary course of trade, and not merely to reserve a right in a mark.” 15 U.S.C. §1127.

Because registrations are presumed valid under the law, a party seeking to cancel a registration on the ground of abandonment bears the burden of proof to establish its case by a preponderance of the evidence. *See On-Line Careline, Inc. v. America Online, Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000); and *Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989). If petitioner makes a *prima facie* case of abandonment, the burden of production, i.e., of going forward, then shifts to the respondent to rebut the *prima facie* showing with evidence. *Id.* “The burden of persuasion remains with the plaintiff to prove abandonment by a preponderance of the evidence.” *ShutEmDown Sports*, 102 USPQ2d at 1042.

Here, petitioner’s abandonment claim is based on respondent’s responses to petitioner’s written discovery requests, stating that respondent has no:

- documents related to the use of its involved mark in association with its services;
- documents bearing its mark which relate to its services and which are viewed by customers or prospective customers;
- documents related to the marketing, advertising, offer of sale, use and/or promotion of services offered under its mark;
- advertisements, promotional materials, packaging, labeling or other materials or documents related to its involved mark;

- invoices for sales of services sold under its involved mark;
- documents that report on, describe, refer to, and/or relate to respondent's use of its involved mark;
- documents it will rely upon to establish use of its mark in the United States;
- documents showing respondent's annual advertising, marketing, and promotional expenses for services related to its involved mark;
- contracts, agreements, licenses or consents related to its involved mark, or documents related thereto;
- documents concerning quality control exercised by respondent over the use of its involved mark by third parties;
- documents identifying providers of services on respondent's behalf under the involved mark;
- documents identifying recipients of services by or on behalf of respondent under its involved mark; or
- documents which refer to or reflect any research, trademark maintenance program, advertising campaign, Internet strategy, and/or marketing program for respondent's services bearing respondent's mark.

In addition, respondent's total revenues for services offered under its involved mark are "0," and those services have only been offered in India. Petitioner's NOR Ex. A (Responses to Interrogatory Nos. 11 and 13) and B (Responses to Document Request Nos. 2, 3, 5, 8, 12, 13, 16, 20, 22, 23, 29, 30 and 34).

This evidence establishes a *prima facie* case of abandonment. Indeed, respondent filed the involved application on October 16, 2008, which is over five years ago, and respondent effectively concedes that it has no documents since that

date (and at trial introduced no documents at all) related to its use or marketing of its mark, offers for sale under its mark or materials bearing the mark which were viewed by customers or potential customers. Respondent also concedes that it has no documents identifying providers or recipients of services offered under the involved mark. It has no invoices, which is consistent with it having no revenue for services offered under the involved mark. Respondent indicates that its services have only been offered in India, which, standing alone, effectively means that respondent has not offered its services in the United States. These facts establish that for at least the past three years, respondent has not used its mark for the identified services.

Indeed, this case is in many ways similar to *ShutEmDown Sports*. There, the respondent owned a registration for 113 items of clothing, 109 of which it admitted to never offering under the mark. With respect to the remaining four items of clothing which respondent claimed to offer (in contrast to respondent in this case, which has not introduced any evidence of use whatsoever), respondent claimed to have spent “\$200+” annually on promotion, and to have annual sales of “\$100.” However, “respondent kept no documents” relating to his alleged operating expenses and had no documents relating to his sales, and respondent “does not have a bank account; has no tax returns; did not keep copies of sales receipts, invoices and/or bills of service for goods using the mark for the last three years; has no sales documents used in selling or distributing goods; has no copies of any advertisements or promotional materials or other media advertising.” *ShutEmDown Sports*, 102

USPQ2d at 1041. As a result, despite respondent's claim to have sold four items identified in his registration, the Board found that petitioner had established a *prima facie* case of abandonment.

As there, we find here that petitioner has established a *prima facie* case of abandonment. *Id.* at 1043. In short, respondent's lack of any revenue, of even a claim to having used its mark in the United States and of any documents or testimony relating to use or promotion of the involved mark establish that the mark has not been used for at least three years. And we find that respondent, who like the respondent in *ShutEmDown Sports* introduced no testimony or other evidence, has not rebutted petitioner's *prima facie* case. In fact, as in *ShutEmDown Sports*, respondent in this case "did not provide a shred of evidence to corroborate his alleged use of the mark in commerce." *Id.* And as in *ShutEmDown Sports*, respondent's "uncorroborated interrogatory responses that he used the mark," albeit in this case only in India, "are insufficient to rebut the presumption of abandonment resulting from the lack of any advertising, sales, or customers" *Id.*

In the December 20, 2012 order which denied petitioner's motion for summary judgment on its abandonment claim, we noted that *petitioner* introduced two documents which respondent produced during discovery, "each of which consists of a Memorandum of Understanding between a college located in India and Campus EAI, the exclusive vendor of respondent, for the provision of information technology training on different short term courses and information technology related programs to be delivered by the faculty appointed by respondent." December 20,

2012 order at 8. We found on summary judgment that the documents “appear to demonstrate use of respondent’s mark in commerce, i.e., the provision of educational services between a U.S. entity and a foreign country by way of an exclusive vendor, and inasmuch as these documents conflict with respondent’s other discovery responses evidencing apparent non-use of respondent’s mark,” there was a genuine dispute of material fact sufficient to deny summary judgment. *Id.* at 8-9.

These two documents do not rebut petitioner’s *prima facie* case, for two reasons. First, it is settled that evidence submitted in connection with a motion for summary judgment is of record only for consideration of that motion, and to be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1465 n.2 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911, 913 n.4 (TTAB (1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712, 716 n.2 (TTAB 1981). Here, the documents were not introduced into evidence during the trial, are not of record and may not be considered.⁴ Second, the standards applicable to motions for summary judgment are quite different from the standards applicable to evaluating evidence properly introduced at trial. On summary judgment, “[i]ssues of fact are not to be tried ... rather, all that is to be determined is whether issues of fact exist which should be tried.” *Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251, 1254 (TTAB

⁴ Petitioner did not have the opportunity to cross-examine any witnesses about the documents at the summary judgment stage. *American Meat Institute*, 211 USPQ at 716 n.2.

1995). Moreover, “all doubts as to whether or not particular factual issues are genuinely in dispute must be resolved against the moving party and, similarly, all inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the nonmoving party.” *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994). At trial, we must evaluate the evidence differently. In fact, even if respondent had introduced the documents at trial, which it did not, there is no testimony or other evidence establishing the nature, scope or location of any use of the involved mark, much less any evidence establishing whether or when respondent itself or any party acting on respondent’s behalf used the involved mark for the services identified in the Registration. While the documents themselves were found sufficient to defeat petitioner’s motion for summary judgment, without any accompanying explanatory evidence they would not be sufficient, even if of record, to overcome petitioner’s *prima facie* case. It is one thing to establish the existence of a genuine dispute of material fact sufficient to deny summary judgment, and quite another to rebut a *prima facie* case of abandonment at trial. Rebutting a *prima facie* case of abandonment at trial is simply impossible without any evidence of record, as in this case.

Conclusion

Petitioner has established a *prima facie* case of abandonment by establishing that respondent has not used the involved mark for at least three years. Having failed to take any testimony or to submit any other evidence, respondent is unable to rebut petitioner’s *prima facie* case.

Cancellation No. 92053509

Decision: The petition to cancel is granted on the ground of abandonment.

Registration No. 3735435 will be cancelled in due course.⁵

⁵ Having granted the petition to cancel, there is no need to consider petitioner's claims of priority and likelihood of confusion or dilution.