

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: August 26, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

—
Capital City, LLC

v.

Select Brands LLC

—
Cancellation No. 92054587
against Registration No. 2247855

—
Asia Johnson for Capital City, LLC.

Julianne M. Hartzell of Marshall, Gerstein & Borun LLP for Select Brands LLC.

—
Before Quinn, Wellington and Shaw,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Capital City, LLC (hereinafter “petitioner”) filed a petition to cancel the registration of Select Brands LLC (hereinafter “respondent”) for the mark **MUMBO** in typed character format for “barbeque sauce” in International Class 36.¹ As ground for cancellation, petitioner asserts that “the term mumbo has been and continues to be a generic term for a well-known and widely available condiment, not a proprie-

¹ Registration No. 2247855 issued on May 25, 1999 and has been renewed.

tary barbeque sauce.”² In particular, petitioner alleges that “mumbo” is a term that “has been used throughout the Washington, D.C. metropolitan area since at least as early as the 1960’s and such use continues today by local area Washingtonians.” With regard to its standing, petitioner asserts that it is “a new business entity engaged in the sale and promotion of a condiment, well-known and widely available in the Washington, DC area for decades” and that respondent has sent letters to petitioner “demanding [petitioner’s] business to cease and desist its sale and promotion of mumbo sauce.”

With its complaint, petitioner attached several exhibits containing materials it alleges are evidence of generic usage of the term “mumbo.” However, except for certain types of copies of pleaded registrations, exhibits attached to pleadings are not considered of record and may not be relied upon by parties on final decision unless otherwise properly introduced during trial. Trademark Rule 2.122(d); see also TBMP § 317 (3d ed. rev.2 2013) (Exhibits to Pleadings).

Respondent, in its answer to the amended pleading, denied the salient allegations in the complaint.

The parties have filed trial briefs.

Evidentiary Submissions

During its initial trial period, petitioner filed the following:

² Petitioner also alleged a ground for cancellation asserting that respondent “has abandoned its mark by failing to police its use.” However, petitioner did not pursue this allegation at trial and acknowledged in its trial brief that the “Issue Presented” in this proceeding is “[w]hether the Board should cancel [the registration] on the grounds that word is generic.” Brief at (unnumbered) p. 6. Accordingly, any possible abandonment ground based on an alleged failure to police the use of the mark is considered to have been waived and has been given no further consideration.

- 1st Notice of Reliance on printouts from various third-party websites with a stated relevance of showing “generic use of the term mumbo”;
- 2nd Notice of Reliance on respondent’s responses to petitioner’s Interrogatory Nos. 8 and 9, with copies of correspondence involving respondent’s requests for third parties to cease and desist from using the term “mumbo” or the phrase “mumbo sauce” and replies thereto;
- 3rd Notice of Reliance on copies of correspondence labeled “confidential” between respondent’s counsel and third parties involving use of the term “mumbo”;³
- 7th Notice of Reliance⁴ on copies of printouts from various websites: The Social Skinny, Social Media in Business, Twitter, Facebook, Wikipedia, Yelp, GreaterGreaterWashington, Washington City Paper, Georgetown University and U.S. Census Bureau. The subject matter of the materials involves demographic information, statistics involving the general use of the websites, etc.; the notice of reliance does not contain a statement regarding the relevance or reasons for reliance upon these materials.

Respondent filed the following during its trial period:

- Testimonial deposition of Ms. Allison Collins, respondent’s manager and owner, with attached exhibits;
- 1st Notice of Reliance on printouts from various dictionaries with the stated relevance of showing an absence of a defined meaning for the term “mumbo” as a generic reference to a type of sauce;
- 2nd Notice of Reliance on petitioner’s responses to Admission Requests Nos. 2, 9, and 11-4; and
- 3rd Notice of Reliance on excerpts taken from the Rule 30(b)(6) deposition of petitioner (Ms. Arsha Jones testifying on behalf of petitioner).

³ The documents were filed without a notice of reliance cover page. However, respondent acknowledges in its trial brief that these are “portions of [respondent’s] document production.”

⁴ Petitioner filed a “Seventh” notice of reliance without any intervening notices of reliance filed since the “Third” notice of reliance. In its motion to strike (filed December 28, 2012), respondent noted that it had not received any notices of reliance numbered “4, 5, or 6” filed by petitioner. In its response to the motion to strike, petitioner acknowledged that no such notices of reliance numbered “4, 5, or 6” were filed.

In its rebuttal period, petitioner filed nine additional notices of reliance, namely, Notices of Reliance 8-16, on the following:

- Copies of printouts from third-party restaurant websites and a travel guide with the stated relevance of showing “generic use of the term MUMBO since 2007” (Notice of Reliance 8);
- Copies of excerpts from books and magazines with the stated relevance of showing “generic use of the term MUMBO within the last 23 years” (Notice of Reliance 9);
- Printouts from the internet websites Wikipedia and Urban Dictionary, as well as copies of pages from a book titled “Hip Hoptionary,” with the stated relevance of showing “generic use of the term MUMBO in a dictionary” (Notice of Reliance 10);
- Printouts from third-party websites, including Twitter, Washington Post, Facebook, food-related websites, etc., with stated relevance of showing “a relevant generic use of the term MUMBO...[or] in 2007 or earlier...[or] in the Washington, DC area [or] in the last 23 years” (Notices of Reliance 11-15); and
- Petitioner’s responses to respondent’s Admission Requests Nos. 1-27 (Notice of Reliance 16).

Respondent’s Motions to Strike Petitioner’s Submissions

Respondent has filed two motions to strike the materials submitted by petitioner during trial. The Board, in two separate orders, informed the parties that determination of the motions would be deferred until final hearing. We now address these motions.

Motion to Strike Materials Submitted with Petitioner’s Notices of Reliance Nos. 1 and 7

On December 28, 2012, two weeks after petitioner filed its last notice of reliance in its initial trial period, respondent moved to strike the documents submitted via petitioner’s Notices of Reliance Nos. 1 and 7. As to Notice of Reliance No. 1, respondent argues the documents submitted therewith were “responsive to [respondent’s] discovery requests but were not produced” and thus petitioner should not be

allowed to introduce these documents at trial. With respect to the materials submitted with petitioner's Notice of Reliance No. 7, respondent asserts that petitioner failed "to indicate the relevance of any of the documents," citing to Trademark Rule 2.122(e).

Petitioner filed its opposition to this motion, arguing that any objection by respondent to the introduction of documents on the basis that they were not previously produced in response to discovery requests is unavailing. Specifically, petitioner notes that it raised several objections to respondent's discovery requests and respondent did not move to compel such materials. As to the respondent's objection based on petitioner's failure to state the relevance of the documents with petitioner's Notice of Reliance No. 7, petitioner asserts that "[t]he titles of the articles themselves make clear the relevance of the information in those articles to the issues presented here." Petitioner, however, does not articulate the relevance of the documents in its opposition to the motion.

As a sanction for improper discovery practice, a party that responds to a request for discovery by indicating that it does not have the documents or information, or merely fails to provide the discovery sought, may be barred by its own action from later introducing the information or documents sought as part of its evidence on the case. See TBMP § 527.01 (Estoppel Sanction); see also, TBMP § 411 (Remedy for Failure to Provide Disclosures or Discovery). However, several key procedural facts in this proceeding show that such sanctions are not warranted. In particular, we note that petitioner did raise various objections to respondent's aforementioned dis-

covery requests or it did not respond at all. Respondent, faced with these objections, did not move to compel any of the information or documents requested nor did respondent move to compel initial or pretrial disclosures. *Linville v. Rivard*, 41 USPQ2d 1731, 1733 (TTAB 1996) (no estoppel; party should have filed motion to compel where objections that discovery requests are, for example, ambiguous or burdensome, or are otherwise not of a nature which would lead propounding party to believe that the requested information does not exist), *aff'd*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); see also, *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994). Lastly, many of the documents introduced under Notice of Reliance No. 1 are not of the type whereby we can conclude they were solely within the possession of petitioner prior to trial; rather, many of the documents appear to be publicly available on the internet and were acquired by petitioner in anticipation of trial. See *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1071-72 (TTAB 2011). Under these circumstances, we do not find sanctions are warranted.

Accordingly, respondent's motion to strike petitioner's Notice of Reliance No. 1 is denied.

With regard to petitioner's Notice of Reliance No. 7, Trademark Rule 2.122(e) provides that a notice of reliance "shall ... indicate generally the relevance of the material being offered." (Emphasis added). There is no dispute that petitioner did not indicate in the notice of reliance what it believed is the relevance of the submitted materials or how it intends to rely on these materials. Petitioner had the oppor-

tunity to correct this procedural error when it responded to the motion to strike but it chose not to. Instead, petitioner argued that “the titles of the articles themselves make clear the relevance of the information in those articles to the issues presented here.” Such a response is ill-advised because it contravenes the purpose of the rule requiring advance notice to the party and, in this case, we disagree with petitioner’s characterization of the materials’ relevance based on the titles of the articles. It is not obvious to the Board how the subject matter of these materials have a bearing in this matter and, to wit, petitioner does not reference any of these materials in its trial brief.

Accordingly, respondent’s motion to strike petitioner’s Notice of Reliance No. 7 is granted.⁵

Motion to Strike Materials Submitted with Petitioner’s Notices of Reliance Nos. 8-16

On May 24, 2013, respondent filed a motion to strike all of the notices of reliance filed by petitioner during its rebuttal trial period, namely, petitioner’s Notices of Reliance Nos. 8-16. Respondent argues that these submissions constitute improper rebuttal evidence because they are “merely cumulative intended to support petitioner’s case-in-chief.” Motion at p. 2. In addition, and specifically with respect to respondent’s own responses to discovery submitted under Notice of Reliance No. 16, respondent argues this is improper because petitioner does not explain how or why these discovery responses should be considered.

⁵ We hasten to add that even if we were to consider these materials this would not alter the outcome of this proceeding.

Petitioner did not file a response to respondent's motion or otherwise address the objections in its trial brief.

The plaintiff's rebuttal testimony period is intended solely for the introduction of evidence or testimony that denies, explains, or discredits evidence adduced by the defendant. It is improper for a plaintiff to introduce, for the first time during its rebuttal testimony period, evidence that relates to facts that might appropriately have been introduced during the party's case-in-chief. See *Carefirst of Maryland Inc. v. FirstHealth of the Carolina Inc.*, 77 USPQ2d 1492, 1498 (TTAB 2005); and *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712, 719 (TTAB 1981) (“[i]t is the general rule that a party plaintiff may in his case on rebuttal introduce facts and witnesses appropriate to deny, explain, or otherwise discredit the facts and witnesses adduced by the opponent, but not any facts or witnesses which might appropriately have been introduced during its case-in-chief to sustain its pleading” and thus “a plaintiff may not utilize its rebuttal period to prove its case-in-chief or to shore up its principal case in light of a defendant's evidence”). See also, *General Electric Company v. Graham Magnetics Incorporated*, 197 U.S.P.Q. 690, 692 n.5 (TTAB 1977); and *Western Leather Goods Co. v. Blue Bell, Inc.*, 178 USPQ 382 (TTAB 1973).

Here, we find the materials submitted by petitioner under its Notices of Reliance Nos. 8-15 constitute improper rebuttal testimony. Petitioner has not explained how these materials are anything more than just a continuation of its case-in-chief

or that they somehow discredit the evidence and testimony submitted by respondent.

In addition, petitioner's responses to respondent's admission requests, submitted under Notice of Reliance No. 16, were not properly introduced into evidence because petitioner has failed to show how such responses "should in fairness be considered so as to make not misleading what was offered" by respondent, as required by Trademark Rule 2.120(j)(5).

Accordingly, respondent's motion to strike petitioner's Notices of Reliance Nos. 8-16 is granted and the materials submitted therewith are given no further consideration.

The Record

By operation of the rules, the record includes the pleadings and the file of the subject registration.

In addition, based on the aforementioned evidentiary submissions and disposition of respondent's evidentiary objections, the record also includes petitioner's Notices of Reliance Nos. 1-3, the testimony of Ms. Collins with exhibits, and respondent's Notices of Reliance Nos. 1-3.

Standing

The record establishes that petitioner is a manufacturer of sauces and has used the term "mumbo sauce" to describe a type of sauce. Respondent acknowledges that petitioner has "adopted" use of the term "mumbo" in connection with its own product. Brief, p. 9. Respondent further acknowledges that it sent a cease and desist

letter to petitioner requesting that petitioner “cease infringing use of the mark.” These facts demonstrate that petitioner is not a “mere intermeddler” and that it has standing to petition to cancel respondent’s mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *see also Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Genericness

Section 14 of the Trademark Act provides:

A petition to cancel a registration of a mark... may... be filed...

(3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered. ... If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used. 15 U.S.C. § 1064(3).

A mark is a generic name if it refers to the class or category of goods and/or services on or in connection with which it is used. *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), *citing H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986) (“*Marvin Ginn*”). The test for determining whether a mark is generic is its primary significance to the relevant public. Trademark Act § 14(3); *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and *Marvin Ginn, supra*. Making this determination “involves a two-step inquiry: First, what

is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?” *Marvin Ginn*, 228 USPQ at 530. Our primary reviewing court has stated that a party charging genericness must prove its claim by a preponderance of the evidence. *Magic Wand*, 19 USPQ2d at 1554; *Stocker v. General Conference Corp. of Seventh-day Adventists*, 39 USPQ2d 1385, 1392 (TTAB 1996).

There is no real dispute that the genus of goods is that identified in the application, namely, barbeque sauce, and the relevant public for purposes of our genericness analysis consists of consumers and potential consumers of barbeque sauce.

We now consider whether petitioner has met its burden and shown by a preponderance of the evidence that consumers, or potential consumers, of barbeque sauce regard the term “mumbo” as primarily a reference to a type of barbeque sauce. Evidence of this relevant public's understanding of the term may be obtained from any competent source, including testimony, surveys, dictionaries, trade journals, newspapers, and other publications. *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985). Furthermore, “evidence of competitors' use of particular words as the name of their goods or services is, of course, persuasive evidence that those words would be perceived by purchasers as a generic designation for the goods and services.” *Continental Airlines, Inc. v. United Air Lines, Inc.*, 53 USPQ2d 1385, 1395 (TTAB 1999).

The only actual evidence of record submitted by petitioner showing third-party use of the term “mumbo” as a possible generic reference to a sauce are those mate-

rials filed under Petitioner's Notice of Reliance No. 1. These materials consist of internet printouts from six different retail websites, one Facebook page website, and a website identified as "The Sauces." These materials reflect use of the term "Mumbo" or "Mumbo Sauce" in connection with what the Board can decipher are three different branded sauces – a "Henry's Mumbo Sauce", a "Mumbo Sauce" offered by Chuck's Wagon, and a "Steve's Own Special Sauce (S.O.S.S.) Mumbo Sauce."⁶ On one website called "Green Mountain Grills," the following description is provided:

There is a very popular sauce in the DC area which they call Mumbo Sauce (some call it mambo). Local Lore says the Chinese restaurants originated this for use on wings, ribs, etc., but more accurately, the African-American restaurants in that area probably first developed it.

In addition, The Sauces website contains descriptions of four different "Mumbo sauces" based on a stated "vision of Mumbo Sauces is to blend the aromatic flavors of California's ethnic cultures into a distinctive International taste."

Although the aforementioned evidence indicates some generic use of the term "Mumbo" in connection with sauces, this evidence is of limited probative value for several reasons. First, the number of uses by third parties may be considered minimal inasmuch as the materials are drawn from seven different websites and one Facebook page. Second, there is no evidence showing the extent of exposure to these uses, i.e., there is no indication whether these are relatively obscure websites nor is there any way to determine the number of bottles, if any, of "Mumbo" sauce that have been sold by third parties. That is, there is no testimony or corroborating evi-

⁶ Photographs of the latter-identified sauce reveal jars with the same label are advertised in several retail websites and may be referred alternatively as "Steve's Mumbo Sauce" or "Steve Mumbo Sauce" or "Mumbo Sauce."

dence showing that the aforementioned third-party use of the term “Mumbo” is so extensive such that we can conclude that the relevant consuming public recognizes “Mumbo” primarily as a generic reference for a type of barbeque sauce.

Through the testimony of Ms. Collins and other evidence, respondent has shown that it has engaged in serious efforts to police what it considers improper use of its MUMBO mark, including successful efforts with respect to some of above-referenced third-party uses of the term “Mumbo.” For example, Ms. Collins testified that respondent first learned of the Green Mountain Grills’ use of the term “Mumbo” on barbeque sauces during the course of this proceeding and, shortly thereafter, contacted the owners of the website with a request to “cease and desist” from its use of the term “Mumbo” on its website. According to Ms. Collins and based on correspondence between respondent and Green Mountain Grills that has been attached as exhibits to the Collins declaration, the Green Mountain Grills website no longer contains advertisements for a “Mumbo” sauce.

We have carefully reviewed all of the evidence of record, as well as all of the parties' arguments, and we find that petitioner has not met its burden by proving that the consuming public primarily views MUMBO as a generic term for barbeque sauce.

Because petitioner has failed to meet its burden in this cancellation proceeding, the subject registration remains prima facie evidence of the validity of the mark and respondent’s exclusive right to use the mark in commerce. Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). Nevertheless, we would be remiss if did not

offer a brief history regarding respondent's acquisition of rights in the mark MUMBO. Through the testimony of Ms. Collins, respondent has demonstrated that it is the successor-in-interest to all rights in the mark MUMBO first acquired by Mr. Argia B. Collins in the early 1950's. Mr. Collins was the father of Ms. Collins and was also a notable African-American entrepreneur who owned several restaurants in Chicago's South Side beginning in 1950. Mr. Collins coined the term MUMBO as a trademark for use on bottles of his barbeque sauce that initially were offered for retail sale in his restaurants and were later sold through independent stores and other restaurants, and then to larger retail food chains. On September 23, 1958, a registration for the mark MUMBO for "barbeque sauce" was issued to Mr. Collins (the registration was not renewed and was cancelled as of September 23, 1978).⁷ Mr. Collins and his MUMBO-branded barbeque sauce acquired some notoriety in the Chicago area and his "Mumbo barbeque sauce" enterprise was identified in a 1968 Time magazine business piece as one of the successful results of a program initiated by Martin Luther King, Jr.⁸ In the "early [19]90's," Mr. Collins became ill and "transferred the interest in the [MUMBO] mark and all other assets" to respondent. Collins 22:8-11. The subject registration of this cancellation proceeding was issued to respondent in 1999. Based on the testimony of Ms. Collins and supporting exhibits, respondent has demonstrated that it has continuously used the MUMBO mark

⁷ Registration No. 667502 issued from Application Serial No. 72-033058 that was filed on July 2, 1957.

⁸ The program, called "Operation Breadbasket," is described by Ms. Collins as the "brain-child" of Martin Luther King, Jr. and essentially was an "organization that could advocate on behalf of black businessmen." Collins dep. 30:1-5. Mr. Collins was "one of the founding members" of Operation Breadbasket. Id. at 19-20.

nationally in advertisements and retail sales of its barbeque sauce since it acquired rights in said mark.

Decision: The petition to cancel on the ground of genericness is dismissed.