

This Opinion is Not a
Precedent of the TTAB

Hearing: August 16, 2016

Mailed: February 1, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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*Theatrical Stage Employees Union Local No. 2
of the International Alliance of Theatrical Stage Employees
and Moving Picture Technicians, Artists and Allied Crafts
of the United States and Canada*

v.

David B. Eaves

—
Cancellation No. 92055242
—

Robert S. Rigg of Vedder Price PC for Theatrical Stage Employees Union Local No. 2.

Catherine Simmons-Gill and Pawel A. Fraczek of Offices of Catherine Simmons-Gill LLC for David B. Eaves.

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Before Cataldo, Masiello, and Heasley, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

In this proceeding, Theatrical Stage Employees Union Local No. 2 of the International Alliance of Theatrical Stage Employees and Moving Picture Technicians, Artists and Allied Crafts of the United States and Canada (“Petitioner”) filed a petition to cancel U.S. Reg. No. 3761918 on the Supplemental Register (the

“Registration”),¹ owned by David B. Eaves (“Respondent”). After the case was briefed and argued, the Registration lapsed because of Respondent’s failure to make the maintenance filings required by Trademark Act Section 8, 15 U.S.C. § 1058. The Director cancelled the registration on December 15, 2016, and on the same date the Board allowed Respondent twenty days to show cause why such cancellation should not be deemed to be the equivalent of a cancellation by request of Respondent without the consent of Petitioner, warranting entry of judgment against Respondent.² In response, Respondent showed that the cancellation was inadvertent.³ The Board discharged the order to show cause; did not enter judgment against Respondent; and allowed Petitioner twenty days to request a determination on the merits of its claim, failing which the claim would be deemed moot.⁴ Petitioner has requested a determination on the merits and the issuance of a final decision.⁵ Therefore, while the Registration stands cancelled, we proceed to consider the merits of Petitioner’s claim.

The mark in the Registration is CHICAGO STAGEHAND in standard characters, and it was registered for “Employment Staffing in the field of labor and technical support in live corporate, concert and special events,” in International Class 35. Petitioner sought cancellation of the Registration on the ground of likelihood of

¹ Issued March 16, 2010, based on an application filed August 28, 2009 under Trademark Act Section 1(a), 15 U.S.C. § 1051(a).

² Board’s order to show cause, 113 TTABVUE.

³ 114 TTABVUE.

⁴ 115 TTABVUE.

⁵ 116 TTABVUE.

confusion, under Trademark Act Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Petitioner alleged that it has used the designation CHICAGO STAGEHANDS in connection with its labor union activities since at least as early as 1950.

In his answer, Respondent admitted “that Petitioner’s improper use of the name CHICAGO STAGEHANDS is likely to cause confusion among consumers ...,”⁶ but has otherwise denied the salient allegations of the petition. Respondent asserted affirmative defenses of lack of a continuous and commercial use; acquiescence, laches, abandonment, and unclean hands; estoppel, use merely as a trade name, and lack of secondary meaning.⁷ Respondent also pleaded hypothetically that he is entitled to maintain his Registration if his identified services were limited to “Non Labor Union related employment Staffing in the field of (labor and technical support in live corporate, concert and special events” [*sic*].⁸

The case is fully briefed and oral arguments were heard at a hearing at which both parties were represented on August 16, 2016.

⁶ Amended Answer ¶ 13, 13 TTABVUE 10.

⁷ Respondent has not addressed the defenses of acquiescence, laches, or estoppel in his brief; accordingly, those defenses are waived. *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422 (TTAB 2014). The facts relevant to the defenses of lack of continuous or commercial use, abandonment, use merely as a trade name, and lack of secondary meaning are subsumed in, and addressed by, our discussion of the parties’ use of their designations and acquired distinctiveness. Respondent has briefed his asserted defense of unclean hands, and it will be addressed separately herein.

⁸ Amended Answer, Affirmative Defense Six, 13 TTABVUE 13.

I. The record.⁹

The record includes the pleadings and, by operation of Trademark Rule 2.122, 37 C.F.R. § 2.122, the file history of the Registration and underlying application. The parties have submitted a stipulation of facts. 78 TTABVUE (duplicate at 85 TTABVUE). In addition, the parties have made of record the following testimony and evidence:

A. Filed by Petitioner:

- Testimony deposition of Craig Carlson, business manager of Petitioner (and exhibits), 93 TTABVUE 103-246 (public version at 92 TTABVUE 103-246).
- Testimony deposition of Thomas L. Herrmann, member, call steward, and vice president of Petitioner (and exhibits), 91 TTABVUE 60-125 (public version at 90 TTABVUE 60-125).
- Testimony deposition of Clarinda Corbett, office manager of Petitioner (and exhibits), 91 TTABVUE 125-171 (public version at 90 TTABVUE 125-171).
- Declaration of Clarinda Corbett 79 TTABVUE (duplicate at 84 TTABVUE) (admitted by stipulation).
- Testimony deposition of Mark A. Donahue, a journeyman member of Petitioner (and exhibits), 89 TTABVUE.
- Testimony deposition of Patrick Stephen Hudson, stagehand at Goodman Theatre and member of Petitioner (and exhibits), 95 TTABVUE 32-72 (public version at 94 TTABVUE 32-72).
- Testimony deposition of Caitriona Laseau, a freelance production manager (and exhibits), 91 TTABVUE 8-59 (public version at 90 TTABVUE 8-59).

⁹ Petitioner has moved to strike Exs. 65, 66 and 68 to the testimonial deposition of David Eaves, and related testimony. The motion is fully briefed. Motion at 104 TTABVUE 59-62. Exhibits at 99 TTABVUE 400-410 and 414. On this extensive record, the evidence at issue is primarily either duplicative or merely corroborative of other evidence of record. We find the inclusion of the subject evidence harmless and therefore deny Petitioner's motion. The exclusion of the evidence would not have altered our determinations herein.

- Testimony deposition of Floyd Dillman, proprietor of Event Media, dba Complete Crewing (and exhibits), 93 TTABVUE 8-102 (public version at 92 TTABVUE 8-102).
- Testimony deposition of Louis Raizin, president of Broadway in Chicago (and exhibits), 95 TTABVUE 8-32 (public version at 94 TTABVUE 8-32).
- Testimony deposition of Richard James Dowsek, retired director of finance and administration of Lyric Opera of Chicago (and exhibits), 96 TTABVUE.
- Testimony deposition of Mario Educate, president and CEO of OSA International (and exhibits), 97 TTABVUE.
- Petitioner's first notice of reliance on printed publications and books, 70 TTABVUE.
- Petitioner's second notice of reliance on third-party registrations, 71 TTABVUE.
- Petitioner's third notice of reliance on evidence from the internet and publications, 72 TTABVUE.
- Petitioner's fourth notice of reliance on Respondent's responses to interrogatories, 74 TTABVUE 5-13; and discovery deposition of Respondent David Eaves (and exhibits), 74 TTABVUE 15-294.
- Petitioner's fifth notice of reliance on printed publications, 86 TTABVUE.
- Petitioner's sixth notice of reliance on Respondent's responses to document requests; and printed publications. 87 TTABVUE.

B. Filed by Respondent:

- Testimony depositions of Respondent David Eaves (and exhibits), 99 TTABVUE (public version at 98 TTABVUE).
- Testimony deposition of Craig Carlson (and exhibits), 100 TTABVUE.
- Respondent's notice of reliance on:
 - Discovery depositions of Craig Carlson, Rule 30(b)(6) witness for Petitioner, 80 TTABVUE 6-497 (public version at 81 TTABVUE 6-489).

Discovery deposition of Thomas Herrmann, 80 TTABVUE 498-874 (public version at 81 TTABVUE 490-854).

Petitioner's answers to supplemental interrogatories, 80 TTABVUE 875-890).

Petitioner's responses to requests to admit, 80 TTABVUE 892-911.

- Respondent's notice of reliance (82-83 TTABVUE) on:

Respondent's pending application Serial No. 86399091.

Petitioner's pending applications Serial Nos. 86238513, 85530945, 85530942, 85530932, 85530927, and 85530919, and related USPTO Office actions and responses.

Petitioner's U.S. Reg. Nos. 4322950 and 4303933.

II. Standing.

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015). The plaintiff must show that it has a real interest in the proceeding beyond that of a mere intermeddler, and that it has a reasonable basis for its belief of damage resulting from registration of the subject mark. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

The record shows that Petitioner is a labor union that represents workers in the field of the production of live events, such as theatre, concerts, opera, conventions and tradeshow¹⁰. Such workers, who include carpenters, painters, electricians, lighting

¹⁰ Petitioner's answer to Supplemental Interrogatory No. 1, 80 TTABVUE 877-8.

technicians and audio technicians, are sometimes called “stagehands.”¹¹ As part of the services that Petitioner provides to its members, Petitioner refers its members to available stagehand jobs with companies that are preparing to produce live events.¹² Respondent admits in his brief that referrals to work are a part of Petitioner’s services,¹³ and at oral argument Respondent’s counsel conceded that such services are essentially the same as the “Employment Staffing” services identified in Respondent’s Registration. (Respondent’s staffing services involve non-union stagehand labor, but his Registration is not limited to non-union workers.) It is apparent on this record that Petitioner and Respondent are direct competitors and that both focus their services on the geographic markets in the vicinity of Chicago, Illinois. The record also shows that Petitioner has filed applications for U.S. registration of CHICAGO STAGEHANDS as a collective membership mark “to indicate membership in a union of stagehands” (Serial No. 86238513) and as a service mark for various labor union services (Serial No. 85530945); and that the USPTO has refused to register those marks on grounds of likelihood of confusion with the mark in Respondent’s Registration.¹⁴ It is clear from the foregoing that Petitioner has a real interest in the outcome of this proceeding and has established its standing to seek cancellation of the Registration. *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 (TTAB 1999) (competitor has standing); *Lipton Industries, Inc.*

¹¹ *Id.*, 80 TTABVUE 878.

¹² *Id.*, 80 TTABVUE 878; Herrmann test. 142:17-18, 91 TTABVUE 70.

¹³ Respondent’s brief at 6, 105 TTABVUE 7.

¹⁴ Respondent’s notice of reliance, 82 TTABVUE 82-145.

v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (a cancellation petitioner may establish its standing by proving that its pending application for registration has been refused on the basis of the involved registration).

III. Petitioner's claim under Section 2(d).

In this case, Petitioner challenges a registration on the Supplemental Register of a term that is primarily geographically descriptive, and bases its challenge on its asserted common law rights in a highly similar geographically descriptive term. Ordinarily, where two parties vie for proprietary rights in merely descriptive terminology, the case does not turn on who, chronologically, used the term first, but on “the priority of acquisition of acquired distinctiveness (also commonly referred to as secondary meaning).” *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1136 (TTAB 1992). In this case, as we will discuss, neither party has persuaded us that it has acquired distinctiveness in its chosen designation. The most direct instruction as to how to address such circumstances was provided, albeit in *dicta*, by our primary reviewing Court in *Books on Tape Inc. v. The Booktape Corp.*, 836 F2d 519, 5 USPQ2d 1301 (Fed. Cir. 1987). There, the Federal Circuit pointed out that the owner of a registration on the Supplemental Register “has as yet no proprietary rights in a mark ...” 5 USPQ2d at 1302. Accordingly, the Court held that the challenger need not demonstrate proprietary rights, as is usually required when challenging a registration on the Principal Register or a distinctive unregistered mark. *See, e.g., Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). Rather, the *Books on Tape* Court said:

The statute does not require the anomalous result that a junior user is entitled to keep its Supplemental Registration for a descriptive term in which it has not established secondary meaning (as evidenced by registration on the Supplemental Register) because a *prior* user cannot show secondary meaning in that term either. See *Kwik-Kopy Franchise Corporation v. Dimensional Lithographers, Inc.*, 165 USPQ 397, 398-99 (TTAB 1970) (“lawful use” in Section 23 (15 U.S.C. §1091) means “exclusive use”).

5 USPQ2d at 1302-1303.¹⁵

Practically speaking, a registration of a merely descriptive term on the Supplemental Register, owned by a user that has not acquired distinctiveness in the term, will impede another party that *has* acquired distinctiveness in a similar descriptive term from obtaining registration on the Principal Register. The obstacle need not be perpetual, because the party that can demonstrate acquired distinctiveness would have grounds to cancel the registration on the Supplemental Register, thereby clearing the way for its own efforts to obtain registration on the Principal Register. However, the guidance of the Federal Circuit in *Books on Tape*, which we accept, is that such party need not wait until it has acquired distinctiveness in its mark before seeking to clear away the impediment.

¹⁵ We note that *Books on Tape* was decided before the 1988 amendments to Section 23 of the Trademark Act, which eliminated the requirement that an applicant for registration on the Supplemental Register have used its mark for at least the one-year period preceding the application. The amendment did not remove the requirement that the mark be in “lawful use.” The Senate Judiciary Report characterized the changes to Section 23 as “technical amendments,” saying, “This revision of the Act will have no effect on the underlying rights of the registrant.” See 7 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, Appendix A5 (4th ed., 2016 update), Selected Legislative History of the 1988 Trademark Law Revision Act: Senate Judiciary Report on S. 1883.

In this case, both parties vigorously asserted proprietary rights in their respective designations and sought to demonstrate that their marks had acquired distinctiveness. We treat the issue of acquired distinctiveness, on both sides, as having been tried by implied consent. Had either party successfully demonstrated acquired distinctiveness, we would have considered the guidance of *Books on Tape* to be inapposite. However, because we find otherwise, we agree with Petitioner's contention that it "does not need to show that its mark has acquired distinctiveness in the market in order to cancel the registered mark."¹⁶ We therefore turn to consider the parties' arguments and evidence regarding priority, acquired distinctiveness, and likelihood of confusion.

A. Priority.

1. Respondent.

Respondent testified that he began operating his business as Chicago Stagehand LLC "somewhere in the winter, spring or maybe even the summer of 2009."¹⁷ He registered the domain name <chicagostagehand.com> on November 14, 2008.¹⁸ The existence of the website appears to have been first detected by the Internet Archive Wayback Machine on March 24, 2009.¹⁹ Respondent testified that "we were capable of providing services in the spring of 2009. Could have been summer."²⁰ By

¹⁶ Petitioner's brief at 39, 104 TTABVUE 40.

¹⁷ Eaves disc. dep. 75:1-5, 74 TTABVUE.89.

¹⁸ Eaves test. 673:16 and Respondent's Ex. 44, 99 TTABVUE 25, 257-261.

¹⁹ Respondent's notice of reliance, 82 TTABVUE 37.

²⁰ Eaves disc. dep. 167:8-10, 74 TTABVUE 181-183.

approximately mid-June 2009, he had prepared various conventional forms of display of the mark, such as business cards, stationery, and stamps, had created a press release, and had begun work on an advertising campaign.²¹ The earliest marked invoice for his services that is of record is dated May 9, 2009, but the job was cancelled and never performed.²² When asked whether he had sent invoices to other clients in the same format prior to that date, he replied, “I could have.”²³ The record also includes an invoice dated October 24, 2009 for services rendered October 19-24, 2009.²⁴ That Respondent was active under the mark in 2009 does not appear to be in dispute; Mario Educate, a staging production management executive, made use of Respondent’s services “In about 2009 ...”²⁵ A claim for unemployment insurance filed with the State of Illinois indicates that Respondent’s business paid an employee wages during the third quarter of 2009.²⁶ For purposes of our analysis, we accept that Respondent was providing services under his mark in 2009, with use analogous to trademark use commencing as early as March 2009.

2. Petitioner.

Petitioner contends that CHICAGO STAGEHANDS has been its trade identity for much of the twentieth century and continuing to the time of trial. However,

²¹ Eaves test. 689-690; 692:15-21; 698:3-5; 701:23-24; 704:17-20; 708-722; 722:19, 99 TTABVUE 41-2, 44, 50, 53, 56, 60, 74.

²² Eaves test. 735:13-736:12, 99 TTABVUE 87-88.

²³ Eaves test. 870:13, 99 TTABVUE 243.

²⁴ Respondent’s notice of reliance, 82 TTABVUE 46.

²⁵ Educate test. Ex. 23, ¶ 8; and 584:1-2, 97 TTABVUE 48, 12.

²⁶ Eaves test. Ex. 70; 740:5-741:5, 99 TTABVUE 421, 92-93.

Petitioner's technical trademark use of CHICAGO STAGEHANDS was sporadic. In 2001, on the occasion of a strike against the Goodman Theatre, Petitioner prepared and distributed to its members a baseball cap bearing the mark, which various strikers wore at the site of the strike.²⁷ At the same strike, a placard displaying a "shield" bearing the mark was carried.²⁸ The hats were not manufactured again, and by 2005 there was apparently only one such cap "left over from the Goodman Strike" in Petitioner's possession.²⁹ Petitioner's business manager testified that Petitioner gave out marked hats at golf outings in the early 1990's, but there is no documentary evidence of such hats.³⁰ At some time in 2009, Petitioner undertook to produce approximately 500 casual shirts displaying the mark.³¹ Approximately 20 of them remained in inventory at the time of trial.³² Between 1995 and 2005, a union member named Mark Donahue arranged to produce and distribute, apparently on his own initiative, various kinds of apparel displaying the term CHICAGO STAGEHANDS; these included baseball caps, sweatshirts, fleece jackets, shirts, and wool hats.³³ These were produced in very small numbers, sometimes to the order of individual union members. Between 1993 and 1997, Mr. Donahue's brother Tim produced some

²⁷ Donahue test. 20:15-17; 21:17-22:3 and Exhibit 5, 89 TTABVUE 24-26, 101-102; Hudson test. 524ff.; 527:16-23; 529:535, 95 TTABVUE 41-44, 46-52.

²⁸ Hudson test. 532:1-5, 95 TTABVUE 49.

²⁹ Corbett test. 199:12-18, 91 TTABVUE 127.

³⁰ Carlson test. 628:1-12, 100 TTABVUE 28.

³¹ Carlson disc., 159-160; 177:19-22, 80 TTABVUE 165-166, 183; Corbett test, Ex. 13, 91 TTABVUE 208.

³² Corbett test. 208:22-23; 210:14, 91 TTABVUE 136, 138.

³³ Donahue test. Exs. 2-4, 6-9, 89 TTABVUE 98-100, 103-106.

such apparel.³⁴ There is testimony that union members wore such insignia apparel on virtually every jobsite to which union workers were dispatched.³⁵ Petitioner's call steward claimed to have first worn such apparel to jobsites in the late 1970s.³⁶ However, the insignia apparel appears to have been in such short supply that the claim that such apparel could be seen at virtually every jobsite seems exaggerated. On cross-examination, some witnesses admitted that the union insignia most often in evidence on jobsites was a button, which did not include the words CHICAGO STAGEHANDS.³⁷ On this record, Petitioner's technical service mark use of CHICAGO STAGEHANDS before Respondent adopted the phrase CHICAGO STAGEHAND was very limited and not continuous.

More significant, however, is testimony of third parties to the effect that they use and recognize the term CHICAGO STAGEHANDS as a reference to Petitioner. Caitriona Laseau, a freelance production manager, testified that "it was known to me that the Chicago Stagehands was a name that referred to the Chicago Stagehands Local 2";³⁸ and that she uses the term and has heard others use the term to refer to Petitioner. She first heard of Petitioner under the name CHICAGO STAGEHANDS while in college:

³⁴ Donahue test 31:7-33:5, 89 TTABVUE 35.

³⁵ Donahue test. 12:8-10; 14:2, 89 TTABVUE 16, 18; Herrmann test. 148:20-149:9; 149:17; 91 TTABVUE 76-77; Carlson test. 355:2-18, 93 TTABVUE 115.

³⁶ Herrmann test. 151:24-152:3, 91 TTABVUE 79-80.

³⁷ Herrmann test. 189:20-21, 91 TTABVUE 117; Donahue test. 59:24, 89 TTABVUE 63.

³⁸ Laseau test. 106:19-23; 111:14-19; 109:4-8; 109:21, 91 TTABVUE 34, 39, 37.

That's what we referred to as the Union that was in Chicago.³⁹ ...

I don't know if it was on any paperwork, but I know they referred to them as Chicago Stagehand when we were talking about the Union in Chicago. I, actually, haven't even heard IATSE until after that, so it was Chicago Stagehand before I heard IATSE.⁴⁰

She claimed to have also heard such use from "different vendors," and specifically identified Gand Concert Sound as one of them.⁴¹

When I was on the phone with, say, a tour that was coming through, and I say, "We're a Union venue." And they're like, "Oh, what Union?" And I'm like, "Oh, the Chicago Stagehands." And they're like, "Okay, that's cool. Chicago Stagehands are cool."⁴²

Floyd Dillman, the owner of a company that provides theatrical labor for business meetings and other events, said of the term CHICAGO STAGEHANDS, "I typically think that that refers to Local 2 Stagehands."⁴³ He suggested that this usage reflected an industry convention:

Just as if someone said to me, "San Diego Stagehands," I would assume it's IATSE Local 122 in San Diego.⁴⁴ ...

So if you said, lacking context, my reference is if you say, "Chicago Stagehands," I'd presume you're referring to Local 2. As the same case as I said before, if you said "San

³⁹ Laseau test. 107:2-8, 91 TTABVUE 35.

⁴⁰ Laseau test. 127:8-14, 91 TTABVUE 55.

⁴¹ Laseau test. 109:4-8; 109:14-16, 91 TTABVUE 37.

⁴² Laseau test. 110:14-19, 91 TTABVUE 38.

⁴³ Dillman test. 263:18-21, 93 TTABVUE 23.

⁴⁴ *Id.*, 93 TTABVUE 23.

Diego Stagehands,” I’d assume it was the Stagehands Local in San Diego or whatever city you went into.⁴⁵

Mario Educate, president of a staging production management company for TV, corporate and special events, reinforced the impression of conventional usage in the industry. He said of the term CHICAGO STAGEHANDS:

That means that you’re referring to a Local 2 member. It’s synonymous in any city. If you were to tell me as I go into a venue that “Who is the labor here? It’s the LA Stagehands,” it means to me it is the LA Stagehands union. Same thing, New York Stagehands is Local 1. Chicago Stagehands is Local 2. It’s known with every production manager in this business.⁴⁶

[A]s every different industry has its lingo, this is -- across-the-board in our industry, anything that refers to Chicago Stagehands is Local 2. No doubt. I don’t even have to explain it to someone. To them that means that “You are to call Local 2.” So if I were to say, “Hey we’re going into Chicago, call Chicago Stagehands,” it’s Local 2.”⁴⁷

It’s pretty much an industry given that when you refer to first a city’s name and then “stagehand,” that is union. It is our lingo.⁴⁸

Louis Raizin, the president of a company that operates theaters, testified, “I think to me, saying Stagehands, Chicago Stagehands, Local 2 are words that I see as interchangeable.”⁴⁹

They may characterize them as Local 2. They may characterize them as IA. They may characterize them as Chicago Stagehands. Any -- in going back to my prior

⁴⁵ Dillman test. 317:4-17, 93 TTABVUE 77.

⁴⁶ Educate test. 586:4-11, 97 TTABVUE 14.

⁴⁷ Educate test. 587:24-588:6, 97 TTABVUE 15-16.

⁴⁸ Educate test. 588:17-19, 97 TTABVUE 16.

⁴⁹ Raizin test. 499:24-500:2, 95 TTABVUE 16-17.

statement that those types of words are common use in terms of those kinds of conversations and interchangeable, all meaning the same thing at the end of the day.⁵⁰

James Dowsek, retired director of finance and administration of Lyric Opera of Chicago, stated:

[C]ertainly, “Chicago Stagehands” is a term that’s used at least in my experience to describe members of Local 2. They are Chicago Stagehands.⁵¹

[F]or the entirety of my experience in this business, that “Chicago Stagehands” to me translated to members of Local 2. They were the stagehands that worked in the Opera House.⁵²

They were Chicago Stagehands in that they were in Chicago, and they were members of Local 2, and they worked at the Opera House. But as I said before, Chicago Stagehands would be translated to Local 2 members who worked at the Lyric or worked at the CSO or worked at Ravinia, wherever there was covered employment.⁵³

It wasn’t an exclusive, but it was a way to describe the folks who commonly were covered by a CBA, entered into by, again, any number of the employers in Chicago used them, whether it was Goodman or CSO or Joffrey or...⁵⁴

This evidence demonstrates that persons in the live event trade find CHICAGO STAGEHANDS to be an appropriate descriptive term for unionized stagehands in the field of live events who provide their services in the vicinity of Chicago; that such persons have in fact used this phrase in order to describe Petitioner and its members;

⁵⁰ Raizin test. 502:16-24, 95 TTABVUE 19.

⁵¹ Dowsek test. 567:3-6, 96 TTABVUE 15.

⁵² Dowsek test. 567:12-15, 96 TTABVUE 15.

⁵³ Dowsek test. 568:2-10, 96 TTABVUE 16.

⁵⁴ Dowsek test. 568:15-19, 96 TTABVUE 16.

that, in their own experience, they have found this phrase to immediately convey information about Petitioner and its members; and that they expect others to understand them when they use the phrase to refer to Petitioner and its members.

Petitioner has supplemented the testimony discussed above with press notices and publications in which CHICAGO STAGEHANDS (or a variant thereof) has been used to describe Petitioner and its members. Salient examples from the years indicated follow:

1923: CHI STAGEHANDS' RAISE: Chicago stagehands' union wa[s] awarded a general Increase of 20 per cent, over last season's wag[e] scale here today.⁵⁵

1939: Chicago Stagehands officers are also meeting theatre executives on terms.⁵⁶

1941: At Correa's request, the defendant fished in his pockets and handed over three "union cards," one in local 2 – the Chicago stagehands – and the other two in California movie studio locals.⁵⁷

1944: George E. Browne, who rose from business manager of local 2, the Chicago Stagehands union, to president of the IATSE & NPMO union, with the help of Bioff and the old Capone gang, is "definitely out as even a member of both organizations," members of local 2 said yesterday.⁵⁸

⁵⁵ Variety, 77 TTABVUE 59. (This digital archive article appears to have been generated by optical character recognition and it contains many errors.)

⁵⁶ Motion Picture Herald, 77 TTABVUE 47.

⁵⁷ Chicago Daily Tribune, "5 Aliases Bob Up to Haunt Bioff at Extort Trial," 86 TTABVUE 18.

⁵⁸ Chicago Daily Tribune, "Browne, Bioff, Leaders in Film Racket, Paroled," 86 TTABVUE 13. The record shows that Mr. George E. Browne had some notoriety. Other accounts of his deeds can be found in *The Hollywood Book of Scandals: The Shocking, Often Disgraceful Deeds and Affairs of More than 100 American Movie and TV Idols* (2004) (86 TTABVUE 26); *Hot Toddy: The True Story of Hollywood's Most Sensational Murder* (1989) (86 TTABVUE 3ff.); *The Hollywood Connection: The True Story of Organized Crime in Hollywood*, p. 117 (1993) (87 TTABVUE 24); and Los Angeles Times, "The Mob and The Movies" (1987) (70 TTABVUE 10).

- 1988: He also writes doggerel verse and enjoys exchanging it with people ranging from pianist Rudolf Serkin to Chicago stagehands.⁵⁹
- 1996: The Chicago mob, then under the aegis of Frank Nitti while Al Capone was in jail, wanted the IA's Hollywood chapter to hire Chicago "stagehands."⁶⁰
- 2001: He ... was a member of ... IATSE (Stagehands of Chicago).⁶¹
- 2003: John Willard Hull became a charter member of the Chicago stagehands union in 1893.⁶²
- 2007: Even though the Chicago stagehands – members of IATSE's Local Two, as distinct from the striking Local One in New York – are working under a different contract ... they haven't wanted to say anything on the record that could be read as disloyal to their brethren in New York.⁶³
- 2008: Craig Carlson of the Chicago stagehands union Local 2 has been elected vice president of the International Alliance of Theatrical Stage Employees.⁶⁴
- 2009: Gene and I never met till last year at Amigos but we are both in the entertainment industry belong to same union IATSE local #2 Chicago Stagehands for me Local #600? Cameramen for Gene ...⁶⁵
- 2011: The march merged with the marches of other unions into the plaza, including SEIU, Chicago Stagehands, AFT 1708, CTU, Letter Carriers, Chicago Firefighters, IBEW, and even one sign from the past and present, the IWW – One Big Union.⁶⁶

⁵⁹ Philadelphia Inquirer, 86 TTABVUE 30.

⁶⁰ The Washington Post, "The Star in the Wings; Washington's Stagehands Make Theater a Moving Experience," 70 TTABVUE 22.

⁶¹ Obituary, Arkansas Democrat-Gazette, 87 TTABVUE 14.

⁶² The Hull Family Association Journal, 86 TTABVUE 45.

⁶³ Chicago Tribune, 70 TTABVUE 14.

⁶⁴ Chicago Tribune, 70 TTABVUE 6.

⁶⁵ Post on Cave Diver's Forum blog, 77 TTABVUE 13.

⁶⁶ College Union Voice, 70 TTABVUE 44.

2011: Tim Bowman's Overview: Current: Stagehand at Chicago stagehands local 2.⁶⁷

2012: He still keeps his ears tuned by occasionally mixing shows for the Chicago Stagehands Union (local #2) at Navy Pier and other Chicago theatres.⁶⁸

2012: Locals 705 (LA Costumers), 700 (Editors Guild) and 2 (Chicago Stagehands) are celebrating their Anniversaries.⁶⁹

2015: Chicago Stagehands Local Endorses HR 676, National Single Payer Legislation. Thomas Cleary, Secretary-Treasurer of Stagehands Local 2 in Chicago, reports that his local has wholeheartedly endorsed HR 676 ...⁷⁰

2015: There's also ... James Dennett, who at the start of his career as a production manager saw the slender, thoroughly non-violent Lewis punch out the belligerent head of Chicago's stagehands' union for calling him a [expletive].⁷¹

The evidence detailed above shows that over a long period of time, and leading to the time of trial, the expression CHICAGO STAGEHANDS has been used to describe or refer to Petitioner and its members. Courts have, on occasion, found that even where a company itself has not used a mark, use of the mark by the relevant public for the purpose of referring to the company may inure to the benefit of the company, even to the extent of resulting in a protectable property right in the term.

Moreover, even without use directly by the claimant of the rights, the courts and the Board generally have recognized that abbreviations and nicknames of trademarks or names used *only* by the public give rise to protectable rights in the

⁶⁷ Linked-In profile, 77 TTABVUE 11.

⁶⁸ Online professional resume, 77 TTABVUE 9.

⁶⁹ Minutes of Executive Board Meeting of IATSE Local 784, 77 TTABVUE 15.

⁷⁰ Physicians for a National Health Program newsletter, 70 TTABVUE 38.

⁷¹ Online review of 2010 movie "Herschell Gordon Lewis: The Godfather of Gore," 77 TTABVUE 38.

owners of the trade name or mark which the public *modified*. Such public use by others inures to the claimant's benefit and, where this occurs, public use can reasonably be deemed use 'by' that party in the sense of a use on its behalf.

National Cable Television Ass'n Inc. v. American Cinema Editors Inc., 937 F.2d 1572, 19 USPQ2d 1424, 1428 (Fed. Cir. 1991).

We note that the public's adoption of 'VDS' to refer to Stock's company is enough to establish trade name and service mark use.

Martahus v. Video Duplication Svcs, Inc., 3 F.3d 417, 27 USPQ2d 1846, 1853 n.9 (Fed. Cir. 1993).

In the case before us, as we have noted, Petitioner need not demonstrate a protectable proprietary right in its asserted designation. We find that the evidence of Petitioner's own limited use of CHICAGO STAGEHANDS and the public's ongoing use of CHICAGO STAGEHANDS to describe and refer to Petitioner are, together, sufficient to show descriptive use of the term pointing to Petitioner that is prior to any use of the term CHICAGO STAGEHAND by Respondent.

B. Acquired distinctiveness.

As noted above, a dispute between two users of merely descriptive trademarks is often resolved by means of a race to acquired distinctiveness. In this case, if Petitioner can demonstrate acquired distinctiveness, that fact plus its priority of use would entitle it to cancel Respondent's registration. On the other hand, if only Respondent can demonstrate acquired distinctiveness, he would be entitled to maintain his Registration despite Petitioner's priority of use; there would be no "anomalous result," as contemplated by *Books on Tape*, because Respondent's showing would

indicate, *vis-à-vis* Petitioner, a superior proprietary right. *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d at 1136. However, as we have already adumbrated, in this case neither party has demonstrated acquired distinctiveness.

Acquired distinctiveness is generally understood to mean “a mental association in buyers’ minds between the alleged mark and a single source of the product.” 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 15:5 (4th ed. June 2016 update). “It is only necessary that a ‘substantial part’ of the buying class make such an association.” *Id.* §15:45. We will address each party’s showing in turn.

1. Respondent.

The Trademark Act is silent as to the quantum of evidence that is necessary to establish acquired distinctiveness, except for the provision of Section 2(f) that states, “The Director *may* accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant’s goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.” 15 U.S.C. § 1052(f) (emphasis added). Indeed, the USPTO often allows marks that are primarily geographically descriptive to be registered on the Principal Register upon such a showing. In the present case, Respondent cannot make such a showing, because he cannot viably contend that he has had five years of “substantially exclusive” use.

Respondent has filed an application for registration of his mark on the Principal Register on grounds of acquired distinctiveness; evidence submitted with that

application for purposes of showing acquired distinctiveness is of record.⁷² Respondent offered additional evidence of acquired distinctiveness through his testimony deposition. Considered together, respondent's evidence includes printouts from his website; domain name registration documentation; Google Adwords reports on the performance of the website at <chicagostagehand.com>; Google search results for the term "chicago stagehand" ("hit lists" only); a short declaration of David Eaves, alleging substantially exclusive and continuous use since at least November 14th, 2008 and expenditure of \$25,000 in advertising and marketing; Wayback Machine captures of portions of Respondent's website; correspondence regarding preparation of advertising and marketing materials; correspondence regarding placement of advertisements; a small sample of advertisements and blog posts; email solicitations for business; several invoices for services; a press release; several press notices; and a vendor agreement. Respondent testified as to his 2014 gross revenues, which are indicative of a *bona fide* small business.

Most of the evidence adduced by Respondent was offered for the purpose of demonstrating that Respondent was in business as of an early date. Very little of the evidence indicates the degree to which members of the relevant public associate the term CHICAGO STAGEHAND with Respondent. Respondent is a very small business; the amount of business that he has done and his efforts to advertise and otherwise promote his business are extremely modest. Moreover, as discussed above, the record shows that Respondent's use of his mark has not been exclusive, even in

⁷² Respondent's notice of reliance, 82 TTABVue 5-81.

his own geographic market, and this fact reduces the likelihood that customers would come to associate the term CHICAGO STAGEHAND with Respondent as his exclusive source indicator. Respondent's mark is a highly descriptive term in the context of stagehand services offered in the market area of Chicago. Substantially more evidence bearing directly on the degree of public recognition of Respondent's mark would be required to demonstrate that it has acquired public recognition as Respondent's source indicator. *In re Steelbuilding.com*, 415 F.3d 1293, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005) (“[T]he applicant's burden of showing acquired distinctiveness increases with the level of descriptiveness; a more descriptive term requires more evidence of secondary meaning.”) Considering all of the evidence of record, we find that Respondent has failed to demonstrate that his mark has become distinctive of his services.

2. Petitioner.

Petitioner has submitted a great deal of evidence relevant to the question of acquired distinctiveness. The strongest evidence was detailed above. Petitioner itself has made sparse use of the expression CHICAGO STAGEHANDS as a technical service mark. However, the record shows that third parties in the field of stagehand labor have used this expression in order to describe and refer to Petitioner and its members. We find the evidence bearing on the way in which the public views the term CHICAGO STAGEHANDS to be quite mixed: while there are some clear examples of individuals using this expression as a direct reference to Petitioner or as Petitioner's “nickname” (especially in the testimony), in many of the examples of record it is not

clear whether the speaker uses the phrase to refer to *unionized* stagehands and Petitioner itself or merely to stagehands in general. Such equivocal evidence does not support a finding of acquired distinctiveness. Although Petitioner is a large and vigorous organization, there is very little evidence to show that Petitioner has engaged in marketing efforts to promote itself under the name or mark CHICAGO STAGEHANDS or to promote a public association between itself and that name. Further, as was the case with Respondent, in the years between 2009 and the time of trial Petitioner's use of CHICAGO STAGEHANDS has not been exclusive, even in its primary geographic market, due to Respondent's ongoing use of CHICAGO STAGEHAND. This lack of exclusivity reduces the likelihood that CHICAGO STAGEHANDS would come to be recognized as Petitioner's mark. The sporadic and scant use of the term CHICAGO STAGEHANDS by Petitioner and the public's equivocal use of that term, either as an apt descriptor applicable to Petitioner or as a direct reference to Petitioner, are insufficient to persuade us that CHICAGO STAGEHANDS has acquired distinctiveness as a source indicator for Petitioner's services.

C. Likelihood of confusion.

There is little dispute that the concurrent appropriation and use by the parties of their asserted designations would be likely to cause confusion, mistake, or deception; Respondent has come very close to admitting as much in his answer, stating that "*Petitioner's* improper use of the name CHICAGO STAGEHANDS is likely to cause

confusion among consumers ...”⁷³ An analysis applying the factors set forth in *In re E. I. du Pont de Nemours & Co.* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) leads to the conclusion that such confusion would be likely.

The two marks are identical, except for the difference between singular and plural, which has almost no effect on the marks’ appearance, sound, or meaning. *See, e.g., Wilson v. Delaunay*, 114 USPQ 339, 341 (CCPA 1957); *In re Pix of America, Inc.*, 225 USPQ 691, 692 (TTAB 1985). Respondent’s mark is registered in standard characters, is not limited to any particular form of display, *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983), and could be displayed in manners similar to those that Petitioner uses.

With respect to the services, even though the parties are quite different types of businesses, in at least one important respect their services overlap: both businesses place workers in employment positions in the field of live event production. Respondent’s brief admits that an aspect of Petitioner’s services is providing “referrals to work” for its members;⁷⁴ this activity is squarely within the scope of Respondent’s “Employment Staffing” services, as identified in the Registration, and Respondent’s counsel confirmed at hearing that, in this regard, the parties’ services are identical. As these services of the parties are identical, we presume that they move through the same channels of trade and are marketed to the same classes of

⁷³ Amended Answer ¶ 13, 13 TTABVUE 10 (emphasis added).

⁷⁴ Respondent’s brief at 6, 105 TTABVUE 7.

customers. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).

The record contains an account of an incident of actual confusion caused by the two designations. Mario Educate, the president of a “staging production management company for TV, corporate and special events,” testified that he frequently uses both union and freelance workers for his productions.⁷⁵ He offered the account in a written declaration⁷⁶ and in testimony. The written account is as follows:

8. In about 2009, I became aware that one of my employees at OSA had hired the company “Chicago Stagehand,” owned by David Eaves, to provide employees to perform work in my shop, preparing and maintaining equipment used on events and productions. When I heard Chicago Stagehand, I thought it was related to IATSE Local No. 2 and their services referring employees. I discussed it further with my employee in order to understand that Eaves’s company, Chicago Stagehand, was not actually related to or authorized to use the name by IATSE Local No. 2. Since that time, OSA has used Chicago Stagehand’s services in the shop, but generally everyone in this industry knows the mark CHICAGO STAGEHANDS means and refers to IATSE Local No. 2.⁷⁷

Mr. Educate’s account in testimony is as follows:

I originally saw it when I looked at some of the labor bills of what was going on in our warehouses and at that time I thought we were contacting Local 2. I wondered why it was notated like that, but to me I thought we were calling the local for some shop help, but we weren’t.

⁷⁵ Educate test. 591:11-17, 97 TTABVUE 19.

⁷⁶ Mr. Educate verified the content of the declaration at Educate test. 584:1-2, 97 TTABVUE 12.

⁷⁷ Educate declaration, Exhibit 23 to Educate test., 97 TTABVUE 48.

Q. So I'm clear here, you have hired -- either you or somebody at your company has hired Chicago Stagehand, LLC to do work for one of your facilities?

A. Yes. Yes, our Chicago facility. I did not hire. One of my warehouse people made the contact.

Q. And when you indicated you saw the bills for Chicago Stagehand, LLC, did you believe that to be Local No. 2?

A. Yes, I did.

Q. Did you later learn that it's not Local No. 2?

A. Yeah, I later asked, you know, "Who -- what is going on with this? Why are we bringing in the local for some stuff in the warehouse?" And that's when I was told we weren't bringing in the local, that it was a company called Chicago Stagehand that we were hiring labor to help, you know, unload some trucks and move some stuff in our warehouse.

Q. And who did you have this conversation with?

A. With my warehouse manager in Chicago.⁷⁸

On cross-examination, the following exchange took place:

Q. So you indicated that when you saw these invoices from Chicago Stagehand that you were reviewing some of the materials, business documents of your company, your question in your own head was, Why are we calling Local 2 when we don't need to have union in our own warehouse, correct?

A. Correct.⁷⁹

This testimony demonstrates that confusion is likely between two businesses that identify themselves by the two designations at issue in an environment in which the same event production companies hire both union and non-union workers. Although

⁷⁸ Educate test. 589:18-590:22, 97 TTABVUE 17-18.

⁷⁹ Educate test. 598:8-14, 97 TTABVUE 26.

there is no indication of untoward harm resulting from Mr. Educate's confusion, it occurred in a context in which the respective reputations of the parties could have been affected. We hasten to point out that, on the present record, no opprobrium attaches to either party in connection with this incident of confusion, because neither party has demonstrated its proprietary right to the words involved. Parties that seek to identify themselves by highly descriptive words run the risk that they may be confused with others who may be aptly described by the same, or similar, words. *Milwaukee Nut Co. v. Brewster Food Svc.*, 277 F.2d 190, 125 USPQ 399, 401 (CCPA 1960) (“[A]ppellee, in adopting a word which is highly suggestive to the trade to which it was catering, ran the risk of having similar merchandise sold by others for the same purpose to the same trade...”); *In re Pennington Seed Inc.*, 466 F.3d 1053, 80 USPQ2d 1758, 1762 (Fed. Cir. 2006) (“[M]erchants act at their peril in attempting, by advertising, to convert common descriptive names, which belong to the public, to their own exclusive use”) (quoting *Weiss Noodle Co. v. Golden Cracknel & Specialty Co.*, 290 F.2d 845, 129 USPQ 411, 414 (CCPA 1961)). Respondent argues that the sophistication of the parties' respective customers renders confusion unlikely, especially among those who have a collective bargaining agreement with Petitioner, who “know when they must hire Local 2 members, and when they are free to hire freelance labor, even on ‘mixed jobs.’”⁸⁰ Respondent points out that the cost of labor may account for 10-12% of a production company's budget,⁸¹ suggesting that

⁸⁰ Respondent's brief at 46, 105 TTABVUE 47.

⁸¹ *Id.*

heightened care would be applied to the selection of services. However, Mr. Educate's testimony reveals him to be highly sophisticated in his field. (He testified that his company produces at least two to three shows a week in Chicago.) Yet his testimony persuades us that he was actually confused.

Upon consideration of all of the arguments and evidence of record, we find that confusion is likely to arise from the concurrent use of CHICAGO STAGEHANDS and CHICAGO STAGEHAND as source-indicating designations for the parties' respective services.

D. Respondent's defense of "unclean hands."

Respondent argues, in his brief, that "Local 2 brought this Petition to Cancel for anticompetitive purposes with little or no basis for a claim of senior use of the mark 'Chicago Stagehands' ..."; and that "Local 2's goal in the litigation is to snuff out all competitors, because its evidence of any use of the mark 'Chicago Stagehands' is close to non-existent."⁸² There is testimony that Craig Carlson, Petitioner's business manager, told Respondent that he would put Respondent out of business.⁸³

We do not agree that Petitioner had no basis for its claim. We have found merit in the contention that Petitioner and others have used CHICAGO STAGEHANDS in a descriptive manner to refer to Petitioner and its members, although we have not found a proprietary interest in Petitioner with respect to this term.

⁸² Respondent's brief at 48-49, 105 TTABVUE 49-50.

⁸³ Eaves disc. dep.207:6-7, 74 TTABVUE 221; Eaves test. 749:18-19, 99 TTABVUE 101.

Further, a business person's expressed desire to prevail over a competitor does not constitute the type of inequitable conduct that would form a basis for a defense of unclean hands. *See* 6 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 31:46 (4th ed., 2016 update). We also do not agree with Respondent's contention that Petitioner's institution of this proceeding constitutes an abuse of process that would support a defense of unclean hands. "The allegedly unfair or improper filing of a trademark infringement lawsuit cannot itself constitute a basis for an unclean hands defense to that lawsuit." *Id.* § 31:51 and cases cited therein. Accordingly, we find that Respondent has not established a defense of unclean hands against Petitioner's claim.

E. Proposed limitation of Respondent's registration.⁸⁴

Respondent asserted, as an affirmative defense, that likelihood of confusion would be obviated if the identified services in his Registration were limited to "Non Labor Union related employment Staffing in the field of (labor and technical support in live corporate, concert and special events" [*sic*].⁸⁵ We disagree. A number of witnesses that hire Petitioner's members testified that they also have occasion to hire non-unionized

⁸⁴ *See* 37 C.F.R. § 2.133(b) ("If, in an inter partes proceeding, the Trademark Trial and Appeal Board finds that a party whose application or registration is the subject of the proceeding is not entitled to registration in the absence of a specified restriction to the application or registration, the Board will allow the party time in which to file a motion that the application or registration be amended to conform to the findings of the Board, failing which judgment will be entered against the party.") *See also* TBMP § 311.02(b) ("At the same time, the applicant might plead alternatively that it actually uses its mark only on a specific type (identified in the pleading) of the goods covered by the broad identification in its application; that there is no likelihood of confusion with respect to applicant's actual goods; and that even if the Board ultimately finds that opposer is entitled to judgment with respect to applicant's goods as broadly identified, applicant would be entitled to a registration of its mark with a restricted identification reflecting the actual nature of its goods.")

⁸⁵ Amended Answer, Affirmative Defense Six, 13 TTABVUE 13.

workers or that, for other reasons, unionized and non-unionized workers are often present on a single job site. Mr. Educate, when asked how he decides whether to hire union or non-union workers, stated:

It depends on the venue and it depends on our client. Some of our clients are nonunion companies, some of our clients are nonunion but choose to use union no matter where they are, one being McDonald's Corporation. They're a nonunion company, but they demand that we use union stagehands. ... Some corporate clients are nonunion and they don't want to hear that you have union people on a show.⁸⁶

Floyd Dillman, when asked where his pool of laborers came from, answered:

I would say we predominantly crew with Union labor. ... We occasionally crew with freelance or non-Union personnel where necessary, especially for supervisory roles.⁸⁷

We do our best to respect our contract and use Local 2 wherever we can. In areas where it's simply not feasible, we try to give Local 2 as much of the job as possible, but realize that there is a lot of work we just can't turn down, and we use our non-Union labor where needed to meet the needs of our customers.⁸⁸

Louis Raizin testified that he hires workers from six or seven unions as well as non-union workers.⁸⁹ Craig Carlson testified that Petitioner competes with non-union providers of labor for certain jobs, and that he had solicited and gotten work from venues that previously used non-union crews. Among these were Union Station and certain Swank hotels (which were, according to Mr. Carlson, customers of

⁸⁶ Educate test. 600:23-601:8, 97 TTABVUE 28-29.

⁸⁷ Dillman test. 256:21-257:2, 93 TTABVUE 16-17.

⁸⁸ *Id.* 259:7-13; *see also id.* 259:17 and 315:17-316:4, 93 TTABVUE 19, 75-76.

⁸⁹ Raizin test. 493:7-20, 95 TTABVUE 10.

Respondent); Marriott Convention center in Schaumburg; Swisshotel; and The Drake hotel.⁹⁰ Respondent himself testified that “it was kind of public knowledge or industry knowledge that there would be Union crew and non-Union crew as part of the Lollapalooza build.”⁹¹

Under circumstances such as these, the fact that Petitioner’s members are unionized workers and Respondent’s workers are non-unionized is not a sufficient distinction to avoid confusion in the marketplace.

IV. Conclusion.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein. We find that Petitioner has demonstrated that it has used CHICAGO STAGEHANDS to refer to itself and that members of the public have used that term to refer to Petitioner prior to Respondent’s adoption and first use of the term CHICAGO STAGEHAND; and that the use of these designations by the parties as marks for their respective services is likely to cause confusion, mistake or deception. In accordance with *Books on Tape*, we find that cancellation of Respondent’s Registration on the Supplemental Register is warranted.

On the present record, neither party has demonstrated that it has a protectable proprietary interest in its designation; indeed, at present neither is capable of demonstrating substantially exclusive use of its designation even in its own geographic market. We emphasize that our determination in this case does not affect

⁹⁰ Carlson test. 378:14-380:3; 380:10-15. *See also id.* 381:3-4, 93 TTABVUE 138-140, 141.

⁹¹ Eaves disc. dep. 93:2-11, 74 TTABVUE 107.

either party's right to continue use of its designation; and it does not foreclose to either party the opportunity to demonstrate at another time and on a different record that its mark has in fact acquired distinctiveness, for the purpose of enforcing asserted service mark rights or obtaining registration on the Principal Register.

Decision: The petition for cancellation is granted.