Mailed: May 29, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

BD Hotels, LLC

v.

Michael D. Linczyc

Cancellation No. 92055278

Thomas W. Brooke of Holland & Knight LLP,
for BD Hotels, LLC

Matthew H. Swyers of The Trademark Company LLC,
for Michael D. Linczyc.

Before Quinn, Greenbaum and Gorowitz,
Administrative Trademark Judges.

Opinion by Greenbaum, Administrative Trademark Judge:

BD Hotels, LLC ("Petitioner") filed a petition for cancellation of a registration owned by Michael D. Linczyc ("Respondent") for the mark METRO-POD, in standard characters, for "providing hotel and restaurant services" in International Class 43.[1]

[1] Registration No. 3424090 issued on May 6, 2008; Section 8 declaration accepted.

The ground for cancellation is abandonment of the registered mark. In support of this claim, Petitioner alleges that Respondent has not used the METRO-POD mark for the services identified in Registration No. 3424090 for at least three consecutive years. As for standing, Petitioner asserts that it is the owner of Registration Nos. 3575140 and 3575141 for THE POD HOTEL ("hotel" disclaimed in each registration) for "hotel, bar and restaurant services," and "hotel concierge services," respectively, and that the continued registration of the mark METRO-POD will dilute and weaken Petitioner's mark THE POD HOTEL, and will adversely affect Petitioner's ability to protect its reputation and goodwill.

Respondent, in his answer, denied the salient allegations in the petition for cancellation.

I. Motion to Strike Reply Brief

As a preliminary matter, we consider Respondent's uncontested motion to strike Petitioner's reply brief as untimely. Pursuant to the January 29, 2015 Board order, which was issued at the parties' request, Petitioner's reply brief was due March 12, 2015. Petitioner filed its reply brief on March 18, 2015, six days late, with no explanation or accompanying motion to accept the late-filed brief. Accordingly, the motion is granted as conceded and as well-taken, and we have given no further consideration to Petitioner's reply brief. *See* Trademark Rules 2.127(a) and 2.128(a)(1).

II. The Record

The record includes the pleadings and, pursuant to Trademark Rule 2.122(b)(1), Respondent's registration file.

Petitioner submitted a notice of reliance on: TSDR printouts of Petitioner's pleaded registrations and Respondent's registration; several printouts of Respondent's metro-pod.com website; the Affidavit of Richard Born, managing member of Petitioner, with associated exhibits; Respondent's Petition to Revive and related filings; and the Declaration of Joanna Crosby, a paralegal working for the Holland & Knight law firm, with associated exhibits.[2]

There is no stipulation of record allowing for testimony by declaration or affidavit. Absent such a written agreement, testimony must be taken by deposition upon oral examination in accordance with Trademark Rule 2.123, 37 CFR § 2.123, or by deposition upon written questions in accordance with Trademark Rule 2.124, 37 CFR § 2.124. *See also* TBMP § 703 (2014). Although Respondent did not raise, or affirmatively waive, an objection to the Born Affidavit or the Crosby Declaration, Respondent's silence does not satisfy the Trademark Rule § 2.123 requirement of a "written agreement." Where parties improperly introduce or submit non-conforming evidence, such evidence "will not be considered even if the adverse party does not specifically object to it, as long as the adverse party does not specifically treat it as of record such that we can say it has been stipulated into the record." *Calypso*

[2] It was unnecessary for Petitioner to submit the printout of Respondent's registration and the Petition to Revive and related filings, as they are already of record. *See* Trademark Rule 2.122(b)(1).

Technology, Inc.. v. Calypso Capital Management, LP, 100 USPQ2d 1213, 1216 (TTAB 2011). *Cf. Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1425 n.8 (TTAB 1993) (objection waived where although there was no such agreement, plaintiff did not object to declarations with exhibits submitted by defendant *and* treated the evidence as if properly of record). Respondent did not refer to the affidavit or declaration in his brief. Accordingly, we may not and have not considered the Affidavit of Richard Born or the Declaration of Joanna Crosby. Nonetheless, the exhibits attached to each of the foregoing, which comprise Internet printouts with URLs and access/print dates, are appropriate matter for submission under notice of reliance, and we have considered them. *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1038 (TTAB 2010).

In addition, Petitioner introduced the testimonial depositions, with associated exhibits, of Respondent, and of Richard Born. Respondent submitted no testimony or evidence.

Both parties filed briefs. As discussed above, we have not considered Petitioner's reply brief.

III. Standing

To establish standing, Petitioner must show a real interest in the proceeding. *See Ritchie v. Simpson*, 170 F.2d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). Because Petitioner properly has made its pleaded registrations of record through both its notice of reliance and Mr. Born's testimony and accompanying exhibits, and further has shown, by its use and registration of marks that are at least arguably similar to

Respondent's mark that it is not a mere intermeddler, we find that Petitioner has established its standing to petition to cancel Respondent's registration for his mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). We also note that Respondent has not challenged Petitioner's standing to bring this proceeding.

IV. Abandonment

We now turn to the abandonment claim. "A registered trademark may be cancelled if it has been abandoned." *On-Line Careline, Inc. v. America Online, Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000), *citing* Section 14(3) of the Trademark Act, 15 U.S.C. § 1064(3). A mark shall be deemed abandoned under Section 45 of the Trademark Act, 15 U.S.C. § 1127:

> (1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie abandonment. "Use" of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in the mark.

Cf. Couture v. Playdom, Inc., 778 F.3d 1379, 113 USPQ2d 2042, 2043 (Fed. Cir. 2015) ("To apply for registration under Lanham Act § 1(a), a mark must be 'used in commerce.' 15 U.S.C. § 1051(a)(1). … Use in commerce must be 'as of the application filing date.' 37 CFR § 2.34(a)(1)(i)," and "The registration of a mark that does not meet the use [in commerce] requirement is void ab intio."), *citing Aycock*

Engineering Inc. v. Airflite Inc., 560 F.3d 1350, 90 USPQ2d 1301, 1305 (Fed. Cir. 2009).

Under Section 45 of the Trademark Act, prima facie abandonment is established by proof of nonuse for three consecutive years. To overcome that prima facie case, the respondent must come forth with evidence that it did not "discontinue" use of the mark, or if such use has been discontinued, the nonuse of the mark was without "an intent not to resume" use. *Imperial Tobacco Ltd. v. Phillip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390, 1393 (Fed. Cir. 1990).

As noted above, Respondent owns a registration for the mark METRO-POD for "providing hotel and restaurant services." Petitioner maintains that Respondent has not owned or operated any hotels or restaurants under the METRO-POD mark for at least three consecutive years, and, thus, Respondent's mark METRO-POD has not been in use in connection with "providing hotel and restaurant services" and has been abandoned. On the other hand, Respondent maintains that he provides hotel and restaurant services even though he does not own or operate a "brick and mortar" hotel or restaurant, because he owns the metro-pod.com website, through which he provides information and booking services for a third-party hotel and links to the booking sites for several other travel-related websites, and such services fall within the broad category of "providing hotel and restaurant services." It is Respondent's position that providing hotel services is a broad category that does not require actual provision of accommodation services.

Insofar as Respondent contends that the provision of accommodation services is not necessary to show that a party is rendering hotel services, such contention is not well-taken. We take judicial notice of the following relevant definition of the word "hotel" from dictionary.com (based on the Random House Dictionary (2015)):[3]

> **Hotel**: a commercial establishment offering lodging to travelers and sometimes to permanent residents, and often having restaurants, meeting rooms, stores, etc., that are available to the general public.

Based on this definition, we find that "providing hotel services" means providing a commercial establishment that offers lodging.

Similarly, we take judicial notice of the following relevant definition of the word "restaurant" from the same source:

> **Restaurant**: an establishment where meals are served to customers.

There is no dispute that Respondent has not used his mark METRO-POD in commerce in connection with operating any commercial "brick and mortar" establishment commonly known as a "hotel" or "restaurant" for at least three consecutive years. Respondent testified that METRO-POD is "a referral and reservation service to provide hotel accommodations,"[4] that he uses his mark METRO-POD in connection with his metro-pod.com website,[5] and that the website

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[3] The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

[4] 24 TTABVUE 70. Citations to the record or briefs in this opinion also include citations to the TTABVUE docket entry number, and the electronic page number where the document or argument appears. TTABVUE is the Board's electronic docketing system.

[5] *Id.* at 54.

provides a link to the on-line reservation system for the Westminster Hotel[6] (where Respondent formerly worked as the asset manager and the project and construction manager),[7] and to the booking sites for three third-party travel-related websites.[8] As for restaurant services, Respondent testified that "The Westminster Hotel has the Strip House Hotel which I developed. The opportunity to have access to information about the restaurants in the Westminster Hotel in that specific example."[9] We interpret this statement as an assertion that Respondent renders restaurant services because he provides information about restaurants in the Westminster Hotel.

Respondent contends in his brief that because "providing hotel and restaurant services" is an acceptable identification of services, albeit broadly worded, his more specific services of "providing and relaying information in connection with reservations and booking for temporary lodging … fall within the large umbra"[10] of the identified services, and therefore Respondent provides the identified "hotel and restaurant services." As support for this position, Respondent refers to 14 third-party registrations which are of record as exhibits to his testimony deposition.[11] According to Respondent, these registrations are evidence that services similar to the services he actually provides are properly categorized in International Class 43

[6] *Id*. at 69.

[7] *Id*. at 15.

[8] *Id*. at 40.

[9] *Id*. at 70-71.

[10] 31 TTABVUE 10-11.

[11] *Id*. at 8-11.

under the broader recitation of "hotel services."[12] However, these registrations are simply examples of other sufficiently accurate and definite identifications of services, and do not support a finding that "providing hotels and restaurant services," automatically or necessarily encompasses the services that Respondent actually provides.

The question is not whether "providing hotel and restaurant services" is an acceptable identification of services – it is. The question is whether the record supports a finding that Respondent provides hotel and restaurant services under the commonly understood definitions of those terms. The record does not support such a finding. As defined above, "providing hotel and restaurant services" means providing an establishment that offers accommodation (hotel) and an establishment that offers food (restaurant). Providing booking and information about a hotel, and providing links to third-party websites that locate hotels, are different services from "providing hotel and restaurant services." Respondent might provide the former under his mark METRO-POD, but he does not provide the latter and has not done so for at least three consecutive years.

In view of the foregoing, we find that Petitioner has established a prima facie case of abandonment, and that Respondent has failed to rebut this prima facie case. Because Respondent has not made use of the mark METRO-POD in connection with

[12] Registration No. 3919339 for EXPEDIA and Design is illustrative. The services identified therein are: "hotel and lodging services, namely, providing and relaying information and securing payment in connection with reservations and bookings for temporary lodging and providing reviews of hotels by means of a telephone, facsimile, the mails, courier or over electronic communication networks."

the services identified in his registration for a period of time lasting in excess of three years, Respondent has abandoned use of the mark for all of the services identified in his registration. Accordingly, pursuant to 15 U.S.C. §§ 1064 and 1127, Registration No. 3424090 shall be cancelled in its entirety on the ground of abandonment.

Decision: The petition for cancellation is granted. Registration No. 3424090 will be cancelled in due course.