

THIS OPINION
IS NOT A
PRECEDENT
OF THE T.T.A.B.

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

DUNN

Mailed: September 30, 2014

Opposition No. 91203884

Ennis, Inc.

v.

*Joel L. Beling d/b/a Supa
Characters Pty Ltd*

Cancellation No. 92055374

*Joel L. Beling d/b/a Supa
Characters Pty Ltd*

v.

Ennis, Inc.

Before Cataldo, Bergsman and Adlin, Administrative Trademark Judges:

By the Board:

This case comes up on cross motions for summary judgment in Cancellation No. 92055374, which the Board has treated as a counterclaim to cancel Registration No. 3372884, pleaded in Opposition No. 91203884. The motions are contested.

Both parties attempted to circumvent the Board's page limits on motions by filing separate motions for summary judgment in the opposition and cancellation,

which is impermissible in consolidated proceedings. However, the filing in the opposition by Ennis, Inc. (hereafter, Ennis) was not apparent when the suspension order issued, and was only found later. On March 19, 2014, the Board suspended this consolidated proceeding pending the disposition of Ennis' motion for summary judgment on the claims brought in Cancellation No. 92055374. On May 27, 2014, the Board noted that Joel L. Beling d/b/a Supa Characters Pty Ltd (hereafter, Beling) filed separate cross-motions for summary judgment for the cancellation and the opposition which exceeded the Board's page limits. The Board ordered Beling to refile a single response and cross-motion. Ennis filed a reply brief only for the cancellation. Accordingly, as stated in the May 27, 2014 suspension order, the Board will address only the motion and cross-motion for summary judgment in Cancellation No. 92055374, which has been fully briefed.

Beling moves for an augmented panel hearing in view of the "exceptional importance of the claims to be decided by the Board." Since early in this proceeding, Beling has sought exceptional treatment from the Board, urging the Board to ignore current law and applicable rules to adopt Beling's legal theories and to accept his view of appropriate argument and evidence. Beling's list of issues warranting augmented panel consideration involves more of the same.

An augmented panel is used by the Board only in extraordinary cases, involving precedent-setting issues of exceptional importance, or when consideration by an augmented panel is necessary to secure or maintain uniformity of Board decisions. *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223

USPQ 909, 909 n.1 (TTAB 1984); Trademark Trial and Appeal Board Manual of Procedure (TBMP) §540 (2014). Here, Ennis pleads likelihood of confusion with its pleaded registration in the opposition to Beling’s application, and Beling brought this cancellation against Ennis’ registration pleading that the registration was fraudulently procured and generic, merely descriptive, incapable of functioning as a trademark, and unregistrable without a disclaimer. These claims are hardly exceptional at the Board, but rather are quite common. The present summary judgment motions involve the common question of whether trial is necessary, because discovery has closed and it is alleged that the party with the burden of proof will be unable to prove his claims. Notwithstanding the several claims in the cancellation, there is not a great deal of evidence of record, and none presents novel issues of any kind. Accordingly, Beling’s motion for an augmented panel hearing is DENIED. *See Fioravanti v. Fioravanti Corrado S.R.L.*, 1 USPQ2d 1304, 1305 (TTAB 1986) (case not appropriate for designation of more than three-member panel).

On January 22, 2008, Registration No. 3372884 issued to Ennis, Inc. (hereafter, Ennis) for the mark shown below for “printing services.”



Pursuant to the second amended petition to cancel filed July 27, 2012, Petitioner Joel L. Beling d/b/a Supa Characters Pty Ltd (hereafter, Beling), seeks to cancel the registration alleging that (i) the mark is generic, or registrable only with a

disclaimer of the literal element, (ii) the mark is merely descriptive or registrable only with a disclaimer of the literal element, (iii) the mark is incapable of functioning as a trademark as applied to Ennis' services and/or is unregistrable without a disclaimer of the literal element, and (iv) the registration was obtained by fraudulent statements regarding Ennis' exclusive right to use the mark COLORWORX and design. Ennis filed an answer denying the salient allegations of the petition to cancel. Discovery closed January 10, 2014, except the Board approved certain depositions for which notices were served within the discovery period to take place outside the discovery period.

Before turning to the merits of the motions for summary judgment, we address Beling's motion to exclude as an estoppel sanction much of the evidence which Ennis submitted in support of its motion for summary judgment. Under the estoppel sanction, a party that fails to provide information requested during discovery may, upon motion or objection by its adversary, be precluded from using that information or witness at trial, unless the failure was substantially justified or is harmless. Fed. R. Civ. P. 37(c)(1); *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1757 (TTAB 2013). Ennis' motion for summary judgment asserts that trial is unnecessary because Beling cannot prove his claims for cancellation of Ennis' Registration No. 3372884. In support of the motion Ennis submits its own application file from USPTO records, the affidavit of Steven Osterloh, Ennis' Vice President of Marketing, and information obtained from Beling during this proceeding. Beling contends that "Ennis is estopped from adducing the

above evidence because it has objected to responding to discovery requests seeking such information.”

To be clear, by operation of Trademark Rule 2.122(b)(1), Ennis’ involved trademark registration and its underlying application is automatically part of the record and Beling has custody of the information Ennis obtained from Beling. Thus, the only information at issue is that in the Osterloh affidavit. Beling conducted his own deposition of Steven Osterloh on January 13, 2014, and submits the deposition in support of his cross-motion for summary judgment. On March 8, 2014, the Board denied Beling’s motion to compel Osterloh’s responses to deposition questions on the ground, among others, that there was nothing to compel because the witness plainly answered each question which was put to him. We have compared Ennis’ discovery responses and the Osterloh deposition with the Osterloh affidavit, and find no inconsistency which would support a finding that Ennis now relies on evidence which was improperly withheld from Beling during discovery. Accordingly, Beling’s motion to exclude the Osterloh affidavit is DENIED.

Turning to the merits, Beling seeks to cancel Ennis’ registered mark



for printing services based on fraud and because, under several legal theories, the relevant purchasing public will not perceive the mark as an indicator of source.

Ennis moves for entry of summary judgment in its favor in the cancellation because Beling cannot prove his claims, making trial unnecessary.

In support of its motion for summary judgment, Ennis submitted the following evidence:

- a TESS status and title copy of subject Registration No. 3372884 (Ex. A);
- a TESS copy of Ennis' application Serial No. 78698743 filed August 23, 2005, which issued as subject Registration No. 3372884 (Ex. B);
- the Osterloh affidavit (Exhibit C);
- Beling's December 11, 2013 responses to discovery requests (interrogatories, document requests, and requests for admissions) in which Beling was asked to "identify all facts, information, or materials that provide any evidence" regarding the various pleaded claims, and in response to which Beling uniformly failed to identify any specific fact or document, but referred generally to "documents already produced" (Ex. D, E, and F)¹;
- webpages for COLORWORKS digital retouching services in New York and COLORWORX printing services in Canada, third party uses cited by Beling in the second amended petition to cancel (Ex. G and H); and
- copies of the office action and Ennis' response issued during examination of its application, which ultimately issued as Registration No. 3372884 (Ex. I and J).

In its motion, Ennis discusses Beling's exhibits to the second amended petition to cancel, namely TESS printouts of five third party registrations for COLORWORKS or COLOR WORKS marks, which Beling offered as evidence that,

¹ Beling essentially provided the same discovery response in each instance:

Apart from the above objections, the Applicant refers the opposer to the documents already produced to it, as well as the documents attached hereto; to the evidence, arguments, laws, Marks, companies (and associated websites of such companies, to which the opposer has equal access) in the applicant/petitioner's second amended petition to cancel; to all of the opposer's responses and lack of candid and complete and to the applicant's discovery requests; to current trademark laws on generic marks of which the opposer has a better understanding than the applicant.

on August 23, 2005 when Ennis filed the application which ultimately issued as Registration No. 3372884, Ennis knew it did not have exclusive right to use its COLORWORX and design mark on printing services.² Ennis points out that these registrations are for products and services so different than those for which the involved mark is registered that they are irrelevant.

COLORWORKS	Reg. No. 2000638	cosmetics, namely lipstick, eyeshadow, blush, foundation, eyeliner, mascara, lip liner
COLORWORKS	Reg. No. 2313535	sheet vinyl and vinyl tile flooring
COLOR WORKS (COLOR disclaimed)	Reg. No. 2476288	paint color cards
COLORWORKS	Reg. No. 2615133	Apparatus, machines, and machine tools, all for handling and working paper, boards and books, namely, machines for folding, binding, collating, cutting, stitching, spine taping, jogging and drafting paper, boards and books; and replacement parts for the aforementioned apparatus, machines, and machine tools
COLORWORKS	Reg. No. 2783206	Design and technical consultation services in the area of plastics coloration; technical consultation on color management in the area of plastics and development of standard color criteria for manufacturers of plastic products; technical consultation on application of color concentrates and performance enhancing chemicals in the area of plastics coloration; technical and scientific

² Also attached to the second amended petition to cancel, and discussed in Ennis' motion, were TESS printouts for third party COLORWORKS applications and registrations which, at the time Ennis filed its application, were abandoned (application Serial Nos. 75595803, 75617896, 75463213, and 75224752), cancelled (Registration Nos. 2524890, 2453770, 2451486, 2103537, 2115953, 2210089, and 2349187), or had not yet been filed (Registration Nos. 3632494 and 4248262).

		consultation and research services in the fields of chemistry and color concentrates; consultation services in the area of color matching of plastics to standards and custom color formulations
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In support of his opposition to Ennis' motion for summary judgment and in support of his cross-motion for summary judgment, Beling submits the following evidence:³

- January 13, 2014 Osterloh deposition (TTABVUE #91, p. 2-96);
- Ennis' discovery responses in lieu of deposition signed January 12, 2014 and January 13, 2014 (TTABVUE #91, p. 97-104);
- June 2, 2014 confidential declaration of Joel Beling describing his character licensing company (TTABVUE #91, p. 106-119);
- Undated Australian business register listing for Supa Characters Pty., Ltd.; (TTABVUE #91, p. 120-124);
- August 12, 2012 press release by Beling with description of "current litigation" referring to this opposition. (TTABVUE #91, p. 125-127);
- May 9, 2013 press release, same text as August 12, 2012 (TTABVUE #91, p. 128-130);
- Undated Beling's description of characters available for licensing (TTABVUE #91, p. 132-403);
- TESS copies of Beling's applications Serial Nos. 85324453 and 85324457 (TTABVUE #91, p. 405-408);
- Beling's June 2012 discovery and settlement correspondence with Ennis (TTABVUE #91, p.410-412);⁴

³ Beling submitted his evidence under seal. In view thereof, the Board describes that portion of the evidence containing truly confidential material in general terms.

⁴ Pursuant to Federal Rule of Evidence 408, which prohibits the use of settlement negotiations to prove or disprove a disputed claim, we sustain Ennis' objection to Beling's submission of its June 25, 2012 settlement offer as evidence that Ennis' mark is unregistrable. *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1834 (TTAB 2012). The settlement offer has not been considered.

- July 1, 2014 Webpage printout for COLORWORKS photography services in New York (TTABVUE #91, p. 414-415);
- July 1, 2014 Webpage printout for COLORWORX printing services in Canada (TTABVUE #91, p. 417-428);
- July 1, 2014 Webpage printout for COLORWORKS printing services in Pennsylvania (TTABVUE #91, p. 430-435);
- January 1, 2014 Webpage printout for Opposer's COLORWORX services (TTABVUE #91, p. 438-441);
- January 8, 2014 Webpage printout for ILOVETOCREATE COLORWORKS program for classroom projects and lesson plans in California (TTABVUE #91, p. 443- 445);
- July 1, 2014 Webpage printout for COLORWORKS Folders4Success in Ohio (TTABVUE #91, p. 447- 450);
- July 1, 2014 Webpage printout for smartpress.com featuring cross hairs design (TTABVUE #91, p. 452- 455);
- July 1, 2014 Webpage printout for Four Color Print Group book printing services featuring cross hairs design (TTABVUE #92, p. 3-5);
- January 8, 2014 Webpage printout for SPECTRUM Color printing and mailing featuring cross hairs design (TTABVUE #92, p. 7-9);
- January 5-7, 2014 Beling's email correspondence (TTABVUE #92, p. 11- 17);⁵
- TESS copy of Registration No. 23491867, issued May 16, 2006 and cancelled December 17, 2010 for COLORWORKS for "computer generated color prints" (TTABVUE #94, p. 28-30).
- TESS copy of Application Serial No. 75463213, filed April 6, 1998 and abandoned December 23, 2000 for COLOR WORKS for "ophthalmic preparations" (TTABVUE #94, p. 31-32);

⁵ Inasmuch as Beling's declaration avers that the email exchanges took place, and Ennis does not dispute the accuracy of the email message sent to Ennis, we overrule Ennis' objection that these email messages are inadmissible as "manufactured evidence."

- TESS copy of Application Serial No. 75595803, filed November 25, 1998 and abandoned June 29, 2000 for COLORWORX for “hair salon services” (TTABVUE #94, p. 33-34);
- TESS copy of Application Serial No. 76052896, filed May 22, 2000 and abandoned February 16, 2003 for COLORWORKS for “instructional book, namely a color guide for children” (TTABVUE #94, p. 35-36);
- TESS copy of Registration No. 85227723, filed January 27, 2011 and issued November 27, 2012 for COLORWORKS for “downloadable lessons and instruction videos featuring educational ceramic art projects, for educators and students in kindergarten through grade 12” and “providing a website featuring on-line publications, namely, on-line non-downloadable lessons featuring educational ceramic art projects, for educators and students in kindergarten through grade 12; providing a website featuring on-line non-downloadable instructional videos in the field of educational ceramic art projects for educators and students in kindergarten through grade 12 (TTABVUE #94, p. 37-39);
- Beling incorporates by reference Ennis’ discovery responses (TTABVUE #26) and Beling’s request for reconsideration of the Board’s November 12, 2013 order (TTABVUE #41) (TTABVUE #94, p. 41).
- *United States Patent and Trademark Office’s Report to Congress: Trademark Litigation Tactics and Federal Government Services to Protect Trademarks and Prevent Counterfeiting* (April 2011) (TTABVUE #94, p. 42-75); and
- June 2, 2014 ESTTA filing receipt issued to Beling (TTABVUE #94, p. 81-99).

DISCUSSION

Summary judgment is appropriate when there is no genuine dispute as to any material fact and the moving party is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(a). A party moving for summary judgment has the initial burden of demonstrating the absence of evidence to support the nonmoving party’s case, and that it is entitled to judgment as a matter of law. *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548, 2554 (1986). Therefore, although there are cross-

motions for summary judgment, the moving party in each of the pending motions has the burden as to its own motion.

When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine dispute of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of disputes of material fact which must be resolved at trial. *See* Fed. R. Civ. P. 56(e); *Novartis Corp. v. Ben Venue Laboratories, Inc.*, 271 F.3d 1043, 60 USPQ2d 1836, 1838 (Fed. Cir. 2001). One purpose of the summary judgment rule “is to isolate and dispose of factually unsupported claims.” *Celotex v. Catrett*, 477 U.S. at 323. The nonmoving party may not rest upon the mere allegations or denials of its pleading, but must proffer countering evidence sufficient to create a genuine factual dispute for trial. *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1795 (Fed. Cir. 1987). The nonmovant is not entitled to a trial on the basis of a mere hope that he can produce some evidence at that time. Wright, Miller & Kane, 10A FED. PRAC. & PRO. CIV. § 2727 (2014).

STANDING

As noted above, we treat Beling as a counterclaimant. A counterclaimant's standing to cancel a pleaded registration is inherent in its position as defendant in the original proceeding. *Finanz St. Honore B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1479 (TTAB 2007). Ennis's standing is established by its registration. *Cunningham v. Laser Golf Corp.*, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

CROSS-MOTIONS FOR SUMMARY JUDGMENT ON THE FRAUD CLAIM

Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application. *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986). Absent the requisite intent to mislead the PTO, even a material misrepresentation would not qualify as fraud under the Lanham Act warranting cancellation. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009). A trademark applicant has no duty to investigate potential conflicting uses that might be found through a trademark search, and therefore there is no duty to investigate specific information such as when a third party may have started using a mark. *Maids to Order of Ohio Inc. v. Maid-to-Order Inc.*, 78 USPQ2d 1899, 1909 (TTAB 2006).

Ennis seeks entry of summary judgment because there is no genuine dispute of material fact regarding Beling's claim that Ennis's Registration No. 3372884 was obtained by fraudulent statements regarding Ennis' exclusive right to use the mark, and Ennis is entitled to judgment as a matter of law. In support of the motion Ennis submits Beling's discovery responses indicating that Beling has produced all evidence relevant to the claim. In opposition to Ennis' motion for summary judgment and in support of his cross-motion for summary judgment on the fraud claim, Beling argues that Ennis made the fraudulent misrepresentation in its trademark application that no other party had superior rights to the mark, and that the fraud is demonstrated by third party uses of marks including a cross hair design

or the terms COLORWORKS or COLORWORX as shown in webpage printouts dated July 1, 2014 or in USPTO records available to Ennis August 23, 2005 when it filed its application; and Beling's self-styled "smoking gun" evidence regarding Ennis' creation and adoption of its mark. Although not well-articulated, Beling's contention is that circumstances surrounding the 2002 adoption and creation of Ennis' mark demonstrate that Ennis was committing fraud in 2005 when it filed the application averring that it knew of no one with superior rights to the mark. Among those circumstances was Ennis' inability to identify the individuals from its now defunct subsidiary who coined the literal portion of the mark prior to 2002; Osterloh's testimony that in 2002 when Ennis decided to create a new mark by combining the literal term already in use by a subsidiary with a design component, Osterloh did not recall conducting a trademark search or being aware of third party uses; and alleged inconsistencies between Ennis' discovery responses and deposition testimony. Our review of Ennis' discovery responses and deposition plainly shows that the different answers were produced as a result of Beling asking different questions.

After careful review of the record, we find that Ennis has met its burden in establishing the absence of any genuine disputes of material fact that its registration was not fraudulently obtained. In determining whether an applicant, when he signed his application oath, held an honest, good faith belief that he was entitled to registration of his mark, the Board has stated that "if the other person's rights in the mark, vis-à-vis the applicant's rights are not known by applicant to be

superior or clearly established, e.g., *by court decree or prior agreement of the parties*, then the applicant has a reasonable basis for believing that no one else has the right to use the mark in commerce, and that applicant's averment of that reasonable belief in its application declaration or oath is not fraudulent.” *Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203, 1207 (TTAB 1997) (*emphasis supplied*). The evidence submitted by Ennis, namely the documents regarding its application filed August 25, 2005, Osterloh’s affidavit, and Beling’s discovery responses and third party uses, indicate that Beling has no evidence to support his claim that Ennis committed fraud in connection with its application which issued as Registration No. 3372884.

Beling failed to introduce any evidence to establish a genuine dispute of fact because his evidentiary showing is irrelevant to the fraud claim and has no probative value. Beling made no effort to restrict his evidence to relevant times. That is, Beling cited third party uses of a cross hair design or the term COLORWORKS for printing services found online on July 1, 2014 as evidence that Ennis committed fraud in its application filed in 2005. Information available online on July 1, 2014 is not proof that the same information was available in 2005 when Ennis filed its application for the mark, much less that Ennis was aware of the information and that by court decree or prior agreement Ennis knew its representations to the Office to be intentionally false. In addition, Beling cited third party applications and registrations for the term COLORWORKS as evidence that Ennis committed fraud, but the majority of the cited marks had been abandoned or

cancelled, or had not yet been filed, in 2005 when Ennis filed its application for the mark. USPTO records showing that third parties no longer sought to register a COLORWORKS mark, or to maintain a COLORWORKS registration, are not proof that Ennis knew of superior third party rights to a similar mark. Beling made no effort to meet the relevant standard for demonstrating that a third party had superior rights to Ennis for the purposes of fraud, that is, rights which were clearly established by a court degree or prior agreement of the parties. More importantly, Beling has not shown that even if any third party had superior rights (and there is no evidence that any third party does), Ennis was aware of the rights *and knew them to be superior*.

We have carefully considered Ennis' discovery responses and the deposition testimony of Steven Osterloh, and find absolutely no merit to Beling's contentions that Ennis applied to register his mark with knowledge of third party uses, and the belief that the third party or parties had superior rights.

Accordingly, Ennis' motion for summary judgment on the claim that Ennis's Registration No. 3372884 was obtained fraudulently is GRANTED, and Beling's cross-motion for summary judgment on the claim is DENIED.

CROSS-MOTIONS FOR SUMMARY JUDGMENT ON THE CLAIMS THAT REGISTRATION NO. 3372884 MUST BE CANCELLED IN ITS ENTIRETY BECAUSE THE MARK IS GENERIC, MERELY DESCRIPTIVE, OR INCAPABLE OF FUNCTIONING AS A TRADEMARK



Ennis seeks entry of summary judgment because there is no genuine dispute of material fact that Ennis’s mark is generic, merely descriptive, or incapable of functioning as a trademark when used in connection with printing services. Beling’s discovery responses make clear that Beling can produce no facts in support of these claims. While Beling argues that his claims are established by "third party uses of ... the cross-hairs logo”, citing three webpage printouts dated July 1, 2014 showing that three different printing companies use cross hair designs in their marks, Beling does not contend, much less establish, that these logos are the mark at issue. At most they are similar to a component of the mark at issue. Furthermore, the uses below are trademark uses, and not uses which indicate that the design element is generic, descriptive or incapable of functioning as a trademark when used in connection with printing services.

Logo for smartpress.com (TTABVUE #91, p. 452-455)	Logo for Four Color Print Group services (TTABVUE #92, p. 3-5)	Logo for SPECTRUM Color services (TTABVUE #92, p. 7-9)
		

After careful review of the record, we therefore find that Ennis has met its burden of establishing the absence of any genuine disputes of material fact, and that the mark is not generic, merely descriptive, or incapable of functioning as a trademark when used in connection with printing services. The evidence submitted by Ennis, namely Beling’s discovery responses, indicates that Beling has no

evidence to support his claims. Beling's motion and response to Ennis's motion include no proof that Ennis' mark is generic, merely descriptive or incapable of functioning as a trademark and, thus, Beling failed to raise any genuine disputes of material fact.

Accordingly, Ennis' motion for summary judgment on the claims that Registration No. 3372884 must be cancelled in its entirety because the mark is generic, merely descriptive, or incapable of functioning as a trademark is GRANTED, and Beling's cross-motion for summary judgment on the claim is DENIED.

CROSS MOTIONS FOR SUMMARY JUDGMENT ON THE ON THE CLAIMS THAT THE MARK IS ONLY REGISTRABLE WITH A DISCLAIMER OF THE TERM COLORWORX BECAUSE IT IS GENERIC, MERELY DESCRIPTIVE, OR INCAPABLE OF FUNCTIONING AS A TRADEMARK



Any ground which could have barred registration in the first place may be a ground for cancellation of registrations less than five years old. *Kellogg Co. v. Pack'Em Enterprises, Inc.*, 14 USPQ2d 1545, 1548-49 (TTAB 1990). Pursuant to Trademark Act Sec. 18, a registration less than five years old may be cancelled on the ground that an undisclaimed portion of the mark is generic or merely descriptive of the identified goods or services, and that the mark should not be registered without a disclaimer of that portion. *Montecash LLC v. Anzar Enterprises Inc.*, 95 USPQ2d 1060, 1064 (TTAB 2010). If a mark is comprised in part of matter

that, as applied to services, does not function as a mark, the matter must be disclaimed to permit registration on the Principal Register. Trademark Manual of Examining Procedure (“TMEP”) §1213.03(b) (2014).

The test for determining whether a mark is generic involves a two-step inquiry. First, what is the genus (category or class) 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 (category or class) of goods or services? *Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Here, there is no dispute that the genus of the services at issue are printing services, so determination of the genericness claim turns on whether the term COLORWORX, or its phonetic equivalent COLORWORKS, is understood by the relevant public to refer to printing services.

A mark is merely descriptive “if it immediately conveys knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.” *Coach Services Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713, 1728 (Fed. Cir. 2012). Descriptiveness must be evaluated “in relation to the particular goods for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use.” *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963 (Fed. Cir. 2007).

Unregistrable marks include certain designations that are inherently incapable of functioning as trademarks to identify and distinguish the source of the

products in connection with which they are used. *American Velcro, Inc. v. Charles Mayer Studios, Inc.*, 177 USPQ 149, 154 (TTAB 1973). The critical inquiry in determining whether a term functions as a trademark or service mark is how the proposed mark would be perceived by the relevant public. *In re Eagle Crest, Inc.* 96 USPQ 2d 1227, 1229-30 (TTAB 2010).

Ennis seeks entry of summary judgment because there is no genuine dispute of material fact regarding Beling's claim that the term COLORWORX as a component of Ennis' mark is generic, merely descriptive, or incapable of functioning as a trademark for printing services, and therefore must be disclaimed. As with the other claims, Beling's discovery responses indicate that Beling can produce no evidence in support of these claims. Beling responds that his claims are proven by dictionary definitions⁶, Ennis' admissions in its discovery responses, third party

⁶ Inasmuch as neither party submitted a dictionary definition with its evidence, the Board takes judicial notice of the following dictionary definitions :

col·or

noun, often attributive \ 'kə-lər \

: a quality such as red, blue, green, yellow, etc., that you see when you look at something

: something used to give color to something : a pigment or dye

: the use or combination of colors

¹work

noun \ 'wərk \

: a job or activity that you do regularly especially in order to earn money

: the place where you do your job

: the things that you do especially as part of your job

4

a: a fortified structure (as a fort, earthen barricade, or trench)

bplural: structures in engineering (as docks, bridges, or embankments) or mining (as shafts or tunnels)

5

plural but sing or plural in constr: a place where industrial labor is carried on : plant, factory

uses, and Ennis' failure to object to Beling's use of the phrase "color works" in an email message sent from Beling (emphasis added):

From: Joel Beling [mailto:joelbeling@hotmail.com]

Sent: Sunday, January 05, 2014 4:12 PM

To: colorworx

Subject: Product Inquiry/Quote

Hi guys,

I'm a small business owner and was just wanting to order some color works, such as business cards, envelopes and "with compliments" slips. I need about 1000 business cards, 500 envelopes and 500 "with compliments" slips; no works of color, just black and white. Can you give me a quote, please?

Cheers,

Joel

(TTABVUE #92, p. 11). It is not necessary to reproduce the entire exchange, because there is no recurrence of, or reference to, the phrases "color works" or "works of color" by Ennis, or any person or entity other than Beling, an interested party in this proceeding whose "gotcha" e-mail proves nothing other than that Beling tried to manufacture evidence to use for his own benefit. Beling's own use of the term is not evidence of how the relevant public, consisting of prospective customers for printing services, perceives the term COLORWORX, or the phonetic equivalent, COLORWORKS. Beling's view on the subject has been clear for the

6

plural: the working or moving parts of a mechanism <the works of a clock>

11

plural

a: everything possessed, available, or belonging <the whole works, rod, reel, tackle box, went overboard> <ordered pizza with the works>

b: subjection to drastic treatment : all possible abuse —usually used with get <get the works> or give <gave them the works>

Merriam-Webster.com. Merriam-Webster, n.d. Web. 29 Sept. 2014. <<http://www.merriam-webster.com/dictionary/work>>.

See *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); and TBMP §704.12(a).

duration of these proceedings, but the relevant public's understanding is the only issue.

We have carefully reviewed Ennis' responses to Beling's requests for admission and disagree that any pertinent admissions were made. There is no dispute that the terms COLOR and WORK or WORKS have dictionary definitions, and that WORX is the phonetic equivalent of WORKS, but there is no evidence, much less any admissions regarding the pertinent point, which is the relevant public's perception of the compound term COLORWORX. Ennis's responses to Beling's requests for admission, as well as its other discovery responses, steadfastly maintain that the term COLORWORX, and its phonetic equivalent COLORWORKS, is a source indicator for its printing services, and has no meaning which is generic, merely descriptive, or incapable of functioning as a trademark for printing services. *Compare In re Gould Paper Corp.*, 5 USPQ2d 1110 (Fed. Cir. 1987) ("Gould's own submissions provided the most damaging evidence that its alleged mark is generic and would be perceived by the purchasing public as merely a common name for its goods rather than a mark identifying the good's source. On its own specimen supporting the application, Gould advises: "a . . . wipe . . . for . . . screens." Whether compounded as "screen wipe" -- two words -- or "screenwipe" -- one word -- either is ordinary grammatical construction. . . . Nothing is left for speculation or conjecture in the alleged trademark.").

Finally, Beling's evidence of third party trademark uses of the terms COLORWORKS and COLORWORX is not probative of consumer recognition of

either term as possessing meaning which is generic, merely descriptive, or incapable of functioning as a trademark for printing services. *Nobelle.com LLC v. Qwest Communications International Inc.*, 66 USPQ2d 1300 (TTAB 2003) (“We see no legal or logical basis for finding that trademark or service mark use of a designation by competitors is probative evidence, under the second part of the *Ginn* test, that the relevant public regards the designation as being generic.”). While there are many deficiencies as to the form of Beling’s evidence of third party use, we have considered it carefully and find that in each business webpage, and each trademark application or registration, each third party uses the term COLORWORKS or COLORWORX as a source indicator, or a trademark, and no third party refers to “color works” as having any direct meaning as applied to printing services.

After careful review of the record, we find that Ennis has met its burden in establishing the absence of any genuine disputes of material fact that the term COLORWORX is generic, merely descriptive, or incapable of functioning as a trademark for printing services, and must be disclaimed. The evidence submitted by Ennis indicates that Beling has no evidence to support his claim that the term COLORWORX is generic, merely descriptive, or incapable of functioning as a trademark for printing services, and must be disclaimed, and because Beling’s evidentiary submissions are entitled, as described above, to little or no probative value, Beling did not rebut this evidence.

After careful review of the record, in view of the complete absence of evidence showing any public perception of the compound term COLORWORX (or even its

phonetic equivalent COLORWORKS), we cannot find that the term identifies the genus of the printing services, immediately conveys merely descriptive information about the printing services or is incapable of functioning as a mark for printing services.

Accordingly, Ennis' motion for summary judgment on the claim that the term COLORWORX is generic, merely descriptive, or incapable of functioning as a trademark for printing services, and must be disclaimed, is GRANTED, and Beling's cross-motion for summary judgment on the claim is DENIED.

REVIEW OF INTERLOCUTORY ORDERS

The Board panel to which the case is assigned for decision may review an interlocutory ruling and reverse it, if appropriate. *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1832 (TTAB 2013). Beling's opposition and cross motion for summary judgment devotes several pages (p. 5-14) to the argument that based on trademark bullying, abusive litigation practices, and actions taken by Ennis in bad faith, judgment should be entered for Beling. The Board construes these arguments as a request for review of the interlocutory orders rejecting Beling's contentions made in various motions that Ennis engaged in trademark bullying, abusive litigation practices and acted in bad faith.

Our review of the proceeding file and the interlocutory orders issued by the Board demonstrates no error. The only basis for Beling's allegation of trademark bullying is his disagreement with Ennis' decision to bring the opposition against his application. Beling's claims have been given an exceedingly generous construction

and allowed to go forward despite practices which would ordinarily result in dismissal or sanctions. Moreover, notwithstanding his protestations that he abhors the expense and delay of this proceeding, the record shows that Beling has rejected settlement offers which would allow the parties to co-exist, treating these offers not only with disdain but as admissions of bad faith. Indeed, rather than end the alleged trademark bullying, Beling has issued press releases, and introduced them as evidence in this proceeding, boasting that he is “involved in hostile trademark litigation with a number of major players in the entertainment industry and American business at large.”

The Board will not reprise all of its efforts to contain Beling’s disdain for the Board’s rules but provides the following excerpts from Board orders issued on the dates listed:

July 13, 2012

With respect to the references in the petition to cancel to information located on web pages, the Board advises Mr. Beling that the Board will not seek evidence by visiting listed websites.

May 15, 2013

Mr. Beling is advised that the Board has jurisdiction over the issue of registrability only. Allegations of attorney misconduct in other proceedings is irrelevant to the Board’s determination here. Mr. Beling may not allege attorney misconduct in this proceeding except in support of a motion for Fed. R. Civ. P. 11 sanctions. If Mr. Beling makes allegations of attorney misconduct in other papers filed with the Board, the Board will cease consideration of that paper.

...

In addition to the previous Board orders barring Mr. Beling from duplicative, piecemeal, and unorganized filings, Mr. Beling now also is barred from filing any motion or response which exceeds the Board’s page limits; is barred from filing motions to exceed page limits; is barred from seeking to amend the petition to cancel; and is barred

from alleging attorney misconduct in this proceeding except in support of a motion for Fed. R. Civ. P. 11 sanctions.

November 12, 2013

The Board's review of the original and modified discovery requests and responses relating to the motion to compel demonstrates that the perceived deficiency in opposer's responses to disputed Interrogatory Nos. 4, 9, 10, 13, 14, 15, 16, 17, and 19 comprise no more than applicant's wish for a different answer, applicant's wish that it had asked a different question, or applicant's impertinent suggestion that the fraudulent actions of opposer warrant the Board compelling the production of privileged information. Moreover, applicant's proposed new document requests involve more requests regarding opposer's use of its mark on "works of color", which are irrelevant to the pleaded issues regarding opposer's use of its mark in connection with printing services. Applicant has abused the discovery process and is barred from serving further written discovery or filing further motions to compel regarding written discovery.

December 20, 2013

At the outset, it is noted that it would be overly burdensome to address in detail each of Mr. Beling's numerous and scattershot allegations of error, many of which bear no relationship to--or are a gross distortion of-- applicable legal principles, in this order. Each of the allegations has been carefully considered and found wanting. The following discussion addresses most of his major allegations and is believed sufficiently illustrative of the nature of all his allegations that further discussion is unnecessary. ...

With respect to the restriction of discovery and motions to compel, the Board's November 12, 2013 order set forth the relevant chronology of discovery in the proceeding, including issuance of the Board's prior orders addressing Mr. Beling's conduct. Inasmuch as the parties are presumed to be familiar with the Board's orders, the substance of the Board's prior orders was not repeated. The prior orders detail Mr. Beling's allegations that opposer's mark is COLORWORX instead of COLORWORX and design, his rambling, improper, and irrelevant allegations; his unorganized, incomplete and/or irrelevant filings, his baseless allegations of attorney misconduct; his failure to follow the Board's rules, and his failure to comply with the Board's orders.

December 23, 2013

Inasmuch as Mr. Beling has been previously advised that such communications are inappropriate, the Board will give no

consideration to email communications. In addition, the Board will give no consideration to filings from Mr. Beling addressing prior orders of the Board, or requests to suspend proceedings pending his appeal of prior orders.

January 7, 2014

Mr. Beling's motion to extend discovery ignores his past abuse of the discovery process, detailed in the Board's November 12, 2013 order restricting his ability to serve written discovery and the Board's December 20, 2013 order denying his request for reconsideration of that order, and in essence seeks to start over with a new six month discovery period to be devoted to depositions. The record provides no facts demonstrating that Mr. Beling has been diligent in seeking depositions so as to warrant any extension of discovery. In fact, inasmuch as Mr. Beling's motion to extend is his fifth paper seeking to extend or suspend this proceeding since the Board resumed proceedings on November 12, 2013, the record shows only that Mr. Beling has been diligent in seeking to delay this proceeding.

March 8, 2014

The Board also notes that Mr. Beling's aspersions on the witness' responses are undermined by the evidence that Mr. Beling been advised in advance of the deposition as to what the responses would be. More specifically, Mr. Beling served notices of deposition upon four individuals associated with Ennis, Inc. The parties then agreed that Mr. Beling would cancel the depositions if opposer gave written responses to five questions of Mr. Beling "in the same manner as would be given in the noticed depositions." On January 12 and 13, 2014, Ennis Inc. served Mr. Beling with written responses designated confidential regarding sales and advertising, trademark searches, the significance of components of the mark, and the creation of its mark. Mr. Beling did not then cancel the deposition pursuant to the agreement, but deposed Mr. Osterloh.

March 11, 2014

Applicant/petitioner moves to submit evidence "by way of declarations or affidavits, without the need to file Notices of Reliance." As discussed, notices of reliance are not necessary with respect to testimony, so the Board construes the motion as requesting that declarations be allowed in lieu of trial depositions. Applicant also specifies that this waiver of the Board's evidentiary rules should apply only to him. In support of the motion, applicant/petitioner contends that trial depositions are "neither practical nor logical", but

opposer/respondent should be forced to employ them in response to its alleged abusive litigation tactics.

March 19, 2014

Mr. Beling's assertion that he requires information on the creation of Ennis Inc.'s mark, and third party use of the literal and design elements of Ennis Inc.'s mark, is belied by Mr. Beling's admissions in his motion that he has previously requested, and received, responses on these topics. Mr. Beling's dissatisfaction with Ennis Inc.'s discovery responses has been addressed in multiple Board decisions denying his motions to compel different discovery responses (and then denying reconsideration of the denials).

Suffice it to say, we have reviewed the the entire file, and all prior orders in this case, and find no error or basis for ruling against Ennis or in favor of Beling.

In short, Ennis' motion for summary judgment in Cancellation No. 92055374 is GRANTED, and Beling's motion for summary judgment is DENIED. The petition for cancellation of Registration No. 3372884 is dismissed with prejudice.⁷

Proceedings in Opposition No. 91203884 are resumed, and dates are reset below. From this point forward, papers filed in Opposition No. 91203884 should refer only to the opposition.

Discovery	CLOSED
Plaintiff's Pretrial Disclosures	11/2/2014
Plaintiff's 30-day Trial Period Ends	12/17/2014
Defendant's Pretrial Disclosures	1/1/2015
Defendant's 30-day Trial Period Ends	2/15/2015
Plaintiff's Rebuttal Disclosures	3/2/2015
Plaintiff's 15-day Rebuttal Period Ends	4/1/2015

⁷ This final dispositive ruling ends litigation on the merits of the petition to cancel before the Board and may be appealed pursuant to Trademark Rule 2.145.

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.