

**This Opinion is Not a
Precedent of the TTAB**

Mailed:
August 20, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

2156775 Ontario Inc.

v.

GI Group, Inc.

Cancellation No. 92058047

Motion for Modification

Ronald E. Shapiro of Shapiro and Silverstein PLLC,
for 2156775 Ontario Inc.

John A. James of Law Offices of John A. James,
for GI Group, Inc.

Before Cataldo, Wellington, and Hightower,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

On June 15, 2015, Petitioner 2156775 Ontario Inc. timely filed a motion for modification of the Board's final decision issued May 15, 2015, in which the Board dismissed the petition to cancel with prejudice based on Petitioner's failure to prove

its standing. Petitioner contends that, pursuant to Federal Circuit precedent, the dismissal should have been made without prejudice and asks us to modify our decision to that extent. Respondent did not respond to the motion.

Generally, the premise underlying a request for rehearing, reconsideration, or modification of a final decision under Trademark Rule 2.129(c), 37 C.F.R. § 2.129(c), is that, based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it issued. The request should not be devoted simply to a reargument of the points presented in the requesting party's brief on the case. Rather, the request should be limited to a demonstration that, based on the evidence of record and the applicable law, the Board's ruling is in error and requires appropriate change. *See Trademark Trial and Appeal Board Manual of Procedure (TBMP) §§ 543 and 804 (2015).*

Standing is a threshold issue that must be proven by the plaintiff in every *inter partes* case. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1945 (TTAB 2010). Pursuant to Section 14 of the Trademark Act, 15 U.S.C. § 1064, a party has standing to seek cancellation of a registration if the party believes it is or will be damaged by the registration. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

In this case, Petitioner alleged that its own application to register the mark STAR for beer has been refused due to a likelihood of confusion with Respondent GI

Group, Inc.'s registration of the mark STARZ for beer and lager,¹ and that Petitioner has appealed that refusal. Proof that Petitioner filed an application that was rejected because of Registrant's registration would be sufficient to establish its standing. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). At trial, however, Petitioner introduced no evidence regarding its application or otherwise establishing its direct commercial interest in this proceeding, apparently under the misapprehension that the file of its application was of record automatically.²

On careful consideration, we do not agree with Petitioner that our final decision in this case erred in dismissing the petition with prejudice. Petitioner quotes our primary reviewing court, the U.S. Court of Appeals for the Federal Circuit, as stating: "Ordinarily, dismissal for lack of standing is without prejudice." *Fieldturf Inc. v. Southwest Recreational Indus. Inc.*, 357 F.3d 1266, 69 USPQ2d 1795, 1798 (Fed. Cir. 2004). Neither *Fieldturf* nor the other cases cited by Petitioner, however, involved the Board; rather, all were appeals from federal district courts established under Article III of the U.S. Constitution. In a court created pursuant to Article III, standing is a jurisdictional requirement, without which the court has no power to render judgment on the merits of the substantive claim. As the Federal Circuit explained in *Ritchie v. Simpson*, in Article III courts, a plaintiff must make out a

¹ Registration No. 3624412, issued May 19, 2009 from an application filed May 15, 2008.

² Although the file of a respondent's registration "forms part of the record of the proceeding without any action by the parties," a petitioner's application does not. Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b); TBMP 704.03(b)(2).

“case or controversy” between itself and a defendant to have standing. *Id.*, 50 USPQ2d at 1025 (citing *Warth v. Seldin*, 422 U.S. 490, 498-99 (1975)).

In contrast, “case” and “controversy” restrictions for standing do not apply to matters before administrative agencies and boards, including the Trademark Trial and Appeal Board. *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012); *see also* 13B CHARLES ALAN WRIGHT ET AL., FEDERAL PRACTICE & PROCEDURE § 3531.13 (April 2015) (“Administrative agencies are not established under Article III and should not be bound by judicial rules of standing in determining what parties to admit to adjudicatory or rulemaking proceedings, any more than they are bound by other judicial rules of procedure.”). It is Trademark Act Section 14 which confers standing to petition to cancel a registration of a mark before the Board.

In a cancellation proceeding, moreover, a petitioner bears the burden of proving standing at trial as an essential element of its case in chief. *Lipton*, 213 USPQ at 189 (“The facts regarding standing, we hold, are part of a petitioner’s case and must be affirmatively proved.”); *see also No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502, 504 (TTAB 1985) (stating that “an essential element of proof in any opposition or cancellation proceeding is that the opposer or petitioner possess a ‘real interest’ in the proceeding”). Petitioner’s failure to prove the essential element of its standing at trial results in a judgment on the merits. Thus, dismissal with prejudice was appropriate.

Decision: Petitioner’s motion for modification of our final decision is ***denied***.