

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed: December 22, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Rescue Response Group Inc.

v.

American Residential Services, L.L.C.

Cancellation No. 92060597

Wendy Peterson, Not Just Patents LLC,
for Rescue Response Group Inc.

P. Jay Hines and Leo V. Gureff, Muncy Geissler Olds and Lowe P.C.,
for American Residential Services, L.L.C.

Before Wellington, Ritchie, and Kuczma, Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

This is a cancellation proceeding in which Rescue Response Group Inc. (Petitioner) seeks to cancel Registration No. 3716081, owned by American Residential Services, L.L.C. (Respondent), for the mark shown below, for

“plumbing services, namely, plumbing repair, drain cleaning and sewer cleaning,” in International Class 37¹:



The grounds for cancellation asserted in the amended petition are abandonment and fraud.² Petitioner has alleged that it is “a competitor of Registrant and provides plumbing and drain cleaning services and has been opposed by Registrant in the Opposition Proceeding 91199269.” 8 TTABVue 2. Petitioner further alleged that “Respondent has not used this mark in commerce since approximately 2008” and the “mark has been prima facie abandoned.” Furthermore, Petitioner alleges that there is “an intent not to resume use.” *Id.* at 3-4. Petitioner asserts a claim of fraud based on Respondent’s Section 8 filing, alleging that Respondent swore that the mark “has been continuously used in commerce for five (5) consecutive years after the date of registration” and is “still in use” when in fact Respondent knew that such statements were “false and material representations of fact.” *Id.* at 5.

¹ Registered on the Principal Register on November 24, 2009, with a Statement of Use filed October 7, 2009, alleging dates of first use and first use in commerce on February 4, 2008. Sections 8 and 15 affidavits accepted and acknowledged.

² Petitioner also alleged nonuse “as of the time of filing,” but only the grounds of abandonment and fraud were pursued on brief. Accordingly, we consider any other claims to be waived.

In its answer, Respondent denied the salient allegations of the first amended petition, except that Respondent admitted that Petitioner is a competitor of Respondent and that the parties are involved in an opposition proceeding before the Board. As noted below, the parties agreed to proceed via the Board's Accelerated Case Resolution ("ACR") procedure to streamline their pre-trial and trial procedures and reduce the pendency of this proceeding.

Both parties filed briefs, and Petitioner filed a reply brief.

The Record and ACR Procedural Background

At their discovery conference, the parties agreed to proceed via ACR, as outlined in the June 25, 2015 Board order memorializing the conference and the agreement of the parties.³ 11 TTABVUE 1-3. The agreement included the following fairly standard ACR terms:

1. The parties agreed "to have the Board reach conclusions as to any issues of material fact in dispute";
2. The parties agreed "to prosecute this case using the summary judgment model of ACR";
3. The parties agreed "there would be no period of discovery"; and
4. The parties agreed their "testimony will be presented by affidavit or declaration (and, of course, any exhibits referenced by the affiants or declarants)."

³ The Board attorney attended the discovery conference at the invitation of Petitioner's attorney. See 10 TTABVUE 2.

Id. at 2.

Both parties submitted exhibits with their ACR briefs, although only Respondent submitted a declaration in connection with its exhibits. Neither party objected to the other's submissions. Accordingly, pursuant to the parties' agreement, the record consists of the evidence submitted by each party with its briefs. *See Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913 (TTAB 2015) (Case decided by ACR based on agreement of the parties early in proceeding). By operation of law, the record also contains the pleadings and the file of the involved registration. Trademark Rule 2.122 (b); 37 CFR § 2.122 (b).

Standing

Standing is a threshold issue that must be proven in every *inter partes* case. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) ("The facts regarding standing . . . must be affirmatively proved. Accordingly, [plaintiff] is not entitled to standing solely because of the allegations in its [pleading]."). To establish standing in an opposition or cancellation, plaintiff must show both "a real interest in the proceedings as well as a 'reasonable' basis for his belief of damage." *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

Respondent admitted the assertion by Petitioner in the amended petition that Petitioner "is a competitor of Registrant and provides plumbing and drain cleaning services and has been opposed by Registrant in the Opposition

Proceeding 91199269.” 8 TTABVUE 2. Petitioner has therefore established its interest as a competitor. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Cerveceria Modelo S.A. de C.V. v. R.B. Marco & Sons Inc.*, 55 USPQ2d 1298 (TTAB 2000); and *Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990). Accordingly, we find that Petitioner here has shown that it has a reasonable belief of damage and a real interest in this proceeding. Therefore it is not a mere intermeddler, and has established its standing. 15 U.S.C. §1064.

Abandonment

Section 14(3) of the Trademark Act, 15 U.S.C. §1064(3), lists, as one of the grounds for cancellation, abandonment, and Section 45 of the Act, 15 U.S.C. §1127, in pertinent part, defines “abandonment” of a mark as follows:

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 evidence of 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 a mark.

There are two elements to an abandonment claim: non-use and an intent not to resume use. A plaintiff must show both of these elements unless it can show three years of nonuse, which prima facie establishes abandonment, in which case the burden shifts to the defendant to show either that it has used the mark, or that it has an intent to resume use. *See Cerveceria*

Centroamericana S.A. v. Cerveceria India Inc., 892 USPQ2d 1307, 1309 (Fed. Cir. 1989).

Petitioner claims that Respondent is not using and has not used its registered mark, but rather is using a variation thereof, as submitted in its Section 8 filing on November 29, 2014:



Petitioner submitted samples of web pages from Respondent's website from what appear to be 2010 to the present⁴ (we note again that Petitioner did not submit a declaration with its evidence) to demonstrate that Respondent's website only depicts the mark as submitted with its Section 8 filing rather than the mark as shown on its registration, and that this therefore constitutes abandonment of the latter. The parties did not conduct any discovery in this case, and Petitioner took no testimony from Respondent. Petitioner is not able to point to any admissions by Respondent, whether through discovery or otherwise, that would assist in making Petitioner's *prima facie* case of nonuse for at least three consecutive years. *See Toufigh v. Persona Parfum Inc.*, 95 USPQ2d 1872, 1875 (TTAB 2010).

⁴ All printouts except those from the present are from an archive source. While we may accept these printouts, they are limited in probative value to what they "show on their face." *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010) ("We underscore that a printout from a webpage may have more limitations on its probative value than traditional printed publications. A party may increase the weight we will give such website evidence by submitting testimony and proof of the

We note that the burden does not shift to Respondent unless Petitioner has made a *prima facie* case of abandonment. *Id.* Nevertheless, Respondent did submit a declaration from its corporate counsel, Christopher C. Fairey, which states that Respondent “uses the original form of the mark as well as slight variations thereof.” 13 TTABVUE 15. The declaration includes as Exhibit B thereto “[a] true and correct copy of [Respondent’s] postcard to customers that has been in use since 2013, depicting the use of the mark.” *Id.* Exhibit B displays a postcard to a prospective customer with Respondent’s registered mark in the top left corner, over the return address.

Petitioner disputes the authenticity of the postcard, as well as its actual use; however, we have no reason to doubt the uncontroverted testimony of Mr. Fairey that the registered mark is in use, as shown on the postcard.⁵ In sum, even if we were to find that Petitioner has established a *prima facie* case of abandonment, and we do not, Respondent has adequately shown that it has not abandoned use of its mark, as registered.⁶ Petitioner has failed to

extent to which a particular website has been viewed. Otherwise, it might not have much probative value.”)

⁵ The evidence submitted by Petitioner merely indicates that Respondent may be using other marks or variations *in addition to*, not *instead of* the registered mark. Because we find that Respondent is using the registered mark, we need not consider the issue of whether the mark as shown on the specimen submitted with Respondent’s Section 8 filing is the “legal equivalent” for purposes of creating “the same continuing commercial impression.” *See Hana Financial, Inc., v Hana Bank*, 574 U.S. ____ (2015), citing *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866, 1868 (Fed. Cir. 1991).

⁶ Petitioner is mistaken in its assertion that “[a]t a bare minimum, Respondent needed to show not just a few bare samples of advertising artwork but also use of the mark for each of the services (Plumbing services, namely, plumbing repair, drain cleaning and sewer cleaning) in the registration for each of the time periods in question for the abandonment and fraud claims.” 14 TTABVUE 2.

establish its claim of abandonment, and the petition to cancel on this basis is dismissed.

Fraud

The second ground for cancellation is fraud.⁷ Specifically, Petitioner avers that in making its Section 8 filing, Respondent swore that the mark “has been continuously used in commerce for five (5) consecutive years after the date of registration” and is “still in use” when in fact Respondent knew that such statements were “false and material representations of fact.”

The Court in *In re Bose Corp.*, 476 F.3d 1331, 91 USPQ2d 1938, 1939 (Fed. Cir. 2009), set out the relevant standard for proving fraud:

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, 48 [1 USPQ2d 1483] (Fed. Cir. 1986). A party seeking cancellation of a trademark registration for fraudulent procurement bears a heavy burden of proof. *W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 377 F.2d 1001, 1004 [153 USPQ 749] (CCPA 1967). Indeed, “the very nature of the charge of fraud requires that it be proven ‘to the hilt’ with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.” *Smith Int’l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981).

Respondent executed and filed its Section 8 affidavit of continuing use on

⁷ Although Respondent argues the Board dismissed Petitioner’s fraud claim, as Petitioner notes in reply, the amended petition to cancel contains a fraud claim which Respondent answered rather than filing a motion to dismiss.

November 29, 2014. Petitioner has not submitted any evidence that shows Respondent's mark was not in use on its goods on that date. Rather, as stated above, Respondent's corporate counsel has attested that its mark is in use, and has submitted evidence to support that statement.

Since Petitioner has failed to show that any statements made in Respondent's Section 8 affidavit of continuing use were false, let alone proving this to the hilt, Petitioner's claim of fraud must fail.

Decision: The petition to cancel is dismissed with respect to both the ground of abandonment and the ground of fraud.