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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Qurate Retail, Inc.

v.

Thomas Brooke

Cancellation No. 92069076

Lynn E. Rzonca of Ballard Spahr LLP
for Petitioner Qurate Retail, Inc.

Jeffrey H. Greger of Hauptman Ham, LLP
for Respondent Thomas Brooke.

Before Lynch, Hudis, and Johnson,
Administrative Trademark Judges.

Opinion by Johnson, Administrative Trademark Judge:

Thomas Brooke ("Respondent") is the owner of record of the registered mark QURATE (in standard characters) ("QURATE Mark"), issued on the Principal Register, for:

> Computer hardware and computer software for organizing communication platforms and social networking; computer games software; downloadable software for mobile phones and tablet computers for use in electronic storage of data; mobile telephones; computer hardware and software for controlling the operation of digital electronic devices and for the reproduction, processing and streaming of audio,

video and multimedia content; computer programs for playing games; programs for handheld games in the nature of computer game programs; blank magnetic discs, blank optical discs, blank optical magnetic discs, blank magnetic tapes for tape recorders, ROM cards, ROM cartridges, CD-ROMs, DVD-ROMs; sound, video and data recording and reproducing instruments and apparatus; downloadable computer programs for organizing communication platforms and social networking and computer games programs; audio-visual teaching apparatus, namely, compact disc players, multimedia projectors; electronic books and publications in the nature of magazines in the field of entertainment, social networking, advertising, marketing and promotion; parts and fittings for all the aforesaid goods, in International Class 9;

Telecommunication and communication service, namely, electronic transmission of data and documents among users of computers; electronic transmission of data, messages and information between and among computers, mobile and handheld devices and wired and wireless communication devices; telecommunication services enabling users to transmit messages, multimedia content and other user-generated content via a global computer network and computer and communications networks; providing online communications links which transfer users to other websites; providing online forums, chat rooms, and electronic bulletin boards for transmission of messages among users in the field of social networking and online data communications; providing access to computer, electronic and online databases; audio, text, video and multimedia broadcasting services over computer and electronic communications networks; providing access to computer databases in the fields of entertainment, social networking, advertising, marketing and promotion; providing rental of telecommunication facilities that enable the creation and updating of personal electronic web pages featuring user-provided content; distribution of electronic information in the nature of data over computer networks, global information networks and wireless networks; providing access to websites and databases for searching and navigating within information from databases; broadcasting services, namely, transmission of advertising programs and media advertising communications via digital communications networks; provision of access to blogs and forums for transmission of

messages, all the aforesaid provided by electronic means, namely, the Internet; information, advisory and consultancy services and the preparation of reports, all relating to the aforesaid services, in International Class 38;

Entertainment services, namely, providing an on-line computer game; entertainment services, namely, facilitating interactive and multiplayer and single player game services for games played via computer or communication networks; game services provided on-line from a computer network, namely, providing online video games; providing information about online computer games and video games via computer or communication networks; publication of electronic journals and web logs, featuring user generated or specified content; publishing of magazines, books, journals; electronic and online publishing of magazines, books, journals; electronic desktop publishing; publication of electronic books and journals; publication of books, booklets, brochures, leaflets, magazines, journals, periodical publications, reports, newspapers, newsletters, guides; providing on-line non-downloadable electronic publications in the nature of magazines, books, journals in the field of entertainment, social networking, advertising, marketing and promotion; Online publication of non-downloadable magazines, periodicals, newsletters, reports, blogs, articles, audio-visual works and multimedia works in the fields of entertainment, social networking, advertising, marketing and promotion by means of a global computer network; arranging and conducting exhibitions, conferences and seminars and networking events for entertainment purposes in the field of entertainment, social networking, advertising, marketing and promotion; entertainment services in the form of television programs in the nature of production and distribution of ongoing television programs in the field of entertainment, social networking, advertising, marketing and promotion; audio, film, video and television recording services; production of sound and video recordings; information, advisory and consultancy services and the preparation of reports, all relating to the aforesaid services, in International Class 41; and

Computer services, namely, hosting electronic facilities for others for organizing and conducting interactive discussions via the Internet or other communications networks; hosting virtual communities for registered users to organize groups, events, participate in discussions,

aggregate information and resources, and engage in social networking; providing a search engine to allow users to preview and download information in the field of entertainment, social networking, advertising, marketing and promotion on a global computer network; hosting a web site on the internet that enables users to store, organize, track, monitor, and share information; providing search engines for obtaining data via communications networks; providing search engines for the Internet; provision internet search engines, namely, provision of customized search engines for others; computer services, namely, creating computer network based indexes of information, websites and resources, namely, creating searchable indexes of information, web sites and other information sources; design, creation, hosting and maintenance of internet sites for third parties; hosting the websites of others on a global computer network; hosting of digital content online; cross-platform conversion of digital content into other forms of digital content; application service provider (ASP), namely, hosting computer software applications of others; hosting a website featuring non-downloadable software for use in database management in the fields of entertainment, social networking, advertising, marketing and promotion; providing non-downloadable software enabling users to search, locate and communicate with others via electronic communications networks for entertainment, social networking, advertising, marketing and promotion; hosting online computer databases and online searchable databases for others in the fields of entertainment, social networking, advertising, marketing and promotion; design and development of computer software; development of computer based networks; computer programming; providing technical information in the field of computer software development; hosting an online website community for registered users to share information and engage in communication and collaboration between and among themselves, to form groups and to engage in professional networking; digital compression of computer data; design and development of software for compression and decompression of multimedia contents; electronic library services for the supply of electronic information relating to video hosting in the form of text, audio and/or video; information, advisory and consultancy services and the preparation of reports, all relating to the aforesaid services, in International Class

42.[1]

Petitioner Qurate Retail, Inc. ("Petitioner") seeks to cancel Respondent's QURATE Registration on the ground of abandonment under Trademark Act Sections 14(3) and 45, 15 U.S.C. §§ 1064(3) and 1127. Respondent's Answer denies the salient allegations of the Petition, but does not assert any affirmative defenses.

The case is fully briefed. Having considered the evidentiary record and the parties' arguments, we **GRANT** the Petition on the ground that Respondent has abandoned the QURATE Mark.

I. The Evidentiary Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of Respondent's involved registration.[2] In addition, the parties

[1] Registration No. 4,733,726 (the "'726 Registration") was issued on May 12, 2015. The underlying application for the registration was filed on July 18, 2013 under Trademark Act Section 66(a), 15 U.S.C. § 1141f(a), with a priority date of January 23, 2013, based on International Registration No. 1210107. In his brief, Respondent claims that certain goods and services in classes 9, 38, and 42 should not be cancelled, but then "concedes that the remainder of the coverage in the '726 Registration should be cancelled." Respondent's Brief, 30 TTABVUE 5. Respondent did not file a request to delete any goods or services from the '726 Registration. In any event, a registration that is the subject of an inter partes proceeding may not be amended, except with the consent of the opposing party and the approval of the Board, or upon motion granted by the Board. Trademark Rule 2.133(a), 37 C.F.R. § 2.133(a); *see also* Trademark Act Section 7(e), 15 U.S.C. § 1057(e). Petitioner did not request and has not been granted consent to amend the '726 Registration. Therefore, the goods and services at issue in this case remain as recited above.

Citations to the record or briefs are to the publicly available documents in TTABVUE, the Board's electronic docketing system. *See, e.g., Turdin v. Trilobite, Ltd.,* 109 USPQ2d 1473, 1476 n.6 (TTAB 2014). The number preceding "TTABVUE" corresponds to the docket entry number; the number(s) following "TTABVUE" refer to the page number(s) of that particular docket entry, if applicable.

[2] Any citations in this opinion to the application record are to pages in the Trademark Status and Document Retrieval (TSDR) database of the United States Patent and Trademark Office (USPTO). All citations to documents contained in the TSDR database are to the downloadable .pdf versions of the documents in the USPTO TTABVUE Case Viewer.

introduced the following evidence:

A. Petitioner's Evidence

Petitioner submitted a Notice of Reliance,[3] introducing into the record: (1) printouts from the Trademark Status and Document Retrieval (TSDR) database showing the current status and title of the '726 Registration for Respondent's QURATE Mark; (2) a copy of the redacted transcript from the March 15, 2019 discovery deposition of Respondent Thomas Brooke, with exhibits; and (3) a copy of the transcript from the June 25, 2019 continued discovery deposition of Mr. Brooke, with exhibits; (4) Petitioner's First Set of Interrogatories to Respondent, and Respondent's responses to same, dated November 12, 2018 and January 8, 2019; (5) Petitioner's First Requests for Admission to Respondent and Respondent's responses to same, dated November 14, 2018 and December 12, 2018; (6) a copy of Respondent's response in the European Union Intellectual Property Office (EUIPO) proceeding to cancel Respondent's European Union (EU) trademark registration for the QURATE Mark; and (7) an October 4, 2019 printout of Respondent's publicly available QURATE website, hosted at QURATE.COM. Petitioner also submitted a February 26, 2020 EUIPO Cancellation Decision pertaining to Respondent's EU trademark registration for the QURATE Mark.[4]

B. Respondent's Evidence

Respondent submitted a Notice of Reliance,[5] introducing into the record: (1) an

[3] 16 TTABVUE. Petitioner also submitted a Confidential Notice of Reliance that includes confidential portions of Mr. Brooke's March 15, 2019 deposition transcript. 17 TTABVUE.

[4] Petitioner's Brief, Appendix "A," 24 TTABVUE 47-58.

[5] 22 TTABVUE.

Internet printout of a December 11, 2019 *PR Industry News* article entitled "Global Aqueous Packaging Printing Market Insights Report 2019-2025—HP Inc., Toppan Printing Co., Ltd., Mondi Plc., WS Packaging Group, DuPont"; (2) an Internet printout of a December 11, 2019 *PR Industry News* article entitled "Global Solvent-based Packaging Printing Market Analysis 2019-2025—HP Inc., Toppan Printing Co., Ltd., Mondi Plc., WS Packaging Group; (3) an Internet printout of a November 2019 article entitled "Toppan Printing wins '2019 CRM Best Practice Award'" from the toppan.co.jp website; (4) a December 5, 2019 AP News.com Wired Release entitled "Barrier Films Market Increasing Demand – Berry Global Inc, Toppan Printing Co. Ltd, Amcor Limited"; (5) Internet printouts of dictionary definitions of "telecommunications," "communication," and "platform" from the COLLINS ENGLISH DICTIONARY; and (6) printouts from the TSDR database showing the current status and title of several registrations based on Trademark Act Section 66a. Respondent also submitted the Testimonial Declaration of Thomas Brooke In Support of Registrant (with exhibits).[6]

II. Preliminary Matter--Petitioner's Requests to Take Judicial Notice of the EUIPO Decisions

Petitioner requests that the Board take judicial notice of the February 26, 2020 EUIPO Cancellation Decision[7] for Respondent's EU Trademark Registration No. 115133438 for the mark QURATE. The EU registration forms the sole registration basis for the Petitioner's QURATE Mark in the United States. Petitioner also requests that the Board take judicial notice of a January 2, 2021 decision by the EUIPO Fourth Board

[6] 21 TTABVUE.

[7] Petitioner's Brief, 24 TTABVUE 10 n.2. The decision is located at 24 TTABVUE 47-58.

of Appeal, which dismissed Respondent's appeal of the February 26, 2020 EUIPO Decision.[8] Respondent does not object to the Board taking judicial notice of the EUIPO decisions;[9] the parties agree that the Board should exercise its discretion and take judicial notice of the EUIPO decisions, albeit for different reasons. Specifically, Petitioner argues that the Board should "take judicial notice of the EUIPO's finding of the incongruence between Respondent's submitted evidence and deposition testimony, and Respondent's consequent lack of credibility."[10] Respondent argues that "[t]he facts in the EU decision are indeed pertinent because they establish what efforts were made by the Respondent to commence use of the QURATE mark in Europe," and that such international use should be considered when assessing intent to commence use of the QURATE Mark in the United States.[11]

"The only kind of fact that may be judicially noticed by the Board is a fact that is not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned." TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 704.12 (2020),

[8] Petitioner's Request for Judicial Notice of EUIPO Cancellation Decision, 33 TTABVUE. The January 2, 2021 decision is attached to Petitioner's request, 33 TTABVUE 11-24. While we are aware that the EUIPO's appellate decision did not issue until January 2021 and the EUIPO's cancellation decision did not issue until February 2020, the Board generally disfavors the filing of motions for judicial notice — regardless of how they are styled — filed after the close of the parties' testimony periods.

[9] Respondent's Trial Brief, 30 TTABVUE 13; Respondent's Response to Petitioner's Request for Judicial Notice of EUIPO Cancellation Decision, 35 TTABVUE 4.

[10] Petitioner's Request for Judicial Notice, 33 TTABVUE 4-5.

[11] Respondent's Brief, 30 TTABVUE 13; *see also* Respondent's Response to Request for Judicial Notice, 35 TTABVUE 3.

and the authorities cited therein, including FED. R. EVID. ("FRE") 201(b). Considering this, we take judicial notice of the two EUIPO decisions. However, we find that the "Reasons" and "Decisions" sections of the EUIPO decisions have little probative value; they are based on laws that are not necessarily in alignment with U.S. law, and the contents of the record in the proceedings may have been different from the record here.

III. Evidentiary Matters

A. Petitioner's Objections to Evidence based on FRE 402

Before proceeding to the merits of this cancellation proceeding, we address several evidentiary issues. First, Petitioner objects to the following evidence, proffered by Respondent, as inadmissible under FRE 402 because it is irrelevant to the issues of use, and intent to commence use, of the QURATE Mark in the United States.[12]

Exhibit	Exhibit Description
Exhibit 1	A printout from the ICANN WHOIS database showing a domain name registration record. The domain name does not appear on the printout.
Exhibit 4	A document entitled "Qurate Team" dated September 26, 2017, showing the key employees, advisors, and office locations for Qurate Inc. (HQ – Fukuoka, Japan; Tokyo) and Qurate Ltd. (London, England, United Kingdom).
Exhibit 6	Email exchanges dated July-August 2018 between Daniel Yoder, Head of Media at Qurate, and Maxwell Ward about the cost of a system and server powering a web site, which would also provide a license to use "our Qurate CMS support, manuals, and training," among other services.
Exhibit 8	Three invoices from Qurate Inc. in Fukuoka, Japan to Gravity Road Ltd., a U.K. company, for services provided on various dates in 2016; one invoice from Qurate Ltd. in London, England to Sync, a U.K. company, for services provided in May 2017; two invoices from Qurate Ltd. to Bloomsbury Economics Ltd., a U.K. company, for services provided in 2017; four invoices from Qurate Ltd. to Richard Davies for services provided to Bloomsbury Economics Ltd. on various dates in 2017 and 2018. All invoices are quoted in GBP.

[12] Petitioner's Brief, 24 TTABVUE 62-74, Appendix "B." The exhibits are attached to Respondent's Testimonial Declaration of Thomas Brooke, 21 TTABVUE 17-312.

Exhibit	Exhibit Description
Exhibit 9	Email exchanges dated 2017 between Registrant and Guillaume DeGroisse of L'Atelier BNP Paribas in Paris, France about scheduling a meeting in Paris to give a presentation about Qurate to L'Atelier BNP Paribas staff.
Exhibits 10-11	Email message dated December 2015 from Scott Broekhuyse of Gravity Road Ltd. in London regarding promotional presentation plans for Qurate (Exhibit 10); email exchanges dated December 2016 between Registrant and Karl Eddy of Grant Thornton UK LLP regarding investing in Qurate (Exhibit 11).
Exhibits 12-16	Qurate candidate application for the Havas Incubator located at Station F in Paris, France and email exchanges dated February 2018 between Registrant and various staff at Havas Media regarding planning Respondent's trip to Paris to "reintroduce" Qurate to Havas Media (Exhibit 12); PowerPoint slide (with photos) listing start-up entity awards won by Qurate and Que (Exhibit 13); Qurate Competitor Analysis dated September 27, 2017 (Exhibit 14); Qurate Startup Plan dated December 31, 2013 (Exhibit 15); email exchanges dated December 2016 through February 2017 between Respondent and various individuals regarding an introduction to Qurate (Exhibit 16).
Exhibit 17	"Two Year Roadmap" for Qurate (2017-18).
Exhibits 18-19	iTunes page for "Que: Make your website" (version 1.5) by Qurate Inc. Page updated May 2, 2016 (Exhibit 18); web site pages for Que, "Powered by Qurate" (Exhibit 19).
Exhibits 21-22	A summary of impressions, conversions, cost per acquisition (CPA), cost per tap (CPT), tap through rate (TTR), and conversion rate (CR) for the Que test campaign in the United States between September 30, 2016 and September 14, 2017 (Exhibit 21); a summary of downloads of the QUE app in the United States from February 1, 2016-December 21, 2018 (Exhibit 22).
Exhibit 23	Screenshots from the QUE app and QR8 system administration panel and dashboard from 2016-2017.
Exhibits 24-25	PowerPoint presentation slides from Registrant's presentation in San Francisco in January 2017.
Exhibits 26-29	Registrant's travel records from trip Registrant made to San Francisco, California to pitch QURATE to U.S.-based companies (Exhibit 26 – undated Uber receipt; Exhibit 27 – Expedia flight itinerary for Registrant from FUK to SFO for January 2017); Email to Registrant from Kazuhiro Koga of Qurate dated January 23, 2017, Subject: SF Schedule Day 1-5, showing schedule for pitch meetings at btrax, Draper Nexus, Slack, and other entities in San Francisco (Exhibit 28); Email correspondence between Registrant and various individuals regarding meetings at btrax in San Francisco and more discussions with companies with California contacts (Exhibit 29).
Exhibit 30	A non-disclosure agreement with Slack Technologies, Inc., signed by Registrant and dated January 20, 2017. The agreement is "governed by the internal laws of the State of California."

Exhibit	Exhibit Description
Exhibit 31	Emails between Registrant and Stripe dated from August 2015 through August 2016 regarding beta testing of a multi-currency functionality on a Japanese Stripe account.
Exhibits 32-33	Descriptions of Qurate Inc.'s partnership with Toppan Printing of Tokyo, Japan (Exhibit 32); meeting notes with representatives of Toppan Printing and Qurate, dated April 2018 through March 2019 (Exhibit 33).

Respondent asserts that Petitioner's objections should be overruled because, as we understand his argument, this case not only involves use the QURATE Mark in the United States, but also intent to commence use of the QURATE Mark in the United States.[13]

After careful consideration, we find that much of Respondent's evidence made of record concerns his (1) business activities outside of the United States directed to non-U.S. customers in non-U.S. markets, (2) preliminary attempts to "pitch" QURATE goods and services to companies outside of the U.S. in non-U.S. markets, and (3) business conducted under the QUE mark. As to these exhibits, we accord the evidence whatever probative value it has, if any. *See The Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC,* 2020 USPQ2d 10914, *4 (TTAB 2020) (citations omitted).

B. Petitioner's Remaining Objections to Respondent's Evidence Based on FRE 1002

Petitioner next relies on the Best Evidence Rule under FRE 1002 for its objections to an email thread discussing the existence of a statement of work and "Qr8" license between Respondent's company and Bacardi-Martini B.V. (Exhibit 7), and to a spreadsheet showing Apple iOS sales data in the United States, European Union, and Japan for the QUE app

[13] *See* Respondent's Brief, 30 TTABVUE 6. Because Respondent conducts substantial business activity outside of the United States, Respondent contends that his ex-U.S. business activity is relevant to intent to commence use of the QURATE Mark in the United States. *See* discussion *infra* Section V.B.4.

at various times between February 2016 and October 2018 (Exhibit 20). Petitioner objects to Exhibit 7 because the actual license with Bacardi was not produced.[14] Petitioner objects to Exhibit 20 because Respondent offers the spreadsheet without providing any supporting documentation for the spreadsheet's contents.[15] As to Petitioner's objection to the spreadsheet, Respondent contends that the "evidence only existed in a computer database and the reports [sic] obtainable by the Respondent printing them out and declaring under oath that the report was downloaded from his computer. … Further, the evidence is not set forth to establish actual use but instead to evidence a marketing test."[16]

The Best Evidence Rule, codified in FRE 1002, states "[a]n original writing, recording, or photograph is required in order to prove its content unless these rules or a federal statute provides otherwise." "However, the rule has been described as 'one of preferences, not absolute exclusion.'" *Mag Instrument Inc. v. Brinkmann Corp.,* 96 USPQ2d 1701, 1707 (TTAB 2010) (quoting 6 WEINSTEIN'S FEDERAL EVIDENCE, Section 1004.01 (2nd Ed. 1997)). Keeping this general guidance in mind, we sustain Petitioner's objection to Exhibit 7; the actual license with Bacardi is needed to reveal that the QURATE Mark was licensed to Bacardi in a specific territory, for a specific term, and for specific services. We also sustain Petitioner's objection to Exhibit 20 because the spreadsheet only shows sales data for the QUE app, which is not the mark at issue here.

C. Petitioner's Objection to Evidence Based on TBMP § 532 and Relevance

Finally, we address Petitioner's objection to Exhibits A through D of Respondent's

[14] Petitioner's Brief, 24 TTABVUE 63-64.

[15] *Id*. at 68.

[16] Respondent's Brief, 30 TTABVUE 6-7.

Notice of Reliance,[17] citing TBMP § 532, which allows an adverse party to move to strike a notice of reliance, in whole or in part, "on the ground that the notice of reliance does not comply with the procedural requirements of the particular rule under which it was submitted." Exhibits A through D consist of Internet print outs of press releases (in form or in substance) about Toppan Printing Company, a Tokyo-based business partner of Qurate, but the press releases do not mention the Qurate company or mark. Petitioner asserts that press releases are not properly the subject of a notice of reliance.[18] Petitioner also objects to the press releases based on relevance.[19]

Petitioner's objection that press releases generally are not properly the subject of a notice of reliance is not well-taken. We have held that a document from the Internet that identifies its date of publication or date that it was accessed and printed, as well as its source (e.g., the URL), may be admitted into evidence, and considered for what it says on its face (but not for its truth), pursuant to a notice of reliance in the same manner as a printed publication in general circulation, in accordance with Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e). *Safer, Inc. v. OMS Investments, Inc.,* 94 USPQ2d 1031, 1039 (TTAB 2010) (citation omitted).

In addition, it is improper to make such a procedural objection to a notice of reliance at this stage of the proceedings. *See* TBMP §§ 707.02 and 707.04; *Moke Am. LLC v. Moke USA, LLC,* 2020 USPQ2d 10400, at *4 (TTAB 2020) ("As a general rule, [procedural] objections that are curable must be seasonably raised, or they will be deemed waived.")

[17] Respondent's Notice of Reliance, 22 TTABVUE 5-27, Exs. A-D.

[18] Petitioner's Brief, 24 TTABVUE 74.

[19] *Id.*

(citation omitted).

However, as to Petitioner's objection to the relevance of Exhibits A through D, again we accord the evidence whatever probative value it has, if any. *See The Brooklyn Brewery Corp.,* 2020 USPQ2d 10914, at *4 (citations omitted).

IV. The Parties

Petitioner asserts that it is a "global leader in the field of omnichannel retail," providing general consumer merchandise to over 380 million homes internationally through its eight retail brands, including QVC, HSN, and ZULILY, via television, ecommerce, and social media.[20] Petitioner asserts its ownership of Application Serial Nos. 87813432, 87813439, 87813441 (now Reg. No. 5,921,649), 87813443, and 87813446 for its mark, QURATE RETAIL GROUP (in standard characters); and Application Serial Nos. 87871518, 87871523, 87871529, 87874124, 87874168 (now Reg. No. 6,104,581), and 87874176 (now Reg. No. 5,743,211) for its mark, QURATE RETAIL GROUP (stylized word mark), shown below.[21]

Respondent Thomas Brooke, a British national residing in Japan,[22] asserts his ownership of the QURATE Mark. He is the Chief Executive Officer and controlling

[20] Petitioner's Brief, 24 TTABVUE 20.

[21] Petition for Cancellation, 1 TTABVUE 7.

[22] Petitioner's Notice of Reliance, 16 TTABVUE 32:16-25.

shareholder of Qurate Inc., a software development company headquartered in Fukuoka, Japan, and its subsidiary, Qurate Ltd., which is based in London, England.[23] According to Respondent, the QURATE brand is used for computer systems and platforms.[24]

V. Discussion

A. Entitlement to a Statutory Cause of Action

Petitioner's entitlement to a statutory cause of action, formerly referred to as "standing,"[25] must be established in this inter partes proceeding before the Board. *See Corcamore, LLC v. SFM, LLC,* 978 F.3d 1298, 2020 USPQ2d 11277, at *6-8 (Fed. Cir. 2020); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC,* 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.,* 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute and (ii) proximate causation. *Corcamore*, 2020 USPQ2d 11277, at *4. *See also Empresa Cubana*, 111 USPQ2d at 1062; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (TTAB 1982).

[23] Petitioner's Notice of Reliance, 16 TTABVUE 34:4-11, 35:2-8, 38:10-18; Respondent's Brief, 30 TTABVUE 7.

[24] Testimonial Declaration of Thomas Brooke, 21 TTABVUE 7 ¶ 22.

[25] Our decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063 and 1064, under the rubric of "standing." We now refer to this inquiry as "entitlement to a statutory cause of action." Despite the change in nomenclature, our prior decisions and those of the U.S. Court of Appeals for the Federal Circuit interpreting "standing" under Sections 13 and 14 of the Trademark Act remain applicable. *See Spanishtown Enters., Inc. v. Transcend Resources, Inc.,* 2020 USPQ2d 11388, at *2 (TTAB 2020).

Demonstrating a real interest in cancelling the registration of a mark satisfies the zone-of-interests requirement, and demonstrating a reasonable belief in damage by the registration of a mark demonstrates damage proximately caused by registration of the mark. *Corcamore,* 2020 USPQ2d 11277, at *7-8.

Petitioner alleges the following in its Petition to Cancel:[26]

> 3. On June 12 and 13, 2018, the USPTO issued Office Actions against the QURATE RETAIL GROUP Applications, refusing to register Petitioner's QURATE RETAIL GROUP Marks on the grounds that they are confusingly similar to the mark of the '726 Registration.
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> ***
>
> 5. Petitioner has been damaged and will continue to be damaged if the '726 Registration is permitted to remain on the Principal Register because such registration stands as a bar to Petitioner's ability to federally register its QURATE RETAIL GROUP Marks for Petitioner's Goods and Services, thereby hindering Petitioner's ability to protect and enforce its rights in the QURATE RETAIL GROUP Marks.
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> ***
>
> 10. Based on the foregoing, if the Registered Mark is permitted to remain on the Principal Register with all of the rights and privileges conferred on it by its status as the subject of a Principal Register registration, Petitioner will be damaged, including its potential inability to secure a registration for its QURATE RETAIL GROUP marks.

Since Petitioner's pending applications were refused based on the existence of Respondent's '726 Registration, Petitioner satisfies the zone-of-interests requirement as well as the proximate causation requirement for its entitlement to a statutory cause of action. *See ShutEmDown Sports Inc. v. Lacy,* 102 USPQ2d 1036, 1042 (TTAB 2012) ("standing" shown by evidence that plaintiff's application was refused registration in

[26] 1 TTABVUE 8 ¶¶ 3 and 5, 9 ¶ 10.

view of defendant's registration).

B. Abandonment

1. Abandonment Generally

Abandonment occurs when "use [of a mark] has been discontinued with [the] intent not to resume such use. Intent not to resume use may be inferred from circumstances." Section 45 of the Trademark Act, 15 U.S.C. § 1127. In addition, under the Trademark Act, "[n]onuse for three consecutive years shall be prima facie evidence of abandonment." *Id.; see also City Nat'l Bank v. OPGI Mgmt. GP Inc./GestionOPGI Inc.,* 106 USPQ2d 1673, 1678 (TTAB 2013) ("A presumption of abandonment based on three years nonuse may be invoked against a [ ]registrant who never begins use of the mark or who discontinues using the mark."). "'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." 15 U.S.C. § 1127. Use in commerce contemplates "commercial use of the type common to the particular industry in question." *Lewis Silkin LLP v. Firebrand LLC,* 129 USPQ2d 1015, 1018 (TTAB 2018). "Introduction of evidence of nonuse of a mark for three consecutive years constitutes a prima facie showing of abandonment and triggers a rebuttable presumption that a mark was abandoned without [the owner's] intent to resume use." *Wirecard AG v. Striatum Ventures B.V.,* 2020 USPQ2d 10086, at *4 (TTAB 2020) (citing *Exec. Coach Builders, Inc. v. SPV Coach Co.,* 123 USPQ2d 1175, 1180 (TTAB 2017)) (internal citation omitted).

To cancel Respondent's entire registration, Petitioner must prove abandonment of the mark as to each of the four classes of goods and services. *Wirecard AG,* 2020 USPQ2d 10086, at *4 (comparing *Federated Foods, Inc. v. Fort Howard Paper Co.,* 544 F.2d 1098,

192 USPQ 24, 28 (CCPA 1976) ("We conclude, therefore, that this opposition proceeding as to four classes of a combined application is, effectively, four different oppositions which require four different factual determinations and four different conclusions on the ultimate issue of likelihood of confusion under § 2(d).")). However, evidence of abandonment may pertain to goods and/or services in multiple classes. *Wirecard AG,* 2020 USPQ2d 10086, at *4.

In this case, the QURATE goods and services are expansive and somewhat interrelated. Neither party parses out evidence applicable to each registered class; both rely upon the same evidence to argue their different positions regarding the QURATE goods and services. Notwithstanding the parties' failure to parse out the evidence, still we determine Respondent's abandonment for each class of registered goods and services. Respondent concedes abandonment of all of the services registered in Class 41, some of the goods registered in Class 9, and some of the services registered in classes 38 and 42.[27] The remainder of the registered goods and services offered under the QURATE Mark, namely, computer software, downloadable computer programs, telecommunication services, electronic information distribution services, web site hosting services, computer software design and development services, application service provider services, digital content hosting and conversion services, are interrelated.

2. Abandonment of a Registration Issued Under Trademark Act Section 66(a)

Use in commerce prior to registration is not required for registrations issued

[27] Respondent's Brief, 30 TTABVUE 4-5.

pursuant to Trademark Act Section 66(a). *See* Trademark Act Section 68(a)(3), 15 U.S.C. § 1141h(a)(3) ("Extension of protection shall not be refused on the ground that the mark has not been used in commerce.").[28] However, after registration, the registration is subject to the same grounds for cancellation as those registrations issued under Section 1 or Section 44(e), including abandonment. *Saddlesprings,* 104 USPQ2d at 1951.

Petitioner pleads in the alternative that Respondent never used the QURATE Mark in commerce or, if use ever began, Respondent stopped using the mark for at least three consecutive years from the date the QURATE Registration issued, which was on May 12, 2015. The Board and the Federal Circuit have considered this same issue before:

> The Board and the United States Court of Appeals for the Federal Circuit have had occasion to consider the question of a 'never used' mark in connection with abandonment, and have found that, so long as the period during which the mark was never used is alleged to be at least three years, or alleged to be less than three years but is accompanied by the necessary lack of intent to resume (or commence) use, a pleading that the mark was 'never used' pleads the necessary nonuse for an abandonment claim. In other words, so long as the claim that the mark was never used specifies a period of three years of nonuse, the claim that the mark was never used also pleads the nonuse necessary for the prima facie case for abandonment. Accordingly, we do not treat the alternative arguments for abandonment as separate claims.

Wirecard AG, 2020 USPQ2d 10086, at *3-4 (citing *Imperial Tobacco Ltd. v. Philip Morris Inc.,* 899 F.2d 1575, 14 USPQ2d 1390, 1395 (Fed. Cir. 1990) and *Saddlesprings,* 104

[28] "Under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), the holder of an international registration may file a request for extension of protection of that registration to the United States. An applicant who files such a request must declare its intention to use the mark in the United States, Section 66 of the Trademark Act, 15 U.S.C. § 1141f(a), and the resulting U.S. application is subject to examination and opposition, Section 68 of the Trademark Act, 15 U.S.C. §1141h." *Saddlesprings, Inc. v. Mad Croc Brands, Inc.,* 104 USPQ2d 1948, 1950 (TTAB 2012).

USPQ2d at 1950). Here, because Respondent's registration issued under Section 66(a), the earliest date on which the three-year period for the statutory presumption of abandonment may begin in this case is the registration date, May 12, 2015. *Dragon Bleu (SARL) v. VENM, LLC,* 112 USPQ2d 1925, 1931 (TTAB 2014).

"The rebuttable presumption [of abandonment] shifts the burden of production to the party contesting the abandonment to submit evidence of either: (1) use of the mark during the statutory period of nonuse; or (2) activities reflecting an intent to resume (or commence) use during the nonuse period.[29] The burden of persuasion however, always remains with the party asserting abandonment, which must prove it by a preponderance of evidence." *Wirecard AG,* 2020 USPQ2d 10086, at *4 (citation and internal citations omitted). "In the absence of justifiable non-use, Section 66(a) registrations which have never been used, or for which use has been discontinued with no intent to resume use, may be subject to cancellation for abandonment even if the international registration remains valid and subsisting." *Saddlesprings,* 104 USPQ2d at 1952.

3. Respondent's Nonuse of the Mark for Three Years

Under the Trademark Act, a mark is in use in commerce on goods when "it is placed in any manner on the goods or their containers or the displays associated therewith or

[29] The Federal Circuit has found that the statutory language "intent not to resume" use is "appropriate for the usual situation in which a registered mark has been used at some time in this country." *Imperial Tobacco Ltd. v. Philip Morris Inc.,* 14 USPQ2d at 1394. In *Imperial Tobacco,* the Federal Circuit held that the language "intent to begin use" or "intent to use" is an appropriate adaptation of the statutory language in the situation of a never-used mark registered on the basis of foreign rights. *Id.* at 1395. *Accord Rivard v. Linville,* 133 F.3d 1446, 45 USPQ2d 1374, 1376 (Fed. Cir. 1998) ("Where a registrant has never used the mark in the United States because the registration issued on the basis of a foreign counterpart registration … cancellation is proper if a lack of intent to commence use in the United States accompanies the nonuse.").

on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and the goods are sold or transported in commerce." 15 U.S.C. § 1127. A mark is in use in commerce on services when "it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services." *Id.*

Petitioner asserts that from at least Respondent's registration date of May 12, 2015 through July 27, 2018—the day this cancellation proceeding was filed—Respondent never used the QURATE Mark in the United States for any of the goods or services in the '726 Registration.[30] Petitioner further asserts that that Respondent does not have the intent to commence use of the QURATE Mark in the United States in the foreseeable future.[31] In support, Petitioner cites Respondent's deposition testimony. For example, Respondent admitted that during the three-year period from May 12, 2015 through May 12, 2018, he did not have a single QURATE customer in the United States, he had no employees or promotional teams for QURATE in the United States, he was not registered to do business in the United States, and he had no physical presence for his business in the United States.[32] Respondent also could not recall exact details or approximate circumstances underlying the sale, or offer for sale, of any QURATE-

[30] Petitioner's Brief, 24 TTABVUE 7-10, 26.

[31] *Id.* at 10, 38-41.

[32] Petitioner's Notice of Reliance, 16 TTABVUE 28:24-30:16, 321:4-15.

branded good or service in the United States.[33] Respondent even conceded that there are no U.S. customers for the "Qurate Platform," best described as a digital content management system that "allows for the end-to-end management of online content for the purposes of consumption and publishing on the Internet," which can also be used to power websites:[34]

> Q [Counsel for Petitioner]: Is it correct that there are no U.S. customers for the Qurate platform?
>
> A [Respondent]: The Qurate Platform meaning the system? And that is correct, there are no American companies licensing the system directly.
>
> Q: Have there ever been any U.S. customers for the Qurate platform?
>
> A: No.

March 15, 2019 Deposition of Thomas John Brooke, 16 TTABVUE 92:8-15.

Even though Respondent testified that he "[has] made actual uses in the United States in connection with promotional effort, test marketing, and plans,"[35] Respondent concedes in his brief that "[l]ike the Respondent in *Wirecard,* [he] has not commenced actual use in U.S. commerce, as that term is defined as use in the ordinary course of trade."[36] Respondent's plans to use the QURATE Mark in the United States are not the same as actual use of the mark in the United States. *See Aycock Eng'g, Inc. v Airflite, Inc.,* 560 F.3d 1350, 90 USPQ2d 1301, 1308 (Fed. Cir. 2009) (registrant's AIRFLITE

[33] *Id.* at 28:24-30:16*; see also id.* at 323:16-324:6 (Qurate Content Hub), 330:1-342:15 (Qurate generally).

[34] *See* Testimonial Declaration of Thomas Brooke, 21 TTABVUE 7-8 ¶ 25, 8 ¶26.

[35] *Id.* at 11 ¶ 39.

[36] Respondent's Brief, 30 TTABVUE 14.

service mark void ab initio because registrant only used the mark in preparatory stages of development, but never offered actual services to the public). As a result, we find Petitioner has established a prima facie case that Respondent did not use the QURATE Mark from May 12, 2015, the date of registration, and continuing for at least three consecutive years thereafter. Thus, there is a rebuttable presumption that Respondent never used the QURATE Mark in the United States, and as a result, Respondent abandoned the mark without an intent to resume use.

4. Intent to Commence Use

Because Respondent has not yet used the mark in the United States, the "presumption shifts the burden to the registrant to produce evidence that he ... intended to ... commence use." *Rivard v. Linville,* 45 USPQ2d at 1376. "Respondent may establish its intent to commence use by showing 'special circumstances' relevant to its nonuse." *Wirecard AG,* 2020 USPQ2d 10086, at *6 (citation omitted). "This is the same standard used to assess whether a mark once in use has been abandoned." *Id.* (citation omitted). "To prove intent to begin use, Respondent must produce evidence showing that, under its particular circumstances, its activities are those that a reasonable business with a bona fide intent to use the mark in United States commerce would have undertaken." *Id.* (citing *Rivard v. Linville,* 45 USPQ2d at 1376; *Reynolds Televator Corp. v. Pfeffer,* 173 USPQ 437, 439 (TTAB 1972) ("A resolution of this question [of intent to commence use] involves a consideration of a number of factors including the nature and character of the goods, the feasibility of producing the goods, the actual or potential market for the goods, and the steps taken by respondent which could possibly result in the movement of the goods under the registered mark 'in commerce' within the foreseeable future.")).

"Conclusory statements, even if sworn, regarding intent — intent to resume or intent to commence — are insufficient to rebut a prima facie case of abandonment." *Id.* at *7 (citing *Imperial Tobacco,* 14 USPQ2d at 1394-95); *compare Rivard v. Linville,* 45 USPQ2d at 1376 ("A registrant's proclamations of his intent to resume or commence use in United States commerce during the period of nonuse are awarded little, if any, weight."), *with Oromeccanica, Inc. v. Ottmar Botzehnardt G.m.b.H. & Co. KG,* 223 USPQ 59 (TTAB 1983) (no abandonment of "heart design" mark, based on a German registration, where registrant started a market survey in the United States before initiation of cancellation proceedings and continued the survey throughout the proceedings), *and Reynolds Televator,* 173 USPQ 437 (no abandonment of registered mark TELEVATOR, based on an Austrian registration, considering limited market for goods, registrant's continuous efforts to obtain financial backing for building a prototype, and registrant's efforts over several years to interest customers in the United States).

In his Testimonial Declaration, Respondent avers that in April 2017, "Qurate had plans for a US Sales Office, and U.S. team, although the plan has yet to come to fruition,"[37] and that he has "never abandoned plans to commercialize the Qurate brand in the United States. … I have always maintained an intent to commercialize the QURATE brand in the United States, certainly at least as early as January of 2013 when I filed for trademark protection."[38]

In furtherance of his plans to commercialize the Qurate brand in the United States, Respondent traveled to San Francisco for a week in late January 2017 to attend

[37] Testimonial Declaration of Thomas Brooke, 21 TTABVUE 9 ¶ 38.

[38] *Id.* at 11 ¶ 39.

meetings with potential investors as well as American companies in the digital communications and content management industry.[39] During the meetings, Respondent made a presentation that "touted the Qurate digital platform."[40] Prior to his meeting that week with a company called Slack, which Respondent describes as a "U.S. technology company in the field of providing instant messaging services," Respondent signed a non-disclosure agreement (NDA) enforceable under California law.[41] The QURATE Mark does not appear on the NDA.[42]

Citing the Federal Circuit's decision in *Rivard v. Linville,* Petitioner contends that Respondent's one trip to San Francisco to "pitch" Qurate and meet with investors does not rise to the level of use of, or a bona fide intent to use, the QURATE Mark in the United States.[43] In *Rivard,* the Federal Circuit affirmed the Board's holding that the appellant, a hair and beauty entrepreneur, abandoned his registered mark in the United States after making multiple "sporadic" trips to the U.S. over five years to meet with commercial realtors, engage landlords in several states, take photos of a competitor's business, and to contact a franchising consultant. 45 USPQ2d at 1375.

The facts here are even worse for Respondent than the facts were for the registrant in *Rivard*. Other than showing that Respondent made only one trip to the United States between May 12, 2015 and May 11, 2018 in furtherance of doing business under the QURATE Mark, the record is devoid of any evidence that Respondent (or one of his

[39] Respondent's Brief, 30 TTABVUE 11.

[40] *Id.*

[41] *Id.* at 12.

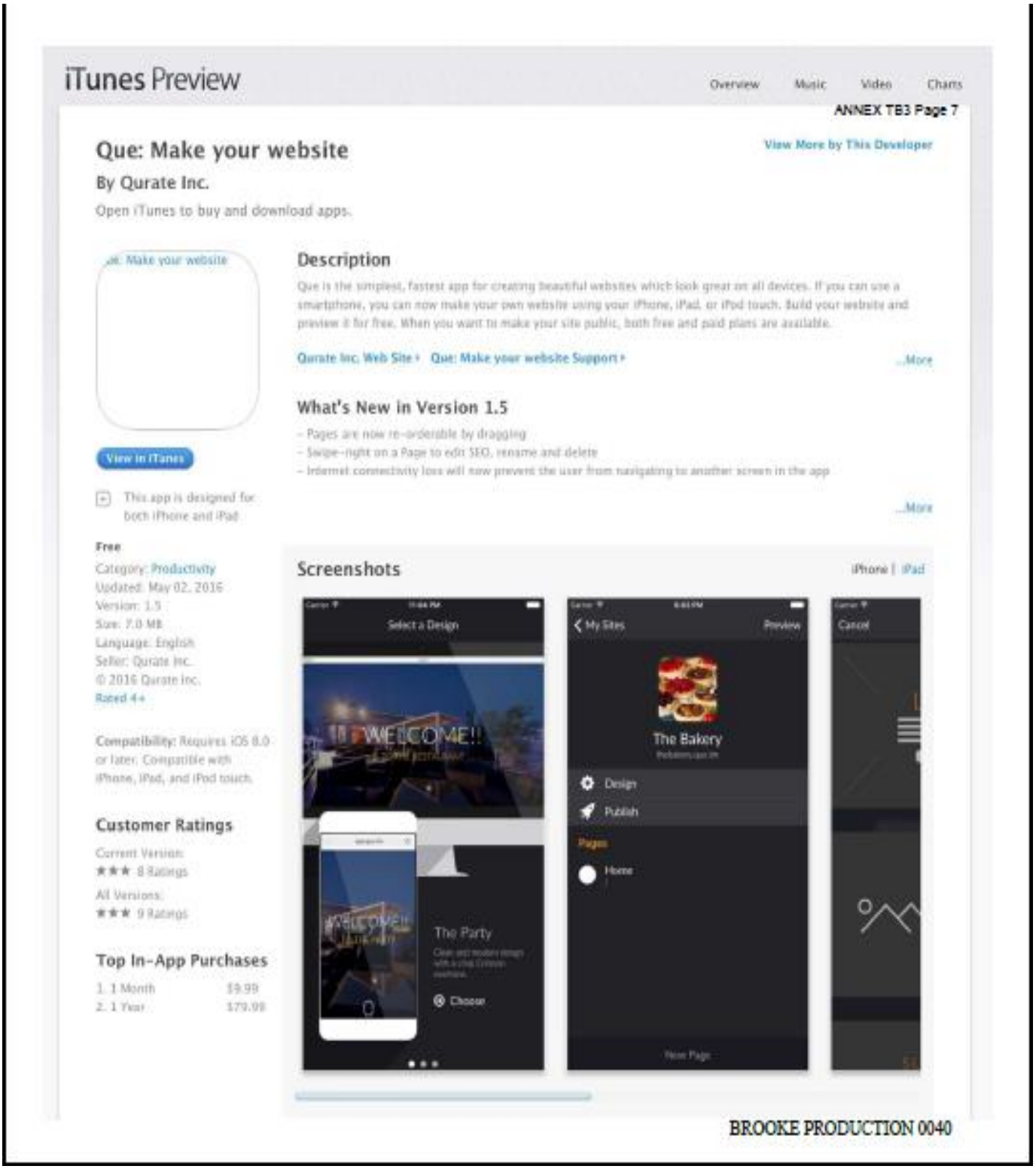
[42] Testimonial Declaration of Thomas Brooke, 21 TTABVUE 243-44.

[43] Plaintiff's Brief, 24 TTABVUE 28-30.

employees or agents) returned to the United States in furtherance of conducting business in connection with the QURATE Mark. Further, there is no proof of Respondent's specific business plans or continued communications showing his intent to use the QURATE Mark in U.S. commerce. *See Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.,* 126 USPQ2d 1526, 1539 (TTAB 2018) ("Respondent's efforts were neither consistent nor sustained, and assertions of discussions concerning the potential use of the mark at some unknown point in the future are insufficient to show an intent to resume use.").

In an attempt to refute allegations of his failure to use the QURATE Mark in the United States, Respondent claims that he uses the QUE mark, the trade names "Qurate Inc." and "Qurate Ltd.," and the advertising tagline "Powered by Qurate," interchangeably with the QURATE Mark.[44] For example, the "iTunes Preview" page, shown below, is for the QUE application, or "app," for creating websites. The "Qurate Inc." trade name appears at least four times on the page.

[44] Testimonial Declaration of Thomas Brooke, 21 TTABVUE 12 ¶¶ 41, 42; *see also* Petitioner's Notice of Reliance, 16 TTABVUE 93:5-97:15, 99:11-19, 107:6-108:8, 115:9-17, 121:1-25, 123:12-19, 145:15-25, 147:1-24, 149:14-25, 150:1-22, 151:6-153:12, 206:4-207:2.



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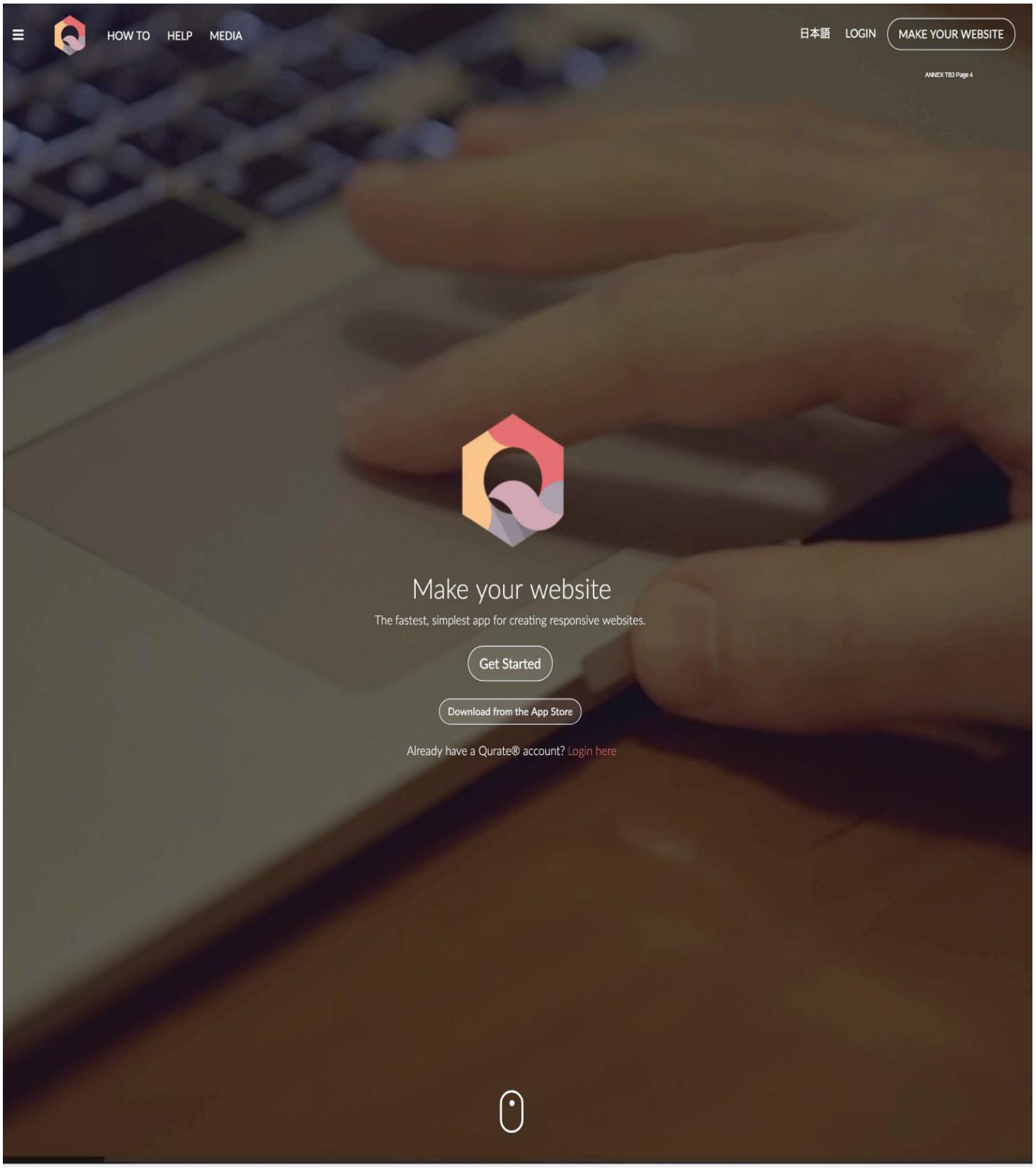
[45] Testimonial Declaration of Thomas Brooke, 21 TTABVUE Ex. 18.

Our case law does not support such flexible use of "the mark." First, the registered mark at issue is QURATE, not QUE. Respondent's use of the QUE mark in conjunction with his identified goods and services is not the same. *See Hamilton Burr Publ'g Co. v. E.W. Commc'ns, Inc.,* 216 USPQ 802, 807 (TTAB 1982) (applicant's use of "The International Countermeasures Handbook" for a handbook is not the same as use of the COUNTERMEASURES mark for newsletters, which applicant abandoned). In addition, Respondent's trade name use of "Qurate Inc." alone does not rise to the level of trademark use of the QURATE Mark. *See, e.g., In re Letica Corp.,* 226 USPQ 276, 277-78 (TTAB 1985) ("trade names qua trade names do not qualify for registration"; specimens showing that "Letica Corp." on the bottom of applicant's goods is trade name use, and not trademark use); *see also In re Pa. Fashion Factory, Inc*., 588 F.2d 1343, 200 USPQ 140, 142 (CCPA 1978) ("[T]he mere fact that appellant's goods are placed in bags (bearing the words sought to be registered) … does not, *ipso facto,* establish trademark usage of those words.").

As to the QUE website pages shown below, "Qurate" appears in the statements, "Already have a Qurate account? Login here," "Powered by Qurate," and "Que is brought to you by Qurate, see what else we make at Qurate.com."



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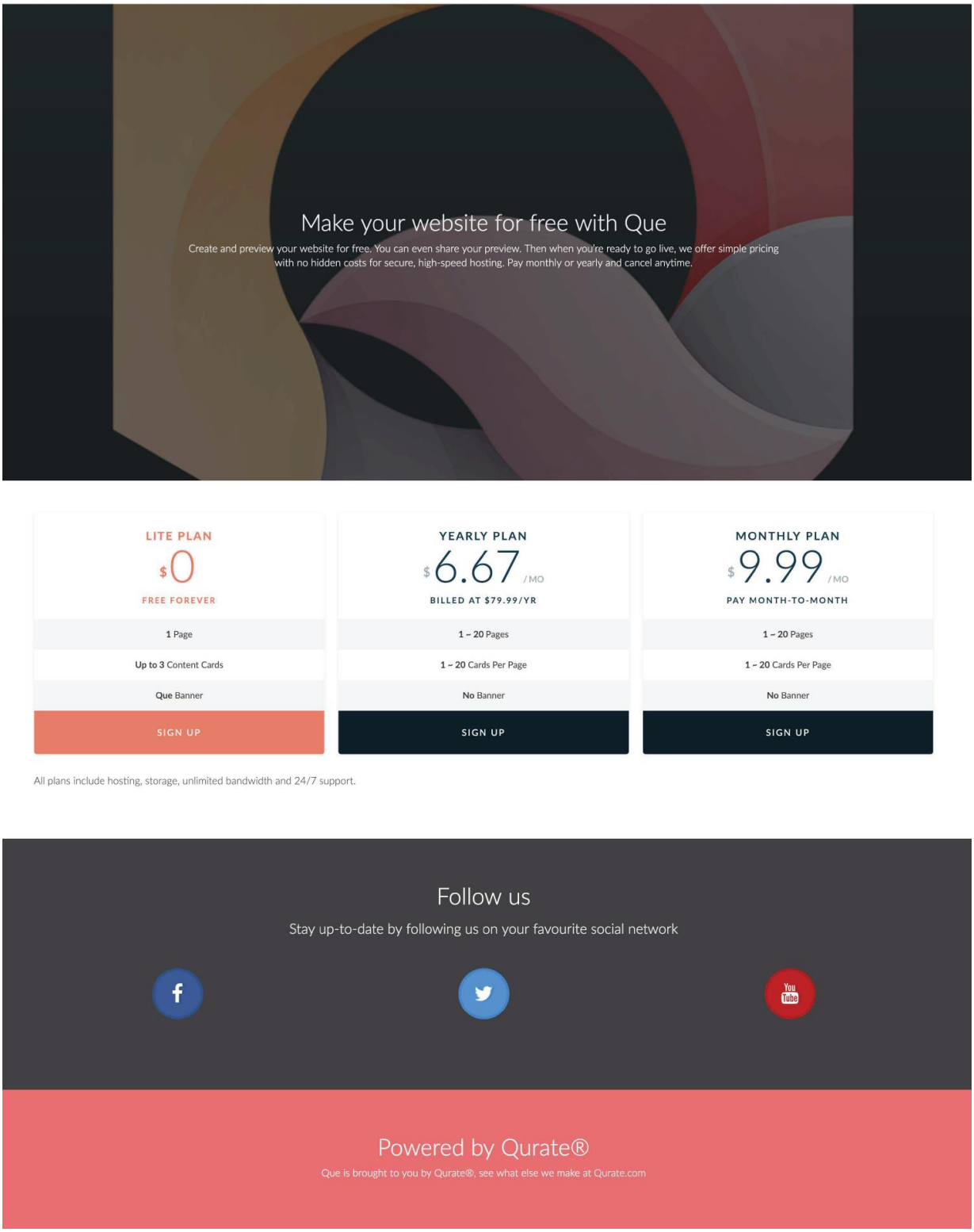
[46] *Id.* at Ex. 19.


Make your website for free with Que
Create and preview your website for free. You can even share your preview. Then when you're ready to go live, we offer simple pricing with no hidden costs for secure, high-speed hosting. Pay monthly or yearly and cancel anytime.
LITE PLAN
$0
FREE FOREVER
1 Page
Up to 3 Content Cards
Que Banner
SIGN UP
YEARLY PLAN
$6.67 /MO
BILLED AT $79.99/YR
1 – 20 Pages
1 – 20 Cards Per Page
No Banner
SIGN UP
MONTHLY PLAN
$9.99 /MO
PAY MONTH-TO-MONTH
1 – 20 Pages
1 – 20 Cards Per Page
No Banner
SIGN UP
All plans include hosting, storage, unlimited bandwidth and 24/7 support.
Follow us
Stay up-to-date by following us on your favourite social network
Powered by Qurate®
Que is brought to you by Qurate®, see what else we make at Qurate.com

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Id.

We find that consumers would perceive as a mark the prominent Q logo placed near the reference to a web creation app, but would not perceive the relatively small statement further down on the page, "Already have a Qurate account? Login here" as a mark for any particular goods and services, as it is unclear what the purpose of the account is. We find that the reference to a "Qurate account" is not directly associated with any of the relevant goods or services. *See id.* As to "Powered by Qurate" and "Que is brought to you by Qurate, see what else we make at Qurate.com," we find that given their placement at the bottom of the page and the unclear significance of the prefatory language "powered by" and "brought to you by," these QURATE references likely would be perceived as trade name usage, or in any event, not directly associated with the registered goods and services. *See In re Johnson Controls, Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994) ("there must be something which creates in the mind of the purchaser an association between the mark and the service activity.").

As a result, we find that under this record, Respondent has not carried his burden of proving an intent to commence use of the QURATE Mark in commerce in the United States for any of the registered goods and services.

VI. Conclusion

After considering the evidence, we find Respondent has not used the QURATE Mark in the United States in connection with any of the goods or services recited in Respondent's registration, nor has Respondent rebutted Petitioner's prima facie showing of abandonment of the registered mark by demonstrating an intent to commence use of the QURATE Mark in United States commerce as to any of the goods or services recited in Respondent's registration.

Decision: The Petition to Cancel Registration No. 4,733,726 on the ground of abandonment is granted as to all four classes of goods and services identified in the Registration.