

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

Mailed: March 8, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*Miss United States of America LLC,
DBA United States of America Pageants*

v.

Abundance Productions, LLC

—
Cancellation No. 92071814

—
Thomas D. Foster of TDFoster Intellectual Property Law, and
Amanda Milgrom and Lindsey J. Brown of Milgrom & Daskam,
for Miss United States of America LLC.

William D. Kellen, Mark G. Emde, and Clement J. Hayes of Block45
Legal LLC, for Abundance Productions, LLC.

—
Before Wellington, Heasley, and Johnson,
Administrative Trademark Judges.

Opinion by Johnson, Administrative Trademark Judge:

Abundance Productions, LLC (“Respondent”) is the owner of record of the registered standard character mark MRS. COLORADO¹ (“Registered Mark” or “Registration”),

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¹ Registration No. 5600946 (“the ’946 Registration”) was issued on November 6, 2018, from an underlying application filed on March 28, 2018, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on a claim of first use of the mark anywhere and in commerce since at least as early as June 2, 2008. The exclusive right to use the word “COLORADO” is disclaimed.

Citations to the record are from 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

issued on the Principal Register for “Entertainment in the nature of beauty pageants,” in International Class 41.

Petitioner, Miss United States of America LLC, DBA United States of America Pageants, uses the title “United States of America’s Mrs. Colorado” or “USOA Mrs. Colorado” for pageants in the State of Colorado.² (See Ex. A2, 25 TTABVUE 115; *see also* Ex. 1, 31 TTABVUE 15). By way of its Amended Petition,³ (19 TTABVUE 10-14), Petitioner seeks to cancel the Registration on the ground that it is void ab initio because “Registrant has no independent, bona fide use of MRS. COLORADO prior to submission of the use-based application.”⁴ (19 TTABVUE 11). *See* Trademark Act Section 45, 15 U.S.C. § 1127. Petitioner also seeks to cancel the Registration on the following grounds: The Registered Mark is generic for “Entertainment in the nature of beauty pageants,”⁵

(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 *See also* Amended Petition for Cancellation (“Amended Petition”), 19 TTABVUE 10 ¶ 1 (“Petitioner ... is using the term ‘Mrs. Colorado’ as a generic designation for the title holders of its Colorado state beauty pageant and as the name of its pageant, namely ‘United States of America’s Mrs. Colorado.’”).

³ Petitioner sought to cancel the Registration on the ground of fraud, but the Board denied Petitioner’s motion for leave to amend its Petition for Cancellation to add that claim. *See* Order, 23 TTABVUE 7-9.

⁴ Also, in its brief, Petitioner argued that the MRS. COLORADO mark was abandoned, *see* 46 TTABVUE 37-38, 44-47, but Petitioner did not mention or allege abandonment in its Amended Petition for Cancellation. In response, Respondent argued in its brief that the prior registration for MRS. COLORADO was abandoned by its owner, but Respondent had not abandoned its Registration for MRS. COLORADO. 49 TTABVUE 23-24. Since both parties have asserted arguments concerning abandonment, Respondent has not objected to Petitioner’s assertions of abandonment, and evidence supporting Petitioner’s abandonment argument was entered into the record, we will consider the unpleaded issue of abandonment as having been tried by implied consent. Fed. R. Civ. P. 15(b); Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a); *see also* *Morgan Creek Prods. Inc. v. Foria Int’l Inc.*, 91 USPQ2d 1134, 1139 (TTAB 2009) (discussing awareness and fairness in determining whether an unpleaded issue was tried by implied consent); *see generally* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 507.03(b) (2023).

⁵ Petitioner seeks to cancel the Registration also on the ground that the Registered Mark is generic

under Sections 1, 2, 3, and 45 of the Trademark Act, 15 U.S.C. §§ 1051, 1052, 1053, and 1127, and if not generic, that it is merely descriptive of the identified services under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), without having acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f) (19 TTABVUE 11-12); and on the ground that the Registered Mark is primarily geographically descriptive under Section 2(e)(2) of the Trademark Act, 15 U.S.C. § 1052(e)(2). (19 TTABVUE 11-12).

In a cancellation proceeding, the challenged Registration has a presumption of validity. Trademark Act Section 7(b), 15 U.S.C. § 1057(b). Accordingly, the “party seeking to cancel a registration must overcome the registration’s presumption of validity by a preponderance of the evidence.” *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) (citation omitted). *Accord DuoProSS Meditech Corp. v. Inviro Med. Devices, Ltd.*, 103 USPQ2d 1753, 1756 (Fed. Cir. 2012) (merely descriptive grounds); *Cold War Museum*, 92 USPQ2d at 1629-30 (grounds of no acquired distinctiveness); *In re Uman Diagnostics AB*, 2023 USPQ2d 191, at *28 (TTAB 2023) (citations omitted) (genericness grounds); *ShutEmDown Sports, Inc. v. Lacy*, 102 USPQ2d 1036, 1045 (TTAB 2012) (nonuse grounds); *see also In re Societe Generale des Eaux*

“for the title holders of Colorado state beauty pageants involving married women,” 19 TTABVUE 11 ¶ 5, but we only focus on the services identified in the Registration; we cannot read in limitations based on evidence of the parties’ current or historical uses which might suggest something different. *See, e.g., SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983) (“[W]here the likelihood of confusion is asserted with a registered mark, the issue must be resolved on the basis of the [services] named in the registration and, in the absence of specific limitations in the registration, on the basis of all normal and usual channels of trade and methods of distribution.”) (citation omitted).

Minerals de Vittel, S.A., 824 F.2d 957, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987) (ex parte appeal on grounds that mark was primarily geographically descriptive).

The case is fully briefed. Having considered the evidentiary record, the parties' arguments, and applicable authorities, for the reasons set forth below, we grant the Amended Petition for Cancellation on the ground that the Registration is void ab initio.

I. Respondent's Answer and Affirmative Defenses

In its Answer,⁶ Respondent denies the salient allegations of the Amended Petition, and asserts that its mark is "inherently distinctive and enjoys strong recognition and secondary meaning." (24 TTABVUE 4 ¶ 3). Respondent also asserts several affirmative defenses, including acquiescence, laches, and estoppel (24 TTABVUE 4 ¶ 2), and "unclean hands, unfair competition, false designation, fraud, prior registration and license, and common law." (24 TTABVUE 3 ¶ 1). But Respondent did not pursue acquiescence, estoppel, unclean hands, or fraud in its trial brief, so we deem these waived or forfeited. *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013) (affirmative defense not argued in brief deemed waived), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *NT- MDT LLC v. Kozodaeva*, 2021 USPQ2d 433, at *5 n.8 (TTAB 2021) (citing *Alcatraz Media*). Unfair competition and "false designation," which we construe as false designation of origin, are not claims that the Board may entertain in a cancellation proceeding. *See Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1481 (Fed. Cir. 1990) (Board cannot adjudicate unfair competition claims); *Fiat Grp. Autos. S.p.A. v. ISM, Inc.*, 94 USPQ2d 1111, 1116 n.8 (TTAB 2010) (claims under Section 43(a) of

⁶ Registrant's Answer to Amended Petition for Cancellation, 24 TTABVUE ("Answer").

the Trademark Act, 15 U.S.C. § 1125(a), are outside the Board's jurisdiction); *see generally* TBMP § 102.01.

Respondent's purported reservation of "the right to rely on any further affirmative defenses that become available or appear during discovery and reserves the right to amend its Answer for the purposes of asserting any such affirmative defenses," (24 TTABVue 4 ¶ 4), is improper because the reservation does not give Petitioner fair notice of such defenses. *Philanthropist.com, Inc. v. Gen. Conf. Corp. of Seventh-Day Adventists*, 2021 USPQ2d 643, at *4 n.6 (TTAB 2021), *aff'd per curiam*, No. 2021-2208, 2022 WL 3147202 (Fed. Cir. Aug. 8, 2022) (mem); *see also FDIC v. Mahajan*, 923 F. Supp. 2d 1133, 1141 (N.D. Ill. 2013).

II. 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 prosecution file for Respondent's MRS. COLORADO registration. While all of the evidence has been carefully considered, not all of it will be discussed. Much of the evidence is duplicative, with the same exhibits being submitted as attachments to declarations or under notice of reliance.⁷ The parties also introduced the evidence listed below.

⁷ "When evidence has been made of record by one party in accordance with these rules, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence." Trademark Rule 2.122(a), 37 C.F.R. § 2.122(a). Thus, it is not necessary for the parties to introduce testimony and evidence multiple times.

Petitioner's Evidence

Petitioner submitted a Notice of Reliance (28 TTABVUE),⁸ introducing into the record:

1. Respondent's Responses to Petitioner's First Set of Interrogatories (Ex. A10), Respondent's Responses to Petitioner's First Set of Requests for Admission (Ex. A11)⁹, Respondent's Responses to Petitioner's Second Set of Requests for Admission (Ex. A12)¹⁰, and Respondent's Responses to Petitioner's Second Set of Interrogatories (Ex. A13) (28 TTABVUE 8-36)
2. A copy of the Colorado Secretary of State "Application for Registration of Trademark" for MRS. COLORADO (Ex. A14) (28 TTABVUE 37)
3. Selected documents (status record, application filing receipt, Office Action, Examiner's Amendment, plain copy of registration certificate) from the TSDR database for the prior registration, MRS. COLORADO, Reg. No. 3259786 ("the '786 Registration" or "Prior Registration") (Ex. A15) (28 TTABVUE 39-47)
4. Extension of Time to oppose the Prior Registration (Ex. A16) (28 TTABVUE 49)
5. "Best Beauty Pageants: 2021 Edition," from the Pageant Planet website, www.pageantplanet.com/article/best-beauty-pageants (Ex. A18) (28 TTABVUE 66-104)
6. Excerpts from the Feb. 10, 2021 Deposition of Emily Stark, Respondent's CEO (28 TTABVUE 105-20)

⁸ Petitioner included selected documents from the Trademark Status and Document Retrieval (TSDR) file for the Registered Mark (Ex. A17, 28 TTABVUE 50-64), but this file is already included in the record. Trademark Rule 2.122(b).

⁹ Responses 4 through 9 are denials. A denial in response to a request to admit establishes neither the truth nor falsity of the assertion, but leaves the matter for proof at trial; they cannot be submitted under a notice of reliance. FED.R.CIV.P. 36(b); Trademark Rule 2.120(k), 37 C.F.R. § 2.120(k); *see also* TBMP § 704.10. As a result, we do not consider responses 4 through 9.

¹⁰ Responses 11 through 13 are also denials, which will not be considered.

In addition, Petitioner submitted:¹¹

7. The October 16, 2021 testimony Declaration of Laura Clark, National Director for Miss Earth USA (25 TTABVUE 3-7). Petitioner disclosed Ms. Clark as an expert witness.¹² (15 TTABVUE).

8. The October 16, 2021 testimony Declaration of Stephanie Williams, CEO and owner of Crown Garland LLC, and CEO of Cosmos International Pageants, Inc. (25 TTABVUE 9-14). Petitioner disclosed Ms. Williams as an expert witness.¹³ (15 TTABVUE).

9. The October 16, 2021 testimony Declaration of Tanice Smith, Petitioner's founder, owner, and Executive Director (with Exs. A1-A9, A20, and A21)¹⁴ ("Smith Decl.," 25 TTABVUE 16-24)

¹¹ Petitioner designated all of its testimony and exhibits at Vol. I (26 TTABVUE) and Vol. II (27 TTABVUE) as "confidential testimony." Except where indicated, however, most of the documents are not confidential, and many of them were posted at 25 TTABVUE without a confidential designation. "The Board may treat as not confidential that material which cannot reasonably be considered confidential, notwithstanding a designation as such by a party." Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g); *see generally* TBMP § 412.01(a) ("Proper Designation of Confidential Matter"). Accordingly, we will consider only commercially sensitive or trade secret information as confidential.

¹² In her declaration, Ms. Clark testifies, "Mrs. Colorado' is both a generic and descriptive term used in the pageant industry to describe pageants of a certain type (i.e., for married women) and in a particular location (i.e., in Colorado)." (25 TTABVUE 6; *see also* 25 TTABVUE 12 (Williams Declaration)). Whether or not it is expert testimony, the Board does not consider statements that go to an ultimate question of law, such as whether Respondent's mark is generic or whether a likelihood of confusion exists. The opinions of witnesses, even expert witnesses, on such questions are entitled to no weight, because "we will not substitute the opinion of a witness, even an expert witness, for our evaluation of the facts." *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1402 (TTAB 2010) (citing *Mennen Co. v. Yamanouchi Pharm. Co.*, 203 USPQ 302, 305 (TTAB 1979) (holding the "opinions of witnesses, including those qualified as expert witnesses, on the question of likelihood of confusion are entitled to little if any weight and should not be substituted for the opinion of the tribunal charged with the responsibility for the ultimate opinion on the question.")). Accordingly, on ultimate questions of law, we give no weight to the opinions of the parties' expert witnesses.

¹³ In her declaration, Ms. Williams testifies, "Mrs. Colorado' is both a generic and descriptive term used in the pageant industry to describe pageants of a certain type (i.e., for married women) and in a particular location (i.e., in Colorado)." (25 TTABVUE 12). The opinions of witnesses, even expert witnesses, on questions of law are entitled to no weight. *Edwards Lifesciences*, 94 USPQ2d at 1402 (citing *Mennen*, 203 USPQ at 305).

¹⁴ Exhibits A2-A9 (25 TTABVUE 27-292; 26 TTABVUE 27-46; 27 TTABVUE 2-190) are not clearly and properly identified and authenticated in the Declaration of Tanice Smith. The documentary and Internet material in Exhibits A2-A8 is not listed in Petitioner's Notice of Reliance. In addition, much of the Internet material does not display its source (i.e., website address or URL) or the date printed, and therefore, does not comply with the self-authentication requirements of *Safer Inc. v.*

Petitioner also submitted the following evidence during its rebuttal period:

10. The rebuttal Declaration of Tanice Smith (41 TTABVUE 2-15), with Rebuttal Exs. A-E (41 TTABVUE 16-54)

11. The Rebuttal Testimony Deposition of Emily Stark (45 TTABVUE 2-32), with Exs. 1-23 (45 TTABVUE 33-79)

12. The rebuttal Declaration of Stephanie Williams (44 TTABVUE 2- 6)¹⁵

Respondent's Evidence

Respondent submitted a Notice of Reliance (33 TTABVUE),¹⁶ introducing into the record:

1. Petitioner's Answers to Registrant's First Set of Interrogatories to Petitioner (Nos. 1-42) (Ex. 4) (33 TTABVUE 5-29)

2. Feb. 5, 2021 discovery Deposition of Tanice Smith(Ex. 5) (33 TTABVUE 30-58)

In addition, Respondent submitted:

3. The December 16, 2021 Testimony Declaration of Emily Stark (30 TTABVUE 3-13), with Exs. 1A-1I (30 TTABVUE 14-240) and Exs. 1J-1M (32 TTABVUE 2-373)

OMS Invs. Inc., 94 USPQ2d 1031, 1039 (TTAB 2010). Even though Respondent has not objected on the record, inasmuch as the evidence at Exhibits A2-A9 has not been properly authenticated, we will give it no consideration generally, *see Starbucks U.S. Brands, LLC v. Ruben*, 78 USPQ2d 1741, 1748 (TTAB 2006); *see generally* TBMP § 704.08(c), unless it is Internet evidence that complies with the requirements of *Safer*, or unless we find the evidence to be particularly probative.

¹⁵ The rebuttal Declaration of Stephanie Williams was executed and served on March 30, 2022, well after Petitioner's Rebuttal Period ended on March 11, 2022. "A party may not ... execute or submit a testimony affidavit or declaration, outside of its assigned testimony period, except by stipulation of the parties approved by the Board, or on motion granted by the Board, or by order of the Board." TBMP § 707.03(b)(1). However, we will consider it since Respondent did not object, but instead included the declaration in its description of the record. *See, e.g., Int'l Dairy Foods Ass'n v. Interprofession du Gruyère*, 2020 USPQ2d 10892, at *3 n.12 (TTAB 2020) (declarations dated prior to testimony period and submitted by opposers as trial testimony considered because applicants did not object to them as untimely and treated them as part of the record by raising substantive objections against them), *aff'd sub. nom. Interprofession du Gruyère v. U.S. Dairy Exp. Council*, 575 F.Supp.3d 627 (E.D. Va. 2021), *aff'd sub. nom. Interprofessionnel du Gruyère v. U.S. Dairy Exp. Council*, 61 F.4th 407, 2023 USPQ2d 266 (4th Cir. 2023).

¹⁶ Exhibits 6 and 7 to Respondent's Notice of Reliance are stricken from the record. *See* Order, 37 TTABVUE.

4. The December 15, 2021 Declaration of Ashley Starling, co-owner of Clothed in Strength Productions, LLC. (31 TTABVUE 3-10). Respondent disclosed Ms. Starling as an expert witness. (16 TTABVUE).

5. The December 16, 2021 Testimony Declaration of Christina Sacha, owner and operator of Creating the Perfect You, a pageant coaching business, and former Mrs. Colorado title holder (31 TTABVUE 11-16), with photos at Ex. 1. (31 TTABVUE 15). Respondent disclosed Ms. Sacha as an expert witness. (16 TTABVUE).

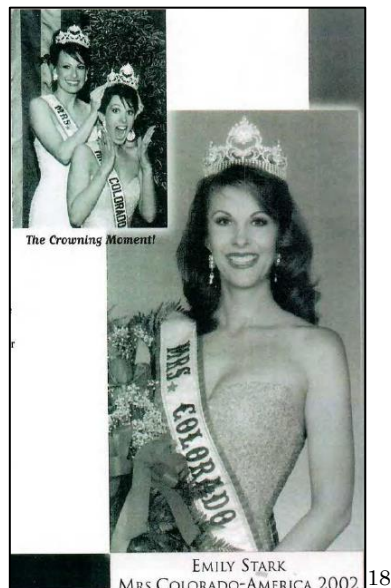
III. The Parties

A. Petitioner

Petitioner Miss United States of America LLC is a Nevada limited liability company which was formed in June 2017 by Tanice Smith, and began operations in January 2018. (Smith Decl., 25 TTABVUE 16). Petitioner recruits pageant contestants from across the United States, and operates pageants in a number of states, including Colorado. (25 TTABVUE 17). According to Ms. Smith, for “internal purposes,” Petitioner calls its Colorado pageant “Mrs. Colorado,” because according to her, “the pageant system is clear.” (25 TTABVUE 19). But Ms. Smith also testified that it is industry practice to include the national organization in the state pageant title: “For outward-facing mentions” Petitioner “typically includes the pageant system name in order to distinguish which system the Mrs. Colorado is from” (25 TTABVUE 19). Accordingly, in public, or for “outward-facing mentions,” the Colorado state title holder of Petitioner’s “Mrs.” division pageant uses the title “United States of America’s Mrs. Colorado” or “USOA Mrs. Colorado.” (*see* Ex. A2, 25 TTABVUE 115; *see also* Ex. 1, 31 TTABVUE 15).

B. Respondent

Respondent Abundance Productions, LLC is a Colorado limited liability corporation with offices in Parker, Colorado.¹⁷ Emily Stark, Respondent's owner, is an independent contractor for the Mrs. America Pageant, and she produces the Mrs. Colorado Pageant. (Stark Decl., 30 TTABVUE 3). Ms. Stark "took over the MRS. COLORADO directorship in 2008," (30 TTABVUE 4; *see also* 28 TTABVUE 108), which includes production, finding participants, marketing, obtaining sponsorships, and finding community appearances for the pageant. (30 TTABVUE 5-6). She has "crowned one Colorado woman every year since 2008 with the title of 'Mrs. Colorado,' with the exception of the three years when [her] agreement with Mrs. Dampier had lapsed, during which time the winner was crowned as 'Mrs. Colorado America.'" (30 TTABVUE 7). Ms. Stark estimates that the MRS. COLORADO pageant has "anywhere from 36 to 65 contestants per year." (28 TTABVUE 120).



¹⁷ TSDR record for Reg. No. 5600946.

¹⁸ Cropped photo of Emily Stark, Mrs. Colorado-America 2002. 32 TTABVUE 327.

C. Background and Prior Use of MRS. COLORADO

Since 1938, the title “Mrs. Colorado” has been used in conjunction with the Mrs. Colorado Pageant. (30 TTABVUE 3). According to Ms. Stark, “[t]he Mrs. Colorado title is historically the oldest beauty pageant in Colorado and continues to be the largest pageant competition in Colorado for married women.” (30 TTABVUE 4). The winner of the Mrs. Colorado Pageant advances to compete for the “Mrs. America” title at the Mrs. America national pageant. (30 TTABVUE 3-4).

From 1938 until 1990 (except during a brief hiatus in the 1960s), the Mrs. Colorado Pageant operated under the names “Mrs. Colorado” or “Mrs. Colorado America.” (See 28 TTABVUE 8-9). According to USPTO records, the MRS. COLORADO mark was first used on July 29, 1976 by Mrs. Colorado America, Inc. (TSDR for Reg. No. 3259786, 28 TTABVUE 39-47).

On October 15, 2008, Mrs. Colorado America, Inc. assigned the '786 Registration and its goodwill to Mrs. Patricia Dampier. (28 TTABVUE 40-41). Mrs. Dampier, who earned the MRS. COLORADO title in 1989, (28 TTABVUE 28), had operated the pageant under the MRS. COLORADO name since 1990. (See 28 TTABVUE 9).



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¹⁹ Cropped photo. 32 TTABVUE 303.

On January 12, 2009, Mrs. Dampier entered into an agreement to license use of the '786 Registration and other intellectual property²⁰ to Respondent. ("Intellectual Property License Agreement," 27 TTABVUE 193-99). Respondent, through its principal Ms. Stark, had been directing and producing the MRS. COLORADO pageant since 2008. (30 TTABVUE 4; *see also* 28 TTABVUE 108).

Due to a disagreement between the parties, the license agreement was expressly terminated on April 20, 2015. ("License Agreement Termination Agreement," 27 TTABVUE 213-17). As a result, from April 20, 2015 through December 2017, Respondent used "Mrs. Colorado America" for its pageant activities, as permitted by the Termination Agreement. (*See* 27 TTABVUE 214). The Termination Agreement, which included a \$5,000.00 "buy-out fee" of the non-competition and "listings" restrictions of the license agreement, also provided that Respondent could use certain intellectual property, including the '786 Registration, only for specific historical uses and wind-down activities. (27 TTABVUE 213-14).

The '786 Registration, also referred to in this opinion as the "Prior Registration," was cancelled on February 16, 2018 for Mrs. Dampier's failure to file declarations of use and renewal under Sections 8 and 9 of the Trademark Act, 15 U.S.C. §§ 1058 and 1059. (28 TTABVUE 40). According to Ms. Stark, in the fall of 2017, "Mrs. Dampier wanted to give the trademark to my company," but the two women could not agree on some of the terms of that agreement, so Ms. Stark "chose to let Mrs. Dampier's trademark expire and

²⁰ This cancellation proceeding pertains to the '946 Registration only.

then file paperwork for [the MRS. COLORADO mark].” (30 TTABVUE 6 ¶ 14; *see also* 30 TTABVUE 10 ¶ 26).

In January 2018, Respondent sent “informational” letters to Petitioner and the Mrs. Colorado International pageant “to try to avoid any community confusion and maintain brand separation.” (30 TTABVUE 8; *see also* 28 TTABVUE 25-26). On March 28, 2018, Respondent filed a new application to register MRS. COLORADO for “Entertainment in the nature of beauty pageants,” claiming a date of first use in commerce and anywhere of June 2, 2008. The registration issued on November 6, 2018.

IV. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a requirement in every inter partes case. *Austl. Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2066 (2014)). A party in the position of plaintiff may seek cancellation of a registration of a mark when doing so is within its zone of interests and it has a reasonable belief in damage that is proximately caused by the registration of the defendant’s mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *6-7 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021) (holding that the test in *Lexmark* is met by demonstrating: (1) a real interest in opposing or cancelling a registration of a mark, which satisfies the zone-of-interests requirement; and (2) a reasonable belief in damage proximately caused by registration of the mark). Once the plaintiff shows an entitlement to a statutory cause of action on one ground, it has the right to assert any other grounds in a cancellation proceeding. *See Hole In 1 Drinks, Inc. v. Lajtay*, 2020 USPQ2d 10020, at *3 (TTAB 2020) (once standing

shown on one ground, plaintiff has right to assert any other ground in proceeding); *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1479 (TTAB 2017) (standing established based on surname claim sufficient to establish standing for any other ground).

In her declaration, Ms. Tanice Smith, Petitioner's founder, owner, and Executive Director, testified that Petitioner received a January 10, 2019 letter from Respondent's founder, Ms. Stark, demanding that Petitioner cease use of "Mrs. Colorado" based on Respondent's ownership of the MRS. COLORADO Registration. (25 TTABVUE 21-22, ¶¶15-16; *see also* 25 TTABVUE 26 (Jan. 10, 2019 letter)). Petitioner has thus established its entitlement to a statutory cause of action for the cancellation. *See Books on Tape, Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987) (finding competitor has standing because it has an interest in the outcome beyond that of the general public); *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at *6 (TTAB 2020) (entitlement to a statutory cause of action found where petitioner and respondent are competitors); *Ipcor Corp. v. Blessings Corp.*, 5 USPQ2d 1974, 1976-77 (TTAB 1988) (cease and desist letter sent by applicant coupled with opposer's use of the mark found sufficient to demonstrate opposer's standing); *see generally* TBMP § 309.03(b) ("Entitlement to a Statutory Cause of Action").

V. Laches

The affirmative defense of laches "may be defined as the neglect or delay in bringing suit to remedy an alleged wrong, which taken together with lapse of time and other circumstances, causes prejudice to the adverse party and operates as an equitable bar." *A.C. Aukerman Co. v. R.L. Chaides Constr. Co.*, 960 F.2d 1020, 22 USPQ2d 1321, 1325 (Fed. Cir. 1992). Although Respondent asserted "laches" as an affirmative defense in its

Answer, it did not argue this defense in its trial brief. (*See* 24 TTABVUE 4 ¶ 2). In any event, “laches is not available as a defense in an action to remove a registration which was clearly void ab initio.” *Wandel Mach. Co. v. Altoona Fam Inc.*, 133 USPQ 410, 410-11 (TTAB 1962) (citation omitted); *see also Am. Velcro, Inc. v. Charles Mayer Studios, Inc.*, 177 USPQ 149, 153 n.5 (TTAB 1973). Thus, because we find that the underlying application and resulting registration for Respondent’s Mark is void ab initio, laches is not a defense available to Respondent.

VI. The Registration is Void Ab Initio.

We now address Petitioner’s claim that Respondent’s Registration is void ab initio because the mark was not in use at the time Respondent filed its use-based application. In the Amended Petition, Petitioner alleges “Upon information and belief, Registrant has no independent, bona fide use of MRS. COLORADO prior to submission of the use-based application. Registration No. 5600946 should therefore be cancelled as void ab initio.” (19 TTABVUE 11 ¶ 9).

The law is clear that a use-based application and its resulting registration can be held void if the petitioner pleads and proves nonuse of a mark for the identified services prior to the application filing date. *See ShutEmDown Sports*, 102 USPQ2d at 1045 (citing *Grand Canyon W. Ranch LLC v. Hualapai Tribe*, 78 USPQ2d 1696, 1697 (TTAB 2006)). The “use in commerce” requirement for a mark used in conjunction with services is divided into two parts: (1) when it is used or displayed in the sale or advertising of services; and (2) 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. Trademark Act § 45; *see also Couture v. Playdom, Inc.*, 778 F.3d 1379, 113 USPQ2d 2042, 2043 (Fed. Cir. 2015).

In a use-based application for services, if an applicant fails to use its mark “in commerce” in association with any of the services in a particular class specified at the time of filing, the application and any resulting registration are void ab initio as to those services on the ground of nonuse. *Couture v. Playdom*, 113 USPQ2d at 2043 (citing Trademark Rule 2.34(a)(1)(i), 37 C.F.R. § 2.34(a)(1)(i)); *see also Aycock Eng’g Inc. v. Airflite, Inc.*, 560 F.3d 1350, 90 USPQ2d 1301, 1305 (Fed. Cir. 2009). “A service mark specimen must show the mark as used in the sale of the services, including use in the performance or rendering of the services, or in the advertising of the services. The specimen must show a direct association between the mark and the services.” Trademark Act § 2.56(b)(2), 37 C.F.R. § 2.56(b)(2). “Mere publicity about services to be rendered in the future does not lay a foundation for an application. The statute requires not only the display of the mark in the sale or advertising of services but also the rendition of those services in order to constitute use of the service mark in commerce.” *Intermed Comms., Inc. v. Chaney*, 197 USPQ 501, 507-08 (TTAB 1977); *see also Aycock Eng.*, 90 USPQ2d at 1308. “Rendering services requires actual provision of services.” *Couture v. Playdom*, 113 USPQ2d at 2044 (citing MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:103 (4th ed. Supp. 2013)).

For use-based applications identifying entertainment services in Class 41, the actual entertainment services must have been rendered on or before the filing date of the application. *See, e.g., Couture v. Playdom*, 113 USPQ2d at 2043 (use of the service mark “Playdom” to advertise goods and services on a website that was under construction, where

no goods or services were ever provided, does not constitute “use in commerce” for identified Class 41 entertainment services); *Am. Polo Ass’n., LLC v. Scripps*, Canc. No. 92066032, 2019 WL 7423482 (TTAB Dec. 19, 2019) (nonprecedential)²¹ (petition to cancel use-based registration for POLO GIRLS for “Entertainment in the nature of ongoing television programs in the field of polo sports events, and polo lifestyle,” in Class 41 granted; respondent’s sporadic use of POLO GIRLS in three short, unconnected online videos produced over a period of two years did not meet the legal standard for rendering of services on or before the date of the application was filed); *United Glob. Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1044 (TTAB 2014) (use-based application for BEAUTV void ab initio where applicant had not rendered any of the services, identified as “providing information about beauty,” before or at the time the application was filed); *In re Cedar Point, Inc.*, 220 USPQ 533, 535 (TTAB 1983) (use-based application for OCEANA for “marine entertainment park” void ab initio where applicant began to issue press releases, brochures, and flyers, advertising the new marine entertainment park addition to applicant’s amusement park, but the new addition was not open for business when the application was filed). *See generally* TRADEMARK MANUAL OF EXAMINING PROCEDURE §§ 1301.03(b) (“Rendering of Service in Commerce Regulable by Congress”), 1402.11 (“Identification of Services”), and 1402.11(g) (“Recorded Entertainment Services”) (“For entertainment services such as those rendered by a musical group, the performance must be live.”) (Nov. 2023).

²¹ Non-precedential decisions are not binding on the Board, but we may cite to and consider them for whatever persuasive value they may have. *In re Fiat Grp. Mktg. & Corp. Commc’ns. S.p.A.*, 109 USPQ2d 1593, 1596 n.6 (TTAB 2014).

Petitioner contends that Respondent was not using its MRS. COLORADO mark in commerce as of the filing date of the Application for “Entertainment in the nature of beauty pageants,” as Respondent had not yet rendered any pageant services under its mark as of its March 28, 2018 application filing date, and that any use of the Prior Registration by Respondent that predated its March 28, 2018 application filing date was under the Intellectual Property License Agreement and inured to the benefit of Mrs. Dampier. (*See* 46 TTABVUE 37-43). Petitioner further contends that any use by Respondent of its MRS. COLORADO mark, which occurred after three years of nonuse of the Prior Registration, constitutes a new and separate use with a new date of first use, which occurred after the March 28, 2018 application filing date for Respondent’s Mark. (*See id.*).

Respondent counters that at the time it filed the application to register its MRS. COLORADO mark, Respondent submitted a specimen of a webpage, shown below, with the words “MRS. COLORADO PAGEANT” at the top and a pink rectangle superimposed with the words “BUY TICKET HERE” through which the public could purchase tickets for the MRS. COLORADO pageant. (Ex. A17-012, 28 TTABVUE 50-64). Respondent further contends that the Mark has been used continuously by Registrant since 2008 and has never been abandoned. (*See* 49 TTABVUE 23-24).



On March 28, 2018, Respondent filed a use-based application that matured into its registration for MRS. COLORADO, identifying “Entertainment in the nature of beauty pageants” as services in Class 41. In the declaration for the application, Respondent alleged that its mark was in use at the time of filing. 15 U.S.C. § 1051(a); Trademark Rule 2.34(a)(1)(i).

Respondent engaged in preparatory efforts for the April 2018 MRS. COLORADO pageant through activities such as marketing, advertising, booking talent, securing facilities, sponsors, and contestants, executing contracts since at least April 2017.²³ (32 TTABVUE 250-51 (April 2017 letter from Holiday Inn Denver-Cherry Creek);

²² Specimen for Serial No. 87853397 (Reg. No. 5600946), filed Mar. 28, 2018, as shown in Petitioner’s Notice of Reliance at 28 TTABVUE 62. We cannot consider this evidence, however, because the webpage does not comply with the requirements of Trademark Rule 2.122(k), 37 C.F.R. §2.122(k) (“Matters in evidence”), specifically, no URL and access date are shown on the webpage.

²³ While preparatory efforts may be considered use analogous to trademark use and relevant for priority purposes, preparatory efforts do not constitute actual use when determining whether a registration is void ab initio. *See, e.g., Aycock Eng’g*, 90 USPQ2d at 1301 (discussing whether service mark was void ab initio for failure to render the services); *Westrex Corp. v. New Sensor Corp.*, 83 USPQ2d 1215, 1218 (TTAB 2007) (discussing pre-sales analogous use in priority context); *see also* 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 16:14, 16:33 (5th ed. Dec. 2023 Update).

32 TTABVUE 252-91 (various documents including other preparatory activities)). Respondent sold online tickets to the public since at least January 25, 2018. (32 TTABVUE 71; *see also* 32 TTABVUE 286-91 (“Happy New Year” email message dated Jan. 2, 2018 from Emily Stark to pageant contestants, stating “Tickets go on sale January 25 and 26”)). But the operative date is March 28, 2018, the filing date of the use-based application which issued as the ’946 Registration. Ticket sales (online or at the box office) and preparatory activities such as marketing and advertising do not amount to rendering “Entertainment in the nature of beauty pageants.” *See, e.g., In re Cedar Point*, 220 USPQ at 535.

Respondent did not render its entertainment services until its 2018 MRS. COLORADO Pageant actually took place. Based on our review of the record, Respondent’s 2018 MRS. COLORADO Pageant did not occur until on or about April 16, 2018.²⁴

Furthermore, we find that Respondent’s licensed use of the Prior Registration does not qualify as rendering “Entertainment in the nature of beauty pageants.” Under the terms of the license agreement, all of the goodwill pertaining to the Prior Registration belonged to Mrs. Dampier, and all rights resulting from the use of the Prior Registration inured to the benefit of Mrs. Dampier.²⁵ *See also Moreno v. Pro Boxing Supplies, Inc.*, 124 USPQ2d 1028, 1034-36 (TTAB 2017) (“It is well-settled that use of a mark by a licensee inures to the benefit of the trademark owner.”) (citations omitted).

²⁴ *See Mrs. Colorado America Pageant Crowning 2018*, XPOSER MAG. BLOG (Apr. 16, 2018), Ex. 1J, 32 TTABVUE 145-72 (“Mrs. Colorado” used throughout post); *see also* 30 TTABVUE 11 ¶ 32.

²⁵ “Intellectual Property License Agreement,” ¶ 9, 27 TTABVUE 194-95.

VII. Conclusion

By a preponderance of the evidence, Petitioner has made a prima facie case that Respondent had not used the MRS. COLORADO mark as of the March 28, 2018 application filing date, and Respondent has not rebutted this showing. Respondent provided no probative evidence during its testimony period demonstrating its bona fide use of the MRS. COLORADO mark in commerce in connection with “Entertainment in the nature of beauty pageants,” on or before the application filing date. The ’946 Registration is thus void ab initio and is cancelled on this ground. We do not reach Petitioner’s claims that the Registration is generic, merely descriptive, primarily geographically descriptive, or that it has been abandoned.

Decision: The Amended Petition to cancel Registration No. 5600946 is granted.