

This Opinion is Not a
Precedent of the TTAB

Mailed: January 30, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Monster Energy Company
v.
Howard Vernick and Coulter Ventures, LLC d/b/a Rogue Fitness

—
Cancellation No. 92072010

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Steven J. Nataupsky, Matthew S. Bellinger, Lauren Keller Katzenellenbogen,
Jason A. Champion, and Alexander D. Zeng of Knobbe, Martens, Olson & Bear,
LLP for Monster Energy Company

Louis DiSanto and Anthony J. Denis of Banner & Witcoff, Ltd. for Howard Vernick
and Coulter Ventures, LLC d/b/a Rogue Fitness

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Before Lynch, Lebow, and Elgin, Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:


I. Introductory Background and Evidentiary Record¹

Petitioner Monster Energy Company (“Petitioner”) seeks to cancel Registration
No. 4383307, now owned by Coulter Ventures, LLC d/b/a Rogue Fitness (“Coulter”),

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¹ Citations in this opinion to the briefs and other materials in the case docket refer to TTABVUE, the Board’s online docketing system. *See New Era Cap Co. v. Pro Era, LLC*, Opp. No. 91216455, 2020 TTAB LEXIS 199, *4 n.1 (TTAB 2020). The number preceding TTABVUE

and previously owned by Howard Vernick (“Vernick”) (collectively, “Respondents”). The Board joined Coulter as a party defendant when, during the pendency of this proceeding, an assignment to Coulter of the registration being challenged was recorded with the USPTO.²



The challenged registration for the mark  (ATHLETE disclaimed)

recites the following services in International Class 41:

Athletic training services; Consulting services in the fields of fitness and exercise; Personal fitness training services and consultancy; Physical fitness training of individuals and groups; Training services in the field of sport specific movement.³

corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear.

As part of an internal Board pilot citation program on broadening acceptable forms of legal citation, this order cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For decisions of the Board, this order employs citations to the LEXIS legal database and cites only precedential decisions, unless otherwise specified. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 101.03 (2024). Proceeding and serial numbers also are included for decisions of the Board. Those Board decisions that issued on or after January 1, 2008 may be viewed in TTABVUE by entering the proceeding number, application number, registration number, expungement/reexamination number, mark, party, or correspondent. Many precedential Board decisions that issued from 1996 to 2008 are available through USPTO.gov in the TTAB Reading Room by entering the same information. Most TTAB decisions that issued prior to 1996 are not available in USPTO databases.

² 12 TTABVUE (January 6, 2020 Order).

³ Registration No. 4383307 (“the ’307 Registration”) issued August 13, 2013, and has been maintained. The registration includes the following description: “The mark consists of a stylized dark blue and lime green letter ‘M’ with the stylized wording ‘MONSTER ATHLETE’ below it where ‘MONSTER’ appears in dark blue and ‘ATHLETE’ appears in lime green. The stylized ‘M’ has a depiction of an eye on the left side of the ‘M’ which is outlined in dark blue, with a dark blue pupil, white iris, and curved line of lime green. There are four lime green

The petition to cancel the registration asserts abandonment under Trademark Act Section 45, 15 U.S.C. § 1127, which is the sole ground for decision before the Board.⁴

In its trial Brief, Petitioner refers to Vernick's assignment to Coulter as an "invalid assignment-in-gross because Vernick had already abandoned the Mark."⁵ Respondents countered, asking the Board to reject Petitioner's attempt to raise a new, unpled ground for cancellation.⁶ See TBMP § 314 (2024) ("A plaintiff may not rely on an unpleaded claim") and cases cited therein. Petitioner does not assert or address invalidity of the assignment as a separate ground on reply.⁷ We construe Petitioner's arguments regarding the invalidity of the assignment, which appears under the Abandonment heading in Petitioner's Brief as merely elaborating on Petitioner's position that Vernick already had abandoned the mark as of that timeframe, and not as arguing a separate asserted ground for cancellation.

Respondents' Answer denies the salient allegations of the Petition for Cancellation and raises no affirmative defenses. The case is fully briefed.⁸

waves that represent spikes above dark blue and lime green lines that form a tale with a lime green spike that extends away from the letter 'M'. Other than the white in the iris, white is not claimed as a feature of the mark and represents background. The colors lime green, dark blue, and white are claimed as a feature of the mark."

⁴ The Board previously struck a likelihood of confusion claim as time-barred. 15 TTABVUE.

⁵ 116 TTABVUE 37 (Petitioner's Brief).

⁶ 118 TTABVUE 50 (Respondents' Brief).

⁷ 120 TTABVUE (Petitioner's Reply Brief).

⁸ Applicant's Brief cites to non-precedential cases without identifying them as such, in violation of TBMP § 101.03(a)(2) ("Any nonprecedential cases must be clearly identified as nonprecedential."). Non-precedential decisions are not binding on the Board, but may be relied upon for whatever persuasive value they may have. *In re Fiat Grp. Mktg. & Corp. Comm'ns. S.p.A.*, Serial No. 79099154, 2014 TTAB LEXIS 29, at *10 n.6 (TTAB 2014).

The parties both list the contents of the record in their briefs,⁹ and the lists are consistent. To their credit, neither party raised unnecessary evidentiary objections. Given the agreement and lack of objections, we consider all the listed evidence, according it whatever probative value is appropriate.


II. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action must be established in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 1373 (Fed. Cir. 2020) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 n.4 (2014)). A party in the position of plaintiff may seek cancellation of the registration of a mark when such proceedings are within the zone of interests protected by the statute and the plaintiff has a reasonable belief in damage that is proximately caused by registration of the mark. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1303 (Fed. Cir. 2020).

Based on the evidence of record, we find that Petitioner has cleared the “low threshold for a plaintiff to go from being a mere intermeddler to one with an interest in the proceeding.” *Estate of Biro v. Bic Corp.*, Opp. No. 73600, 1991 TTAB LEXIS 65, *14 (TTAB 1991). That is, we find that Petitioner has a legitimate commercial interest in this matter that falls within the zone of interests protected by statute, and a reasonable belief in damage to that legitimate commercial interest, proximately

⁹ 116 TTABVUE 10-12 (Petitioner’s Brief); 118 TTABVUE 9-10 (Respondents’ Brief).



caused by continued registration of Respondents' mark . *Luca McDermott Catena Gift Trust v. Fructuoso-Hobbs, SL*, 102 F.4th 1314, 1325 (Fed. Cir. 2024).

Petitioner properly made of record its numerous MONSTER-formative registrations for marks for goods and services that include “All purpose sport bags,” and “Sports helmets,”¹⁰ which raises plausible likelihood of confusion issues with Respondents' mark for services that include athletic training and personal fitness training for which sports bags and sports helmets could be complementary. Although the Board struck Petitioner's likelihood of confusion claim as time-barred against this registration, this does not foreclose Petitioner's reliance on plausible likely confusion of the marks as the basis for its reasonable belief in damage and interest in cancelling Coulter's registration based on abandonment.

Coulter, which acquired the registration at issue during the pendency of this proceeding, is also engaged with Petitioner in other Board proceedings involving MONSTER-formative marks, including one where Coulter is in the position of

¹⁰ 1 TTABVUE 71-74 (Registration No. 3923683, issued February 22, 2011; renewed), 76-79 (Registration No. 3914828, issued February 1, 2011; renewed). *See* Trademark Rule 2.122(d)(1), 37 C.F.R. § 2.122(d)(1) (registrations made of record by attaching USPTO records showing status and title to the Petition for Cancellation).

plaintiff and Petitioner is in the position of defendant.¹¹ In that proceeding, Coulter identified this case to the Board herein for consideration as potentially related.¹²

Petitioner asserts that Coulter intends to assert the registration at issue in this case for advantage in the other Board proceedings.¹³ Coulter's corporate designee conceded that Coulter's only plans for the registration were and are to license the mark out, and since acquiring the registration in November 2019, the only licensee has been Vernick.¹⁴ Coulter also acquired Vernick's monsterathlete.com domain name registration in November 2019, but has not used it.¹⁵

According to Coulter's corporate designee, "Counsel at Banner Witcoff identified the "307 registration [at issue in this case] to Mr. [Kevin] Mueller [Coulter's General Counsel].¹⁶ Mr. Mueller instructed Banner Witcoff to investigate the possibility of acquiring the "307 registration."¹⁷ The registration was subsequently acquired by Coulter at the direction of its General Counsel without further discussion with "any members of [Coulter's] executive team" and without consulting with Coulter's marketing or sales teams.¹⁸ Given the parties' litigation, if Respondents' registered

¹¹ 77 TTABVUE 84-85.

¹² *Id.*

¹³ 120 TTABVUE 27 (Petitioner's Reply Brief).

¹⁴ 114 TTABVUE 434-35 (Coulter 30(b)(6) Deposition).

¹⁵ 114 TTABVUE 436 (Coulter 30(b)(6) Deposition).

¹⁶ 114 TTABVUE 412 (Coulter 30(b)(6) Deposition).

¹⁷ 114 TTABVUE 421 (Coulter 30(b)(6) Deposition).

¹⁸ 114 TTABVUE 421-22 (Coulter 30(b)(6) Deposition).

mark were deemed abandoned, it would no longer stand as an impediment to Petitioner's commercial interest in its MONSTER-formative marks.

In view of the foregoing, we find that Petitioner has established its entitlement to a statutory cause of action.

III. Abandonment

A. Legal Principles

The Lanham Act provides for canceling a registration at any time if the registered mark has been abandoned. *Rivard v. Linville*, 133 F.3d 1446, 1448 (Fed. Cir. 1998) (citing 15 U.S.C. § 1064(3)). This provision permits the abandoned mark to return to the public domain, so it may be used by others in the marketplace. *Exec. Coach Builders, Inc. v. SPV Coach Co., Inc.*, Opp. No. 91212312, 2017 TTAB LEXIS 201, *20 (TTAB 2017).

“A trademark is considered ‘abandoned’ if its ‘use has been discontinued with intent not to resume such use.’” Section 45 of the Trademark Act, 15 U.S.C. § 1127. There are two elements to a claim for abandonment: (1) nonuse; and (2) intent not to resume use.” *Tiger Lily Ventures Ltd. v. Barclays Cap. Inc.*, 35 F.4th 1352, 1360 (Fed. Cir. 2022). Section 45, quoted more fully below, provides that a mark shall be deemed to be abandoned:

- (1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

15 U.S.C. § 1127.

“This ‘bona fide use’ language was intended to eliminate ‘token uses,’ which occurred when applicants used marks in conjunction with selling goods or offering services for the sole purpose of obtaining registration, and with no intention of legitimately using the mark in commerce until a later date.” *Aycock Eng’g Inc. v. Airflite Inc.*, 560 F.3d 1350, 1357 (Fed. Cir. 2009); *see also Christian Faith Fellowship Church v. Adidas AG*, 841 F.3d 986, 989 (Fed. Cir. 2016) (providing an overview of the statutory use in commerce requirement).

Because a registration is presumed valid under the law, Trademark Act Section 7(b), 15 U.S.C. § 1057(b), a party seeking its cancellation bears the burden of proving abandonment by a preponderance of the evidence. *Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 1023 (Fed. Cir.1989). As noted in the excerpted statute above, proof of nonuse of a mark for three consecutive years establishes a prima facie case of abandonment. *On-Line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1087 (Fed. Cir. 2000). This eliminates the need to establish the intent element of abandonment as an initial part of a petitioner’s case, creating a rebuttable presumption that the registrant has abandoned the mark with intent not to resume use. *Rivard v. Linville*, 133 F.3d at 1449; *Imperial Tobacco, Ltd. v. Philip Morris, Inc.*, 899 F.2d 1575, 1579 (Fed. Cir. 1990). This presumption shifts the burden to the respondent to produce evidence of “what activities it engaged in during the nonuse period or what outside events occurred from which an intent to resume use during the nonuse period may reasonably be inferred.” *Imperial Tobacco*, 899 F.2d at 1581.

B. Analysis

Coulter has never used the mark itself, and Vernick, the original registrant, has been the only licensee since Coulter acquired the registration and attendant rights in November 2019.¹⁹ Thus, for purposes of assessing abandonment and use of the mark, the relevant inquiry rests entirely on Vernick's activities.

Vernick described himself as having worked for approximately 25 years as a professional volleyball coach for high schools and clubs, as well as conducting volleyball camps and clinics".²⁰ Along the way, he developed a small business focused on youth volleyball training. Vernick characterized it as a part-time occupation he undertook after retiring in 2011.²¹

The record suggests that he ran the business rather informally. He generated business by word of mouth, and through his website and Facebook.²² Otherwise, he did not advertise his services, noting "[a]s far as other ads, I never – I did not place ads in the – in newspapers or anything like that."²³ Sometimes he created flyers for his training programs, but "[i]t would depend on the program.... Some of them were word of mouth."²⁴ Sometimes Vernick offered volleyball training sessions at no cost

¹⁹ 114 TTABVUE 433-35 (Coulter 30(b)(6) Deposition).

²⁰ 81 TTABVUE 3 (Vernick Declaration).

²¹ 114 TTABVUE 605-07 (Vernick Deposition).

²² 114 TTABVUE 580 (Vernick Deposition). *See also* 78 TTABVUE 35-39 (website screenshots displaying the mark), 40-47 (Facebook pages displaying the mark).

²³ 114 TTABVUE 596 (Vernick Deposition).

²⁴ 114 TTABVUE 588 (Vernick Deposition).

to attendees,²⁵ such as one weeklong series at Senn High School where the school's coach noted that he and Vernick "didn't sign any formal agreement" and "there's no receipts for these trainings."²⁶ To secure gym space for some of his training, Vernick bartered with a school principal to give lessons to the principal's daughter in exchange for use of the school gym.²⁷ Vernick does not have bank or tax records for the business, which he "operated on a cash basis."²⁸

Vernick testified that he has engaged in "continuous use of the MONSTER ATHLETE Mark [defined as the composite mark at issue in this proceeding] since at least 2011."²⁹ He elaborated: "Each year since 2011, and continuing today, I have provided training services in connection with the MONSTER ATHLETE Mark, and advertised and promoted my services in connection with the MONSTER ATHLETE Mark by way of in-person, word-of-mouth, online, and/or in print materials, such as brochures, flyers, mugs, and/or shirts that I distributed at camps, clinics, competitions, and/or training sessions."³⁰ Regarding the online presence of the business, Vernick maintained two domain names, monsterathlete.com and

²⁵ 114 TTABVUE 579 (offered a free weeklong clinic at a Chicago high school).

²⁶ 114 TTABVUE 268-69 (Benson Deposition).

²⁷ 114 TTABVUE 132 (Gehringer Deposition). Mr. Gehringer described himself as Vernick's friend, and testified that they had an arrangement whereby Mr. Gehringer allowed Vernick to hold training sessions in Mr. Gehringer's school gym in Pennsylvania "for free... And in turn, [Vernick] would train [Gehringer's daughter Emma] for free." 114 TTABVUE 120-22 (Gehringer Deposition).

²⁸ 105 TTABVUE 535-36; *see also* 114 TTABVUE 600-01 (Vernick Deposition).

²⁹ 111 TTABVUE 5 (Vernick Declaration).

³⁰ 111 TTABVUE 6 (Vernick Declaration).

monstervolleyball.com.³¹ The former site redirected users to the latter site, which promoted his volleyball training services and displayed the mark.³² He registered the mark at issue in 2013 in connection with his business of providing volleyball training and coaching, including volleyball camps and clinics.³³

November 2016 marked a turning point for Vernick, when he relocated from Pennsylvania to Arizona.³⁴ The parties in this case paint different pictures of what transpired with the mark after that. Vernick claims he “continued to promote [his] training services using the MONSTER ATHLETE Mark as [he] established [him]self in the Arizona volleyball community.”³⁵

But Petitioner maintains that a period of nonuse of the mark began in September 1, 2016, shortly before Vernick’s move, and continued until December 5, 2019. Petitioner insists that Vernick “moved from Pennsylvania to Arizona to retire,” highlighting the fact that Vernick got rid of training equipment before the move, and unlike in prior years, from late 2016 to late 2019, no longer generated the same types of business documents as he had previously.³⁶ Petitioner relies on this period from September 1, 2016 until December 5, 2019 as a period of at least three consecutive

³¹ 111 TTABVUE 8 (Vernick Declaration).

³² 111 TTABVUE 8 (Vernick Declaration).

³³ 111 TTABVUE 6 (Vernick Declaration).

³⁴ 105 TTABVUE 506 (Vernick Deposition).

³⁵ 111 TTABVUE 26 (Vernick Declaration).

³⁶ 116 TTABVUE 16-18 (Petitioner’s Brief); *see also* 114 TTABVUE 610-11 (Vernick Deposition).

years of nonuse triggering the statutory presumption of abandonment.³⁷ While Petitioner acknowledges that Vernick testified to ongoing use of the mark during this timeframe, Petitioner contends that the testimony alone is insufficient and “Vernick failed to produce any documents showing use of the Mark or Monster Athlete during this period.”³⁸

Before turning to the alleged period of nonuse, we pause here to include some additional background about the nature of Vernick’s use of the mark during the earlier timeframe from 2011 to 2016. This background helps set the stage as to the nature of Vernick’s small business and the types of activities that constitute the ordinary course of trade for his volleyball-related services. And the understanding of Vernick’s ordinary course of trade will guide the analysis of whether his later activities are in keeping with it.

The record includes just a few examples of use of the mark on printed materials, such as flyers from 2013 and 2015,³⁹ and a “Hitter Statistics” sheet for recordkeeping at clinics in 2012-13.⁴⁰ But the primary use of the mark involved displaying it on t-shirts. The 2013 flyer bearing the mark promotes a four-day “Summer Volleyball Camp” and indicates that the \$195 cost “includes [a] Monster Athlete Tee Shirt.”⁴¹

³⁷ 116 TTABVUE 12 (Petitioner’s Brief).

³⁸ 116 TTABVUE 28 (Petitioner’s Brief).

³⁹ 82 TTABVUE 45, 59.

⁴⁰ 111 TTABVUE 16.

⁴¹ 82 TTABVUE 45.

Vernick frequently wore a shirt displaying the mark while rendering services.⁴² And he and several corroborating witnesses testified that he often distributed t-shirts bearing the mark to potential customers and to attendees of his training camps and sessions. In addition to Vernick's testimony regarding his use of the mark on shirts he wore and distributed,⁴³ Respondents' record includes the following testimony:

- Michael Gehringer, the school principal mentioned above whose child Vernick trained, testified that Vernick used his gym for training sessions, including during summer and fall 2016 and earlier, where Vernick handed out t-shirts bearing the mark and sometimes wore a t-shirt bearing the mark while providing his services.⁴⁴
- Brian Benson, a volleyball coach whose players participated in a training camp with Vernick in summer 2016, where Vernick handed out t-shirts bearing the mark.⁴⁵

⁴² *E.g.*, 111 TTABVUE 11, 19 (Vernick Declaration).

⁴³ *E.g.*, 111 TTABVUE 15, 16, 19-20, 22 (Vernick Declaration).

⁴⁴ 105 TTABVUE 47, 64, 74 (Gehringer Deposition, stating that he had seen the mark “[o]n T-shirts that my daughter has and that he [Vernick] would give out to other athletes”; that Vernick was “[b]oth wearing and providing them [t-shirts with the mark] to the athletes”; and that Vernick “often” wore such shirts); 114 TTABVUE 132 (Gehringer Deposition). Mr. Gehringer described himself as Vernick's friend, and testified that they had an arrangement whereby Mr. Gehringer allowed Vernick to hold training sessions in Mr. Gehringer's school gym in Pennsylvania (Summer 2016 and earlier) “for free... And in turn, [Vernick] would train [Gehringer's daughter Emma] for free.” 114 TTABVUE 120-22 (Gehringer Deposition). Mr. Gehringer testified to encountering the mark “[o]n T-shirts that [his] daughter has and that [Vernick] would give out to other athletes.” 114 TTABVUE 124 (Gehringer Deposition).

⁴⁵ 114 TTABVUE 263, 267-69 (Benson Deposition).

- Jason Smith, a friend of Vernick's⁴⁶ and a volleyball coach who assisted Vernick with some of his services from 2012 to 2015, who testified that Vernick "typically would hand out T-shirts [bearing the mark] at practices and things like that, just kind of bringing awareness to his services that he provided through Monster Athlete."⁴⁷

Turning back to the alleged period of nonuse, the first couple of months Petitioner relies on, September and October 2016, come before Vernick's move from Pennsylvania to Arizona. However, Vernick testified that he conducted volleyball training sessions under the mark at Mr. Gehringer's school gym "until November 2016" when Vernick moved.⁴⁸ Mr. Gehringer concurs, stating that Vernick provided training for Emma Gehringer and others "during the summer of 2016 between May and August,"⁴⁹ and Vernick continued to use Mr. Gehringer's gym to provide other private training sessions thereafter.⁵⁰ Mr. Gehringer testified that those sessions occurred "in the fall of 2016 after [Gehringer's] daughter had gone back to college," "up until the time [Vernick] decided to go to Arizona."⁵¹ As noted above, Mr. Gehringer stated that Vernick periodically wore t-shirts bearing the mark and

⁴⁶ 114 TTABVUE 195 (Smith Deposition).

⁴⁷ 105 TTABVUE 123 (Smith Deposition); 105 TTABVUE 222-24 (Smith Declaration); 105 TTABVUE 123-26, 136-37 (Smith Deposition); 114 TTABVUE 176-77, 198, 208-09 (Smith Deposition).

⁴⁸ 111 TTABVUE 25 (Vernick Declaration).

⁴⁹ 114 TTABVUE 137 (Gehringer Deposition).

⁵⁰ 114 TTABVUE 145-46 (Gehringer Deposition).

⁵¹ 114 TTABVUE 145-46 (Gehringer Deposition). Petitioner criticizes Mr. Gehringer's inability to provide "dates and specifics" of such sessions, 116 TTABVUE 14 (Petitioner's Brief), but we do not agree that this level of detail should be expected.

handed out t-shirts bearing the mark to attendees of his sessions.⁵² We find Vernick's and Mr. Gehringer's testimony and evidence persuasive to establish use of the mark during this timeframe.

Vernick's relocation occurred in November 2016, when he and his wife moved to Arizona to be closer to their daughter.⁵³ Vernick states that "[b]efore moving, [he] discarded many records and personal possessions, including records regarding [his] training services in connection with the MONSTER ATHLETE Mark."⁵⁴ As for the training equipment he relinquished, he reports that the equipment was "too large and expensive to ship."⁵⁵ He therefore donated it to a non-profit he had worked with.⁵⁶

After his relocation to Arizona in November 2016, Vernick concedes that his volleyball activities slowed down for a time, explaining, "I was in a brand-new state. They had different ... ways of doing things. And so it took me a while to acquaint myself with what volleyball opportunities were available in Arizona."⁵⁷ Nonetheless, he claims he continued to "promote [his] training services using the MONSTER ATHLETE Mark as [he] established [himself] in the Arizona volleyball community,

⁵² 105 TTABVUE 103 (Gehringer Declaration).

⁵³ 111 TTABVUE 26 (Vernick Declaration); 105 TTABVUE 506 (Vernick Deposition).

⁵⁴ 111 TTABVUE 26 (Vernick Declaration).

⁵⁵ 111 TTABVUE 26 (Vernick Declaration); *see also* 114 TTABVUE 586 (Vernick Deposition, stating that he donated equipment before his move because "these items were difficult to transport to Arizona, and because I didn't have any storage in Arizona for these items.").

⁵⁶ 105 TTABVUE 501 (Vernick Deposition).

⁵⁷ 105 TTABVUE 508 (Vernick Deposition).

including online.”⁵⁸ Respondents emphasize that Vernick maintained his website displaying the mark and promoting his services during this time.

Starting in February 2017, and continuing into 2018, Vernick held a part-time job as a volleyball instructor for the City of Surprise, Arizona. Vernick’s testimony about this job does not assert that his services for the City of Surprise were performed under the mark.⁵⁹ A testimony declaration from the custodian of records for the City of Surprise affirms in response to a subpoena from Petitioner that the city has no records related to Vernick’s Monster Athlete business.⁶⁰ The record also includes an introductory email from Vernick to the parents and athletes on his “2017 Maroon” volleyball team for Surprise Recreation, and although it provides a couple of paragraphs about Vernick’s background and experience, it does not mention Monster Athlete and does not display the mark.⁶¹ A later email about a team trip also does not display the mark or refer to Monster Athlete, and it directs payment by cash or check, with checks “made out to Howard Vernick.”⁶²

Also in 2017, Vernick testified that he “began the process of purchasing new volleyball equipment to use in connection with [his] training services.”⁶³ Vernick

⁵⁸ 111 TTABVUE 26 (Vernick Declaration).

⁵⁹ 111 TTABVUE 28-29 (Vernick Declaration); *see also* 81 TTABVUE 5 (Vernick Declaration, stating, “For example, between 2017-2018, I was hired by the City of Surprise, Arizona to run volleyball training camps and clinics, and I worked as a youth league coach for the Surprise Parks & Recreation Department.”).

⁶⁰ 98 TTABVUE 3-4.

⁶¹ 115 TTABVUE 103-04 (confidential).

⁶² 115 TTABVUE 106 (confidential)

⁶³ 111 TTABVUE 27 (Vernick Declaration).

provided two corroborating email exchanges with equipment providers. In a March 2017 exchange regarding a volleyball net, his signature block identifies him as “High School Varsity Coach” and “USAV Club Coach,” and the email indicates that he “intend[s] to use [the net] for training” and “look[s] forward to using it in [his] training.”⁶⁴ A January 2017 email exchange involves Vernick’s inquiry about purchasing a volleyball cart.⁶⁵ Vernick also “created videos for use in promoting [his] training services,” and “hired a freelancer” online to provide technical support.⁶⁶ Vernick was unsatisfied with the end results and “decided against using [the videos].”⁶⁷ A February 2017 email exchange with a customer service representative of the company, Fiverr, concerns technical assistance with the videos.⁶⁸ Vernick testified that he was unable to locate copies of the videos to produce in this proceeding.⁶⁹ The titles of the mp4 attachments in the email exchange, however, are “monsterathlete_v2” and “monsterathlete_v1.”⁷⁰

In 2018, Vernick states that he conducted “several training sessions for three to four athletes at Heritage Park in Surprise, Arizona” and “at least a few private

⁶⁴ 112 TTABVUE 49-51 (confidential email exchange); *see also* 111 TTABVUE 27, 28. The email exchange does not include a display of the mark..

⁶⁵ 112 TTABVUE 46-47 (confidential email exchange). The email exchange does not include a display of the mark.

⁶⁶ 111 TTABVUE 28 (Vernick Declaration).

⁶⁷ 111 TTABVUE 28 (Vernick Declaration).

⁶⁸ 111 TTABVUE 27-28 (Vernick Declaration); 112 TTABVUE 52-54 (confidential email exchange).

⁶⁹ 111 TTABVUE 28 (Vernick Declaration).

⁷⁰ 112 TTABVUE 54.

sessions with a student athlete from this group.”⁷¹ According to Vernick, these services were separate from his job with the city, and “were conducted in connection with the MONSTER ATHLETE Mark.”⁷² Vernick did not provide specific details about how participants would have encountered the mark, and candidly notes that he does not recall whether he provided attendees with t-shirts bearing the mark.⁷³ A confidential email in the record from Vernick’s juniorsusa@aol.com email address, dated April 16, 2018, refers to a “kick off practice session this Saturday” at Heritage Park, but does not display the mark.⁷⁴

In 2019, according to Vernick, he also conducted training sessions “in connection with the MONSTER ATHLETE Mark” from January to April 2019, on a weekly basis, with some exceptions.⁷⁵ Vernick testified that “[a]pproximately five athletes attended the training sessions throughout that time, but most sessions consisted of two to four athletes due to absences. At one of the training sessions, I distributed t-shirts and mugs displaying the Monster Athlete Mark to those that attended.”⁷⁶ Vernick supplied photos “showing examples of the t-shirts and mugs [he] distributed at the training sessions.”⁷⁷ He also supported this testimony with an invoice for his gym rentals, but the invoice is billed to “Harold Vernick” with no mention of Monster

⁷¹ 111 TTABVUE 30-31 (Vernick Declaration).

⁷² 111 TTABVUE 31 (Vernick Declaration).

⁷³ 111 TTABVUE 31 (Vernick Declaration).

⁷⁴ 112 TTABVUE 75 (confidential).

⁷⁵ 111 TTABVUE 33 (Vernick Declaration).

⁷⁶ 111 TTABVUE 33 (Vernick Declaration).

⁷⁷ 111 TTABVUE 33, 128-29 (Vernick Declaration).

Athlete.⁷⁸ A “kick off” email to parents for this program refers to it as “the USA Juniors volleyball program.”⁷⁹

Vernick’s daughter, Amanda Lester, whose 10-year-old daughter Amaya participated in the sessions, testified as follows in her declaration:

Beginning in January 2019, my daughter, Amaya, received volleyball training services from my father, Mr. Howard Vernick. I understood that the services were performed in connection with the MONSTER ATHLETE Mark.... The training sessions started on Saturday, January 12, 2019, and took place at the Peoria Sportsplex in Peoria, Arizona. We attended approximately 12 training sessions on Saturdays between January to April 2019. Approximately five to six students also attended the lessons throughout that time. Mr. Vernick taught the girls fundamental volleyball skills and other basics of the sport, and offered guidance on volleyball-specific strength and fitness training techniques. I understand that Mr. Vernick rented the Sportsplex for the training sessions and provided the equipment used at the sessions, including volleyballs. I paid Mr. Vernick about \$120 a month for the training sessions. At one of the earlier training sessions, Mr. Vernick distributed t-shirts and mugs bearing the MONSTER ATHLETE Mark. Attached to this declaration as Exhibit A is a photograph of the mug that we received at the training session. I understood from Mr. Vernick’s distribution of these items that he was using the MONSTER ATHLETE Mark to identify Mr. Vernick’s volleyball training services.⁸⁰

To counter the proposition that these services were under the mark, Petitioner submitted witness testimony from two other parents of students who participated in Vernick’s training from January to April 2019, as well as documents relating to the

⁷⁸ 112 TTABVUE 80-81 (confidential).

⁷⁹ 112 TTABVUE 85 (confidential).

⁸⁰ 105 TTABVUE 434-35 (Lester Declaration).

services. Ms. Jennifer Sawicki, whose daughter Kora participated in group volleyball lessons from Vernick in Peoria, Arizona approximately once a week from January 19, 2019, and April 28, 2019, provided a declaration.⁸¹ Ms. Sawicki set up the lessons through emails with Vernick and attended the lessons, but did not receive a t-shirt, mug, or other materials bearing the mark, and never otherwise encountered the mark or the term “Monster Athlete.”⁸² Several emails, which she attached, referred to the volleyball program as “USA Juniors,”⁸³ and reflect Vernick’s request for payment by cash or “a check to ‘Howard Vernick.’”⁸⁴

Rachel Ballowe, another parent whose daughter participated in some of the same volleyball lessons in Peoria, Arizona, also provided a declaration.⁸⁵ Ms. Ballowe communicated with Vernick and his daughter, Amanda Lester, about the lessons, and attended several lessons between January 12, 2019 and late February 2019.⁸⁶ Ms. Ballowe testified that she did not receive any merchandise bearing the mark, and did not otherwise encounter the mark or the term “Monster Athlete” in connection with the lessons either.⁸⁷

⁸¹ 96 TTABVUE. Respondents also submitted cross-examination deposition testimony. 109 TTABVUE; 110 TTABVUE (confidential email exhibits).

⁸² 96 TTABVUE 4-6 (Sawicki Declaration); 109 TTABVUE 70-71 (Sawicki Deposition).

⁸³ 96 TTABVUE 5 (Sawicki Declaration).

⁸⁴ 96 TTABVUE 6 (Sawicki Declaration).

⁸⁵ 97 TTABVUE (Ballowe Declaration). Respondents also submitted cross-examination deposition testimony. 108 TTABVUE.

⁸⁶ 97 TTABVUE 4 (Ballowe Declaration).

⁸⁷ 97 TTABVUE 4-5 (Ballowe Declaration); 108 TTABVUE 29-30 (Ballowe Deposition).

In response to Ms. Sawicki's and Ms. Ballowe's testimony that they apparently did not receive t-shirts or mugs bearing the mark, Vernick responded that he "presume[s] this is because they did not attend the session when [he] handed out the t-shirt and mug bearing the MONSTER ATHLETE Mark."⁸⁸ In Ms. Sawicki's and Ms. Ballowe's cross examination depositions, both witnesses confirmed that they and their daughters did not attend every session.⁸⁹ Ms. Ballowe, who identified a shorter timeframe for her daughter's participation in the sessions, with an end date in February, stated that she attended all the sessions except one.⁹⁰ Ms. Sawicki, who identified a longer timeframe for the sessions, with an end date in April, stated that she attended all but two or three sessions.⁹¹

As for the testimony and evidence regarding "USA Juniors," Vernick responded: "That I named the program 'USA Juniors' does not indicate that the training sessions were not conducted in connection with the MONSTER ATHLETE Mark."⁹² Ms. Lester explained that based on her longtime involvement in volleyball, "Juniors USA" would be understood as a general term "for kids about, like, that age range playing in competitive volleyball and training."⁹³ Vernick acknowledged that his emails and other correspondence with the parents in connection with the training did not

⁸⁸ 111 TTABVUE 33 (Vernick Declaration).

⁸⁹ 108 & 109 TTABVUE (Ballowe & Sawicki Declarations).

⁹⁰ 108 TTABVUE 20-21 (Ballowe Deposition).

⁹¹ 109 TTABVUE 42, 45 (Sawicki Deposition).

⁹² 111 TTABVUE 33 (Vernick Declaration).

⁹³ 105 TTABVUE 353 (Lester Deposition).

mention Monster Athlete or displayed the mark,⁹⁴ and the only specific use of the mark he point to in connection with these sessions was the merchandise giveaway.⁹⁵ He also emphasized that his granddaughter was a participant, and his daughter “was fully knowledgable [sic] that I had a business called Monster Athlete with that trademark.”⁹⁶

In June 2019, Vernick was contacted by an agent of Coulter about purchasing his “MONSTER ATHLETE trademark rights, the ’307 Registration, and the monsterathlete.com domain.”⁹⁷

From July 2019 to June 2020, Vernick held a volunteer job as an Assistant Varsity Coach for Show Low High School in Arizona.⁹⁸ He testified as follows about this timeframe:

While coaching, I promoted my training services in connection with the MONSTER ATHLETE Mark to members of the team, including by describing my private training services in connection with the MONSTER ATHLETE Mark while providing my background when being introduced to the team at the beginning of the season, and by periodically wearing t-shirts displaying the MONSTER ATHLETE Mark at team practices. In addition, I regularly conducted private training sessions for members of the team after team practices. I volunteered my training services in connection with these private training sessions and considered them to be performed in connection with the MONSTER ATHLETE Mark. During my deposition testimony of August 8, 2023, I stated that I did not use the MONSTER ATHLETE Mark in a visible

⁹⁴ 113 TTABVUE 20 (Vernick Deposition).

⁹⁵ 113 TTABVUE 21-22 (Vernick Deposition).

⁹⁶ 113 TTABVUE 21-22 (Vernick Deposition).

⁹⁷ 111 TTABVUE 37-38 (Vernick Declaration).

⁹⁸ 111 TTABVUE 34 (Vernick Declaration).

way while providing private training sessions to the setter of the Show Low High School team. While I do not recall whether I was wearing a t-shirt displaying the MONSTER ATHLETE Mark during the particular training sessions for the setter of the Show Low High School team, it was my regular practice to periodically wear t-shirts bearing the MONSTER ATHLETE Mark during team practices.⁹⁹

Petitioner petitioned to cancel the registration in August 2019. Initially, Vernick did not answer the petition, so it was granted by default judgment and the registration was cancelled.¹⁰⁰ Vernick testified that he was not aware of the petition to cancel, as he had not received notice of it because it went to his old address in Pennsylvania, which remained the correspondence address of record with the USPTO, and the petition was returned as “undeliverable.”¹⁰¹

⁹⁹ 111 TTABVUE 34 (Vernick Declaration).

¹⁰⁰ 8 TTABVUE (Board order); 9 TTABVUE (Commissioner’s order).

¹⁰¹ 111 TTABVUE 37. In the alleged period of nonuse for the statutory presumption of abandonment, Petitioner includes a few months when this cancellation proceeding already was pending, August 12, 2019 to December 5, 2019. In many cases a pending cancellation might excuse nonuse and not be counted in the time period for the statutory presumption of abandonment because a registrant who knows the registration is under attack may reasonably want to await the result of the proceeding before further investing in the mark. *See e.g., Penthouse Int’l, Ltd. v. Dyn Elecs., Inc.* (no proceeding number), 1977 TTAB LEXIS 72, at *17 (TTAB 1977) (“Nonuse of a mark pending the outcome of litigation to determine the right to such use or pending the outcome of a party’s protest to such use constitutes excusable nonuse sufficient to overcome any inference of abandonment.”); *see also ARSA Distrib., Inc. v. Salud Nat. Mexicana S.A. de C.V.*, Opp. No. 91240240, 2022 TTAB LEXIS 347, at **34-41 (TTAB 2022) (finding that Applicant’s nonuse during the pending dispute between the parties constituted excusable nonuse negating the inference of abandonment and Applicant’s vigorous defense of the oppositions supported a finding that Applicant maintained an intent to resume use of its mark).

However, that rationale does not apply here, as Respondents have averred they were not aware of the pendency of the proceeding then. *See* 11 TTABVUE (Motion to Set Aside Default Judgment); 82 TTABVUE 19 (Vernick Declaration, stating that he only learned of the cancellation on December 6, 2019).

On October 25, 2019, Vernick reached a deal with Coulter which included a license back for him to use the mark “in connection with [his] training services.”¹⁰² In November 2019, the assignment was recorded with the USPTO.¹⁰³ Vernick “republished [his] website content” with the mark (we discuss the temporary inactivity of Vernick’s website below) by December 6, 2019 on the new domain monsterathlete.net, and began referring to that web address in his promotions.¹⁰⁴ On December 20, 2019, Coulter successfully moved to set aside the default judgment and have the registration reinstated.¹⁰⁵ Coulter filed maintenance documents for the registration on February 4, 2020.¹⁰⁶

Ultimately, the only documents in the record bearing both a date during the alleged period of nonuse from September 1, 2016 through December 5, 2019 and the mark are Wayback Machine screenshots of Vernick’s website. These screenshots were captured during the relevant timeframe and authenticated by Vernick.¹⁰⁷ Examples

¹⁰² 111 TTABVUE 38 (Vernick Declaration).

¹⁰³ 111 TTABVUE 38, 147-48 (Vernick Declaration).

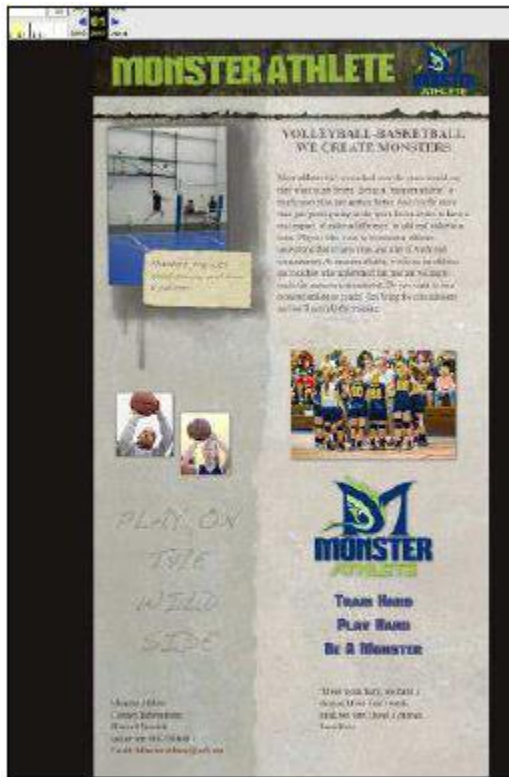
¹⁰⁴ 111 TTABVUE 35-36 (Vernick Declaration).

¹⁰⁵ The Board granted the motion, 15 TTABVUE, and the registration was reinstated, 16 TTABVUE.

¹⁰⁶ Vernick testified that he believed he had renewed the registration in July 2019 through TJ Supernaw of TTC Business Solutions, LLC. Vernick had directed a payment to TTC Business Solutions to maintain the registration. 111 TTABVUE 35-37 (Vernick Declaration). Vernick only learned on December 6, 2019 that the registration had been cancelled as a result of the default judgment and that the money he sent TTC Business Solutions, LLC was not used for his intended purpose. *Id.* at 37. Under the circumstances, we reject Petitioner’s argument that the belated submission of maintenance filings resulted from an intent to abandon the mark.

¹⁰⁷ *See* 77 TTABVUE 161-62 (collection of one screenshot bearing the mark for each year 2011-2021); *see also* 78 TTABVUE 6-23; 82 TTABVUE 15, 63-79. Vernick vouched for the

appear below, and there are additional examples in the record. Vernick repeatedly testified to promoting his services through the website, including stating, “I have used the monsterathlete.com and monstervolleyball.com websites as marketing and promotional tools. Among other things, I also used the sites to schedule training sessions, coordinate camps, and generally to promote my business.”¹⁰⁸



2017



2018

Petitioner argues that, unlike in previous years, the website remained almost unchanged in the screenshots from the alleged period of nonuse,¹⁰⁹ to which Vernick

accuracy of the screen captures. 82 TTABVUE 14-15 (authenticating the 2017 and 2018 Wayback Machine captures).

¹⁰⁸ 81 TTABVUE 4 (Vernick Declaration).

¹⁰⁹ 116 TTABVUE 16-17 (Petitioner’s Brief).

noted he only “updated [the website] on an as-needed basis.”¹¹⁰ Vernick testified to one change evident above – “[s]ometime during the summer of 2018, [he] updated [his] website to remove references to basketball training,” as reflected in the wording near the top of the webpages above.¹¹¹ In addition, evidence in the record of some prior Wayback Machine screen captures from before the alleged period of nonuse, such as December 2014 and February and March 2016, also appear relatively unchanged.¹¹²

Petitioner also points out that the website displayed an email, monsterathlete@aol.com, that was inactive or only minimally used.¹¹³ Vernick testified that he “only used that [email] account for a short time.”¹¹⁴

During the relevant timeframe, in March 2019,¹¹⁵ the monsterathlete.com website went inactive due to Vernick’s failure to renew the domain name for monstervolleyball.com, to which monsterathlete.com had redirected traffic.¹¹⁶ Vernick testified that this was because he “mistakenly failed to renew” the domain

¹¹⁰ 114 TTABVUE 599 (Vernick Deposition).

¹¹¹ 111 TTABVUE 31-32 (Vernick Declaration).

¹¹² 78 TTABVUE 7-8 (screenshot from December 30, 2014), 10-11 (screenshot from February 2, 2016), 36 (screenshot from March 25, 2016).

¹¹³ 114 TTABVUE 488 (Coulter 30(b)(6) Deposition) (five emails were sent between 2016 and 2020).

¹¹⁴ 114 TTABVUE 590 (Vernick Deposition).

¹¹⁵ 111 TTABVUE 35 (Vernick Declaration).

¹¹⁶ 111 TTABVUE 35 (Vernick Declaration).

registration.¹¹⁷ In one declaration, he stated he did not realize the website was inaccessible until “later in 2019.”¹¹⁸ An earlier declaration stated in more detail:

I believe two problems occurred. First, I mistakenly allowed the monstervolleyball.com domain to lapse, which I did not realize initially. I was using monsterathlete.com to redirect users to monstervolleyball.com. However, when the monstervolleyball.com domain lapsed, there was no place for monsterathlete.com to redirect to and the content of my website was unable to be viewed. Second, when I realized the problem, I attempted to republish my website through monsterathelete.com but was unsuccessful. I discovered that the software I had been using to create my website content, iWeb, was no longer compatible with the latest Mac operating system and iWeb was not being updated or supported. Because I was still coaching and providing training services, I intended to replace the iWeb software, update my website, including use of the '307 Registration trademark, and to republish my website on a working domain. I continued working on solutions through spring 2019.

Vernick eventually relaunched the website on monsterathlete.com on December 6, 2019,¹¹⁹ which is the day after the alleged period of nonuse. The new version of the website appears to include additional menu options along the top banner.¹²⁰

As additional documentary corroboration of Vernick’s testimony that he maintained an intent to continue providing services under the mark after his move to Arizona and during the period of alleged nonuse, Vernick points to résumés he distributed in 2017, 2018 and 2019 that referred to him as the owner and director of

¹¹⁷ 111 TTABVUE 35 (Vernick Declaration).

¹¹⁸ 111 TTABVUE 35 (Vernick Declaration).

¹¹⁹ 82 TTABVUE 17; *see also* 78 TTABVUE 25-26 (“whois” information for monsterathlete.net domain, showing registration on December 6, 2019).

¹²⁰ 82 TTABVUE 16; 77 TTABVUE 162.

Monster Athlete “2013 – Present,”¹²¹ suggesting that the business remained a going concern.

Petitioner argues that the minimal dated documentary evidence showing the mark during the period of alleged nonuse reflects a dramatic change from Vernick’s earlier time in Pennsylvania.¹²² Petitioner relies on discovery regarding the alleged period of nonuse showing, for example, the lack of “printed materials,”¹²³ sales and revenue records,¹²⁴ and customer/athlete sign-up registrations.¹²⁵ Petitioner lists the supposedly voluminous documents from that earlier timeframe, to contrast with the scant evidence from the alleged period of nonuse.¹²⁶

However, Petitioner’s Brief and record cites overinflate the alleged existence of voluminous documentary evidence from the earlier timeframe by sweeping in materials that did not display the mark, but instead merely included the wording “Monster Athlete,” which Vernick used to refer to his business.¹²⁷ And some of Petitioner’s claims, such as the mark being used in Vernick’s “signatures,” simply are

¹²¹ 111 TTABVUE 28, 30, 34 (Vernick Declaration). *See also* 112 TTABVUE (confidential) 56-58 (resume from 2017; *id.* at 68-70, 75-78 (resumes from 2018), *id.* at 91-95 (resume from 2019).

¹²² 116 TTABVUE 12-13 (Petitioner’s Brief).

¹²³ 77 TTABVUE 147-150 (Amended Responses to Requests for Admission Nos. 20-23). “Printed materials” were defined as “physical or electronic things and documents that are intended to be distributed physically but that does not include Facebook pages or website pages.” *Id.* at 148.

¹²⁴ 77 TTABVUE 98-99, 76-77.

¹²⁵ 77 TTABVUE 129-31 (Responses to Requests for Admission 12-15).

¹²⁶ 116 TTABVUE 12-13 (Petitioner’s Brief).

¹²⁷ 116 TTABVUE 12-13 (Petitioner’s Brief).

not borne out by Petitioner's record cites.¹²⁸ Overall, the record does not suggest such a dramatic drop-off in documentary evidence displaying the mark during the period of alleged nonuse. Instead it appears that Vernick was never in the practice of displaying the mark on a large number of documents. For instance, in response to Petitioner's request for sales revenue documents, Respondents noted that "Vernick does not maintain documents showing sales revenue since 2011," reflecting no change from before the alleged period of nonuse.¹²⁹ Overall, we find that the minimal documentary evidence showing use of the mark during the alleged period of nonuse is in keeping with use in Vernick's ordinary course of trade under the mark.

For Vernick's particular business, as reflected by the record regarding use pre-dating the alleged period of nonuse, the ordinary course of trade always has been part-time, occasional volleyball training services. Moreover, as discussed above, the record indicates that Vernick historically has conducted the business without a lot of accompanying business records. Thus, although typically "[t]he presence of business records documenting these activities would strengthen the registrant's case, and the absence of such records does the opposite," *Adamson Sys. Eng'g, Inc. v. Peavey Elecs. Corp.*, Canc. No. 92076586, 2023 TTAB LEXIS 454, *36 (TTAB 2023), the minimal documentary evidence in this case does not raise such a red flag.

We find that Petitioner has not met its burden of proving three consecutive years of nonuse by Respondents by a preponderance of the evidence, so as to trigger the

¹²⁸ 116 TTABVUE 13 (Petitioner's Brief citing to materials with signature blocks that may use the wording "Monster Athlete" but do not display the mark).

¹²⁹ 77 TTABVUE 98-99, 76-77.

statutory presumption of abandonment. We bear in mind that bona fide use in the ordinary course of trade requires consideration of the ordinary course of trade, within the meaning of Section 45 of the Trademark Act. *See Automedx, Inc. v. Artivent Corp.*, Opp. No. 91182429, 2010 TTAB LEXIS 343, *18 (TTAB 2010) (observing that “[u]se in commerce should be interpreted with flexibility to account for different industry practices.”).

In reviewing the evidence of alleged use by Vernick, and Petitioner’s evidence countering it,¹³⁰ we must “look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together.” *W. Fla. Seafood Inc. v. Jet Rests. Inc.*, 31 F.3d 1122, 1125-26 (Fed. Cir. 1994). “There is also no rule of law that the owner of a trademark must reach a particular level of success, measured either by the size of the market or by its own level of sales, to avoid abandoning a mark.” *Adamson Sys. Eng’g*, 2023 TTAB LEXIS 454, at *50 (quoting *Person’s Co. v. Christman*, 900 F.2d 1565 (Fed. Cir. 1990)). Moreover, use in commerce contemplates “commercial use of the type common to the particular industry in question.” *Paramount Pictures Corp. v. White*, Opp. No. 90130, 1994 TTAB LEXIS 14, *20 (TTAB 1994), *aff’d mem.*, *White v. Paramount Pictures Corp.*, 108 F.3d 1392 (Fed. Cir. 1997); *see also Double Coin Holdings Ltd. v. Tru Dev.*, 2019 TTAB LEXIS 347, at *34 (TTAB 2019) (“According to the statutory language and legislative history, ‘nonuse’

¹³⁰ We have considered but do not discuss the confidential “Attorneys’ Eyes Only” testimony of Sonia Doubet on behalf of the agent that assisted Coulter in negotiating for and acquiring the registration at issue in this case. 115 TTABVUE. We do not agree with Petitioner that her representations of discussions with Vernick about the mark point to abandonment.

of a mark for abandonment purposes means ‘no bona fide use of the mark made in the ordinary course of trade,’ and this is to be interpreted with flexibility to encompass a variety of commercial uses.”). We find that the type of use Vernick engaged in after his relocation, and during the period of alleged nonuse, is in keeping with the rather informal and occasional ordinary course of trade for his individual training and coaching.

As detailed above through the testimony of Vernick and Mr. Gehringer, Vernick performed services under the mark in Pennsylvania in October or November 2016.¹³¹ At a minimum, we find that Vernick’s display of the mark on his promotional website during much of the ensuing three years, until March 2019, along with proof of the services rendered, establish sufficient use to foreclose the presumption. Vernick’s maintenance of the website and his activities after his relocation, such as the volleyball training sessions rendered in January to April 2019, demonstrate the requisite type of bona fide use in the ordinary course of trade for Vernick’s small business.¹³² See, e.g., *Christian Faith Fellowship Church*, 841 F.3d at 994 (noting that the Federal Circuit has “refused to adopt a de minimis test for the ‘use in commerce’ requirement” and that the sale of two hats to an out-of-state resident qualified as use in commerce sufficient to support registration under the Trademark Act) (citation omitted).

¹³¹ 114 TTABVUE 145-46 (Gehringer Deposition); 111 TTABVUE 24 (Vernick Declaration).

¹³² While we rely on these services as one of the more compelling and well-supported instances of use of the mark during the relevant timeframe, this does not constitute a finding that these were the only services rendered under the mark.

During the period of alleged nonuse, the website featured the mark in connection with Vernick's recited services in the registration. The screen captures and testimony described above show that the website was available during most of the alleged period of nonuse (going inactive sometime in March 2019), and that Vernick made at least some update to the website in 2018, showing his attention to the site. We do not agree that any requirement exists for more substantial updates to the site, or that the inclusion of a minimally-used email address negates the probative value of the website. The site promotes the services and displays the mark.

As an example of Vernick rendering the services under the mark in the ordinary course of trade during the relevant timeframe, we find the record sufficient on this score as to the January to April 2019 sessions. We rely on Vernick's testimony, the testimony of Amanda Lester, the invoice for the gym rental, and the photographs of t-shirts and mugs bearing the mark that both witnesses state were like those distributed to attendees. We carefully considered the declarations and deposition testimony of Vernick and Ms. Lester and find them credible on this point.¹³³ They both expressed certainty that Vernick distributed t-shirts and mugs bearing the mark to attendees, conveying the connection between the mark and the services. Although Ms. Lester has a familial relationship with Vernick, we do not discount her testimony on that basis, as urged by Petitioner. We considered the potential for bias in reviewing

¹³³ For example, we note that in connection with Vernick's training sessions in 2018, which he also claims were under the mark, he candidly acknowledged that he cannot recall whether he distributed t-shirts bearing the mark, although it would have been in his interest to testify that he did so. 111 TTABVUE 31.

her declaration and deposition, but that is not a reason to automatically disregard her testimony, which was not self-serving. We find credible her contention that she was an actual, paying consumer of Vernick's services, and we find her testimony persuasive.

While the testimony from Ms. Sawicki and Ms. Ballowe reflect that these two other consumers of the same services did not understand the services to be in connection with the mark, it does not disprove Vernick's use. For one thing, their children represented only a couple of the larger group of five or six attendees.¹³⁴ We also find it reasonable that both Ms. Sawicki and Ms. Ballowe simply were not present for the particular session when Vernick distributed the merchandise bearing the mark. Neither Ms. Lester nor Vernick could identify the date of that session, and both Ms. Sawicki and Ms. Ballowe acknowledged that they and their children did not attend every session. In fact, Ms. Ballowe's daughter only participated in the first half of the sessions, from January 12 through February, and missed one session during that time.¹³⁵ Ms. Sawicki's daughter missed two or three sessions.¹³⁶

Petitioner attempts to piece together their testimony about dates and attendance with Ms. Lester's to establish that there was no "earlier session" Ms. Lester attended that both Ms. Sawicki and Ms. Ballowe missed.¹³⁷ But their collective testimony and

¹³⁴ 109 TTABVUE 32 (Sawicki Deposition).

¹³⁵ 108 TTABVUE 20 (Ballowe Deposition).

¹³⁶ 109 TTABVUE 45 (Sawicki Deposition).

¹³⁷ 116 TTABVUE 20-22 (Petitioner's Brief, table). Petitioner concedes that "Sawicki and Ballowe did not attend the second-to-last session on April 20, 2019, but insists that because

the accompanying emails are not sufficiently precise enough about dates and attendance to establish this proposition.¹³⁸ Ms. Lester stated, "...from my memory, I believe it was an earlier session [when the merchandise was distributed]. I don't remember the exact session, though."¹³⁹ Ms. Sawicki indicated that she based her answers about attendance from email and calendar entries, sometimes qualified her answers that she was not independently recalling the information or that it was to the "best of [her] recollection" only, and sometimes indicated that her daughter would have attended and/or Ms. Sawicki's husband accompanied their daughter, but not necessarily that she attended all the sessions in question.¹⁴⁰

Ultimately, given the nature and substance of Ms. Ballowe's and Ms. Sawicki's testimony, it does not contradict or disprove that of Ms. Lester and Vernick regarding the sessions in January to April 2019 and the merchandise distribution. We find that Ms. Lester's and Vernick's testimony is not undermined by Ms. Ballowe's and Ms. Sawicki's testimony.

Considering the record overall, we find that the mark remained in bona fide use in the ordinary course of Vernick's trade during the alleged period of nonuse. Thus,

Lester referred to distribution of the t-shirts at an "earlier session," this cannot resolve a potential discrepancy in their testimony. 120 TTABVUE 23-24 (Petitioner's Reply Brief).

¹³⁸ See, e.g., 108 TTABVUE 23-28 (Ballowe deposition testimony regarding attendance at particular sessions and who else attended); 109 TTABVUE 24-24, 31-49 (Sawicki deposition testimony regarding attendance at particular sessions and who else attended).

¹³⁹ 105 TTABVUE 352 (Lester Deposition).

¹⁴⁰ See, e.g., 109 TTABVUE 39, 45-46, 49 (Sawicki Deposition).

Petitioner cannot rely on the three-year statutory presumption of abandonment, and has not otherwise established the elements of its abandonment claim.

For completeness, we add that even if Vernick were deemed to have discontinued use during the alleged period of nonuse, we would find that he retained the requisite intent to resume use to avoid abandonment. 15 U.S.C. § 1127 (“use has been discontinued with intent not to resume such use”). Vernick’s activities in the relevant period, discussed above, would support an intent to resume use. In addition, we would rely on the record evidence of Vernick’s activity under the mark after the alleged period of nonuse to infer his intent to resume during the relevant timeframe.¹⁴¹ His activities in 2020 included, among others, updating his website and running ads on Facebook that promoted his services and featured the mark, and providing training sessions where mugs and t-shirts displaying the mark were distributed.¹⁴² Respondents submitted corroborating testimony from Anne Long, whose daughter Laila participated in the training sessions in Peoria, Arizona from November 2020 to May 2021. Ms. Long stated that she “understood that the services were performed in

¹⁴¹ We do not agree with Petitioner’s argument about the supposedly damning nature of Vernick’s testimony that that his decision “to start showcasing” the mark more after 2020 was influenced by the trademark dispute, which raised his awareness “of the importance of displaying” the mark. 120 TTABVUE 12-13 (Petitioner’s Reply Brief, citing 114 TTABVUE 761-762, 765-77).

¹⁴² 111 TTABVUE 38-42 (Vernick Declaration, detailing use of the mark in 2020); *see also* 120 TTABVUE 10-11 (Petitioner’s Reply Brief and records cites therein) (“After Coulter purchased Vernick’s Registration and the default judgment on November 26, 2019, Vernick suddenly embarked on a flurry of new activities to try to revive the Mark”).

connection with the MONSTER ATHLETE Mark [defined as the composite mark at issue in this case].”¹⁴³ She further testified:

At one of the training sessions, Mr. Vernick handed out t-shirts and mugs bearing the MONSTER ATHLETE Mark. Attached to this declaration as Exhibit A is a photograph of the t-shirt and mug that we received. It was my understanding that Mr. Vernick handed out these items to promote his volleyball training services provided in connection with the MONSTER ATHLETE Mark.¹⁴⁴

While evidence of subsequent intent to resume use does not rebut the presumption of abandonment, *Cerveceria Centroamericana*, 892 F.2d at 1027, the Board may consider evidence regarding activities that occurred outside the period of nonuse to infer intent to resume use during this three-year period. *Exec. Coach Builders*, 2017 TTAB LEXIS 201, at *86 (citing *Crash Dummy Movie, LLC v. Mattel, Inc.*, 601 F.3d 1387, (Fed. Cir. 2010)). The evidence would support such an inference here.

Decision: Petitioner has failed to establish that Respondents abandoned the registered mark within the meaning of Section 45 of the Trademark Act, 15 U.S.C. § 1127. We deny the petition to cancel.

¹⁴³ 107 TTABVUE 4 (Long Declaration).

¹⁴⁴ 107 TTABVUE 5 (Long Declaration).