

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: September 30, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Rascal House, Inc.*  
*v.*  
*Jerry's Famous Deli, Inc.*  
—

Cancellation Nos. 92075125 (parent)  
92075180  
92075185  
—

John M. Skeriotis of Emerson, Thomson & Bennett LLC,  
for Rascal House, Inc.

David K. Friedland and Jaime Rich Vining of Friedland Vining P.A.,  
for Jerry's Famous Deli, Inc.

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Before Rogers, Chief Administrative Trademark Judge,  
Heasley and Coggins, Administrative Trademark Judges.

Opinion by Heasley, Administrative Trademark Judge:

**I. Background**

This is the second part of a bifurcated proceeding. To recount pertinent parts of the background:

Respondent, Jerry's Famous Deli, Inc., acquired rights in a longstanding restaurant, "Wolfie Cohen's Rascal House" in Sunny Isles, Florida in 1996, and

opened another “Rascal House” restaurant in Boca Raton, Florida in 1998.<sup>1</sup> In 2000-2001, Respondent obtained Principal Register registrations for three marks:

**WOLFIE COHEN’S RASCAL HOUSE**, in typed drawing form,<sup>2</sup>

**RASCAL HOUSE**, in typed drawing form,<sup>3</sup> and

**WOLFIE COHEN’S RASCAL HOUSE RESTAURANT** and design (with “RESTAURANT” disclaimed), depicted as follows



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(Collectively, the “RASCAL HOUSE” marks.) All three Registrations recite services in International Class 42: “restaurant and carry-out restaurant services” for the

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<sup>1</sup> Respondent’s motion for summary judgment. 23 TTABVUE 4. *See ex. 5*, Rule 30(b)(6) deposition of Jonathan Mitchell, Respondent’s corporate designee, 28:12-21, 31:1-12, 23 TTABVUE 65, 66. Petitioner’s response to motion for summary judgment. 28 TTABVUE 4. Respondent’s reply in support of motion for summary judgment, 29 TTABVUE 4.

<sup>2</sup> Reg. No. 2411646, issued Dec. 12, 2000, renewed. A mark depicted as a typed drawing is the legal equivalent of a standard character mark. *See In re Viterra Inc.*, 671 F.3d 1358, 1363 n.2 (Fed. Cir. 2012); *see also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 807.03(i) (2024).

<sup>3</sup> Reg. No. 2406028, issued Nov. 21, 2000, renewed.

<sup>4</sup> Reg. No. 2432479, issued March 6, 2001, renewed.

typed drawing marks and “restaurant services and take-out food services” for the composite mark. Both of Respondent’s restaurants used the RASCAL HOUSE marks in connection with rendering restaurant and carry-out/take-out services until they closed their doors by 2008.<sup>5</sup>

In 2020 Petitioner, Rascal House, Inc., filed separate petitions to cancel each of Respondent’s RASCAL HOUSE registrations under Trademark Act Section 14, 15 U.S.C. § 1064, on the ground of abandonment. In its Answers, Respondent denied the salient allegations of the petitions for cancellation. The proceedings were consolidated, and all record citations are to the “parent” case, Cancellation No. 92075125.<sup>6</sup>

Respondent moved for summary judgment on Petitioner’s abandonment claim.<sup>7</sup>

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<sup>5</sup> Respondent’s motion, 23 TTABVUE 7. *See* Mitchell dep. 277:14-19, 157:5-17, (Petitioner’s request for admission to Respondent asks it to “[a]dmit that, since at least January 2009, Registrant has not operated a restaurant where the name of the restaurant includes Rascal House. [DEPONENT:] Yeah, that’s true.”); *see also* 143:9-11, 17-21, 149:23-24, (“Q On May 25, 2011 was there a restaurant named Wolfie Cohen’s Rascal House in existence? A No.” “Q But there was no Wolfie Cohen’s Rascal House Restaurant offering carry-out restaurant services on May 25, 2011, correct? A Correct.” “Q And there was no restaurant named Wolfie Cohen’s Rascal House on November 18, 2020 open for business, correct? A Correct.”), 23 TTABVUE 94-97, 127.

<sup>6</sup> 15 TTABVUE. Record citations are to TTABVUE, the Board’s publicly available docket history system. *See, e.g., New Era Cap Co., Inc. v. Pro Era, LLC*, 2020 WL 2853282, \*1 n.1 (TTAB 2020). 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.

As part of an internal Board pilot citation program on broadening acceptable forms of legal citation in Board cases, this decision 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 Westlaw legal database. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 101.03 (2024).

<sup>7</sup> 23 TTABVUE.

The Board denied the motion,<sup>8</sup> but suggested that the parties consider resolving this matter by way of the Board's Accelerated Case Resolution ("ACR") procedure. *See generally* TBMP §§ 528.05(a)(2), 702.04 and 705. To their credit, the parties agreed to do so.<sup>9</sup>

As the Court of Appeals for the Federal Circuit has observed, under Section 45 of the Trademark Act, "A trademark is considered 'abandoned' if its 'use has been discontinued with intent not to resume such use.' 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). The parties' ACR stipulation, which the Board approved, bifurcated the case into two stages tracking those elements.<sup>10</sup>

In Stage One, the Board determined that Respondent discontinued its use of all three RASCAL HOUSE marks in 2008, when it closed its two RASCAL HOUSE restaurants.<sup>11</sup> Respondent contended that it continued to display RASCAL HOUSE marks on menus and indoor and outdoor signage at its "Jerry's" restaurants (Jerry's Famous Deli, Jerry's Restaurant and Deli, and Jerry's Patio Café and Bar) located in Studio City, Encino, and Marina del Rey, California, and two "Epicure" supermarkets in Florida, and continued to do so until the last of these establishments closed in 2020-21 due to the COVID-19 pandemic.<sup>12</sup> But the Board found that Respondent's

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<sup>8</sup> 30 TTABVUE.

<sup>9</sup> ACR Stipulation, 33 TTABVUE.

<sup>10</sup> 34 TTABVUE.

<sup>11</sup> 36 TTABVUE.

<sup>12</sup> Respondent's motion, 23 TTABVUE 5-6, 15-17. Petitioner's response, 28 TTABVUE 8. Respondent's reply, 29 TTABVUE 6, 9, 11-12. Mitchell dep. 8:24-9:5, 32:20-22, 35:16-25, 40:6-

evidence of purported continued use did not constitute use in commerce of the marks in association with their identified services within the meaning of Section 45 of the Trademark Act, 15 U.S.C. § 1127.<sup>13</sup> In short, Petitioner made a prima facie showing of abandonment by demonstrating Respondent's nonuse of the registered RASCAL HOUSE marks for at least three years.<sup>14</sup>

For purposes of Stage Two, Respondent's position on non-abandonment is limited to the second element: whether it intended to resume use of its marks.<sup>15</sup> Stage Two provides for additional direct testimony, cross-examination, stipulations, and supplementation by the parties.<sup>16</sup> For purposes of this Stage Two opinion, we presume the parties' familiarity with the pleadings, the ACR Stipulation, the Board Order approving the stipulation, the arguments and evidence the parties submitted in connection with Respondent's motion for summary judgment,<sup>17</sup> and the parties' supplemental ACR briefs.<sup>18</sup> As the parties stipulated, "Subject to paragraph 3 below [concerning objections], the evidence submitted in connection with the parties' respective summary judgment briefing and permitted supplementation is authentic for purposes of admission into the evidence and deemed properly of record for

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41:14, 43:1-2, 44:12-15, 45:1-8, 47:2-16, 54:15-:3, 56:19-23, 72:2-6, 126:15-24, 127:3-128:10, 23 TTABVUE 60, 66-70, 72, 76, 90.

<sup>13</sup> 36 TTABVUE.

<sup>14</sup> Board decision on Stage One, 36 TTABVUE.

<sup>15</sup> ACR Stipulation, 33 TTABVUE 3.

<sup>16</sup> *Id.*, 33 TTABVUE 3-5.

<sup>17</sup> 23 TTABVUE; 28 TTABVUE; 29 TTABVUE.

<sup>18</sup> 38-40 TTABVUE.

purposes of the ACR trial and the Board’s ACR final decision....”<sup>19</sup> And as the Board accordingly ordered, “Evidence shall be admissible without authentication or accompanying witness testimony but [is] subject to objections on substantive grounds, such as hearsay, competency, relevancy, or materiality, or if the evidence was required to be disclosed in initial disclosures or requested but not produced during discovery.”<sup>20</sup> In accordance with the parties’ ACR Stipulation, we may resolve any genuine disputes of material fact and draw reasonable inferences from any such facts.<sup>21</sup> While we have carefully considered all of the parties’ arguments and evidence, we do not repeat or discuss all of them.

## **II. Entitlement**

Entitlement to a statutory cause of action is a requirement in every inter partes case. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370 (Fed. Cir. 2020) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 128 n.4 (2014)). A party in the position of plaintiff may petition for cancellation of a registered mark where such cancellation is within the zone of interests protected by the statute, 15 U.S.C. § 1064, and the party’s reasonable belief in damage is proximately caused by continued registration of the mark. *Luca McDermott Catena Gift Trust v. Fructuoso-Hobbs SL*, 102 F.4th 1314, 1325 (Fed. Cir. 2024); *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298 (Fed. Cir. 2020); *Peterson v. Awshucks SC, LLC*, 2020 WL 7888976, \*6 (TTAB 2020).

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<sup>19</sup> ACR Stipulation, 33 TTABVUE 5.

<sup>20</sup> Board Order Approving ACR Stipulation, 34 TTABVUE 4.

<sup>21</sup> ACR Stipulation, 33 TTABVUE 5. Again, the parties are commended for agreeing to proceed by ACR.

This is a low threshold, intended only to ensure that the plaintiff has a real interest in the matter, and is not a mere intermeddler. *Peterson v. Awshucks*, 2020 WL 7888976, at \*7. “Each of the zone-of-interests test and real-interests test serves the purpose of excluding only the claims of mere intermeddlers or ... meddlesome parties acting as self-appointed guardians of the purity of the Register.” *Luca McDermott v. Fructuoso-Hobbs*, 102 F.4th at 1325 (cleaned up). “The bar in demonstrating entitlement to a statutory cause of action is not high.” *Kimberley Kampers IP Pty Ltd v. Safiery Pty Ltd*, 2022 WL 16708341, \*2 (TTAB 2022).

The relevant statute provides that

A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged ... by the registration of a mark on the principal register established by this chapter...

(3) At any time if the registered mark ... has been abandoned ....

15 U.S.C. § 1064, *cited in Piano Factory Grp., Inc. v. Schiedmayer Celesta GmbH*, 11 F.4th 1363, 1376 (Fed. Cir. 2021).

The parties do not address or contest entitlement in their Supplemental briefs, which are devoted to the issue of intent to resume.<sup>22</sup> Petitioner has nonetheless proven its entitlement based on the pleadings, testimony, and documentary evidence in the record.<sup>23</sup> The record reveals that Petitioner’s predecessor in interest, R. House, Inc.,

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<sup>22</sup> The Board Order approving the parties’ ACR stipulation provided that “As with any Board proceeding, Petitioner bears the burden of proving its entitlement to bring a statutory cause of action. The issue of Petitioner’s entitlement will be addressed by Petitioner in its main supplemental briefing.” Board Order approving ACR Stipulation, 34 TTABVUE 2. The parties are reminded that the Order governs their conduct under ACR, not just the parties’ stipulation.

<sup>23</sup> *See* ACR Stipulation, 33 TTABVUE 5 (evidence submitted is “authentic for purposes of admission into the evidence and deemed properly of record for purposes of the ACR trial and

obtained Registration No. 2005731 (the '731 Registration) for RASCAL HOUSE (in standard characters) for “restaurants specializing in pizza and related foods and featuring home delivery” in October 1996.<sup>24</sup> Respondent JFD petitioned to cancel the '731 registration on the ground of likelihood of confusion with its registered RASCAL HOUSE marks.<sup>25</sup> The parties entered into a Settlement Agreement dated November 1999, agreeing to assign the '731 Registration, mark, and good will to Respondent JFD and to dismiss the proceeding to cancel that registration.<sup>26</sup> As part of the Settlement Agreement, Respondent JFD licensed Petitioner’s parent and predecessor-in-interest, R. House, Inc., to use the RASCAL HOUSE mark in certain states for the services recited in the '731 Registration, “restaurants specializing in pizza and related foods and featuring home delivery.”<sup>27</sup> Respondent JFD describes this license relationship in its brief in the present case: “By its own admission, [Petitioner] RHI, through R. House, was licensed to use RASCAL HOUSE through the 1999 license grant from JFD to R. House. Amended Petition to Cancel, ¶¶ 4-5.”<sup>28</sup>

The license agreement provided, in pertinent part, that:

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the Board’s ACR final decision ....”); Board Order Approving ACR Stipulation, 34 TTABVUE 4 (documents of record deemed admissible without authentication).

<sup>24</sup> Mitchell dep. 187:16-22, 212:7-20, 23 TTABVUE 105, 111. Friedland decl. ex. 6, 23 TTABVUE 191 (registration certificate); Friedland decl. ex. 10-1, 23 TTABVUE 395-97 (TSDR record). Skeriotis decl. ex. H, 28 TTABVUE 114 (TSDR record).

<sup>25</sup> Mitchell dep. 195:13-14, 23 TTABVUE 107; Friedland decl. ex. 6, 23 TTABVUE 188-191.

<sup>26</sup> Mitchell dep. 164:8-13, 195:8-12, 23 TTABVUE 99, 107. Friedland decl. ex. 9, 23 TTABVUE 249-252.

<sup>27</sup> Settlement Agreement ¶2, Friedland decl. ex. 9, 23 TTABVUE 250. License Agreement, Friedland decl. ex. 9, 23 TTABVUE 253-57. Mitchell dep. 162:18-24, 184:21-25, 185:10-24, 186:2-9, 23 TTABVUE 99, 104-05.

<sup>28</sup> Respondent’s Motion for Summary Judgment, 23 TTABVUE 7. See also Respondent’s Answer to Interrogatory no. 29: “INTERROGATORY NO. 29: State the time period that Registrant alleges that Petitioner was or is a licensee of U.S. Trademark Reg. No. 2005731.



This Agreement shall be in effect for so long as OWNER [Respondent JFD] maintains the above identified registration [731] as provided in a certain Assignment ....

Likewise, if Owner shall abandon the Mark for a period of three years or ceases to use same in interstate commerce for three years, then this License shall terminate and the Mark shall revert back to User.<sup>29</sup>

These terms tracked similar language in the parties' Assignment Agreement: "if Assignee [Respondent JFD] shall abandon the use of the name Rascal House for a period of three years or otherwise ceases to use same in interstate commerce for three years then this Assignment shall terminate and be rendered null and void upon which the name shall revert back to Assignor."<sup>30</sup>

In the pleadings in the present cancellation proceeding, Petitioner claims and Respondent admits that "Registration No. 2005731 for the Licensed Registered Mark was cancelled on April 24, 2020, because 'registrant did not file an acceptable declaration under Section 8,' according to the USPTO database records ...."<sup>31</sup> So the

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ANSWER: The license period began in 1999 with execution of the parties' agreement. Registrant is unaware of the specific termination date, as that date may rely upon information solely in Petitioner's possession that has yet to be disclosed in discovery. Registrant believes that Petitioner's license terminated when it first violated the 1999 agreement, which date is to be determined through discovery." Skeriotis decl. ex. F, 28 TTABVUE 77.

<sup>29</sup> License Agreement ¶2, Friedland decl. ex. 9, 23 TTABVUE 253-54. Mitchell dep. 188:13-17, 191:19-192:4, 193:23-194:3, 201:3-8, 23 TTABVUE 105-08.

<sup>30</sup> Addendum to Assignment of Trademark and Trademark Registration, Friedland decl. ex. 9, 23 TTABVUE 252.

<sup>31</sup> Petitioner's Amended Petition for Cancellation ¶6, 7 TTABVUE 3, Respondent's Answer thereto, ¶6, 14 TTABVUE 3 ("Registrant admits the allegations as to the status of Registration No. 2,005,731, which registration is not the subject of this Petition."). Friedland decl. ex. 10-1, 23 TTABVUE 395-97 (Petition exhibit A: RASCAL HOUSE Registration '731 cancelled). Skeriotis decl. ex. H, 28 TTABVUE 114 (TSDR record of cancelled RASCAL HOUSE Registration '731).

parties' 1999 agreement terminated (the parties blame each other).<sup>32</sup> Petitioner contends that the license terminated and "rights to use the RASCAL HOUSE mark reverted to R. House, Inc., the licensor to Petitioner [Rascal House, Inc.] of the trademark and trade name RASCAL HOUSE."<sup>33</sup> Respondent answers that the terms of the agreements speak for themselves, and denies the remaining allegations.<sup>34</sup>

The License Agreement between Respondent JFD and R. House, Inc. provided in pertinent part that "[t]he terms and provisions of this License shall inure to the benefit of and bind the successors and assigns and legal representatives and licensees of both OWNER [Respondent JFD] and USER [R. House, Inc.]."<sup>35</sup> R. House, Inc. entered into a "Confirmatory Trademark License Agreement" with Petitioner Rascal House, Inc. acknowledging and agreeing that it has licensed Petitioner to use the RASCAL HOUSE trademark in connection with restaurant services under the 1999 License Agreement with Respondent JFD, and that Petitioner is authorized to bring cancellation actions on behalf of its parent or in its own name against Respondent JFD regarding any RASCAL HOUSE and/or RASCAL HOUSE-formative trademark.<sup>36</sup>

Based on the evidence of record, we find that Petitioner, Rascal House, Inc., 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.*, 1991 WL 325858, \*4

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<sup>32</sup> Mitchell dep. 198:5-7, 164:17-20, 193:4-9, 23 TTABVUE 99, 106, 108.

<sup>33</sup> Petitioner's Amended Petition for Cancellation ¶ 10, 7 TTABVUE 4.

<sup>34</sup> Answer to Amended Petition for Cancellation, ¶ 10, 14 TTABVUE 3.

<sup>35</sup> License Agreement ¶6, 23 TTABVUE 255.

<sup>36</sup> Confirmatory Trademark License Agreement, Friedland decl., Ex. J, 23 TTABVUE 429-431.

(TTAB 1991). It has a legitimate commercial interest in the RASCAL HOUSE mark, an interest that falls well within the zone of interests protected by statute. *Luca McDermott v. Fructuoso-Hobbs*, 102 F.4th at 1325. It has a reasonable belief in damage to that legitimate commercial interest, proximately caused by continued registration of Respondent’s RASCAL HOUSE and RASCAL HOUSE-formative marks—witness the prior cancellation proceeding brought by Respondent. *Id.*; *Cf. Domino’s Pizza, Inc. v. Little Caesar Enters., Inc.*, 1988 WL 252360, \*4 (TTAB 1988) (“Opposer’s standing to bring this proceeding is clear, being evidenced not only by its status as a competitor of applicant in the pizza business, but also by its position as defendant in the civil action, wherein applicant relied on one of the designations now sought to be registered.”). In the first Stage of this proceeding, Petitioner made out a prima facie case of abandonment by showing Respondent’s nonuse of the registered RASCAL HOUSE marks for over three years.<sup>37</sup> 15 U.S.C. § 1127. And in this Stage, it has presented evidence and argument purporting to show that Respondent discontinued its use of the three registered marks at issue for over three years without intent to resume their use.<sup>38</sup> If the three registered marks are indeed abandoned, they become available for others to adopt and use. *Azeka Bldg. Corp. v. Azeka*, 2017 WL 2391862, \*7 (TTAB 2017). And they would no longer stand as an impediment to Petitioner’s legitimate commercial interest in using RASCAL HOUSE.

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

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<sup>37</sup> Board decision on Stage One, 36 TTABVUE.

<sup>38</sup> Petitioner’s Supplemental ACR brief, 28 TTABVUE; Petitioner’s Supplemental reply ACR brief, 40 TTABVUE.

### III. Discussion and Analysis

#### A. Applicable Law of Abandonment Generally

Section 45 of the Trademark Act, quoted more fully, 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.

Because a registration is presumed valid under the law, 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). 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); *Hornby v. Tjx Cos.*, 2008 WL 1808555, \*10 (TTAB 2008). Establishing a prima facie case eliminates the petitioner's burden to establish the intent element of abandonment as an initial part of its case, creating a rebuttable presumption that the registrant has abandoned the mark without intent to resume use. *Rivard v. Linville*, 133 F.3d 1446, 1449 (Fed. Cir. 1998); *Imperial Tobacco, Ltd. v. Philip Morris, Inc.*, 899 F.2d 1575, 1579 (Fed. Cir. 1990); *ARSA Dist., Inc. v. Salud Nat. Mexicana S.A. de C.V.*, 2022 WL 4592443, \*10 (TTAB 2022); *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 2017 WL 3034059, \*7 (TTAB 2017).

This presumption shifts the burden to the registrant to produce evidence that it either used the mark during the statutory period or intended to resume use. *Cerveceria Centroamericana v. Cerveceria India*, 892 F.2d at 1026; *Adamson Sys. Eng'g. Inc. v. Peavey Elec. Corp.*, 2023 WL 7274674, \*9 (TTAB 2023). The burden of persuasion, however, always remains with the petitioner to prove abandonment by a preponderance of evidence. *Rivard v. Linville*, 133 F.3d at 1449; *Azeka Bldg. v. Azeka*, 2017 WL 2391862, at \*9.

In this case, as noted, the Board found nonuse of the RASCAL HOUSE marks for more than three consecutive years after Respondent closed its RASCAL HOUSE restaurants in 2008.<sup>39</sup> Petitioner thus established a prima facie case of abandonment, eliminating its burden to establish the intent element as an initial part of its case, and creating a rebuttable presumption that Respondent abandoned the mark without intent to resume. *See, e.g., Adamson v. Peavey*, 2023 WL 7274674 at \*17 (citing *Rivard v. Linville*, 133 F.3d at 1449). Respondent did not prove use of the marks during the statutory period.<sup>40</sup> So the key issue for our determination at this second Stage is whether Respondent has produced sufficient evidence of intent to resume use.<sup>41</sup>

## **B. Applicable Law of Intent to Resume**

To meet its burden of production, “[t]he registrant must put forth evidence with respect to 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

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<sup>39</sup> 36 TTABVUE.

<sup>40</sup> 36 TTABVUE.

<sup>41</sup> ACR Stipulation, 33 TTABVUE 2-3.

reasonably be inferred.” *Imperial Tobacco v. Philip Morris*, 899 F.2d at 1581. *Accord Vans, Inc. v. Branded, LLC*, 2022 WL 3369641, \*24 (TTAB 2022) (“In order to establish intent to ... resume use, a respondent must put forth evidence with respect to either specific activities undertaken during the period of nonuse, or special circumstances which excuse nonuse.”).

The Federal Circuit elaborates: “Intent to resume use in abandonment cases has been equated with a showing of special circumstances which excuse a registrant’s nonuse. ... If a registrant’s nonuse is excusable, the registrant has overcome the presumption that its nonuse was coupled with an ‘intent not to resume use[.]’” *Imperial Tobacco v. Philip Morris*, 899 F.2d at 1581. Nonuse may be excusable if it is forced by outside causes. *See generally ARSA v. Salud Nat. Mexicana*, 2022 WL 4592443, at \*29-30 (providing examples of external causes such as war, labor strike, prohibition of the sale of liquor). But “if the activities are insufficient to excuse nonuse, the presumption is not overcome.” *Id.* at \*11; *see also Exec. Coach Builders v. SPV Coach*, 2017 WL 3034059, at \*25.

“To prove excusable nonuse,” the Federal Circuit states, “the registrant must produce evidence showing that, under his particular circumstances, his activities are those that a reasonable business[], who had a bona fide intent to use the mark in United States commerce, would have undertaken.” *Rivard v. Linville*, 133 F.3d at 1449, *quoted in Exec. Coach Builders v. SPV Coach*, 2017 WL 3034059, at \*26. “The intent must be to resume use of the mark within the reasonably foreseeable future once the reason for suspension abates.” *ARSA v. Salud Nat. Mexicana*, 2022 WL 4592443, at \*12 (citing 3 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION

§ 17:16 (“[A]s soon as the external cause has passed, the user must resume use within a reasonable time.”)).

### **C. Application of Law to This Case**

In the present case, Respondent’s president and corporate designee, Jonathan Mitchell, declares its intent to resume use of the RASCAL HOUSE marks:

At all times between 2008, when the last WOLFIE COHEN’S RASCAL HOUSE location closed, and 2021, when the last JFD establishments in California closed as a result of the COVID-19 pandemic, JFD always maintained a healthy interest in finding, and intended to find, new locations where all the JFD trademarks, including the three RASCAL HOUSE marks in this proceeding, would be featured on menus and signage identifying these brands to the public.

At no time during my tenure with JFD following the 2008 closure of WOLFIE COHEN’S RASCAL HOUSE did the company lack an intent to find new locations for our business and resume use of the JFD Marks beyond the usage on the menus and signage where the JFD Marks were used continuously throughout my tenure, through the closing of the final JFD establishments due to the COVID-19 pandemic.<sup>42</sup>

However, “[a] registrant’s proclamations of his intent to resume ... use in United States commerce during the period of nonuse are awarded little, if any, weight.” *Rivard v. Linville*, 133 F.3d at 1449. “In every contested abandonment case, the respondent denies an intention to abandon its mark; otherwise there would be no contest.” *Imperial Tobacco v. Philip Morris*, 899 F.2d at 1581. “Thus, to support a finding of intent to resume use of the mark, the owner must do more than simply assert a vague, unsubstantiated intent to make use of the mark at some unspecified time in the future.” *Yazhong Investing Ltd. v. Multi-media Tech. Ventures, Ltd.*, 2018

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<sup>42</sup> Mitchell decl. ¶¶ 11-12, 39 TTABVUE 25-26. See also Jason Starkman decl. ¶¶ 11-12, TTABVUE 77.

WL 2113778, \*12 (TTAB 2018) *quoted in Adamson v. Peavey*, 2023 WL 7274674, at \*21.

Respondent reiterates the position it took in Stage One of this bifurcated proceeding, averring that “After the last location of ‘WOLFIE COHEN’S RASCAL HOUSE’ restaurant closed in Sunny Isles, Florida in 2008, JFD continued to use JFD’s Marks on menus and signage at its other establishments.”<sup>43</sup> Respondent argues that such displays could evidence its reasonable efforts to use the marks, from which intent to resume may be reasonably inferred. It likens its displays to those in *Wells Fargo & Co. v. ABD Ins. & Fin. Servs.*, 758 F.3d 1069 (9th Cir. 2014) (finding Wells Fargo did not abandon its ABD mark).<sup>44</sup>

But Wells Fargo continued to make bona fide use of its ABD mark in the ordinary course of business, and did not have to show intent to resume use, according to the Court:

Wells Fargo acquired the original ABD Insurance and Financial Services (“Former ABD”) in 2007, at which point hundreds of Former ABD employees joined Wells Fargo offices. In 2008, Wells Fargo changed the name of ABD to “Wells Fargo Insurance Services,” but continued to display the Former ABD mark on customer presentations and solicitations, to maintain the abdi.com website and metatags, and to accept customer payments made to ABD.

In this case, Wells Fargo continued to use the mark in several ways, most notably in customer presentations and solicitations. Such uses demonstrate Wells Fargo’s business calculation that it could continue to benefit from the goodwill and mark recognition associated with ABD, and we conclude that Wells Fargo continued its bona fide use of the mark in the ordinary course of business through these uses.

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<sup>43</sup> Mitchell decl. ¶7, 39 TTABVUE 24; *see also* Starkman decl. ¶ 7, 39 TTABVUE 76.

<sup>44</sup> Respondent’s Supplemental Brief, 39 TTABVUE 10, 15.



*Id.* at 1071-72.

In sum, Wells Fargo continued to use its mark from its solicitation of customers through its acceptance of their payments. Its services were both advertised and rendered under the mark. Here, in contrast, when Respondent closed its RASCAL HOUSE doors in 2008, it no longer rendered services under the RASCAL HOUSE marks. That was the Board's finding in Stage One.<sup>45</sup> *See Couture v. Playdom, Inc.*, 778 F.3d 1379, 1382 (Fed. Cir. 2015) ("Here, there is no evidence in the record showing that appellant rendered services to any customer ..., and the cancellation of appellant's registration was appropriate.").

Respondent may have continued to display the RASCAL HOUSE marks at its other establishments, along with other marks (such as PUMPERNIKS, a brand under which Respondent **never** provided services)<sup>46</sup> because it wanted the residual goodwill that might emanate from those brands. But "residual goodwill does not negate a finding of abandonment based on nonuse." *Adamson v. Peavey*, 2023 WL 7274674, at \*17. The statute "speaks not to remembrance of things past, but to use." *Id.*; *see also Azeka Bldg. v. Azeka*, 2017 WL 2391862, at \*9 (finding mark abandoned even though its owner contended that "goodwill associated with the mark has not dissipated since the mark was last used in 2006."). "Like epitaphs on the tombstone in the family burial plot, they reflect an honored past ...." *Exec. Coach Builders v. SPV Coach*, 2017 WL 3034059, at \*24-25 (quoting *Am. Photographic Publ'g Co. v. Ziff-Davis Publ'g Co.*,

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<sup>45</sup> 36 TTABVUE 14.

<sup>46</sup> Mitchell dep. 52:20-53:1, 23 TTABVUE 71.

135 F.2d 569, 572 (7th Cir. 1943)). But they do not reflect present use in commerce, much less intent to resume use.

Respondent points out that it renewed the RASCAL HOUSE marks twice since 2008—first in 2010 and again in 2020-21.<sup>47</sup> But the renewals were predicated on Respondent’s specimens, which, as we have found, did not evidence continued use of the marks in commerce. The renewals do not rebut the prima facie proof of abandonment Petitioner has established. *See AmBRIT Inc. v. Kraft Inc.*, 812 F.2d 1531, 1550-51 (11th Cir. 1986) (“The only evidence Kraft presented to establish its intent to resume use was that it had renewed the registration of the mark in 1949 and 1969. Given the circumstances, however, this is insufficient to rebut the prima facie proof of abandonment.”).

Respondent argues that its reliance on the renewals of its involved registrations was reasonable, particularly in view of the Commissioner for Trademarks’ acceptance of: Burger King’s WHOPPER mark for restaurant services rendered under its BURGER KING mark; McDonald’s BIG MAC mark for restaurant services actually under its MCDONALD’S brand; and Subway’s FOOTLONG PRO mark for restaurant services rendered under its SUBWAY mark.<sup>48</sup>

It is unclear how this point pertains to the present case. “As has often been stated, a term may serve as both a trademark and a service mark depending on how it is used as evidenced by the specimens of record.” *In re Brown & Portillo Inc.*, 1987 WL 123868, \*1 (TTAB 1987). *See also In re McDonald’s Corp.*, 1978 WL 21263, \*2 (TTAB

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<sup>47</sup> Respondent’s Supplemental brief, 39 TTABVUE 12.

<sup>48</sup> Respondent’s Supplemental brief, 39 TTABVUE 12-14.

1978) (“It is a well settled principle of trademark law that a mark may serve in the dual capacity of advertising one’s services and also serving as an indicia of origin for one’s products.”); *In re McDonald’s Corp.*, 1986 WL 83585, \*3 (TTAB 1986) (“[A] term may serve in a dual capacity, functioning, for example, both as a trademark and as a service mark ....”) *rev’d without opinion*, 818 F.2d 875 (Fed. Cir. 1987). But this does not support Respondent’s position: the cases deal with contemporaneous use of the same mark on food goods and restaurant services; the present case deals with discontinued restaurant service marks displayed in restaurants operating under different service marks.

Additionally, Respondent did not introduce the three registrations to which it refers or the specimens submitted in their prosecution histories. “The Board’s well-established practice is not to take judicial notice of USPTO records.” *Flame & Wax, Inc. v. Laguna Candles, LLC*, 2022 WL 3083070, \*15 n.57 (TTAB 2022). Thus we cannot compare the specimens or records supporting the three registrations with Respondent’s specimens or records. Moreover, “[e]ach case must be decided on its own facts and the differences are often subtle ones.” *Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 1199 (CCPA 1973).

Apart from failing to establish continued use, Respondent also fails to establish excusable nonuse, for the period of nonuse that followed the 2008 cessation of use. As noted above, nonuse of a mark may be excused when its discontinuance is compelled by outside causes, such as war, labor strikes, or prohibition of the sale of liquor. *ARSA v. Salud Nat. Mexicana*, 2022 WL 4592443, at \*29-30. In *ARSA*, the Board stressed that “[t]his is not a case where Applicant decided to cease use of its mark for business

reasons. Rather, Applicant had no choice but to cease use of its mark because its use was prohibited by government sanctions banning it from doing business in the United States ....” *Id.* at \*13. “[N]ot every business reason excuses nonuse.” *Rivard v. Linville*, 133 F.3d at 1449-50.

In this case, Respondent’s corporate designee testified that it changed its “Wolfie Cohen’s Rascal House” restaurant in Sunny Isles, Florida into an Epicure Market in response to demographic changes in the area brought on by the advent of high-rise condominiums:

And then in Aventura, which is an area not too far from Sunny Isles, they have tons of restaurants in there, and so all the people that are living in Aventura, which is a fairly good-sized population because it’s all highrise condos and stuff, they’re all eating right in that area, they’re not necessarily coming to Sunny Isles to get their food. So, you know, it -- The demographics changed in the area. It just didn’t work.<sup>49</sup>

Respondent also sold its Boca Raton “Wolfie Cohen’s Rascal House” property because “another company came to that location, they wanted that property an awful lot and they offered us a tremendous amount of money for the real estate, so we sold it.”<sup>50</sup> So Respondent closed the “Wolfie Cohen’s Rascal House” in Boca Raton in 2008, and the buyer changed it into “some kind of restaurant.”<sup>51</sup>

Respondent may have had business reasons for its decisions to close its RASCAL HOUSE restaurants in 2008, but it fails to explain why it could not open another RASCAL HOUSE restaurant in nearby Aventura or Boca Raton, or simply rename

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<sup>49</sup> Mitchell dep. 245:12-246:13, 263:14-25, 277:12-23, 23 TTABVUE 119-20, 124, 127.

<sup>50</sup> Mitchell dep. 114:3-6, 23 TTABVUE 87.

<sup>51</sup> Mitchell dep. 113:22-114:11, 270:10-15, 23 TTABVUE 87, 126.

one of its other existing “Jerry’s Famous Deli” restaurants using the RASCAL HOUSE marks. Unlike *ARSA*, Respondent does not show special external circumstances compelling it to cease using the RASCAL HOUSE marks. This is not excusable nonuse.

Turning to Respondent’s asserted evidence of an intent to resume use, Respondent’s corporate designee, Mr. Mitchell, avers that:

Following the closing of “WOLFIE COHEN’S RASCAL HOUSE” in Sunny Isles, JFD’s then-President, Jason Starkman, was tasked with finding potential new locations for JFD establishments in South Florida, with the goal of incorporating all of JFD’s brands into these concepts, including the various “WOLFIE COHEN’S RASCAL HOUSE” marks at issue in this cancellation proceeding.<sup>52</sup>

Respondent’s then-president, Jason Starkman, echoes this language in his declaration.<sup>53</sup> He attaches as exhibits to his declaration four lease proposals between Respondent “JFD and potential landlords related to our search for new locations. In each of these negotiations, the goal was to find a location where we could feature restaurant offerings from the various brands in the JFD family that had acquired loyal consumer followings for many years – WOLFIE’S, PUMPERNIKS, EPICURE, RASCAL HOUSE, JERRY’S FAMOUS DELI, and WOLFIE COHEN’S RASCAL HOUSE.”<sup>54</sup> The lease proposals were with Arena Shops (Edens) LLC,<sup>55</sup> Ledoc, LLC,<sup>56</sup>

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<sup>52</sup> Mitchell decl. ¶8, 39 TTABVUE 24.

<sup>53</sup> Starkman decl. ¶8, 39 TTABVUE 76.

<sup>54</sup> Starkman decl. ¶9, 39 TTABVUE 76.

<sup>55</sup> 39 TTABVUE 87-134.

<sup>56</sup> 39 TTABVUE 137-42.

Equity One (Florida Portfolio) Inc.,<sup>57</sup> and Courtney Sunset LLC,<sup>58</sup> all for premises in or around Miami, Florida.

There are several holes in Respondent’s testimony and exhibits. To begin with, Mr. Starkman’s declaration, like Mr. Mitchell’s, begins with the words “Following the closing of ‘WOLFIE COHEN’S RASCAL HOUSE’ in Sunny Isles ...,”<sup>59</sup> but he fails to inform us **how long** following that closing he was tasked with finding potential new locations. Notably, every one of the lease proposals is dated 2014—a year that coincides not with the 2008 closing of the RASCAL HOUSE restaurants, but with the 2014 closing of a Jerry’s Famous Deli in Miami.<sup>60</sup>

Mr. Starkman declares that the potential new locations “could feature restaurant offerings from the various brands in the JFD family,”<sup>61</sup> but does not state that the restaurant services would be offered under any of the RASCAL HOUSE marks. Instead, the potential leases or letters of intent name EPICURE or JERRY’S FAMOUS DELI.<sup>62</sup>

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<sup>57</sup> 39 TTABVUE 143-75.

<sup>58</sup> 39 TTABVUE 176-78.

<sup>59</sup> Starkman decl. ¶8, 39 TTABVUE 76.

<sup>60</sup> Mitchell dep. 90:9-24, 23 TTABVUE 81.

<sup>61</sup> Starkman decl. ¶8, 39 TTABVUE 76.

<sup>62</sup> “TBD (‘Tenant’) Doing business as Epicure Gourmet Market & Café,” 39 TTABVUE 87-88; “Per your request, the following are proposed lease (‘Lease’) terms for Epicure Restaurant (‘Tenant’)” “TRADE NAME: Epicure Restaurant-actual name TBD”, 39 TTABVUE 137-38; “Jerry’s Famous Deli, Inc.” “Trade Name: Jerry’s Deli”, “only for the Permitted Use under Tenant’s Trade Name, and for no other use or purpose whatsoever without the prior written consent of Landlord,” “JERRY’S FAMOUS DELI, INC. D/B/A JERRY’S DELI,” 39 TTABVUE 143-45, 175; “Tenant: Epicure Market, an entity to be established prior to lease execution” 39 TTABVUE 176.

Furthermore, the lease proposals are in the most early, inchoate, and tentative stages. Three are unexecuted,<sup>63</sup> one has “DRAFT” stamped on every page,<sup>64</sup> and the sole signed proposal states “This Proposal merely sets forth the basic terms and conditions to be incorporated into a draft Lease. This letter is not contractually binding on the parties and does not obligate either party to negotiate in good faith or to proceed to the completion of a Lease or any other agreement.”<sup>65</sup> There is no evidence of any follow-up on these lease proposals, of any consistent, sustained negotiations toward execution of a lease agreement. Mr. Starkman admits that “[N]one of my negotiations ever resulted in JFD opening new locations ....”<sup>66</sup>

Respondent tries to liken its actions to those of the registrant in *Peterson v. Awshucks*, 2020 WL 7888976 (TTAB 2020): “In *Peterson*, the Board looked at the registrant’s efforts to find a new restaurant location, including discussions with real estate brokers that did not specifically identify the mark at issue, along with plans, designs, and other actions undertaken in support of opening a new location, demonstrated an intent to resume use of the mark throughout the period of nonuse ....”<sup>67</sup>

In *Peterson v. Awshucks*, the registrant temporarily ceased using the A.W. SHUCK’S mark for restaurant services in Charleston, South Carolina in 2016, and

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<sup>63</sup> 39 TTABVUE 121, 164, 178.

<sup>64</sup> 39 TTABVUE 143-75.

<sup>65</sup> 39 TTABVUE 142.

<sup>66</sup> Starkman decl. ¶ 10, 39 TTABVUE 77.

<sup>67</sup> Respondent’s Supplemental Brief, 39 TTABVUE 8-9.

ultimately resumed use under AW SHUCKS in 2019. After an in-depth review of the record, the Board found that the registrant had discontinued use of the mark for three consecutive years, but overcame the presumption of abandonment by proof of its intent to resume during that time. 2020 WL 7888976, at \*19. The registrant LLC's sole member testified that he intended to convert the original full-service A.W. SHUCK'S restaurant to a fast-casual restaurant under the same mark. *Id.* at \*8. Beginning in 2016, he contacted two real estate agents "to look for a suitable location for an A.W. Shuck's restaurant in Charleston ...." *Id.* In 2017, when space adjacent to his original site became available, he retained an architect to prepare plans for an A.W. Shuck's restaurant, and began building out the space that year. *Id.* at \*8-9. He retained a graphic designer to design menus, logos, and signage "for an A.W. Shuck's restaurant ...." *Id.* at \*9. He contacted a restaurant designer to help with the restaurant's floor plan and design, and continued construction in 2018, opening the restaurant, A.W. Shuck's on the Porch, in March 2019. *Id.* That month, he learned of another "potential location for an A.W. Shuck's" was available in Charleston, and he opened that restaurant in June 2019 as A.W. Shuck's Seafood Shack. *Id.* at 10.

*Peterson v. Awshucks* differs from the present case in three significant ways. First, the evidence showed that the registrant intended to resume use of the subject mark, A.W. SHUCK'S, in one form or another. Second, the registrant's testimony was corroborated by nonparty witnesses—a real estate agent, a graphic designer, and an architect—who testified, with documentary support in the form of emails, texts, and invoices, to the registrant's intent to reopen a restaurant under the mark A.W. SHUCK'S. And third, as the Board found:



Respondent's plans, designs, and construction at a proposed new location at 66 State Street between 2017 and 2018; preparation of proposed new logo and menu designs between 2017 and 2018, including designs that were eventually used; and the opening of the 208 King Street location on June 3, 2019; demonstrates that Respondent maintained an intent to resume use of the mark **throughout the period of nonuse**.

*Id.* at \*19 (emphasis added).

In contrast, Respondent's evidence falls far short of establishing intent to resume use. Its evidence shows an intent to continue use of other marks, such as EPICURE or JERRY'S FAMOUS DELI, but not the RASCAL HOUSE marks. Respondent's testimony relies exclusively on party witnesses, its president and former president, with no corroboration from nonparty witnesses or documentation focusing on the RASCAL HOUSE marks. "The presence of business records documenting these activities would strengthen the registrant's case, and the absence of such records does the opposite." *Adamson v. Peavey*, 2023 WL 7274674, at \*22.

Respondent's evidence shows vague, desultory communications concerning potential use of some marks, not serious, sustained efforts directed toward execution of lease agreements for RASCAL HOUSE restaurants. "Essentially the evidence in this case does not show ... focused negotiations toward execution of a license agreement; rather, these mostly 'one and done' contacts were sporadic, cursory and, given the lack of [Respondent's] follow-up in most instances, half-hearted .... [Respondent's] efforts were neither consistent nor sustained. Evidence of vague discussions concerning the potential use of the mark at some unknown point in the future are insufficient to show an intent to resume use." *Azeka Bldg. v. Azeka*, 2017 WL 2391862, at \*13.

These are not the actions of a reasonable business intending to resume use of its mark in the foreseeable future. Petitioner notes that “Respondent was no novice; it had previously been an established member of this industry before the closure of its restaurants in 2008.”<sup>68</sup> And Respondent admits that “the negotiations were undertaken during the same time that Registrant’s non-RASCAL HOUSE locations remained open ....”<sup>69</sup> Respondent has shown no impediment to reopening a RASCAL HOUSE restaurant in the three years after it decided to close its restaurants in 2008. As in *Executive Coach Builders*, “there is no evidence that [Respondent] developed an intent to resume commercial use of the ... mark in the reasonably foreseeable future within the three-year period of nonuse .... This includes [Respondent’s] ongoing display of interior signs and memorabilia, which we find neither constitutes a plan to resume use nor demonstrates activities that would support a showing of an intent to resume use within the reasonably foreseeable future.” *Exec. Coach Builders v. SPV Coach*, 2017 WL 3034059, at \*26.

Importantly, Respondent’s efforts, feeble as they were, did not take place until 2014, six years after the RASCAL HOUSE restaurants closed in 2008. Yes, we may consider evidence of a registrant’s actions before or after the three-year period of nonuse to infer its intent to resume use during that three-year period. *Crash Dummy Movie LLC v. Mattel Inc.*, 601 F.3d 1387, 1392 (Fed. Cir. 2010). But “[s]uch evidence should temporally and logically link the later use to the prior nonuse, such that an inference can be drawn regarding the intent to resume use during the period of

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<sup>68</sup> Petitioner’s Supplemental reply brief, 40 TTABVUE 8.

<sup>69</sup> Respondent’s Supplemental brief, 39 TTABVUE 18.

nonuse; otherwise, mere evidence of subsequent use may not suffice to establish that the registrant intended to resume use.” *Peterson v. Awshucks*, 2020 WL 7888976, at \*12. “This lengthy period of nonuse heightens the inference of intent not to resume use ....” *Azeka Bldg. Corp. v. Azeka*, 2017 WL 2391862, at \*13.

After its isolated burst of activity in 2014, Respondent’s use of the RASCAL HOUSE marks lay dormant for over five years, until Petitioner filed its petitions for cancellation in 2020. In the course of these consolidated cancellation proceedings, Respondent’s president, Jonathan Mitchell, testified in his discovery deposition, taken in April 2022, about his plans to open establishments in Sarasota, Florida:

I’m also intending to open new stores with those trademarks.

...

Q What brand restaurant would you put into that location?

A I would -- I would put -- I would put a deli for sure. I would either -- I would either call it -- Well, I don’t know which specific name I want to use at this point, but it would be one of the three names of delis we have, which -- or four names actually, and I may even divide it into two.

...

Q Do you know what the names of any of those restaurants will be as you sit here today?

A One will be -- Well, one is Epicure, which is a market, one is Rascal House, and one is Wolfie’s. Those are the first three I was going to start with.<sup>70</sup>

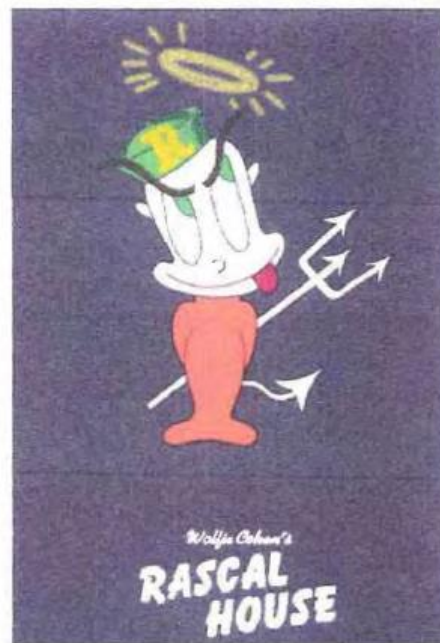
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<sup>70</sup> Mitchell dep. 207:9-10, 225:9-16, 100:3-7, 23 TTABVUE 110, 114, 83.

Jason Starkman avers in his November 2023 declaration that “Current owner, Jonathan Mitchell, took over the business of JFD and ultimately found a location in Sarasota, Florida that is opening as a combined RASCAL HOUSE and WOLFIE’S restaurant utilizing all of JFD’s brands.”<sup>71</sup>

Mr. Mitchell confirms in his November 2023 declaration:

10. Attached as “Exhibit B” to my Declaration are several examples of menus and signage being used at the Sarasota location and featuring the various brands in the JFD family that had acquired loyal consumer followings for many years – WOLFIE’S, PUMPERNIKS, EPICURE, RASCAL HOUSE, JERRY’S FAMOUS DELI, and WOLFIE COHEN’S RASCAL HOUSE. Each of the WOLFIE COHEN’S RASCAL HOUSE trademarks is featured on both signage and menus, including menu items that incorporate recipes dating back to the opening of the first WOLFIE COHEN’S RASCAL HOUSE in the 1940s:



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<sup>71</sup> Starkman decl. ¶ 10, 39 TTABVUE 77.

<sup>72</sup> Mitchell decl. ¶ 10, 39 TTABVUE 23.

These recent efforts to resurrect the RASCAL HOUSE marks, however, took place “in 2023, long after the period of nonuse.” *Adamson v. Peavey*, 2023 WL 7274674, at \*20. Respondent could have made these efforts in the ten years after it closed the RASCAL HOUSE restaurants in 2008. *Imperial Tobacco, Ltd. v. Philip Morris*, 899 F.2d at 1582 (“As the board pointed out, Imperial simply began selling cigarettes in 1987, as it could have all along.”).

At this late date, Respondent’s use of the RASCAL HOUSE marks, initiated after Petitioner instituted its cancellation proceedings, “not only detracts from [Respondent’s] credibility, but also more than adequately supports the conclusion that [Respondent’s] approximately five years of nonuse is not excusable.” *Rivard v. Linville*, 133 F.3d at 1450. This recent use constitutes a new and separate use that does not cure the abandonment. *Exec. Coach Builders, v. SPV Coach*, 2017 WL 3034059, \*26 (citing *AmBRIT Inc. v. Kraft Inc.*, 812 F.2d at 1550); *Hornby v. TJX*, 2008 WL 1808555, at \*11. *See generally* 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 17:3 (5th ed. Sept. 2024) (Once a period of nonuse results in abandonment, a resumption of use thereafter cannot cure the preceding abandonment. Such a resumption represents a new and separate use with a new date of first use. Once a trademark is abandoned, its registration may be cancelled even if the registrant subsequently resumes use of the mark.”). As Mr. Mitchell testified, referring to another case: “You can’t unabandon something you abandoned. You either abandoned it or you didn’t abandon it.”<sup>73</sup>

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<sup>73</sup> Mitchell dep. 221:22-24, 23 TTABVUE 113.

#### **IV. Decision**

The Federal Circuit has declared:

[A]n affirmative desire by the registrant not to relinquish a mark is not determinative of the intent element of abandonment under the Lanham Act. Nothing in the statute entitles a registrant who has formerly used a mark to overcome a presumption of abandonment arising from subsequent nonuse by simply averring a subjective affirmative “intent not to abandon.” ... [T]he Lanham Act was not intended to provide a warehouse for unused marks.

*Imperial Tobacco v. Philip Morris*, 899 F.2d at 1581.

The Board finds that Respondent discontinued its use of the three registered RASCAL HOUSE marks at issue in 2008 without intent to resume their use. It has therefore abandoned the three marks within the meaning of Section 45 of the Trademark Act, 15 U.S.C. § 1127. The three registrations will be cancelled in due course.