

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: March 29, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

MEC Addheat Co. Ltd.

v.

Baiduren (Dongguan) E-Commerce Co., Ltd.

Cancellation No. 92079084

Andrew T. Rissler of Patel & Almeida PC,
for MEC Addheat Co. Ltd.

Haoyi Chen of Arch & Lake LLP,
for Baiduren (Dongguan) E-Commerce Co., Ltd.

Before Shaw, Coggins and Casagrande,
Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:¹

¹ As part of an internal Board pilot citation program on possibly broadening acceptable forms of legal citation in Board cases, this opinion varies from the citation form recommended in the Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 101.03 (June 2023). This opinion cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals only by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). For opinions of the Board, this opinion employs citation to the Westlaw (WL) database. Only precedential decisions are cited. Until further notice, however, practitioners should continue to adhere to the practice set forth in TBMP § 101.03.

Baiduren (Dongguan) E-Commerce Co., Ltd. (“Respondent”) owns a Principal Register registration for the standard-character mark ADDHEAT for goods identified as: “Boots; Gloves; Hats; Hoodies; Insoles; Jackets; Overalls; Pants; Shoes; Sweatshirts; Thermal underwear; Tops as clothing; Undershirts; Vests,” in International Class 25.²

MEC Addheat Co. Ltd. (“Petitioner”) has petitioned to cancel the Registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground that Respondent’s mark so resembles Petitioner’s previously used common-law mark ADDHEAT for “Electric heating pads, other than for medical purposes; Electrical heating cables; Electrically heated clothing; Heating cushions, electric, not for medical purposes,” as to be likely to cause confusion.³ Petitioner pleaded ownership of Trademark Application Serial No. 90668125 for the standard-character mark ADDHEAT for use in connection with the foregoing goods.⁴ Petitioner also seeks to

Citations to the record are to TTABVUE, the Board’s online docketing system. *See Turdin v. Trilobite, Ltd.*, 2014 WL 343270, at *2 n.6 (TTAB 2014). The number preceding “TTABVUE” corresponds to the docket entry number; the number(s) following “TTABVUE” refer to the page number(s) of that particular docket entry, if applicable.

² Registration No. 6041732, issued to Liu linjie on April 28, 2020, from an application filed on September 20, 2019. The Petition named Liu linjie as Respondent. 1 TTABVUE. Because, however, the mark in this subject registration was assigned from Liu linjie to Baiduren (Dongguan) E-Commerce Co., Ltd. prior to the commencement of this proceeding, and the assignment has been recorded in the Assignment Recordation Branch of the USPTO at Reel 7632 and Frame 0391, Baiduren (Dongguan) E-Commerce Co., Ltd. is hereby substituted as the party defendant. *See* Respondent’s Answer p. 2 n.1, 5 TTABVUE 2. *See also* TBMP § 512.01.

³ 1 TTABVUE.

⁴ *Id.* Application Serial No. 90668125, filed on April 23, 2021, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

Petitioner also pleaded ownership of Trademark Registration No. 5626179 for the mark VENTURE HEAT (and design) for use in connection with: “Clothing, namely, neck warmers;

cancel the Registration on the ground that Respondent does not own the mark, and, as discussed below, that the Registration is “void ab initio because Respondent was not using the ADDHEAT mark in interstate commerce as of the filing date of the application.”⁵

Respondent denied the salient allegations in the petition for cancellation, but did not introduce any testimony or other evidence, or file a brief. Respondent asserted several affirmative defenses, but waived them by not filing a brief. *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 2013 WL 5407315, at *2 n.6 (TTAB 2013) (affirmative defense not argued in brief deemed waived), *aff’d mem.*, 565 F. App’x 900 (Fed. Cir. 2014).

I. The Pleadings and Issues Before the Board

Petitioner properly pleaded a claim of likelihood of confusion under Trademark Act Section 2(d). Petitioner’s second claim, titled “Respondent Is Not The Owner Of The Marks,” alleges that Petitioner, not Respondent, is the true owner of the marks. According to the pleading, “[o]n information and belief, Respondent is not and has never been the source of ADDHEAT products. Respondent is not and has never been the true owner of the ADDHEAT Marks.”⁶ Although the allegation that Respondent

Gloves; Motorcycle jackets; Ski jackets; Undershirts; Vests; Athletic uniforms; Bottoms as clothing; Jackets; Tops as clothing,” in International Class 25. However, Petitioner did not introduce a copy of this registration into the record, nor did Respondent admit or stipulate to the ownership and validity of this registration. Accordingly, this registration will not be considered. *See, e.g., Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 2009 WL 691309, at *3 (TTAB 2009).

⁵ Petitioner’s Br., p. 8, 11 TTABVUE 9; Petition for Cancellation, ¶¶ 19-22, 1 TTABVUE 7-8.

⁶ Petition for Cancellation, ¶ 21, 1 TTABVUE 7.

is not the “source of ADDHEAT products” could be read to imply nonuse, it more naturally implies an allegation that Petitioner’s rights are superior to Respondent’s. In addition, we note that the Petition does not specifically plead that the Registration is void ab initio, which is an allegation we would expect to see as part of a nonuse claim. Rather, the claim that the Registration is void ab initio appears in Petitioner’s brief. Notwithstanding these observations about the Petition, for the following reasons we find that nonuse of the ADDHEAT mark by Respondent was tried by implied consent of the parties.

During discovery, Petitioner propounded a First Set of Requests for Admissions from Respondent that included eighteen questions, all of which related to Respondent’s use of the mark ADDHEAT before and after the filing of the application.⁷ Respondent did not file a response to the requests for admission.

During trial, Petitioner filed a notice of reliance, introducing, among other things, the unanswered requests for admission, noting that the admissions “are relevant to show that Respondent has in fact never used the ADDHEAT mark in United States commerce and is therefore not entitled to the registration of the mark.”⁸

In Petitioner’s brief, Petitioner’s Statement of the Issues defines the third issue in this proceeding as: “whether the Petitioned Registration is void ab initio because Respondent was not using the ADDHEAT mark in interstate commerce as of the

⁷ Petitioner’s First Set of Requests for Admission, 10 TTABVUE 15-20.

⁸ Petitioner’s First Notice of Reliance, p. 1, 10 TTABVUE 2.

filing date of the application.”⁹ According to Petitioner’s argument, “the Petitioned Registration should be cancelled for the independent reason that Respondent has never used, and certainly at the time of filing had never used, the ADDHEAT mark in connection with any of the goods identified in the Petitioned Registration.”¹⁰

From the foregoing, we find that throughout this proceeding, Respondent was on notice that nonuse of its ADDHEAT mark was an issue. Respondent has never objected to the nonuse claim, nor did Respondent file a brief arguing against the claim. Accordingly, we consider the issue of nonuse as having been tried by implied consent. Fed. R. Civ. P. 15(b)(2); Trademark Rule 2.116(a), 37 C.F.R. § 2.116(a); *see also Morgan Creek Prods. Inc. v. Foria Int’l Inc.*, 2009 WL 1719597, at *3 (TTAB 2009) (“[I]mplied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue.”); *see generally* TBMP § 507.03(b).

II. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the involved registration.

Petitioner introduced a single notice of reliance on: (1) printouts from the USPTO’s Trademark Status & Document Retrieval (TSDR) database showing current status

⁹ Petitioner’s Br., p. 8, 11 TTABVUE 9.

¹⁰ *Id.* at 19, 11 TTABVUE 20.

and title of its pending application and Respondent's Registration;¹¹ and (2) a copy of Petitioner's First Set of Requests for Admissions, to which Respondent failed to serve a timely response.¹² As noted above, Respondent did not introduce any testimony or evidence, or file a brief.

III. Entitlement to Statutory Cause of Action

A plaintiff must prove entitlement to its statutory cause of action in every inter partes case. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 1275 (Fed. Cir. 2014). To establish entitlement to institute a statutory cause of action under Trademark Act Section 14, 15 U.S.C. § 1064, a plaintiff must demonstrate "an interest falling within the zone of interests protected by the statute and . . . proximate causation." *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1303 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 120-37 (2014)). Stated another way, a plaintiff is entitled to bring a statutory cause of action by demonstrating a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370 (Fed. Cir. 2020); *see also Empresa Cubana*, 753 F.3d at 1275.

As plaintiff in this proceeding, Petitioner must prove both its entitlement to a statutory cause of action and its asserted claims by a preponderance of the evidence. *See Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 1370 (Fed. Cir. 2002) ("The

¹¹ 10 TTABVUE 6-14. It was not necessary for Petitioner to submit a TSDR printout of Respondent's registration because the entire file was already of record under Trademark Rule 2.122(b).

¹² *Id.* at 15-20.

burden of proof rests with the [plaintiff] . . . to produce sufficient evidence to support the ultimate conclusion of [priority of use] and likelihood of confusion.”); *Sanyo Watch Co. v. Sanyo Elec. Co.*, 691 F.2d 1019, 1022 (Fed. Cir. 1982) (“As the [plaintiff], appellant bears the burden of proof which encompasses not only the ultimate burden of persuasion, but also the burden of going forward with sufficient proof of the material allegations of the [petition to cancel], which, if not countered, negates appellee’s right to a registration.”).

To support its entitlement to a statutory cause of action, Petitioner introduced only a printout from the USPTO’s TSDR database showing the current status of and title to its application in Petitioner. The printout shows that action on the application has been suspended, but not the reason for the suspension.¹³ Petitioner failed to submit a copy of the Office Action refusing registration of its pleaded mark based on Respondent’s subject registration (or a copy of the Office Action suspending action on the application based on the Registration). In its brief, Petitioner simply states that “On December 23, 2021, the Examining Attorney issued a 2(d) refusal against the Petitioner’s Application, citing the Petitioned Registration against the Petitioner’s Application.”¹⁴ Petitioner’s statement is insufficient to establish the basis for suspension of Petitioner’s application. Allegations alone do not establish entitlement. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1028 (CCPA 1982) (facts alleged at the pleading stage must be proven at trial to establish standing). *See also*

¹³ *Id.* at 6-9.

¹⁴ Petitioner’s Br., p. 7, 11 TTABVUE 8.

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Cai v. Diamond Hong, Inc., 901 F.3d 1367, 1371 (Fed. Cir. 2018) (citing *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005) (“Attorney argument is no substitute for evidence.”)).

Nevertheless, it is not necessary that Petitioner prove that the Office cited Respondent’s mark as a bar to registration:

Rather, it is sufficient if the circumstances are such that it would be reasonable for a petitioner to believe that the existence of the respondent’s registration would damage him, e.g., reasonable belief that there is a likelihood of confusion between the marks, or that the presence on the register of the respondent’s mark may hinder the petitioner in using or registering his mark.

Toufigh v. Persona Parfum, Inc., 2010 WL 2783900, at *2 (TTAB 2010); *see also Spirits Int’l, B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birliigi*, 2011 WL 2909909, at *2 (TTAB 2011) (“[T]he arguable similarities in the marks and the arguable relatedness of the goods is sufficient for us to find that opposer has met the statutory requirement of establishing a reasonable belief of damage by showing that it possesses a real interest in the proceeding, and is not an intermeddler.”).

Thus, statutory entitlement to bring a cancellation proceeding can be found based on the filing of an application to register an identical mark for arguably related goods. *Id.* Here, the identity of the marks and the in-part identity of the goods (articles of clothing) is sufficient to establish Petitioner’s statutory entitlement to bring the cancellation proceeding.

IV. Trademark Act Section 2(d) Claim

Section 2(d) of the Trademark Act provides a ground for cancellation of a registration fewer than five years old based on likelihood of confusion with a

petitioner's mark or trade name previously used in the United States and not abandoned. *Kemi Organics, LLC v. Gupta*, 2018 WL 2230555, at *3 (TTAB 2018). We begin with a determination of the parties' priority.

A. Priority

A party may establish its own prior proprietary rights in a mark through actual use, use analogous to trademark use, or an earlier constructive use date accorded to the party's own application. *See Giersch v. Scripps Networks Inc.*, 2009 WL 706673, at *3 (TTAB 2009). In addressing priority, we look to each party's earliest established date of first use.

1. Respondent's Priority Date

"It is well settled that in the absence of any evidence of earlier use, the earliest date upon which respondent may rely is the filing date of its underlying application. *See* Trademark Act Section 7(c), 15 U.S.C. § 1057(c)." *Id.* For Respondent, this date is September 20, 2019. Inasmuch as Respondent has not introduced any evidence or testimony, we need not consider whether it is entitled to rely on an earlier date of first use. In order to prevail, Petitioner must establish proprietary rights in its pleaded ADDHEAT mark prior to September 20, 2019.

2. Petitioner's Priority Date

To establish priority of use of its ADDHEAT mark, Petitioner relies solely on the dates of use claimed in its later-filed application: "Petitioner submitted a copy of the TSDR printout of Petitioner's Application, showing the alleged date of first use of

September 1, 2006 with its Notice of Reliance.”¹⁵ But Petitioner may not rely on the dates of use claimed in its application without supporting testimony or evidence, which it did not introduce. Trademark Rule 2.122(b)(2), 37 C.F.R. § 2.122(b)(2), provides, inter alia, that the allegation of a date of use in an application is not evidence on behalf of the applicant, nor are statements made in an affidavit or declaration in the file of an application testimony on behalf of the applicant. *See, e.g., Life Zone Inc. v. Middleman Grp. Inc.*, 2008 WL 2781162, at *7 (TTAB 2008) (alleged date of use in application not evidence); *Baseball Am., Inc. v. Powerplay Sports, Ltd.*, 2004 WL 1942057, at *3 n.10 (TTAB 2004) (dates of use and specimens not evidence).

Accordingly, in the absence of any evidence regarding its use of the ADDHEAT mark, Petitioner has not established a specific first use date for its pleaded mark on any goods, much less a date prior to the filing date of Respondent’s application. Respondent therefore has priority of use of its mark.

B. Likelihood of Confusion

Because we found that Petitioner has not established priority of use, an essential element of its claim under Section 2(d), we need not consider the remaining element of a likelihood of confusion. *See, e.g., Exec. Coach Builders, Inc. v. SPV Coach Co., Inc.*, 2017 WL 3034059, at *27 (TTAB 2017). The petition is denied insofar as it rests on Section 2(d).

¹⁵ *Id.* at 11, 11 TTABVUE 12.

V. The Registration is Void Ab Initio

We next address Petitioner's claim that Respondent's Registration is void ab initio because the mark was not in use at the time Respondent filed its use-based application.

A registration under Trademark Act Section 1, 15 U.S.C. § 1051, cannot be obtained for goods or services upon which an applicant or registrant has not used the mark. *Grand Canyon W. Ranch, LLC v. Hualapai Tribe*, 2006 WL 802407, at *1 (TTAB 2006) ("The case law is clear that holding an application to be void is an appropriate remedy when . . . the applicant has not used the applied-for mark on any of the goods or services identified in the application prior to the filing of the application.").

In the case of a use-based application, if it is shown that the applicant made no provable use in commerce of its mark prior to the filing date of its trademark application, a plaintiff can seek to cancel the resulting registration on this ground. *ShutEmDown Sports, Inc. v. Lacy*, 2012 WL 684464, at *10 (TTAB 2012) ("Because we find that respondent's allegation of use of his mark in commerce for the identified goods, at the time of filing of his application was false, we hold that the application was void ab initio[.]").

Petitioner's evidence consists solely of Respondent's failure to respond to Petitioner's First Set of Requests for Admissions, which are deemed admitted under Fed. R. Civ. P. 36(a)(3) ("A matter is admitted unless, within 30 days after being served, the party to whom the request is directed serves on the requesting party a written answer or objection addressed to the matter and signed by the party or its

attorney.”). *See Fram Trak Indus. v. Wiretracks LLC*, 2006 WL 236416, at *5 (TTAB 2006) (requests for admissions deemed admitted by respondent’s failure to respond to petitioner’s requests for admissions).

Petitioner’s requests for admission to Respondent are therefore deemed admitted, including the following:¹⁶

REQUEST NO. 1: Admit that YOU did not use the ADDHEAT Mark between 2019 and the present.

REQUEST NO. 8: Admit that you have not sold any of the goods in Class 25 listed in the petitioned registration for the mark ADDHEAT anywhere in the United States as of the filing date of the ADDHEAT Application.

REQUEST NO. 11: Admit that you have never used the ADDHEAT Mark.

REQUEST NO. 14: Admit that you have never sold products bearing tags or labels displaying the ADDHEAT Mark.

REQUEST NO. 17: Admit that the specimen YOU submitted to the USPTO on September 20, 2019 with the application for Ser. No. 88/624,371 does not show an actual photo of an item of goods as sold in commerce.

Pursuant to the admissions, in particular Requests for Admission Nos. 1, 8, 11, 14, and 17, above, we find that Petitioner has established that Respondent never used the ADDHEAT mark in commerce in the United States. Because the evidence establishes that Respondent’s mark was not in use in connection with any of the goods identified in the Registration at the time the underlying Application was filed, we

¹⁶ Petitioner’s First Set of Requests for Admission, 10 TTABVUE 15-20.

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find that Petitioner has shown that Respondent's mark was not used in commerce on or before the critical date of September 20, 2019. Respondent's underlying Application, and therefore its resulting Registration, are void ab initio.

Decision: The Petition for Cancellation is granted solely on the ground that the Registration is void ab initio and is otherwise denied.