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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: March 29, 2006

Cancellation No. 92044270

SMART CHOICE FOOD SALES, LTD.

v.

NATURE'S WAY PRODUCTS, INC.

Before Quinn, Hohein and Rogers, Administrative Trademark Judges.

By the Board:

Smart Choice Food Sales, Ltd. seeks to cancel the registration owned by Nature's Way Products, Inc. for the mark THE GOLD STANDARD for "vitamins and nutritional dietary supplements" in International Class 5[1] on the ground that respondent has abandoned the mark by having failed to use the mark in commerce "for a period in excess of three years" with no intent "to resume use of the mark in connection with such goods."[2]

Respondent, in its answer, has denied the essential allegations of the petition to cancel and pleaded certain affirmative defenses.

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[1] Reg. No. 1,500,164, issued on August 16, 1988 on the Principal Register, which claims a date of first use in commerce of January 25, 1988; Section 8 and 15 affidavit acknowledged March 29, 1995.
[2] The petition to cancel was filed on February 7, 2005.

This case now comes up for consideration of petitioner's motion, filed July 29, 2005, for summary judgment on the ground of abandonment. The motion is fully briefed.

In support of its motion, petitioner contends that since the commencement of the proceeding, respondent has failed to produce a single piece of evidence that the registered mark THE GOLD STANDARD was ever used in commerce; that there is not a single fact in the record showing use by respondent or rebutting the showing of abandonment; that abandonment can be presumed from respondent's failure to provide evidence of sales, usage or affixation of the involved mark to any of its products in response to petitioner's discovery requests, which were largely directed to the central issue of abandonment; that respondent's failure to provide substantive answers to petitioner's interrogatories and its production of only four documents in response to petitioner's document requests supports a showing of abandonment; and that the four documents produced by respondent do not address the abandonment issue nor do they show that THE GOLD STANDARD was ever used as a mark.[3]

[3] With regard to the four documents produced, petitioner argues that respondent has failed to show when or whether these documents were actually used in advertising the products (2005 advertisement – B-2) or affixed to the goods (2005 document - B-1 and 1994 label - B-3); and that the document dated 2002 is not evidence of any actual or ongoing usage or even resumption following nonusage nor can an intent to resume use be inferred from the document.

As evidence to support its position, petitioner has provided the declaration of Robert Seader, president of petitioner, who avers that he undertook a factual investigation of the abandonment of respondent's THE GOLD STANDARD mark; that he examined respondent's products in stores, reviewed respondent's websites, product literature, and advertisements through Internet searches and found no usage of THE GOLD STANDARD mark; and that he called respondent to inquire about THE GOLD STANDARD products and "was informed that no such name existed." Petitioner has also submitted the four documents produced by respondent in response to petitioner's document discovery requests as prima facie evidence of abandonment.

In response, respondent argues that petitioner's president's investigation into respondent's use is unreliable and irrelevant and does not establish abandonment as matter of law; that the documents produced by respondent in discovery create questions of fact; that use of the subject mark in commerce and in a printed publication as recently as 2005 "affirmatively evidence intent to utilize the mark"; and that petitioner has failed to demonstrate an absence of issues of material fact as to respondent's intent to abandon the mark.

In support of its response, respondent has provided the declaration of Robyn Phillips, respondent's counsel. In her

declaration, respondent's counsel avers that petitioner has not produced documentary evidence with regard to its factual investigation into respondent's alleged abandonment of THE GOLD STANDARD mark (i.e., the phone call and Internet search); and that the documents produced by respondent establish that it uses the mark "as a secondary mark in connection with goods."

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1986) and *Sweats Fashions Inc., v. Pannil Knitting Co., Inc*., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *See Lloyd's Food Products Inc. v. Eli's Inc*., 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

Turning to the merits of petitioner's motion, we find that there is no genuine issue of material fact that respondent ceased using THE GOLD STANDARD mark sometime after 1994 for a period of no less than three consecutive

years. We agree with petitioner that the discovery responses made of record are sufficient to establish a prima facie case of abandonment.[4]

Irrespective of events in 2005 when, evidently, respondent may have made some use of the mark, we find that, by that time, respondent had abandoned its right to THE GOLD STANDARD mark through nonuse. Simply put, the record is devoid of any evidence to show that the registered mark was used in the ordinary course of trade on any of the goods listed in the involved registration. Despite petitioner's various discovery requests therefor, respondent furnished no evidence showing that there was never a three-year period prior to 2005 in which it had failed to make any sales or other use of THE GOLD STANDARD mark, whether such use be on receipts, tags, labels, advertisements or otherwise. Instead, the only documentation provided by respondent showing possible use of THE GOLD STANDARD mark for a date prior to 2005 is a label with a 1994 copyright notice. The total lack of corroborating evidence of sales and use of such goods under the mark clearly establishes a prima facie case of abandonment of respondent's THE GOLD STANDARD mark.

[4] Section 45 of the Trademark Act, 15 U.S.C. Section 1127, provides that a mark is abandoned when "its use has been discontinued with intent not to resume use.... Nonuse for three consecutive years shall be prima facie evidence of abandonment."

We also find that there is no genuine issue that the 2005 uses of the mark, if they were used in connection with the goods at all, represent a new and separate use of the mark. These uses cannot serve to cure the prior abandonment inasmuch as abandonment of a mark cannot be reversed by subsequent re-adoption of a mark. *Parfums Nautee Ltd. v. American International Industries*, 22 USPQ2d 1306, 1310 (TTAB 1992).

Accordingly, we find that as a matter of law, petitioner has established a prima facie case of abandonment of the mark.

Such a prima facie case of abandonment eliminates petitioner's burden of establishing the intent element of abandonment as an initial part of the case and creates a rebuttable presumption that respondent abandoned its mark without an intent to resume use. *See Rivard v. Linville*, 133 F.3d 1446, 45 USPQ2d 1374, 1376 (Fed. Cir. 1998); and *Imperial Tobacco Ltd. v. Philip Morris, Inc.*, 899 F.2d 1575, 14 USPQ2d 1390, 1393 (Fed. Cir. 1990). The presumption shifts the burden to respondent to produce evidence that it intended to resume use of the mark. See *Rivard v. Linville*, *supra*; and *Cerveceria Centroamericana S.A. v. Cerveceria India, Inc.*, *supra*.

Thus, in the case of a motion for summary judgment, when the moving party supports its position by evidence sufficient to indicate that there is no genuine issue of

material fact, and that the moving party is entitled to judgment as a matter of law, the burden shifts to the nonmoving party to demonstrate the existence of specific, genuinely-disputed facts that must be resolved at trial. In this case, the question is whether respondent, like any other registrant who has not made use for at least three years, has put forth sufficient evidence to at least raise a genuine issue of material fact of intent to resume use. *Imperial Tobacco Ltd. v. Philip Morris Inc.*, supra.

After reviewing the evidence in a light most favorable to respondent, we conclude that respondent has not raised a genuine issue of fact to rebut the presumption that respondent abandoned its mark without an intent to resume use. Respondent has provided no documentary evidence showing specific actions taken to plan for resumption of use but has only offered unsupported statements[5] in its responsive brief regarding its continuing intent. The declaration from its counsel does not go to respondent's intent to resume use and only asserts that THE GOLD STANDARD is a secondary trademark.[6] We also find little value in the 2002 "survey" document which was produced in discovery inasmuch as "an affirmative desire by the registrant not to relinquish a mark is not determinative of the intent element

[5] The unsupported statements are made by respondent's attorney.
[6] We note that respondent's attorney could not submit averments as to respondent's use or its intent to resume use.

of abandonment under the Lanham Act." *Imperial Tobacco*, 45 USPQ2d at 1394. See also, *Rivard v. Linville*, 45 USPQ2d at 1376 ("registrant's bare proclamations of its intent to resume use ... are entitled to little, if any, weight"). Further, we cannot agree with respondent that the 2005 documents produced in discovery are evidence of a continuing intent to use the mark. As stated above, the 2005 uses are clearly new use of the mark after abandonment.

In view of the foregoing, we conclude that respondent has not raised a genuine issue of material fact to overcome the presumption of no intent to resume use of the mark, after years of nonuse of the mark. Thus, and provided that the matter below is resolved in its favor, petitioner appears to be entitled to summary judgment in its favor on the issue of abandonment.

One further matter remains, however. Specifically, in order to prevail herein, petitioner must establish not only a valid ground for cancellation but must prove its standing to bring the petiton to cancel as well. *Medinol Ltd. v. Neuro Vasx Inc.*, 67 USPQ2d 1205, 1210 (TTAB 2003). However, petitioner has not submitted any evidence on this point.

In view thereof, petitioner is allowed until **THIRTY DAYS** from the mailing date of this order in which to submit a showing that there is no genuine issue of fact as to its

standing. *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1775-76 (TTAB 1994). If petitioner's showing is sufficient to establish petitioner's standing, the motion for summary judgment on the issue of abandonment will be granted, and the petition for cancellation will be granted. If petitioner's showing is not sufficient on the issue of standing, proceedings will resume on the issue of petitioner’s standing to bring this proceeding.

Proceedings herein remain otherwise SUSPENDED pending petitioner's response.