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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Colonial Williamsburg Foundation  
v.  
The Williamsburg Store, Inc.

Cancellation No. 92047662

Edward T. White of Hunton & Williams for The Colonial  
Williamsburg Foundation.

The Williamsburg Store, Inc., pro se.

Before Grendel, Walsh, and Ritchie, Administrative Trademark  
Judges.

Opinion by Grendel, Administrative Trademark Judge:

**INTRODUCTION**

In this cancellation proceeding, The Colonial  
Williamsburg Foundation is the petitioner, and The  
Williamsburg Store, Inc. is the respondent.

On June 1, 2007, petitioner filed a petition for  
cancellation seeking cancellation of respondent's

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Registration No. 2726455, which is of the mark depicted below



for services identified in the registration as "retail shops featuring gifts, collectibles, notions, furnishings, apparel, toys, books and other publications, recorded music, handcrafted goods, memorabilia and artwork." Respondent's registration issued on June 17, 2003, from an application filed on May 7, 2001.<sup>1</sup>

In its petition for cancellation, petitioner alleged two grounds for cancellation. First, petitioner alleged that respondent's registration should be cancelled because the registered mark is likely to cause confusion vis-à-vis numerous previously-used and registered marks owned by petitioner which consist of or contain the word WILLIAMSBURG. See Trademark Act Section 2(d), 15 U.S.C.

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<sup>1</sup> In the registration, October 14, 1999 is alleged to be the date of first use of the mark anywhere and the date of first use of the mark in commerce. The registration includes a disclaimer of "WILLIAMSBURGSTORE.COM."

§1052(d). Second, petitioner alleged that the registration should be cancelled because respondent has abandoned the mark. See Trademark Act Section 14(3), 15 U.S.C. §1064(3).

Respondent filed an answer which, as discussed below, consists essentially of mere argument going to the merits of the case, rather than specific admissions or denials of the allegations in the petition for cancellation.

The evidence of record includes the pleadings,<sup>2</sup> and the file of respondent's involved registration. See Trademark Rule 2.122(b), 37 C.F.R. §2.122(b). The record also includes certain discovery materials submitted at trial by petitioner under a notice of reliance. Specifically, petitioner made of record and relies upon its requests for admissions, and the declaration of its counsel attesting to the fact that respondent never answered the requests for admissions. Respondent submitted no evidence at trial. Petitioner filed a brief on the case;<sup>3</sup> respondent did not.

After considering all of the evidence properly made of record, and for the reasons discussed below, we find that petitioner has established its standing to petition to cancel respondent's registration, and that there are valid

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<sup>2</sup> However, the exhibits attached to petitioner's petition and to respondent's answer were not made of record at trial and thus are not evidence in this case. See Trademark Rule 2.122(c), 37 C.F.R. §2.122(c).

grounds for cancelling that registration. We therefore sustain the petition to cancel. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

#### PETITIONER'S STANDING

We find that the record establishes the following facts regarding petitioner. Petitioner alleged in its petition to cancel that:

Colonial Williamsburg is a well known charitable and educational organization whose purposes include the preservation, restoration, and reconstruction of early American historical locations, buildings, objects, and works of art, and the conduct of related historical research and educational activities. For over seventy-five years, Colonial Williamsburg has been restoring, reconstructing, and operating as a living community [in] Virginia's Colonial capital at Williamsburg, Virginia, and has been researching, collecting, and displaying, within its museums and reconstructed buildings, a broad range of early American decorative art, and artifacts. [Petition to Cancel, ¶3.]

Over the years, more than 100 million people have visited the Historic Area maintained by Colonial Williamsburg. ... Many of Colonial Williamsburg's visitors have shopped at Colonial Williamsburg's retail and online stores and have purchased products bearing one or more of [petitioner's pleaded registered marks]. In addition, many of those visitors have shopped at retail stores operated by Colonial Williamsburg's licensees and, while doing so, have purchased products bearing one or more of [petitioner's pleaded registered marks]. [Petition to Cancel, ¶7.]

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<sup>3</sup> However, the evidence submitted by petitioner for the first time with its brief is untimely and we have given it no consideration. See TBMP §704.05(b).

Colonial Williamsburg has invested substantial time, effort, and money advertising, promoting, and selling its goods and services under [petitioner's pleaded registered marks]. Those marks are well known to the consuming public and reflect substantial goodwill created through the use of those marks by Colonial Williamsburg. Certain of the marks, particularly including COLONIAL WILLIAMSBURG, have become famous. [Petition to Cancel, ¶10.]

In its answer to the petition for cancellation, respondent did not deny these allegations. We therefore deem respondent to have admitted the allegations. See Fed. R. Civ. P. 8(b); Trademark Rule 2.114(b)(1), 37 C.F.R. §§2.114(b)(1).<sup>4</sup> In view of respondent's admissions, we find that these pleaded facts regarding petitioner and its operations are established.

At paragraph 8 of its petition to cancel, petitioner pleaded that it is the owner of numerous registrations of marks which consist of or include the word WILLIAMSBURG, and that those registrations are "in full force and effect." Respondent in its answer did not deny petitioner's allegations regarding the status and title of petitioner's

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<sup>4</sup> Fed. R. Civ. P. 8(b)(1)(B) provides: "In responding to a pleading, a party must: ... (B) admit or deny the allegations asserted against it by the opposing party." Similarly, Trademark Rule 2.114(b)(1) provides: "An answer shall ... admit or deny the averments upon which the petitioner relies." Fed. R. Civ. P. 8(b)(2) provides: "A denial must fairly respond to the substance of the allegation." Fed. R. Civ. P. 8(b)(6) provides in pertinent part: "An allegation - other than one relating to the amount of damages - is admitted if a responsive pleading is required and the allegation is not denied."

registrations, either in its specific answer to paragraph 8 or elsewhere in its answer to the petition for cancellation. Instead, respondent essentially treated petitioner's registrations as being of record by presenting, in its answer to paragraph 8 of the petition to cancel, substantive arguments regarding the alleged dissimilarity of respondent's mark to petitioner's registered marks, the dissimilarity of respondent's services to the goods and services identified in petitioner's registrations, and the alleged weakness of petitioner's registered marks.

Because respondent did not deny petitioner's allegations in paragraph 8 of the petition to cancel regarding the status and title of petitioner's pleaded registrations, we deem respondent to have admitted those allegations. See Fed. R. Civ. P. 8(b). In view of these admissions by respondent, the record establishes, and we find, that petitioner is the owner of its pleaded registrations and that those registrations are in full force and effect.

Of opposer's numerous pleaded registrations, we need and shall make our findings in this case based on only one of them, i.e., Registration No. 1385520, which is of the mark COLONIAL WILLIAMSBURG (in typed or standard character form) for "retail household furnishings and accessories, gifts and souvenir store services." This registration

issued on March 4, 1986, from an application filed on January 14, 1985.

Based on this evidence of record establishing petitioner's activities and petitioner's ownership of and the current status of its Registration No. 1385520, we find that petitioner has standing to petition to cancel respondent's registration. *See Cunningham v. Laser Golf Corp. supra.*

**SECTION 2 (d) GROUND FOR CANCELLATION**

We turn next to petitioner's Section 2(d) ground for cancellation of respondent's mark. This ground for cancellation is available to petitioner in this case because the petition to cancel was filed less than five years after the issuance of respondent's registration at issue. *See id.* To prevail on this claim, petitioner must prove its priority of use and the existence of a likelihood of confusion. *See id.*

The earliest date upon which respondent can rely for priority purposes in this case is its constructive use date of May 7, 2001, the filing date of the application which matured into its registration. *See Trademark Act Section 7(c), 15 U.S.C. §1057(c).* For its part, petitioner is entitled to rely on its constructive use date of January 14, 1985, the filing date of the application which matured into

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its pleaded Registration No. 1385520. *See id.* Because petitioner's constructive first use date predates respondent's constructive first use date, we find that petitioner has priority for purposes of its Section 2(d) claim. *See Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281 (TTAB 1998).

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Again, respondent's registration at issue is of the mark depicted below





for services identified in the registration as "retail shops featuring gifts, collectibles, notions, furnishings, apparel, toys, books and other publications, recorded music, handcrafted goods, memorabilia and artwork." Petitioner's Registration No. 1385520 is of the mark COLONIAL WILLIAMSBURG (in standard character form) for services identified in the registration as "retail household furnishings and accessories, gifts and souvenir store services."

We turn first to the second *du Pont* factor, under which we determine the similarity or dissimilarity of respondent's services as identified in its registration and petitioner's services as recited in petitioner's registration. We find that the respective services are identical to the extent that they both consist of retail establishments featuring "gifts" and "furnishings." We also find that the "souvenirs" identified in petitioner's registration legally encompass or are closely related to the other goods sold at respondent's retail shops as identified in respondent's registration, i.e., collectibles, notions, apparel, toys, books and other publications, recorded music, handcrafted goods, memorabilia and artwork. Because the parties' services are legally identical and/or otherwise closely

related, we find that the second *du Pont* factor weighs in favor of a finding of likelihood of confusion.

The third *du Pont* factor requires us to determine the similarity or dissimilarity of the trade channels in which the parties' respective services are marketed. Neither petitioner's nor respondent's respective identification of services includes any limitation or restriction as to trade channels, and we therefore presume that the services would be marketed in all of the normal trade channels for such services. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Because respondent's services as identified in its registration are essentially identical or otherwise closely related to petitioner's services as identified in its registration, we find that the trade channels for the respective services would be essentially identical or closely related as well. *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). For these reasons, we find that the third *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Under the fourth *du Pont* factor (conditions of purchase), we find that the consumers for the parties' retail store services as identified in their respective registrations are or would include ordinary consumers who would exercise only an ordinary degree of care in purchasing the services. We therefore find that the fourth *du Pont*

factor weighs in favor of a finding of likelihood of confusion.

We turn finally to the first *du Pont* factor, which requires us to determine the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc., supra*. The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks and service marks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Finally, in cases such as this, where the respondent's services are identical to petitioner's services, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the services were not identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applying these principles in the present case, we find as follows.

In terms of appearance, we find that respondent's mark and petitioner's mark are similar to the extent that they both include the word WILLIAMSBURG. Petitioner's mark is registered in standard character form, and thus may be displayed in any reasonable manner, including in the script form in which the word WILLIAMSBURG appears in respondent's mark. See *Cunningham v. Laser Golf Corp.*, *supra*.

Petitioner's and respondent's marks look dissimilar to the extent that each includes wording which does not appear in the other, and to the extent that respondent's mark includes design elements not present in petitioner's mark. However, we find that the similarity in appearance which results from the presence of the word WILLIAMSBURG in both marks outweighs the points of dissimilarity between the marks. On balance, we find that the marks are similar rather than dissimilar in terms of appearance. At the very least, the "appearance" element of our comparison of the marks is neutral.

In terms of sound, we find that the marks are identical to the extent that they both include the word WILLIAMSBURG. They otherwise sound different due to the different wording in the respective marks. On balance, however, we find that the marks sound similar, rather than dissimilar. At the very least, the "sound" element of our comparison of the marks is neutral.

In terms of connotation and overall commercial impression, we find that the marks are highly similar. Both marks specifically and prominently refer to "Williamsburg." The design elements in respondent's mark, i.e., the colonial mansion in the background and the man and woman dressed in colonial-era costumes, directly correlate to and evoke the word COLONIAL appearing in petitioner's mark, giving both marks the commercial impression that they are referring to "Colonial Williamsburg."<sup>5</sup>

For all of these reasons, we find that petitioner's and respondent's marks are similar when viewed in their entirety, especially in terms of overall commercial impression. They certainly are sufficiently similar to support a finding of likelihood of confusion given the legally identical nature of the parties' services. We find

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<sup>5</sup> During ex parte prosecution of the application which matured into respondent's registration, respondent submitted (on October 5, 2002) the following "statement describing mark" as part of its attempt to satisfy the Trademark Examining Attorney's requirement for an acceptable drawing of the mark:

The mark consists of the phrase "The Williamsburg Store.com" with the word "Williamsburg" written in script and the remaining words in plain text, with a drawing of a gentleman standing to the left of the text, and a drawing of a lady standing to the right of the text, both depicted as wearing colonial-era costumes. In the background, and above the text phrase "The Williamsburg Store.com," is a graphical image of the Williamsburg, Virginia colonial governor's palace.

This statement was not printed on the registration certificate as issued, but we deem it to be relevant to petitioner's Section 2(d) ground for cancellation in that it demonstrates the commercial impression respondent intends its mark to have.

that the first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Considering all of the evidence of record as it pertains to the *du Pont* factors, and for the reasons discussed above, we conclude that a likelihood of confusion exists.

Because petitioner has established its priority and the existence of a likelihood of confusion, we find that petitioner is entitled to prevail on its Section 2(d) ground of cancellation, and we accordingly grant the petition to cancel on that ground.

#### **ABANDONMENT GROUND FOR CANCELLATION**

We turn next to petitioner's second ground for cancellation of respondent's registration, i.e., abandonment.

A mark is deemed to be abandoned "[w]hen its use has been discontinued with intent not to resume such use." Trademark Act Section 45, 15 U.S.C. §1127. Nonuse of a mark for three consecutive years constitutes prima facie evidence of abandonment. *Id.* If petitioner establishes a prima facie case of abandonment by proving respondent's nonuse of the mark for three consecutive years, respondent then bears the burden of rebutting the prima facie case by producing evidence which either disproves that there was a period of

three consecutive years of nonuse, or proves that, during the period of nonuse, it had an intent to resume use (or to commence use, in cases such as this where the mark has never been used in commerce; see discussion *infra*). See *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989); *Auburn Farms Inc. v. McKee Foods Corp.*, 51 USPQ2d 1439 (TTAB 1999).

By notice of reliance, petitioner made of record the requests for admissions it propounded to respondent during the discovery period. It also made of record the declaration of its counsel attesting to the fact that respondent never answered petitioner's requests for admissions. Because respondent failed to answer petitioner's requests for admissions, respondent is deemed to have admitted the matters set forth in the requests for admissions. See Fed. R. Civ. P. 36(b)(3); Trademark Rule 2.120(a), 37 C.F.R. §2.120(a).

Respondent therefore has admitted (in pertinent part) that: "[respondent does] not own or operate, under the trademark or trade name THE WILLIAMSBURGSTORE.COM or WILLIAMSBURGSTORE.COM,<sup>6</sup> a physical retail store anywhere in

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<sup>6</sup> The definitions set forth in petitioner's discovery requests include No. 13, which defines respondent's mark as "'THE WILLIAMSBURG STORE.COM,' the subject of [respondent's] Registration, and any other formation or style of 'THE WILLIAMSBURG STORE.COM to which you claim any right, title or interest."

the United States" (admission no. 1); "[respondent] never has owned or operated, under the trademark or trade name THE WILLIAMSBURGSTORE.COM or WILLIAMSBURGSTORE.COM, a physical retail store anywhere in the United States" (admission no. 2); and that "[respondent has] not sold any goods or services under the trademark or trade name THE WILLIAMSBURGSTORE.COM, including any gifts, collectibles, notions, furnishings, apparel, toys, books and other publications, recorded music, handcrafted goods, memorabilia and artwork" (admission no. 21).

Respondent's admissions establish that respondent does not render and never has rendered the services identified in its registration in commerce. It has been held, in a case involving a petition to cancel a mark registered pursuant to Trademark Act Section 44(e), 15 U.S.C. §1126(e), on the ground of abandonment, that a prima facie case of abandonment is established where the registered mark has never been used in commerce on or in connection with the goods and/or services identified in the registration. See *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990). Likewise, in a case involving a petition for partial cancellation of a registration pursuant to Trademark Act Section 18, 15 U.S.C. §1068, on the ground of abandonment of the mark as to certain of the goods/and or services identified in the



registration, it was held that a prima facie case of abandonment is established where the registered mark has never been used in commerce on or in connection with those goods and/or services. See *The Procter & Gamble Co. v. Sentry Chemical Co.*, 22 USPQ2d 1589 (TTAB 1992).

We find that this principle is equally applicable in a case like the present one, involving a registration based on Trademark Act Section 1, 15 U.S.C. §1051. We find that the evidence of record in this case, which establishes that respondent has never used its registered mark in commerce, suffices to make out a prima facie case of abandonment.

We further find that respondent has failed to present any evidence sufficient to rebut petitioner's prima facie showing of abandonment. As noted above, respondent did not present any evidence at all at trial. Respondent's statements in its answer to the petition for cancellation, and its exhibits to the answer, are not evidence of record. See TBMP §704.06(a); Trademark Rule 2.122(c).

For these reasons, we find that respondent has abandoned the registered mark, and we grant the petition for cancellation on that ground.

#### **CONCLUSION AND DECISION**

Because petitioner has established its standing to petition for cancellation of respondent's registration, and

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has established that valid grounds for cancellation exist, we conclude that petitioner is entitled to prevail in this case and that respondent's registration should be cancelled.

Decision: The petition to cancel is granted.