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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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General Contact Number: 571-272-8500

WINTER

Mailed: August 13, 2014

Cancellation No. 92055585

MeUndies, Inc.

v.

Drew Massey dba myUndies Inc.

**Before Quinn, Mermelstein, and Gorowitz,
Administrative Trademark Judges.**

By the Board:

MeUndies, Inc. (“Petitioner”) seeks to cancel the registration of Drew Massey dba myUndies Inc. (“Respondent”) for the mark MYUNDIES in standard character format for “clothing, namely, underwear; boxers, briefs, panties, thongs, bras, sleepwear, loungewear, shirts, shorts, jeans, pants, socks, and hats.”¹ As grounds for cancellation,² Petitioner claims ownership of the marks MEUNDIES and MEUNDIES.COM and asserts claims of abandonment and nonuse. In support of its claims, Petitioner alleges, *inter alia*, prior use of the marks MEUNDIES and MEUNDIES.COM in connection with a wide variety of undergarments since December 21, 2011;

¹ U.S. Reg. No. 3688473, issued September 29, 2009, on the Principal Register. The underlying application was filed on October 22, 2008.

² Petitioner filed an amended petition for cancellation on April 5, 2013.

that its application for the mark MYUNDIES.COM³ has been refused under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with Respondent's mark; and that continued existence of Respondent's registration will be a source of damage and injury to Petitioner in that it will be unable to obtain a registration for its mark.

Respondent, in its amended answer, has denied the essential allegations of the amended petition for cancellation.

This case now comes up on Petitioner's fully briefed motion⁴ (filed May 7, 2014) for summary judgment in its favor on its claim of nonuse. For purposes of this order, we presume the parties' familiarity with the pleadings and the arguments and materials submitted in connection with the motion for summary judgment.

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute with respect to any material fact, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c)(1). A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute as to a material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323

³ Application Serial No. 85776657, filed November 12, 2012, for "lingerie; socks; socks and stockings; undergarments" in International Class 25 and "computerized on-line retail store services in the field of clothing and wearing apparel" (and related services) in International Class 35.

⁴ As discussed in the Board's order mailed June 24, 2014, we will not consider Respondent's sur-reply submitted on June 23, 2014.

(1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

When the moving party has supported its motion with sufficient evidence that, if unopposed, indicates there is no genuine dispute of material fact, the burden then shifts to the non-moving party to demonstrate the existence of a genuine dispute of material fact to be resolved at trial. *Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1540 (TTAB 2009). All evidence must be viewed in a light favorable to the nonmovant, and all justifiable inferences are to be drawn in the nonmovant's favor. *Lloyd's Food Products, Inc.*, 987 F.2d at 766, 25 USPQ2d at 2029; *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 850, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992). Further, in considering whether summary judgment is appropriate, the Board may not resolve any genuine disputes of material fact necessary to decide the merits of the opposition. Rather, the Board may only ascertain whether any material fact cannot be disputed or is genuinely disputed. *See Lloyd's Food Products*, 25 USPQ2d at 2029; and *Olde Tyme Foods*, 22 USPQ2d at 1542.

- *Standing*

Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987). We find that there is no genuine dispute of material fact concerning Petitioner's standing. A party has standing to seek cancellation of a trademark registration if the party reasonably believes it is likely to be damaged by the registration. That belief in likely damage can be shown by establishing a direct commercial interest in the marks at issue. See *Cunningham v. Laser Golf Corp.*, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *International Order of Job's Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 1091, 220 USPQ 1017, 1019 (Fed. Cir. 1984).

Here, Petitioner has submitted a copy of the Office Actions issued on July 9, 2013, and on March 15, 2013, by the Trademark Examining Attorney in connection with Petitioner's pending application Serial No. 85776657 for registration of MYUNDIES.COM. These documents show that the Trademark Office has refused registration of Petitioner's mark under Trademark Act Section 2(d), based on Respondent's registration (see motion, Exh. A). In view of this evidence, there is no genuine dispute that Petitioner has standing to pursue this cancellation. See *Weatherford/Lamb Inc. v. C&J Energy Services Inc.*, 96 USPQ2d 1834, 1837 (TTAB 2010) ("Inasmuch as Petitioner has made of record the USPTO Office action suspending its

pleaded application pending the possible refusal to registration under Section 2(d) of the Lanham Act based on an alleged likelihood of confusion with Respondent's registration, there is no question that Petitioner has standing to bring this petition for cancellation.”). *Cf. Fiat Group Automobiles S.p.A. v. ISM, Inc.*, 94 USPQ2d 1111, 1112 (TTAB 2010) (standing found where Office made a provisional refusal of opposer's application based on prior pending applications), *citing Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008).

- *Nonuse*

A registration may be found void *ab initio*⁵ under Trademark Act Section 1(a) when the mark in the underlying use-based application was not in use in commerce as of the application filing date. *American Hygienic Laboratories, Inc. v. Tiffany & Co.*, 12 USPQ 2d 1979, 1984 (TTAB 1989).

Petitioner seeks summary judgment on its pleaded ground that Respondent's registration should be cancelled because at the time Respondent filed his use-based application, the applied-for mark was not in use in commerce on the identified goods (amended petition, ¶30). As evidence of nonuse, Petitioner relies on the discovery responses of Drew Massey, specifically, his responses to Petitioner's requests for admission, nos. 8-16 (motion, Exh. B) and to his responses to Petitioner's requests for production

⁵ “From the beginning.” See http://www.oxforddictionaries.com/us/definition/american_english/ab-initio (visited August 7, 2014).

of documents to show that Respondent did not use the mark MYUNDIES prior to the filing date of the underlying application. In particular, in the referenced admission requests, Respondent was requested to admit or to deny that “[y]ou did not offer [specific good identified in the registration] for sale in connection with the designation MYUNDIES as of October 22, 2008,” the filing date of the underlying application. With respect to each identified good, *i.e.*, underwear; boxers, briefs, panties, thongs, bras, sleepwear, loungewear, shirts, shorts, jeans, pants, socks, and hats, Respondent admitted as follows:

“ADMIT. Registration [*sic*] was pro se and should have filed as ‘intend to use’ versus referring to ‘first known use’ which was done by a prior separate company (See exhibit in RFP Answer)” (motion, Exh. D).

In response to request for production no. 24, in which Petitioner requested “all documents that identify, refer to, or relate to customers who have purchased goods that were sold bearing the designation MYUNDIES prior to October 22, 2008,” Respondent provided the following response:

“ADMIT. No sales exist prior to October 22, 2008. The application for the trademark was filed pro se and the first use statement is based on knowledge of a prior company’s efforts and not based on first use by Registrant” (motion, Exh. E).

Respondent provided the identical response to request no. 26 by which Petitioner requested “all documents that refer to or relate to revenue generated from the sale of goods that were sold bearing the designation MYUNDIES prior to October 22, 2008.”

We note also the declaration of Frederick D. Ross, III, which comprises Exh. 6 to Respondent's responses to Petitioner's document requests (motion, Exh. E). Mr. Ross explains that he was the founder and CEO of a company named "myUndies.com, Inc," which existed from 1999 to 2001, and which used the mark MYUNDIES in connection with online retail services (Ross dec., ¶¶ 1, 3 and 7). Mr. Ross declares that Respondent was not involved in his company and that when Respondent contacted Mr. Ross regarding Respondent's possible use of the mark, the mark MYUNDIES had been abandoned by myUndies.com, Inc. for nearly eight years (Ross dec., ¶8-9).

In view of the foregoing evidence, we find that Petitioner has set forth sufficient evidence that, if unopposed, shows that there is no genuine dispute that Respondent was not using the mark MYUNDIES in connection with any of the identified goods on the date on which the underlying use-based application was filed.

In response to Petitioner's motion, Respondent has failed to submit any evidence that would demonstrate that a genuine dispute exists as to his use of the MYUNDIES mark on any of the identified goods on the date on which the underlying application was filed. Rather, in his unsworn response to Petitioner's motion, Respondent merely argues, among other things, that he has been and is using the mark MYUNDIES and has no intention to abandon the mark, and did not commit fraud when he filed the underlying application. These arguments are unavailing. In the motion before us, Petitioner seeks

judgment only on its claim of nonuse, *i.e.*, that Respondent was not using its mark on any of the identified goods *at the time he filed his application*. Whether Respondent is currently using the registered mark or whether he has any current intent to resume use is not the issue. Further, the issue of fraud is not involved here insofar as Petitioner did not include a fraud claim in its amended petition. Simply put, if an application is filed under Section 1(a) of the Trademark Act, 15 U.S.C. § 1052(a), and there was no actual use of the applied-for mark on the goods identified in the application on or before the filing date of the application, the application is void, and any resulting registration is subject to cancellation. *See ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 (TTAB 2012); *Laboratories du Dr. N.G. Payot Etablissement v. Southwestern Classics Collection Ltd.*, 3 USPQ2d 1600 (TTAB 1987).

Similarly, it is irrelevant that Respondent represented himself and possibly misunderstood the law when he filed his use-based application. A use-based application is void if the mark is not in use on the identified goods at the time of filing, regardless of whether the applicant understood the statutory requirement for use or intended to mislead the USPTO. *See Aycock Eng'g Inc. v. Airflite Inc.*, 560 F.3d 1350, 90 USPQ2d 1301, 1307 (Fed. Cir. 2009) (“Without question, advertising or publicizing a service that the applicant intends to perform in the future will not support registration. Instead, the advertising or publicizing must relate to an existing service

which has already been offered to the public. Furthermore, mere adoption (selection) of a mark accompanied by preparations to begin its use are insufficient ... for claiming ownership of and applying to register the mark.” (citations and internal quotation marks omitted); *Gay Toys, Inc. v. McDonald’s Corp.*, 585 F.2d 1067, 199 USPQ 722, 723 (CCPA 1978).

As noted, there is no issue as to whether Respondent’s mark was in use when he filed his application — Respondent admits that it was not. In view of the foregoing, even viewing his arguments in the light most favorable to Mr. Massey as the non-movant, we find that Respondent has failed to show the existence of a genuine dispute of material fact to be resolved at trial regarding whether he was using the MYUNDIES mark on or prior to the date the application was filed.

Accordingly, Petitioner’s motion for summary judgment on the ground that the registration is void *ab initio* because the mark was not in use on the date the underlying application was filed is **granted**. Judgment is hereby granted against Respondent, the petition to cancel is **granted**, and Registration No. 3688473 will be cancelled in due course.⁶

⁶ In view thereof, Petitioner’s claim of abandonment is dismissed without prejudice. *Cf. Sarl Corexco v. Webid Consulting Ltd.*, 110 USPQ2d 1587 (TTAB 2014); *Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170 (TTAB 2013); and *ShutEmDown Sports, Inc. v. Lacy*, 102 USPQ2d 1036, 1045-1046 (TTAB 2012) (“We need not discuss the remaining elements of the fraud claim or render a decision on it, as we have already determined that the registration must be cancelled in its entirety both on the abandonment claim and because of the application’s voidness.”).