

This Opinion Is Not a
Precedent of the TTAB

Mailed: February 14, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

A & M Wings, Inc.
v.
Glenn Thompson

Cancellation No. 92064044

Derek R. Fahey of The Plus IP Firm, PLLC,
for A & M Wings, Inc.

Glenn Thompson, *pro se*.

Before Adlin, Hightower, and Lynch,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

A & M Wings, Inc. (“Petitioner”) petitions to cancel Glenn Thompson’s (“Respondent”) Principal Register registration for the mark TREE’S, WINGS AND RIBS, in standard characters and with “wings and ribs” disclaimed, for “restaurant services” in International Class 43.¹ The asserted grounds for cancellation are fraud and abandonment by naked licensing.

We deny the petition.

¹ Registration No. 3025777, issued December 13, 2005; renewed.

I. Record

The record consists of the pleadings and, without any action by the parties, the files of the involved registration. Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1).²

A. Petitioner's Evidence

Petitioner submitted the following evidence by Notice of Reliance:

- The affidavits of Andrew Maynard, its owner (“Maynard Aff.”) (Exhibit 1, 25 TTABVUE 5-35), and Erin Townsend, general manager of its restaurant (Exhibit 2, 25 TTABVUE 36-41), both with exhibits;
- Certain of Petitioner’s interrogatories, requests for production, and requests for admission, and Respondent’s responses (Exhibits 3-8, 25 TTABVUE 42-120);³
- Dictionary definitions of the terms “unbridled,” “absolute,” and “unconditional” (Exhibits 10-16, 25 TTABVUE 179-232); and
- Articles of incorporation and other corporate documents pertaining to Petitioner and its predecessor-in-interest, Southern Wings of Royal Palm Beach, Inc. (Exhibits 17-20, 25 TTABVUE 233-54).

B. Respondent's Evidence

In its Order dated July 3, 2018, the Board granted Petitioner’s motion to strike Respondent’s Notice of Reliance as untimely. 29 TTABVUE. Respondent therefore made no evidence of record.

² Petitioner therefore should not have resubmitted the prosecution history of the subject registration. Exhibit 9, 25 TTABVUE 121-78.

³ Only responses to requests for production indicating that no responsive documents exist are properly of record. *See* Trademark Rule 2.120(k)(3), 37 C.F.R. § 2.120(k)(3); *United Glob. Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1044 (TTAB 2014). Therefore, we have considered only responses to document requests 8-12, 25 TTABVUE 86-87, as well as Respondent’s interrogatory responses and admissions.

II. Petitioner's Standing

Standing is a threshold issue that must be proven by the plaintiff in every inter partes case. Petitioner bears the burden of proving standing as an essential element of its case in chief. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (“The facts regarding standing, we hold, are part of a petitioner’s case and must be affirmatively proved.”); *Nobelle.com LLC v. Qwest Commc’ns Int’l Inc.*, 66 USPQ2d 1300, 1303 (TTAB 2003) (“[S]tanding is an essential element of petitioner’s case which, if it is not proved at trial, defeats petitioner’s claim.”). To establish its standing, Petitioner must prove that it has a “real interest,” i.e., a “reasonable” basis for its belief of damage. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

Petitioner did not address its standing to bring this proceeding in its petition or its trial briefs. Petitioner did, however, submit evidence that it operates a restaurant known as “Tree’s Wings and Ribs,” which is identical to the mark in the subject registration except for a comma.⁴ *See, e.g.,* Maynard Aff. at ¶ 4, 25 TTABVUE 7. This demonstrates that Petitioner has a relevant commercial interest in the term TREE’S, WINGS AND RIBS for restaurant services and an interest in the outcome of this proceeding beyond that of a mere intermeddler. Thus, it has standing to petition for cancellation. *See, e.g., Exec. Coach Builders*, 123 USPQ2d at 1179-80; *Brooks v. Creative Arts By Calloway LLC*, 93 USPQ2d 1823, 1827 (TTAB 2009).

⁴ The marks are not distinguished by this minor variation in punctuation. *See, e.g., Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1179 (TTAB 2017).

III. Abandonment

We first consider Petitioner's claim that Respondent has abandoned his mark by uncontrolled or "naked" licensing to Petitioner itself and third parties. A trademark registration may be cancelled if the mark has become abandoned. Trademark Act § 45, 15 U.S.C. § 1127, provides that a mark shall be deemed abandoned when "any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark." Uncontrolled or "naked" licensing can result in a loss of significance of a trademark such that a registration should be cancelled. *Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 USPQ2d 1856, 1864 (TTAB 2007). Because registrations are presumed valid under Trademark Act Section 7, 15 U.S.C. § 1057, however, the party seeking cancellation based on abandonment bears the burden of proving abandonment by a preponderance of the evidence. *Rivard v. Linville*, 133 F.3d 1446, 45 USPQ2d 1374, 1376 (Fed. Cir. 1998); *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309-12 (Fed. Cir. 1989).

Petitioner submitted evidence that Respondent licensed it to use the name "Tree's Wings and Ribs" in 1995, and that in 2004 the parties extended the license agreement for 99 years, until 2103. *See* Maynard Aff. at ¶ 41, 25 TTABVUE 17; Extention [sic] Agreement, 25 TTABVUE 116-17. Because Petitioner is licensed to use the subject mark, the doctrine of licensee estoppel bars Petitioner from bringing a claim that Respondent abandoned the mark through uncontrolled licensing. *See, e.g., Freeman v. Nat'l Ass'n of Realtors*, 64 USPQ2d 1700, 1703 (TTAB 2002) (attacking validity of

marks petitioner was licensed to use “is the type of conduct which the doctrine of licensee estoppel is intended to prevent”); *Leatherwood Scopes Int’l Inc. v. Leatherwood*, 63 USPQ2d 1699, 1703 (TTAB 2002); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1386 (TTAB 1991); *Garri Publ’n Assocs. Inc. v. Dabora Inc.*, 10 USPQ2d 1694, 1697 (TTAB 1988); *see also* 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 18:63 (5th ed. 2018) (“The licensee estoppel rule is founded on the view that a licensee should not be permitted to enjoy the use of the licensed mark while at the same time challenging the mark as being invalid.”). The abandonment claim therefore is dismissed.

IV. Fraud

Fraud in procuring or maintaining a trademark registration occurs when an applicant or registrant knowingly makes a false, material representation of fact with the intent to deceive the U.S. Patent and Trademark Office (USPTO), thereby obtaining or maintaining a registration to which it is otherwise not entitled. *See In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1044 (TTAB 2012). A party seeking cancellation of a trademark registration for fraudulent procurement or renewal bears a heavy burden of proof. *See id.* at 1939. Indeed, “the very nature of the charge of fraud requires that it be proven ‘to the hilt’ with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.” *Smith Int’l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981); *see also Swiss Watch Int’l Inc. v. Fed. of Swiss Watch Indus.*, 101 USPQ2d 1731, 1745 (TTAB 2012).

Petitioner alleges that Respondent committed fraud in renewing his registration by submitting a picture of Petitioner's restaurant and website as specimens. While the USPTO recognizes ownership and use claims based on "use by controlled licensees, pursuant to a contract or agreement," if Petitioner's use of the mark is not "controlled" by Respondent, Petitioner's use in the renewal specimens does not inure to Respondent's benefit. Trademark Manual of Examining Procedure (TMEP) § 1201.03(e) (Oct. 2018) (citing *Pneutek, Inc. v. Scherr*, 211 USPQ 824, 833 (TTAB 1981)); *see also, e.g., Moreno v. Pro Boxing Supplies, Inc.*, 124 USPQ2d 1028, 1035-36 (TTAB 2017).

Here, there is no showing that Respondent knowingly made a false representation with the intent to deceive the USPTO.⁵ *See Loren Cook Co. v. Acme Eng'g & Mfg. Corp.*, 216 USPQ 517, 520 (TTAB 1982). The Section 8 specimens showing Petitioner's use were submitted March 22, 2016. The accompanying declaration included the statements that "the mark is in use in commerce" and that the specimens show "the mark as used in commerce." There is no dispute that these statements were true. The problem with Petitioner's fraud claim is that "[t]he USPTO does not require an application to specify if the applied-for mark is not being used by the applicant but is being used by one or more related companies whose use inures to the benefit of the applicant." TMEP § 1201.03(a). Applying this policy to Respondent's allegation of use

⁵ We therefore need not address the effect, if any, of Respondent's July 18, 2016 submission of an additional, untimely specimen apparently intended to support the Section 8 affidavit, according to the July 18, 2016 Note to the File. Respondent submitted the additional specimen after the relevant deadline and failed to include the required Section 8 affidavit or declaration that the additional specimen was in use during the relevant period.

in the registration maintenance filing, because Respondent was not required to disclose that the claimed use of the mark was by Petitioner, this omission was immaterial and cannot serve as the basis for a fraud claim.

In any event, Petitioner has not shown that Respondent intended to deceive the Office. There was no false allegation that Respondent had the requisite control over Petitioner's use, because there was no such allegation in Respondent's submission to the Office. And Petitioner has not proven that Petitioner knew the use claimed in the Section 8 affidavit did not inure to his benefit, but falsely represented to the Office that it did. Rather, Petitioner argues that Respondent submitted the specimen "knowing that Petitioner did not consider such use to inure to Respondent." Petitioner's Brief at 32, 30 TTABVUE 33. Petitioner's own belief does not establish Respondent's intent to deceive the Office. Petitioner's fraud claim is dismissed.

Decision: The petition to cancel is denied.