

**This Opinion is Not a
Precedent of the TTAB**

Mailed: April 28, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Norman “Cess” Silvera
v.
Richard Effs

Cancellation No. 92064094
—

Susan Dierenfeldt Troy of Troy & Schwartz LLC,
for Norman “Cess” Silvera.

William D. Weyrowski of William D. Weyrowski PA,
for Richard Effs.

—
Before Wolfson, Larkin, and English,
Administrative Trademark Judges.

Opinion by English, Administrative Trademark Judge:

Respondent, Richard Effs, has registered on the Principal Register the standard character mark SHOTTAS for “computer programs for video games” in International Class 9; “fashion clothing, namely, t-shirts, shorts, hats” in International Class 25; and “motion picture film production, entertainment media production services for motion pictures television and internet” in International Class 41.¹

¹ Registration No. 4463486 issued on the Principal Register on January 7, 2014 from an application filed June 14, 2012 based on an intent to use the mark under Section 1(b) of the

Petitioner, Norman “Cess” Silvera, has petitioned to cancel Respondent’s registration, alleging prior use of the mark SHOTTAS “in connection with screen play writing and motion picture film distribution.”² In the Electronic System for Trademark Trials and Appeals (ESTTA) coversheet and the body of the petition for cancellation, Petitioner identifies his claims as priority and likelihood of confusion, dilution, nonuse, and fraud. For the goods and services in International Classes 9 and 41, Petitioner further claims that the mark is the title of a single creative work.³

In his Answer, Respondent admits that:

- “Registrant’s mark is identical to the Petitioner’s mark.”
- “Petitioner as well as other individuals, were at some point, involved with or otherwise associated with the use of the name SHOTTAS in connection with a motion picture[.]”⁴
- “Petitioner as well as other individuals, were at some point, involved with or otherwise associated with the creation of a screenplay and the production of a movie by the name *Shottas*.”
- “Petitioner as well as other individuals, were at some point, involved with or otherwise associated with the completion of a movie by the name *Shottas*.”⁵

Trademark Act, 15 U.S.C. § 1051(b); statement of use filed July 19, 2013 asserting first use and first use in commerce on January 1, 2009 for the goods in International Classes 9 and 25 and first use and first use in commerce on February 1, 2002 for the services in International Class 41.

² Petition for Cancellation, 1 TTABVUE 3.

³ In his brief, Petitioner argues abandonment. In view of our decision on Petitioner’s nonuse claim, we need not consider whether Petitioner’s unpleaded abandonment claim was tried by implied consent.

⁴ Respondent qualifies this admission with the statement that “[s]uch use was not exclusive to Petitioner.” Answer, 11 TTABVUE 2, ¶ 1.

⁵ Petition for Cancellation, 1 TTABVUE 2-5, ¶¶ 1, 2, 4, and 14; Answer, 11 TTABVUE 2-3, ¶¶ 1, 2, 4, and 14.

Respondent otherwise denies the salient allegations in the petition for cancellation.⁶

I. Evidence of Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), Respondent's registration file. In addition, Petitioner took the testimony deposition of Respondent during which Respondent's attorney cross-examined Respondent. Neither party introduced any other evidence during trial, but both parties attached new evidence to their briefs.⁷

The time for the parties to have submitted evidence was during trial, not briefing. *Life Zone Inc. v. Middleman Grp.*, 87 USPQ2d 1953, 1955 (TTAB 2008). The Board

⁶ Respondent pleaded affirmative defenses of failure to state a claim, laches, waiver, estoppel, and acquiescence but did not argue these affirmative defenses in his brief so we deem them waived. *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (affirmative defense not argued in brief deemed waived), *aff'd mem.*, 565 F. App'x 900 (Fed. Cir. 2014); *Swiss Watch Int'l Inc. v. Fed'n of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1734 n.4 (TTAB 2012) (same). Respondent also pleaded an affirmative defense of unclean hands and argued in his brief that Petitioner "engaged in fraud." 29 TTABVUE 11. Whether unclean hands is available as a defense against Petitioner's nonuse claim – the claim we address in this opinion – is not an issue we need to decide, because even if it were available, Respondent has not proven that Petitioner acted with unclean hands. *Barbara's Bakery, Inc. v. Landesman*, 82 USPQ2d 1283, 1290, n.11 (TTAB 2007) ("[W]e need not and specifically do not reach the issue of whether unclean hands is available to applicant as an affirmative defense to opposer's nonuse claim, because even if it were, applicant has not proven it."). To support his assertion of "fraud," Respondent points to allegations in complaints filed against Petitioner in Florida state court. The complaints are probative only for what they show on their face, not for the truth of the allegations contained therein.

⁷ Both parties also attached to their briefs excerpts from and exhibits to Respondent's testimony deposition. Attaching evidence to briefs hinders the Board's review of the record. The parties should have cited to the TTABVUE entry and page number for the evidence, as we have done in this decision. *See, e.g., RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1804 (TTAB 2018); Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 801.03 (2019) ("When referring to the record in an inter partes proceeding before the Board, parties should include a citation to the TTABVUE entry and page number (*e.g.*, 1 TTABVUE 2) to allow the reader to easily locate the cited materials.").

assigns each party a specific testimony period, and “[n]o testimony shall be taken or evidence presented except during the times assigned, unless by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.” Trademark Rule 2.121(a), 37 C.F.R. § 2.121(a). Despite the parties’ failure to adhere to Trademark Rule 2.121(a), because neither party objected to the untimely submission of evidence by the other, and because each party discussed the evidence submitted by the other and treated all of the evidence attached to their main briefs as part of the record, we exercise our discretion to treat the evidence as having been stipulated into the record.⁸ Accordingly, we have considered the new evidence attached to the parties’ main briefs for what the documents show on their face.⁹ *Life Zone Inc.*, 87 USPQ2d at 1957 (applicant’s reliance on evidence opposer improperly

⁸ Respondent’s Brief, 29 TTABVUE 5-7; Petitioner’s Reply Brief, 30 TTABVUE 3. Petitioner’s relevancy objection to the complaint in *Wekerle v. Silvera* is overruled. The Board is capable of weighing the relevance and strength or weakness of evidence. *RxD Media*, 125 USPQ2d at 1804. Petitioner’s objection to the “mediation and settlement agreement” on the ground that Respondent should have produced it at his testimony deposition also is overruled. Petitioner’s deposition notice was not broad enough to cover the agreement. 24 TTABVUE 3. In any event, “Petitioner nevertheless relies on the mediated agreement to the extent it supports the Petitioner’s position that cancellation of the Shottas mark is warranted.” 30 TTABVUE 3.

⁹ The truth of the matters asserted in these documents is not a proper subject for judicial notice so to the extent Petitioner asks that we take judicial notice of such “facts,” the request is denied. *See, e.g. Lee v. City of L.A.*, 250 F.3d 668, 690 (9th Cir. 2001) (district court erred in taking judicial notice of disputed facts in public records); *General Elec. Capital Corp. v. Lease Resolution Corp.*, 128 F.3d 1074, 1076 (7th Cir. 1997) (district court erred in taking judicial notice of “facts” from an unrelated proceeding without determining that the facts were undisputed); *In re Jimmy Moore, LLC*, 119 USPQ2d 1764, 1767 (TTAB 2016) (“[T]he Board does not take judicial notice of records residing in the Patent and Trademark Office.”); *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1931 n.26 (TTAB 2006) (third-party website “materials are clearly not proper subject matter for judicial notice”).

As for the attachments to Petitioner’s reply brief, there is no basis for treating them as stipulated into the record, and we decline to do so.

submitted construed as a stipulation to the admission of the evidence). This evidence is enumerated below.

A. Petitioner’s Evidence

Petitioner attached to his main brief:

- Printouts from the United States Patent and Trademark Office’s Trademark databases related to abandoned application Serial No. 87068612 for the mark TOP SHOTTAS;¹⁰
- An article from 365voice.com;¹¹
- Printouts from the Copyright Office database showing search results for “Norman Cess Silvera” and registrations for a motion picture and screenplay titled “SHOTTAS” identifying Petitioner as the “Copyright Claimant”;¹²
- Printouts from the Miami-Dade County Civil, Family and Probate Courts online system identifying a case between the parties: *Effs v. Norman “Cess” Silvera, et al.*, Case No. 12-8650, in the 11th Judicial Circuit in and for Miami-Dade County, Florida;¹³
- An order in *Effs v. Sony Pictures Home Entertainment, Inc., et al.*, Case No. 13-22843-WJZ, in the Southern District of Florida, granting summary judgment to Sony Pictures Home Entertainment, Inc. on Respondent’s (as plaintiff therein) claims of trademark infringement and dilution and dismissing the claims;¹⁴
- Filings with the Secretary of State, Tallahassee, Florida related to Access Pictures, LLC;¹⁵

¹⁰ Petitioner’s Brief, 26 TTABVUE 101-109.

¹¹ *Id.* at 110.

¹² *Id.* at 111-114.

¹³ *Id.* at 115-117.

¹⁴ *Id.* at 118-129.

Neither party addressed whether either the state or federal case might have a preclusive effect here, so we need not address that issue.

¹⁵ *Id.* at 130-134.

- Printout from the Florida Department of State website for Access Pictures, LLC;¹⁶ and
- Printout from the website fandango.com.¹⁷

B. Respondent's Evidence

Respondent attached to his brief:

- Copies of a complaint, answer/counterclaim, “mediation settlement agreement,” and court order on a motion to compel enforcement of the “mediation settlement agreement” in the state court action *Effs v. Norman “Cess” Silvera, et al.*, Case No. 12-8650;¹⁸
- Copy of a complaint, and exhibits thereto, in another state court action: *Wekerle v. Silvera, et al.*, (no case number) in the 11th Judicial Circuit in and for Miami-Dade County, Florida;¹⁹ and
- Screen shots from a website promoting apparel bearing the mark SHOTTAS.²⁰

II. Analysis

A. Standing

Standing is a threshold requirement that the plaintiff must prove in every inter partes case. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1061-62 (Fed. Cir. 2014); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187-89 (CCPA 1982); *Bell's Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1344 (TTAB 2017). “The purpose of the standing requirement is ‘to prevent litigation where there is no real controversy between the

¹⁶ *Id.* at 134-135.

¹⁷ *Id.* at 136-139.

¹⁸ Respondent's Brief, 29 TTABVUE 13-56. The pages of the complaint are out of order.

¹⁹ *Id.* at 59-169.

²⁰ *Id.* at 169-170.

parties,” where a plaintiff “is no more than a mere intermeddler.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012) (quoting *Lipton Indus.*, 213 USPQ at 189). To meet the standing requirement, a plaintiff need only show that it has a “real interest” in the proceeding, i.e., a direct and personal stake in the outcome of the proceeding, and a “reasonable basis” for its belief in damage. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999); *see also Coach Servs., v. Triumph Learning*, 101 USPQ2d at 1727.

In his answer, Respondent admitted that his mark “is identical to Petitioner’s mark” and that Petitioner was “at some point, involved with or otherwise associated with the use of the name SHOTTAS in connection with a motion picture.”²¹ Respondent also testified that he and Petitioner were “partner[s]” in “building” the SHOTTAS “brand.”²² Respondent’s admissions and testimony establish that Petitioner is not a “mere intermeddler,” but rather has a direct and personal stake in the outcome of this proceeding and a reasonable basis for his belief in damage. Accordingly, we find that Petitioner has standing.

B. Nonuse

In the body of the petition for cancellation, Petitioner’s allegations of nonuse are set out as part of his fraud claim. While it would have been preferable for Petitioner to have pleaded nonuse under a separate heading, Petitioner identified nonuse as a separate claim in the ESTTA coversheet to his petition for cancellation, and thus

²¹ Petition for Cancellation, 1 TTABVUE 3 and 5, ¶¶ 1 and 14; Answer, 11 TTABVUE 2-3, ¶¶ 1 and 14.

²² Respondent’s Testimony Deposition, 25 TTABVUE 24 and 73.

Respondent had adequate notice that Petitioner was pleading separate claims of nonuse and fraud based on nonuse. *See PPG Indus. Inc. v. Guardian Indus. Corp.*, 73 USPQ2d 1926, 1927-28 (TTAB 2005) (recognizing that the ESTTA “filing form and the attachment thereto are considered a single, integrated filing”); *see also ShutEmDown Sports, Inc. v. Lacy*, 102 USPQ2d 1036, 1045 (TTAB 2012) (separate pleading of nonuse “preferable” but failure to do so not “critical”).

To prevail on his claim of nonuse, Petitioner must prove that Respondent was not using the SHOTTAS mark in commerce for the goods and services identified in Registration No. 4463486 as of August 19, 2013, i.e., Respondent’s deadline to file a statement of use.²³ *Embarcadero Techs., Inc. v. Delphix Corp.*, 117 USPQ2d 1518, 1524 (TTAB 2016) (“[T]he actual filing of a statement of use does not cut off the deadline for meeting the requirements for a statement of use” so the focus in a nonuse claim is whether the mark was in use as of the deadline to file a statement of use). “Commerce” is “all commerce which may lawfully be regulated by Congress,” 15 U.S.C. § 1127, including activities that have a substantial effect on interstate commerce. *Christian Faith Fellowship Church v. Adidas AG*, 841 F.3d 986, 120 USPQ2d 1640, 1643 (Fed. Cir. 2016). The Trademark Act defines “use in commerce” as:

the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce—
(1) on goods when—
(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or

²³ A notice of allowance issued February 19, 2013.

if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and
(B) the goods are sold or transported in commerce, and
(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

Section 45 of the Trademark Act, 15 U.S.C. § 1127. Such use must be “open, public and notorious use such that the purchasing public is made aware of the availability of the goods [and services] under said mark and of the use of the mark as an indication of the origin of those goods [or services].” *See, e.g., Mastic Inc. v. Mastic Corp.*, 230 USPQ 699, 701 (TTAB 1986).

For the goods in International Class 9, Respondent testified that he hired a developer who created a video game prototype, but that he never sold any SHOTTAS computer programs for video games.²⁴ There is no evidence that Respondent transported SHOTTAS video games in commerce. Indeed, when asked if he had “any plans in place” for distributing a video game under the SHOTTAS mark, Respondent testified “Not offhand. ... [W]e were working towards it.”²⁵ On this record, we find that Respondent did not make use in commerce of his mark on computer programs for video games.

With respect to “fashion clothing, namely, t-shirts, shorts, hats,” Respondent also testified that he did not make any sales under the SHOTTAS mark.²⁶ Rather,

²⁴ Respondent’s Testimony Deposition, 25 TTABVUE 37, 42, 45-48, 62, and 79-80.

²⁵ *Id.* at 47.

²⁶ *Id.* at 28.

Respondent had “50 to 60” t-shirts, “if not more,” printed with the SHOTTAS mark and the t-shirts, as well as hats and shorts, “were given away for promotion” in Miami, Florida to “friends, anybody that knew the [SHOTTAS] movie,” to “wear it, see what’s the response.”²⁷

Based on the record, we cannot find that Respondent’s distribution of a limited number of SHOTTAS t-shirts, hats and shorts in Miami, Florida had a substantial effect on interstate commerce, or was sufficiently open, public and notorious, as necessary to constitute “use in commerce.” There also is no evidence that distributing product samples is typical in the clothing industry. *See, e.g., Tao Licensing LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1053 (TTAB 2017) (“Depending on the particular facts and industry practice, some types of promotional activities, such as distributing samples, may qualify as use in commerce” but “test marketing typically involves some limited actual sales rather than complimentary samples....”).

As to “motion picture film production, entertainment media production services for motion pictures television and internet,” Respondent testified that since January 1, 2009, he has been involved in three film projects,²⁸ but there is no evidence that he used the SHOTTAS mark in connection with any of these projects. To the extent Respondent points to the *Shottas* movie completed in “2002, 2003” and released in 2005 as supporting his allegation of use for the Class 41 services,²⁹ the evidence

²⁷ *Id.* at 28-29, 32-33 and 36.

²⁸ *Id.* at 49-55.

²⁹ *Id.* at 68.

supports a finding that this project was a collaboration between Petitioner and Respondent, and perhaps other individuals, so any such use of the *Shottas* mark was not by Respondent alone. Even if we were to attribute such use only to Respondent, however, the use does not support that Respondent was using the mark as of his deadline to file a statement of use, which was eight years after distribution of the SHOTTAS motion picture. *See Barbara's Bakery*, 82 USPQ2d at 1289 (finding no use in commerce where claimed use occurred “more than six years prior to the filing date of applicant’s use-based application”).

Based on the foregoing, we find that Petitioner has established a prima facie case of nonuse with respect to the goods and services in the involved registration. Respondent has not rebutted this prima facie showing. Indeed, Respondent testified that “everything” related to the SHOTTAS mark was “on hold” because of the lawsuits between the parties related to the *Shottas* motion picture.³⁰ Accordingly, Petitioner has proven his claim of nonuse with respect to each class of goods and services covered by Registration No. 4463486.

In view of this determination, we need not decide Petitioner’s claim of fraud based on nonuse or Petitioner’s other claims. *Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1540 n.52 (TTAB 2018) (Board has the “discretion to decide only those claims necessary to enter judgment and dispose of the case”).

³⁰ *Id.* at 55-56, 60, 63-64, and 79-80.

III. Conclusion

Petitioner has established that Respondent was not using the mark SHOTTAS in commerce for the goods and services identified in Registration No. 4463486 by his deadline to file a statement of use. Accordingly, the application underlying involved Registration No. 4463486 was void ab initio and the resulting registration is void.

Decision: The petition for cancellation is **granted**. Registration No. 4463486 will be cancelled in due course.