

This Opinion is Not a
Precedent of the TTAB

Mailed: January 28, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Mariana Travassos Miguel Pereira

v.

Dean Thompson and Lime Enterprises Ltd., joined as party defendants¹

—
Cancellation No. 92066525
—

Derek A. Simpson of the Law Offices of Derek A. Simpson, P.C.,
for Mariana Travassos Miguel Pereira.

Pollie A. Gautsch of G&A Legal,
for Dean Thompson.

—

Before Taylor, Greenbaum and Lebow,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Dean Thompson (“Respondent”) owns a registration on the Principal Register for the mark HUNTER FIGHT WEAR, in standard characters, for goods identified as:

¹ In view of the assignment of the involved registration from Dean Thompson to Lime Enterprises Ltd., executed March 21, 2018 and recorded in the Trademark Assignment Records at Reel/Frame: 6297/0812 on March 22, 2018, we join Lime Enterprises Ltd. as a party defendant. See TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) Section 512.01 (2020). See also *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910, 1910 n.1 (TTAB 2000) (assignee joined at final decision).

Athletic apparel all for use in martial arts, namely, shirts, pants, jackets, footwear, hats and caps, athletic uniforms, Beanies, Fight shorts for mixed martial arts or grappling, Hooded sweatshirts Martial arts uniforms, Track suits, all the aforementioned for use in martial arts

in International Class 25.² The words “FIGHT WEAR” are disclaimed.

Mariana Travassos Miguel Pereira (“Petitioner”) seeks to cancel Respondent’s registration on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), alleging prior common law use by her predecessor of an identical mark (HUNTER FIGHT WEAR) for “Brazilian jiu-jitsu gis, fight shorts, and related apparel,” and asserting ownership of application Serial No. 87199284, which has been refused registration in view of Respondent’s registration.³ Petitioner also alleges (1) non-use of the mark in connection with jiu-jitsu apparel or any of the goods listed in the registration in U.S. Commerce or, alternatively, that in the past two years, Respondent has not offered the goods listed in the Registration under the mark in U.S. commerce and does not intend to resume such use; and (2) fraud by “blatant misrepresentations in [Respondent’s underlying]

² Registration No. 4771161 issued on the Principle Register on July 14, 2015, based upon Application Serial No. 86051293, filed on August 29, 2013. The registration claims August 29, 2013 as the date of first use of the mark anywhere and in commerce.

³ Petitioner’s application Serial No. 87199284 was suspended by the Trademark Examining Operation at the time the petition to cancel was filed. However, the application subsequently was returned to pending status on December 1, 2017 after cancellation of the involved registration following entry of default judgment in this proceeding. Respondent successfully moved for relief from the default judgment and involved Registration No. 4771161 was reinstated on August 30, 2018. A review of Office records reveals that during the period that Registration No. 4771161 was cancelled, Petitioner’s application Serial No. 87199284 was approved for publication. That application is now the subject of Opposition No. 91240612 brought by Lime Enterprises Limited, successor in interest to involved Registration No. 4771161.

application with malice and an intent to defraud the USPTO,” and that the fraudulent conduct includes “Registrant’s knowingly false assertion that Registrant was using the registered mark in connection with the goods listed in the application in United States commerce” and that “the specimen submitted by Registrant, to show use of his mark in United States commerce, consisted of ... a paper hang-tag displaying the mark that was not affixed to the jacket ..., by which Respondent intended to deceive the USPTO into perceiving it to be a collar patch and hag tag displayed to buyers”⁴

Applicant, in his answer, agrees that:

Likelihood of confusion exists between Petitioner’s trademark and the mark listed in Registrant’s registration. The marks are identical and the goods are identical. Plus, one item listed in Registrant’s registration, “martial arts uniforms,” would include jiu-jitsu gis. So the trade channels and prospective customers would be identical.

Petition for Cancellation ¶ 16, Answer ¶ 16.⁵ Applicant otherwise has denied the salient allegations in the notice of opposition.⁶

⁴ 1 TTABVUE. Citations in this opinion are to the TTABVUE docket entry number and, where applicable, the electronic page number where the document appears.

⁵ 1 TTABVUE 6, 17 TTABVUE 3. Respondent answers with the wording “Respondents [sic] agree to this allegation.” We consider Respondent’s use of the word “agree” in its answer to be interchangeable with the customarily used word “admit.”

⁶ Applicant also asserts the affirmative defenses of acquiescence and failure to state a claim upon which relief may be granted. However, Respondent did not pursue the acquiescence claim at trial. Nor did Respondent file a timely motion to dismiss pursuant to Fed R. Civ. P. 12(b)(6). We therefore deem these affirmative defenses to have been waived. *Cf. Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1758 (TTAB 2013), *aff’d mem.*, 565 F. App’x 900 (Fed. Cir. 2014) (“Insofar as respondent neither filed a formal motion to dismiss pursuant to Fed R. Civ. P. 12(b)(6) during the interlocutory phase of this proceeding, nor argued this asserted affirmative defense in its brief, it is hereby deemed waived.”). *See also Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422 (TTAB 2014). Respondent also makes allegations, labeled as affirmative defenses, which are

I. The Record

The record in this case consists of the pleadings and, by rule, the file of Respondent's involved registration. Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1). In addition, Petitioner introduced the following evidence.

- Testimony declaration, with exhibits, of Mariana Travassos Miguel Pereira, Petitioner and legatee of the pleaded common law mark HUNTER FIGHT WEAR (Pereira decl.);⁷
- Testimony declaration, with exhibits, of Márcio Carvalho Corleta, licensee of Petitioner's HUNTER FIGHT WEAR mark;⁸ and
- Petitioner's Notice of Reliance on:

the underlying trademark application for Respondent's involved HUNTER FIGHT WEAR mark, including the specimen of use filed in connection with the application (NOR 1);

in the nature of amplifications of his denials, and we construe them as such. *See generally* TBMP § 311.02(d).

⁷ 24 TTABVUE. Exhibits 1, 5, 6 and 8 comprise documents which are either partially or entirely in Portuguese. No English language translation was provided. "Board proceedings are conducted in English. If a party intends to rely upon any submissions that are in a language other than English, the party should also file a translation of the submissions. If a translation is not filed, the submissions may not be considered." TBMP § 104. Accordingly, the Board does not consider evidence submitted in a foreign language without a signed translation. *See Swiss Watch Int'l Inc. v. Federation of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1734 n.8 (TTAB 2012) (printed publications submitted in a foreign language without translations have no probative value); *Johnson & Johnson v. Obschestvo s ogranitchennoy; otvetstvennostiu "WDS"*, 95 USPQ2d 1567, 1570 n.3 (TTAB 2010) (if a party intends to rely at trial on business records in a foreign language, it must provide a translation); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1405 (TTAB 1998) (a proffered excerpt from a newspaper or periodical is lacking in foundation and, thus, is not admissible as evidence to the extent that it is unintelligible because it is in a language other than English). In view thereof, the portions of Exhibit Nos. 1, 5, 6 and 8 that are in Portuguese are inadmissible and have not been considered.

⁸ 25 TTABVUE.

the certificate of registration for the involved registration, Registration No. 4771161 (NOR 2);⁹

assignment documents for involved Registration No. 4771161 (NOR 3); and

the application and portions of the prosecution history of Petitioner's application Serial No. 87199284 (NOR 4-7).¹⁰

Only Petitioner filed a brief.

II. Background

In the late 1990's, in Rio de Janeiro, Brazil, Maurício Miguel Pereira, Petitioner's father and predecessor-in-interest, started using HUNTER FIGHT WEAR as a trademark in connection with jiu-jitsu kimonos and other clothing items. Pereira decl. ¶¶ 1-3.¹¹ At the same time in the late 1990's, Mr. Pereira operated a store named HUNTER FIGHT WEAR from which he sold HUNTER FIGHT WEAR apparel. *Id.* at ¶ 4.¹² Concurrently, Mr. Pereira sponsored Brazilian elite-level, mixed-martial-arts and jiu-jitsu competitors who wore the HUNTER FIGHT WEAR branded apparel at competitions including those in the United States. *Id.* at ¶ 5.¹³ From at least as early as 1999 through 2006, Mr. Pereira and Márcio Corleta, Petitioner's licensee, regularly traveled to the United States to visit jiu-jitsu academies and put on seminars. During

⁹ Petitioner's submission of copy of involved Registration No. 4771161 was unnecessary as it is of record by operation of Trademark Rule 2.122(b)(1).

¹⁰ 26 TTABVUE. Petitioner's submission of the file of the trademark application that matured into Respondent's involved registration is also unnecessary as it, too, is of record by operation of Trademark Rule 2.122(b)(1).

¹¹ 24 TTABVUE 2.

¹² *Id.* at 2-3.

¹³ *Id.* at 3.

these seminars and at events and competitions in the United States, Mr. Pereira sold HUNTER FIGHT WEAR jiu-jitsu kimonos and other clothing bearing the HUNTER FIGHT WEAR trademark. Corleta decl. ¶ 7.¹⁴

In 2006, Mr. Pereira was killed in Rio de Janeiro, leaving Petitioner, at age 16, as his only surviving heir. Pereira decl. ¶¶ 8 and 10.¹⁵ Thereafter, Petitioner, Petitioner's maternal grandfather and mother "operated" the HUNTER FIGHT WEAR brand, closing all existing stores, but opening a new store in Copacabana (a neighborhood in Rio de Janeiro) which remained open at least until 2012. *Id.* at ¶ 11.¹⁶ Petitioner's grandfather and mother, and resellers in Brazil, continued to sell Brazilian jiu-jitsu apparel under the HUNTER FIGHT WEAR brand, including sales to U.S. customers, both by shipping apparel to the United States and to U.S. customers in Brazil. *Id.*¹⁷

¹⁴ 25 TTABVUE 3. Mr. Corleta particularly stated that:

Pereira and I, from at least as early as 1999 through 2006, would regularly travel to the United States in order to visit jiu-jitsu academies and put on seminars. At these seminars in the United States, I saw Pereira sell HUNTER FIGHT WEAR jiu-jitsu kimonos and other items of apparel bearing the HUNTER FIGHT WEAR trademark. And at competitions in the United States during this time, I saw Pereira doing the same thing – selling HUNTER FIGHT WEAR jiu-jitsu kimonos and other items of apparel bearing the HUNTER FIGHT WEAR trademark.

¹⁵ 24 TTABVUE 3.

¹⁶ *Id.* at 3-4.

¹⁷ *Id.* Ms. Pereira further stated in her declaration that:

12. Since the time of my father's death, I have never, even once, considered giving up on the HUNTER FIGHT WEAR BRAND. It has always been my intention to make and sell Brazilian jiu-jitsu apparel, under the HUNTER FIGHT WEAR trademark, as soon as I was old enough to do so.

In 2012, Petitioner acquired the domain name hunterfightwear.com, which she “continue[s] to own [to] display a website promoting HUNTER FIGHT WEAR apparel.” *Id.* at ¶ 16.¹⁸ After the Copacabana store closed, sales of HUNTER FIGHT WEAR apparel continued. *Id.* at ¶ 18.¹⁹

Sometime after 2013, Mr. Corleta licensed the rights to sell jiu-jitsu apparel under the HUNTER FIGHT WEAR mark, and in 2015, Mr. Corleta, established an online store in Brazil for HUNTER FIGHT WEAR apparel. Corleta decl. ¶¶ 9-10.²⁰ Starting then, Mr. Corleta sold HUNTER FIGHT WEAR apparel, under license from Petitioner, at jiu-jitsu competitions in Brazil and in the United States. Corleta decl. ¶¶ 11; Pereira decl. ¶¶ 20-21.²¹ Mr. Corleta also sold apparel under the HUNTER FIGHT WEAR mark at the Master World jiu-jitsu competitions in Las Vegas, Nevada

13. In 2012, I was contacted by a sports program host and UFC commentator Jorje “Joinha” Guimarães. He told me that a Chinese businessman was interested in buying my HUNTER FIGHT WEAR trademark rights I did not accept the offer. The HUNTER FIGHT WEAR store in Copacabana was operating satisfactorily and I was otherwise pleased with the wholesale sales and sales through the website, including international sales (of which sales to the U.S. were a portion).

Id. at 4.

¹⁸ *Id.* at 4-5.

¹⁹ *Id.* at 5. Petitioner also states that her father owned the hunterfightwear.com domain name from 2000 until 2006 through which he promoted HUNTER FIGHT WEAR apparel, and points to Exhibit 7, a copy of the 2000-version of the website, which she asserts “indicates that my father shipped his HUNTER FIGHT WEAR apparel to U.S. customer[s] as early as 2000. *Id.* at 22. While the web page states “We Ship Worldwide!,” that is insufficient to prove that shipments actually were made to the United States.

²⁰ 25 TTABVUE 4.

²¹ 25 TTABVUE 4; 24 TTABVUE 5.

in 2017 and 2018. Corleta decl. ¶¶ 11, Ex. 8; Pereira decl. ¶¶ 20-21, Ex. 9.²² Mr. Corleta, under his license agreement with Petitioner, continues “until now” to make and sell clothing under the HUNTER FIGHT WEAR mark to Brazilian jiu-jitsu schools and at competitions and seminars in the United States. Corleta decl. ¶ 12, Pereira decl. ¶ 22.²³

III. Petitioner’s Entitlement to a Cause of Action²⁴

Entitlement to a statutory cause of action is a threshold issue in every inter partes case. *See Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067 n.4 (2014)). “A party in the position of plaintiff may petition for cancellation of a registered mark where such cancellation is within the zone of interests protected by the statute, 15 U.S.C. § 1064, and the party’s reasonable belief in damage is proximately caused by continued registration of the mark.” *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, BL 503435 (TTAB 2020) (citing *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *6-7 (Fed. Cir. Oct. 27, 2020)).

²² *Id.* at 4, 27-30; *id.* at 5, 7-10. Exhibit 8 to the Corleta declaration is identical to Exhibit 9 to the Pereira declaration.

²³ *Id.* at 4; *id.* at 5-6.

²⁴ Board decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of “standing.” Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Section 13 and 14 remain applicable. *See Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

To establish her statutory entitlement to a statutory cause of action, Petitioner introduced copies of relevant portions of her application file for Serial No. 87199284 showing Respondent's involved Registration No. 4771161 for the mark HUNTER FIGHT WEAR was cited as a bar to the registration of Petitioner's standard character mark HUNTER FIGHT WEAR, the subject of application Serial No. 85972230.

Evidence that the USPTO refused to register Petitioner's application based on Respondent's registration is sufficient to prove that Petitioner is entitled to a statutory cause of action under Section 2(d) of the Trademark Act. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) ("Thus, to have standing in this case, it would be sufficient that [plaintiff] prove that it filed an application and that a rejection was made because of [defendant's] registration."); *Tri-Star Mktg., LLC v. Nino Franco Spumanti S.R.L.*, 84 USPQ2d 1912, 1914 (TTAB 2007) ("petitioner has standing to bring the petition for cancellation based on the fact that its application to register [its mark] was refused registration by the office under Section 2(d) based on a likelihood of confusion with respondent's previously registered mark.").

Having established her entitlement to a cause of action with respect to the likelihood of confusion claim, Petitioner may assert any other legally sufficient ground as well, including her non-use or alternative abandonment and fraud claims. *See Poly-America, L.P. v. Ill. Tool Works Inc.*, 124 USPQ2d 1508, 1512 (TTAB 2017) (if petitioner can show standing on the ground of functionality, it can assert any other grounds, including abandonment); *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477,

1479 (TTAB 2017) (standing established based on surname claim sufficient to establish standing for any other ground); *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1481 (TTAB 2017) (opposer established its standing as to genericness ground of certification mark and was entitled to assert any other ground).

IV. Priority and Likelihood of Confusion

Respondent admits there is no issue as to the likelihood of confusion between the parties' respective HUNTER FIGHT WEAR marks. Pet. for Can. ¶16, Answer ¶ 16.²⁵ Obviously, the respective marks are identical and the goods in-part identical.²⁶ "With regard to the Section 2(d) claim, when the parties are claiming rights in the same mark for the same goods or services, likelihood of confusion is inevitable." *Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1301-02 (TTAB 2015). Therefore, the sole issue remaining with regard to this claim is priority.

To establish priority on her likelihood of confusion claim under Section 2(d) of the Trademark Act, Petitioner must prove by a preponderance of the evidence that, vis-à-vis Respondent, she owns "a mark or trade name previously used in the United

²⁵ 1 TTABVUE 6, 17 TTABVUE 3.

²⁶ In addition to the admittedly legally-identical martial arts uniforms, Respondent's registration recites other Class 25 goods. We need not, however, find similarity as to each additional listed product. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any item encompassed by the identification of goods in a particular class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 866 F.3d 1315, 116 USPQ2d 1406, 1409 (TTAB 2015); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014).

States . . . and not abandoned . . .” *Threshold.TV, Inc. v. Metronome Enterprises, Inc.*, 96 USPQ2d 1031, 1036-37 (TTAB 2010) (citing *Otto Roth & Co. v. Universal Foods Corp.*, 640 F. 2d 1317, 209 USPQ 40, 44 (CCPA 1981)). If Petitioner cannot prove that she used the mark as a trademark before either the filing date of Respondent’s underlying application or Respondent’s proven date of first use (whichever is earlier), Petitioner cannot establish priority. *Cf. Herbko International, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981).

In the absence of evidence establishing earlier use of its mark, a party may rely for priority purposes on the filing date of the application that matured into its registration. Section 7(c) of the Trademark Act, 15 U.S.C. § 1057(c); *see also Brewski Beer Co. v. Brewski Bros. Inc.*, 47 USPQ2d 1281, 1283-84 (TTAB 1998); *Am. Standard Inc. v. AQM Corp.*, 208 USPQ 840, 842 (TTAB 1980). Because Respondent did not introduce any testimony or other evidence, the earliest date on which it may rely to prove priority is June 27, 2013, the filing date for the application underlying the registration at issue, which notably is the first use date claimed in the underlying application.

Petitioner did not plead ownership of any registered trademark and therefore must rely on her common law use of HUNTER FIGHT CLUB as a trademark to prove priority. In order for a plaintiff to prevail on a claim of likelihood of confusion based on its ownership of common law rights in a mark, the mark must be distinctive,

inherently or otherwise, and plaintiff must show priority of use. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). Respondent has not challenged the distinctiveness of the pleaded mark and the marks at issue are identical. Therefore, we find the HUNTER FIGHT CLUB to be inherently distinctive for the goods at issue here.

As to priority, the testimony of Petitioner and Mr. Corleta demonstrate that Petitioner's predecessor-in-interest began using the HUNTER FIGHT CLUB mark in connection with the sale of jiu-jitsu kimonos in the United States in 1999²⁷ and continued such sales until his death in 2006; that Petitioner continued sales of HUNTER FIGHT CLUB branded apparel by shipments to the United States to U.S. consumers; and that Petitioner's licensee, Mr. Corleta, continues "until now" to sale HUNTER FIGHT CLUB clothing, including jiu-jitsu kimonos at competitions in the United States.

Although the record is devoid of evidence corroborating sales activities, we find the declaration testimony sufficient to prove Petitioner's priority because it is clear, convincing, and uncontradicted. *See Nat'l Bank Book Co. v. Leather Crafted Prods., Inc.*, 218 USPQ 826, 828 (TTAB 1993) (oral testimony may be sufficient to prove the first use of a party's mark when it is based on personal knowledge, it is clear and convincing, and it has not be contradicted); *Liquacon Corp. v. Browning-Ferris Indus.*

²⁷ Because neither Ms. Pereira nor Mr. Corleta provided a specific date in 1999, we interpret Mr. Pereira to have begun selling jiu-jitsu kimonos in the United States on December 31, 1999. *Cf.* TRADEMARK MANUAL OF EXAMINING PROCEDURE Section 903.06 (Oct. 2018) ("When a month and year are given without a specified day, the date presumed for purposes of examination is the last day of the month. When only a year is given, the date presumed for purposes of examination is the last day of the year.").

Inc., 203 USPQ 305, 316 (TTAB 1979) (oral testimony may be sufficient to establish both prior use and continuous use when the testimony is proffered by a witness with knowledge of the facts and the testimony is clear, convincing, consistent, and sufficiently circumstantial to convince the Board of its probative value); *GAF Corp. v. Anatox Analytical Servs., Inc.*, 192 USPQ 576, 577 (TTAB 1976) (oral testimony may establish prior use when the testimony is clear, consistent, convincing, and uncontradicted).

In view of the foregoing, we find that Petitioner has established by a preponderance of the evidence that she has prior use and has not abandoned trademark rights in the wording HUNTER FIGHT CLUB for jiu-jitsu kimonos.

V. Conclusion

In conclusion, we find that Respondent's mark HUNTER FIGHT WEAR, as used on martial arts uniforms, is likely to be confused with Petitioner's previously-used mark HUNTER FIGHT WEAR for jiu-jitsu kimonos.

Decision: The petition for cancellation on the ground of priority and likelihood of confusion is granted and Registration No. 4771161 will be cancelled in due course.²⁸

²⁸ In view of our decision to grant the cancellation on the ground of likelihood of confusion, we need not reach the non-use, alternative abandonment, and fraud claims. *See Venture Out Props. LLC v. Wynn Resorts Holdings LLC*, 81 USPQ2d 1887, 1894 (TTAB 2007) ("In view of our decision finding a likelihood of confusion, we need not reach the issue of dilution."); *Interlego AG v. Abrams/Gentile Entm't Inc.*, 63 USPQ2d 1862, 1864 (TTAB 2002) ("Having found that there exists a likelihood of confusion, we elect to sustain the opposition on this basis alone.").