

This Opinion Is Not a
Precedent of the TTAB

Mailed: May 12, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Dr. Martens International Trading GmbH

v.

Dejon Marquis Muldrow
—

Cancellation No. 92067439
—

Anne Hiaring Hocking, Andrew S. MacKay, and Padmini Cheruvu of Donahue Fitzgerald LLP for Dr. Martens International Trading GmbH.

Kevin J. Keener of Keener & Associates, P.C. for Dejon Marquis Muldrow.
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Before Zervas, Bergsman and Pologeorgis, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Dejon Marquis Muldrow (Respondent) is the owner of Registration No. 5195183 on the Principal Register for the mark DM (stylized), reproduced below, for the following goods:

Clothing, namely, khakis; Dress pants; Dress shirts; Dressing gowns; Shoe accessories, namely, fitted decorative covers for shoes; Shoes; Suit coats; Suits; Suits of leather; T-shirts; Athletic shoes; Baseball shoes; Beach shoes; Belts; Belts for clothing; Bottoms; Drawers; Dress suits; Eyeshades; Football shoes; Gloves as clothing; Golf shoes; Graphic T-shirts; Head wraps; Hoodies; Hoods; Jackets; Jerseys; Jogging suits; Knit dresses; Leather

shoes; Leather belts; Men's dress socks; Men's suits; Men's suits, women's suits; Pocket squares; Pockets for clothing; Rubber shoes; Running shoes; Running suits; Short sets; Short-sleeved or long-sleeved t-shirts; Sports shoes; Swim suits; Tennis shoes; Ties; Tops; Track suits; Training suits; Wristbands, in International Class 25.¹



According to the description of the mark set forth in the registration, “[t]he mark consists of the stylized letters ‘D’ and ‘M’ connected together.”

Dr. Martens International Trading GmbH (Petitioner) has filed a Petition to Cancel Respondent’s registration on the grounds of likelihood of confusion, Respondent’s underlying application is void ab initio because Respondent had not used the mark when he filed his use-based application, fraud, and for partial cancellation to restrict the registration under Section 18 of the Trademark Act, 15 U.S.C. § 1068, because Respondent is not using his mark to identify shoes.

Respondent, in his Answer, denied the salient allegations in the Petition for Cancellation. As an affirmative defense, Respondent pleaded laches. Because

¹ Registered May 2, 2017. On September 18, 2016, Respondent filed the underlying application under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), based on Respondent’s claim of first use of his mark anywhere as of May 17, 2010, and first use of his mark in commerce as of March 3, 2013.

Respondent did not pursue the affirmative defense, either by motion or in his brief, Respondent has waived it. *Harry Winston, Inc. and Harry Winston S.A. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422 (TTAB 2014); *Research in Motion Ltd. v. Defining Presence Mktg. Grp. Inc.*, 102 USPQ2d 1187, 1189-90 (TTAB 2012); *Swiss Watch Int'l Inc. v. Fed'n of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1734 n.4 (TTAB 2012).²

I. The Record

Both parties filed numerous objections.³ Because a cancellation proceeding is akin to a bench trial, the Board is capable of assessing the proper evidentiary weight to be accorded the testimony and evidence, taking into account the imperfections surrounding the admissibility of such testimony and evidence. As necessary and appropriate, we will point out any limitations in the evidence or otherwise note that we cannot rely on the evidence in the manner sought. We have considered all of the testimony and evidence introduced into the record. In doing so, we have kept in mind the various objections the parties have raised and we have accorded whatever probative value the subject testimony and evidence merit. *See Luxco, Inc. v. Consejo*

² Respondent also pleaded as purported affirmative defenses that Petitioner failed to state a claim upon which relief can be granted, Petitioner lacks standing, and that there is no likelihood of confusion. Insofar as Respondent neither filed a formal motion to dismiss for failure to state a claim during the interlocutory phase of this proceeding, nor argued this asserted affirmative defense in its brief, we hold Respondent waived its laches affirmative defense. *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 n.6 (TTAB 2013), *aff'd mem.*, 565 F. App'x 900 (Fed. Cir. 2014). The remaining defenses are not true affirmative defenses but mere amplifications of Respondent's denials to the allegations in the petition to cancel.

³ Petitioner's Separate Statement of Objections (32 TTABVUE 21-27); Respondent's Separate Statement of Objections (33 TTABVUE 18-19).

Regulador del Tequila, A.C., 121 USPQ2d 1477, 1479 (TTAB 1017), *appeal dismissed per stipulation*, No. 17-00345 (E.D. Va. August 24, 2017); *U.S. Playing Card Co. v. Harbro, LLC*, 81 USPQ2d 1537, 1540 (TTAB 2006). *See also Poly-America, L.P. v. Ill. Tool Works Inc.*, 124 USPQ2d 1508, 1510 (TTAB 2017) (where the objections refer to probative value rather than admissibility and the evidence that is subject to the objections is not outcome determinative, “we choose not to make specific rulings on each and every objection”).

The record includes the pleadings, and pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Respondent’s registration file. The parties introduced the testimony and evidence listed below:

A. Petitioner’s testimony and evidence.

1. Notice of reliance on Respondent’s responses to Petitioner’s requests for admission (Exhibit 1);⁴
2. Notice of reliance on Respondent’s responses to Petitioner’s interrogatories (Exhibit 2);⁵
3. Notice of reliance on Respondent’s responses to Petitioner’s requests for production of documents (Exhibit 3);⁶

⁴ 12 TTABVUE 9-24.

⁵ 12 TTABVUE 26-124.

⁶ 12 TTABVUE 126-215. Respondent answered all the requests stating, “After a reasonable search, all responsive, non-privileged documents in Registrant’s possession will be produced.” Responses to a request for production of documents introduced through a notice of reliance are admissible solely for purposes of showing that a party has stated that there are no responsive documents; documents produced in response to the requests are generally not admissible by notice of reliance alone. Trademark Rule 2.120(j)(3)(ii), 37 C.F.R. § 2.120(j)(3)(ii); *see also City Nat’l Bank v. OPGI Mgmt. GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1668, 1674 n.10 (TTAB 2013) (responses to document production requests are admissible solely for purposes of showing that a party has stated that there are no responsive documents); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 n.7 (TTAB 2012) (written responses to document requests indicating that no documents exist may be submitted by notice of reliance); *Calypso Tech. Inc. v. Calypso Capital Mgmt. LP*, 100 USPQ2d 1213, 1217

4. Notice of reliance on screenshots of Respondent's website (Exhibit 4);⁷
5. Notice of reliance on screenshots of Respondent's Facebook account (Exhibit 5);⁸
6. Notice of reliance on screenshots of Respondent's Instagram account (Exhibit 6);⁹
7. Notice of reliance on screenshots of Respondent's website from the Wayback Machine (Exhibit 7);¹⁰
8. Notice of reliance on screenshots of Respondent's Facebook and Instagram accounts that Respondent produced during discovery (Exhibit 8);¹¹
9. Notice of reliance on a screenshot of Whois.com website for the domain name Dejonmarquis.com (Exhibit 9);¹²
10. Notice of reliance on a screenshot of Change.org (Exhibit 10);¹³
11. Notice of reliance on copies of Wikipedia entries purportedly regarding high fashion (Exhibit 11);¹⁴
12. Notice of reliance on copies of trademark applications and registrations that Respondent produced during discovery (Exhibit 12);¹⁵

n.8 (TTAB 2011); *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1020-21 n.2 (TTAB 2011); *Spirits Int'l B.V. v. S.S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birliđi*, 99 USPQ2d 1545, 1547-48 n.5 (TTAB 2011); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883 n.5 (TTAB 2008).

⁷ 12 TTABVUE 217-219. *See also* Petitioner's supplemental notice of reliance at 22 TTABVUE 5-6.

⁸ 12 TTABVUE 221-222. *See also* Petitioner's supplemental notice of reliance at 22 TTABVUE 8-10.

⁹ 12 TTABVUE 224. *See also* Petitioner's supplemental notice of reliance at 22 TTABVUE 12.

¹⁰ 12 TTABVUE 226-306.

¹¹ 12 TTABVUE 308-493.

¹² 12 TTABVUE 495-497.

¹³ 12 TTABVUE 499-536.

¹⁴ 13 TTABVUE 3-290 and 14 TTABVUE 3-53.

¹⁵ 14 TTABVUE 55-144.

13. Notice of reliance on the Wikipedia entry regarding Petitioner (Exhibit 13);¹⁶
 14. Notice of reliance on a copy of Petitioner's website accessed November 11, 2018 produced by Respondent (Exhibit 14);¹⁷
 15. Notice of reliance on a copies of articles regarding Petitioner (Exhibit 15);¹⁸
 16. Notice of reliance on excerpts from Petitioner's Instagram and Facebook accounts accessed January 22, 2019 (Exhibit 16);¹⁹ and
 17. Declaration of Padmini Cheruvu, one of Petitioner's attorneys, purportedly to introduce emails regarding discovery.²⁰
- B. Respondent's testimony and evidence.
1. Testimony declarations of third-party consumers;²¹
 2. Notice of reliance on screenshots from Respondent's website (Exhibits 1-2 and 9-10);²²
 3. Notice of reliance on screenshots from Respondent's Instagram account (Exhibits 3-4);²³

¹⁶ 14 TTABVUE 146-150.

¹⁷ 14 TTABVUE 152-156. The excerpts from Petitioner's website are admissible under Trademark Rule 2.122(e)(2), 37 C.F.R. § 2.122(e)(2) ("Internet materials may be admitted into evidence under a notice of reliance in accordance with paragraph (g) of this section, in the same manner as a printed publication in general circulation, so long as the date the internet materials were accessed and their source (e.g., URL) are provided."). They are not admissible via a notice of reliance as documents produced by Respondent in response to Petitioner's request for production of documents. *See* Trademark Rule 2.120(k)(3)(ii), 27 C.F.R. § 2.120(k)(3)(ii) ("A party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e).").

¹⁸ 14 TTABVUE 158-179.

¹⁹ 14 TTABVUE 181-197.

²⁰ 15 TTABVUE.

²¹ 23, 24 and 26 TTABVUE .

²² 25 TTABVUE 17-21 and 162-181.

²³ 25 TTABVUE 23-53.

4. Notice of reliance on screenshots from Respondent's Facebook account (Exhibit 5);²⁴
5. Notice of reliance on screenshots from ICANDRESS2.com (Exhibit 6);²⁵
6. Notice of reliance on a screenshot from the ICANDRESS2 Instagram account (Exhibit 7);²⁶
7. Notice of reliance on a screenshot from Respondent's Twitter account (Exhibit 8);²⁷
8. Notice of reliance on third-party registrations purportedly consisting of the letters DM (Exhibits 11-29);²⁸
9. Notice of reliance on Wikipedia entries (Exhibits 30 and 32-81);²⁹
10. Notice of reliance on an excerpt from Strunk and White, *The Elements of Style* (Exhibit 31);³⁰ and
11. Testimony declaration of Kevin Keener, Applicant's attorney, introducing Applicant's purported invoices.³¹

II. Standing

Standing is a threshold issue which plaintiffs must prove in every inter partes case. To establish standing in an opposition or cancellation proceeding, a plaintiff must show "both a 'real interest' in the proceedings as well as a 'reasonable basis' for its belief of damage." *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270,

²⁴ 25 TTABVUE 55-102.

²⁵ 25 TTABVUE 104-116.

²⁶ 25 TTABVIE 118-135.

²⁷ 25 TTABVUE 137-160.

²⁸ 25 TTABVUE 183-285.

²⁹ 25 TTABVUE 287-299 and 307-673.

³⁰ 25 TTABVUE 301-305.

³¹ 27 TTABVUE (Confidential).

111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (quoting *ShutEmDown Sports, Inc., v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012)); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). The Court of Appeals for the Federal Circuit has enunciated a liberal threshold for determining standing in Board proceedings. *Ritchie*, 50 USPQ2d at 1030.

Petitioner contends that it has standing but it did not cite any testimony or evidence to support that contention.³²

As the owner of The DM'S Mark, Petitioner unquestionably has a 'real interest' in challenging the registration of Registrant's DM Mark. Accordingly, there is no dispute that Petitioner has standing.³³

Petitioner attached to the Petition for Cancellation a photocopy of certificate of registration for Registration No. 2364671 for the mark DM'S, in standard character form, for "footwear," in International Class 29. Respondent, in his Answer, denied that the registration is "subsisting and not abandoned."³⁴ Attaching a photocopy of a certificate of registration to a petition of cancellation does not make it of record. *See* Trademark Rule 2.122(d), 37 C.F.R. § 2.122(d); Trademark Rule 2.122(c), 37 C.F.R. § 2.122(c) ("Except as provided in paragraph (d)(1) of this section, an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached, and must be identified and introduced in evidence as an exhibit during the

³² Petitioner's Brief, pp. 5-6 (32 TTABVE 10-11).

³³ *Id.* at p. 6 (32 TTABVUE 11).

³⁴ Answer ¶2 (7 TTABVUE 3).

period for the taking of testimony.”). *See also Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) (opposer’s pleaded registration not of record where opposer’s copies of registrations submitted with notice of opposition did not show current status or title); *Sterling Jewelers Inc. v. Romance & Co.*, 110 USPQ2d 1598, 1601 (TTAB 2014) (opposer failed to comply with “simple and clear’ directives of Trademark Rule 2.122(d)” by submitting plain copy of registration attached to notice of opposition – registration not of record); *Indus. Adhesive Co. v. Borden, Inc.*, 218 USPQ 945, 947 (TTAB 1983) (photocopy of registration did not contain status and title information). Thus, Petitioner failed to introduce a copy of its pleaded registration to make it of record.

Petitioner pleaded that it “has continuously used in interstate commerce the DM’S Mark since at least as early as 1992,” but failed to introduce any testimony to make that fact of record.³⁵ Respondent averred that he “is without knowledge of the allegations in paragraph 3 of the Notice of Opposition [sic] and therefore denies the same.”³⁶

Petitioner introduced the Wikipedia entry regarding Petitioner, an excerpt from Petitioner’s website, copies of news articles regarding Petitioner, and excerpts from Petitioner’s Facebook and Instagram accounts. However, Internet evidence is admissible only to show what has been printed, not for the truth of what has been printed. *Safer Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1040 (TTAB 2010).

³⁵ Petition for Cancellation ¶3 (1 TTABVUE 4).

³⁶ Answer ¶3 (7 TTABVUE 3).

See also *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1038 (TTAB 2018) (although Internet evidence is admissible, it is “hearsay and may not be relied upon for the truth of the matters asserted therein.”); *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1467 n.30 (TTAB 2014); *Calypso Tech., Inc. v. Calypso Capital Mgmt., LP*, 100 USPQ2d 1213, 1219 (TTAB 2011) (“In particular, with respect to articles and other material published on websites or in publications, we have considered them only for the fact that they have been published and may have been viewed, but not for the truth of the statements made in them.”). *Compare* *Swiss Watch Int’l Inc. v. Fed’n of the Swiss Watch Indus.*, 101 USPQ2d 1731, 1735 11 (TTAB 2012) (Internet printouts submitted as exhibits to testimony are not hearsay).

In addition, the Notice of Reliance states, “Exhibit 14 consists of screenshots taken from Petitioner’s website and produced by Registrant on or around November 11, 2018 with the bates numbers Dejon_000835- Dejon_000839.” The statement in the Notice of Reliance does not aid Petitioner because (i) Petitioner offered this evidence to establish (1) the proximity of Petitioner’s and Registrant’s goods; and (2) overlap of consumers and trade channels, not standing, and (ii) it is a statement signed by Petitioner’s attorney and not by a sworn witness. Attorney statements are not evidence.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018), *quoting* *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1284 (Fed. Cir. 2005).

We find that Petitioner failed to introduce any testimony or evidence sufficient to prove that it has standing.

Decision: The Petition for Cancellation is denied.