

ESTTA Tracking number: **ESTTA883029**

Filing date: **03/13/2018**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92067609
Party	Defendant Theatrical Stage Employees Union Local No. 2 of the International Alliance of Theatrical Stage Employees and Moving Picture Technicians, Artist and Allied Crafts of the United States and Canada
Correspondence Address	THEATRICAL STAGE EMPLOYEES UNION LOCAL #2 EL AL 216 SOUTH JEFFERSON ST STE 400 CHICAGO, IL 60661 UNITED STATES
Submission	Answer
Filer's Name	Robert S. Rigg
Filer's email	rrigg@vedderprice.com, jburke@vedderprice.com, skowalski@vedderprice.com, ipdocket@vedderprice.com
Signature	/Robert S. Rigg/
Date	03/13/2018
Attachments	Chicago Stagehands - Answer to Petition for Cancellation.pdf(38883 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

David B. Eaves and Chicago Stagehand, LLC,

Petitioners,

v.

Theatrical Stage Employees Union Local No. 2
of the International Alliance of Theatrical
Stage Employees and Moving Picture
Technicians, Artists and Allied Crafts of the
United States and Canada,

Respondent.

Cancellation No.: 92067609

Mark: CHICAGO STAGEHANDS

Registration No.: 4,303,933

REGISTRANT'S ANSWER TO PETITION FOR CANCELLATION

NOW COMES Respondent, Theatrical Stage Employees Union Local No. 2 of the International Alliance of Theatrical Stage Employees and Moving Picture Technicians, Artists and Allied Crafts of the United States and Canada (“Respondent”), the owner of and registrant named in U.S. Registration No. 4,303,933 for the mark CHICAGO STAGEHANDS (“Respondent’s Mark”) and, in accordance with Rules 2.106 and 2.116 of the Trademark Rules of Practice and by and through its undersigned counsel, files this answer to the Petition for Cancellation (the “Petition”) filed by Petitioners David B. Eaves and Chicago Stagehand, LLC (collectively, “Petitioners”) on December 21, 2017 (Dkt. No. 1), and in support thereof respectfully states as follows:¹

ALLEGATION NO. 1:

Chicago Stagehand, LLC is a sole member limited liability company, doing business as CHICAGO STAGEHAND. Chicago Stagehand, LLC provides freelance stage crew to live event venues and live events in the Chicagoland area including interstate commerce.

¹ Capitalized terms used but not defined herein shall have the meanings ascribed thereto in the Petition.

RESPONSE:

Respondent lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 1 of the Petition and therefore denies same.

ALLEGATION NO. 2:

Chicago Stagehand, LLC has been in business since late 2008 and has invested substantial effort and money into developing the CHICAGO STAGEHAND brand. It continues to do business and develop the CHICAGO STAGEHAND brand and will be damaged by the existence of U.S. Registration No. 4,303,933. David B. Eaves is the owner of the Mark CHICAGO STAGEHAND, the owner of Chicago Stagehand, LLC and the applicant for the mark CHICAGO STAGEHAND for “employment staffing in the field of labor and technical support in live corporate, concert and special events,” (U.S. Ser. No. 86/399, 091) and will be damaged by the existence of U.S. Registration No. 4,303,933.

RESPONSE:

Respondent lacks sufficient knowledge and information to form a belief as to the truth of the allegations of Paragraph 2 of the Petition and therefore denies same.

ALLEGATION NO. 3:

Theatrical Stage Employees Union Local No. 2 of the International Alliance of Theatrical Stage Employees and Moving Picture Technicians, Artists and Allied Crafts of the United States and Canada, an unincorporated association existing under the laws of the State of Illinois, having its principal place of business at 216 S. Jefferson St., Suite 400, Chicago, IL 60661 (“Respondent”), is the owner of U.S. Registration No. 4,303,933 (“Registration”), issued on March 19, 2013, in the Principal Register for “Clothing, namely, shirts,” from the application U.S. Serial No. 85/530,942 (“Application”).

RESPONSE:

Admitted.

ALLEGATION NO. 4:

Respondent operates a union of stage crew in the Chicagoland area that provides services, including: organizing, providing support for strikes, negotiating/renegotiating collective bargaining agreements, training, referrals to work and benefits for its members.

RESPONSE:

Admitted.

ALLEGATION NO. 5:

On February 1, 2012, Respondent submitted the Application to the USPTO seeking registration of the mark CHICAGO STAGEHANDS for shirts and in connection therewith supplied as a specimen a shirt with a logo on the left breast pocket area claiming use in commerce since January 2008. (“Specimen”)

RESPONSE:

Admitted.

ALLEGATION NO. 6:

On information and belief and based on the evidence submitted by Respondent in Cancellation No. 92055242, Respondent has never been in the clothing or apparel business.

RESPONSE:

Denied.

ALLEGATION NO. 7:

On information and belief and based on the evidence submitted by Respondent in Cancellation No. 92055242, Respondent and a few of Respondent’s individual members have occasionally obtained very limited numbers of baseball caps or shirts with various logos that include the words “Chicago Stagehands” or other words relating to Respondent for use or purchase by members at strikes or golf outings.

RESPONSE:

Respondent admits that Respondent and its members have obtained or had made various clothing items, including but not limited to baseball caps and shirts, bearing Respondent’s Mark. Respondent admits that it has sold clothing items bearing Respondent’s Mark at events including but not limited to strikes and golf outings. Otherwise, denied.

ALLEGATION NO. 8:

The appearance of any logo or words on those items is strictly decorative and not for the purpose of promoting a brand of clothing or apparel.

RESPONSE:

Denied.

ALLEGATION NO. 9:

The identical shirt was supplied by Respondent as a specimen in its application for the mark CHICAGO STAGEHANDS for union services (Serial No. 85/530,945). As is apparent in that specimen, the brand name of the manufacturer of the shirt appears in the neck label. The design on the left breast pocket area is decorative.

RESPONSE:

Respondent admits that a photograph of a shirt bearing Respondent's Mark was submitted in connection with Respondent's U.S. Trademark Application Serial No. 85/530,945 and that this shirt bears a tag in the neck area with information indicative of the shirt's manufacturer. Respondent denies that the use of Respondent's Mark on the pictured shirt is decorative. Otherwise, denied.

ALLEGATION NO. 10:

Respondent claims 2007 as first use and January 2008 as first use in commerce but cannot provide any facts to support the claims in the Application. On information and belief and based on the evidence submitted by Respondent in Cancellation No. 92055242, Respondent did not sell, order, or produce shirts during the claimed dates. Respondent's claimed dates of use on the Application for the Registration have no basis in fact.

RESPONSE:

Respondent admits that Respondent identified 2007 as the date of first use and January 2008 as the date of first use in commerce of Respondent's Mark in connection with U.S. Registration No. 4,303,933. Otherwise, denied.

ALLEGATION NO. 11:

On information and belief and based on the evidence submitted by Respondent in Cancellation No. 92055242, in the specific years 2007 and 2008, neither Respondent nor any of its individual members were selling or offering for sale any item of apparel with the words "chicago stagehands" on that apparel either in Illinois or in interstate commerce (either as a decorative element or as a trademark).

RESPONSE:

Denied.

ALLEGATION NO. 12:

Assuming for the sake of argument that the words “Chicago Stagehands” on the shirt has any trademark significance for a line of shirts, the Specimen shirt was not ordered by Respondent until July 2009, more than one and a half years after the claimed first use in commerce date.

RESPONSE:

Respondent admits that the specific shirt shown in the specimen submitted in connection with the application that resulted in U.S. Registration No. 4,303,933 was not ordered by Respondent until July 2009. Otherwise, denied.

ALLEGATION NO. 13:

Thus, Respondent did not provide a proper specimen for the Registration. Respondent submitted the Specimen to obtain the Registration as a mark for shirts, but was not using the mark on shirts in 2007 and 2008.

RESPONSE:

Denied.

ALLEGATION NO. 14:

Respondent has been involved in a Cancellation Proceeding, Cancellation Proceeding No. 92055242, involving the CHICAGO STAGEHANDS mark against David B. Eaves. Respondent, then petitioner, cited this Registration and other applications as evidence of proprietary rights in the mark. The Trademark Trial and Appeal Board held that that Respondent, then petitioner, did not acquire distinctiveness and did not have any rights in the Mark. Since then, Respondent has not used the mark in commerce on hats, shirts, or any other manner.

RESPONSE:

Respondent admits that Respondent cited U.S. Registration No. 4,303,933 in Cancellation Proceeding No. 92/055,242 and that Respondent was the petitioner in that proceeding. Otherwise, denied.

ALLEGATION NO. 15:

For the reasons stated above, Respondent’s Specimen and claims do not support use of the claimed mark as a trademark for shirts because: a) the use of the words on the Specimen are decorative use not trademark use for apparel, b) Respondent has committed Fraud on the United

States Patent and Trademark office during the filing of the Application for the Registration, and c) the Mark has not acquired distinctiveness.

RESPONSE:

Denied.

In response to the ad damnum clause following Paragraph 15 of the Petition, Respondent denies that Petitioner is entitled to any of the relief requested, and asks that the Board deny Petitioner's request for cancellation of U.S. Registration No. 4,303,933. Respondent further denies each and every allegation set forth in the Petition not specifically admitted hereinabove.

FIRST AFFIRMATIVE DEFENSE

No Standing

1. Petitioner states that it believes it will be damaged by the Registration on the basis that

Chicago Stagehand, LLC has been in business since late 2008 and has invested substantial effort and money into developing the CHICAGO STAGEHAND brand. It continues to do business and develop the CHICAGO STAGEHAND brand and will be damaged by the existence of U.S. Registration No. 4,303,933. David B. Eaves is the owner of the Mark CHICAGO STAGEHAND, the owner of Chicago Stagehand, LLC and the applicant for the mark CHICAGO STAGEHAND for "employment staffing in the field of labor and technical support in live corporate, concert and special events," (U.S Ser. No. 86/399, 091) and will be damaged by the existence of U.S. Registration No. 4,303,933.

(Pet., Dkt. No. 1 (Allegation No. 2).)

2. Petitioner's U.S Application Serial No. 86/399,091 ("Petitioner's Application") was filed on September 18, 2014 and was suspended based on a likelihood of confusion with Respondent's pending U.S. Application Serial Nos. 85/530,945 and 86/238,513. The Registration was not cited against Petitioner's Application, and Petitioner tacitly admits that the USPTO has not actually rejected Petitioner's Application based on the Registration.

3. Petitioner has not pled that Petitioner's Application was refused pending the

outcome of this cancellation.²

4. Petitioner has not pled a legitimate commercial interest in the outcome of this proceeding. Petitioner has not pled that it is engaged in the manufacture or sale of goods related to those identified in the Registration.

5. Petitioner has not pled that it has a bona fide intent to use Respondent's Mark in connection with the goods identified in the Registration.³

Respectfully submitted,

Theatrical Stage Employees Union Local No. 2
of the International Alliance of Theatrical
Stage Employees and Moving Picture
Technicians, Artists and Allied Crafts of the
United States and Canada

By: /Robert S. Rigg/
One of Its Attorneys

Robert S. Rigg
John K. Burke
Vedder Price P.C.
222 North LaSalle Street
Chicago, Illinois 60601
T: +1 312 609 7500

Dated: March 13, 2018

² *Giersch v. Scripps Networks*, 90 U.S.P.Q.2d 1020, 1022 (T.T.A.B. 2009) (pending application must be properly introduced, and the fact that it was refused pending outcome of proceeding must be documented, before the Board will rely upon application in determining plaintiff's standing).

³ *Am. Vitamin Prods. Inc. v. Dow Brands Inc.*, 22 U.S.P.Q.2d 1313, 1314 (T.T.A.B. 1992).

CERTIFICATE OF SERVICE

The undersigned hereby certifies that, on March 13, 2018, the foregoing document(s) were caused to be served on the person(s) listed below via electronic mail.

Catherine Simmons-Gill
Offices of Catherine Simmonsgill LLC
111 West Washington St., Ste. 1110
Chicago, IL 60602
United States
simmonsgill@gmail.com, fraczekp@gmail.com

/Robert S. Rigg/

Robert S. Rigg