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

Proceeding	92067794
Party	Plaintiff Joshua S. Schoonover
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Reg. Nos. 2,207,535 and 3,598,502
Mark: FORUM

Joshua S. Schoonover,)	
)	
Petitioner,)	Cancellation No.: 92067794 (parent)
)	
vs)	
)	Cancellation No. 92069499
The Burton Corporation,)	
)	
Registrant,)	

PETITIONER’S OPENING TRIAL BRIEF

Petitioner, Joshua S. Schoonover (“Petitioner”), files its Opening Trial Brief in support of its Petition to Cancel Registration Nos. 2,207,535 and 3,598,502 (collectively, the “Subject Registrations”), owned by Registrant, The Burton Corporation (“Registrant”).

Dated: May 13, 2021

Respectfully submitted,

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DESCRIPTION OF THE RECORD

The evidence of record filed by Petitioner is as follows:

23 TTABVUE

Petitioner's Notice of Reliance on Official Records (filed on September 30, 2020):

1. Exhibit A: Status Report showing Petitioner's Application Ser. No. 87629391 to register its FORUM mark.
2. Exhibit B: Office Action in connection with Petitioner's Application Ser. No. 87629391 refusing registration based on Section 2(d) Likelihood of Confusion in view of the Subject Registrations.

24 TTABVUE

Petitioner's Notice of Reliance on Printed Publications (filed on September 30, 2020):

1. Exhibit A: Screenshot of web page obtained at: <https://www.snowboarder.com/transworld-snowboarding-archive/snowboarding-news/burton-realigns-its-family-of-brands-for-long-term-success/> showing publication of the Burton Press Release and that Registrant intended to "exit out of the Program Brands (incl. FORUM) in winter 2014".
2. Exhibit B: Screenshot of web page obtained at: https://www.espn.com/action/snowboarding/story/_/id/8545120/burton-announces-brand-restructuring-forum-close-analog-surf-skate showing publication of the Burton Press Release and that Registrant intended to "exit out of the Program Brands (incl. FORUM) in winter 2014".
Additionally, this evidence supports an interview with TransWorld Business in 2012, where Registrant said "We'll probably... put them to bed. I don't see us selling them. I think we will retain the trademarks should anything ever develop in the future."
3. Exhibit C: Copy of the Burton Press Release provided by Registrant in discovery and marked BUR_00001 through BUR_00005.

25 TTABVUE

Petitioner's Notice of Reliance on Registrant's Discovery Responses (filed on September 30, 2020):

1. Exhibit A: Registrant's Response to Petitioner's First and Second Requests for Admissions.
2. Exhibit B: Registrant's Response to Petitioner's Third Requests for Admissions.

26 TTABVUE

Declaration of Toby F. Bost (filed on September 30, 2020) in support of the meaning of "transition out of" and "exist out of":

1. Exhibit A: Resume of Toby F. Bost.
2. Exhibit B: Copy of the Burton Press Release provided in discovery and marked BUR_00001 through BUR_00005.
3. Exhibit C: Copy of an article published by TransWorld Business titled "Jake Burton On Overhauling Corporate Structure, Closing The Program Brands" obtained from <https://www.adventuresportsnetwork.com/transworld-business/burton-overhauls-corporate-structure-pulling-out-of-the-program/> on August 31, 2018 detailing an interview with Registrant's then CEO Jake Burton, also included is a copy of the Burton Press Release that was published with the interview.

27 TTABVUE

Testimony Declaration of Joshua S. Schoonover (filed on September 30, 2020):

1. Exhibit A: Copy of Articles of Organization for Reeflection, LLC (Petitioner's Licensee), goes to standing.
2. Exhibit B: Copy of a Statement of Information for Reeflection, LLC, goes to standing.
3. Exhibit C: Copy of email exchange between owners of Reeflection, LLC evidencing adoption of the FORUM mark.
4. Exhibit D: Copy of a business plan evidencing *bona fide* use of the FORUM mark.
5. Exhibit E: Copy of email exchange with V9 Sports Goods Co., Ltd (a snowboard manufacturer) related to Petitioner's efforts to manufacture FORUM snowboards.
6. Exhibit F: Copy of a second email exchange with V9 Sports Goods Co., Ltd related to Petitioner's efforts to manufacture FORUM snowboards.

7. *Exhibit G*: Copy of email exchange with Never Summer Industries (a snowboard manufacturer) related to Petitioner's efforts to manufacture FORUM snowboards.
8. *Exhibit H*: Copy of Amazon.com search query results for "reflection brands" obtained on September 1, 2018 evidencing bona fide intent to sell sporting goods, and more specifically, snowboard related goods.
4. *Exhibit I*: Screenshot of web page obtained at: <https://snowboarding.transworld.net/news/burton-realigns-its-family-of-brands-for-long-term-success/8/31> on August 31, 2018 showing publication of the Burton Press Release and that Registrant intended to "exit out of the Program Brands (incl. FORUM) in winter 2014".
5. *Exhibit J*: Screenshot of web page obtained at: http://www.espn.com/action/snowboarding/story/_/id/8545120/burton-announces-brand-restructuring-forum-close-analog-surf-skate on August 31, 2018 showing publication of the Burton Press Release and that Registrant intended to "exit out of the Program Brands (incl. FORUM) in winter 2014". Additionally, this evidence supports an interview with TransWorld Business in 2012, where Registrant said "We'll probably... put them to bed. I don't see us selling them. I think we will retain the trademarks should anything ever develop in the future."
9. *Exhibit K*: Screenshot of web page obtained at: <https://www.adventuresportsnetwork.com/transworld-business/burton-overhauls-corporate-structure-pulling-out-of-the-program/> on August 31, 2018 showing publication of the Burton Press Release and that Registrant intended to "exit out of the Program Brands (incl. FORUM) in winter 2014". Additionally, this evidence shows an interview with TransWorld Business in 2012, where Registrant said "We'll probably... put them to bed. I don't see us selling them. I think we will retain the trademarks should anything ever develop in the future."
10. *Exhibit L*: Screenshot of web page obtained at: <https://www.adventuresportsnetwork.com/sport/snowboarding/snow-industry-reacts-to-burton-snowboards-dropping-legendary-brands/> on August 31, 2018 showing publication of the Burton

Press Release and that Registrant intended to “exit out of the Program Brands (incl. FORUM) in winter 2014”.

11. Exhibit M: Screenshot of Facebook page for the account @forumsnowboards obtained on August 31, 2018 showing use of the account ceased after the last post dated November 16, 2012.
12. Exhibit N: Screenshot of Twitter page for the account @forumsnowboards obtained on August 31, 2018 showing use of the account ceased after the last post dated October 18, 2012.
13. Exhibit O: Screenshot of Instagram page for the account @forumsnowboards obtained on August 31, 2018 showing use of the account ceased after the last post dated September 27, 2012.
14. Exhibit P: Copy of the Burton Press Release provided by Registrant in discovery and marked BUR_00001 through BUR_00005.

53 TTABVUE (confidential) / 56 TTABVUE (public filing)

Transcript of Oral Deposition Testimony of Steven Cooley (Registrant) and exhibits:

1. Exhibit 1: Copy of Registrant’s sales of FORUM goods from Registrant’s fiscal year 2013 through end of Registrant’s fiscal year 2017 [also marked as BUR_00040 through BUR_00050].
2. Exhibit 2: Copy of a summary of the sales illustrated in Exhibit 1 produced by Registrant to Petitioner on October 4, 2018, which shows a winding down of FORUM product inventory during the stated period [also marked as BUR_00051].
3. Exhibit 3: Copy of the Burton Press Release provided by Registrant in discovery [also marked BUR_00001 through BUR_00005].
4. Exhibit 4: Screenshot of web page obtained at:
<https://www.adventuresportsnetwork.com/transworld-business/burton-overhauls-corporate-structure-pulling-out-of-the-program/> on August 31, 2018 showing publication of the Burton Press Release and that Registrant intended to “exit out of the Program Brands [incl. FORUM] in winter 2014”. Additionally, this evidence shows an interview with TransWorld Business in 2012, where Registrant admits "We'll probably... put them to bed. I don't see us selling them. I think we will retain the trademarks should anything ever develop in the future."

54 TTABVUE (confidential) / 57 TTABVUE (public filing)

Transcript of Oral Deposition Testimony of Christopher Cunningham (Registrant) and exhibits:

1. Exhibit 13: Testimony Declaration of Christopher L. Cunningham and exhibits [also, in the record as Registrant's evidence at 34 TTABVUE (public filing)].

55 TTABVUE (confidential) / 58 TTABVUE (public filing)

Transcript of Oral Deposition Testimony of Mark Wakeling (Registrant) and exhibits:

1. Exhibit 3: Copy of the Burton Press Release provided by Registrant in discovery [also marked BUR_00001 through BUR_00005].
2. Exhibit 4: Screenshot of web page obtained at:
<https://www.adventuresportsnetwork.com/transworld-business/burton-overhauls-corporate-structure-pulling-out-of-the-program/> on August 31, 2018 showing publication of the Burton Press Release and that Registrant intended to "exit out of the Program Brands [incl. FORUM] in winter 2014". Additionally, this evidence shows an interview with TransWorld Business in 2012, where Registrant admits "We'll probably... put them to bed. I don't see us selling them. I think we will retain the trademarks should anything ever develop in the future."
3. Exhibit 5: Copy of Registrant's invoice dated January 7, 2014 indicating sale of FORUM goods to The House.
4. Exhibit 6: Copy of Registrant's invoice dated November 19, 2013 indicating sale of FORUM goods to The Sound Barrier.
5. Exhibit 7: Copy of Registrant's invoice dated February 26, 2015 indicating sale of FORUM goods to The Sound Barrier.

STATEMENT OF THE ISSUES

1. Whether Registrant abandoned use of the FORUM marks connected with the Registration Nos. 2,207,535 and 3,598,502 (collectively, the “Subject Registrations”) with intent not to resume such use.
 - a. Are “winding down” sales, e.g., those consisting of the sale of older existing inventory in an effort to sell off without making new products, *bona fide* use in commerce?
 - b. Whether the period of non-use, for purposes of abandonment, includes or excludes “winding down” sales (liquidation of existing inventory, which is not a *bona fide* use in commerce); i.e. should the period of non-use be calculated as the period between sales that are consistent with *bona fide* use of the mark in commerce, or alternatively, should the period of non-use be calculated as the period of any sale, including “winding down” sales, even if the “winding down” sales are not *bona fide* use of a mark in commerce?

STATEMENT OF FACTS

1. The group of brands known as the “Program Brands” as presented throughout the evidence includes the marks FORUM, FOURSQUARE, and SPECIAL BLEND. (55 TTABVUE 30:16 through 30:20 (confidential) / 58 TTABVUE 30:16 through 30:20 (public filing)). The marks FOURSQUARE and SPECIAL BLEND are not currently at issue in this proceeding. This proceeding, in its current state, is directed only to the FORUM marks in connection with the Registration Nos. 2,207,535 and 3,598,502 (collectively, the “Subject Registrations”).
2. Registrant acquired the Subject Registrations from previous owner, The Program Corp., on or about January 18, 2007 (according to assignment records for the Subject Registrations at the USPTO, judicial notice requested), or as early as 2004 (25 TTABVUE 9).
3. On October 12, 2012, Registrant objectively manifested an intent to “exit out of” the Program Brands, including FORUM, as of winter 2014, in a press release that was delivered to and published by multiple sources (24 TTABVUE 19-23; 25 TTABVUE 9; 26 TTABVUE 10-14, and 21-25; 27 TTABVUE 37-81; and 95-99; and 55 TTABVUE 27:5 through 31:23, and 58-62 (confidential) / 58 TTABVUE 27:5 through 31:23, and 58-62 (public filing)); hereinafter the “Burton Press Release”. Because snow sports are a seasonal business, “winter 2014” means the period covering approximately October of 2013 through March of 2014.
4. Also, on October 12, 2012, Jake Burton, at the time CEO for Registrant, gave an interview with TransWorld Business, as confirmed by an article published by ESPN (27 TTABVUE 43), confirming such intent with statements such as “We'll probably... put them to bed. I don't see us selling them. I think we will retain the trademarks should anything ever develop in the future.” (27 TTABVUE 53).
5. On or about October of 2012, Registrant stopped manufacturing goods bearing the FORUM mark (See at least, 55 TTABVUE 29:3 through 29:14, and 31:16 through 31:19 (confidential) / 58 TTABVUE 29:3 through 29:14, and 31:16 through 31:19 (public filing))
6. Registrant discontinued use of its Instagram account @forumsnowboards with a final post on September 27, 2012 (27 TTABVUE 91-93; 25 TTABVUE 14-15 (RFA 19-21)).

7. Registrant discontinued use of its Twitter account @forumsnowboards with a final post on October 16, 2012 (27 TTABVUE 87-89; 25 TTABVUE 13-14 (RFA 16-18)).
8. Registrant discontinued use of its Facebook account @forumsnowboards with a final post on November 16, 2012 (27 TTABVUE 83-85; 25 TTABVUE 12-13 (RFA 13-15)).
9. Registrant sponsored athletes under the FORUM mark prior to October 23, 2012 (25 TTABVUE 16 (RFA25)).
10. Registrant sponsored no athletes under the FORUM mark after January 26, 2014 (25 TTABVUE 16 (RFA27)).
11. Registrant did not exhibit FORUM products at any trade show in years 2013 to at least 2017 (25 TTABVUE 30 (RFA 30)).
12. Registrant produced no FORUM products between October of 2012 and October of 2018 (55 TTABVUE 29:3 through 29:14 (confidential) / 58 TTABVUE 29:3 through 29:14 (public filing)).
13. Between November 19, 2013 (55 TTABVUE 84 (confidential) / 58 TTABVUE 84 (public filing)) and February 26, 2015 (55 TTABVUE 89 (confidential) / 58 TTABVUE 89 (public filing)), as indicated in the PO Number references and by amount of discount, Registrant sold closeout FORUM products to wind-down inventory and transition out of the FORUM mark.
14. Except for one alleged sale in 2018/2019, and as early as March 29, 2018, Registrant's last sale of FORUM product in the United States was a closeout sale on February 26, 2015 (55 TTABVUE 89 (confidential) / 58 TTABVUE 89 (public filing); 56 TTABVUE 78; and 25 TTABVUE 25 (RFA 55)).
15. Registrant made no sales of FORUM product for at least three years between February 26, 2015 and the subsequent deal with The House for 100 snowboards in 2018/2019, as early as March 29, 2018 (55 TTABVUE 21:9 through 21:13 (confidential) / 58 TTABVUE 21:9 through 21:13 (public filing)).
16. Petitioner filed its application to register its FORUM mark on September 30, 2017. (23 TTABVUE).
17. On January 9, 2018, Petitioner received an office action refusing its application in view of one of the Subject Registrations, namely, Reg. No. 2207535. (23 TTABVUE 7).

18. On January 18, 2018, Petitioner filed its Petition to Cancel resulting in what is now this consolidated Cancellation Proceeding.

19. On March 29, 2018, after institution of this Cancellation Proceeding, Registrant approached its customer The House to offer a sale of the one-hundred snowboards (36 TTABVUE 4; 55 TTABVUE 21:14 through 22:3 (confidential) / 58 TTABVUE 21:14 through 22:3 (public filing)).

20. In winter 2019, more than three years after February 26, 2015 (last sale of FORUM products), Registrant sold the one-hundred snowboards to its customer The House (35 TTABVUE 4).

21. On December 19, 2018, Petitioner received an office action refusing its application in view of both Subject Registrations. (23 TTABVUE 7).

22. On January 24, 2019, Cancellation No 92067794 (parent) and Cancellation No. 92069499 were consolidated into this consolidated Cancellation Proceeding.

23. Other than the one-hundred snowboards Registrant sold to The House in winter 2019, Registrant has produced no documentary evidence of sales of FORUM products since February 26, 2015.

ARGUMENT

I. Introduction

The Petitioner's evidence shows that Registrant made no sales of FORUM product between at least February 26, 2015 and, depending on how one defines the date of a sale, as early as March 29, 2018 (date an offer/inquiry was extended for sale) or as late as March 2019 (date with maximum reasonable credit terms considering the sale was in winter 2019), either way for a period of more than three years (55 TTABVUE 21:9 through 21:13 (confidential) / 58 TTABVUE 21:9 through 21:13 (public filing)). Registrant never supplemented discovery of sales after responding to Petitioner's discovery, including any sales in 2018/2019, so the exact date the 100 snowboards were sold to The House, while within this range, if at all, remains unverified. However, as mentioned above, since Mark D. Wakeling reached out to The House to initiate conversations about the sale of 100 snowboards on March 29, 2018 (36 TTABVUE 4; 55 TTABVUE 21:14 through 22:3 (confidential) / 58 TTABVUE 21:14 through 22:3 (public filing)), even if we count this as the date of an offer for sale sufficient to constitute *bona fide* U.S. sales, it remains more than three years after the February 26, 2015 sale verified in the record (55 TTABVUE 89 (confidential) / 58 TTABVUE 89 (public filing); 56 TTABVUE 78; and 25 TTABVUE 25 (RFA 55)).

In the Burton Press Release, Registrant objectively manifested its intent to "exit out of" the Program Brands (incl. FORUM) by winter 2014 (See at least 27 TTABVUE 95-99). Additionally, Jake Burton, CEO for Registrant at the time of the Burton Press Release, gave an interview with TransWorld Business, as confirmed by an article published by ESPN (27 TTABVUE 43), confirming such intent with statements such as "We'll probably... put them to bed. I don't see us selling them. I think we will retain the trademarks should anything ever develop in the future." (27 TTABVUE 53). Moreover, Mark D. Wakeling (Registrant) confirmed this, in his own words, "that was the position I discussed with [Jake Burton] at the time." (58 TTABVUE 34:8 through 34:17 (confidential) / 58 TTABVUE 34:8 through 34:17(public filing)).

As will be further discussed herein, after the Burton Press Release, and by winter 2014, Registrant made several actions in furtherance of that intent, namely: closing the FORUM headquarters in California, laying off employees working the FORUM brand, terminating sponsor deals under the FORUM marks,

ceasing marketing efforts under the FORUM marks on social media (Facebook, Instagram, Twitter), discontinuing the marketing of FORUM product at trade shows, ceasing the manufacture of FORUM product until a token revival in 2018, and substantially discounting closeout FORUM product as high as 83% off wholesale price to wind down the FORUM brand.

The act of creating token sales after institution of this proceeding, namely the 100 snowboards sold to The House in 2018/2019, is insufficient to remedy the abandonment of the FORUM mark. It is clear, at least to those sophisticated in the business, that Registrant merely sought to acquire the customer base of FORUM, convert those customers to BURTON customers, and shelf the FORUM brand merely retaining the trademarks. This much is suggested in the Burton Press Release.

Registrant has offered no evidence of sales of FORUM product between February 26, 2015 and at least March 29, 2018, such that this three-year gap establishes a prima facie case of abandonment. Moreover, Registrant is not selling FORUM product now, or since the 100 snowboards allegedly sold to The House in winter 2019.

Accordingly, as will be demonstrated below, the overwhelming evidence demonstrates that Registrant knowingly and voluntarily abandoned the FORUM marks of the Subject Registrations by February 26, 2015, and Registrant did not have a *bona fide* intent to use the FORUM marks at a later time or to resume use, until the institution of this consolidated Cancellation proceeding, whereafter only token sales of one-hundred snowboards were sold to one customer after more than a three-year gap of non-use, and thereafter no further sales were established by Registrant for FORUM products. Instead, the evidence demonstrates that Registrant had an intent merely to preserve the Subject Registrations for its FORUM marks on the trademark register without a bona fide use of the FORUM mark in commerce.

II. Standing

Petitioner has standing to bring this action for Cancellation of the Subject Registrations for the FORUM mark because his application Ser. No. 87629391 was refused registration based on alleged Section 2d likelihood of confusion with Registration Nos. 2,207,535 and 3,598,502 (collectively, the “Subject

Registrations”) (23 TTABVUE) and therefore the Subject Registrations being on the register are a source of actual and present harm to Petitioner.

It is respectfully submitted that the issue of standing was previously resolved by Petitioner's Motion for Summary Judgment (9 TTABVUE), which Petitioner motioned for partial summary judgment in its favor on the issues of: (i) whether Petitioner has standing to bring this cancellation proceeding; and (ii) whether Registrant abandoned the FOURSQUARE mark; and which was later resolved by the Board Order of January 24, 2019 stating in relevant part “Petitioner’s motion for summary judgment in the ‘794 Cancellation is granted as conceded because Respondent did not oppose it.” (12 TTABVUE 1).

Accordingly, it is believed that standing is not an issue that remains in this consolidated Cancellation proceeding.

III. Memorandum of Law & Argument

A. Law

Under the Lanham Act, a federally registered trademark is considered abandoned if its “use has been discontinued with intent not to resume such use.” *Crash Dummy Movie, LLC v. Mattel, Inc.*, 601 F.3d 1387, 1391 (Fed. Cir. 2010) (citing 15 U.S.C. § 1127). The burden is on the challenger – here Petitioner – to prove abandonment by a preponderance of the evidence. See *Cerveceria Controamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 1023-24 (Fed. Cir. 1989). Although non-use for a three-year period is prima facie evidence of abandonment, abandonment may be shown with less than three years of non-use coupled with an intent to not resume use. See, e.g., *Otto Int’l, Inc. v. Otto Kern GmbH*, 83 U.S.P.Q.2d 1861, *2 (T.T.A.B. 2007) (“The facts alleged must set forth a prima facie case of abandonment by a pleading of at least three consecutive years of non-use or must set forth facts that show a period of non-use less than three years coupled with an intent not to resume use.”). Importantly, there is no minimum time of non-use required for a mark to be abandoned. *Id.*

Rather, the Lanham Act provides that “[i]ntent not to resume use may be inferred from circumstances.” 15 U.S.C. § 1127. Conclusory statements by the mark holder are insufficient as a matter of law to avoid a finding of abandonment. See, e.g., *Imperial Tobacco Ltd., Assignee of Imperial Grp. PLC v.*

Philip Morris, Inc., 899 F.2d 1575, 1581 (Fed. Cir. 1990) (“in every contested abandonment case, the respondent denies an intention to abandon its mark; otherwise, there would be no contest...one must, however, proffer more than conclusory testimony or affidavits. An averment of no intent to abandon is little more than a denial in a pleading, which is patently insufficient to preclude summary judgment on the ground the facts are disputed.”); Hiland Potato Chip Co. v. Culbro Snack Foods, Inc., 720 F.2d 981, 983 (8th Cir. 1983) (quoting McCarthy, Trademarks and Unfair Competition, Vol 1, Sec. 17:3C (1973) (“if all a party had to do to avoid a holding of abandonment was to testify that he never had any intent to abandon the mark, then no mark would ever be held abandoned.”)). Thus, actions and statements of a party during the period of non-use must be evaluated to determine whether there was intent not to resume use. See, e.g., Hiland, 720 F.2d at 981; Intrawest Fin. Corp. v. W. Nat. Bank of Denver, 610 F. Supp. 950, 951 (D. Colo. 1985).

“[T]he bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.” 15 U.S.C. § 1127.

B. Registrant’s Discontinued Use of its FORUM marks

The first question before the Board is whether Registrant discontinued use of the FORUM marks of the Subject Registrations.

Petitioner need only show a three-year period of non-use by Registrant to establish a prima facie case. 15 U.S.C. § 1127.

Petitioner submits that Registrant abandoned use of the FORUM marks on October 12, 2012, when Registrant published its intent to “exit out of” the Program Brands, including FORUM, in the Burton Press Release (27 TTABVUE 95-99). Any sales after October 12, 2012 are merely “winding down” existing inventory in order for Registrant to “transition out of” the FORUM brand. Such sales connected to a winding down period are not *bona fide* sales sufficient to support the maintenance of a mark on the register because they are made only to recover costs, often at a liquidated value, and not with a *bona fide* intent to continue use of the mark in commerce.

Even if liquidation sales, such as closeout sales, are sales sufficient to support the maintenance of a trademark on the register, the evidence is clear that Registrant had no sales between at least February 26, 2015 and March 29, 2018.

Therefore, Petitioner respectfully submits that Registrant had no *bona fide* sales between October 12, 2012 to date; and in the alternative Registrant had no sales at all for at least three years between at least February 26, 2015 and March 29, 2018. (55 TTABVUE 21:9 through 21:13 (confidential) / 58 TTABVUE 21:9 through 21:13 (public filing); 25 TTABVUE 22 (RFA 39) and 23 (RFA 47)).

Registrant provided sales records between fiscal year 2013 and fiscal year 2017. (53 TTABVUE (confidential) / 56 TTABVUE (public filing)). Note that Registrant's fiscal year ends on the Saturday that is closest to the end of January. (56 TTABVUE 11:24 through 12:3). Therefore, the February 26, 2015 sale is categorized as Registrant's fiscal year 2016, since it occurred after the last Saturday of January in 2015. Moreover, the total on the February 26, 2015 invoice does not match the total in Steven Cooley's sales data and summary table because not all of the product on the invoice is FORUM product (at least some is designated "SB" for SPECIAL BLEND, and some is designated "4SQ" for FOURSQUSRE) (55 TTABVUE 18:13 through 18:17 / 58 TTABVUE 18:13 through 18:17 (public filing)). All of this considered the February 26, 2015 sale was Registrant's last sale of FORUM products prior to 2018. Registrant had a duty to supplement disclosures during the discovery period, yet no supplemental discovery was provided indicating any further sales. There are no subsequent sales of in the record.

Next, Registrant, only after being served with Petitioner's Notice of Cancellation, and the institution of this consolidated Cancellation proceeding, reached out to its customer, The House, in an attempt to resurrect use of the FORUM mark and offer to sell The House a token number (one-hundred) snowboards. Mark D. Wakeling (Registrant) sent an email to the House on March 29, 2018 inquiring whether they would be interested to buy FORUM snowboards (36 TTABVUE 26-27). Petitioner can't prove it with smoking gun evidence, but it seems obvious that Registrant merely sold this token number of snowboards to one specific client (as opposed to a general market offering), for purposes of re-establishing rights in its abandoned FORUM marks. This sale therefore is not a *bona fide* sale since it does not genuinely

comprise an effort to use the FORUM marks in the regular course of business as a legitimate proprietor would. Registrant has offered no other evidence of use of the FORUM mark since the February 26, 2015 closeout liquidation sale. Registrant expects the Board to believe that this 2018/2019 token sale is sufficient to establish intent to reuse the mark. However, as clearly articulated by Jake Burton in his interview with TransWorld Business (*supra*), Registrant's intent was to put FORUM to bed and to merely preserve the marks on the Register. Again, this was confirmed by Mark Wakeling in his cross-examination testimony. (58 TTABVUE 34:8 through 34:17 (confidential) / 58 TTABVUE 34:8 through 34:17(public filing)). Petitioner, therefore, submits that the 2018/2019 token sale to The House should be excluded as not amounting to a *bona fide* sale in accordance with the Lanham Act. However, in the alternative, the 2018/2019 sale to The House was, at the earliest date, generated with the inquiry of Mark Wakeling to the House on March 29, 2018, more than three-years after the February 26, 2015 sale.

Registrant's period of non-use began as early as October 12, 2012 (no *bona fide* use after this date) and as late as February 26, 2015 (date of winding down and liquidating existing FORUM inventory). The only subsequent use of the FORUM mark is the 2018/2019 sale of one-hundred snowboards to The House, which occurred as early as March 29, 2018, or as late as March of 2019. Even if the Board gives Registrant the benefit of every doubt and measures the period of non-use between February 26, 2015 and March 29, 2018, this is still a period of more than three-years and a prima facie case has been established. Registrant will need to rebut this presumption with evidence, for which there is none in the record.

C. Intent to Not Resume Use

It is nearly impossible to prove the subjective intent of an opposing party. However, in this matter, such intent was objectively manifested by Registrant in the Burton Press Release (See at least, 27 TTABVUE 95-99), specifically that Registrant expressly intended to "exit out of" the Program Brands (incl. FORUM) by winter 2014, which was not only confirmed, but more deeply clarified, by then CEO Jake Burton in his interview with TransWorld Business, where Burton stated "We'll probably... put them to bed. I don't see us selling them. I think we will retain the trademarks should anything ever develop in the future." (27 TTABVUE 53). There can be no other inference from this evidence other than Registrant

intended to stop all *bona fide* use of making and selling FORUM products in United States commerce. Again, this intent was corroborated by Mark D. Wakeling (Registrant) in his cross-examination testimony, where Mr. Wakeling said on the subject “that was the position I discussed with [Jake Burton] at the time.” (58 TTABVUE 34:8 through 34:17).

While it seems clear from the context of the evidence, the Registrant denies that its intent was not to resume use. However, the Burton Press Release, and the words of then CEO Jake Burton seem contrary to Registrant’s current position. Because Registrant raised the issue of the meaning of “exit out of” and “transition out of”, Petitioner obtained the opinion of expert Toby F. Bost, former CEO of O’Neil, who provided an opinion concerning the meaning of “transition out of” and “exit out of” a brand, such as the Program Brands (incl. FORUM). Mr. Bost says “to “transition out” or “exit out” means, with respect to the brand, to stop making, selling and/or offering for sale, goods which bear the mark associated with the respective brand.” (26 TTABVUE 3, item 10). Therefore, the evidence suggests that Registrant’s statement “[t]he company will exit out of The Program Brands [incl. FORUM] in winter 2014, in order to better focus on and invest in Burton” (27 TTABVUE 95, third ¶) means that Burton was intentionally going to stop making, selling and/or offering for sale FORUM product in winter 2014. Also, this was qualified with the added portion of the statement “in order to better focus on and invest in Burton,” which suggests that Registrant intended to no longer focus on or invest in FORUM products or the other Program Brands.

In addition to the express manifestations of intent taken from the Burton Press Release (27 TTABVUE 95-99) and the TransWorld Business interview with Jake Burton (27 TTABVUE 53), and further to the evidence offered by Mr. Bost clarifying the meaning of the statements made in the Burton Press Release (26 TTABVUE 3), Registrant acted in furtherance of that intent by at least: closing the FORUM headquarters in California (27 TTABVUE 52), laying off employees working the FORUM brand (55 TTABVUE 33:18 through 33:20 (confidential) / 58 TTABVUE 33:18 through 33:20 (public filing)), terminating sponsor deals under the FORUM marks (25 TTABVUE 16 (RFA 27)), ceasing marketing efforts under the FORUM marks on social media, including Facebook (27 TTABVUE 83-85; 25 TTABVUE 12-13 (RFA 13-15)), Instagram (27 TTABVUE 91-93; 25 TTABVUE 14-15 (RFA 19-21)),

and Twitter (27 TTABVUE 87-89; 25 TTABVUE 13-14 (RFA 16-18)), discontinuing the marketing of FORUM product at trade shows (25 TTABVUE 30 (RFA 30)), ceasing the manufacture of FORUM product until a token revival in 2018 (36 TTABVUE 4; 55 TTABVUE 21:14 through 22:3 (confidential) / 58 TTABVUE 21:14 through 22:3 (public filing)), and substantially discounting closeout FORUM product as high as 83% off wholesale price to wind down the FORUM brand (55 TTABVUE 18:21 through 19:8, and 89 (confidential) / 58 TTABVUE 18:21 through 19:8, and 89 (public filing)). All of these acts support a finding of Registrant's objective intent to abandon the FORUM brand.

IV. Conclusion

Even with the evidence of sales interpreted in the most favorable light for Registrant, it still shows a period of non-use of more than three-years (February 26, 2015 through March 29, 2018), amounting to prima facie evidence of abandonment. Further, this matter is one demonstrating documentary evidence of Registrant's intent to not resume use at least because the statement "exit out of" is not temporary but definitive and permanent. The evidence further supports a finding that Registrant merely intended to reserve the mark on the register, as indicated by the statements by Jake Burton and confirmed by Mark D. Wakeling. The evidence also supports a finding that the 2018/2019 sales, the only sales by Registrant of FORUM products after February 26, 2015, are merely token use aimed at the goal of re-establishing rights in the FORUM mark to prevent Petitioner from using the FORUM mark and competing in Registrant's market.

In sum, the evidence overwhelmingly demonstrates that Registrant abandoned use of its FORUM marks with the specific intent not to resume use, after which time Petitioner properly filed its ITU for the same mark. Therefore, it is respectfully submitted that Registrant's FORUM Registrations should be cancelled.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and accurate copy of PETITIONER'S OPENING TRIAL BRIEF has this 13th day of May 2021 been delivered via email only to the below-identified Attorney/Correspondent for the Respondent:

tmip@drm.com

By: Joshua S. Schoonover/

Joshua S. Schoonover