

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

Hearing Date: September 8, 2021

Mailed: October 27, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Joshua S. Schoonover

v.

The Burton Corporation
—

Cancellation Nos. 92067794 and 92069499
(Consolidated)
—

Joshua S. Schoonover
pro se.

Cathleen E. Stadecker and Evan J. O'Brien of Downs Rachlin Martin PLLC
for The Burton Corporation.
—

Before Kuhlke, Kuczma and Hudis,
Administrative Trademark Judges.

Opinion by Hudis, Administrative Trademark Judge:

In these consolidated proceedings, we are asked to decide whether a trademark owner abandoned its marks, warranting the cancellation of its registrations. As of the institution of these proceedings, Respondent, The Burton Corporation (“Respondent”) was the owner-of-record of the following standard character marks registered on the Principal Register:

Mark	Registration No. Registration Date	Goods
FORUM	2207535 December 1, 1998	Snowboards, snowboards binding, snowboards leashes and accessories therefor, in International Class 28 ¹
FORUM	3598502 March 31, 2009	Sweatshirts, in International Class 25 ²
FOURSQUARE	2134652 February 3, 1998	Clothing, namely, T-shirts, sweatshirts, tank tops, shirts, sweaters, vests, jackets, pants, sweatpants, shorts, coats; headwear, hats and caps and footwear, in International Class 25 ³

I. Preliminary Matters

A. The Pleadings

In its Petitions for Cancellation,⁴ Petitioner, Joshua S. Schoonover (“Petitioner”), seeks cancellation of Respondent’s FORUM and FOURSQUARE registrations under Trademark Act Sections 14 and 45, 15 U.S.C. § 1064 and 1127, on the ground that Respondent discontinued use of the marks with an intent not to resume their use, resulting in Respondent’s abandonment thereof.

In its Trial Brief, Respondent faults Petitioner for not alleging a specific period of Respondent’s non-use of the FORUM mark in the Petitions for Cancellation;

¹ Registration No. 2207535 has been renewed.

² As originally issued, Registration No. 3598502 recited the following goods: “shirts, sweatshirts, hats, beanies, caps, socks, gloves, and belts.” When the registration was maintained on March 30, 2015, the goods “shirts, socks, belts” were deleted. When the registration was renewed on March 21, 2019, the goods “hats, beanies, caps, gloves” were deleted. Otherwise, Registration No. 3598502 has been renewed.

³ As noted below, Registration No. 2134652 was cancelled on January 24, 2019.

⁴ 1 TTABVUE in each of Cancellation Nos. 92067794 and 92069499. References to the pleadings, the evidence of record and the parties’ briefs refer to the Board’s TTABVUE docket system. Coming before the designation TTABVUE is the docket entry number; and coming after this designation are the page and paragraph references, if applicable.

alternatively, for arguing in its Trial Brief a different period of non-use than Petitioner alleged.⁵ Respondent's criticisms are without merit.

Trademark Act Section 14, in relevant part, provides “[a] petition to cancel registration of a mark, stating the grounds relied upon, may ... be filed ... by any person who believes that he is or will be damaged by the registration of a mark on the principal register....” “Section 14 has been interpreted as requiring a cancellation petitioner ‘to show (1) that it possesses standing to challenge the continued presence on the register of the subject registration [now known as entitlement to a cause of action,]⁶ and (2) that there is a valid ground why the registrant is not entitled under law to maintain the registration.’” *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998) (quoting *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982)). “The ‘valid ground’ that must be alleged and ultimately proved by a cancellation petitioner must be a ‘**statutory** ground which negates the ... [respondent’s] right to the subject registration.’” *Young*, 47 USPQ2d at 1754 (quoting *Lipton*, 213 USPQ at 190 (emphasis original)).

As the Board aptly stated in *Lewis Silkin LLP v. Firebrand LLC*, 129 USPQ2d 1015 (TTAB 2018):

The petition to cancel pleads that Respondent is not using the mark with its goods ..., and has no intent to resume use. [N]o more is necessary for a legally sufficient abandonment claim [T]he allegations of nonuse plus intent serve both to describe the claim and to describe the necessary facts to support the claim. The Board specifically rejects the argument that the factual allegations of nonuse plus intent must include

⁵ Respondent's Trial Brief, 63 TTABVUE 11-12, 17-20.

⁶ We discuss Petitioner's entitlement to a statutory cause of action below.

additional allegations which demonstrate how Petitioner will prove the allegations of nonuse plus intent.

Lewis Silkin, 129 USPQ2d at 1020. *See also*, Trademark Act Section 45 (definition of abandonment).

Both of Petitioner's Petitions for Cancellation assert Respondent's non-use of the FORUM mark with an intent not to resume use thereof. No more specificity is necessary. The period(s) of Respondent's non-use of the mark, and the consequences arising therefrom, are matters of evidence that need not be provided with particularity in Petitioner's pleadings. *See Lifetime Indus., Inc. v. Trim-Lok, Inc.*, 869 F.3d 1372, 124 USPQ2d 1061, 1066 (Fed. Cir. 2017) ("[Defendant]'s complaints concerning lack of detail ask for too much. There is no requirement for [Plaintiff] to prove its case at the pleading stage." (internal quote marks omitted)).

Respondent denied the salient allegations of the Petitions for Cancellation in its Answers.⁷ Respondent also asserted two affirmative defenses in its Answer filed in Cancellation No. 92067794. In its Order of April 5, 2018,⁸ the Board ruled, "The first affirmative defense of failure to state a claim is **stricken** because Petitioner has sufficiently alleged his standing and claims for abandonment. Respondent's second affirmative defense [challenging Petitioner's standing, now known as entitlement to a statutory cause of action] is not a true affirmative defense, but it amplifies

⁷ Answer, 4 TTABVUE in Cancellation No. 92067794; Answer, 5 TTABVUE in Cancellation No. 92069499.

⁸ Board Order of April 5, 2018 in Cancellation No. 92067794, 6 TTABVUE 3.

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Respondent's denials, and therefore, is allowed to stand." Having reviewed the pleadings and the Board's April 5, 2018 Order, we leave those rulings undisturbed.

Respondent also asserted an affirmative defense challenging Petitioner's standing [entitlement to a statutory cause of action] in Cancellation No. 92069499. Lack of standing is not an affirmative defense. Standing, which we now refer to as an entitlement to a statutory cause of action, is an element of Petitioner's asserted claim that he must prove as part of his case. *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, n3 (TTAB 2020) (citing *Lipton*, 213 USPQ at 189 and *Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1637 (TTAB 2011)).

Ultimately, as we discuss below, we find that Petitioner adequately pleaded and proved its entitlement to bring and maintain both cancellation proceedings.

B. Partial Summary Judgment and Consolidation

On November 19, 2018 in Cancellation No. 92067794,⁹ Petitioner moved for summary judgment on the issues of whether it has standing (entitlement to a cause of action) and whether Respondent abandoned its FOURSQUARE mark of Registration No. 2134652. Respondent did not oppose this motion. On January 7, 2018, Petitioner filed a Notice of Concurrent Proceedings making the Board aware that Cancellation Nos. 92067794 and 92069499 were related proceedings.

In its Order of January 24, 2019,¹⁰ the Board granted Petitioner's summary judgment motion as unopposed. On the same day, the Commissioner of Trademarks

⁹ Petitioner's Summary Judgment Motion in Cancellation No. 92067794, 9 TTABVUE.

¹⁰ Board Order of January 24, 2019, 12 TTABVUE 1-2.

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issued an Order canceling Registration No. 2134652.¹¹ Also on the same day, the Board sua sponte consolidated Cancellation Nos. 92067794 and 92069499, notified the parties that the record will be maintained in Cancellation No. 92067794 as the “parent” case, and directed the parties to file all submissions in the parent case only.

From this point forward in our decision, unless otherwise indicated, our citations to the record only pertain to the submissions filed in Cancellation No. 92067794. Moreover, our findings, conclusions and final decision shall pertain only to the FORUM mark and associated goods of Registration Nos. 2207535 and 3598502.

II. Burden of Proof and Decision Summary

The consolidated cases are fully briefed, and an oral hearing was held on September 8, 2021. Petitioner bears the burden of proving his abandonment claim by a preponderance of the evidence. *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1180-81 (TTAB 2017). Having considered the evidentiary record, the parties’ arguments and applicable authorities, as explained below, we find that Petitioner has carried this burden, and grant the Petitions.

III. The Evidentiary Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the files of Respondent’s involved registrations. In addition, the parties introduced the following evidence:

¹¹ Commissioner’s Cancellation Order of January 24, 2019, 13 TTABVUE.

A. Petitioner's Evidence

- Petitioner's Notice of Reliance on Official Records ("P NOR1"), with exhibits consisting of a TSDR trademark database search result, and a portion of the file history, for Petitioner's Application Serial No. 87629391 (FORUM) [23 TTABVUE].
- Petitioner's Notice of Reliance on Printed Publications ("P NOR2"), with exhibits consisting of Respondent's press release¹² and articles concerning Respondent's business in October 2012 [24 TTABVUE].
- Petitioner's Notice of Reliance on Respondent's Discovery Responses ("P NOR3"), with exhibits consisting of Respondent's Responses to Petitioner's First, Second and Third Requests for Admissions [25 TTABVUE].
- Petitioner's Testimony Declaration of his Expert, Toby F. Bost ("Bost Decl."), with exhibits consisting of Mr. Bost's curriculum vitae, Respondent's press release and an article concerning Respondent's business in October 2012 [26 TTABVUE].
- Petitioner's Testimony Declaration of Joshua S. Schoonover ("Schoonover Decl."), with exhibits consisting of documents pertaining to his business (Reeflection, LLC), his company's business plans, Respondent's press release and articles concerning Respondent's business in October 2012, and Respondent's social media pages [27 TTABVUE].

B. Respondent's Evidence

- Transcript from Respondent's testimony deposition of Toby F. Bost ("Bost Depo."), with exhibits consisting of Mr. Bost's testimony declaration/exhibits and Petitioner's Notice of Expert Disclosure [31 TTABVUE].
- Respondent's Testimony Declaration of its Director of Financial Planning and Analysis, Steven Cooley ("Cooley Decl."), with exhibits consisting of a listing of customer orders for FORUM products for a portion of the fiscal year ("FY") 2013 and for FY 2014-17, and a document summarizing those customer orders [Public/Redacted 33 TTABVUE; Confidential 37 TTABVUE].

¹² Respondent's press release, 24 TTABVUE 18-23, does not qualify as a printed publication pursuant to Trademark Rule 2.122(e)(1), 37 C.F.R. § 2.122(e)(1). However, Respondent admitted to the issuance of this press release, P NOR3, 25 TTABVUE 9, Adm. Resp. 2. Moreover, the facts of the press release's issuance as well as its contents were discussed extensively and acknowledged by Mr. Wakeling during his cross-examination testimony, Wakeling Depo., 58 TTABVUE 27-31, 58-62, Depo. Exh. 3. We find this press release admissible pursuant to Trademark Rules 2.120(k)(3)(i)(ii) and 2.123(e)(2), 37 C.F.R. §§ 2.120(k)(3)(i)(ii) and 2.123(e)(2), and as an Opposing Party's Statement pursuant to Fed. R. Evid. 801(d)(2).

- Respondent's Testimony Declaration of its Senior Vice President of Global Product Christopher L. Cunningham ("Cunningham Decl."), with exhibits consisting of e-mail correspondence and product specifications [Public/Redacted 33 TTABVUE, Confidential 37 TTABVUE].
- Respondent's Testimony Declaration of its Senior Director of Commercialization for Hardgoods, Eric Gaisser ("Gaisser Decl."), with exhibits consisting of e-mail correspondence and product specifications [Public/Redacted 35 TTABVUE, Confidential 39 TTABVUE].
- Respondent's Testimony Declaration of Mark D. Wakeling ("Wakeling Decl."), with exhibits consisting of e-mail correspondence and sales invoices [Public/Redacted 36 TTABVUE, Confidential 40 TTABVUE].
- Respondent's Notice of Reliance ("R NOR"), with exhibits consisting of page captures from a retailer's website [41 TTABVUE].

C. Petitioner's Rebuttal Evidence

- Transcript from Petitioner's cross-examination testimony deposition of Steven Cooley ("Cooley Depo."), with exhibits consisting of the attachments to Mr. Cooley's testimony declaration, plus Respondent's press release and an article concerning Respondent's business in October 2012 [Public/Redacted 56 TTABVUE, Confidential 53 TTABVUE].
- Transcript from Petitioner's cross-examination testimony deposition of Christopher Cunningham ("Cunningham Depo."), with an exhibit comprising Mr. Cunningham's testimony declaration and the attachments thereto [Public/Redacted 57 TTABVUE, Confidential 54 TTABVUE].
- Transcript from Petitioner's cross-examination testimony deposition of Mark Wakeling ("Wakeling Depo."), with exhibits consisting of Respondent's press release and an article concerning Respondent's business in October 2012, and sales invoices [Public/Redacted 58 TTABVUE, Confidential 55 TTABVUE].

IV. Evidentiary Issues

Before proceeding to the merits of the cancellation proceeding, we address evidentiary matters raised by Respondent in its Trial Brief. First, Respondent argues we should afford no weight to its press release dated October 23, 2012, titled "Burton Realigns its Family of Brands for Long-Term Success." This press release, in part, contains the following statements:

[As] part of today's restructure, Burton announced it will **transition out of** its Program brands (Foursquare, Forum and Special Blend), which were purchased in 2004 The company will **exit out of** The Program brands in winter 2014, in order to better focus on and invest in Burton. (Emphasis added).¹³

Respondent argues that “[t]he Board ... need not, and should not, accord any weight to this press release because it need not make a finding as to Registrant’s intent as of October 2012 in light of the evidence that Registrant was engaged in continuous bona fide use of the marks for more than two years thereafter.”¹⁴ We interpret Respondent’s argument as asserting that we not consider the press release because its contents are irrelevant. Fed. R. Evid. 401, 402. We disagree, and **overrule** Respondent’s objection. As we already stated in note 12 above, the document is admissible pursuant to the Board’s Rules of Practice and the Federal Rules of Evidence. We further find the press release is relevant to Respondent’s intent with respect to its continued commitment (or not) to using the FORUM mark in connection with its business and products.

Second, Respondent objects to the testimony of Petitioner’s expert witness, Toby F. Bost. Mr. Bost’s testimony declaration, in relevant part, states as follows:¹⁵

9. I have been asked by Petitioner, Joshua S. Schoonover, to clarify the meaning of the phrase “transition out of”, “transitioning out of”, “exit out of” or “exiting out of” as it is used in the action sports apparel and hard goods business. I have also been asked to lend my opinion as to the intent of The Burton Corporation related to the act of exiting out of the Program Brands, namely the Forum brand.

¹³ Respondent’s press release, P NOR2, 24 TTABVUE 19.

¹⁴ Respondent’s Brief, 63 TTABVUE 26.

¹⁵ Bost Decl., 26 TTABVUE 3-4, ¶¶ 9-11.

10. [T]he phases “transition out of”, “transitioning out of”, “exit out of” or “exiting out of”, with respect to a brand, is a phrase that is often used in the action sports apparel and hardgoods business, and 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. With respect to a business, it would mean to cease activities of a business as a whole. In the instant matter, the phrase “transition out of” or “exit out of” is used in connection with The Program Brands, including Forum.

11. Therefore, it is my opinion that when The Burton Corporation made a public statement ... manifesting intent to “exit out of the Program Brands”, namely Forum, it was received by myself, and likely most or all in the field, that Burton was going to stop manufacturing and selling goods bearing these marks, specifically the Forum mark.

In the Appendix to its Trial Brief, Respondent moves to exclude Mr. Bost’s testimony on numerous grounds.¹⁶ Alternatively, within Respondent’s Trial Brief itself, Respondent asserts that Mr. Bost’s opinions should be given no weight.¹⁷ In its Reply Brief, Petitioner did not respond to Respondent’s motion to exclude or any of Respondent’s criticisms of Mr. Bost’s testimony. Having read through Respondent’s copious objections to and criticisms of Mr. Bost’s testimony, we find the vast majority of them go to the weight afforded his opinions rather than their admissibility.

Unlike jury trials, proceedings before the Board are adjudicated by Administrative Trademark Judges who are capable of separating reliable from unreliable testimony – even when offered by an expert witness. *Grote Indus., Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1200 (TTAB 2018) (“[O]ur proceedings are tried before judges not likely to be easily confused or prejudiced. Objections to trial testimony on bases more relevant to jury trials are particularly unnecessary in this forum.”), *complaint filed*,

¹⁶ Respondent’s Brief, 63 TTABVue 31-36.

¹⁷ *Id.* at 27.

No. 18-CV-599-LJV-MJR (W.D.N.Y. May 4, 2018); *RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1804 (TTAB 2018) (“the Board is capable of weighing the relevance and strength or weakness of the objected to testimony and evidence, including any inherent limitations”), *aff’d*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff’d*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021). We therefore **overrule** Respondent’s motion to exclude Mr. Bost’s testimony outright.

With that being said, during cross-examination Petitioner laid bare numerous shortcomings in Mr. Bost’s testimony declaration, as follows:¹⁸

- Mr. Bost did nothing (including any review of the pleadings or discovery materials in this proceeding) to research Respondent’s FORUM product sales, advertising spend, manufacturing, trademark licensing or any sale of rights to the mark since 2012.¹⁹
- Mr. Bost was aware that the “Program Brands” are a group of Respondent’s brands that include the marks Forum, Special Blend, and Foursquare. However, Mr. Bost did not know whether Respondent had stopped making, selling or offering for sale any goods which bore any particular Program Brand mark (including, of course, the FORUM mark).²⁰
- Mr. Bost devoted a maximum of two to three hours to this proceeding, including the time he spent at his deposition.²¹ He also conceded to not having spent much time on this matter prior to signing his testimony declaration.²²

¹⁸ Respondent leveled many other criticisms upon Mr. Bost that we find do not bear on the credibility or persuasiveness of his testimony, including that: Petitioner is Mr. Bost’s friend and former patent lawyer, Mr. Bost did his work in this case without compensation but as a favor to Petitioner, Mr. Bost’s testimony declaration was written by Petitioner based upon discussions had between the two of them (31 TTABVUE 56 – a fact not mentioned in Respondent’s motion to exclude), and that Mr. Bost rendered an opinion on the ultimate issues in this case (a contention with which we disagree – the ultimate issue here is Respondent’s purported abandonment of the FORUM mark, a matter on which Mr. Bost did not offer testimony). Respondent’s Brief, 63 TTABVUE 31-36.

¹⁹ Bost Depo., 31 TTABVUE 11-12.

²⁰ *Id.* at 36-37.

²¹ *Id.* at 18.

²² *Id.* at 45-46

- Mr. Bost has no prior experience as an expert witness, has not authored any publications and has no experience lecturing to or teaching others in the area for which he has been offered as an expert (the action sports apparel and hard goods business).²³
- While stating that “transition out of”, “transitioning out of”, “exit out of” or “exiting out of” have a separate and distinct meaning in his field of work, Mr. Bost did not provide any citations (to written materials) for that proposition. Mr. Bost’s opinions are based purely on his personal experience in the action sports apparel and hard goods businesses.²⁴
- Mr. Bost also did not cite any other examples in his declaration of “exit out of” or “transition out of” being used by anyone in the action sports apparel and hard goods businesses,²⁵ including Mr. Bost’s own prior employers.²⁶
- Mr. Bost was not sure whether a layperson would be capable of understanding the phrases “exit out of” and “transition out of”; in fact conceding it is possible that laypeople are perfectly capable of understanding the meaning of these phrases.²⁷

For these reasons, we give little probative value to Mr. Bost’s testimony and opinions. In fact, since we can resolve the ordinary meaning of the “transition out of”, “transitioning out of”, “exit out of” and “exiting out of” by resort to intrinsic evidence (Respondent’s press release itself) and dictionary definitions, we do not need expert testimony to separately define or interpret these terms. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 62 USPQ2d 1658, 1664 (Fed. Cir. 2002). *See also, Sunbeam Corp. v. Melitta-Werke Bentz & Sohn Kommanditgesellschaft*, 219 USPQ 945, 947 (TTAB 1983) (“Th[e] interpretation of ... [the disputed term at issue] is

²³ *Id.* at 19, 52-53.

²⁴ *Id.* at 31-33, 52.

²⁵ *Id.* at 33-35.

²⁶ *Id.* at 51-52.

²⁷ *Id.* at 34.

consistent with the ordinary meaning of the term, as shown by ... cited dictionary definitions.”).

V. The Parties

Petitioner is part owner of Reeflection LLC, a company that designs, manufactures and sells action sports-related goods, such as surfing, skateboarding, and snowboarding goods. Petitioner is interested in adopting the FORUM mark for his company’s use in connection with the manufacture and sale of snowboards, snowboarding apparel and outerwear.²⁸

Respondent designs and manufactures products for snowboarding and the snowboard lifestyle, including snowboards, boots, bindings, outerwear and layering as well as year-round apparel, packs/bags and accessories.²⁹ Respondent purchased the so-called “Program Brands” – Foursquare, Forum and Special Blend – from Forum Star Distribution in 2004 when that company declared bankruptcy.³⁰

VI. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a threshold issue that must be proven by the plaintiff in every inter partes case. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). To establish entitlement to a statutory cause of action under Trademark Act Section 14, 15 U.S.C. § 1064, a plaintiff must demonstrate “an interest falling within the zone of interests protected

²⁸ Schoonover Decl., 27 TTABVUE 2-3, 8-17, ¶¶ 2-4; Exhs. A-D.

²⁹ Article published in Snowboarding.Transworld.Net, Schoonover Decl., 27 TTABVUE 36-41, Exh. I.

³⁰ *Id.* See also article published in ESPN.com, Schoonover Decl., 27 TTABVUE 42-49, Exh. J.

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by the statute and ... proximate causation.” *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at *4 (Fed. Cir. 2020), *cert. denied*, ___ U.S. ___ (2021), (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067-70 (2014)).³¹ Stated another way, a plaintiff is entitled to bring a statutory cause of action by demonstrating a real interest in the proceeding and a reasonable belief of damage. *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at *3 (Fed. Cir. 2020), *cert. denied*, ___ U.S. ___ (2021); *see also Empresa Cubana*, 111 USPQ2d at 1062.

There is “no meaningful, substantive difference between the analytical frameworks expressed in *Lexmark* and *Empresa Cubana*.” *Corcamore*, 2020 USPQ2d 11277 at *4. Thus, “a party that demonstrates a real interest in canceling a trademark under [Trademark Act Section 14, 15 U.S.C.] § 1064 has demonstrated an interest falling within the zone of interests protected by [the Trademark Act] Similarly, a party that demonstrates a reasonable belief of damage by the registration of a trademark demonstrates proximate causation within the context of § 1064.” *See Corcamore*, 2020 USPQ2d 11277 at *7.

As noted, Petitioner is interested in adopting the FORUM mark for his company’s use in connection with the manufacture and sale of snowboards, snowboarding

³¹ Our decisions have previously analyzed the requirements of Trademark Act Sections 13 and 14, 15 U.S.C. §§ 1063-64, under the rubric of “standing.” We now refer to this inquiry as entitlement to a statutory cause of action. Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Trademark Act Sections 13 and 14 remain applicable.

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apparel and outerwear.³² Petitioner, and his colleagues at Reeflection, LLC, have gone so far as developing a business plan around the adoption and use of the FORUM mark, and contacting potential manufacturers of snowboards that would bear the mark.³³

Petitioner made of record USPTO TSDR database search results for his Application Serial No. 87629391³⁴ to register the mark FORUM for:

“Beanies; Belts; Gloves; Hats; Hoodies; Pants; Shoes; Shorts; Snow boots; Snow pants; Snowboard gloves; Snowboard jackets; Snowboard pants; Snowboard trousers; Socks; Sweatshirts; T-shirts; Ski and snowboard shoes and parts thereof” in International Class 25, and

“Snow boards; Snow skis; Snowboard bindings; Snowboards; Harnesses specially adapted for carrying snowboards, skis and Skateboards” in International Class 28

showing that this Application currently is in suspended status. Petitioner also made of record a copy of an Office Action he received from the USPTO, preliminarily refusing registration of Petitioner’s FORUM mark on the grounds of likelihood of confusion with Respondent’s FORUM mark of Registration Nos. 3598502 and 2207535.³⁵

We find that Petitioner has established his entitlement to bring and maintain these proceedings on the ground of abandonment, based on Petitioner’s status as a

³² Schoonover Decl., 27 TTABVUE 2-3, 8-17, ¶¶ 2-4; Exhs. A-D.

³³ *Id.* at 3-4, ¶¶ 4-8, 16-28, Exhs. D-G.

³⁴ Respondent admits that Petitioner is the owner of record of this Application. Petition for Cancellation in Cancellation No. 92067794, 1 TTABVUE 4, ¶ 5; Answer in Cancellation No. 92067794, 4 TTABVUE 3, ¶5. Petition for Cancellation in Cancellation No. 92069499, 1 TTABVUE 4, ¶ 6; Answer in Cancellation No. 92069499, 5 TTABVUE 3, ¶ 6.

³⁵ P NOR1, 23 TTABVUE 5-16, Exhs. A-B.

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competitor of Respondent, *Books on Tape, Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987) (finding competitor has standing, now known as entitlement to a statutory cause of action, because it has an interest in the outcome beyond that of the general public); *NT-MDT LLC v. Kozodaeva*, 2021 USPQ2d 433, *10 (TTAB 2021)(“Petitioner has established ... that it ... is a competitor of Respondent ... [and] uses a mark with the same wording and design as the mark [in Respondent’s] ... registration;” therefore showing its entitlement to seek cancellation of Respondent’s mark.), and by virtue of the USPTO’s preliminary refusal to register Petitioner’s FORUM application on grounds of likelihood of confusion with Respondent’s FORUM mark and registrations. *Empresa Cubana*, 111 USPQ2d at 1062; *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1040 (TTAB 2018).

VII. Applicable Law on Abandonment

Abandonment due to nonuse of a mark is defined as use that:

has been discontinued with an intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. ‘Use’ of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

Trademark Act Section 45, 15 U.S.C. § 1127. According to the statutory language and legislative history, “nonuse” of a mark for abandonment purposes means “no bona fide use of the mark made in the ordinary course of trade,” and this is to be interpreted with flexibility to encompass a variety of commercial uses. *Lewis Silkin*, 129 USPQ2d at 1018.

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Because a registration is presumed valid under the law, Trademark Act Section 7(b), 15 U.S.C. § 1057(b), a party seeking its cancellation bears the burden of proving abandonment by a preponderance of the evidence. *See Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1628 (Fed. Cir. 2009) (citing *W. Fla. Seafood v. Jet Rests.*, 31 F.3d 1122, 1125, 31 USPQ2d 1660 (Fed. Cir. 1994)).

As relevant here, a mark is deemed abandoned when two elements are proven: (1) use of the mark “has been discontinued,” (2) “with intent not to resume such use.” Trademark Act Section 45. If the petitioner shows three consecutive years of nonuse, it has established a prima facie showing of abandonment, creating a rebuttable presumption that the registrant has abandoned the mark. *Noble House Home Furnishings, LLC v. Floorco Enterprises, LLC*, 118 USPQ2d 1413, 1417 (TTAB 2016) (citing *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390, 1393 (Fed. Cir. 1990)):

The burden of production (i.e., going forward) then shifts to the respondent to produce evidence that he has either used the mark or that he has intended to resume use (e.g., a convincing demonstration of ‘excusable non-use’ that would negate any intent not to resume use of the mark). The burden of persuasion remains with the plaintiff to prove abandonment by a preponderance of the evidence.

In *Rivard v. Linville*, 133 F.3d 1446, 45 USPQ2d 1374, 1376 (Fed. Cir. 1998), the U.S. Federal Circuit Court of Appeals stated:

To prove excusable nonuse, the registrant must produce evidence showing that, under his particular circumstances, his activities are those that a reasonable businessman, who had a bona fide intent to use the mark in United States commerce, would have undertaken. *See Imperial Tobacco Ltd. v. Philip Morris, Inc.*, 899 F.2d

1575, 14 USPQ2d 1390, 1394-95 (Fed.Cir.1990) (requiring evidence “with respect to what activities it engaged in during the nonuse period or what outside events occurred from which an intent to resume use during the nonuse period may reasonably be inferred”).³⁶

VIII. Material facts of Record

Petitioner places considerable reliance on statements Respondent made in 2012 as evidence of Respondent’s abandonment of the FORUM mark.³⁷ Petitioner also points to Respondent’s cessation of a number of activities in connection with the FORUM mark after 2012.³⁸ Below we shall consider Respondent’s 2012 statements and its activities thereafter, or its cessation thereof, in turn.

³⁶ *Rivard and Imperial Tobacco* both involved challenges to registrations that had issued under Trademark Act Section 44, 15 U.S.C. § 1126, which does not require proof of use in commerce prior to registration. As a result, in both cases, use of the mark had never commenced, and the “excusable nonuse” issue was whether the registrant provided sufficient proof of its intent to commence use. In other words, to paraphrase *Imperial Tobacco*, the issue decided was whether the “activities [the registrant] engaged in during the nonuse period or what outside events occurred” were evidence “from which an intent to [commence] use during the nonuse period may reasonably be inferred.” 14 USPQ2d at 1395. In the case before us, the parties do not dispute that use of the FORUM mark commenced prior to registration, but rather that its use ceased following registration. As we discuss below, the issue here is whether Respondent’s discontinuation of use of the mark, and its activities following thereafter, reflected an intent not to resume use. See *Executive Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1198-99 (TTAB 2017) (in assessing excusable nonuse in this context, “plans must be to resume commercial use of a mark within the ‘reasonably foreseeable future’”) (quoting *Hornby v. Tjx Cos.*, 87 USPQ2d 1411, 1421-22 (TTAB 2008) (internal quotation omitted)). Although the term “excusable nonuse” in abandonment cases pertains to either the resumption or commencement of use, depending upon whether the involved registration issued under Trademark Act Sections 1(a), 44 or 66, 15 U.S.C. §§ 1051(a), 1126 or 1141f(a), the same standard for abandonment under Section 45 of the Act applies in all three contexts.

³⁷ Petitioner’s Brief, 61 TTABVUE 10, 13, 15, 18-19.

³⁸ *Id.* at 10-11, 13-14, 19-20.

A. Respondent's 2012 Statements – Allegation of Abandonment by Express Declaration

As we previously noted, on October 23, 2012 Respondent issued a press release, titled “Burton Realigns its Family of Brands for Long-Term Success.” This press release, in part, contains the following statements:³⁹

[As] part of today's restructure, Burton announced it will **transition out of** its Program brands (Foursquare, Forum and Special Blend), which were purchased in 2004 The company will **exit out of** The Program brands in winter 2014, in order to better focus on and invest in Burton. (Emphasis added).

* * *

2012 Burton Restructure: Key Facts by Brand

* * *

THE PROGRAM (Foursquare, Forum, Special Blend)

Heritage

Burton purchased The Program brands in 2004 from Four Star Distribution. At that time, Burton felt an obligation (and an opportunity) to slow the trend of ski companies buying up snowboard brands. Consequently, when these companies went up for sale, Burton purchased them and they became “The Program” brands for Burton.

Key Facts

- The intent from the beginning was to keep snowboard companies in the hands of snowboarders and keep these brands thriving. As the world's leading snowboard company, Burton felt there would never be a better home for these three brands.
- But even under Burton's wing, after 8 years, **the businesses have failed to be viable**. Consequently, Burton has realized it's time to **exit out of them**, in order to better focus and invest in the Burton brand.
- Therefore, Burton will be **transitioning out** of Foursquare, Forum and Special Blend globally after this season.
- Current winter 2013 product will be supported over the next year, via warranty, dealer, marketing and inventory support.

³⁹ Respondent's press release, P NOR 2, 24 TTABVUE 19, 22.

Team Update

We will be working with each team rider on an individual **exit plan** to transition them out of these brands. (Emphasis added).

We already stated above that the interpretation of this press release by Petitioner's expert is not persuasive, and that in any event we do not need Mr. Bost's testimony to construe its meaning. To "exit" from something means "to go out or away, depart, leave." To "transition" from something means "to make a change or shift from one state, subject, place, etc. to another" or "to cause (something or someone) to change or shift from one state, subject, place, etc. to another."⁴⁰ We find Respondent's use of "exit" and "transition" in the context of Respondent's press release shows Respondent's intent to cease commercial use of the FORUM brand in the foreseeable future.⁴¹

During his cross-examination, Respondent's Mr. Wakeling remembered this press release well. He knew at the time this press release was coming out that it would have a large impact on a lot of people; certain of Respondent's personnel were going to be let go because of this. As of October 2012, Burton was not going to be making FORUM products, or any other products in connection with The Program Brands.⁴²

⁴⁰ Definitions of "exit" and "transition" from MERRIAM-WEBSTER dictionary online. <https://www.merriam-webster.com/dictionary/exit> and <https://www.merriam-webster.com/dictionary/transition> (last visited October 25, 2021). The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. *Threshold.TV Inc. v. Metronome Enters. Inc.*, 96 USPQ2d 1031, 1037 n.14 (TTAB 2010).

⁴¹ Media coverage of Respondent's press release also was picked up by the SNOWBOARDER newsletter, ESPN, and the ADVENTURE SPORTS NETWORK. P NOR2, 24 TTABVUE 16-23; Schoonover Decl., 27 TTABVUE 5, 77-81, ¶ 13, Exh. L; P NOR3 25 TTABVUE 10-11, Adm. Resps. 5-9.

⁴² Wakeling Depo., 58 TTABVUE 27-28, 33-35, 38, 40.

According to Mr. Wakeling, Respondent stopped all commercial production of FORUM products by October of 2012, and would not resume production again until 2018.⁴³

⁴³ *Id.* at 29. See also P NOR3, 25 TTABVUE 21-23, Adm. Resps. 34-39, 42-47, which in relevant part provide:

REQUEST NO. 34: Admit that Registrant did not manufacture ... sweatshirts ... bearing the FORUM mark in year 2014. **RESPONSE TO REQUEST NO. 34:** Admitted.

REQUEST NO. 35: Admit that Registrant did not manufacture ... sweatshirts ... bearing the FORUM mark in year 2015. **RESPONSE TO REQUEST NO. 35:** Admitted.

REQUEST NO. 36: Admit that Registrant did not manufacture ... sweatshirts ... bearing the FORUM mark in year 2016. **RESPONSE TO REQUEST NO. 36:** Admitted.

REQUEST NO. 37: Admit that Registrant did not manufacture ... sweatshirts ... bearing the FORUM mark in year 2017. **RESPONSE TO REQUEST NO. 37:** Admitted.

REQUEST NO. 38: Admit that Registrant did not manufacture ... sweatshirts ... bearing the FORUM mark in year 2018. **RESPONSE TO REQUEST NO. 38:** Admitted.

REQUEST NO. 39: Admit that Registrant has not sold any ... sweatshirts ... bearing the FORUM mark and which were manufactured after year 2013 and prior to year 2018 (i.e. 2014, 2015, 2016, and 2017). **RESPONSE TO REQUEST NO. 39:** Admitted.

REQUEST NO. 42: Admit that Registrant did not manufacture snowboards, snowboard bindings, and snowboard leashes and accessories therefor bearing the FORUM mark in year 2014. **RESPONSE TO REQUEST NO. 42:** Admitted.

REQUEST NO. 43: Admit that Registrant did not manufacture snowboards, snowboard bindings, and snowboard leashes and accessories therefor bearing the FORUM mark in year 2015. **RESPONSE TO REQUEST NO. 43:** Admitted.

REQUEST NO. 44: Admit that Registrant did not manufacture snowboards, snowboard bindings, and snowboard leashes and accessories therefor bearing the FORUM mark in year 2016. **RESPONSE TO REQUEST NO. 44:** Admitted.

REQUEST NO. 45: Admit that Registrant did not manufacture snowboards, snowboard bindings, and snowboard leashes and accessories therefor bearing the FORUM mark in year 2017. **RESPONSE TO REQUEST NO. 45:** Admitted.

REQUEST NO. 46: Admit that Registrant did not manufacture snowboards, snowboard bindings, and snowboard leashes and accessories therefor bearing the FORUM mark in year 2018. **RESPONSE TO REQUEST NO. 46:** Admitted as to snowboard bindings, snowboard leashes and accessories. Denied except as expressly admitted.

REQUEST NO. 47: Admit that Registrant has not sold any snowboards, snowboard bindings, and snowboard leashes and accessories therefor bearing the FORUM mark and which were manufactured after year 2013 and prior to year 2018 (i.e. 2014, 2015, 2016, and 2017): **RESPONSE TO REQUEST NO. 47:** Admitted.

The press release was not the only statement in 2012 of Respondent's intent concerning the FORUM brand. On the same day as the press release, an article was published in ADVENTURE SPORTS NETWORK titled "Jake Burton on Overhauling Corporate Structure, Closing the Program Brands."⁴⁴ The article summarizes an interview with Respondent's founder and then CEO, Jake Burton.⁴⁵ In relevant part, the article states:

In a company-wide meeting this morning, Jake Burton announced a sweeping realignment of the company's brands and corporate structure including **transitioning out** of The Program brands, Foursquare; Forum; and Special Blend after this winter

* * *

With focusing more of your efforts on the Burton brand, where do you see reinvesting on that side?

* * *

Having those other brands that were **not making money** [Foursquare; Forum; and Special Blend] – it wasn't like I was all stressed solely about having to make money – but in the longer term it was money that could have been spent in other areas.

* * *

As far as The Program brands, the release says your [sic] **transitioning out** of them. What does that mean? Are you planning on selling them or are you putting those to bed?

⁴⁴ Schoonover Decl., 27 TTABVUE 4-5, 50-76, ¶ 12, Exh. K.

⁴⁵ Jake Burton began his tenure as CEO of Respondent around 2011. Mr. Burton was CEO in 2012. Wakeling Depo., 58 TTABVUE 25-26. He passed away in 2019. Cooley Depo., 56 TTABVUE 22-23. Consequently, Respondent could not present his testimony during its testimony period in September 2020. There is no evidence in the record that Petitioner took Mr. Burton's discovery deposition before discovery closed in April 2018 or, if it did, that this testimony was made of record during Respondent's testimony period in November 2020.

We'll probably, to use your words, **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 (Emphasis added).

In this interview, Mr. Burton clearly expressed his company's intent to "transition out of" (that is, stop using) the FORUM brand, yet retain the mark for potential use at some undetermined time in the future. This was the thinking of Respondent's management at the time (October 2012).⁴⁶

On the other hand, while "[a] public announcement of intention to discontinue the sale of a product may be a circumstance from which an intent not to resume [use of a mark] may be inferred," *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, *14 (TTAB 2019) (quoting *Hiland Potato Chip Co. v. Culbro Snack Foods, Inc.*, 720 F.2d 981, 222 USPQ 790, 792 (8th Cir. 1983)), such an "announcement [does not necessarily constitute] an intentional abandonment of the ... mark." *Id.* Furthermore, the very next day, week or month Respondent could have changed its mind and decided after all to continue marketing and selling products in connection with the FORUM mark. We therefore must examine, from the facts of record, Respondent's activities in connection with the FORUM mark, or lack thereof, after October 2012.

B. Respondent's Activities, or Cessation Thereof, Subsequent to October 2012

In addition to Respondent's press release and Jake Burton's interview in October 2012, Petitioner directs us to Respondent's "@forumsnowboards" social media

⁴⁶ Wakeling Depo., 58 TTABVUE 34-35.

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accounts on Facebook, Twitter and Instagram. Petitioner made web page captures of these social media pages of record, which Respondent concedes all show that they have been inactive with no posts from the company after the fall (September-November) of 2012.⁴⁷ Respondent also admits that, since January 2014, it sponsored no athletes under the FORUM mark, which it had done prior to October 2012.⁴⁸ Respondent further admits that it did not exhibit any goods related in any way to the FORUM mark at any trade shows from 2013-17.⁴⁹

Despite Respondent's terminating its manufacture of FORUM products as of October 2012, and ceasing to advertise them for years thereafter, Respondent points to its sales of FORUM products from 2013 to 2017.⁵⁰ The evidence supporting these purported sales does not hold up to scrutiny. Respondent's Director of Financial Planning and Analysis, Steven Cooley, testified that he had "personal knowledge that Burton has sold and offered for sale products under the FORUM brand both in the United States and internationally."⁵¹ Accompanying his testimony declaration, Mr. Cooley submitted a "a report generated ... [from Respondent's] Business Intelligence (BI) database ... [of] all orders of FORUM branded products for a portion of fiscal year 2013 and for the entirety of fiscal years 2014, 2015, 2016, and 2017" and "a chart

⁴⁷ P NOR3, 25 TTABVUE 12-15, Adm. Resps. 13-21; Schoonover Decl., 27 TTABVUE 5, 82-93, ¶¶ 14-16, Exhs. M-O

⁴⁸ P NOR3, 25 TTABVUE 16, Adm. Resps. 25-27.

⁴⁹ *Id.* at 17, Adm. Resp. 30.

⁵⁰ Respondent's Brief, 63 TTABVUE 8, 12.

⁵¹ Cooley Decl., 33 TTABVUE 3, ¶ 7.

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which summarizes, by fiscal year and Sales Organization, the voluminous data set forth in ... [the report].”⁵²

Respondent’s sales report and its summary show Respondent’s sales in the United States, Europe, Japan, Australia and Canada for the stated time period. We do not credit any of Respondent’s product orders outside the United States. *Adolphe Lafont, S.A. v. S.A.C.S.E. Societa Azioni Confezioni Sportive Ellera, S.p.A.*, 228 USPQ 589, 595 (TTAB 1985) (“prior use ... of a mark in connection with goods ... marketed in a foreign country ... creates no ... rights in said mark in the United States”) (quoting *Mother’s Rests. Inc. v. Mother’s Other Kitchen, Inc.*, 218 USPQ 1046, 1048 (TTAB 1983)).

Moreover, Respondent’s sales report does not show the types of products ordered or sold (e.g., snowboards, outwear, etc.), rendering the entire report uninformative. The sales summary shows a pattern of dwindling orders (in dollars) starting in 2013 – to the point that there was no more than very few FORUM product sales in 2016, and no sales at all in 2017. Mr. Cooley’s cross-examination testimony about these sales documents was equally unhelpful.

Mr. Cooley did not prepare Respondent’s sales report himself; rather, it was prepared by another employee at his request.⁵³ He had no independent knowledge of Respondent’s U.S. sales of FORUM products unless he checked his company’s BI

⁵² Cooley Decl., 33 TTABVUE 3-4, ¶¶ 9, 11; Cooley Confidential Decl. 37 TTABVUE 6-19, Exhs. 1-2.

⁵³ Cooley Depo., 56 TTABVUE 10, 14, 43.

database.⁵⁴ Respondent has other sources within its records that reflect its FORUM product sales, but Mr. Cooley did not consult them.⁵⁵ Even though it has been Mr. Cooley's job to report on the sales, profitability and budgeting for FORUM products, he reported them to Respondent's CFO without interpretation, commentary or discussion.⁵⁶ He further professed not to have any opinions or concerns about the declining FORUM product sales as reflected in the exhibits to his testimony declaration.⁵⁷

Respondent did not make of record any documents regarding its sales of FORUM products from the latter half of 2018 to 2021 when Mr. Cooley's cross-examination deposition was taken. Mr. Cooley had no independent knowledge regarding Respondent's sales of FORUM products during that period.⁵⁸ Overall, we find Mr. Cooley was unprepared, uncooperative and/or evasive in answering many questions put to him on cross-examination.

Respondent's Mr. Wakeling testified to his company's three separate, individual sales of "FORUM snowboards ..., bindings, boots, and other products under the FORUM brand" in each of 2013, 2014 and 2015.⁵⁹ Respondent sold such items to a Vermont customer in November 2013 at a 70% discount; a Minnesota customer in

⁵⁴ *Id.* at 18-19.

⁵⁵ *Id.* at 19.

⁵⁶ *Id.* at 21, 22, 26, 27, 28, 32

⁵⁷ *Id.* at 38-40.

⁵⁸ *Id.* at 15-18.

⁵⁹ Wakeling Decl., 36 TTABVUE 3-4, 6-21, ¶¶ 5-7, Exhs. 1-3.

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January 2014 at a 40% discount; and again to the Vermont customer in February 2015 at an 83% discount. Mr. Wakeling described these transactions as so-called “closeout sales” of merchandise manufactured on or before 2012, at ever greater discounts due to the increasing age of the products.⁶⁰ Notably, between 2013 and 2018, no FORUM products were manufactured.⁶¹

Respondent also points to its negotiations in 2016 with two separate companies to license the FORUM mark as evidence that its mark was not abandoned.⁶² The evidence of Respondent’s so-called “licensing negotiations” speaks to the contrary. In the spring of 2016, Respondent was approached by an Asian manufacturer to license the FORUM mark for the manufacture and sale of snowboards in a number of Asian countries (with the possibility of adding other products in following years). After considering the proposal, Respondent rejected it.⁶³ Even if these negotiations had been consummated with a licensing agreement, it would have no bearing on Respondent’s rights in the United States – because U.S. consumers would not have been exposed to branded products sold in Asia.⁶⁴ *Adolphe Lafont*, 228 USPQ at 595.

⁶⁰ Wakeling Depo., 58 TTABVUE 8-20, 38, 40, 79-91, Exhs. 5-7.

⁶¹ *Id.* at 20.

⁶² Respondent’s Brief, 64 TTABVUE 9, 21, 24-25.

⁶³ Gaisser Decl., 35 TTABVUE 3-4, ¶¶ 4-8; Gaisser Confidential Decl., 39 TTABVUE 5-13, Exhs. 1-3; Cunningham Decl., 34 TTABVUE 3-4, ¶¶ 5-9; Cunningham Confidential Decl., 38 TTABVUE 5-21, Exhs. 1-3.

⁶⁴ During Respondent’s negotiations with the Asian company, the possibility of sales of licensed FORUM products in the United States was not even considered or discussed. Cunningham Depo., 57 TTABVUE 7-9.

In April 2016, Respondent was approached by a United States company to license the FORUM mark for the manufacture and sale of snowboards and a number of related snowboarding and winter outerwear goods in the United States. Once again, Respondent rejected the proposal.⁶⁵ According to Mr. Wakeling, in 2016 the licensing “deal didn’t make sense for the sales” that Respondent was “going to gain for it.”⁶⁶

Petitioner filed Cancellation No. 92067794 in January 2018. In March 2018, Mr. Wakeling arranged for 100 new FORUM snowboards to be sold to one of its retail customers,⁶⁷ which he described as a relatively small deal for the company.⁶⁸ The deal involved the sale of these snowboards on a limited release in the winter of 2019.⁶⁹ Respondent provided the proposed details but (unlike the 2013-15 transactions discussed above) did not provide the final details for this consummated transaction (e.g., price, delivery, payment terms), other than product specifications of what these FORUM snowboards would look like when sold in March 2019.⁷⁰

Respondent’s final item of evidence consists of page captures taken in April 2019 from the website of outdoor gear online retailer The House.⁷¹ The pages from The

⁶⁵ Wakeling Decl., 36 TTABVUE 4, ¶¶ 9-10; Wakeling Confidential Decl., 40 TTABVUE 22-24, Exh. 4.

⁶⁶ Wakeling Depo., 58 TTABVUE 23-24.

⁶⁷ Wakeling Decl., 36 TTABVUE 4, ¶¶ 10-11; Wakeling Confidential Decl., 40 TTABVUE 25-28, Exh. 5; Wakeling Depo., 58 TTABVUE 21-23.

⁶⁸ *Id.* at 23-24.

⁶⁹ Cunningham Decl., 34 TTABVUE 4, ¶ 10; Gaisser Decl., 35 TTABVUE 4, ¶ 9.

⁷⁰ Cunningham Decl., 34 TTABVUE 22-24, Exh. 4; Gaisser Decl., 35 TTABVUE 14-16, Exh. 4.

⁷¹ R NOR, 41 TTABVUE 6-60

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House' website show snowboard boots, hoodies, sweaters, snowboards and snowboarding DVDs promoted for sale in connection with the FORUM mark. Except for two of the snowboard models, these items were all offered for sale at substantial discounts, from 48% to 83%. Respondent did not proffer any testimony about the FORUM items marketed for sale on The House website.

The probative value of The House web pages is limited. Respondent can use this evidence to demonstrate what the web pages show on their face, but cannot use them to demonstrate the truth of what has been printed. *Spiritline Cruises LLC v. Tour Management Services, Inc.*, 2020 USPQ2d 48324, at *2 (TTAB 2020) (Internet printouts and other materials properly introduced under a notice of reliance without supporting testimony considered only for what they show on their face rather than for the truth of the matters asserted).

Based on Mr. Wakeling's testimony, presuming that all of the FORUM merchandise on The House' website was obtained from Respondent (for which we do not have testimony), then all of the items shown, except for the two snowboard models, comprise old merchandise that was manufactured in 2012 or earlier. Without linking testimony, we have no way of knowing how many consumers actually visited these web pages much less purchased the pictured items. *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *3 (TTAB 2019) (no evidence introduced to show that United States consumers visited website) (citing *In re Brouwerij Bosteels*, 96 USPQ2d 1414, 1424 (TTAB 2010)); *Baroness Small Estates, Inc. v. American Wine Trade, Inc.*, 104 USPQ2d 1224, 1228 (TTAB 2012) (noting that

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there was no evidence in the record as to the public exposure to the website pages submitted as evidence) (citing *In re Country Music Association Inc.*, 100 USPQ2d 1824, 1830 (TTAB 2011)).

IX. Abandonment – Analysis, Findings and Conclusion

Respondent’s witnesses say uniformly that it was never their company’s intention to abandon the FORUM mark.⁷² Rather, as Mr. Wakeling testified, “FORUM ... [is] a valuable brand that could and would be utilized if the timing and situation were appropriate”⁷³ However, “intent to abandon” is not the test. Intent not to resume use is the critical element:

[A]n affirmative desire by the registrant not to relinquish a mark is not determinative of the intent element of abandonment under the Lanham Act. ... In every contested abandonment case, the respondent denies an intention to abandon its mark; otherwise there would be no contest. ... The registrant must put forth evidence with respect to what activities it engaged in during the nonuse period or what outside events occurred from which an intent to resume use during the nonuse period may reasonably be inferred.

Imperial Tobacco, 14 USPQ2d at 1394-95.

In October 2012, Respondent (as a company in its press release) and its then CEO Jake Burton (in an interview) affirmatively stated the company’s intention to “exit out of” or “transition out of” the FORUM brand, “putting it to bed” because the brand was unprofitable. Could Respondent have changed its mind the following day, week or month? Yes. So we look to Respondent’s activities following October 2012 up

⁷² Cunningham Decl., 34 TTABVUE 3, ¶ 4; Gaisser Decl., 35 TTABVUE 3, ¶ 4; Wakeling Decl., 36 TTABVUE 3, ¶ 3.

⁷³ Wakeling Decl., 36 TTABVUE 3, ¶ 3.

through the close of Respondent's testimony period in this proceeding in November 2020.

Mr. Cooley testified to a FORUM product orders report, and its summary, spanning from 2013 to 2017. Since the report does not list the items ordered, and Mr. Cooley had no independent knowledge of the products ordered or sold, his testimony, the report, and its summary are of little probative value. Mr. Wakeling testified that “[d]uring ... [Respondent’s] fiscal years 2013 through 2017, Burton continued to sell FORUM products and ... [he] was personally involved in doing so.”⁷⁴ However, Mr. Wakeling’s testimony is undercut by the report and summary Mr. Cooley provided, showing no FORUM product sales in the United States in 2017. Mr. Cooley’s and Mr. Wakeling’s testimony regarding the years of product sales also are undercut by Respondent’s admissions that it did not manufacture or sell new sweatshirts, snowboards, snowboard bindings, snowboard leashes or accessories therefor (that is, produced after 2012 – see note 43 *supra*.) bearing the FORUM mark from 2014 to 2017.

What Respondent did prove, through Mr. Wakeling, is that its last bona fide commercial “closeout” sale of old FORUM merchandise was in February 2015 to its Vermont customer at an 83% discount. Thereafter, Respondent turned down two FORUM licensing proposals, from two separate companies, in 2016. After Petitioner filed his first cancellation action in January 2018, Mr. Wakeling negotiated in March 2018 with one of its retail customers for the sales of a small order of 100 FORUM

⁷⁴ Wakeling Decl., 36 TTABVUE 3, ¶ 4.

snowboards, with the transaction apparently having been consummated in March 2019. Respondent provided evidence (of little probative value) showing that The House displayed FORUM products for sale on its website in April 2019 – much of it at substantial discounts suggesting that it was old (“closeout”) merchandise.

A registered trademark is considered abandoned if its “use has been discontinued with intent not to resume such use.” 15 U.S.C. § 1127 “Nonuse for 3 consecutive years shall be prima facie evidence of abandonment.” *Id.* A showing of a prima facie case creates a rebuttable presumption that the trademark owner has abandoned the mark without intent to resume use. [*On-Line Careline, Inc. v. Am. Online, Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000)]. “The burden then shifts to the trademark owner to produce evidence that he either used the mark during the statutory period or intended to resume use.” *Id.* “The burden of persuasion, however, always remains with the [challenger] to prove abandonment by a preponderance of the evidence.” *Id.*

Crash Dummy Movie, LLC v. Mattel, Inc., 601 F.3d 1387, 94 USPQ2d 1315, 1316 (Fed. Cir. 2010).

We find that Respondent discontinued use of the FORUM mark in connection with the goods identified in both challenged registrations from at least February 2015 until March 2019. Even without Respondent’s public statements made in 2012 (or considering the negotiations in March 2018), Respondent’s cessation of use of the mark for greater than three consecutive years is prima facie evidence (a rebuttable presumption) of abandonment. Thus, the burden shifted to Respondent to produce evidence that it either used the FORUM mark during this period or that Respondent intended to its resume use. In this connection, we “may consider evidence and testimony regarding ... [Respondent’s] practices that occurred before or after the

three-year statutory period [of non-use] to infer ... [Respondent's] intent to resume use during the three-year period." *Crash Dummy Movie*, 94 USPQ2d at 1317.

Certainly, we do not credit Respondent's professed 2016 "licensing negotiations," which Respondent did not initiate and in both instances Respondent rejected. We find that Respondent's March 2019 sale of 100 FORUM snowboards – after Petitioner initiated the first of these consolidated cancellation proceedings – not to be evidence of Respondent's intent to resume use of the mark. That is, the 2019 sale was not a "bona fide use of a mark in the ordinary course of trade," but rather a sale "made merely to reserve a right in a mark." Trademark Act Section 45, 15 U.S.C. § 1127 (definition of "use in commerce"). At most, such use would be a new use and not evidence of an intent to resume use during the non-use period. This is particularly so given that Respondent provided no evidence of any plans to resume use of the mark or actual commercial use of the mark at any time between the March 2019 sale and the November 2020 close of Respondent's testimony period in this proceeding. We therefore find and conclude that Respondent has discontinued use of the FORUM mark with an intent not to resume use – such that Respondent has abandoned the mark.

Respondent's reliance on *Double Coin Holdings*, 2019 USPQ2d 377409, at *15, *18,⁷⁵ is misplaced. *Double Coin Holdings* involved a petition to cancel the respondent's ROAD WARRIOR registration for tires on the ground of priority and likelihood of confusion with the petitioner's registered WARRIOR mark for tires. *Id.*

⁷⁵ Respondent's Brief, 63 TTABVUE 16.

at *1. The respondent counterclaimed for cancellation of the petitioner's WARRIOR registration on grounds of abandonment. *Id.* First, unlike the present case, the Board found that the petitioner's non-use of its WARRIOR mark in the United States was not in excess of the statutory three-year period; such that the burden to demonstrate abandonment remained with the respondent/counterclaimant. *Id.* at *15. Second, again unlike the present case, the petitioner (a Chinese tire manufacturer) demonstrated that its non-use of the WARRIOR mark in the United States was occasioned by very high importation tariffs leveled by the United States government on certain China tire manufacturers. The petitioner provided testimonial and document evidence that, during the period of non-use, it erected a new tire manufacturing facility in Thailand from which it could manufacture and import tires to the United States so as to avoid the high importation tariffs. *Id.* These kind of circumstances, or similar conditions, have not been shown by the evidence made of record in this case.

Decision:

We grant the Petitions to Cancel on grounds of abandonment pursuant to Trademark Act Sections 14 and 45, 15 U.S.C. §§ 1064, 1127. Registration Nos. 2207535 and 3598502 for the FORUM mark will be canceled in due course. Registration No. 2134652 for the FOURSQUARE mark already has been cancelled.