

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: June 10, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Steven Westlake

v.

*Edgar Alexander Barrera and Richard K. Fox Publishing Company*¹

Cancellation No. 92067883

Steven Westlake, pro se.

Anderson J. Duff of Duff Law PLLC,
for Edgar Alexander Barrera.

Before Kuhlke, Wolfson, and Coggins, Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

This proceeding involves two individuals claiming rights in the same mark for a magazine. That mark is depicted below:

¹ The involved Registration No. 3662484 was assigned by Edgar Alexander Barrera to Richard K. Fox Publishing Company nunc pro tunc effective 8/28/2020. The assignment was recorded at Reel and Frame Nos. 7497/0465 on November 17, 2021. We join Richard K. Fox Publishing Company as a party defendant sua sponte. *See generally* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) Section 512.01 (June 2021) and authorities cited therein.



Defendant Edgar Alexander Barrera filed an application to register the mark that issued as Registration No. 3662484. The mark is registered for “Magazines in the field of current events and sports,” in International Class 16; and “Publication of magazines; Newspaper publication; Newspaper publishing,” in International Class 41.²

Petitioner Steven Westlake filed a petition to cancel Respondent’s registration. Petitioner alleged the following grounds in his petition for cancellation:

- abandonment under Trademark Act Section 14(3), 15 U.S.C. § 1064(3);
- false suggestion of a connection under Section 2(a), 15 U.S.C. § 1052(a);
- deceptiveness under Section 2(a);
- that the registration is being used so as to misrepresent the source of the goods and services with which it is used under Section 14(3); and

² Reg. No. 3662484 issued on August 4, 2009; renewed. The terms "Gazette" and "Journal" have been disclaimed. Limitations under Section 2(f) is entered as to “The National Police Gazette” and “The Leading Illustrated Sporting Journal in America.” Color is not claimed as a feature of the mark.

- fraud.³

Petitioner also alleged priority of use of the mark in connection with “online magazine[s] and publishing activities” and a likelihood of confusion; and that Respondent was not using the mark at the time he filed for its registration. 1 TTABVUE 4. Neither claim is available to Petitioner because Respondent’s registration is more than five years old. *See* Trademark Act Section 14; 15 U.S.C. § 1064; *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 (TTAB 2017) (registration more than five years old is immune to attack on likelihood of confusion grounds) (citing *In re Strategic Partners, Inc.*, 102 USPQ2d 1397, 1399 (TTAB 2012)); *Maids to Order of Ohio, Inc. v. Maid-to-Order, Inc.*, 78 USPQ2d 1899, 1906 n.6 (TTAB 2006) (registration more than five years old may not be challenged on ground mark was not used in commerce at time of application filing).

Respondent filed an answer denying the salient allegations in the petition to cancel, and asserted that Petitioner’s claims as set forth in paragraph Nos. 5-13 are “barred by claim preclusion.”⁴ We do not reach the merits of this defense because

³ To the extent these claims were most clearly set forth in the ESTTA filing form, we note the ESTTA filing form and the attached pleading are considered to be a single document. *PPG Indus. Inc. v. Guardian Indus. Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005).

⁴ Respondent further asserted the following purported affirmative defenses: that the petition fails to state a claim upon which relief may be granted, and that Petitioner lacks standing to petition to cancel the registration. Neither of these are true affirmative defenses. Lack of standing, now referred to as an entitlement to a statutory cause of action (as discussed more fully below) is not a true affirmative defense because “[t]he facts regarding standing . . . are part of [a plaintiff’s] case and must be affirmatively proved.” *Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1848 (TTAB 2017) (quoting *Lipton*

Respondent did not pursue the matter in its brief. *See Baroness Small Estates Inc. v. Am. Wine Trade Inc.*, 104 USPQ2d 1224, 1225 n.2 (TTAB 2012) (respondent's affirmative defenses waived where respondent did not pursue them in its brief); *cf. Miller v. Miller*, 105 USPQ2d 1615, 1616 n.3 (TTAB 2013) (applicant's affirmative defense of unclean hands deemed waived because applicant failed to argue and present evidence regarding the defense at trial).

We also do not consider any but Petitioner's claims of abandonment and fraud because none of the other claims was argued in Petitioner's brief. *See Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1426 n.3 (TTAB 2013) (claim not argued in brief is considered waived) (citing *Knight Textile Corp. v. Jones Invest. Co.*, 75 USPQ2d 1313, 1314 n.4 (TTAB 2005) (opposer's failure to present arguments in support of its pleaded ground of dilution deemed waived)).

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the challenged registration and its file history. In addition, both parties have submitted evidence as follows:

Ind., Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982)). The asserted defense of failure to state a claim is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading of a plaintiff's claim rather than a statement of a defense to a properly pleaded claim. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001).

A. Petitioner's Evidence

- Testimony declaration of Steven Westlake and attached exhibits (12 TTABVUE);
- Rebuttal Testimony declaration of Steven Westlake and attached exhibits (29 TTABVUE).

B. Respondent's Evidence

- Testimony declaration of Lester A. Euell and attached exhibits (23 TTABVUE);
- Testimony declaration of Edgar Alexander Barrera and attached exhibits (24 TTABVUE);
- Testimony declaration of Jorge Antonio Martinez-Soto and attached exhibits (25 TTABVUE); and
- Respondent's Notice of Reliance and attached exhibits (26 TTABVUE).

II. The Parties

A. Petitioner

In his brief, Petitioner describes an American periodical known as the NATIONAL POLICE GAZETTE, which was founded in 1845 and published weekly until the 1930s, then monthly through its last dated issue of January 1977. Petitioner's Brief, 31 TTABVUE 2. The NATIONAL POLICE GAZETTE ("POLICE GAZETTE") was published by the Police Gazette Publishing Corp. Petitioner's Rebuttal Decl., 29 TTABVUE 12, Exs. K, L. According to Petitioner, these rights ultimately transferred to Joseph Azaria, an individual from whom Petitioner purchased "the physical archive." 31 TTABVUE 3. On April 8, 2007, Petitioner started a "Yahoo Small Business" website, identified as www.policegazette.us, on which he has, from that date, continuously used the subject mark. Petitioner's Decl., 12 TTABVUE 4. The results of a Wikipedia

search identified as Ex. E to Petitioner's Testimony declaration identifies a publication known as "The National Police Gazette" founded in 1845 and describes the website www.policegazette.us as "mimic[ing] the *Police Gazette* style." 12 TTABVUE 17. Petitioner contends that his continuous use is confirmed by this Wikipedia search as well as "an online magazine article published by the Petitioner at policegazette.us on April 8, 2017." *Id.* at 4; Ex. O, 12 TTABVUE 30-41.

B. Respondent

Respondent testified that he is the owner of Registration No. 3662484 for the subject mark and that he began using the subject mark as the successor in interest to Lester A. Euell. Respondent also testified that he has "worked with several associates, including... Les Euell," Barrera Decl., 24 TTABVUE 3, and that he assigned the registration to Richard K. Fox Publishing Company on August 25, 2020. 24 TTABVUE 2-3, Exs. A, B.⁵

Les Euell testified that he (Euell) was the "common-law owner of the subject mark;" that he began publishing printed materials under the mark "substantially exclusively and continuously from January 2, 1977 to the present;" and that "a few years prior" to July 9, 2012, Respondent "had taken ownership" of the mark; "assumed primary control of the National Police Gazette;" and obtained his registration. Euell Decl. 23 TTABVUE 2-3.

⁵ The assignment is identified as a "nunc pro tunc assignment effective August 25, 2020."

Jorge Antonio Martinez-Soto, the owner of the Richard K. Fox Publishing Company, asserted in his declaration that his company “intends to continue publishing printed materials under [the subject mark] far into the future.” Martinez-Soto Decl., 25 TTABVUE 3. Four days after the execution of his declaration, that is on September 24, 2021, the Richard K. Fox Publishing Company was administratively dissolved for failure to file an annual report. 29 TTABVUE 10, Ex. M. It was reinstated on November 7, 2021, allegedly “after being alerted to the fact by Petitioner.” Petitioner’s Brief, 31 TTABVUE 20. Respondent asserts that he “and my predecessors in interest published printed materials under the subject mark substantially exclusively and continuously from January 2, 1977 to the present,” although the exact relationship between Petitioner, Les Euell, and his other “associates” is unclear. 24 TTABVUE 2.

III. Petitioner’s Entitlement to a Statutory Cause of Action⁶

Entitlement to a statutory cause of action “is an element of the plaintiff’s case in every inter partes proceeding.” *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, *10 (TTAB 2021) (citing *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020

⁶ Our decisions have previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of “standing.” 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 Sections 13 and 14 remain equally applicable. See *Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

USPQ2d 11277 (Fed. Cir. 2020)); *see also Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 at *3 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 125-26 (2014)).

To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Spanishtown Enters.*, 2020 USPQ2d 11388 at *1 (citing *Corcamore*, 2020 USPQ2d 11277 at *4). *See also Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Indus.*, 213 USPQ at 189.

Here, Petitioner's use of the pleaded mark establishes that he is entitled to petition to cancel Respondent's registration. *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009) (testimony that Petitioner uses its mark "is sufficient to support Petitioner's allegations of a reasonable belief that it would be damaged ..."). Respondent does not contest Petitioner's entitlement to a statutory cause of action. 32 TTABVUE.

IV. Abandonment

Petitioner claims that Respondent has abandoned his registration by failing to use the mark in commerce "since at least December 31, 2013." 31 TTABVUE 17. Although Petitioner admits that "Respondent created his own National Police Gazette website"

in 2010, 12 TTABVUE 4, Petitioner contends that his online search for the website on April 14, 2019, returned a “404 Not Found” page. *Id.*, Ex. N.

In response, Respondent submitted three testimonial declarations wherein each declarant stated that the specimens attached to the January 29, 2016 Declaration of Use and the February 3, 2020 Combined Declaration of Use and Renewal Application for the subject registration were authentic, and in particular Mr. Barrera (who signed the documents) “affirms the statements made therein were true and accurate.” 24 TTABVUE 3, Exs. C, D.⁷ In the 2016 Declaration of Use, an authenticated copy of which was submitted with his testimonial declaration as Ex. C, Respondent stated that he was using the mark in Class 16 on all the goods listed, and was submitting as a specimen: “magazine covers.” In Class 41, Respondent again stated he was using the mark on all services listed, submitting as a specimen: “advertisements; magazine covers.”

In the 2020 Combined Declaration of Use and Renewal, 24 TTABVUE Ex. D, Respondent stated that he was using the mark in Class 16 in connection with all the goods, and was submitting “an excerpt from [Respondent’s] December 2019 magazine.” With respect to the services in Class 41, Respondent stated that he was

⁷ Respondent also submitted a notice of reliance that he contends supports his use of the mark, but the evidence attached thereto and the arguments made therein are directed to Respondent’s affirmative defense of claim preclusion, which as we earlier noted, has been waived.

using the mark with respect to all services in the class, as supported by a “broadsheet flyer for [Respondent’s] publishing services.” 24 TTABVUE 30.

Given this evidence, we find that Respondent has adequately shown that he has not abandoned his mark.⁸

V. Fraud

“Fraud in procuring or maintaining a trademark registration occurs when an applicant for registration or a registrant in a declaration of use or a renewal application knowingly makes specific false, material representations of fact with the intent of obtaining or maintaining a registration to which it is otherwise not entitled.” *Illyrian Imp., Inc. v. ADOL Sh.p.k.*, 2022 USPQ2d 292, *39 (TTAB 2022) (citing *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1939 (Fed. Cir. 2009)).

Petitioner alleges that Respondent committed fraud in the execution of the underlying application that matured to Reg. No. 3662484 by knowingly submitting, with intent to deceive, digital renderings instead of proper specimens, and by fraudulently claiming the mark was in use in commerce. Petitioner’s Brief, 31 TTABVUE 22.⁹ Petitioner alleges that the specimens provided by Respondent were

⁸ We recognize Petitioner’s allegations directed to the credibility of Respondent’s witnesses, and to the extent relevant to the issues at hand, have taken them into account.

⁹ Petitioner also alleges fraud based on allegations that Respondent was aware of Petitioner’s prior use of the mark and that a likelihood of confusion would arise if Respondent began using the mark. Because likelihood of confusion can no longer be asserted against Respondent’s registration, there is no basis for a finding of fraud grounded in these alleged facts. 15 U.S.C. § 1064. However, to the extent Petitioner is claiming that Respondent committed fraud on the Office when it claimed to be the owner of the mark despite its

“clearly not scans of paper items, but are digitally created.” Petitioner’s Testimony Decl., 12 TTABVUE 5.

In support, Petitioner relies on Exs. M and N attached to his declaration to show that Respondent’s website was not active after 2013 (12 TTABVUE 27, Ex. M) and that Petitioner succeeded to whatever rights Joseph Azaria, the mark’s true owner according to Petitioner, had in the subject mark (12 TTABVUE 29, Ex. N). Petitioner further relies on Exs. F-J to prove that the original POLICE GAZETTE ceased publication in 1977 (12 TTABVUE 18-25). Although Petitioner conceded that “some library websites do mention an ‘Alexander Barrera’ as a National Police Gazette publisher,”

these sites indicate their information is from a “surrogate” copy of the “June 2010” issue (Ex. P). Surrogate here means the copy of the magazine they received is not an original.

This June 2010 issue is a fraudulent one posted by the Respondent on the website issuu.com on June 29, 2010[.]

12 TTABVUE 6.

In response, Respondent argues that the “testimony and documentary evidence properly in the trial record contradicts Petitioner’s unsupported allegations,” 32

apparent knowledge of Petitioner’s alleged prior use, the claim fails because Petitioner has not established that Respondent believed Petitioner had superior rights to the subject mark. *See, e.g., Heaton Enter. of Nev., Inc. v. Lang*, 7 USPQ2d 1842 (TTAB 1988) (“Where, as in this case, the affiant believed and was claiming that it had a right to the mark superior to that of other parties who might be using it, fraud is not shown by proof that registrant was aware of those other uses.”).

TTABVUE 7, and as noted above, Respondent testified that he attached “true and correct” copies of the 2016 Declaration of Use and 2020 Combined Declaration of Use and Application for Renewal to his testimony declaration, stating: “I [Edgar Alexander Barrera] affirm the statements made therein were true and accurate.” 24 TTABVUE 3.

A registration filed under Section 1 will not be granted unless and until the applicant files a verified statement, together with specimens, that it has used the mark in commerce. *See* Trademark Rules 2.56(a) and 2.59(a). “[S]tatements regarding specimens submitted in support of an application are certainly material to issuance of a registration.” *Hurley Int’l LLC v. Paul & Joanne Volta*, 82 USPQ2d 1339, 1346 (TTAB 2007) (citing *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1485 (Fed. Cir. 1986) (court found it material that specimen submitted for Section 9 renewal application was not currently in use and cancelled the registration for fraud)).

Registration No. 3662484 was filed on January 23, 2008 and issued on August 4, 2009 under Section 1(a), 15 U.S.C. 1051(a), alleging first use and use in commerce of January 2, 1977. As noted, Respondent filed with the Office verified statements, together with specimens, asserting that he was using the mark in commerce in 2016 and 2020. Although Respondent is silent against Petitioner’s claim that Respondent’s submission of “[d]igitally created images and computer illustrations,” 31 TTABVUE 18, establishes that the mark was not in use as of the application filing date, “the

very nature of the charge of fraud requires that it be proven ‘to the hilt’ with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party.” *Illyrian Imp.*, 2022 USPQ2d 292 at *40; *see also Chutter*, 2021 USPQ2d 1001 at *12 (“A party alleging fraud in the procurement or maintenance of a registration bears the heavy burden of proving fraud with clear and convincing evidence.”). Moreover, Petitioner has not demonstrated Respondent’s intent to deceive, a necessary element of the fraud claim. *Illyrian Imp.*, 2022 USPQ2d 292 at *41.

Based on the evidence of record before us,¹⁰ Petitioner has not proven by clear and convincing evidence that Respondent committed fraud in procuring or maintaining his registration.

Decision

Petitioner has failed to show that Respondent abandoned his mark or that he committed fraud in the execution or maintenance of the mark’s registration. We dismiss Petitioner’s abandonment and fraud claims and deny the petition for cancellation with prejudice.

¹⁰ Our findings and the result in this case are necessarily based on the evidence we have before us, which is regrettably quite sparse. We have carefully examined all the evidence in the record, including where appropriate that contained in the prior cancellation proceeding between the parties. We note Petitioner did not seek to cross-examine any of Respondent’s witnesses, which may have developed a fuller record with respect to the pleaded issues.