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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Hubcap Heaven, LLC
v.
Hubcap Heaven, Inc.

Concurrent Use No. 94001147

James N. Dresser of McGinn & Gibb PLLC for Hubcap Heaven, LLC.

Hubcap Heaven, Inc., pro se.¹

Before Seeherman, Chapman and Rogers, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

A concurrent use application was filed on October 13, 1995 by Hubcap Heaven (a Maryland partnership composed of Thomas J. Jackson and Paul R. Jackson), later assigned to Hubcap Heaven, LLC (a Maryland limited partnership), to register on the Principal Register the mark HUBCAP HEAVEN for services amended to read "wholesale and retail store,

¹ The excepted user, Hubcap Heaven, Inc., was represented by counsel throughout this case, including on the brief after trial. At that time the excepted user's attorney (Jonathan Cohen of

mail order, and on-line electronic catalog sales order services in the field of new, reconditioned and used automotive parts" in International Class 42.² The application is based on applicant's claimed date of first use and first use in commerce of January 1979. Applicant disclaimed the word "hubcap." Applicant seeks registration for the entire United States except for the area within a 50-mile radius around Metairie, Louisiana, the area within a 50-mile radius around Pittsburgh, Pennsylvania, the area within a 50-mile radius around Memphis, Tennessee, and the area within a 50-mile radius around Virginia Beach, Virginia, all of which are areas in which applicant believes Hubcap Heaven, Inc., with a business address in Orlando, Florida, uses the mark HUBCAP HEAVEN for the service of the sale of automotive hubcaps.

Also part of this proceeding is applicant's Registration No. 1803181 for the mark HUBCAP HEAVEN ("hubcap" disclaimed) for "automotive hubcaps, wheel covers, and wheels" in International Class 12. This registration issued November 9, 1993 to "Hubcap Heaven (Partnership)."³

Shutts & Bowen LLP) filed a request for permission to withdraw from representation, which was granted by the Board.

² The application (Serial No. 75005643) has been assigned to Hubcap Heaven, LLC. See Reel 1476, Frame 0754.

³ Registration No. 1803181; Section 8 affidavit accepted, Section 15 affidavit acknowledged; renewed. The registration has been assigned to Hubcap Heaven, LLC. See Reel 1476, Frame 0754.

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The claimed date of first use and first use in commerce is January 1979.

The Board instituted this concurrent use proceeding on August 9, 1999 with the party Hubcap Heaven, LLC (applicant) as the owner of concurrent use application Serial No. 75005643 and Registration No 1803181, and therefore in position of plaintiff; and Hubcap Heaven, Inc. (user or excepted user) as the excepted user named in applicant's concurrent use application, and therefore in position of defendant.

The excepted user filed an answer essentially denying applicant/registrant's right to a concurrent use registration, asserting that it has used the mark since 1981; that it has 22 stores and warehouses in several states; that it also operates a catalog business accessible on-line; that it owns nationwide rights in the mark for these goods and services; and that, if applicant is entitled to any registration, it should be limited to the area within a 50-mile radius of each of applicant's three stores in Hyattsville, Maryland, Marlow Heights, Maryland and Alexandria, Virginia.

The record consists of the pleadings; the file of applicant's application and the file of its registration; applicant's testimony, with exhibits, of (i) Thomas Jackson, one of applicant's partners, and (ii) Julie A. Albright, an

employee of applicant; and the excepted user's notice of reliance on applicant's responses to user's interrogatories.⁴

Both parties have briefed this case. The excepted user requested an oral hearing, but later (after user's attorney had withdrawn as counsel), by its president Floyd Davidson, withdrew its previous request for an oral hearing. We note that the request was in the form of a letter addressed to applicant's attorney of record; that user clearly indicated that it no longer desired an oral hearing (as opposed to user stating that it would not attend any scheduled oral hearing); and that applicant made no response thereto. Based thereon, the Board did not hold an oral hearing in this case.

Preliminary Matters

First, we determine the evidentiary matters raised in user's brief and applicant's reply brief on the case.

⁴ User's notice of reliance had included its own answers to applicant's interrogatories and the discovery deposition of user's president Floyd Davidson, taken by applicant. However, these two items were stricken by Board order dated May 11, 2001.

User's motion for permission to rely on portions of its president's discovery deposition was denied by Board order dated August 6, 2002.

Applicant's motion to strike Exhibit No. 1 attached to user's brief on the case was granted by Board order dated August 6, 2002.

User's motion to strike applicant's notice of reliance on applicant's answers to user's discovery requests was granted by Board order dated August 6, 2002.

In its brief (pp. 16-19), user objects to the following exhibits to Thomas Jackson's testimony: (i) Exhibit No. 2 (a copy of a 1993 letter from applicant's landlord) as hearsay and not authenticated; (ii) Exhibit Nos. 3-6 (photocopies of photographs) because they are copies, not originals and because the witness relied on the dates on the backs of the photographs without making the backs part of the record when the photographs were photocopied; and (iii) Exhibit Nos. 27-34 (photocopies of newspaper articles) because they are hearsay and they are not admissible under Fed. R. Evid. 803(16) as documents over 20 years old.

It is clear from user's arguments that most of its objections relate more to the weight to be accorded the evidence than to its admissibility. For example, although the newspaper articles cannot be considered for the truth of the matters asserted therein, the fact of publication and the publication dates of such articles are proper evidence. User's objections are overruled and all exhibits to the Thomas Jackson testimony have been considered and accorded the probative value to which they are entitled.

Applicant requested in its reply brief (p. 7) that the Board take judicial notice that the town of Ruckersville, Virginia "is more than 180 miles from Virginia Beach, Virginia," and applicant attached photocopies of two pages from a Rand McNally Road Atlas. Such information is proper

subject matter for judicial notice and we hereby grant applicant's request. See *Pinocchio's Pizza v. Sandra Inc.*, 11 USPQ2d 1227, footnote 6 (TTAB 1989). See generally, TBMP §704.12 (2d ed. rev. 2004).

We note also that in its reply brief, applicant commented as follows (p. 11): "[Applicant] may well deserve a registration for the entire United States." Applicant offered no amendment to its pending concurrent use application to delete the named exception to applicant's exclusive right to use the mark. Accordingly, applicant's comment will be given no further consideration by the Board.

Concurrent Use Proceedings/Burden of Proof

As explained in the TBMP §1108 (2d ed. rev. 2004):

The issue to be determined in a concurrent use proceeding is the entitlement of the concurrent use applicant(s) to the registration(s) sought, and the extent, if any, to which every other involved application or registration should be restricted as a result thereof. The Board does not determine the right to registration of a party that is included in the proceeding only as a common law concurrent user, i.e., a party that does not own an involved application or registration...

The Court of Custom and Patent Appeals (a predecessor to our primary reviewing Court -- the Court of Appeals for the Federal Circuit) stated that the two requirements to obtain a concurrent registration are that (i) the parties be entitled to concurrently use the mark in commerce, and (ii)

there be no likelihood of confusion, mistake or deception in the marketplace as to the source of the goods or services. In re Beatrice Foods Co., 429 F.2d 466, 166 USPQ 431, 435, 436 (CCPA 1970).

Analysis -- Facts and Law

Applicant's predecessor partnership started the HUBCAP HEAVEN business in early 1979 following a huge snowstorm in the Washington DC area, resulting in roads with potholes which in turn resulted in hubcaps all over the roadside. (Jackson, dep., pp. 9-13, Exhibit No. 26.) Three brothers, Thomas, Paul and Carl Jackson, collected up to 800 hubcaps and began to sell them on a street corner near a carwash (where their sister worked) in Marlow Heights, Maryland. They then began to buy hubcaps from junkyards, road crews, and from collections advertised in newspapers. Soon they hired a night watchman; and in 1984 they moved from a trailer in Marlow Heights, Maryland to a leased building in Suitland, Maryland. (Jackson dep., Exhibit No. 8; applicant's answer to user's interrogatory No. 15.) Ultimately applicant expanded with two additional stores -- in Alexandria, Virginia and Hyattsville, Maryland (opening in 1991 and 1996, respectively). (Applicant's answer to user's interrogatory No. 13.)

Applicant placed an advertisement for its HUBCAP HEAVEN store in the 1980 yearbook of the La Reine Catholic Girls

School (Exhibit No. 11). It also placed ads in a 1996 Holy Family Parish Community church bulletin (Exhibit No. 12). Applicant now purchases listings in the "yellow pages" directories for the Northern Virginia, suburban Maryland, and Washington DC areas; and it advertises on cable television networks in Maryland, Washington DC and Virginia. Mr. Jackson testified that he did not know how far into Virginia the television stations would be received. (Dep., p. 29.) Another method of advertising by applicant is through "Val-Pak," which is a collection of coupons from various local businesses that are mass-mailed to large blocks of homes in a community. Applicant also puts out a catalog (a wheel and hubcap identification guide), which is distributed on the East Coast. About 10,000 copies of the 1999/2000 edition were distributed in states from South Carolina to New York. (Jackson dep., pp. 42 -44, Exhibit Nos. 24 and 25.)

Applicant has a website (www.hubcapheaven.com), from which it has received orders for its products. Applicant's website states on the first page:

Hubcap Heaven, LLC®
Established in 1979
With retail locations in the Washington DC, Maryland
and Virginia areas...
Shipments are processed daily throughout the United States
and Canada via UPS.

Mr. Jackson testified as to five orders received over the Internet from persons in Laramie, WY, Framingham, MA,

Mediapolis, IA, Ruckersville, VA and Roswell, GA. (Jackson dep., pp. 38-41, Exhibit Nos. 18 and 23.)

As previously explained, applicant owns geographically unrestricted Registration No. 1803181 issued in 1993 for the mark HUBCAP HEAVEN for goods. In its current application applicant named the locations of four of user's stores (Metairie, Louisiana, Pittsburgh, Pennsylvania, Memphis, Tennessee and Virginia Beach, Virginia)⁵ as exceptions to applicant's otherwise exclusive right to use the mark HUBCAP HEAVEN for its identified services, because user assertedly used the mark HUBCAP HEAVEN in those four locations prior to November 15, 1990, the filing date of the application which matured into applicant's involved Registration No. 1803181.

The record is devoid of evidence relating to user and the extent of its use of the mark HUBCAP HEAVEN. User's argument that it uses the mark in many cities and states in addition to the four cities recited by applicant is therefore unsupported in the record.⁶ User also argues that because it is applicant's burden to demonstrate that

⁵ We note that in user's answer it included an exhibit which is a list of 20-plus store and warehouse locations. No evidence as to any of these locations was ever made of record.

Exhibits to pleadings (with one exception not relevant here) are not evidence on behalf of a party. See Trademark Rule 2.122(c).

⁶ Statements made in pleadings cannot be considered as evidence in behalf of the party making them; such statements must be established by competent evidence during the time for taking testimony. See *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); and *Times Mirror Magazines, Inc. v. Sutcliff*,

applicant is entitled to a concurrent use registration, see Trademark Rule 2.99(e), it is also applicant's burden to show the extent of user's use. This is patently absurd. It is obviously user who has the best information as to the nature and extent of its own use and its territory of use. This is particularly true because user claims rights greater than those acknowledged by the concurrent use applicant.

User could have put in evidence to establish its dates of first use and its area(s) of use of the mark for its goods and/or services, but user did not do so. As the Board stated in *Pinocchio's Pizza v. Sandra Inc.*, 11 USPQ2d 1227, 1228 (TTAB 1989):

As a general rule, a prior user of a mark is entitled to a registration covering the entire United States limited only to the extent that the subsequent user can establish that no likelihood of confusion exists and that it has concurrent rights in its actual area of use, plus its area of natural expansion.⁷

205 USPQ 656 (TTAB 1979). See also, TBMP §704.06(a) (2d ed. rev. 2004).

Factual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial. See *BL Cars Ltd. v. Puma Industria de Veiculos S/A*, 221 USPQ 1018 (TTAB 1983); and *Abbott Laboratories v. TAC Industries, Inc.*, 217 USPQ 819 (TTAB 1981). See also, TBMP §704.06(b) (2d ed. rev. 2004).

⁷ We note that user requested in amended paragraph 5 of its answer to the concurrent use proceeding, that if the concurrent use application is allowed at all, that applicant's territory be restricted to a 50-mile radius around each of the three cities where applicant has stores. This is inappropriate as explained in *Pinocchio's Pizza v. Sandra Inc.*, supra. (In any event, user has put nothing in the record that would support granting such a request.)

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User has not established any date of use, but even if we accepted user's pleaded date of 1981 from its answer

(which we cannot do), applicant has established use of the mark HUBCAP HEAVEN prior to 1981. Applicant has therefore met the "jurisdictional requirement" or "condition precedent" of its lawful use in commerce outside of the conflicting claimant's area. See *Gray v. Daffy Dan's Bargaintown*, 823 F.2d 522, 3 USPQ2d 1306, 1308 (Fed. Cir. 1987).⁸

Turning then to the question of whether a likelihood of confusion exists because of concurrent use by the parties in common territories, we note that there is nothing in the Trademark Act or the Trademark Rules of Practice that prohibits a party who is the first user and the first registrant (and whose registration is unrestricted) from seeking a geographically restricted registration. More

⁸ Priority is not generally an issue in concurrent use proceedings, at least not in the same way that it is an issue in opposition and/or cancellation proceedings. Generally, the question only arises insofar as a concurrent use applicant must, as a jurisdictional requirement (or "condition precedent"), establish use in commerce prior to the application filing date of any defendant in the concurrent use proceeding. See *In re Beatrice Foods*, supra; *Gray v. Daffy Dan's Bargaintown*, supra. In this case, because the defending user does not have a federal application or registration, applicant's use obviously is "prior to" any theoretical future filing by user.

On a related issue, we note that, because the defending user does not have an application or registration before us, our decision will not establish its rights, if any, to a concurrent use registration. (The Board is empowered only to determine the right to register. See Sections 17, 18 and 24 of the Trademark Act, 15 U.S.C. §§1067, 1068 and 1092). Therefore, defendant had no duty or burden at trial to prove the extent of its rights except insofar as such proof would suffice to circumscribe those rights claimed by applicant. By our observations herein we do not suggest that user had any greater burden than that which it assumed by contesting applicant's claims.

importantly, there is no clear and unambiguous evidence of use of the mark by both parties in the same geographical area. Again, user had the opportunity to submit evidence to establish actual concurrent use in the same territory by both parties, but it failed to properly submit competent evidence of this.

While user argues that applicant's own evidence establishes that there is use in "overlapping geographical areas," we disagree. The record (e.g., the testimony of Mr. Jackson and applicant's answer to user's interrogatory No. 8) is ambiguous regarding the question of whether applicant operates in any portion of user's named territories (a 50-mile radius around each of four separate cities). Although applicant answered an interrogatory that the goods "have been marketed and distributed" throughout the United States, there is no evidence of current nationwide distribution of the goods (other than through the Internet which is more fully discussed below). Applicant's stores are located in three cities -- Suitland, Maryland, Hyattsville, Maryland and Alexandria, Virginia. The testimony of Mr. Jackson regarding the distribution area of applicant's advertisements and catalogs does not clearly include distribution in the excepted user's four named cities, as set forth by applicant in its application.

We acknowledge that the juxtaposition, on the one hand, of use of a mark on the Internet, and on the other hand, the seeking of a geographically restricted registration is troubling. Indeed, in the age of the Internet, concurrent use registrations premised on geographically distinct uses appear to be a legal fiction as the Internet is accessible not only nationwide but world-wide. However, there is little judicial precedent or guidance as to the effect on either trademark infringement suits or on concurrent use proceedings of use by parties on Internet websites. In *Allard Enterprises Inc. v. Advanced Programming Resources*, 249 F.3d 564, 58 USPQ2d 1710, 1717 (6th Cir. 2001) the Court stated the following:

We also vacate the district court's injunction against Allard's use of the APR mark on the internet. Although we have held that APR has superior rights to use the mark, at a minimum, in central Ohio we decline to affirm the district court's conclusion that an injunction prohibiting Allard's use of the mark in a specific geographic area necessarily precludes any use of the mark by Allard on the internet. ...

We suggest that, due to the paucity of case law addressing concurrent trademark rights and internet use, the district court may want to consider cases addressing the role of national advertising by parties with concurrent trademark rights. Courts have held in some cases that, despite a concurrent user with a territory of exclusive use, an almost-national user should be permitted some form of national advertising. See 4 McCarthy § 26:46.

The Board declines to establish or assert an absolute prohibition on the issuance of geographically restricted registrations when the evidence shows that one or more of the parties to a concurrent use proceeding does business on the Internet. Cases, as always, must be decided on the basis of their individual facts. Here, there is no evidence of applicant achieving sales to consumers in any of user's four excepted territories. Moreover, consumers are becoming more computer and Internet-savvy and they are likely to understand how business is done on the Internet. Thus, the fact that a business has a website does not necessarily mean to consumers that the business is a nationwide business.

In the situation now before us, there is a prior user and prior registrant (applicant) who apparently determined after it obtained Registration No. 1803181 for the mark HUBCAP HEAVEN for goods, and before it applied for the mark for services, that its right to registration was subject to whatever rights user had in the mark HUBCAP HEAVEN for its goods and/or services offered in the cities of Metairie, Louisiana, Pittsburgh, Pennsylvania, Memphis, Tennessee and Virginia Beach, Virginia, as of November 15, 1990. Because of user's possible rights in those cities, applicant "concedes [user] the rights to the mark in those locations." (Reply brief, p. 2.)

There is no evidence that user's use is superior in any area other than those four cities conceded by applicant to user. There is no unambiguous evidence that applicant uses or advertises its mark in any of user's four cities named herein. Based on this record, we find that applicant has established "jurisdictional" priority and that there is no likelihood of confusion, notwithstanding that applicant does business on the Internet.

Decision:

Application Serial No. 75005643: The party Hubcap Heaven, LLC (applicant) is entitled to the registration of its mark HUBCAP HEAVEN for "wholesale and retail store, mail order, and on-line electronic catalog sales order services in the field of new, reconditioned and used automotive parts" for the area comprising the entire United States except for the area within a 50-mile radius around Metairie, Louisiana, the area within a 50-mile radius around Pittsburgh, Pennsylvania, the area within a 50-mile radius around Memphis, Tennessee, and the area within a 50-mile radius around Virginia Beach, Virginia.

Registration No. 1803181: This registration, owned by Hubcap Heaven, LLC, will be restricted to the area comprising the entire United States except for the area within a 50-mile radius around Metairie, Louisiana, the area

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within a 50-mile radius around Pittsburgh, Pennsylvania, the area within a 50-mile radius around Memphis, Tennessee, and the area within a 50-mile radius around Virginia Beach, Virginia.