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PRECEDENT OF THE TTAB 9/4/97

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Dale A. Marschke
v.
Raewiks, Inc. & Global Textile Elite, Inc.

Cancellation No. 20,503

Don B. Finkelstein of Ladas & Parry for Dale A. Marschke.

Philippe Y. Riesen of Bogle & Gates for Raewiks, Inc. &
Global Textile Elite, Inc.

Before Cissel, Hanak and Quinn, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

In February 1992 Dale A. Marschke (petitioner) filed a
petition for cancellation of Registration No. 1,412,446 then
owned by Raewiks, Inc. (registrant).¹ This registration
issued on October 7, 1986 with a claimed first use date of
September 3, 1985. The mark of the registration is RIVER

¹ On October 5, 1994 Raewiks, Inc. assigned Registration No.
1,412,446 to Global Textile Elite, Inc. In an order dated
December 9, 1994 this Board joined Global Textile Elite, Inc.
with Raewiks, Inc. as the defendants herein. For ease of
reference, the term "registrant" will be used to refer
collectively to Raewiks and Global Textile Elite.

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RUN depicted in typed capital letters, and the goods of the registration are "clothing for skiing, hunting and fishing, namely jackets, vests, pants, overalls and one piece suits."

Petitioner alleged in its cancellation petition that continuously since March 1983 (i.e. prior to registrant's first use date of RIVER RUN), petitioner had used RIVER RUN on t-shirts and jewelry pins; that petitioner applied to register RIVER RUN for these goods with PTO, but was denied registration on the basis that its mark is likely to cause confusion with the mark of Registration No. 1,412,446; and that while "petitioner denies that there is any likelihood of confusion," nevertheless "petitioner is now and will continue to be damaged by the continuous registration of registrant's Registration No. 1,412,446 for the mark RIVER RUN." Continuing, petitioner alleged "that registrant has abandoned all use of the mark RIVER RUN for the goods set forth in said registration ... for more than two years preceding this petition for cancellation ... [and that] registrant has no intent to resume any use of the mark RIVER RUN."

In its answer, registrant denied "that it abandoned use of the mark RIVER RUN." Registrant stated that this mark had been continuously used by registrant since September 1985. Registrant also set forth two affirmative defenses.

However, in a paper dated June 12, 1992, registrant explicitly withdrew these two affirmative defenses.

The record in this case includes the depositions, with exhibits, of the petitioner Dale A. Marschke; Cheryl A. O'day (a legal secretary employed by petitioner's law firm); Jason Ou (president of registrant); Kevin Cook (general manager of registrant); Ronald S. Bodner (operations manager of registrant); and Victoria Chin (a former bookkeeper for registrant).²

Both parties filed briefs. Neither party requested an oral hearing.

The only issue before this Board is whether petitioner has proven that registrant abandoned its mark RIVER RUN through non-use. Registrant has never challenged petitioner's standing to bring the petition for cancellation.

In this "cancellation [proceeding] for abandonment, as for any other ground, the petitioner bears the burden of proof." Cerveceria Centroamericana v. Cerveceria India, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989). To be quite blunt, petitioner has totally failed to prove that

² In an order dated January 12, 1995, this Board denied registrant's motion to reopen its testimony period and further stated that "the deposition taken [by registrant] of Mr. [Gary]

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registrant discontinued use of RIVER RUN for any period of time from September 1985 (registrant's claimed first use date) through the close of the testimony period in this case. While it was under no obligation to do so, registrant has proven through the testimony of its witnesses that it has continuously used RIVER RUN on various apparel items continuously since 1985. The testimony of registrant's witnesses is substantiated by significant documentation showing sales of RIVER RUN apparel by registrant for each of the years from 1985 through 1993, the close of the testimony period in this case.

We will quickly review petitioner's "evidence" which it contends demonstrates that the registrant abandoned use of registrant's RIVER RUN trademark. Petitioner Dale Marschke testified that he had never personally seen any clothing items (other than his own) "which borrow the mark RIVER RUN." (Marschke deposition 57). The fact that Mr. Marschke was personally unaware of any use of RIVER RUN by registrant or others in no one way demonstrates that registrant was not using RIVER RUN for apparel.

The second bit of evidence which petitioner relies upon involves a phone call made by Ms. O'day (a legal secretary in the employee of petitioner's counsel) to registrant

Koprivica on November 11, 1994 will be disregarded by the Board."

Raewiks on January 20, 1992, approximately one month prior to the filing of the petition for cancellation. Ms. O'day called Raewiks under the false pretense that she was looking for RIVER RUN clothing. Purportedly, the person who answered the phone at Raewiks stated "that they were no longer using that mark." (O'day deposition 4-5). We find Ms. O'day's testimony to be quite vague and entitled to virtually no consideration. Ms. O'day conceded that she did not obtain the name of the person with whom she purportedly spoke (O'day deposition 10), and that she did not obtain the job title of the person with which whom she purportedly spoke (O'day deposition page 11). Moreover, we are unable to ascertain from Ms. O'day's testimony precisely what question(s) she posed to this unidentified person at Raewiks. At one point, Ms. O'day stated that she informed this person that she (Ms. O'day) "was looking for more clothing, since I was given a jacket." (O'day deposition 4). However, Ms. O'day's notes of her telephone conversation (Exhibit 228) read, in their entirety, as follows: "Called Raewiks & asked if RIVER RUN apparel still available. Was informed that RIVER RUN has not been made for a long time - they 'have something else now.'"

In considering Ms. O'day's testimony, it must be remembered that Raewiks was not a retailer of apparel. Raewiks imported apparel from the Far East with various

labels affixed to the apparel, including RIVER RUN. Raewiks then had delivered to its retail customers in the United States apparel bearing the RIVER RUN trademark. Ms. O'day conceded that in making the January 20, 1992 telephone call to registrant Raewiks, she falsely "wanted the person [at Raewiks] to think it was a personal call." (O'day deposition 12-13). Ms. O'day never identified herself as a representative of a retailer desirous of purchasing RIVER RUN apparel. Thus, it could well be that this unidentified person at Raewiks who answered Ms. O'day's telephone call simply conveyed the notion that Raewiks did not offer RIVER RUN apparel to individual consumers, which is true.

The foregoing testimony of Mr. Marschke and Ms. O'day represents the totality of "evidence" put forth by petitioner in effort to show that registrant had discontinued use of the mark RIVER RUN for apparel. Obviously, this "evidence" totally fails to establish that registrant at any time discontinued use of its RIVER RUN trademark.

As previously noted, while registrant was not under an obligation to establish that it had used its RIVER RUN trademark continuously since 1985, in point of fact, it did so. Registrant Raewiks was founded by Jason Ou in November 1983. (Ou deposition 3). Mr. Ou testified with great specificity that registrant Raewiks continuously used the

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mark RIVER RUN in conjunction with apparel for each and every year from 1985 to 1993. (Mr. Ou's deposition was taken on September 29, 1993). In addition, registrant produced over 2,000 pages of documentation (exhibit 1) showing that for each and every year from 1985 to 1993, it imported from the Far East apparel bearing the trademark RIVER RUN and that it in turn sold such apparel bearing the trademark RIVER RUN to retailers in the United States. At page 12 of its brief, petitioner makes the perplexing statement that "none of those documents [in Exhibit 1] shows importation of a RIVER RUN article of clothing during at least 1986, 1987 and 1988." In point of fact, registrant Raewiks produced numerous documents showing that it imported from the Far East apparel bearing its RIVER RUN trademark for each of those three years, as well as for each of the years from 1985 to 1993.

Finally, petitioner makes the totally unsubstantiated contention that "there is no competent evidence indicating that subsequent to 1986 registrant did make proper use of the [RIVER RUN] mark." (Petitioner's brief pages 12-13). In point of fact, registrant Raewiks provided copies of labels bearing its RIVER RUN trademark which were sewn onto the various apparel items which it sold in the United States (exhibit 1, R1). These labels clearly reflect proper trademark usage.

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Decision: The petition for cancellation is granted.