

Hearing:
January 29, 1998

Paper No.
HANAK/md

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JUNE 29, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Lite Breeze, Inc.

v.

Venator Group Retail, Inc. (formerly
Kinney Shoe Corporation).

Opposition No. 99,389
to application Serial No. 74/801,684
filed on July 13, 1992.

Peter K. Kahn of Luce, Forward, Hamilton & Scripps for Lite,
Breeze, Inc.

Martin F. Majestic and J. Suzanne Siebert of Majestic,
Parsons, Siebert & Hsue for Venator Group Retail, Inc.

Before Cissel, Hanak and Quinn, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Venator Group Retail, Inc. (Venator or applicant) seeks to register THE ZONE and design in the form shown below for "men's and women's clothing, specifically t-shirts, sweat shirts and underwear." This "child" application was originally part of a "parent" application (Serial No.

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74/293,422) filed on July 13, 1992 by Peter DePlacido, who subsequently changed his name to Peter Deep (Deep). As originally filed, the "parent" application listed the following goods and services: "Pharmaceutical -- condoms, adult toys"; "entertainment -- bars, discos, book stores, sex clubs"; and "men's and women's clothing, specifically t-shirts, sweat shirts, underwear." As to all of the goods and services in the "parent" application, Mr. Deep claimed that the mark was first used anywhere and in commerce which the U.S. Congress may regulate on June 1, 1991.

On January 31, 1994 Mr. Deep's attorney filed a request that the men's and women's clothing, specifically t-shirts, sweat shirts and underwear be "divided out" of the "parent" application. This request was granted by the PTO on March 16, 1994 and the application to register THE ZONE and design for "men's and women's clothing, specifically t-shirts,

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sweat shirts and underwear" was assigned application Serial No. 74/801,684 (the "child" application).

Between January 31, 1994 and March 16, 1994, Mr. Deep assigned on February 9, 1994 all of his rights in the mark THE ZONE and design as well as the "parent" application Serial No. 74/293,422 to Sports, Inc. Subsequently, Sports, Inc. assigned the mark THE ZONE and design as well as the "child" application Serial No. 74/801,684 to Venator, which was then known as Kinney Shoe Corporation.

On October 16, 1995 Lite Breeze, Inc. (Lite Breeze or opposer) filed a notice of opposition against the "child" application (Serial No. 74/801,684). Lite Breeze alleged that prior to any use of the mark THE ZONE and design by the owner of application Serial No. 74/801,684, Lite Breeze used its mark IN THE ZONE on shorts, t-shirts, tank tops, sweat shirts and sweat pants. Continuing, Lite Breeze alleged that the use and registration of THE ZONE and design by the owner of application Serial No. 74/801,684 would result in confusion, mistake and deception. In addition, in paragraph 5 of the notice of opposition, Lite Breeze made the following allegation: "Opposer [Lite Breeze] believes that applicant [then Kinney Shoe Corporation] has not made actual or constructive use of the mark THE ZONE prior to July 22, 1992."

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Venator (then Kinney Shoe) filed an answer which denied the pertinent allegations of the notice of opposition.

Both Venator and Lite Breeze have filed extensive briefs and were represented by counsel at a hearing held on January 29, 1998.

The record in this case includes, among other things, the testimony of Mr. Deep, David Kneprath (an owner of a printing company who did work for Mr. Deep), Dean Wolf (a former employee in the law firm representing Venator), Adam Tachner (an attorney and a former summer clerk at Venator's law firm) and Rodd A. Garner (president of Lite Breeze).

Both Lite Breeze and Venator are now in agreement that the contemporaneous use of IN THE ZONE and THE ZONE and design for clothing is likely to result in confusion. See Venator's brief page 4 and Venator's response to Lite Breeze's request for admission no. 3. We too agree that confusion is likely.

The parties are in further agreement that one issue before this Board is priority of use, namely, whether Lite Breeze first used IN THE ZONE or whether Venator through its predecessors in interest (Sports, Inc. and Mr. Deep) first used THE ZONE and design. According to applicant Venator, "this case can be very simply decided since the sole issue presented by the pleadings is whether opposer [Lite Breeze]

has shown by a preponderance of the evidence that it has priority of use." (Venator's brief page 4).

Lite Breeze, while agreeing that this is one of the issues in this proceeding, also argues that there are two additional issues, namely, whether (1) the application was void from the very beginning because as of the application of filing date (July 13, 1992) Mr. Deep (Venator's predecessor in interest) had not made any trademark use of THE ZONE and design, and whether (2) applicant and its predecessors in interest have abandoned the mark THE ZONE and design. (Lite Breeze's brief pages 10 and 11).

With regard to the purported issue of abandonment, it is Lite Breeze's contention that "there is no evidence in the record of any sales of clothing bearing the mark THE ZONE and design by any party after 1993. Accordingly, because there is no evidence that the [opposed] mark was used in 1994, 1995 or 1996, the [opposed] mark has presumptively been abandoned." (Lite Breeze's page 31).

We find that abandonment was not pled, nor was it tried by the consent of the parties. Moreover, we note that in his cross-examination of Mr. Deep, counsel for Lite Breeze questioned Mr. Deep extensively about his use of the mark THE ZONE and design during the years 1991, 1992 and 1993. However, Lite Breeze's counsel, for whatever reason, did not elect to question Mr. Deep regarding use of the mark THE

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ZONE and design by himself or anyone else during the years 1994 and 1995. (Deep deposition pages 194-195).

Accordingly, we will give no consideration to the purported issue of abandonment.

However, we find that the issue of whether the "child" application was void from the beginning due to Mr. Deep's failure to use the mark THE ZONE and design prior to the application filing date was pled in the notice of opposition (perhaps somewhat awkwardly) and was clearly tried by the consent of the parties. As previously noted, paragraph 5 of the notice of opposition reads as follows: "Opposer believes that applicant has not made any actual or constructive use of the mark THE ZONE prior to July 22, 1992." Of course, the application filing date for both the parent and the child application is July 13, 1992. In its brief, Venator acknowledges that it was well aware of the significance of paragraph 5, as witnessed by the following sentences taken from page 6 of Venator's brief:

"Nevertheless, applicant as an exercise of caution did take testimony so as to establish that its predecessor [Mr. Deep] had actually used the subject mark in interstate commerce prior to the July 13, 1992 filing date. This was done since paragraph 5 of the Notice of Opposition might suggest that opposer was seeking to have the Board view the subject application itself ..." Moreover, at the oral hearing counsel

for Venator conceded that the issue of whether the application was void as of the filing date of July 13, 1992 was tried by the consent of the parties.

Turning to the issue of priority of use, we begin our analysis by considering when opposer Lite Breeze first used its mark IN THE ZONE for clothing. Mr. Garner (president of Lite Breeze) testified that Lite Breeze -- a company based in San Diego, California -- first used its mark IN THE ZONE on t-shirts when it sold sixty of such shirts to Divers Sports Center of Manteno, Illinois on June 22, 1992. Mr. Garner testified that neither Lite Breeze nor he had any ownership interest in or other relationship with Divers Sport Center other than that of supplier and customer. (Garner deposition pages 10-11). Mr. Garner further testified that Lite Breeze had been continuously selling clothing bearing the mark IN THE ZONE from June 22, 1992 to the date of his deposition, namely, July 30, 1996. (Garner deposition pages 13 -14).

Mr. Garner's testimony contained no inconsistencies and it was supported by considerable documentary evidence. This evidence included approximately 100 invoices showing sales of IN THE ZONE clothing for each of the years 1992, 1993, 1995 and 1996. In addition, the documentary evidence included color pictures of approximately 10 different styles of shirts bearing the mark IN THE ZONE. Moreover, not only

did Lite Breeze introduce copies of its own catalogs which featured shirts, caps and shorts bearing the mark IN THE ZONE, but in addition, opposer made of record third-party literature which depicted the mark IN THE ZONE on applicant's t-shirts and which offered said t-shirts for sale. One such piece of third-party literature was produced by the sponsors of The Fall Classic baseball tournament held at the Prince William [Virginia] Stadium Complex on October 2, 3 and 4 1992. (Opposer's exhibit 8).

In short, Mr. Garner's clear and consistent testimony supported by substantial documentary evidence convinces us that Lite Breeze has made continuous use of its mark IN THE ZONE in connection with clothing since June 22, 1992.

At this point one matter deserves clarification. At pages 4-6 of its brief, Venator argues that Lite Breeze's earliest first use date cannot be prior to July 22, 1992 because Lite Breeze admitted Venator's request for admissions nos. 1-3, which, in essence, ask that opposer Lite Breeze admit that it did not make use of IN THE ZONE or ZONE before July 22, 1992. Lite Breeze's "admissions" were served on Venator on January 25, 1996.

On June 13, 1997 opposer filed a motion to correct its responses to Venator's request for admission nos. 1-3. In this regard, it is noted that Venator's brief arguing that Lite Breeze is bound to a first use date of no earlier than

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July 22, 1992 was served by first class mail on Lite Breeze's counsel on May 29, 1997. In support of its motion to correct its responses to request for admissions 1-3, Lite Breeze attached the declaration of its counsel Peter K. Hahn who stated that he "mistakenly misread the requests and believed the critical date referred to in the requests to be June 22, 1992, not July 22, 1992" and that he "first became aware that [he] had misread the critical dates in the requests for admission when [he] read the applicant's brief [served by mail on May 29, 1997]." Lite Breeze points out in its motion to correct that in the very same document in which it answered request for admissions 1-3, it also answered Venator's interrogatory no. 4, in part, as follows: "To the extent the interrogatory is understood, opposer [Lite Breeze] identifies Lite Breeze, Inc. Invoice No. 1229, dated June 22, 1992, in response to customer order No. PO#158 for the shipment 60 'IN THE ZONE t-shirts with blocked logo' for sales to customer in Manteno, Illinois." (emphasis added).

Opposer's motion to correct its answers to request for admissions nos. 1-3 is hereby granted. We grant the motion primarily for the following reason. As previously noted, opposer Lite Breeze served its responses to request for admissions nos. 1-3 as well as its response to interrogatory no. 4 in the same paper dated January 25, 1996.

Approximately six months later Mr. Garner's testimony deposition was taken on July 30, 1996. Venator's counsel -- Martin F. Majestic -- was present at that deposition. On direct examination, Mr. Garner testified as follows at page 9:

Q. Okay. If we can start talking a little bit about your use of the mark and when that was initiated. Do you remember when you made your first sale of a clothing product bearing the mark IN THE ZONE?

A. The first sale was made on June 22nd, 1992. The actual sale may have taken place a week or ten days earlier. But the shipping date would be June 22nd of '92.

After that question and answer, the invoice identified in Lite Breeze's response to Venator's interrogatory no. 4 was marked as exhibit 2 and introduced into evidence. Said invoice clearly bore the date June 22, 1992 in the upper right hand corner, and, as previously noted, it reflected the sale by Lite Breeze of sixty IN THE ZONE t-shirts to Divers Sports Center of Manteno, Illinois. Thereafter, Mr. Majestic extensively cross-examined Mr. Garner. Indeed, the cross-examination filled over 100 pages of deposition transcript. However, not once did Mr. Majestic in any manner whatsoever inquire of Mr. Garner as to the discrepancy between his testimony that Lite Breeze first used the mark IN THE ZONE at least as early as June 22, 1992

and Lite Breeze's responses to Venator's request for admissions 1-3, which requests used the date July 22, 1992. Indeed, in his extensive questioning of Mr. Garner, Mr. Majestic never asked questions that in any way probed the accuracy or veracity of Mr. Garner's claim that Lite Breeze first used its mark IN THE ZONE at least as early as June 22, 1992. Primarily because of Mr. Majestic's conduct during the deposition of Mr. Garner, we hereby grant Lite Breeze's motion to correct its answers to Venator's request for admissions 1-3.

We note that in its papers in opposition to Lite Breeze's motion to correct, Venator makes much of the fact that Lite Breeze's motion to correct was not filed until after the trial in this case had been concluded. However, what Venator fails to note is that its counsel had the full opportunity to cross-examine Mr. Garner on any purported inconsistency between the dates of June 22, 1992 and July 22, 1992 when Mr. Garner's testimony deposition was taken on July 30, 1996, approximately six months after Lite Breeze erroneously answered Venator's request for admissions 1-3. Moreover, it cannot be said that Mr. Majestic would have been totally surprised by the testimony of Mr. Garner given the fact that in the very same paper in which it erroneously answered opposer's request for admissions 1-3, Lite Breeze also answered in response to interrogatory no. 4 that it

first used its mark IN THE ZONE on June 22, 1992. In short, confronted with the clear and consistent testimony of Mr. Garner which was backed by substantial documentation showing continuous sales of IN THE ZONE t-shirts by Lite Breeze since at least as early as June 22, 1992, Mr. Majestic elected to simply remain silent.

In any event, whether we find Lite Breeze's first use date of IN THE ZONE to be June 22, 1992 or July 22, 1992 is of no consequence because, as we will explain next, the record does not demonstrate that Venator's predecessor Mr. Deep made any trademark use of THE ZONE and design on any clothing prior to either of the foregoing two dates.

We now turn to an analysis of when Mr. Deep, Venator's predecessor in interest, first used the applied for mark THE ZONE and design. As previously noted, applicant Venator has relied upon the testimony of four individuals: Peter Deep, David Knepprath, Adam Tachner and Dean Wolf. The testimony of Mr. Tachner and Mr. Wolf, while quite interesting, relates entirely to events occurring after 1992 and thus has no bearing on the issues of priority of use or whether the opposed application was void from the beginning for failure to make use of the applied for mark on or before the filing date of July 13, 1992. Thus, applicant Venator's claim of priority rests entirely upon the testimony of Mr. Deep and the stipulated testimony of David Knepprath contained in a

two page declaration. Because Mr. Knepprath was called as a testimonial witness by applicant Venator, we presume that his two page declaration was carefully scrutinized by counsel for Venator.

To cut to the quick, we find that Mr. Deep's actions in connection with his efforts to register THE ZONE and design coupled with his statements and demeanor in his deposition demonstrate that said deposition testimony is simply lacking in credibility. As for Mr. Knepprath's stipulated testimony, we note that in reality, said testimony not only does not support Venator's contention that, through its predecessor Mr. Deep, it was the first to use the mark THE ZONE and design, but in addition, the stipulated testimony of Mr. Knepprath undermines the testimony of Mr. Deep.

We turn now to the stipulated testimony of Mr. Knepprath. Mr. Knepprath testified that he is the owner of a t-shirt printing company and that one of his customers is Mr. Deep. Mr. Knepprath testified that he located two invoices reflecting sales of t-shirts from himself to Mr. Deep. One of the invoices had an order date of January 24, 1992 and the other invoice had an order date of March 18, 1993. Mr. Knepprath's testimony is quite interesting in that he states that Mr. Deep placed orders for t-shirts having either one of two marks, namely, ZONE per se or THE ZONE. Mr. Knepprath then goes on to note that the January

24, 1992 order was for t-shirts bearing the mark ZONE per se, and not the mark THE ZONE, much less the applied for mark, namely, THE ZONE and design. Mr. Kneprath then states that the order of March 18, 1993 (long after Lite Breeze's well established first use date) was for t-shirts "having as project designation 'The Zone.'" On at least two other occasions in his stipulated testimony, Mr. Kneprath made distinctions between orders from Mr. Deep when the mark requested was, on some occasions, ZONE per se and was, on other occasions, THE ZONE. Of course, inasmuch as Mr. Kneprath's declaration was presumably very carefully reviewed by Venator's counsel, his repeated distinction between the marks ZONE per se and THE ZONE is quite telling. Moreover, nowhere in his declaration did Mr. Kneprath state that he ever prepared and sold to Mr. Deep t-shirts bearing the applied for mark, namely, THE ZONE and design.

Thus, not only does Mr. Kneprath's testimony regarding the sale on January 24, 1992 of t-shirts to Mr. Deep bearing the mark ZONE per se not support any use by Mr. Deep of the mark THE ZONE and design, but in addition it contradicts Mr. Deep's sworn testimony that it was the mark THE ZONE which appeared on the t-shirts which came as a result of the January 24, 1992 order. (Deep deposition page 14).

However, even more damaging to Venator's position is the fact that the invoice for the January 24, 1992 order

reflects that Mr. Knepprath charged Mr. Deep sales tax, whereas the invoice for the much later order of March 19, 1993 reflects that Mr. Knepprath did not charge Mr. Deep sales tax. In its brief, Venator never takes issue with Lite Breeze's contention at page 23 of its brief "that the January 1992 purchase invoice indicates the shirts were not for resale by showing the sale to be taxable." Mr. Deep testified that he did not know what percentage of the t-shirts that he ordered "were given to [his] employees for [use as] uniforms." (Deep deposition page 87). Had Mr. Deep truly been selling t-shirts bearing the mark ZONE in January 1992, it is surprising that he would elect to pay a sales tax when apparently even counsel for Venator concedes that he did not have to. A more plausible explanation is that THE ZONE or ZONE t-shirts delivered to Mr. Deep in 1991 and 1992 were for use by employees of Mr. Deep's private men's sex club called THE ZONE located on Sycamore Street in Los Angeles. (Deep deposition page 71). In short, we find that the stipulated testimony of Mr. Knepprath offered by applicant Venator not only does not support the proposition that Mr. Deep ever used the applied for mark THE ZONE and design on any type of apparel, but that in addition, the stipulated testimony of Mr. Knepprath actually contradicts portions of Mr. Deep's testimony.

Before concluding our discussion of Mr. Knepprath's testimony, one final comment is in order. While Venator argued (correctly) that the issue of abandonment was neither pled or tried, out of caution it discussed the merits of this claim at pages 19-25 of its brief. At page 23 of its brief, Venator argued that because Lite Breeze failed to answer request for admission no. 10, Lite Breeze admitted that "the mark IN THE ZONE for clothing is not a material alteration in character of the mark THE ZONE for clothing." In essence, Venator is arguing that it can "tack" Venator's own much later use of IN THE ZONE on to Mr. Deep's purported earlier use of THE ZONE.

Because Venator has raised the question of "tacking" (albeit in another context) and because Venator may wish to appeal this Board's decision, we will explain that should it be found that Mr. Deep used the mark ZONE per se or even THE ZONE prior to June 22, 1992 or July 22, 1992 that such uses cannot be tacked onto the later use by Mr. Deep (if any) of the applied for mark, namely, THE ZONE and design. In order to tack the use of an earlier mark onto the use of the applied for mark, "the previously used mark must be the legal equivalent of the mark in question or indistinguishable therefrom, and the consumer should consider both as the same mark." Van Dyne-Crotty Inc. v. Wear-Guard Corp., 926 F.2d 1156, 17 USPQ2d 1866, 1868 (Fed.

Cir. 1991). It has been repeatedly stated that the "tacking" of the use of one mark onto the use of a second mark for the purposes of establishing priority has only been permitted in "rare instances." American Paging Inc. v. American Mobilphone Inc., 13 USPQ2d 2036, 2038 (TTAB 1989), aff'd 17 USPQ2d 1726 (Fed. Cir. 1990). We find that neither the mark ZONE per se or even the mark THE ZONE are the legal equivalents of or indistinguishable from the applied for mark, namely, THE ZONE and design. Not only are the words in the applied for mark depicted in a decidedly stylized format, but in addition, the applied for mark has a prominent design element beneath the words consisting of a thick line running the entire length of the words. The word marks ZONE per se and THE ZONE are clearly distinguishable from the applied for mark, and neither is the legal equivalent of the applied for mark.

We now turn to a consideration of the testimony of Mr. Deep. This testimony was given in San Francisco on October 16, 1996 and in Eugene, Oregon on October 29, 1996. In both San Francisco and Eugene, Mr. Deep was represented by his own counsel, and not counsel for Venator. However, Mr. Deep conceded that he was being reimbursed for the fees of his counsel. (Deep deposition page 139).

Throughout his deposition, Mr. Deep displayed an extremely cavalier attitude; a very poor memory; and made

numerous flippant comments. For example, when asked if Venator (then Kinney Shoe) would reimburse him for his expenses in attending the deposition, Mr. Deep's answer was as follows: "There's hope, there's dreams, you know."

(Deep deposition page 110). Mr. Deep was then admonished by his own counsel to give counsel for Lite Breeze "a straight answer." At that point Mr. Deep stated as follows: "Yes, they [Kinney] have offered to reimburse me." Mr. Deep's counsel then stated as follows: "I know you [Mr. Deep] were kidding around, but he [Lite Breeze's counsel] needs a straightforward answer." (Deep deposition page 111). Later in his deposition, Mr. Deep's counsel stated as follows:

"Let me withdraw that flippant comment [made by Mr. Deep]." (Deep deposition pages 207-208). As another example, Mr.

Deep acknowledged that he was required to have a resale license in order to sell clothing from his private men's club called THE ZONE. (Deep deposition page 161). When asked if there was such a resale permit, Mr. Deep replied as follows: "It's my belief that they [the club] did. And if they didn't, whoop-de-doo." (Deep deposition page 162).

Moreover, Mr. Deep repeatedly showed a hostile attitude towards perfectly legitimate questions put to him by counsel for Lite Breeze. Mr. Deep accused Lite Breeze's counsel of being "childish." (Deep deposition page 186). Furthermore, in response to another legitimate question posed by Lite

Breeze's counsel, Mr. Deep shot back as follows: "You know, why don't you get your facts straight and call me back." At this point Mr. Deep's counsel -- exhibiting extreme patience and respect for this Board -- stated: "Mr. Deep, please -- please." (Deep deposition page 239).

As troubling as Mr. Deep's flippant and discourteous attitude is, even more troubling was the fact that Mr. Deep repeatedly equivocated in his answers. We will not attempt to even begin to repeat the numerous equivocations made by Mr. Deep. To say the least, Mr. Deep had repeated lapses of memory. When asked questions as to when he used the applied for mark in connection with clothing, a typical response of Mr. Deep was as follows: "I don't know anything for sure." (Deep deposition page 174).

Most shocking of all, Mr. Deep could not even recall "what entity actually owned and sold the t-shirts from the location at THE ZONE, the Sycamore location," nor could he recall "which company had a resale license prior to August of 1993." (Deep deposition page 114). It must be remembered that the parent application seeking to register THE ZONE and design was filed in the name of Peter DePlacido, now Peter Deep. However, in his October 1996 deposition Mr. Deep could not state that it was he personally who made sales of t-shirts or had a resale license prior to August 1993. Mr. Deep testified that he

simply did not know which entity made the sales or had the resale license. Mr. Deep speculated that it could have been such companies as 2 Peters Company, Community Investment Corporation, Deep Entertainment, Horizon Sound or, to use Mr. Deep's own words, "could have been anything." (Deep deposition page 114). This is particularly telling because even if we assume that some entity(s) sold t-shirts bearing the applied for mark in 1991 or 1992 at the private men's club called THE ZONE, Mr. Deep's application to register the mark THE ZONE and design would be void from the beginning unless it was Mr. Deep personally who made such sales or unless it was a licensee of Mr. Deep who made such sales.

As troubling as Mr. Deep's attitude and lack of recollection are, the most troubling aspect of Mr. Deep's testimony is its lack of candor. On June 10, 1991 Peter Deep (then Peter DePlacido) signed the parent application seeking to register THE ZONE and design for, as initially described, "pharmaceutical -- condoms, adult toys"; "entertainment -- bars, discos, book stores, sex clubs"; and "men's and women's clothing, specifically t-shirts, sweat shirts, underwear." (emphasis added). Mr. Deep signed the declaration with the warning "that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001." However, on cross-examination, Mr. Deep acknowledged that he never used the

mark THE ZONE and design in connection with a bar, a disco or a book store. (Deep deposition page 77). Moreover, even more pertinent to the "child" application, Mr. Deep acknowledged that he never used the applied for mark THE ZONE and design on sweat shirts, despite the fact that the application, after listing men's and women's clothing, specifically singled out sweat shirts, along with t-shirts and underwear. (Deep deposition page 99).

In addition, in his trademark and service mark application (the parent application), Mr. Deep declared that he used the applied for mark THE ZONE and design anywhere and in interstate commerce on June 1, 1991. However, on direct examination, Mr. Deep acknowledged that he did not even place an order for t-shirts bearing the mark THE ZONE until June 10, 1991. (Deep deposition page 10).

Furthermore, on cross-examination, Mr. Deep explicitly acknowledged that he had never used the applied for mark on any type of clothing on June 1, 1991. (Deep deposition page 100). Indeed, Mr. Deep acknowledged that the private men's club known as THE ZONE where Mr. Deep allegedly made his first sales of t-shirts bearing the applied for mark did not even open until July 27, 1991. (Deep deposition page 12).¹

¹ On November 27, 1996 (after Mr. Deep's October 1996 deposition), counsel for Venator filed a paper seeking to amend the "child" application to assert a first use date of the applied for mark of "at least as early as July 27, 1991"; to assert a first use date of the applied for mark in commerce of "at least

Mr. Deep's false statements in connection with the "parent" (and hence "child") application did not end with the initial application papers. In the initial application papers, Mr. Deep claimed that he was using the applied for trademark THE ZONE and design by placing it on labels for his clothing. In the first office action, the Examining Attorney noted that there were no labels submitted and that "the applicant must submit three specimens of use for each class; these specimens must be of a type which were in use at least as early as the filing date of the application [July 13, 1992]." Mr. Deep's previous attorney handling this "parent" application responded to the Examining Attorney in a letter dated April 1, 1993. With regard to the labels for Mr. Deep's clothing, the previous attorney stated to the Examining Attorney that "another order of the clothing labels are again in a process of being manufactured. Upon receipt of those labels, we will forward the requisite number of specimens to your office." In a subsequent letter dated April 12, 1993 Mr. Deep's previous attorney submitted the label specimens for the Class 25 goods (clothing). These labels bear the applied for mark THE ZONE and design and they have a PTO mail room stamp

as early as May 1992"; and to delete from the Class 25 apparel items "sweat shirts." Should Venator prevail on appeal, this uncontested amendment is accepted and the registration will issue with the aforementioned new first use dates and with the goods

showing the date of April 16, 1993. Mr. Deep's previous attorney also submitted the April 2, 1993 affidavit of Mr. Deep. In that affidavit, Mr. Deep once again falsely stated that "the mark, 'The Zone', was in use as early as June 1, 1991." In addition, Mr. Deep stated that the "substitute specimens ... were in use in commerce at least as early as the filing date of the original application [July 13, 1992]." Thus, if Mr. Deep's affidavit is truthful there had to be at least two occasions on which Mr. Deep had prepared clothing labels bearing the applied for mark. The first occasion had to be prior to the application filing date of July 13, 1992. The second occasion had to be in the spring of 1993 because in her April 1, 1993 letter to the Examining Attorney, Mr. Deep's former attorney stated that "another order of the clothing labels are again in the process of being manufactured." However, in his deposition testimony, Mr. Deep stated unequivocally that he was sure that he placed only one order for clothing labels bearing the applied for mark THE ZONE and design. (Deep deposition page 84-85). Thus, either Mr. Deep was untruthful in his affidavit filed in connection with the "parent" application or Mr. Deep was untruthful in his deposition testimony.

In sum, we find Mr. Deep to be a witness who is flippant and disrespectful to Board proceedings; who has an

reading simply as follows: "men's and women's clothing, namely,

extremely faulty memory; and who is simply untruthful. Accordingly, we accord no weight to the testimony of Mr. Deep for the purposes of establishing that priority of use rests in Venator's favor or for the purposes of establishing that the applied for mark (THE ZONE and design) was in use as of the application filing date. Thus, we find in favor of Lite Breeze both on the issue of priority of use and on the issue of whether the application was void from the beginning. Moreover, as previously noted, Mr. Deep's testimony is contradicted by the stipulated testimony of Mr. Knepprath prepared by counsel for Venator.

Finally, we wish to comment upon the fact that during the course of Mr. Deep's deposition some documents were introduced as exhibits which purported to show use of the applied for mark in 1991 and 1992. The first are four purchase orders bearing in the upper left hand corner "David K's [Knepprath's] t-shirt printing." (Deep exhibits 13-16). There are two problems with these purchase orders. First, they do not show that the t-shirts ordered had affixed to them the applied for mark, namely, THE ZONE and design. Second, the first three purchase orders predating Lite Breeze's first use date of June 22, 1992 reflect that Mr. Knepprath charged Mr. Deep sales tax. As previously explained, this indicates that the shirts ordered by Mr.

t-shirts and underwear."

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Deep were not for resale. The fourth purchase order bears an order date of June 29, 1992 and a delivery date of July 6, 1992 and in the box marked "tax" there appears for the first time the word "resale." Of course, both the order date and the delivery date of this fourth purchase order are subsequent to Lite Breeze's first use date of its mark IN THE ZONE, namely, June 22, 1992.

The second group of documents bears the words "financial summary sheet" and they are dated February 8, 1992; March 6, 1992; March 16, 1992; and March 19, 1992. (Deep exhibits 22-25). In their totality, these four financial summaries purport to show the sale of but five t-shirts. Again, there are a number of problems with these financial summary sheets. First, they do not show that the five t-shirts purportedly sold had affixed to them the applied for mark THE ZONE and design. Second, these financial summary sheets were prepared by Mr. Deep in his own handwriting, and thus are dependent upon the veracity of Mr. Deep, which is lacking. Finally, despite the fact that Lite Breeze had requested that such documentation be provided during discovery, Mr. Deep miraculously uncovered these four financial summary sheets showing a grand total of five t-shirts being sold prior to June 22, 1992 (or July 22, 1992) just two or three days before the commencement of his deposition on October 16, 1996. (Deep deposition page 27).

Hence, we are granting Lite Breeze's request that they be excluded inasmuch as they were not produced during discovery. Moreover, as previously noted, even if we were to consider them, these financial summary sheets are totally dependent upon Mr. Deep's veracity, which in and of itself is totally lacking.

Before leaving that issue of documentation, we wish to note that Venator never introduced into evidence specimens of clothing bearing the mark THE ZONE and design.

One final note is in order. This Board rarely challenges the veracity of a witness to the extent we have with regard to Mr. Deep's testimony. This is because by the very nature of Board proceedings, Administrative Trademark Judges are unable to observe the actual testimony itself, and thus cannot judge the demeanor of the witness. However, for the reasons exhaustively outlined above, we find that Mr. Deep's flippant and disrespectful attitude coupled with his frequent purported lapses of memory and untruthful statements place us in a rare position to say that his testimony carries virtually no weight.

Decision: We find in favor of Lite Breeze both on the issue of priority of use and on the issue that the opposed "child" application was void from the beginning inasmuch as there was no use of the applied for mark THE ZONE and design as of the application filing date of July 13, 1992.

R. F. Cissel

E. W. Hanak

T. J. Quinn

Administrative Trademark
Judges, Trademark Trial and
Appeal Board