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Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Bell, Inc.
v.
Bell Packaging Corporation

Cancellation No. 92031904

J.W. Gipple of Gipple & Hale for Bell, Inc.

Priscilla L. Dunckel and Pamela S. Ratliff of Baker Botts
L.L.P. for Bell Packaging Corporation.

Before Seeherman, Bottorff and Drost, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

Bell Packaging Corporation, respondent herein, owns
Registration No. 2089082, which is of the mark BELL
PACKAGING CORPORATION (in typed form; PACKAGING CORPORATION
disclaimed) for goods and services identified in the
registration as "packing paper, cardboard, and packaging
goods, namely, linerboards, corrugating medium paper,
corrugated boxes, adhesives for stationery, waxed paper, wax
paper bags," in Class 16, and "consultation and design of

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pallets, storage rack systems, linerboard, corrugating medium, corrugated boxes, and waxed paper products," in Class 42. May 24, 1994 is alleged in the registration as the date of first use of the mark and the date of first use of the mark in commerce, as to both classes. The registration issued on August 19, 1997 from an application filed on July 3, 1996.¹

On March 29, 2001, Bell, Inc., petitioner herein, filed a petition to cancel respondent's registration. As its ground for cancellation, petitioner alleged that "since long prior to 1994," petitioner has used BELL as part of its trademark and trade name in connection with paperboard packaging goods, and that respondent's mark, when used on or in connection with respondent's goods and services, is likely to cause confusion. Trademark Act Section 2(d), 15 U.S.C. §1052(d). Respondent filed an answer by which it denied the salient allegations of the petition to cancel and asserted various affirmative defenses.

The evidence of record consists of the June 12, 2003 testimony deposition of petitioner's president, CEO and sole shareholder Mark Graham (and the exhibits thereto); the August 13, 2003 testimony deposition of respondent's account manager Todd Levy (and the exhibits thereto); and respondent's September 2, 2003 notice of reliance and the

¹ Section 8 affidavit (6-year) accepted.

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documents submitted therewith.² Petitioner and respondent filed main trial briefs, but petitioner did not file a reply brief.³ No oral hearing was requested. We deny the petition to cancel.

Initially, the evidence of record establishes that petitioner has used the trade name "Bell, Inc." from January 2001 until the present. (Graham Depo. at 6.) In view thereof, and because petitioner's likelihood of confusion claim is not frivolous, we find that petitioner has established that it has the requisite commercial interest in the outcome of this proceeding, and that it therefore has standing to petition to cancel respondent's registration. *See, e.g., Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

² In an order dated October 31, 2002, the Board denied, as untimely, a motion for summary judgment filed by petitioner. Then, in an order dated April 3, 2003 (as corrected by an order dated April 18, 2003), the Board granted respondent's motion to quash petitioner's December 26, 2002 deposition on written questions of petitioner's president Mark Graham, due to petitioner's failure to comply with the provisions of Trademark Rule 2.124 pertaining to depositions on written questions. We have given no consideration to the evidence submitted with petitioner's untimely summary judgment motion, or to the procedurally improper December 26, 2002 deposition and the exhibits thereto, except for the summary judgment affidavit of Mark Graham, which respondent itself made of record (during cross-examination) as an exhibit to Mr. Graham's June 12, 2003 testimony deposition.

³ In its brief, respondent preserved and argued in support of its earlier, timely-asserted objections to certain of the exhibits to the testimony deposition of petitioner's president Mark Graham, as well as its objections to certain portions of Mr. Graham's testimony itself. Petitioner did not file a reply brief and has not otherwise responded to respondent's objections. We shall discuss those objections, *infra*.

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To prevail on its Section 2(d) ground for cancellation, petitioner, who does not own a registration, must prove that respondent's mark, when used on or in connection with respondent's goods and services, "so resembles ... a mark or trade name previously used in the United States by another [in this case, petitioner] and not abandoned," as to be likely to cause confusion. Trademark Act Section 2(d). Thus, there are two elements of petitioner's Section 2(d) claim, i.e., that petitioner has priority, and that a likelihood of confusion exists. We turn first to the issue of priority.

Two preliminary comments are in order with respect to the priority issue. First, we reject respondent's contention that petitioner cannot prevail herein because petitioner has not proven prior (or any) technical trademark use of a BELL mark on its paperboard packaging products. Section 2(d), on its face, does not require that a petitioner (or opposer) establish prior technical trademark use; prior trade name use suffices to bar registration of a confusingly similar mark. *See, e.g., Martahus v. Video Duplication Services, Inc.*, 3 F.3d 417, 27 USPQ2d 1846, 1850 (Fed. Cir. 1993).

Second, we reject petitioner's contention that "priority is not an issue" in this case, and its related contention that "Petitioner's burden is to prove that at the

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time when the application which resulted in Reg. No. 2089082 was filed, Petitioner had previously used (and not abandoned) a mark or trade name" to which respondent's mark is confusingly similar. (Petitioner's brief, at 4-5.) In *inter partes* proceedings before the Board where the plaintiff asserting a Section 2(d) claim does not own a registration, the Section 2(d) priority test is not whether the plaintiff's unregistered mark or trade name was "previously used" as of the defendant's application filing date, but rather whether it was "previously used" as of the earliest date on which the defendant can rely for priority purposes.⁴ In other words, the plaintiff asserting a Section 2(d) claim in an opposition or cancellation proceeding, if it does not own a registration, must prove that, as between plaintiff and defendant, plaintiff has superior rights in its unregistered mark or name, i.e., that the earliest date of use on which plaintiff can rely is prior in time to the earliest date of use on which defendant

⁴ Priority is not an issue in an opposition proceeding in which the opposer relies on an unchallenged pleaded registration. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Priority of use must be established in a cancellation proceeding, however, although a petitioner that proves ownership of a registration may rely on the filing date of the application which matured into that registration as its constructive date of first use, for priority purposes. See Trademark Act Section 7(c), 15 U.S.C. §1057(c); *Hilson Research v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993).

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can rely.⁵ Absent proof of ownership of such superior rights vis-à-vis the defendant, the plaintiff cannot prevail on its Section 2(d) claim. See, e.g., *American Security Bank v. American Security and Trust Company*, 571 F.2d 564, 197 USPQ 65, 66 (CCPA 1978); *Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477 (TTAB 1998); and *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154, 156 n.5 (TTAB 1985). Petitioner's burden is to prove such priority by a preponderance of the evidence. See *Hydro-Dynamics Inc. v. George Putnam & Company Inc.*, 811 F.2d 1470, 1 USPQ2d 1772 (Fed. Cir. 1987).

The evidence of record in this case establishes that petitioner adopted its current "Bell, Inc." trade name in January 2001. (Graham Depo. at 6; Respondent's Notice of Reliance, Exh. 6.) Prior to its adoption of the "Bell, Inc." trade name, petitioner had been doing business under the trade name "Bell Paper Box, Inc." since April 1, 1976, when petitioner's president Mark Graham purchased the assets

⁵ In opposition or cancellation proceedings where the defendant does not or cannot present evidence of use which predates its application filing date, the earliest use date on which the defendant may rely for priority purposes is its application filing date, which constitutes its constructive date of first use. See Trademark Act Section 7(c); *Levi Strauss & Co. v. R. Josephs Sportswear*, 28 USPQ2d 1464 (TTAB 1993), *recon. denied*, 36 USPQ2d 1328 (TTAB 1994). In such cases, the plaintiff attempting to establish Section 2(d) priority need only prove use prior to the defendant's application filing date.

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of the company. (Graham Depo. at 6, 49-50.) Since Mr. Graham's purchase of the company in 1976, petitioner's paperboard packaging products business has been in continuous operation, first under the "Bell Paper Box, Inc." name (from April 1976 to January 2001) and then under the "Bell, Inc." name (from January 2001 to the present).

(Graham Depo. at 6-7.) We note that petitioner also asserts that prior to Mr. Graham's acquisition of the company in 1976, the company's prior owners had used the "Bell Paper Box, Inc." trade name in the paperboard packaging products business since the company's founding in 1920. However, we find that the evidence of record does not support that assertion.⁶

⁶ Mr. Graham, petitioner's sole trial witness, admitted that he has no personal knowledge as to the extent or manner of use of the Bell Paper Box, Inc. name prior to his acquisition of the company in 1976. (Graham Depo. at 43-45.) His testimony (*id.* at pp. 42-43) recounting certain statements others had made to him regarding the company's history (i.e., statements made by Mr. Zender in 1976 and by the unidentified building researcher in the late 1980's) is clearly based upon hearsay, and does not establish the truth of the matters asserted in those statements. The only documentary evidence offered by petitioner as proof of pre-1976 use of the Bell Paper Box, Inc. trade name is Exhibit 6 to Mr. Graham's testimony deposition, i.e., the "Catalogue of Type Faces Emblems and Cuts of The Bell Paper Box Co." which bears on its cover the date "January 1932." However, we sustain respondent's timely-asserted and properly-maintained objection to this exhibit, on the ground that it should have been produced during discovery but was not. In particular, we note that respondent's Request for Production of Documents No. 9 requested production of "[d]ocuments sufficient to show continuous use of Petitioner's Mark from its earliest use to the present." Petitioner responded to this request as follows: "All such documents have not yet been identified, but will be made available to Registrant, when identified." (Graham Depo., Exh. No. 9.) Despite this representation that it would produce responsive documents, and despite its obligation under Fed. R.

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As for respondent, the evidence of record establishes the following. In his August 13, 2003 testimony deposition, respondent's witness Mr. Levy testified that he has been employed by respondent since 1978, and that he has held a variety of positions within the company over the years, including as the company's administrative manager with responsibility for all administrative functions of the company, including human resources. He is familiar with the company's history because the company keeps extensive archives, with which he was required to become familiar because his duties have included "overseeing the historical portion of our annual profit plan." (Levy Depo. at 4-5.) The company's archives contain numerous documents which are and have been kept by the company in the ordinary course of business, including the historical documents introduced as exhibits to his deposition. (Levy Depo. at 5, 14, 18.)

Civ. P. 26(e)(2) to timely supplement its response, petitioner failed to produce this 1932 catalog or any other document which would support its claim of pre-1976 use of the Bell Paper Box, Inc. name by petitioner's predecessors. Instead, petitioner attempted to introduce this document for the first time at Mr. Graham's testimony deposition. This is the sort of surprise that the discovery rules (of which respondent properly availed itself) were designed to prevent. In the interest of "fundamental fairness in the conduct of litigation," we find that petitioner is estopped to rely on this document at trial, and we have given it no consideration. See *Weiner King, Inc. v. The Wiener King Corporation*, 615 F.2d 512, 204 USPQ 820, 828 (CCPA 1980). Thus, we find that there is no evidence which establishes use of the Bell Paper Box, Inc. trade name prior to Mr. Graham's acquisition of the company in 1976, much less evidence which establishes that such use commenced in 1920.

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Mr. Levy testified that respondent company was founded in 1913 by George Bell, and that it did business under the trade name "Indiana Fibre Products Company" until 1940, when the name was changed to "Bell Fibre Products Company." Exhibit 4 to Mr. Levy's deposition is a copy of an announcement, dated January 2, 1940 and signed by George Bell, by which the company announced the name change. Mr. Levy testified that the original of this document is framed and displayed in the lobby of the company's plant in Marion, Indiana. (Levy Depo. at 14.)

Continuously from 1940 to 1988, respondent conducted business under the trade name "Bell Fibre Products Corporation," and also used that designation as a trademark on the corrugated containers it produced and as a service mark in connection with its packaging design services.

(Levy Depo., 9, 13.)⁷ Exhibit 5 to Mr. Levy's deposition is a company newsletter dated May 1968, in the masthead of which appears the "Bell Fibre Products Corporation" trade

⁷ Exhibit 3 to Mr. Levy's deposition is a USPTO printout of respondent's expired Reg. No. 1045401, which is of the mark BELL FIBRE PRODUCTS CORPORATION and bell logo design for "corrugated fibreboard boxes," and which alleges December 31, 1939 as the date of first use. The registration issued on August 3, 1976, but was not renewed, and was deemed expired on May 12, 1997. It is settled that an expired or cancelled registration is not evidence of use of the mark, either as of the application filing date or as of the date of use alleged therein. Nor is it evidence of any presently existing rights. See *Elder Mfg. Co. v. International Shoe Co.*, 194 F.2d 114, 92 USPQ 330 (CCPA 1952); *Bonomo Culture Institute, Inc. v. Mini-Gym, Inc.*, 188 USPQ 415 (TTAB 1975). We accordingly have given this expired registration no evidentiary value.

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name and bell logo. (Levy Depo. at 14-15.) Exhibit 6 to Mr. Levy's deposition is a 1985 marketing brochure which was used extensively by respondent; the name "Bell Fibre Products Corporation" appears prominently on the brochure's cover. (Levy Depo. at 15-19.) Exhibit 10 to Mr. Levy's deposition is a certification stamp bearing the designation "Bell Fibre Products Corporation" and bell logo, which was stamped onto every corrugated carton produced by respondent in the years prior to 1988. (Levy Depo. at 24-25, 27.)

In 1988, to celebrate the company's 75th anniversary, respondent changed its trade name from "Bell Fibre Products Corporation" to "Bell Packaging Corporation." (Levy Depo. at 8.) Exhibit 4 to Mr. Levy's deposition is an official record from the Indiana Secretary of State's office consisting of a notice of filing of articles of amendment to respondent's Articles of Incorporation, along with a copy of the December 31, 1987 articles of amendment by which the corporate name change was effected. Respondent has used the BELL PACKAGING CORPORATION trademark and trade name continuously since 1988. (Levy Depo. at 22-24.)⁸

⁸ In respondent's involved registration, respondent alleged May 24, 1994 as the date of first use of the trademark and service mark BELL PACKAGING CORPORATION. Mr. Levy testified that that date is erroneous, because respondent has used the trademark and service mark in commerce since 1988, when the company's name was changed from Bell Fibre Products Corporation to Bell Packaging Corporation. (Levy Depo. at 7-8.) Mr. Levy's testimony is clear, credible and incontroverted, and is supported by the deposition exhibits. In view thereof, we find that respondent has proven, with the requisite clear and convincing evidence,

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Petitioner has not objected to, challenged or rebutted any of respondent's evidence pertaining to the history of respondent's use of its BELL PACKAGING CORPORATION and BELL FIBRE PRODUCTS CORPORATION trade names and trademarks. We find that this evidence suffices to establish that respondent has used the trade name, trademark and service mark BELL PACKAGING CORPORATION since 1988, and that it used the trade name BELL FIBRE PRODUCTS CORPORATION continuously from 1940 to 1988.

Both petitioner and (to a lesser extent) respondent have based their priority arguments on their uses of their previous trade names and/or marks. That is, petitioner is attempting to go behind its January 2001 first use of its current BELL, INC. name and "tack on" its pre-2001 use of its previous name BELL PAPER BOX, INC. Respondent, although arguing that its 1988 first use of its registered BELL PACKAGING CORPORATION mark predates petitioner's 2001 first use of its current BELL, INC. trade name, also argues that it is entitled to go behind its 1988 first use of the BELL PACKAGING MARK and tack on its pre-1988 use of its previous

that its date of first use of the registered mark in commerce is January 1988, rather than May 24, 1994 as alleged in the registration. See *Hydro-Dynamics Inc. v. George Putnam & Company Inc. supra*. We note, however, that this finding is not necessary to our decision in this case because, as discussed *infra*, the evidence of record establishes respondent's priority vis-à-vis petitioner regardless of whether respondent's first use in commerce of the registered trademark and service mark was in 1994 or in 1988.

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BELL FIBRE PRODUCTS CORPORATION mark and name. We find, however, that neither party is entitled to tack in this case.

"Tacking" (for priority purposes) of a party's use of an earlier mark or name onto its use of a later mark or name is permitted only in rare instances, and only where the earlier and later designations are "legal equivalents," i.e., where they would be considered by purchasers to be the same designation. To meet the legal equivalents test, the marks must create the same commercial impression, and cannot differ materially from one another. The fact that two designations may be confusingly similar does not necessarily mean that they are legal equivalents. See *Van Dyne-Crotty Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991); *Ilco Corp. v. Ideal Security Hardware Corp.*, 527 F.2d 1221, 188 USPQ 485 (CCPA 1976); *Pro-Cuts v. Schilz-Price Enterprises Inc.*, 27 USPQ2d 1224 (TTAB 1993); *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992: and *American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036 (TTAB 1989), *aff'd* (unpub.) 17 USPQ2d 1726 (Fed. Cir. 1990).

In this case, we find that petitioner's previous trade name BELL PAPER BOX, INC. is not the legal equivalent of its current trade name BELL, INC. The two names do not create the same commercial impression, because the current name

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(which omits PAPER BOX) is more general and expansive, and less informative, than the former name. See *American Paging Inc. v. American Mobilphone Inc.*, supra. The same is true with respect to respondent's former BELL FIBRE PRODUCTS CORPORATION name and mark and its current BELL PACKAGING CORPORATION name and mark. FIBRE PRODUCTS and PACKAGING are not legally equivalent terms, and the commercial impressions created by the respective marks therefore are not the same. See *Ilco Corp. v. Ideal Security Hardware Corp.*, supra; *American Paging Inc. v. American Mobilphone Inc.*, supra.

Because petitioner is not entitled to tack on its use of its previous BELL PAPER BOX, INC. trade name, the earliest date on which petitioner may rely for priority purposes is the date of its first use of its current BELL, INC. trade name, i.e., January 2001. Respondent likewise is not permitted to tack on its use of its previous name and mark BELL FIBRE PRODUCTS CORPORATION, but respondent has proven actual use of its registered BELL PACKAGING CORPORATION mark since 1988, a date prior to petitioner's January 2001 priority date. (Respondent's 1996 constructive first use date (i.e., the filing date of the application which matured into the involved registration), likewise predates petitioner's January 2001 first use of BELL, INC.)

In sum, because neither party is entitled to tack on its use of its former mark or name, the priority dispute in

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this case comes down to the issue of which party first commenced use of its present mark or name. We find that, as between respondent's registered BELL PACKAGING CORPORATION MARK (first used in 1988) and petitioner's BELL, INC. trade name (first used in 2001), priority rests with respondent, not petitioner.⁹

Because petitioner has failed to prove priority, petitioner cannot prevail on its Section 2(d) ground for cancellation. We need not and do not reach the issue of likelihood of confusion. See *Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, *supra*, 48 USPQ2d at 1479 n.4.

Decision: The petition to cancel is denied.

⁹ We hasten to add that even if the priority issue in this case involved a determination of which party is the prior user of the designation BELL *per se*, i.e., even if both parties were permitted to tack on their use of their respective previous BELL marks or names, priority still would rest with respondent. For the reasons discussed *supra*, the earliest date of use of petitioner's previous BELL PAPER BOX, INC. trade name that has been established by competent evidence is April 1976, when Mr. Graham acquired the company. That date is subsequent to respondent's proven date of first use, in 1940, of its previous BELL FIBRE PRODUCTS CORPORATION mark and name.