Paper No. 22
BAC

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB AUG. 31,99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Lee Drannan Smithson, dba Drannan's and Drannan Co.

v.

Emsa-Werke Wulf GmbH & Co.

Cancellation No. 24,163

Lee Drannan Smithson, dba Drannan's and Drannan Co., pro se.

Laurence R. Brown of Laurence Brown & Assoc., P.C. for Emsa-Werke Wulf GmbH & Co.

Before Cissel, Hairston and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Lee Drannan Smithson, dba Drannan's and Drannan Co., has filed a petition to cancel Registration No. 1,816,920 for the mark TONGULA for "food tongs and spatulas."[1]

As grounds for cancellation petitioner essentially alleges that since October 1, 1975 he has continuously used

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[1] Reg. No. 1,816,920 issued January 18, 1994. The claimed dates of first use and first use in commerce are May 3, 1992.

the mark FORKULA for food handling tongs; that his trademark application Serial No. 74/487,467[2] was refused registration based on Registration No. 1,816,920; and that respondent's mark TONGULA, when used on its goods, so resembles petitioner's previously used mark FORKULA as to be likely to cause confusion, mistake or deception.

Respondent, in its answer, denied the salient allegations of the petition to cancel. Respondent also raised certain affirmative defenses, including that "[u]pon information and belief Petitioner has abandoned the mark 'FORKULA.'"

The record consists of the pleadings[3]; the file of the involved registration[4]; petitioner's notice of reliance on five documents; and respondent's notice of reliance on four documents. Petitioner offered no rebuttal evidence. Petitioner did not file a brief on the case, but respondent

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[2] Appl. Ser. No. 74/487,467, filed February 7, 1994, with claimed dates of first use and first use in commerce of October 1, 1975.

[3] 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, 205 USPQ 656 (TTAB 1979). See also, TBMP §706.01.

[4] Informationally, the parties are advised that the file of the involved registration is of record to the extent provided in Trademark Rule 2.122(b)(1). However, subpart (b)(2) of that rule specifically provides, inter alia, that the claimed dates of use in the registration are not evidence on behalf of the registrant, and that said dates must be established by competent evidence at trial.

filed a brief, and petitioner then filed a reply brief.[5] An oral hearing was not requested by either party.

Preliminarily, we will deal with a procedural matter. Respondent moved to strike portions of petitioner's reply brief[6], and the Board deferred a decision on the motion until final decision on the case. Respondent asserts that the involved portions of petitioner's reply brief were directed to subject matter which should have been raised in an opening brief. Petitioner contends that the entire reply brief is in direct rebuttal of matters in respondent's brief.

Having read the two briefs before us, we find that the objected-to portions of petitioner's reply brief are appropriate. We should point out that briefs on the case are not evidence or testimony, rather, they are written summaries of the respective positions of the parties, and thus generally serve as tools or aids to the Board.

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[5] Factual statements made in briefs 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 §706.02.

[6] We note that in a section of petitioner's reply brief not objected to by respondent, petitioner referred to a "Bon Appetit Research Report" (supposedly Exhibit 1 to his reply brief) relating to circulation numbers for Bon Appetit and Gourmet magazines. There was no exhibit attached to petitioner's reply brief. Even if it had been attached, it could not be considered because it was untimely and was not properly made of record during trial. See TBMP §705.02.

Respondent's motion to strike portions of petitioner's reply brief is denied.[7]

Petitioner bears the burden of proof in this case, and must establish his claims by a preponderance of the evidence. See Cerveceria Centroamericana, S.A. v. Cerveceria India Inc., 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989).

As pointed out above, the entire record of this case consists of nine documents submitted under two notices of reliance, one by each party. The documents introduced into the record by petitioner are the following:

(1) a photocopy of the Office action refusing registration to petitioner's application based on the involved registration;

(2) a photocopy of an advertisement for petitioner's FORKULA (tm) tongs appearing in the October 1975 Gourmet magazine;

(3) an advertisement for petitioner's FORKULA (tm) "bar-b-que tool" appearing in the July 1981 Bon Appetit magazine;

[7] On page nine of his reply brief, petitioner contends that the Board may take judicial notice of "the nature of these publications ["The New York Times," Gourmet magazine, Bon Appetit magazine, and The Complete Food Catalogue] being distributed to the consuming public and the breadth of their circulation o (sic) millions of consumers throughout the United States." Inasmuch as petitioner submitted copies of the relevant pages from these publications by way of a notice of reliance, they are properly of record pursuant to Trademark Rule 2.122(e), and we have accorded

(4) a photocopy of a story about a housewares show from "The New York Times" of January 14, 1981, which mentions petitioner's product; and

(5) a photocopy of a page from the book, The Complete Food Catalogue (1977), which mentions petitioner's FORKULA (tm) tongs.

Respondent introduced the following documents into the record[8]:

(1) a certified status and title copy prepared by the Patent and Trademark Office of respondent's Registration No. 1,816,920;

(2) a photocopy of a third-party registration for the mark SPOONULA for stainless steel laboratory tools having a spoon on one end and spatula on the other;

(3) the Random House College Dictionary (1988) definition of "spatula"; and

(4) a few selected pages from the 1996 National Housewares Manufacturers Association Membership Directory.

By submitting a copy of the Office action refusing

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them the appropriate probative weight. We do not, however, take judicial notice of their circulation, etc.

[8] Respondent's notice of reliance did not include a statement of the relevance of these documents as required by Trademark Rule 2.122(e). However, petitioner did not object thereto, and in fact, treated the material as being of record. Accordingly, we have considered the documents for whatever probative value they have.

registration to petitioner's application, petitioner has proven his standing. See The Hartwell Co. v. Shane, 17 USPQ2d 1569 (TTAB 1990).

Regarding the issue of priority, the party asserting ownership of the trademark must demonstrate that his use of the mark has been "deliberate and continuous, not sporadic, casual, or transitory (citation to a treatise omitted)." See La Societe Anonyme Des Parfums Le Galion v. Jean Patou, Inc. 495 F.2d 1265, 181 USPQ 545, 548 (2nd Cir. 1974). That is, trademark rights are not established by sporadic sales or shipments, with long periods of apparent inactivity. See also, Scholastic Inc. v. Macmillan Inc., 650 F.Supp. 866, 2 USPQ2d 1191, 1196 (SDNY 1987) (wherein the District Court stated "adoption and a single use of the mark may be sufficient to permit registration of the mark, but more is required if the owner seeks to use the mark to stifle the efforts of others.").

While petitioner has proven one use of the mark FORKULA in 1975 and one use in 1981 (and that his product received publicity in publications in 1977 and 1981), there is no evidence of record showing any use by petitioner of the mark FORKULA for food handling tongs since 1981. Thus, petitioner has proven only sporadic use a long time ago. (At the time of petitioner's rebuttal testimony period in 1997, it had been 16 years since the most current

advertisement submitted by petitioner had appeared in a 1981 Bon Appetit magazine.) This is not sufficient to establish that petitioner has superior prior rights in this mark.[9]

As noted earlier, respondent raised the affirmative defense of petitioner's abandonment of his involved mark. The only evidence of record which relates to this issue is respondent's Exhibit D, selected pages from the 1996 National Housewares Manufacturers Association Directory, presumably offered to show that "Drannan's" is not listed therein. The fact that a company name does not appear in an industry association membership directory in a particular year certainly does not prove abandonment of any trademark by that company. Thus, this affirmative defense must fail.

Because petitioner has not established prior continuous use of the mark FORKULA, we need not reach the issue of whether there would be a likelihood of confusion involving respondent's registered mark.[10]

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[9] We note that in petitioner's notice of reliance, relating to the Gourmet magazine ad, "The New York Times" story, and the pages from The Complete Food Catalogue, petitioner made the following statement about the relevance thereof: "[these documents] demonstrate use of the Forkula mark in 1975, 1977 and 1981, which shows continuity of use for those periods." The problem is that "those periods" ended long before the testimony periods began, and we have no evidence of use since then.

[10] Petitioner's evidence claimed to establish likelihood of confusion consisted of the Office action refusing registration to his application wherein the Examining Attorney stated there was a likelihood of confusion. Petitioner offered the Examining Attorney's refusal to register as an "expert opinion" proving likelihood of confusion. The fact that an Examining Attorney refused registration (or did not refuse registration) based on a particular registration is not controlling in a proceeding at the

Decision: The petition to cancel is denied.

R. F. Cissel

P. T. Hairston

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal

Board. See Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993); and Formica Corporation v. Saturn Plastics & Engineering Co., 185 USPQ 251 (TTAB 1975).