

4/26/01

THIS DISPOSITION IS NOT  
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THE TTAB

GDH/gdh

U.S. PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Cancellation No. 25,774

Comision Regata 2000 Puerto  
Rico and Operation Sail, Inc.

v.

American Sail Training  
Association

Before Hohein, Rogers and Drost, Administrative Trademark Judges.

By the Board:

By their amended petition, Comision Regata 2000 Puerto Rico and Operation Sail, Inc. seek to cancel, on the ground of genericness, the registrations owned by American Sail Training Association for (1) the mark "TALL SHIPS," which is registered for "promotion of goods and services of others by planning and operating sailing races and related events through which the goods and services of a variety of sponsors are advertised"<sup>1</sup> and for "organizing, arranging and sponsoring sailing races"<sup>2</sup>; (2) the mark "TALL SHIPS ARE COMING!," which is registered for

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<sup>1</sup> Reg. No. 1,053,408, issued on November 23, 1976, which sets forth dates of first use of February 25, 1975; renewed.

<sup>2</sup> Reg. No. 1,086,636, issued on February 28, 1978, which sets forth dates of first use of February 25, 1975; renewed.

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"promoting the sale of goods and services of others through the medium of sailing races"<sup>3</sup> and for "organizing, arranging and sponsoring sailing races"<sup>4</sup>; and (3) the mark "TALL SHIPS 2000," which is registered for "posters, pamphlets and books on the subject of sailing"<sup>5</sup> and for "drinking glasses and mugs," "t-shirts and sweat shirts," and "organizing, arranging and sponsoring sailing events".<sup>6</sup> Respondent, in its answer, has denied the salient allegations of the petition to cancel.

This case now comes up on respondent's timely filed June 30, 2000 motion to dismiss this proceeding pursuant to Trademark Rule 2.132(a) and petitioners' July 17, 2000 request to reopen their initial testimony period, submitted as part of their timely filed opposition to the motion to dismiss. Respondent, in its timely filed July 25, 2000 reply brief, has opposed the request to reopen.

Turning first to the motion to dismiss since it is potentially dispositive of this case, respondent accurately notes that while petitioners' initial testimony period was extended, by an approved stipulation of the parties, to close on June 28, 2000, such period expired without petitioners' having taken any

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<sup>3</sup> Reg. No. 1,081,983, issued on January 10, 1978, which sets forth dates of first use of April 1976; renewed.

<sup>4</sup> Reg. No. 1,086,634, issued on February 28, 1978, which sets forth dates of first use of May 1975; renewed.

<sup>5</sup> Reg. No. 2,039,265, issued on February 18, 1997, which sets forth dates of first use of July 1996. The term "2000" is disclaimed.

<sup>6</sup> Reg. No. 1,959,420, issued on February 27, 1996, which sets forth dates of first use of September 6, 1995 for the drinking utensils, August 30, 1995 for the clothing items and August 18, 1994 for the services. The term "2000" is disclaimed.

testimony or submitting any other evidence in support of the salient allegations of the petition to cancel. Respondent consequently requests that this proceeding be dismissed with prejudice, in accordance with Trademark Rule 2.132(a), in view of petitioners' failure to submit any evidence to establish their claim that respondent's marks are generic.

Petitioners, in opposition to the motion, argue that dismissal of this proceeding in its entirety is not warranted because, in connection with respondent's previously denied motion for summary judgment, respondent "admitted that the registered term TALL SHIPS is 'generic for tall ships per se' (see Respondent's Motion for Summary Judgment) and conceded," in its reply brief, "the fact that 'tall ships' is generic for tall ships."<sup>7</sup> Petitioners maintain that (footnote omitted):

Notwithstanding this admission, the Board, in its orders denying Petitioners' [cross-]motion for summary judgment and request for reconsideration, stated that "[a]fter careful review of the record, we find that there is a genuine issue of material fact whether the designations TALL SHIPS, TALL SHIPS ARE COMING!, and TALL SHIPS 2000 are generic." As to the designation TALL SHIPS, this statement is directly contrary to the admitted facts. Whatever the Board's view might have been with respect to the appropriateness of summary judgment as to the marks other than the stand-alone TALL SHIPS mark for races and events involving

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<sup>7</sup> Petitioners, in a footnote, attempt to justify their reliance upon such statements by respondent by asserting that, "[a]lthough statements in pleadings are not typically evidence, they may have evidentiary value as admissions against interest." It is pointed out, however, that the sole *pleading* filed by respondent in this proceeding is its answer to the amended petition for cancellation. Such pleading contains no admission of any of petitioner's allegations that respondent's marks are generic for its various goods and services.

tall ships, it is submitted that the record not only supports the conclusion that TALL SHIPS is indeed generic, but requires such a holding. In the circumstances, the subject Registration No. 1,053,408 is invalid for genericness to the extent it is asserted to cover events involving tall ships.

Petitioners nevertheless state in a footnote that they "have no objection to the grant of the present motion [to dismiss] as to the marks TALL SHIPS ARE COMING[!] and TALL SHIPS 2000, or as to any of the marks as they are used for goods or services other than 'planning and operating sailing races and related events,'" noting that "[b]y the time this ... proceeding is resolved, the generic ... 'coming' and '2000' designations will be moot, i.e., the tall ships will have left and the summer of the year 2000 will have ended." Presumably, therefore, petitioners oppose the dismissal of this proceeding only insofar as it pertains to respondent's "TALL SHIPS" mark for its various services, including the services of "organizing, arranging and sponsoring sailing races" which are the subject of its Registration No. 1,086,636.

We agree with respondent, however, that petitioners' position is without merit. As respondent correctly points out in its reply, not only was its "admission" or "concession" that the term "tall ships" is generic for tall ships made solely for the purpose of its motion for summary judgment,<sup>8</sup> but in any event

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<sup>8</sup> Specifically, in its motion for summary judgment, respondent ("ASTA") stated that, "[f]or purposes of this motion, ASTA ... agree[s] that 'tall ships' is generic for tall ships per se." Respondent added, in its reply brief in support of its motion for summary judgment and in opposition to petitioners' cross-motion for summary judgment, the statement that "the fact that 'tall ships' is generic for tall ships

respondent plainly did not admit or concede that such term is generic for the specific services set forth in its "TALL SHIPS" registrations. Accordingly, respondent's motion to dismiss is well taken and, absent a showing of excusable neglect so as to warrant a reopening of petitioners' initial testimony period, this proceeding must be dismissed with prejudice pursuant to Trademark Rule 2.132(a).

Petitioners, in support of their request to reopen, seek an enlargement of their initial testimony period solely for "the limited purpose of introducing examples of ... media coverage" of "OpSail 2000," which according to petitioners "took place on July 4, 2000" and involved "the largest tall ships event in maritime history." Petitioners contend that "media coverage for this event was unprecedented, and was repleat [sic] with generic references to the term 'tall ships' to describe the very event itself." By their request to reopen, petitioners wish to introduce "examples of this media coverage, which examples did not exist prior to the close of the discovery period," as shown for instance in "the attached inside cover page from a forty (40) page insert from the July 2, 2000, New York Daily News."

We concur with respondent, however, that the "request must ... be denied because Petitioners have failed to show, as they must, that their failure to take testimony or introduce evidence with the prescribed testimony period was as a result of

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does not make it generic for the goods and services covered by ASTA's registrations ...."

excusable neglect" as required by Fed. R. Civ. P. 6(b)(2).<sup>9</sup> The mere fact that petitioners obviously could not have obtained the evidence they now desire to introduce does not mean that the request to reopen must be allowed; instead, consideration must also be given to the nature and purpose of the evidence, the stage of the proceeding and respondent's right to a prompt and inexpensive determination of this case. These considerations, on balance, favor respondent, even though it is assumed that the delay by petitioners will not prejudice respondent in the presentation of its case on the merits and that petitioners have not acted in bad faith.

In particular, we note among other things that while petitioners cannot prevail herein absent proof of their standing to bring the petition to cancel, petitioners have not offered to submit any proof that they are and will continue to be damaged by the existence of respondent's registrations, that is, that they have a real interest in this proceeding. Petitioners also have not offered any explanation for their failure to submit any evidence to substantiate their claim that, as of the commencement of this proceeding over four years ago, respondent's marks were generic, as alleged in the petition to cancel. Moreover, the

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<sup>9</sup> As pointed out in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582, 1586 (TTAB 1997), the Supreme Court in *Pioneer Investment Services Co. v. Brunswick Associates Limited Partnership*, 507 U.S. 380, 395 (1993) held that the determination of whether a party's neglect is excusable is "at bottom an equitable one, taking account of all relevant circumstances surrounding the party's omission. These include ... the danger of prejudice to the [nonmovant], the length of the delay and its potential impact on judicial proceedings, the reason for the delay, including whether it was within the reasonable control of the movant, and whether the movant acted in good faith."

evidence petitioners now seek to introduce, as shown by the attachment filed with their request to reopen, simply shows that the term "tall ships" is generic for sailing vessels of the kind known as tall ships.<sup>10</sup> The evidence relating to "Operation Sail 2000" plainly does not show that such term is generic for respondent's services of "organizing, arranging and sponsoring sailing races" and the "promotion of goods and services of others by planning and operating sailing races and related events through which the goods and services of a variety of sponsors are advertised."

Petitioners, in short, have offered nothing to excuse their failure to take any meaningful action during their initial testimony period, as extended by agreement of the parties, and appear unable to advance anything more than what respondent, for the purpose of its motion for summary judgment, previously had admitted, namely, that the term "tall ships" is generic for tall ships. Proof thereof, however, would not constitute proof that such term is generic for respondent's organizational and promotional services. At this relatively late juncture herein,

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<sup>10</sup> The excerpt, which includes a photograph captioned "SEABORNE: Tall ships leave the harbor of the northwestern Italy seaport of Genoa in April, bound for Spain," refers to "an international armada of majestic tall ships, imposing warships, thousands of pleasure boats, glittering fireworks and millions of spectators" and further states that:

The celebration of America's first birthday of the 21st century--Operation Sail 2000 on July Fourth--is shaping up as a star-spangled, only-in-New York tribute.

OpSail 2000 marries the past and the present: the largest maritime fleet assembled in peacetime and tall ships alongside the most sophisticated modern vessels in the world  
....

reopening the trial period (and the consequent resetting of all briefing dates) would significantly delay the resolution of this matter and would unavoidably continue the cloud hanging over the validity of respondent's registrations for its "TALL SHIPS" services, but would not provide any apparent prospects for the introduction of evidence sufficient to meet petitioners' burden of proving genericness.

Thus, inasmuch as petitioners have failed to make the requisite showing of excusable neglect in that they have not offered any valid reason for their delay in presenting their case-in-chief, the request to reopen their initial testimony period is denied and respondent's motion to dismiss is granted. Fed. R. Civ. P. 6(b) and Trademark Rule 2.132(a). The petition for cancellation is accordingly dismissed with prejudice.

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"I think this parade of tall ships is one of the great boat shows of all time," said Walter ....