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THIS DISPOSITION
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OF THE T.T.A.B.

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

RS/kes

Cancellation No. 29,938

Maverick Media, Inc.

v.

Weyerhaeuser Company

Before Simms, Chapman and Bottorff, Administrative
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

This case now comes up on Weyerhaeuser Company's
(respondent's) motion for summary judgment. Maverick
Media, Inc. (petitioner) has opposed the motion and
respondent has filed a reply brief.

In this proceeding, petitioner seeks cancellation of
respondent's registration of the mark IMPAK and design
for the following goods:

printed graphic art, commercial art work, namely,
photographs and manual illustrations, camera-ready
art, namely, artboards of visual elements for
commercial purposes, printed paper liners for use

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with packaging and displays and printed paper liners for use with related promotional products.

(Registration No. 1,586,697, issued March 13, 1990, Sections 8 and 15 affidavit accepted and acknowledged, respectively.) As grounds for cancellation, petitioner asserts that it has filed an application to register the mark AD IMPAC and design for "printed promotional packaging for product inserts, namely, printed sheets and paper advertising inserts"; that registration of this mark has been refused by the Examining Attorney on the basis of respondent's registration; and that respondent has abandoned its mark because the mark is not being used on any of respondent's goods, with no intent to use the mark on these goods. Alternatively, petitioner asserts that respondent has not used its mark on some of the goods in its registration so that it has, in effect, partially abandoned the registered mark. Petitioner asks that the registration either be cancelled in whole or in part to exclude petitioner's goods therefrom.

Respondent has denied the essential allegations of the petition for cancellation.

Near the end of the discovery period, respondent filed its motion for summary judgment and also requested that, if its motion is denied, the discovery period and

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its time to answer petitioner's discovery requests be extended.

In its motion for summary judgment, respondent maintains that it has continuously used the registered mark since the date of registration. Respondent's motion is supported by a declaration of its sales manager, who attests to the fact that the registered mark has been used in connection with all of the products listed in that registration and that the use has been continuous since the date of the registration in 1990. More particularly, he states that he has been employed by respondent in its IMPAK Center for Graphic Packaging for 13 years and that packaging, boxes, printed matter and paper liners bearing the mark have been continuously distributed by respondent during this entire 13-year period. Respondent has submitted samples of boxes and printed packaging showing the mark as it appears on graphic art, illustrations, camera-ready art and paper liners.

In opposition to respondent's motion, petitioner contends that, while respondent's motion may be appropriate against an attempt at full cancellation, here petitioner is seeking, alternatively, partial cancellation, and respondent has not shown the absence of

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a genuine issue with regard to that question. Petitioner's attorney argues that respondent has not shown use on all the goods listed in the registration, such as artboards or printed paper liners. Also, petitioner maintains that respondent has not proven that it is engaged in the business of selling goods similar to those recited in petitioner's application (printed promotional packaging for product inserts).¹ Thus, according to petitioner, respondent's registration is overly broad and should be limited, pursuant to Section 18 of the Act,² to exclude petitioner's goods, which restriction will avoid a finding of likelihood of confusion. Petitioner's opposition is supported by a declaration of its attorney.³

¹ Petitioner states that it provides inserts to the *USA Today* newspaper.

² Section 18 (15 U.S.C. §1068) provides, in relevant part:

In such proceedings the Director may refuse to register the opposed mark, may cancel the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register the registration of a registered mark...

³ Respondent has objected to this declaration. Among other things, respondent complains that the declaration is irrelevant because petitioner's difficulties in obtaining a registration are not relevant to the question of abandonment asserted in petitioner's petition for cancellation. We have chosen to consider the declaration of petitioner's attorney for whatever probative value it has.

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In its reply brief, respondent maintains that there is no genuine issue of fact because its motion and support show that it has used the mark on all of the goods listed in the registration. Respondent maintains that its registration does not claim use on petitioner's goods so that it was not required to show use thereon to demonstrate that there has been no abandonment of its mark. In addition, respondent contends that a Section 18 restriction is inappropriate because petitioner's goods and respondent's goods are sold in the same channels of trade. Accordingly, any restriction would not preclude a likelihood of confusion. Respondent has also submitted another declaration of its sales manager explaining in more detail the nature of its goods.

Upon careful consideration of the record and the arguments on respondent's motion, we believe that summary judgment for respondent is justified. First, respondent has established by declaration that it has used the registered mark continuously on all of the goods listed in its registration. Accordingly, the petition, insofar as it seeks cancellation of the registration in its entirety, is clearly not warranted.

Second, with respect to petitioner's request that the registration be restricted under Section 18, we

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likewise find that there is no genuine issue with respect to the relief requested by petitioner. In this case, respondent's goods (photographs and illustrations, artboards for commercial purposes, and printed paper liners) do not specifically include petitioner's promotional packaging for product inserts. As such, there can be no occasion for an amendment excluding these specific goods from respondent's registration. By way of analogy, if respondent's registration were for shirts and petitioner's goods were pants, there simply would be no occasion for language in the registration that respondent's shirts do not include pants. That statement would be obvious, and unnecessary.

Accordingly, because respondent has demonstrated that there is no genuine issue with respect to the question of abandonment of its mark for the goods in its registration, and because a Section 18 restriction would be inappropriate in this case, respondent's motion for summary judgment is granted and the petition for cancellation is dismissed with prejudice.