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**This Opinion is Not  
Citable as Precedent  
of the TTAB**

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Ted Lapidus  
v.  
Lambertson Truex, Inc.

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Opposition No. 91118497  
to application Serial No. 75453727  
filed on March 20, 1998

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Bruce L. Adams of Adams & Wilks for Ted Lapidus.

William S. Frommer, Marilyn Matthes Brogan, and Deena Levy  
Weinhouse of Frommer Lawrence & Haug LLP for Lambertson  
Truex, Inc.

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Before Seeherman, Chapman and Rogers,  
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Ted Lapidus, a corporation of France, opposed the application of Lambertson Truex, Inc. to register a stylized LT logo. Lambertson Truex, Inc. [hereinafter LTI or petitioner] filed a counterclaim for cancellation directed to one of the seven pleaded registrations of Ted Lapidus [hereinafter Lapidus or respondent].

In an order dated October 15, 2002, the Board considered various pending motions and requests filed by the parties and, *inter alia*, granted applicant's motion under Trademark Rule 2.132(a), 37 C.F.R. 2.132(a), dismissing the Lapidus opposition with prejudice. The Board also noted that this proceeding would continue only in regard to LTI's counterclaim. Lapidus subsequently filed an appeal from the order dismissing the notice of opposition, to the Court of Appeals for the Federal Circuit. The appeal, however, was dismissed approximately four months later, "for failure to prosecute in accordance with the rules [of the Federal Circuit]." Accordingly, the counterclaim is all that remains to be considered.

While the many motions and requests addressed by the Board in the above-referenced October 15, 2002 order were being briefed, proceedings were not suspended, and LTI's testimony period for presenting evidence in support of its counterclaim was from May 17, 2002 through June 15, 2002.<sup>1</sup> During that testimony period, LTI filed notice that it would take the deposition on written questions of the president of

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<sup>1</sup> When this testimony period was scheduled by a Board order dated April 19, 2002, it was set forth as a period for LTI to present evidence in defense of the opposition and in support of its counterclaim. One of the motions decided by the October 15, 2002 order, however, was a motion by Lapidus for reconsideration and sought to limit the testimony period to LTI's prosecution of its counterclaim. The October order granted this motion and reset a testimony period for LTI that was limited to prosecution of its counterclaim.

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Lapidus, the counterclaim respondent, but the Board did not suspend proceedings. Respondent subsequently served cross-questions for this deposition and LTI filed objections to those questions with the Board. The October 15, 2002 order deferred consideration of those objections to final hearing. The proposed deposition on written questions, however, was never taken and, therefore, the objections have been rendered moot.

During the reset testimony period for LTI provided by the October 15, 2002 order, LTI filed two notices of reliance and took one testimony deposition, all in support of its counterclaim.

The notices of reliance introduced certified copies of official records, specifically, copies of LTI's opposed application and of the Lapidus opposition thereto. LTI offered these to establish its standing to pursue its counterclaim. The testimony deposition taken by LTI is of one Joseph Aglione, an investigator with The Stonegate Agency of New York, and was used to introduce two reports prepared for LTI's counsel by the witness. Counsel for counterclaim respondent Lapidus was served with notice of the deposition, but did not attend; nor did counsel object to the taking of the deposition. LTI later filed a brief in support of the counterclaim, but Lapidus did not file a brief in opposition to it.

LTI's counterclaim is set forth in its entirety below:

19. On information and belief, Registration No. 1,023,9[7]1, for TED LAPIDUS, issued October 28, 1975, to Opposer, for leather goods, namely, luggage, handbags, purses, satchels, check and bank note cases, leather cases and leather boxes sold empty; and fancy jewelry, namely, cufflinks, earrings, rings and necklaces, etc.

20. On information and belief, Opposer has abandoned all use of this mark, on at least the leather goods recited in the registration, without any intention to resume use of said mark.

21. If opposer is permitted to continue to maintain its registration, the continued existence of such registration may cast a cloud upon Applicant's right to continue to use, register and expand use of Applicant's LT mark. Such registration might also cast a cloud upon the rights of third parties to adopt, use, and/or register certain marks. Such registration would thus be a source of damage and injury to Applicant, and also to third parties.

Wherefore, Applicant petitions for cancellation of Registration No. 1,023,9[7]1, issued October 28, 1975.

Respondent's answer to the counterclaim petition for cancellation admits the allegations of paragraph 19 but denies the allegations of paragraphs 20 and 21.

As a preliminary matter, we note that the prayer for relief seeks cancellation of the Lapidus registration, without specifying whether one or both classes in the registration should be cancelled. LTI, however, paid one counterclaim fee and, by paragraph 20, only put Lapidus on notice of a claim that Lapidus had abandoned use of its registered mark for the class in the registration covering

leather goods. In addition, the testimony of LTI's witness speaks almost exclusively to the question whether Lapidus has been using its mark for leather goods sold or distributed in the United States. Accordingly, we consider the counterclaim as seeking to cancel only International Class 18 of the Lapidus registration. Irrespective of the issue whether the counterclaim seeks to cancel one or both classes of goods in the registration, LTI has failed to carry its burden of proof as counterclaim petitioner.

In its brief, LTI asserts that Lapidus "has abandoned use of the mark in the '971 registration, for at least three years, and has no intention to resume use of the mark." The foundation for this assertion, however, is infirm. LTI relies on reports prepared by its investigator, Mr. Aglione, and forwarded to counsel on June 27, 2000 and December 18, 2002.<sup>2</sup> Even if we were to accept these reports, and the testimony of the witness, as establishing non-use by Lapidus of its registered mark as early as June 2000 and continuing to December 2002, we would have to infer continuing non-use from the date of the second report until the time of briefing to cobble together a three-year period of non-use. The drawing of such an inference would be improper.<sup>3</sup> There

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<sup>2</sup> December 18, 2002 was two days before the close of LTI's period for presenting evidence in support of its counterclaim.

<sup>3</sup> There is no support for LTI's argument that adverse inferences should be drawn against Lapidus because of its failure to present

is no evidence, and indeed no record, to establish anything beyond the time of trial. Thus, we cannot find that LTI has shown that there has been three years of nonuse, and therefore it has not established prima facie evidence of abandonment. See Trademark Act Section 45, 15 USC 1127.

The question then becomes whether LTI has carried its burden as counterclaim petitioner and established non-use by Lapidus without any intention to resume use. We find that it has not. As the Aglione testimony reveals, the initial investigation of use or non-use by Lapidus resulted only in the witness contacting, and reporting on, a conversation with "an employee of the Commercial division" of Lapidus. Aglione exh. 2, see also, dep. pp. 10-11. We cannot accept this report of a conversation with an unidentified employee as probative evidence that Lapidus then had no intention to make use of its mark in the United States. See In re American Olean Tile Company Inc., 1 USPQ2d 1823, 1824 n. 2 (TTAB 1986) (The report of a statement made by an unknown representative of registrant was accorded no probative value, "especially in the absence of any evidence as to the representative's competency to speak for Simpson regarding its registered mark.") Thus, we accord little weight to the

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evidence in defense of the counterclaim. There is no burden on a defendant to present a case. The burden is on the plaintiff in the first instance to establish a prima facie case and thereby shift the burden of persuasion to defendant.

reported statement of the employee that Lapidus, at that time, had no plans to sell leather products in the United States.

As to the second report introduced by the Aglione testimony, while this details names of individuals with whom the witness discussed the availability of Lapidus leather products in the United States, there is no report of statements regarding intent. Rather, there only are statements confirming that Lapidus leather products were not, at the time of trial, available in the United States. Further, Mr. Aglione only testified that his conclusion, based on each report, was that Lapidus does not sell leather goods in the United States; he drew no conclusion on intent. Aglione, pp. 11, 17.

LTI's counterclaim for cancellation of the Lapidus registration must fail for lack of proof of either a prima facie case of abandonment or of non-use coupled with absence of any intent to resume use.

Decision: The counterclaim petition for cancellation is dismissed.