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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Cromosoma S.A.
v.
Nicole Lambert

Cancellation No. 92041371

Julie B. Seyler of Abelman Frayne & Schwab for Cromosoma S.A.

Patrick T. Perkins and Laura Popp-Rosenberg of Fross, Zelnick, Lehrman & Zissu for Nicole Lambert.

Before Quinn, Holtzman and Rogers, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

Cromosoma S.A. petitioned to cancel a registration owned by Nicole Lambert of the mark shown below



for "stationery, notebooks, memorandum books, pen and pencil cases made of cardboard or paper, writing paper, folders

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made of paper, cardboard or plastic for filing, pencils and pens (in International Class 16) and "dolls" (in International Class 28).¹ As grounds for cancellation petitioner asserts that it is the owner of the mark shown below



for a variety of goods, including multimedia software featuring cartoons, computer game and video game software, books featuring cartoons, posters, stationery, clothing, toys and dolls; that it has filed an application (Serial No. 75326428) to register the mark, and that registration has been refused under Section 2(d) of the Trademark Act on the basis of respondent's registration sought to be cancelled herein; and that respondent's registered mark has been abandoned due to discontinued use with an intent not to resume use.

Respondent, in her answer, denied the salient allegations of the claim of abandonment.

The record consists of the pleadings; the file of the involved registration; trial testimony, with related

¹ Registration No. 2251561, issued June 8, 1999.

exhibits, taken by respondent;² the file contents of petitioner's application, and respondent's responses to certain of petitioner's interrogatories, all introduced by way of petitioner's notice of reliance; and respondent's responses to certain of petitioner's interrogatories made of record in respondent's notice of reliance pursuant to Trademark Rule 2.120(j)(5). Both parties filed briefs. An oral hearing was not requested.

Respondent is a French citizen who is an artist, designer and writer behind a set of cartoon characters known in French as "Les Triplés," and in English as "The Triplets." Ms. Lambert testified that the cartoons have been available in Europe (mostly France), Asia and the United States. The twentieth anniversary of the creation of the cartoon characters was recently celebrated, and Ms. Lambert claims that, during this twenty-year period, she has sold over one million books featuring "Les Triplés." Ms. Lambert testified that licensed products bearing her mark have been sold in the United States since 1999.

The underlying application for the involved registration (Serial No. 74180462) originally was based on

² Petitioner objected to the introduction of exhibit no. 13 on the ground that it is irrelevant and was not timely produced during discovery. Petitioner has requested that the exhibit be stricken. Respondent maintains that the exhibit is relevant and that it became available only shortly before the date of the testimonial deposition. The objection is overruled, and the

an intention to use the mark in commerce, with a claim of priority based on a French application. The original application listed goods in five International Classes. Respondent subsequently filed a statement of use claiming use of the mark in those five classes beginning in 1996. The Office objected to the specimens submitted in support of the statement of use on the basis that the mark(s) shown on the specimens did not match the mark shown in the drawing. Respondent later deleted three classes (3, 18 and 25), the specimens for the two remaining classes were accepted, and the registration ultimately issued in Classes 16 and 28.³

Petitioner established its standing by virtue of the Section 2(d) refusal of its application on the basis of respondent's registration. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); and *The Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990). Respondent has not disputed this point. Accordingly, petitioner may be heard on its claim of abandonment.

Section 45 of the Trademark Act provides, in pertinent part, that a mark is abandoned when the following occurs:

exhibit has been considered for whatever probative value it merits.

³ Although respondent's statement of use in these two classes listed only a portion of the goods originally set forth in the application, the Office inadvertently failed to list the goods in the registration accordingly. The Office registered the mark for the complete list of goods originally set forth in Classes 16 and 28 rather than the reduced list respondent specified in its statement of use. Respondent subsequently notified the Office of the error, and the involved registration was corrected.

When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for three consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

A party claiming abandonment has the burden of establishing the case by a preponderance of the evidence. Introduction of evidence of nonuse of the mark for three consecutive years constitutes a prima facie showing of abandonment, whereby intent not to resume use is inferred, and shifts the burden to the party contesting the abandonment to show either evidence sufficient to disprove the underlying facts showing three years nonuse, or evidence of an intent to resume use to overcome the presumed fact of no intent to resume use. *Rivard v. Linville*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990); *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989); and *Stromgren Supports, Inc. v. Bike Athletic Company*, 43 USPQ2d 1100 (TTAB 1997). The ultimate burden of persuasion remains with the party claiming abandonment to prove abandonment by a preponderance of the evidence. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).

Respondent asserts that her evidence "shows that respondent has continued through the present to market and exploit 'The Triplets' characters and her registered mark in the United States, both for goods listed in the registration as well as for other related goods." (Brief, p. 5).

Respondent goes on to state (Brief, p. 5):

During the period at issue in these proceedings, respondent made continuous and concerted efforts to find opportunities to use her trademark on goods in the United States, including the goods in her registration. Since respondent is herself more of an artist than a merchandiser, most of her efforts were directed towards finding appropriate licensees for merchandise connected to 'The Triplets' and bearing respondent's mark.

Contrary to respondent's contentions, the record fails to establish any use by respondent or a licensee of the registered mark on the specific goods listed in the involved registration for the three-year period preceding December 20, 2002, that is, the date of filing of the petition. In response to Interrogatory No. 1, respondent set forth the goods on which respondent asserts she has made continued use of her registered mark in the United States, during the three years prior to the filing of the petition for cancellation. The only item in the response that is also listed in the registration is "stationery."

In connection therewith, respondent makes much of the fact that she entered into a license agreement with Nikkel

Sprl to manufacture and sell stationery featuring "The Triplets" characters. The license agreement was dated October 1, 1997 and ran for two years, that is, until September 30, 1999. Ms. Lambert testified that she had not shipped any stationery to the United States because "I am in charge of the book, but generally it's not me who ships things, it's the licensees." (Dep. p. 82). It is noteworthy, however, that this agreement did not specifically reference or reproduce the registered logo mark. Further, respondent was able to produce only one sales receipt (showing a sale dated July 27, 1999) of merchandise labeled on the invoice merely as "Les Triplés" with no accompanying design. Respondent claims "it is likely that some of the goods Nikkel sold to retailers in the United States would have remained on the shelves after the termination date of the license and into the supposed abandonment period." (Brief, p. 10). Respondent was asked if she had any examples of uses of the mark on stationery and notebooks, and she answered, "I think so. I think so. I can't tell you, you know, I make so many things." (Dep. p. 55). Respondent defends against petitioner's criticism over the lack of labels and tags for the goods by stating that due to the licensing of merchandise, "it is the licensees and not respondent that keep and control the inventory of merchandise, and it is therefore not surprising

that [respondent] would not possess any labels or tags herself." (Brief, p. 11). Be that as it may, this lone receipt, evidencing a sale more than three years prior to the filing of the petition for cancellation, is the only documentary evidence of any sale at any time of any merchandise purportedly bearing the registered mark. Further, the receipt does not indicate the nature of the products sold. No other examples of use, whether receipts, tags, labels or otherwise, were ever produced or made of record. Simply put, the record is devoid of any other evidence to show that the registered mark was used in the ordinary course of trade on any of the goods listed in the involved registration.

Respondent's nonuse of the registered mark for the relevant goods for at least the three years preceding the filing of the petition for cancellation constitutes a prima facie showing of abandonment. The burden thus shifts to respondent to show evidence of an intent to resume use to disprove the presumed fact of no intent to resume use. We find that the circumstances surrounding respondent's nonuse warrant a finding that the nonuse was accompanied by the absence of any intent to resume use of the mark in connection with the listed goods in Classes 16 and 28. The fact that the registered mark may not be abandoned on other non-related goods is not dispositive proof to the contrary;

rather, we must focus our attention on the specific goods listed in the registration sought to be cancelled.

According to respondent, "[a] significant portion of respondent's business involves the licensing of her characters on merchandise." (Brief, p. 4). Respondent contends that she made continuous and concerted efforts to find opportunities to use her trademark on goods in the United States, and that because she is more of an artist than a merchandiser, most of her efforts were directed toward finding licensees for merchandise bearing her mark. When asked if she had a licensing agent in the United States, respondent replied, "I am working on it, I am making lots of contacts...." (Dep. p. 47). As the evidence "best reflective" of these licensing efforts (Brief, p. 5), respondent points to her attendance at the New York Licensing Fair in 2002. At the show, according to Ms. Lambert, she distributed a licensing booklet to potential licensees (ex. no. 18), and respondent refers, in a general fashion, to her discussions with others about creating an animated series around her cartoon characters.

The twenty-eight-page booklet mainly comprises a series of cartoon strips, storyboards, and pages containing facts about Ms. Lambert and her characters. The last two pages of the booklet (the quality of the photocopy thereof in the record is extremely poor) shows various products, including

a board game, plates and cups, book bags and an A-B-C alphabet chart. We are unable to discern, however, any products that are listed in the involved registration and bearing the registered mark. In point of fact, a review of the entire booklet shows no use of the registered logo mark, but only use of "Les Triplés" and "The Triplets."

Respondent asserts that she has made contacts with numerous potential licensees, and that she is still involved in "serious negotiations" with a production company (Big Cat Productions) regarding an animated series for her characters.

Ms. Lambert also testified about her efforts to sell children's books and to develop licensees for a variety of collateral products. In Ms. Lambert's words, "Yes, I am very much working at it [developing licenses] since quite a long time....things take time." (Dep. p. 42). According to respondent, the market for merchandise bearing respondent's mark depends, to a certain extent, on the creation of an audience for respondent's cartoon characters. In this connection, respondent points to her contacts with Distribooks, Inc. in the fall of 2002 for a book featuring "The Triplets." Respondent also began negotiations in late summer or early fall 2003 with One Nation Films, LLC to produce a film featuring respondent's characters.

The above testimony fails to establish any use of the mark in connection with the specific goods listed in the involved registration. We appreciate respondent's remarks to the effect that licensing prospects rise and fall on the success of her literary works. Here, given the shortcomings of her attempts to line up a film and animated series, it is not surprising that licensing of merchandise bearing respondent's registered mark in the United States has been nonexistent. The simple fact remains that respondent has not identified one executed agreement with any licensee showing continued use of the mark on any item listed in the registration. Further, the negotiations with One Nation Films, LLC began after the prima facie three-year period of nonuse.

Respondent, both in her testimony and in her brief, recounted her efforts to obtain licensing agreements in very broad and general terms. No specific details are given about the depth of any discussions with any particular prospective licensees for any of respondent's goods listed in the involved registration. When asked if she always had "a product in the market in every category at a given time," respondent replied "I can't answer you that, you know, because things change and you are not sure to get all the time everything, you know." (Dep. p. 49). When directly asked whether or not respondent had used the mark on certain

of the identified goods, Ms. Lambert typically responded, "I think so." (Dep. pp. 55-57). And, when asked about packaging or written license agreements, respondent answered, "maybe I can find some." (Dep. pp. 76-77). Respondent did testify, with little or no corroborating documents, about uses of her mark on children's books, cartoons, prints, posters, tape dispensers, snow globes, shoes, perfumes, cosmetics and photographs. None of these products, however, is listed in the involved registration's identification of goods or otherwise is so closely related to the listed goods as to avoid abandonment.

Although respondent indicated at her deposition that any other license agreements would be produced if not already produced, no additional agreements were given to petitioner: "You asked me [if] I am working on some [license agreements], and there are some, yes, of course, you have some of the license agreement[s], but maybe I can find some." (Dep. p. 77). The following exchange (Dep. p. 69) is illustrative of the lack of knowledge, let alone documentary evidence, relative to continued use of the registered mark on the identified goods:

Do you know the--can you specify, to the best of your recollection, what goods are covered in the license agreements with respect to the United States?

No, I can't.

The record establishes that there was no use of the registered mark in connection with stationery, notebooks, memorandum books, pen and pencil cases made of cardboard or paper, writing paper, folders made of paper, cardboard or plastic for filing, pencils, pens and dolls for at least the period December 1999-December 2002. Although respondent attempted to secure deals for a book or film, no concrete attempts involved goods covered in the subject registration.

Respondent, in confronting the evidence of record, essentially urges the Board to adopt a special rule when a mark is used in connection with literary property that is sought to be licensed to third parties. Respondent contends that "[w]hile, in regard to trademarks, use of the trademark on a good other than that covered by the registration may be irrelevant to show intent to resume use on covered items, this general rule [is] inapposite to this particular case." Respondent goes on to argue as follows:

This case is in a different category because respondent's mark relates to a literary property that is to be licensed to third parties. Respondent must maintain a market and a following for the literary characters to increase the interest in licenses for use of those characters and respondent's mark on merchandise. Respondent maintains the market for the literary characters by using or licensing them--and her mark--for use in connection with primary media such as books, comic strips and television programs. These media uses of respondent's characters and mark expand the market for merchandise

licenses, including for the goods covered by the registration, such as stationery, notebooks, pencils and dolls. Therefore, evidence that respondent used, licensed or negotiated to license her characters "The Triplets" and her registered trademark to be used in connection with such things as books, a comic strip, an animated television series, and a film is further evidence of registrant's intention to continue licensing her mark with the goods listed in the registration.

Moreover, registrant's success in other product categories further demonstrates her intent. Therefore, licenses involving goods such as perfumes and cosmetics, footwear, prints and posters, and tape dispensers and globes, not only show respondent's licensing efforts for those items, but also represent evidence that respondent has not abandoned its registration.

For these reasons, respondent's successful efforts to license her trademark in connection with goods not covered by the registration are relevant to the question of whether she has maintained a continuing effort to resume use of the registered mark in connection with the goods covered by that registration.

(Brief, pp. 15-16)(citations to record evidence omitted).

We note, at the outset, that any case law citations to support this theory are conspicuously absent from the brief. Indeed, we know of no case law that lends credence to respondent's theory. To take respondent's position to an extreme, an owner of a literary property (such as a cartoon strip or animated series featuring a character) could

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reserve the mark for a universe of goods far exceeding the specific goods for which the mark is used and/or registered. Clearly, this is not permissible. See *Imperial Tobacco Ltd. V. Philip Morris Inc.* supra at 1394 ["the Lanham Act was not intended to provide a warehouse for unused marks"]. As earlier noted, any analysis of abandonment and an intent not to resume use must focus on the specific goods in the registration sought to be cancelled. Id. at 1395 [strategy of marketing "incidental" products such as whisky, pens and watches did not excuse nonuse of mark on cigarettes].

Respondent's self-serving testimony that she never intended to abandon the mark is simply outweighed by the objective evidence supporting the conclusion that the mark was abandoned with no intent to resume use on the specific goods listed in the involved registration.

Decision: The petition for cancellation is granted, and Registration No. 2251561 will be cancelled in due course.