

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB**

Mailed:

July 12, 2005
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Andre Romanelli, Inc.

v.

Jon Weiser

Cancellation No. 92042567

Myron Amer of Myron Amer, P.C. for Andre Romanelli, Inc.

Eric D. Offner of Law Offices of Eric D. Offner for Jon Weiser.

Before Hohein, Drost and Kuhlke, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Andre Romanelli, Inc. has petitioned to cancel the registration, currently owned by Jon Weiser, of the mark "CHARIVARI" for "retail clothing store services" in International Class 42.¹

As grounds for cancellation, petitioner alleges that it "sells 'men's and women's clothing' under the mark CHARIVARI"; that petitioner owns "application Serial No. 76/466,692, filed November 4, 2002, for the mark CHARIVARI for 'men's and women's

¹ Reg. No. 1,387,851, issued on March 25, 1986 from an application filed by Charivari, Ltd. on August 15, 1985, which sets forth a date of first use anywhere and in commerce of April 4, 1967; combined affidavit §§8 and 15.

clothing"; that such application "has been refused as likely to cause confusion, or to cause mistake, or to deceive, in view of registrant's ... registration No. 1,387,851" for the mark "CHARIVARI"; and that, "[u]pon information and belief, registrant has abandoned said registered mark by discontinuing use of said mark with no intent to resume said use."

Respondent, in his answer, has denied the allegations of the petition to cancel.

The record consists of the pleadings; the file of the involved registration; a notice of reliance filed by petitioner as its case-in-chief² on, *inter alia*, (i) a copy of its pleaded application as initially filed; (ii) a copy of the filing receipt for such application; and (iii) a copy of respondent's responses to petitioner's "Requests for Admission 8, 11, 12, 13, 14, 16, 17, 18 and 19 and correspondingly numbered interrogatories"; and a notice of reliance filed by respondent as his case-in-chief on (i) copies of certain official assignment records and (ii) his responses to petitioner's "requests for admission nos. 6, 7 and 20 to avoid unfair interpretations of the responses offered by Petitioner." Neither party, however, took testimony or submitted any other evidence. Both parties filed a main brief³ and

² Although such notice was filed on May 17, 2004 (the day after the discovery period closed) rather than during petitioner's initially assigned testimony period, the Board in its September 9, 2004 order, which among other things denied respondent's August 19, 2004 contested motion to dismiss this proceeding under Trademark Rule 2.132(a), stated that "[d]espite its being premature, the Board will consider" petitioner's notice of reliance as forming part of the record herein.

³ Although respondent, in his main brief, has raised various "OBJECTIONS TO EVIDENCE RELIED ON BY PETITIONER," such objections

petitioner submitted a reply brief. Neither party requested an oral hearing.

According to the record, petitioner filed application Serial No. 76466692 on November 4, 2002 seeking registration of the mark "CHARIVARI" for "men's and women's clothing" based on an allegation of a bona fide intention to use such mark in commerce. No other information concerning the file history of petitioner's application, however, was submitted, nor is there any evidence as to whether petitioner has ever made actual use of its mark.

With respect to respondent's involved registration, the record indicates that such registration was assigned on September 29, 1993 by the original registrant, Charivari, Ltd. (a New York corporation), to Charivari Holding Corp. (a Delaware corporation) and that such assignment was recorded on October 1, 1993 at reel 1045, frame 0122.⁴ Subsequently, on December 6, 2000, the involved registration was assigned by Charivari Holding Corp. to respondent, Jon Weiser (a United States citizen), and the assignment thereof was recorded on December 11, 2000 at reel 2201, frame 0968.

Respondent served his responses to petitioner's combined first requests for admission and interrogatories on

relate essentially to the probative value of certain evidence offered by petitioner rather than to the admissibility thereof.

⁴ Prior thereto, on March 5, 1991, Charivari, Ltd. executed a security interest in such registration to The Merchant's Bank of New York (a New York corporation), which was recorded on March 22, 1991 at reel 0775, frame 0586. Thereafter, on March 26, 1997, The Merchant's Bank of New York issued a release of the security interest to Charivari Holding Corp., which was later recorded on February 28, 2001 at reel 2251, frame 0703.

March 31, 2004.⁵ As of such date, respondent admits, in response to Request for Admission No. 8, that "[t]he premises of 2109 Broadway, Suite 11-109, New York, NY 10023 is not used for 'Retail Clothing Store Services.'" Such address, it is noted, is indicated in the assignment of the involved registration to respondent to be the address at which he is residing. Respondent also admits, in response to Request for Admission No. 11, that "Charivari, Ltd. does not currently provide retail clothing store services at 2315 Broadway, New York, NY 10024." As stated in the assignment of the involved registration to Charivari Holding Corp., such address is the "principal office" of Charivari, Ltd. Respondent further admits, in response to Request for Admission No. 12, that "Charivari[,] Ltd. does not provide retail clothing store services at any location" and admits, in response to Request for Admission No. 13, that "Charivari[,] Ltd. has not provided retail clothing stores services at any location since March 1, 2001." While respondent additionally admits, in response to Request for Admission No. 14, that "Charivari[,] Ltd. used the telephone number (212) 362-1212," he admits, in response to Request for Admission No. 16, that "[t]here is currently no listed telephone number for Charivari[,] Ltd" and admits, in response to Request for Admission No. 17, that "[t]here has been no listed telephone number for Charivari[,] Ltd. since March 1, 2001."

⁵ Inasmuch as each corresponding interrogatory merely states that "[i]f Respondent denies the admission statement, please state the factual basis for the denial," respondent simply answered "[n]ot applicable" in each instance in which he admitted an admission statement.

Furthermore, respondent admits, in response to Request for Admission No. 18, that "Jon Weiser is a founder of Charivari, Ltd.," provided that "the undefined term 'founder,'" because it is objected to by respondent as "vague and ambiguous," is construed "to mean an initial shareholder." Moreover, respondent admits, in response to Request for Admission No. 19, that "Jon Weiser is not currently active in providing retail clothing store services for Charivari, Ltd." However, respondent denies, in response to Request for Admission No. 20, that "Jon Weiser has not been providing retail clothing store services for Charivari, Ltd. since March 1, 2001" and states, instead, in answer to Interrogatory No. 20, that the factual basis for such denial is that "[r]etail store services are being provided in connection with the sale of CHARIVARI branded products."⁶ Finally, in addition to the above-noted copy of the recorded assignment of the involved registration to him, respondent admits, in response to Request for Admission No. 6, that such "[r]egistration and the goodwill symbolized thereby was also assigned to Jon Weiser of 2109 Broadway, Suite 11-109, New York, NY 10024" and admits, in response to Request for Admission No. 7, that (as previously

⁶ While respondent's notice of reliance, unlike that filed by petitioner, does not specifically include reliance on answers to correspondingly numbered interrogatories, respondent's answer to Interrogatory No. 20 is considered to form part of the record in this proceeding inasmuch as respondent so treats such evidence in his brief and petitioner, in both of its briefs, does likewise. In particular, petitioner notes in its main brief that "[r]espondent has also made of record additional responses that it filed to Petitioner's Request for Admissions and Interrogatories, specifically Answers numbers 6, 7 and 20," and maintains in its reply brief that: "On the record, the mark in issue has been abandoned by nonuse, and any subsequent use, by Jon Weiser even assuming arguendo to have occurred, does not cure the abandonment retroactively."

mentioned) "[t]he assignment to Jon Weiser was recorded in the USPTO at Reel/Frame 2201/0968 on December 11, 2000."

Petitioner, in its main brief, asserts that "[i]t is clear that the goods/services of the parties are related and that the marks are identical." Petitioner contends, in view thereof, that "[t]he sole issue to be decided by this Board relates to the question of abandonment" However, while not directly raised by respondent in his brief, a preliminary issue herein concerns whether petitioner has also proven its standing to be heard in this case on the issue of abandonment. Specifically, although petitioner claims in its main brief that its application to register the mark "CHARIVARI" for men's and women's clothing "was refused registration by the Examining Attorney on June 2, 2003 based upon a perceived likelihood of confusion with the mark in the registration here sought to be cancelled," respondent, citing *Lasek & Miller Associates v. Rubin*, 201 USPQ 831, 833 n.3 (TTAB 1978) correctly points out in his brief that petitioner has proven only that petitioner filed such an application. While proof that petitioner's application has been refused in an Office action on the ground that its mark is likely to cause confusion with the "CHARIVARI" mark which is the subject of respondent's involved registration would be adequate to establish petitioner's standing to be heard in this case, see, e.g., *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) [to have standing in a cancellation proceeding, "it would be sufficient that appellee prove that it filed an application and that a rejection was made because of appellant's

registration"], there is no proof of such in the record. Absent proof of standing, petitioner cannot prevail in this case.

Nonetheless, even if we were to infer, in light of the identity of the marks and the inherent relatedness between petitioner's men's and women's clothing, on the one hand, and respondent's retail clothing store services, on the other, that confusion would be likely, if not inevitable, and thus that petitioner must be deemed to have standing herein because the Examining Attorney would have to cite respondent's involved registration as a bar to petitioner's application, it is still the case that petitioner has failed to prove its claim of abandonment. Section 45 of the Trademark Act, 15 U.S.C. §1127, defines abandonment of a mark in relevant part as follows:

Abandonment of mark. A mark shall be deemed to be "abandoned" when ... the following occurs:

- (1) 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 the mark.

Petitioner, asserting in its main brief that it "has been unable to find any evidence of actual clothing store service [mark] use by Jon Weiser, the owner of the ... registration [sought to be cancelled]," contends that it consequently "believes that the mark has been abandoned" and that the evidence of record establishes a prima facie case of abandonment.

In particular, petitioner argues in its main brief that the following facts haven been proven and are sufficient to demonstrate that respondent has abandoned the mark "CHARIVARI" for retail clothing store services (underlining in original; footnotes omitted):

The record is clear (USPTO Assignment records) that Jon Weiser obtained ownership of the mark and the registration here in issue on December 6, 2000. [Admission No. 6.] The address given by Jon Weiser in the assignment document was 2109 Broadway, Suite 11-109 New York, NY 10023.

In his Admission No. 8, Weiser admits that this specific address is not used for retail clothing store services. The Admissions Nos. 11-13, inclusive, admit that the predecessor, Charivari, Ltd. (of which Jon Weiser was a founder) does not and has not since at least March 1, 2001 provided retail clothing store services at any location. Further, there is no listed telephone number in the local directories for Charivari, Ltd. and there has been none since at least March 1, 2001. [Admission Nos. 16 and 17.]

Jon Weiser has also admitted that he is not currently active in providing retail clothing store services for Charivari, Ltd. [Admission No. 19.]

We agree with respondent, however, that as pointed out in his brief, the "evidence upon which petitioner relies ... demonstrates only that the original owner of the registration, Charivari[,] Ltd., who assigned the interest in the registration in 1993, has not used the mark subsequent to the assignment by its assignee, Charivari Holding Corp., in 2000, to Weiser." The record plainly shows that the chain of title with respect to the involved registration consists of an assignment thereof (along with the subject mark and the goodwill appurtenant thereto) on

September 29, 1993 from the original registrant, Charivari, Ltd., to Charivari Holding Corp. (which was recorded on October 1, 1993 at reel 1045, frame 0122) and a subsequent assignment of such on December 6, 2000 from Charivari Holding Corp. to respondent, Jon Weiser (which was recorded on December 11, 2000 at reel 2201, frame 0968). Thus, as respondent persuasively observes in his brief:

Charivari, Ltd., a stranger to these proceedings, has not owned the mark since 1993. Its activities and location long subsequent to the assignment of the registration to Weiser's predecessor-- Charivari Holding Corp.--are not relevant or in any way probative of the allegation that Weiser has not used the registered mark. Petitioner has not cited any authority to establish that non-use [sic] of a mark by an assignor, subsequent to the assignment of the mark, has any bearing in the issues in this proceeding.

The petitioner's evidence does not constitute the strict proof necessary for establishing three years of nonuse or an intention not to continue using the mark.

In this case, petitioner has not proved that Jon Weiser has not used the CHARIVARI mark for more than three years immediately preceding the filing of the petition for cancellation. There is a total absence of proof of nonuse--petitioner has not established a prima facie case of abandonment.

Petitioner, in reply, insists that a prima facie case of abandonment has nonetheless been shown, arguing that (underlining in original):

From the filing date of August 15, 1985 of the registration in issue ..., Charivari[,] Ltd. is deemed by law to have used the mark and from such date there is an interval of 15 years to the assignment date of August 2000 which is unexplained.

There is no factual basis for assuming that use by Charivari[,] Ltd. occurred at any time during the 15-year interval. In Answer No. 2, in fact, the opposite seems more logical because "a security interest was granted to the Merchant's Bank of New York in 1991 and released in 1997." (underlining added).

The 15-year interval is narrowed to the 6-year interval between 1991 and 1997, an interval still long enough to constitute abandonment and/or a presumption of an intent to abandon and a shifting of a burden to prove otherwise.

Aside from the fact, however, that respondent's response to petitioner's Request for Admission No. 2 is not part of the record herein and therefore will not be considered, it is plain from the record that the original registrant, Charivari, Ltd., ceased to have any ownership interest in the involved registration, the subject mark and the goodwill appurtenant thereto as of its assignment thereof to Charivari Holding Corp. on September 29, 1993. Moreover, there is no evidence which indicates that Charivari, Ltd., during the time which it was the owner of the involved registration, ceased use of the "CHARIVARI" mark for retail clothing store services for a period of three consecutive years and, thus, had prima facie abandoned such mark prior to the assignment to Charivari Holding Corp.⁷

In addition, we note that the record contains no evidence as to whether Charivari Holding Corp., during the period

⁷ To be clear, if there were a showing of nonuse for a consecutive three-year period which spanned the time during which ownership of the involved registration, the subject mark and the goodwill appurtenant thereto changed (e.g., by an assignment thereof), such would suffice to establish a prima facie case of abandonment. However, the record herein contains no such showing.

from September 29, 1993 until the assignment to respondent on December 6, 2000, ever used--or, more significantly, made no use for three consecutive years of, the subject "CHARIVARI" mark in connection with retail clothing store services. Thus, there is no proof on this record of any prima facie abandonment by Charivari Holding Corp., respondent's immediate predecessor-in-title. Finally, while respondent has admitted that his residence address of 2109 Broadway, Suite 11-109, New York, NY 10023 is not used for retail clothing store services, there is no evidence that respondent, since his acquisition of the involved registration by assignment on December 6, 2000, has not made any use of the subject "CHARIVARI" mark for such services for a period of three consecutive years. To the contrary, respondent has not only denied, in his response to Request for Admission No. 20, that he "has not been providing retail clothing store services for Charivari, Ltd. since March 1, 2001",⁸ but has instead stated, in his answer to Interrogatory No. 20, that the factual basis for such denial is that "[r]etail store services are being provided in connection with the sale of CHARIVARI branded products." Petitioner, therefore, has failed to meet its burden of proof of showing, by a preponderance of the evidence,⁹ that the mark "CHARIVARI" has been abandoned and that respondent's registration thereof should be cancelled.

Decision: The petition to cancel is denied.

⁸ The significance of the March 1, 2001 date is simply not apparent from the record and petitioner has not offered an explanation thereof.

⁹ See, e.g., *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309-10 (Fed. Cir. 1989).