

This Opinion is Not a
Precedent of the TTAB

Mailed: August 12, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Titanium, LLC
v.
ZSPEC Design LLC

—
Cancellation No. 92079042
—

Jacob P. East, and Andrew P. Connors, of Darkhorse Law PLLC,
for Titanium, LLC.

Todd Wengrovsky, of Law Offices of Todd Wengrovsky, PLLC,
for ZSPEC Design LLC.

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Before Lykos, Casagrande, and Stanley,
Administrative Trademark Judges.

Opinion by Casagrande, Administrative Trademark Judge:


Petitioner Titanium, LLC (Petitioner) petitions to cancel Registration No.
5868348 for the mark DRESS UP BOLTS (“BOLTS” disclaimed), in standard

Cancellation No. 92079042

characters, for goods identified as “Metal bolts; Metal hardware, namely, washers,” in International Class 6.¹ Respondent ZSPEC Design LLC owns the ’348 Registration.

The Petition asserts a single claim, alleging priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in light of two trademarks as to which Petitioner alleges prior common law rights in the marks



DRESSUPBOLTS and , in connection with “decorative fasteners, including metal bolts and hardware” beginning in 2010.² The Petition further alleges that Petitioner has filed two applications to register its two asserted trademarks³ and that both applications have been initially refused registration by the USPTO under Trademark Act Section 2(d) in view of Respondent’s registration.⁴


Respondent filed an answer denying the salient allegations in the Petition.⁵

¹ Respondent’s ’348 Registration issued on September 24, 2019, on the Principal Register based on an application filed on March 25, 2019, and claims a date of first use anywhere and in commerce of January 1, 2014.

² See 1 TTABVUE 1-2, 4. Citations in this opinion to filings in proceedings before the Board are to TTABVUE, the Board’s online docketing system. The number preceding “TTABVUE” corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry, as paginated by TTABVUE, where any specifically cited portions of the document appear.

³ See 1 TTABVUE 4. Application Serial No. 90505678 is for the composite mark



, and was filed on February 2, 2021, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a) and seeks registration on the Principal Register. It concerns goods identified as “Structural parts for automobiles,” and lists a date of first use and first use in commerce of January 1, 2010. Application Serial No. 90508223 was also filed under Section 1(a), but a day later on February 3, 2021. It asserts the same dates of first use and identifies the same goods, and is for the standard character mark DRESSUPBOLTS.

⁴ See 1 TTABVUE 5.

⁵ See 5 TTABVUE.

Cancellation No. 92079042

Both parties filed trial briefs,⁶ and Petitioner filed a rebuttal brief.⁷ The case is now ready for decision. Petitioner, as plaintiff, bears the burden of establishing its entitlement to a statutory cause of action and Section 2(d) claim by a preponderance of the evidence. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945 (Fed. Cir. 2000) (“The party seeking cancellation must prove two elements: (1) that it has standing; and (2) that there are valid grounds for canceling the registration.”); *Jansen Enters. Inc. v. Rind*, Canc. No. 92042871, 2007 WL 809857, at *2 (TTAB 2007) (same).⁸ For the reasons explained below, we deny the petition.

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the challenged registration. During its trial period, Petitioner also submitted:

- Declarations from Randall Sass, Seth McGuire, Christopher Driver, and Lewis Bishop, all testifying as to prior use by Petitioner and its predecessors-in-interest of Petitioner’s asserted common law marks;⁹
- A declaration from Robert Demers purporting to opine as an expert on the “legitimacy” of Respondent’s evidence of pre-2014 use of Respondent’s marks;¹⁰ and

⁶ See 31 TTABVUE (Petitioner’s trial brief); 32 TTABVUE (Respondent’s trial brief).

⁷ See 33 TTABVUE.

⁸ This opinion is issued as part of an internal Board pilot citation program on broadening acceptable forms of legal citation in Board cases. It cites decisions of the U.S. Court of Appeals for the Federal Circuit and the U.S. Court of Customs and Patent Appeals only by the page(s) on which they appear in the Federal Reporter (e.g., F.2d, F.3d, or F.4th). Westlaw (WL) citations are used for decisions of the Board, and only precedential Board decisions are cited. This opinion thus conforms to the practice set forth in TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 101.03 (2024).

⁹ See 6 TTABVUE 2-117.

¹⁰ See *id.* at 118-39.

Cancellation No. 92079042

- A Notice of Reliance attaching print-outs of results from the Internet Archive's Wayback Machine purporting to reflect webpages and articles bearing on Respondent's claim of priority dating back to 2008, screenshots of Petitioner's Facebook posts, excerpts from certain of Respondent's discovery responses, and the transcripts of discovery depositions of Respondent's founder (Christopher Karl) and Respondent's Chief Executive Officer (Karen Karl).¹¹

Respondent submitted:

- The Testimony Declarations of Christopher Karl and Karen Karl testifying as to Respondent's pre-2014 use of its marks;¹² and
- A Notice of Reliance attaching evidence of Respondent's purported use of its mark before 2014, Respondent's articles of incorporation, and the application that matured into the registration Petitioner seeks to cancel.¹³

II. Petitioner's Entitlement to Institute a Cancellation Proceeding under Section 14.

In every inter partes case, the complaining party case must establish that it is entitled to invoke the statute on which the proceeding is based. *See, e.g., Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 1071-72 (Fed. Cir. 2022). This cancellation proceeding is based on Trademark Act Section 14, 15 U.S.C. § 1064. To establish that it is entitled to bring a cancellation proceeding, Petitioner must demonstrate: (i) an interest falling within the zone of interests protected by Section 14; and (ii) proximate causation. *See, e.g., Corcamore, LLC v. SFM, LLC*, 978 F.3d

¹¹ *See* 7 TTABVUE.

¹² *See* 17 TTABVUE (Christopher Karl); 18 TTABVUE (Karen Karl). Because these declarations were submitted a day after Respondent's testimony period ended, Petitioner moved to strike them, but the Board denied the motion and extended the time for Respondent to re-file and re-serve the two declarations. *See* 26 TTABVUE (Board order); 27 TTABVUE (re-filed Christopher Karl Decl.); 29 TTABVUE (re-filed Karen Karl Decl.).

¹³ *See* 28 TTABVUE.

Cancellation No. 92079042

1298, 1303 (Fed. Cir. 2020) (citing *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 120-37 (2014)); *id.* at 1305 (applying *Lexmark* to inter partes TTAB cases). Demonstrating a real interest in cancelling a registration satisfies the zone-of-interests requirement, and demonstrating a reasonable belief in damage by the registration of a mark demonstrates proximate cause. *Id.* at 1305-06.

Petitioner alleges it is entitled to petition under Section 14 based in part on its ownership of the two previously-identified pending trademark applications and in part on its prior common law use of its two pleaded marks.¹⁴ Petitioner also alleges that its applications have been refused registration based on a likelihood of confusion with Respondent's mark.¹⁵ Petitioner, however, failed to make of record a copy of either pleaded pending application, nor did it make of record any evidence showing the current status and title of the applications or the Office Actions refusing registration. Thus, Petitioner has only alleged, but not proved, that it is entitled to invoke the cancellation statute based on the status of its pending applications. *See, e.g., WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, Opp. No. 91221553, 2018 WL 1326374, at *5-6 (TTAB 2018).

Petitioner also alleges its entitlement to pursue this statutory cancellation proceeding in part based on its prior common law use of its marks and because of alleged demands made by Respondent that Petitioner's distributors cease and desist

¹⁴ *See* 1 TTABVUE 4-5.

¹⁵ *See id.* at 5.

Cancellation No. 92079042

selling Petitioner's products.¹⁶ In contrast to its failure to introduce its applications and the alleged refusals, Petitioner has, in fact, introduced evidence of its use of its



alleged common law marks DRESSUPBOLTS and in connection with washers, nuts, and bolts.¹⁷ This suffices to demonstrate that Petitioner is entitled to have filed this statutory cancellation proceeding. *See, e.g., Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1029 (CCPA 1982) (petitioner establishes entitlement (formerly called "standing") to bring a cancellation proceeding by showing "a real commercial interest in its own marks, and a reasonable basis for its belief that it would be damaged" by the subject registration); *Giersch v. Scripps Networks Inc.*, Canc. No. 92045576, 2009 WL 706673, at *4-6 (TTAB 2009) (plaintiff's continuous common law use of designation similar to the subject registered mark entitled it to petition to cancel).¹⁸

III. Analysis

Having determined that Petitioner is entitled to file this Section 14 cancellation proceeding, we turn to the merits. As noted, Petitioner's sole claim is under Section

¹⁶ *See id.*

¹⁷ *See* exhibits to Testimony Declarations of Randall Sass, Seth McGuire, Christopher Driver, and Lewis Bishop, 6 TTABVUE 2-117.

¹⁸ We do not see any evidence in the record of the alleged demands made by Respondent to Petitioner's distributors. Were there such evidence, that alone would have satisfied the statutory entitlement requirement. *See, e.g., Books on Tape, Inc. v. Booktape Corp.*, 836 F.2d 519, 520 (Fed. Cir. 1987) (finding standing because the petitioner, as a competitor of the respondent, had an interest in the outcome beyond that of the general public). But in the absence of such evidence, the allegation alone does not suffice.

Cancellation No. 92079042

2(d) of the Trademark Act, which prohibits registration of a mark that “so resembles ... a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d).

There are two elements to a claim under Section 2(d). “[A] party petitioning for cancellation under section 2(d) must show [1] that it had priority and [2] that registration of the mark creates a likelihood of confusion.” *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1162 (Fed. Cir. 2002) (bracketed numbers added); *see also Hornby v. Tjx Cos.*, Canc. No. 92044369, 2008 WL 1808555, at *9 (TTAB 2008) (“In order to prevail on her claim of likelihood of confusion (Section 2(d) of the Trademark Act), petitioner must prove both the elements of priority of use and likelihood of confusion.”).

Here, Petitioner’s opening brief fails to make any mention, let alone argument, of the second element: that confusion is likely. Instead, it is entirely devoted to the issue of priority. Priority of use, however:

is not a stand-alone claim, but rather one element of a likelihood of confusion claim under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d). Thus, in order to prevail on its pleaded likelihood of confusion claim ... , Petitioner must prove both priority of use of its pleaded mark **and** a likelihood of confusion.

Empresa Cubana Del Tabaco v. Gen. Cigar Co., Canc. No. 92025859, 2022 WL 17844056, at *21 n.7 (TTAB 2022) (citations omitted; emphasis added). Respondent’s trial brief correctly states that the “[t]he issues presented are whether Petitioner ... has proven that it used its mark ... prior to Registrant ZSPEC Design’s ... usage of

Cancellation No. 92079042

its mark, and whether the marks at issue are likely to be confused with one another.”¹⁹ Respondent further succinctly points out, however, that Petitioner has not “proven that the marks at issue are likely to be confused with one another.”²⁰

We agree with Respondent. In adversary proceedings like this one, it is not the Board’s responsibility to create plaintiffs’ arguments for them. Because Petitioner failed to make any argument at trial on the second required element of its Section 2(d) claim—likelihood of confusion—its petition, which asserts only a Section 2(d) claim, necessarily fails. *See, e.g., WeaponX Performance Prods.*, 2018 WL 1326374, at *2 (claims not mentioned in briefs deemed waived); *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, Canc. No. 92050879, 2013 WL 5407315, at *2 (TTAB 2013) (same), *aff’d mem.*, 565 F. App’x 900 (Fed. Cir. 2014); *see also* TBMP § 801.01 (“If a party fails to reference a pleaded claim or affirmative defense in its brief, the Board will deem the claim or affirmative defense to have been waived or forfeited.”). Because Petitioner’s claim necessarily fails due to Petitioner’s failure even to address the element of likelihood of confusion, we need not resolve whether Petitioner has established the element its trial briefs did address: priority. *See, e.g., Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, Opp. No. 91175091, 2009 WL 691309, at *6 (TTAB 2009) (“We need not reach the issue of likelihood of confusion because without proof of priority, opposer cannot prevail.”); *Life Zone Inc. v. Middleman Grp., Inc.*, Opp. No.

¹⁹ *See* 32 TTABVUE 5.

²⁰ *See id.* Our review of the filings and evidentiary record confirms that Respondent, who denied all the salient allegations in the Petition, nowhere agreed that confusion is likely.

Cancellation No. 92079042

91160999, 2008 WL 2781162, at *8 (TTAB 2008) (same).²¹ Accordingly, Petitioner has failed to establish by a preponderance of the evidence its Section 2(d) claim.

Decision: The petition is denied.

²¹ We need not reach Petitioner's request that we reverse the Board's prior order denying Petitioner's motion to strike the declarations of Christopher and Karen Karl, *see* 31 TTABVUE 17-19, because these declarations concern only priority and the request is therefore moot in light of our disposition of the claim.