

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: August 23, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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City of Dallas
v.
Triple D Gear, LLC
—

Cancellation No. 92077406
—

Elisabeth A. Evert of Hitchcock Evert LLP,
for City of Dallas.

Kimberlee A. Boyle of Richard Law Group, Inc.,
for Triple D Gear, LLC.

—
Before Zervas, Goodman, and Allard,
Administrative Trademark Judges.

Opinion by Allard, Administrative Trademark Judge:

Triple D Gear, LLC (“Respondent” or “Registrant”) owns a registration on the
Principal Register for the mark:



for, among other things, shirts, hat, and t-shirts in International Class 25 (“Ghost Logo”).¹ The registration contains the following statement: “The mark consists of three concentric lines shaped in the form of a stylized letter ‘D.’” Color is not claimed as a feature of the mark.

The City of Dallas (“Petitioner”) seeks cancellation of Respondent’s registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), alleging Respondent’s mark so resembles Petitioner’s common law mark:



(“City Logo”), that it is likely to cause confusion, or to cause mistake, or to deceive. Petitioner alleges that it “has prominently used the City Logo on, *inter alia*, wayfinding signage, street signs, municipal buildings, motor vehicles, employee uniforms, utility bills, social media accounts, marketing and informational materials, and other customary ways in which a municipal government interacts with its constituents.”² Petitioner also alleges that “[its] employees frequently wear clothing and hats that display the City Logo[;]” and that “[Petitioner] and many other municipalities produce or license others to produce t-shirts, hats, and other souvenirs that bear a municipality’s trademark ... to promote tourism.”³ Petitioner also alleges

¹ Registration No. 6141994, issued September 1, 2020, from an application (Serial No. 88850773) filed on March 27, 2020.

² Petition for Cancellation, para. 4 (1 TTABVUE 4).

³ *Id.* para. 9 (1 TTABVUE 4).

that it has applied to register its City Logo, that the applications have been assigned Serial Nos. 90/132,764 and 90/132,560 (the “560 application”), and that the mark of the ’560 application has been refused registration, in part, based on a likelihood of confusion with Respondent’s registered Ghost Logo mark.⁴

In its Answer, Respondent admits that (1) Petitioner provides municipal services to residents of the City of Dallas;⁵ (2) “the City Logo appears on Petitioner’s fleet of vehicles that are used in the provision of certain municipal services, and on the uniforms of certain of Petitioner’s employees[;]”⁶ (3) the pending applications “speak for themselves”;⁷ and (4) “the uniforms of certain of Petitioner’s employees display the City Logo.”⁸ Respondent denied the remaining allegations.

The case is fully briefed. Petitioner, as plaintiff in this proceeding, bears the burden of establishing its statutory entitlement to a cause of action and its Section 2(d) claim by a preponderance of the evidence. *See Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *9 (TTAB 2022). Having considered the evidentiary record, the parties’ arguments and applicable authorities, we deny the petition for cancellation.

⁴ *Id.* paras. 5, 10 (1 TTABVUE 4, 5).

⁵ Answer, para. 1 (8 TTABVUE 2).

⁶ *Id.* para. 4 (8 TTABVUE 2).

⁷ *Id.* paras. 5, 10 (8 TTABVUE 3).

⁸ *Id.* para. 9 (8 TTABVUE 3).

I. The Record and Evidentiary Matters

Before proceeding to the merits of the refusal, we address the record and an evidentiary matter.

A. Record

The record consists of the pleadings, and by operation of Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1), the file of the registration subject to the petition for cancellation.

Petitioner did not submit any testimony but did submit the following notice of reliance evidence:

- First Notice of Reliance on the discovery deposition of Arturo Sanchez as the corporate representative of Respondent (“Sanchez Depo.”), and exhibits thereto;⁹
- Second Notice of Reliance on certain of Respondent’s answers to interrogatories and requests for admission;¹⁰
- Third Notice of Reliance on printed publications: (1) a printout of a website featuring a video segment titled, “Show off your love for Dallas with Triple D Gear,” which aired on *Good Morning Texas* (WFAA), December 17, 2018 (Exhibit 7); (2) a copy of a newspaper article titled, “City Gets New Symbol,” *The Dallas Morning News*, August 11, 1972 (Exhibit 8); a copy of a newspaper article titled, “Designs End Problems,” *The Dallas Morning*

⁹ The deposition transcript is available at 13 TTABVUE. The deposition exhibits are comprised of several filings: Exhibits 1-6 (14 TTABVUE); Exhibits 7-14 (15 TTABVUE); Exhibits 15-20 (16 TTABVUE); Exhibits 21-22 (17 TTABVUE); and Exhibits 23-27 (18 TTABVUE).

¹⁰ 19 TTABVUE. The responses to the requests for admission include a mix of admissions and denials, but we consider only Respondent’s admissions. Trademark Rule 2.120(k)(3)(i), 37 C.F.R. § 2.120 (k)(3)(i); *Life Zone Inc. v. Middleman Grp. Inc.*, 87 USPQ2d 1953, 1957 & n.10 (TTAB 2008) (denials of requests for admission not admissible; the denial of a request for admission establishes neither the truth nor the falsity of the assertion, but rather leaves the matter for proof at trial).

News, April 29, 1973 (Exhibit 9); and “Bust Out the D-Shaped Cake: Dallas’ Logo Turns 40 This Year,” *Dallas Observer*, June 27, 2012 (Exhibit 10);¹¹

- Fourth Notice of Reliance on Official Records consisting of certificates of registration for two of Respondent’s marks: the Ghost Logo mark (Reg. No. 6141994) and the Tilted Star mark (Reg. Nos. 4586688 and 6330048);¹² and
- Fifth Notice of Reliance on Official Records, consisting of select filings from (1) *Youssef v. Jackson*, Cause No. CD-13-01632 in the 101st Judicial District Court of Dallas County, Texas; and (2) *Youssef v. Jackson*, Cancellation No. 920055839, in the United States Patent and Trademark Office (USPTO) before the Trademark Trial and Appeal Board.¹³

¹¹ 22 TTABVUE. The webpage printout featuring the video segment (Exhibit 7) only shows a still image of the video; it is not possible to play the video. Respondent indicates in a footnote that “[a] copy of the video will be submitted to the Board, and it is also available at [the provided link].” Petitioner’s Third Notice of Reliance, p. 1 n.1 (22 TTABVUE 2). However, the video itself was not made of record.

Further, Petitioner’s providing a link to the video content is insufficient to make the video itself of record. *TV Azteca, S.A.B. de C.V. v. Martin*, 128 USPQ2d 1786, 1790 n.14 (TTAB 2018) (Providing an Internet link to an online article is insufficient to make the article of record because the information displayed at a link’s Internet address is impermanent. “The Board does not accept Internet links as a substitute for submission of a copy of the resulting page.”). *See also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 704.08(b) (June 2023) (“Providing only a web address or a hyperlink without the material attached is not sufficient to introduce it into the record.”) and cases cited therein.

We add that the printed publications made of record under a notice of reliance are only admissible for what they show on their face; unless they fall within an exception to the hearsay rule, they will not be considered to prove the truth of any matter stated therein. *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1717 n.2 (TTAB 2007).

Finally, the photocopies of the newspaper articles are difficult to read, even when enlarged, and some portions are illegible. It is the filing party’s responsibility to ensure that all submissions are legible. *See, e.g., Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1404 (TTAB 1998) (“It is [the filing party’s] responsibility to review documents it submits as evidence to ensure that such submissions meet certain basic requirements, such as that they are legible”).

¹² 20 TTABVUE. Exhibit 12 consists of, inter alia, the certificate of registration of the involved registration. As the file of the involved registration is automatically of record, this copy of the certificate of registration is superfluous. Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1).

¹³ 21 TTABVUE.

Respondent introduced the following evidence:

- First Notice of Reliance on the Testimony Declaration of Alfredo Arturo Sanchez, CEO of Respondent (“Sanchez Test.”).¹⁴

Petitioner did not cross-examine Respondent’s witness.

B. Evidentiary Objections

Respondent attaches to its main brief an appendix of objections.¹⁵ In it, Respondent objects to ten pieces of evidence, asserting that the evidence is irrelevant because it pertains to Respondent’s Tilted Star mark, which is not the subject of the present proceeding as it was not pled by Petitioner in the petition for cancellation.

We overrule the objections. While we agree that the Tilted Star mark and its related registrations are not the subject of a pleaded claim, we disagree that this alone makes the mark irrelevant. Indeed, we find that the mark is relevant, for example, to the extent that information about it provides for a clearer understanding of the time line of certain events in Respondent’s business and to the extent that its adoption and use impinge on the credibility of Mr. Sanchez.

¹⁴ 23 TTABVUE. A testimony declaration should be filed with the Board under separate cover, rather than under notice of reliance. *See Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at *2-3 (TTAB 2019) (“Opposer’s submission of the [testimonial] declaration under a notice of reliance was unnecessary, and not the preferred approach, but harmless.”); *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1037 (TTAB 2018) (Board denied opposer’s motion to strike testimony declarations that had been filed and served as exhibits to applicant’s notice of reliance, as doing otherwise would elevate form over substance. “Although the better practice would have been for Applicant to file and serve separately copies of the [witnesses’] testimony declarations, instead of attaching them as exhibits to its notice of reliance, Applicant’s failure to do so is of no consequence.”).

¹⁵ 25 TTABVUE 29-30.

II. Background

A. Petitioner's Business and Marks

Petitioner did not take any testimony of its own officers, employees or the like, so it offers no direct evidence about its mark, the goods or services offered under it, or even other background information. However, Respondent acknowledges that the City Logo, reproduced below, is referred to as the “Big D’ symbol” and is described as “a blue capital letter D with a green stylized tree inside it[;]”¹⁶ that it is “meant to symbolize the quality of living in Dallas, and [to project] a feeling of greenery, growth, and concern for the environment.”¹⁷



Respondent also admits that the City Logo appears on vehicles used in the provision of certain municipal services and on the uniforms of certain of Petitioner's employees,¹⁸ and concedes that the City has priority of use of its mark “as to that scope of priority of use.”¹⁹

¹⁶ Respondent's brief, pp. 10, 12 (25 TTABVUE 15, 17).

¹⁷ Respondent's brief, p. 12 (25 TTABVUE 17) (citing Exhibits 7 and 8 to Petitioner's Third Notice of Reliance (22 TTABVUE 8, 10)).

¹⁸ Answer, para. 4 (8 TTABVUE 2). *See also* Respondent's brief, p. 6 (25 TTABVUE 11) (“As to Petitioner's use of the City Logo to provide its municipal services and on uniforms to identify the employees of Petitioner who provide those municipal services, Respondent has not disputed that use by Petitioner, and in fact has acknowledged throughout this proceeding that Petitioner does indeed have rights in the City Logo as to that scope of priority of use.”).

¹⁹ Respondent's brief, p. 6 (25 TTABVUE 11).

B. Respondent's Business and Marks

Mr. Sanchez, the CEO of Respondent, was born and raised in Dallas and has lived in Dallas or Dallas County his entire life.²⁰ Although Petitioner disputes some portions of Mr. Sanchez's testimony, Mr. Sanchez testified that Respondent is an apparel and accessories company that he founded in 2007;²¹ that he designed the Ghost Logo "around late 2007;" and that the Ghost Logo has been used for "[o]ver the past fifteen years," i.e., since about 2007, for "various products like different styles of shirts; hats and beanies; pants; jackets; jerseys; and sweatshirts and hoodies"²²

Although Mr. Sanchez admitted that he "knew of" the City Logo prior to designing and using the Ghost Logo,²³ and that the Ghost Logo was based in part on the City's Logo,²⁴ he testified that he chose the Ghost Logo because it was comprised of "three Ds which derive their meaning from the phrases 'da dirty dirty' (referring to one who lives in the South) and the related 'dirty dirty Dallas' (referring to pride in Dallas as a Southern city, particularly as used in the Dallas hip hop scene)."²⁵ According to his testimony, the Ghost Logo was chosen "for its meaning and how well it resonated in the hip hop scene."²⁶ Confusion between the parties' marks is unlikely, in his opinion,

²⁰ Sanchez Test., paras. 1, 2 (23 TTABVUE 5).

²¹ Sanchez Test., para. 3 (23 TTABVUE 5); Petitioner's brief, pp. 4-6 (24 TTABVUE 9-11).

²² Sanchez Test., paras. 5, 7 (23 TTABVUE 6).

²³ Responses to Request Nos. 1, 5 of Respondent's Responses to Petitioner's First Set of Requests for Admission (19 TTABVUE 8, 10).

²⁴ Response to Request No. 3 of Respondent's First Amended Responses to Petitioner's First Set of Requests for Admission (19 TTABVUE 51-52).

²⁵ Sanchez Test., para. 6 (23 TTABVUE 6).

²⁶ *Id.*

because the commercial impression of Respondent's mark is completely different than the commercial impression of the City Logo, which "is uncool because, when you look at it, the first thing you think of is municipal services."²⁷

Respondent advertises and promotes its goods bearing the Ghost Logo via its website, its Instagram account, its Facebook page and its Twitter account; it also uses Mailchimp and Google Merchant Services and it has been promoted via mention on the following media outlets: Central Track, WFAA, PPV, ESPN, HBO, BET, and The Grammys, and may have been mentioned on the websites associated with these media outlets.²⁸

Retail prices for Ghost Logo items have changed over time but currently range from \$40 - \$75 per item.²⁹ Respondent estimates that it has sold approximately 2,500 Ghost Logo units, totaling about \$62,500.³⁰

Although Petitioner did not make of record any licensing agreement, Petitioner asserts in its brief that Petitioner entered into a license agreement with Southern Methodist University (SMU) in Dallas that allowed SMU to offer products that use the City's Logo in combination with SMU's athletic mascot."³¹ Regardless, Mr. Sanchez was familiar with the matter and testified in his deposition that he has

²⁷ Sanchez Depo. 138:23-139:3 (13 TTABVUE 142-43).

²⁸ Response to Interrogatory No. 14 of Respondent's Responses to Petitioner's First Set of Interrogatories (19 TTABVUE 25-26).

²⁹ Response to Interrogatory No. 12 of Respondent's Responses to Petitioner's First Set of Interrogatories (19 TTABVUE 25).

³⁰ Response to Interrogatory No. 13 of Respondent's Seconded Amended Responses to Petitioner's First Set of Interrogatories (19 TTABVUE 57) (emphasis in original).

³¹ Petitioner's brief, p. 12 (24 TTABVUE 17).

received “[o]ver a hundred” inquiries about the co-branded SMU apparel.³² When he receives an inquiry, he usually “[goes] along with it,” and “just [says], thank you.”³³ If he is asked if Respondent has SMU branded gear available, he tells them he does not have any “at the moment.”³⁴ He does not tell the inquirer that Respondent has not partnered with SMU.³⁵ Despite the fact that Mr. Sanchez usually “goes along with” the assumption that Respondent’s mark is being used by SMU, in one Tweet, Mr. Sanchez acknowledged that Respondent had nothing to do with the SMU collaboration:³⁶



³² Sanchez Depo. 103:10-104:11 (13 TTABVUE 107-08).

³³ *Id.* at 106:17-107:12 (13 TTABVUE 110-11).

³⁴ *Id.* at 107:13-17 (13 TTABVUE 111).

³⁵ *Id.* at 107:18-20 (13 TTABVUE 111).

³⁶ Sanchez Depo. 129:12-133:20 (13 TTABVUE 133-37).



Mr. Sanchez clarified in his deposition that his tweet says, ““That is what you get when you are culture [vultures], for not doing what is right. We have nothing to do with this design.””³⁸

Mr. Sanchez also testified in his deposition that he considered reaching out to SMU directly about a collaboration, but before he could do so, he received a cease and desist letter from Petitioner.³⁹ He testified at trial that Petitioner’s demand letter,

³⁷ Exhibit 27 to Sanchez Depo. (18 TTABVUE 29-30).

³⁸ *Id.*; Sanchez Depo. 129:12-130:7 (13 TTABVUE 133-34).

³⁹ Sanchez Depo. 130:10-131:20 (13 TTABVUE 134-35).

dated May 7, 2021, asserts that the Ghost Logo is “virtually identical to the City’s logo”.⁴⁰

III. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action is a threshold issue that must be proven by the plaintiff in every inter partes case. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, *4-8 (Fed. Cir. 2020); *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, *3 (Fed. Cir. 2020); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). This is true even where, as here, Respondent does not dispute Petitioner’s entitlement to bring a statutory cause of action or even address the issue at all in its brief. *WeaponX*, 126 USPQ2d at 1039 (“The facts regarding standing ... must be affirmatively proved. Accordingly, [plaintiff] is not entitled to standing solely because of the allegations in its [pleading].”) (quoting *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982)).

To establish entitlement to a statutory cause of action, a plaintiff must demonstrate: (i) an interest falling within the zone of interests protected by the statute, and (ii) a reasonable belief in damage proximately caused by the registration of the mark. *Meenaxi Enter., Inc. v. Coca-Cola Co.*, 38 F.4th 1067, 2022 USPQ2d 602, at *2 (Fed. Cir. 2022) (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 129, 132 (2014)); *Corcamore*, 2020 USPQ2d 11277, at *4.

⁴⁰ Sanchez Test., para. 14 (23 TTABVUE 7).

In its petition for cancellation, Petitioner alleges in part its entitlement to a statutory cause of action based on its ownership of two pending trademark applications to register the City Logo mark (Serial Nos. 90/132,764 and 90/132,560) and based on its prior common law use of its City Logo mark.⁴¹ Petitioner also alleges that its '560 application has been refused registration based on a likelihood of confusion with Respondent's mark.⁴² However, Petitioner failed to make of record a copy of either of pleaded pending application, nor did it make of record any evidence showing the current status and title of the '560 application or the Office Action indicating its refusal. Thus, these mere allegations in support of entitlement are insufficient to prove Petitioner's entitlement. *WeaponX*, 126 USPQ2d at 1039.

In response to Petitioner's allegations that it has filed two applications to register its City Logo mark, and that the '560 application has been refused registration, Respondent admitted that Petitioner's applications "speak for themselves," which we deem to be an admission that the applications were filed but not an admission that the '560 application has been refused registration.⁴³

In its brief, Petitioner alleges that it is entitled to a statutory cause of action because "[i]t is undisputed that City began using the City's Logo in 1972 – decades before Registrant's alleged date of first use of Registrant's Ghost Logo in 2007."⁴⁴ Respondent, as mentioned, does not dispute Petitioner's entitlement to bring a

⁴¹ Petition for Cancellation, paras. 3-5, 9-12 (1 TTABVUE 3-5).

⁴² *Id.* para. 10 (1 TTABVUE 5).

⁴³ Answer, para. 5 (8 TTABVUE 3).

⁴⁴ Petitioner's brief, p. 7 (24 TTABVUE 12).

statutory cause of action, and, in addition, expressly concedes that “[a]s to Petitioner’s use of the City Logo to provide its municipal services and on uniforms to identify the employees of Petitioner who provide those municipal services, Registrant has not disputed that use by Petitioner, and in fact has acknowledged throughout this proceeding that **Petitioner does indeed have rights in the City Logo as to that scope of priority of use.**”⁴⁵

Additionally, although the record does not contain a copy of Petitioner’s cease and desist letter to Respondent, Mr. Sanchez testified at trial and in his deposition that he received it.⁴⁶ In his trial testimony, Mr. Sanchez states that he disagrees with the Petitioner’s position in the letter that the “Ghost Logo [is] ‘virtually identical to the City’s logo.’”⁴⁷ Based on the entirety of the record, including Respondent’s receipt of a cease and desist letter from Petitioner, we find Petitioner has established its entitlement to a statutory cause of action. *See e.g., Miller v. Miller*, 105 USPQ2d 1615, 1618-19 (TTAB 2013) (determining that the cease and desist letters applicant sent to opposer “provide[d] additional evidence that opposer has business interests that have been affected, i.e., a real interest in the proceeding, and thus, has [established entitlement]”).

⁴⁵ Respondent’s brief, p. 6 (25 TTABVUE 11) (emphasis added).

⁴⁶ Sanchez Test., para. 14 (23 TTABVUE 7); Sanchez Depo. 130:10-131:17 (13 TTABVUE 134-35).

⁴⁷ Sanchez Test., para. 14 (23 TTABVUE 7).

IV. Priority

“Section 2(d) of the Trademark Act provides a ground for cancellation of a registered mark based on likelihood of confusion with a petitioner’s mark or trade name previously used in the United States and not abandoned.” *JNF LLC v. Harwood Int’l Inc.*, 2022 USPQ2d 862, at *6 (TTAB 2022) (citing *Kemi Organics, LLC v. Gupta*, 126 USPQ2d 1601, 1604 (TTAB 2018)). The parties agree that sole issues are (1) who has priority, and (2) whether there a likelihood of confusion.⁴⁸ Petitioner argues in its brief that it adopted its City Logo in 1972 for use with municipal services, that this logo “graces just about everything that emanates from City Hall[,]” and that “[t]his includes T-shirts and apparel.”⁴⁹ Respondent argues that Petitioner has failed to establish priority for t-shirts.⁵⁰

⁴⁸ Petitioner’s brief, pp. 2, 7 (24 TTABVUE 7, 12); Petitioner’s reply brief, p. 1 (26 TTABVUE 5); Respondent’s brief, p. 4 (25 TTABVUE 9).

⁴⁹ Petitioner’s brief, p. 1 (24 TTABVUE 6) (quoting Exhibit 10 to its Third Notice of Reliance). For support that Petitioner has priority on t-shirts, Petitioner cites Sanchez Depo. 160:9-19 (13 TTABVUE 164).

Although neither party directly addresses the issue, we construe Petitioner’s claim of priority on t-shirts as “t-shirts for others,” rather than, for example, t-shirts as part of a uniform worn by Petitioner’s employees, for two reasons. First, we believe that this was Petitioner’s point when it alleged in its petition for cancellation that municipalities produce or license others to produce t-shirts for sale to promote tourism. Petition for Cancellation, para. 9 (1 TTABVUE 4). Second, reliance on priority of use with t-shirts worn only by municipal employees while performing municipal services would not – without more – be a sufficient basis for Petitioner to prevail because t-shirts worn as part of a uniform by Petitioner’s employees are not “goods” as they merely identify employees rendering the municipal services. *See Swiss Air Transport Co., Ltd. v. B. W. Harris Mfg. Co.*, 125 USPQ 25, 26 (TTAB 1960) (dismissing notice of opposition for the mark SWISSAIRE for men’s and women’s jackets and coats, stating that “[w]hile opposer alleges use of its [SWISSAIR] mark upon uniforms of its employees and other equipment, it is clear that the mark so used merely serves to identify its [air transportation] services, and to its customers or other persons would not possess any other significance”).

⁵⁰ Respondent’s brief, p. 2 (25 TTABVUE 7).

To establish priority, Petitioner must prove by a preponderance of the evidence that it has “proprietary rights in its pleaded common-law mark that precede [Respondent’s] actual or constructive use of its involved mark.” *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1180 (TTAB 2017); *see also Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981) (plaintiff must establish proprietary rights in pleaded common-law mark).

A. Respondent’s Priority Date

“For priority purposes, a respondent may rely upon the filing date of the underlying application that matured into its involved registration[.]” *JNF*, 2022 USPQ2d 862, at *7 (quoting *Kemi Organics*, 126 USPQ2d at 1604), which is March 27, 2020. Respondent may also try to prove earlier actual use of its registered Ghost Logo mark, *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *15 (TTAB 2021), however, given our findings herein, we need not consider whether Respondent proved that it is entitled to rely on any such earlier date of first use.

B. Did Petitioner Establish Use of its City Logo Mark for T-shirts?

Petitioner must establish priority of its alleged prior common law use of its City Logo mark for t-shirts for others by competent evidence. *See First Niagara Ins. Brokers v. First Niagara Fin. Grp. Inc.*, 476 F.3d 867, 81 USPQ2d 1375, 1378 (Fed. Cir. 2007); *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022-23 (TTAB 2009). The evidence is sparse, but the Federal Circuit has instructed us that in considering evidence of prior use, we must not consider individual portions in isolation, but must “look at the evidence as a whole, as if each piece of evidence were part of a puzzle

which, when fitted together, establishes prior use.” *West Fla. Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994) (finding priority of use of mark for restaurant services on the basis of three advertisements in local newspapers, a Florida state service mark registration, three regulatory licenses, and a food service inspection report). With that in mind, we consider the evidence.

In the section of its brief addressing the issue of priority, Petitioner cites solely to certain exhibits attached to its notices of reliance, the most relevant being Exhibits 8-10 of its Third Notice of Reliance.⁵¹ Exhibits 8-10 are newspaper articles, published in 1972, 1973, and 2012, respectively, all of which discuss Petitioner’s mark in connection with municipal services.⁵² We need not address the hearsay issues associated with these three exhibits, nor do we need to consider whether any qualify as an exception to the hearsay rule, because Respondent concedes that Petitioner has priority of use as to its City Logo for “municipal services and on uniforms to identify the employees of Petitioner who provide those municipal services.”⁵³ Respondent disputes, however, that Petitioner has established “that its priority of use of its City Logo extends to Petitioner being an apparel and lifestyle brand, using its City Logo

⁵¹ Petitioner’s brief, p. 7 (24 TTABVUE 12). Petitioner also cites to Exhibit 12 to its Fourth Notice of Reliance (20 TTABVUE 8-9), which is a copy of Respondent’s certificate of registration for its Ghost Logo. Presumably Petitioner cited to this exhibit for purposes of comparing Petitioner’s alleged first use date to Respondent’s application filing date, as is otherwise irrelevant to show any use by Petitioner of Petitioner’s own mark.

⁵² Exhibits 8-10 (22 TTABVUE 7-12).

⁵³ Respondent’s brief, p. 6 (25 TTABVUE 11). *See also* Registrant’s Answer to Petitioner’s Petition for Cancellation, paras. 4, 9 (8 TTABVUE 2, 3).

as it engages in the making and selling of apparel and headwear sold in retail channels.”⁵⁴ Continuing, Respondent argues:

“The right to trademark and service mark rights is based on prior use, or the one who first uses the marks in connection *with a peculiar line of business*.” Petitioner’s “peculiar line of business” is the provision of municipal services and the identification of employees providing those services, and its priority of use relates to “city publications, on letterheads and envelopes, memos and business cards”; “police cars”; and in things that “emanate from City Hall” to “carry a proper air of bureaucracy”. Petitioner’s “peculiar line of business” is **not** as an apparel and lifestyle brand engaged in the making and selling of apparel and headwear, at retail.⁵⁵

Petitioner counters that “[n]othing in the case [law cited by Respondent] suggests, much less holds, that a senior user has priority only if it is in the same ‘peculiar line of business’ as the junior user.”⁵⁶ Continuing, Petitioner argues, that the parties do not need to offer competing goods and services to support a finding of likelihood of confusion, rather, the parties goods and services “need only be related in some manner and/or the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.”⁵⁷

Petitioner then concedes that it is true that it is a “municipality offering municipal services,” and that “registrant is “an apparel and lifestyle brand,” but that this distinction “is hardly dispositive” because “[t]he City is not required to sell tee shirts or other apparel to prevail in this cancellation proceeding.”⁵⁸ Petitioner then cites

⁵⁴ Respondent’s brief, p. 6 (25 TTABVUE 11).

⁵⁵ Respondent’s brief, pp. 6-7 (25 TTABVUE 11-12) (emphasis added) (citations omitted).

⁵⁶ Petitioner’s reply brief, p. 4 (26 TTABVUE 8).

⁵⁷ *Id.* (quotation omitted).

⁵⁸ *Id.*

Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) for the proposition that “[e]ven if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods. It is this sense of relatedness that matters in the likelihood of confusion analysis.”⁵⁹

To the extent that Petitioner relies on testimony evidence to support its claim of priority, it relies not on testimony of a city employee who may have personal knowledge of use of the mark on t-shirts for others, but rather on the discovery deposition of the Mr. Sanchez, CEO of Respondent:⁶⁰

25 [Q.] Do you have a sense of when Dallas
2 started being referred to as the Da Dirty Dallas
3 or the Triple D?

4 A. Yeah, 2006; 2005-ish, '6-ish.

5 Q. Okay. So would you say, then, that,
6 if the City had been using its logo on T-shirts
7 and baseball caps in 2004, that they would be
8 misappropriating hip-hop culture?

9 A. No. It would look like they were city
10 workers.

11 Q. Well, be that as it may -- and on
12 behalf of all 13,000 city workers, I would like
13 to say thank you for saying that they look
14 uncool.

15 So the City's logo didn't become --
16 the City's logo on a T-shirt didn't become the
17 province of culture vultures until after people
18 started referring to Dallas as Da Dirty Dallas?

19 A. Correct.

20 Q. Okay. And that happened in about
21 2005/2006, you think?

22 A. Correct.

23 Q. So, from 1972 to 2005, as many

⁵⁹ *Id.*

⁶⁰ Petitioner's brief, p. 1 (24 TTABVUE 6) (citing Sanchez Depo. 160:9-19 attached as Exhibit 1 to Petitioner's First Notice of Reliance (13 TTABVUE 164)).

24 T-shirts as you want. From 2005, it's culture
25 vulture?
2 A. It's the Big D.
3 Q. That was the City's logo for 40 years
4 before it became Da Dirty Dallas, wasn't it?
5 A. You have to redefine that because
6 that's always been the municipal services for
7 city workers of the City of Dallas.
8 This is Triple D.
9 Q. **And I'm asking you about -- I'm asking**
10 **you about printing that on T-shirts.**
11 A. Correct.
12 Q. **If the City had done that, which -- if**
13 **the City did do that -- let me rephrase.**
14 **When the City did that in 2004 and**
15 **handed out 50,000 T-shirts that had -- that had**
16 **that logo, that exact logo on it, were they**
17 **misappropriating hip-hop culture then, in 2004?**
18 A. No. They were considered the City of
19 Dallas.⁶¹

Respondent contends that Mr. Sanchez's testimony involves either the hypothetical use of the City Logo on t-shirts or a one-time promotional give away, neither of which is sufficient to support a claim of priority.⁶² Respondent also points out that Petitioner did not produce any evidence of this "hypothetical use, and even if it **had** occurred, a single occurrence of use of a mark on giveaway promotional items would not give Petitioner a priority claim based solely [on] the use of the City Logo on those items."⁶³ Respondent also points out that Petitioner has not produced any evidence that it had a "long-standing promotional or licensing program with use of the City Logo on apparel products, or that it has used the City Logo to 'generate

⁶¹ Sanchez Depo., 158:25-160:19 (13 TTABVUE 162-64) (emphasis added).

⁶² Respondent's brief, pp. 7-8 (25 TTABVUE 12, 13).

⁶³ *Id.* (emphasis in original).

revenue for and/or promote tourism' in Dallas, Texas[,]” as alleged in the petition for cancellation.⁶⁴

While we agree that Petitioner has established priority for municipal services, this is not enough to support a claim that Petitioner also has priority of use of its City Logo mark on t-shirts for others. Based on the record before us, we find that Petitioner has not established priority of use of its mark with t-shirts for others. Petitioner did not submit any testimony of its own witnesses regarding the adoption and use of its mark on t-shirts for others; thus, the only testimony evidence consists of the discovery deposition of the adverse party. While testimony alone may be sufficient to prove the first use of a party's mark when it is based on personal knowledge, is clear and convincing, and has not been contradicted, *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana, Inc.*, 98 USPQ2d 1921, 1931 (TTAB 2011), that is not the case here. We find the deposition testimony of Mr. Sanchez is not sufficiently clear and convincing on the issue of priority of use of Petitioner's City Logo mark for t-shirts. Mr. Sanchez's deposition testimony set out above (in lines 5-8) is at least initially in response to a hypothetical question posed by counsel. Although counsel makes it clear in the last question that she is not posing a hypothetical by striking her first attempt and then clarifying, “When the City did that in 2004 and handed out 50,000 T-shirts that had -- that had that logo, that exact logo on it, were they misappropriating hip-hop culture then, in 2004?” While Mr. Sanchez does not

⁶⁴ Respondent's brief, p. 8 (25 TTABVUE 13) (citing the Petition for Cancellation, para. 9 (1 TTABVUE 4)).

expressly dispute the premise of the question, i.e., that the city handed out t-shirts in 2004, it is also not entirely clear that he agrees with it either, as he responds “no” and then expressly addresses the “culture vulture” issue that permeated that portion of his deposition. Moreover, it is not clear if these t-shirts were for use for city employees to wear as part of their uniform, or if they were for others.

To the extent that Petitioner argues that it is not dispositive that Petitioner is a “municipality offering municipal services,” and that Respondent is “an apparel and lifestyle brand,” relying on *Recot*,⁶⁵ and its other argument that the parties’ goods and services need not be competitive to support a claim of likelihood of confusion, these arguments are not persuasive as these arguments address the issue of relatedness of the parties’ goods under the second factor set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont* factors”) (setting forth factors to be considered). Thus, Petitioner has confused the issue of priority – which party used the its mark first – with the issue of whether the parties’ goods are related. Section 2(d) of the Trademark Act only requires prior use to establish priority (not relatedness), providing in relevant part:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... [c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or 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.

⁶⁵ Petitioner’s reply brief, p. 4 (26 TTABVUE 8).

15 U.S.C. § 1052(d) (emphasis added). While it **could** be true that Petitioner’s t-shirts offered to others are commercially related to the t-shirts offered by Respondent under the second *DuPont* factor, we do not reach that issue as Petitioner has failed to establish that it has priority of use of its mark for t-shirts.⁶⁶ Moreover, while Respondent concedes that Petitioner has established priority of use as to municipal services,⁶⁷ this does not automatically allow Petitioner to prevail on the issue of priority as to t-shirts for others. Petitioner’s actual use priority date as to t-shirts for others must be separately established, but has not been so established on the record before us.

Although there is no evidence to support Petitioner’s argument that it entered into a license agreement with SMU that, as Petitioner contends, “allowed SMU to offer products that use the City’s Logo in combination with SMU’s athletic mascot[,]”⁶⁸ Mr. Sanchez admitted in his deposition that he has received inquiries from customers who think that Respondent is producing gear for SMU,⁶⁹ that some inquiries come

⁶⁶ In support of its argument that it need not sell apparel to prevail, Petitioner makes certain arguments about the New York State Department of Economic Development’s ownership of a certain registered mark, which Petitioner describes as “famous,” as well as the City of New York’s ownership of certain registered marks, and it recites certain registration numbers and provides links to websites to support its arguments. Petitioner’s reply brief, p. 5 (26 TTABVUE 9). We do not consider any of these arguments because the evidence cited in Petitioner’s brief in the form of third-party registrations is not of record. Attorney argument, without evidence, is not persuasive. *See e.g., Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)). *See also* TBMP § 704.06(b) (“Factual statements made in a party’s brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial.”) and cases cited therein.

⁶⁷ Respondent’s brief, p. 6 (25 TTABVUE 11).

⁶⁸ Petitioner’s brief, p. 12 (24 TTABVUE 17).

⁶⁹ Sanchez Depo. 103:10-20 (13 TTABVUE 107).

via social media, and that he denied his association with the collaboration in the Tweet (below):



Even considering this photograph, however, it is not sufficient to establish priority of the City Logo on sweatshirts or hats because the “D” mark shown is different from the City Logo mark pled by Petitioner and argued in its brief as it lacks the inner “tree” design.⁷¹ Further, this evidence is insufficient to establish priority because Mr. Sanchez, as CEO of Respondent, is not competent to testify about any license that Petitioner may have with SMU or ownership of the marks shown in the photo. Consequently, this evidence fails to establish Petitioner’s priority of use of its City Logo mark on apparel.

⁷⁰ Exhibit 27 to the Sanchez Deposition (18 TTABVUE 29-30).

⁷¹ Petition for Cancellation, para. 3 (1 TTABVUE 3); Petitioner’s brief, p. 1 (24 TTABVUE 6).

Petitioner also argues that “[t]his is a simple case. It is one in which the junior user admits taking the senior user’s mark[.]”⁷² citing to Mr. Sanchez’s appearance on *Good Morning Texas* on December 17, 2018, which Petitioner contends is attached as Exhibit 7 to its third notice of reliance.⁷³ Exhibit 7 does not contain the video, but rather consists of a printout of a webpage showing that the video can be played on the website. As noted earlier, the video is not of record, so we give this argument no further consideration. *Cai*, 127 USPQ2d at 1799.

Considering this evidence as a whole, we find it insufficient to support a finding that Petitioner established priority of use of its pleaded City Logo in connection with t-shirts for others prior to Respondent’s constructive use filing date. *Gen. Motors Corp. v. Aristide & Co.*, 87 USPQ2d 1179, 1186 (TTAB 2008) (no common law use found where it was “unclear [from the evidence] whether or when and on what goods” the mark had “actually been used”). Accordingly, Petitioner has failed to prove a critical element of its likelihood of confusion claim, priority, and cannot prevail.

V. Decision

The Petition for Cancellation is denied.

⁷² Petitioner’s brief, p. 1 (24 TTABVUE 6) (citing Exhibit 7 to Petitioner’s Third Notice of Reliance (22 TTABVUE 6)).

⁷³ Petitioner’s brief, p. 1 (24 TTABVUE 6).