

THIS DISPOSITION IS  
CITABLE AS PRECEDENT  
OF THE TTAB

ORIGINALLY ISSUED AS NON-CITABLE FEB. 4, 2003  
RE-DESIGNATED AS A CITABLE PRECEDENT APR. 2, 2003

Bottorff  
Paper No. 34

Hearing:  
Oct. 30, 2002

Mailed:  
Feb. 4, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

\_\_\_\_\_  
Trademark Trial and Appeal Board

Nobelle.com, LLC  
v.  
Qwest Communications International, Inc.<sup>1</sup>

\_\_\_\_\_  
Cancellation No. 92030454

James L. Phillips of Miller Nash LLP for Nobelle.com, LLC.

John C. Cain of Howrey Simon Arnold & White, LLP for Qwest  
Communications International, Inc.

\_\_\_\_\_  
Before Hairston, Bottorff and Rogers, Administrative  
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

This cancellation proceeding involves respondent's  
concurrent use registration of the following mark

\_\_\_\_\_  
<sup>1</sup> Substituted as party defendant by survival of merger with U.S.  
West, Inc. See the Board's May 22, 2001 order, at footnote 1.



(the Bell logo mark), for services recited in the registration as "telecommunications services." A brief discussion of the unique nature and history of this registration is helpful.

The registration originally issued to American Telephone & Telegraph Company on October 5, 1971 as an unrestricted registration, Registration No. 921,734. Pursuant to Trademark Act Sections 2(d) and 37, 15 U.S.C. §§1052(d) and 1119, and in accordance with the July 8, 1983 and February 6, 1984 opinions and orders of the United States District Court for the District of Columbia in the antitrust litigation which resulted in the breakup of AT&T,<sup>2</sup> AT&T assigned all rights and goodwill in the Bell logo mark to the various Regional Bell Operating Companies (hereinafter the RBOCs), and the Patent and Trademark Office re-issued the original 1971 AT&T registration to each of the

---

<sup>2</sup> United States v. Western Electric Co., Inc., et al., 569 F.Supp. 1057, 220 USPQ 113 (D.D.C. 1983).

RBOCs as concurrent registrations.<sup>3</sup> Each of the nine concurrent registrations is nationwide in scope, but is subject to a "mode of use" restriction which allows the registrant to use the registered Bell logo mark only in conjunction with an approved geographic trade modifier, such as, in respondent's case, "Mountain Bell" or "Pacific Northwest Bell." See generally *Tamarkin Co. v. Seaway Food Town*, 34 USPQ2d 1587 (TTAB 1995); see also *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 189 USPQ 630 (CCPA 1976); *Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.*, 293 F.2d 685, 130 USPQ 412 (1961), cert. denied, 369 U.S. 864 (1962).<sup>4</sup>

---

<sup>3</sup> These concurrent registrations are: Reg. No. 1,327,693, owned by Ameritech Corporation of Chicago, IL; Reg. No. 1,327,694, owned by Bell Atlantic Corporation of Philadelphia, PA; Reg. No. 1,327,695, owned by BellSouth Corporation of Atlanta, GA; Reg. No. 1,327,696, owned by Cincinnati Bell Inc. of Cincinnati, OH; Reg. No. 1,327,697, owned by Nynex Corporation of New York, NY; Reg. No. 1,327,698, owned by Pacific Telesis Group of San Francisco, CA; Reg. No. 1,327,699 owned by The Southern New England Telephone Company of New Haven, CT; and Reg. No. 1,327,700, owned by Southwestern Bell Corporation, of St. Louis, MO. See Exhibit A to Respondent's February 12, 2002 Notice of Reliance. Each of these registrations appears to be in full force and effect. We note that respondent's registration is the only one of these registrations that petitioner has petitioned to cancel.

<sup>4</sup> Petitioner has contended in its briefs and at oral hearing that the Office, acting through the Assistant Commissioner of Trademarks in 1984, misconstrued the court's decision and Section 37 order or otherwise committed error when it issued geographically unrestricted "mode of use" concurrent registrations, rather than geographically restricted concurrent registrations, to respondent and the other RBOCs. To the extent that petitioner, notwithstanding the Board's explicit rejection of this argument in its May 22, 2001 summary judgment order, still is attempting to assert such error as a ground for cancellation in this case, we reject the attempt, again. We are

Petitioner seeks to cancel respondent's registration on the grounds that the registered Bell logo mark has become generic and/or has been abandoned due to its loss of significance as a mark. Because petitioner has failed to establish either its standing or any ground for cancellation of respondent's registration, we deny the petition for cancellation.

Initially, two procedural/evidentiary matters require attention. First, we deny petitioner's September 25, 2001 "Motion to Strike." By that motion, petitioner requests that we give no consideration to any of the trial evidence offered by respondent during respondent's testimony period because, according to petitioner, respondent failed to

---

unpersuaded by petitioner's arguments on the merits of this issue. In any event, petitioner cites no authority, and we are aware of none, which grants to the Board the jurisdiction to review the manner in which the Commissioner (now the Director) implements a Section 37 order from a district court, much less the power to set aside or modify that implementation. Moreover, the Office's action of which petitioner complains occurred nearly twenty years ago. "PTO error" is not among the grounds enumerated in Section 14(3) upon which a registration that is over five years old may be cancelled. Finally, to the extent that petitioner, in arguing that respondent and the other RBOCs "misled" the Office into issuing geographically unrestricted registrations in 1984, is attempting to assert fraud as a ground for cancellation, we reject the attempt. The petition for cancellation contains no allegation of a fraud claim, much less the detailed allegation of such a claim required by Fed. R. Civ. P. 9(b). In any event, it is clear from the record that no factual basis for a fraud claim exists. In making its decision to issue geographically unrestricted concurrent registrations, the Office was not "misled" by respondent or the other RBOCs as to the terms of the court's opinion and order, as petitioner contends. Rather, the Office had before it copies of the opinion and order, and was well aware of the terms thereof when it issued the concurrent registrations. See, e.g., the Office's November

produce, prior to the close of the discovery period on December 5, 2000, any documents responsive to petitioner's discovery requests.

Petitioner's motion is essentially a motion for discovery sanctions under Trademark Rule 2.120(g)(1). That is, petitioner contends that respondent should be precluded from submitting trial evidence as a sanction for respondent's alleged failure to comply with its discovery obligations. However, discovery sanctions under Trademark Rule 2.120(g)(1) are available only if respondent has violated a discovery order issued by the Board, such as an order compelling discovery. No such order has been violated by respondent, because no such order was ever issued by the Board or even requested by petitioner.<sup>5</sup> Because respondent has not violated any Board order regarding discovery, there

---

15, 1984 letter to Cary H. Sherman, Esq. of Arnold & Porter, made of record as Exhibit B.5 to respondent's Notice of Reliance.

<sup>5</sup> Indeed, by the time petitioner filed its "Motion to Strike" on September 25, 2001, it was too late for petitioner to file a motion to compel discovery because petitioner's testimony period had already commenced some twenty-five days earlier (on September 1, 2001; see Board's May 22, 2001 order denying respondent's January 31, 2001 motion for summary judgment and resetting petitioner's opening testimony period to close on September 30, 2001, opening thirty days prior thereto). See Trademark Rule 2.120(e)(1). We note that petitioner's counsel, in a November 22, 2000 letter to respondent's counsel, complained of respondent's lack of production and stated, "Please be advised that we intend to seek immediate relief." (See petitioner's November 2, 2001 reply brief in support of the motion to strike, at Exhibit E.) However, petitioner did not file a motion to compel at that time or at any other time, and indeed sought no "relief" at all until it filed its motion to strike, along with its untimely motion for summary judgment, on September 25, 2001, twenty-five days into its testimony period.

is no procedural basis for imposing the discovery sanction requested by petitioner. See TBMP §527.01 and cases cited therein; see also *Greenhouse Systems Inc. v. Carson*, 37 USPQ2d 1748 (TTAB 1995) (Board does not entertain motions in limine).<sup>6</sup> Petitioner's motion is denied, and we have considered the evidence submitted by respondent.

The second procedural matter requiring resolution is respondent's August 8, 2002 motion to strike certain factual assertions made by petitioner in its briefs regarding Unical, respondent's licensee. We deny respondent's motion, inasmuch as it generally is not the Board's practice to strike briefs or portions thereof. TBMP §540.<sup>7</sup>

---

<sup>6</sup> In any event, petitioner's motion is based on a faulty premise, i.e., that respondent failed to comply with its discovery obligations because it failed to make discovery documents available for inspection prior to the close of the discovery period. The Trademark Rules of Practice do not require that the actual production of documents occur prior to the close of the discovery period. Respondent timely served its written response to petitioner's document production requests, and made the responsive documents available for inspection prior to trial. It appears that respondent notified petitioner of the availability of the documents and inquired as to how petitioner wished to proceed with respect to the inspection or copying of the documents; petitioner never responded to those inquiries. If petitioner required more time to inspect the documents prior to the close of the discovery period (to allow for service of follow-up discovery) or prior to the opening of its testimony period (to allow for trial preparation), it was incumbent on petitioner to file a motion seeking extension of those dates. Respondent offered to consent to such extension, but petitioner refused that offer and never sought an extension.

<sup>7</sup> However, we have accorded no probative or persuasive value to petitioner's assertions regarding Unical. As a factual matter, the record does not necessarily support petitioner's contention in its briefs that respondent, through its licensee Unical, "floods the market" with 13,000,000 telephones per year bearing the "Genuine Bell" designation. Petitioner bases this contention

Thus, the evidence of record in this proceeding consists of the testimony deposition of petitioner's principal Bruce Kaser and the documentary exhibits attached thereto, the testimony deposition of respondent's witness Christina Searls, and the public records and printed publications respondent has made of record by means of notice of reliance.

Turning now to the merits, we first find that petitioner has failed to establish its standing to bring

---

on statements appearing on Unical's website. Even if we accept those statements for their truth, they do not prove what petitioner says they prove. Unical boasts that its manufacturing facility in China has a "daily production capacity of 50,000 telephones" (from which petitioner extrapolates the 13,000,000 telephones per year figure, based on five work days a week - see petitioner's main brief at 4), and that it produces telephones for customers "in 40 countries." However, the fact that Unical has the "capacity" to produce 50,000 telephones daily does not prove that it actually produces that number. And even if Unical does produce that many telephones, there is no basis in the record for finding that all of those phones are sold in the United States (and not in the other forty countries to which Unical assertedly sells phones), much less that all of those phones are sold in packaging which bears the "Genuine Bell" designation of which petitioner complains.

More fundamentally, however, and putting aside any question as to the factual validity of the assertions petitioner makes in its briefs regarding Unical, those assertions are legally irrelevant in this case. As discussed *infra* at pp. 18-19, petitioner relies on those assertions to support its claim that respondent has abandoned the registered mark due to naked licensing. But even if petitioner is correct in claiming that respondent fails to exercise quality control over Unical with respect to Unical's production of telephones under license from respondent, such failure does not establish that respondent engages in naked licensing with respect to the telecommunications services recited in the registration petitioner seeks to cancel. There is no evidence that Unical (or anyone else) provides telecommunications services under license from respondent, and there accordingly is no basis for finding that respondent engages in naked licensing with respect to such services.

this cancellation proceeding. Contrary to petitioner's argument, respondent did not waive its right to challenge petitioner's standing by waiting until its brief on the case to do so. "Lack of standing" is not an affirmative defense; rather, standing is an essential element of petitioner's case which, if it is not proved at trial, defeats petitioner's claim. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *No Nonsense Fashions, Inc. v. Consolidated Foods Corporation*, 226 USPQ 502 (TTAB 1985).<sup>8</sup>

To establish its standing to assert a mere descriptiveness or genericness ground of opposition or cancellation, "a plaintiff need only show that it is engaged in the manufacture or sale of the same or related goods as those listed in the defendant's involved application or registration and that the product in question is one which could be produced in the normal expansion of plaintiff's business; that is, that plaintiff has a real interest in the proceeding because it is one who has a present or prospective right to use the term descriptively [or generically] in its business." *Binney & Smith Inc. v. Magic*

---

<sup>8</sup> "Lack of standing" might be the basis for a defendant's motion to dismiss for failure to state a claim, under Fed. R. Civ. P. 12(b)(6), but the "defense" of failure to state a claim is not one which is waived if it is not asserted by motion. See Fed. R. Civ. P. 12(h)(2), which is applicable to Board proceedings under Trademark Rule 2.116(a), 37 C.F.R. 2.116(a).



*Marker Industries, Inc.*, 222 USPQ 1003, 1010 (TTAB 1984).

"All that is necessary is that petitioner be in a position to have a right to use" the mark in question. J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition §20:50 (4<sup>th</sup> ed. 2001). See also *No Nonsense Fashions, Inc. v. Consolidated Foods Corporation*, *supra*, and *Southwire Company v. Kaiser Aluminum & Chemical Corporation*, 196 USPQ 566 (TTAB 1977). This test logically also applies to the question of whether petitioner has standing to assert its claim that respondent's mark has been abandoned (and therefore is in the public domain) due to its loss of significance as a mark.

Petitioner Nobelle.com LLC is a limited liability company whose sole officer, shareholder and employee is Bruce Kaser.<sup>9</sup> Mr. Kaser testified that petitioner is "incubating and developing" a power supply/adaptor product for use with cell phones and laptop computers. (Kaser depo. at 5-7.) He testified that "I've been working on it for quite some time" (*id.* at 70), but "it's still in the development stage. We're not close to bringing it to the marketplace at the present." (*Id.* at 77-78.) When asked "Do you have a time frame when you expect to enter into the

---

<sup>9</sup> At the time the petition to cancel was filed, Mr. Kaser was a lawyer at Miller Nash LLP, the law firm which filed the proceeding on behalf of petitioner and which remains counsel of record for petitioner. Mr. Kaser now is a partner at another law firm, David Wright Tremaine.

marketplace with this product?", Mr. Kaser answered, "I don't have a specific time frame right now." (Id.) Mr. Kaser testified that petitioner is not presently engaged in any other business except developing the product, and that petitioner has not engaged in any other business in the past except developing the product. (Id. at 73.)

It appears that petitioner's claim to standing is based entirely on the fact that Mr. Kaser has an idea for a product, which may or may not ever be brought to market. He testified that the product is "in development," but we cannot determine from this record what that means, if it means anything. All we know is that the product is "not close" to being ready for market, and that petitioner has no time frame for completing the product's development and introducing it into the marketplace. On this record, we cannot conclude that petitioner is (as McCarthy says) "in a position" to use (or have the right to use) the Bell symbol in its business, or that petitioner is engaged in any "business" at all which would give it a real interest in the outcome of this proceeding.<sup>10</sup> In short, although the

---

<sup>10</sup> Indeed, it appears that petitioner, Nobelle.com LLC, is as likely to end up in the winery or orchard business as it is to end up in the business of manufacturing and selling telephone products. When he was asked "Are you seeking to engage in any other business other than the power supply products for Nobelle.com?", Mr. Kaser replied in the affirmative, explaining that "There's a very good chance that I'll be starting up a local orchard or perhaps a winery and I may use the name in connection with that. I haven't decided." (Kaser depo. at 73.)

threshold for determining standing generally is quite low, we find that petitioner has failed to clear it in this case.

However, even if we are incorrect, and it were to be determined that petitioner has established its standing in this case, we find that petitioner still is not entitled to prevail because it has failed to establish either of its pleaded grounds for cancellation of respondent's registration. Before we turn to a discussion of those grounds, a preliminary comment is in order.

It is important to clarify what the grounds for cancellation are in this case. As noted above, petitioner has pleaded genericness and abandonment as its grounds for cancellation. Petitioner, however, has devoted large portions of its briefs (and its arguments at oral hearing) to its contentions that respondent's registration and use of the Bell logo mark are in violation of the terms of the district court's 1983 and 1984 opinion and order in the AT&T antitrust litigation.<sup>11</sup> To the extent that petitioner is

---

<sup>11</sup> Specifically, petitioner contends, first, that the Office committed error in 1984 when, based on alleged misrepresentations by respondent and the other RBOCs as to the terms of the court's order, it issued geographically unrestricted "mode of use" concurrent registrations to respondent and the other RBOCs. We have already rejected this contention, *supra* at footnote 4. Petitioner also contends that respondent, through its licensee Unical, markets telephones in packaging which advertises the products to be "Genuine Bell." However, even if petitioner is correct in contending that this conduct violates the court's order (and we do not assume that it does), such violation involves neither the Bell logo mark depicted in the registration petitioner seeks to cancel nor the telecommunications services recited in that registration. Finally, petitioner contends that

contending that respondent's alleged violations of the court's order are independent grounds for cancellation in this proceeding, we reject the contention. It is not within the province of the Board to enforce the court's order or to decide whether respondent has violated that order.

Likewise, to the extent that petitioner is contending that the conduct of respondent and/or the other RBOCs is in violation of antitrust or unfair competition laws, we have given such contentions no consideration because the Board has no jurisdiction over such claims. See TBMP §102.01 and cases cited therein.

In short, even were we to assume that respondent has violated the court's order (and we make no such assumption), such violation would not constitute an independent ground for cancellation of respondent's registration, nor does any such violation, in itself, suffice to establish either of the pleaded grounds for cancellation, i.e., genericness or abandonment.<sup>12</sup>

---

respondent violates the "spirit" of the court's order by using the Bell logo alone, without a trade modifier, on its Seattle office building and elsewhere. Respondent, however, plausibly contends that such use is allowed or grandfathered under the concurrent use agreement between the RBOCs, a contention which petitioner does not refute or even address.

<sup>12</sup> Thus, we reject as *non sequiturs* petitioner's contentions (in the section headings of its briefs) that "The Bell Mark is Generic Because the RBOCs have Violated Judge Greene's Order" (main brief at 15), and that "Registrant's Use of the Term 'Genuine Bell' Violates Judge Greene's Order and Renders the Mark Generic or Abandoned" (reply brief at 3).

We turn now to petitioner's first ground for cancellation, i.e., that respondent's registration should be cancelled on the ground of genericness. Our primary reviewing court has stated:

The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question. Determining whether a mark is generic therefore involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?

*H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986)(citations omitted).

Under the first part of the *Ginn* two-part genericness test, we find that the genus of goods or services at issue in this case is "telecommunications services," the services recited in respondent's involved registration. See *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991)("Thus, a proper genericness inquiry focuses on the description of services set forth in the certificate of registration.").

Under the second part of the *Ginn* test, we find, for the reasons discussed below, that petitioner has failed to establish that the Bell logo mark depicted in respondent's

registration is understood by the relevant public primarily to refer to the genus of services at issue, i.e., "telecommunications services."

Evidence of the public's understanding (under the second part of the *Ginn* test) may come from direct testimony of consumers, consumer surveys, dictionary listings, or from generic usage in newspapers and other publications. See *Magic Wand Inc., supra*, 19 USPQ2d at 1553; *In re Northland Aluminum Products, Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985). Petitioner has not submitted any of these types of evidence in this case. Instead, petitioner bases its genericness claim on evidence showing use of the Bell logo by multiple, unrelated third-party competitors of respondent's, i.e., the other RBOCs.<sup>13</sup> "The cases have recognized that competitor use is evidence of genericness." *BellSouth Corp. v. DataNational Corp.*, 60 F.3d 1565, 35 USPQ2d 1554, 1558 (Fed. Cir. 1995). However, we have carefully considered petitioner's evidence of competitor use in this case, and we find that it fails to establish that the Bell logo is generic.

---

<sup>13</sup> The only users of the Bell logo evidenced by the record are the RBOCs or licensees of RBOCs. The record shows that numerous non-RBOC companies (e.g., Motorola, Uniden, Siemens, Vtech, Panasonic, Casio, Sharp, Toshiba, and Sony) manufacture and market telephones and telephone accessories, but none of them uses the Bell logo, either generically or otherwise, on or in connection with those goods. There is no evidence that the Bell logo is used in connection with telecommunications services by any non-RBOC company.

First, although the genus of services involved in this case is "telecommunications services," essentially all of petitioner's evidence pertains to respondent's competitors' use of the Bell logo on goods, i.e., telephones, telephone accessories, and other related equipment. Such evidence simply is not relevant to, or probative of, the issue to be decided in this cancellation proceeding, i.e., whether the registered Bell logo mark is generic for the "telecommunications services" recited in the registration petitioner seeks to cancel. *See Magic Wand Inc., supra*, 19 USPQ2d at 1552 ("Thus, a proper genericness inquiry focuses on the description of services set forth in the certificate of registration."). To the extent that the evidence of record pertains to "telecommunications services" at all, we find that it is de minimis and is clearly insufficient to establish that the Bell logo is regarded by the relevant public as a generic identifier for such services.<sup>14</sup>

Second, in the cases which have found that competitor use is evidence of genericness, it is competitors' generic

---

<sup>14</sup> Even if petitioner's evidence had established (it has not) that the Bell logo is generic for telephone equipment, this is not a case in which we would apply the principle that a mark which is generic for goods is also generic for the services related to the selling of those goods. See, e.g., *In re A La Vieille Russie Inc.*, 60 USPQ2d 1812 (TTAB 2001); *cf. In re The Phone Company, Inc.*, 218 USPQ 1027 (TTAB 1983). The "telecommunications services" recited in the registration are neither goods nor the sale of goods, nor have they been shown to be related to goods or to the sale of goods in any manner which would warrant application of the principle.

use of the designation in question that has been deemed to be evidence of genericness; purchasers exposed to generic use by competitors may themselves come to regard the designation as generic. See, e.g., *BellSouth Corp. v. DataNational Corp.*, *supra* (Walking Fingers logo); *Remington Products, Inc. v. North American Philips Corp.*, 892 F.2d 1576, 1578, 13 USPQ2d 1444, 1446 (Fed. Cir. 1990)(TRAVEL CARE); *DeWalt, Inc. v. Magna Power Tool Corp.* 289 F.2d 656, 129 USPQ 275 (CCPA 1961)(POWER SHOP); *Continental Airlines Inc. v. United Air Lines Inc.*, 53 USPQ2d 1385 (TTAB 1999)(E-TICKET); and *In re Consolidated Cigar Corp.*, 13 USPQ2d 1481 (TTAB 1989)(WHIFFS); see also J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition §12:13 (4<sup>th</sup> ed. 12/01)("Evidence to prove genericness can include ... generic use by competitors..." (emphasis added)).

In the present case, however, there is no evidence that any of respondent's competitors uses the Bell logo generically. Instead, petitioner's evidence shows that whenever the Bell logo is used by any of respondent's competitors, it is used in a source-indicating manner, i.e., as part of their trademarks and service marks. For this reason, the cases discussed above are distinguishable from the present case, and the proposition for which they stand (i.e., that generic use by competitors is evidence that the public views the designation in question as generic), is



inapposite here. We see no legal or logical basis for finding that trademark or service mark use of a designation by competitors is probative evidence, under the second part of the *Ginn* test, that the relevant public regards the designation as being generic.

In short, petitioner's "competitor use" genericness evidence (which is petitioner's only proffered genericness evidence) is irrelevant to the extent that it pertains to goods rather than to the services recited in respondent's registration, and it is insufficient in any event because it fails to show that respondent's competitors use the Bell logo in a generic manner or otherwise than as a trademark or service mark. We find that petitioner has not proven that the public understands the Bell logo to be a generic designation as applied to telecommunications services, and that petitioner's genericness claim therefore fails.

We turn next to petitioner's second ground for cancellation, i.e., abandonment. Trademark Act Section 45 provides, in relevant part, that:

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

- (1) When its use has been discontinued with intent not to resume such use..
- (2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or

in connection with which it is used or otherwise to lose its significance as a mark...

Petitioner is asserting the second of these types of abandonment, i.e., that respondent's "course of conduct" has caused the Bell logo "to lose its significance as a mark." Specifically, petitioner argues, first, that respondent has abandoned the mark due to naked licensing because it has licensed use of the mark to a third party, i.e., Unical, but has failed to exercise the requisite control over the nature and quality of the goods Unical sells under the licensed mark. Second, citing the same evidence that it has relied upon in support of its genericness claim, petitioner argues that because multiple, unrelated sources (i.e., the RBOCs) use the Bell logo side-by-side in the marketplace, the logo no longer identifies a single source of goods or services and therefore does not function as a mark, and that it therefore has been abandoned. We are not persuaded by either of these arguments.

Petitioner's "naked licensing" abandonment argument fails because there is no evidence that respondent licenses the Bell logo mark to Unical, or to anyone else, for use in connection with telecommunications services. Because respondent does not license the mark for use in connection with telecommunications services, there is no basis for finding that respondent engages in naked licensing with

respect to such services; the question of whether respondent exercises adequate quality control over use of the mark in connection with such services does not even arise.

Moreover, even if petitioner is correct in contending that respondent has failed to exercise quality control over Unical's marketing of telephones and telephone products (a question we need not and do not decide), such failure by respondent is irrelevant to the issue to be decided in this case, i.e., whether respondent has abandoned the mark with respect to the telecommunications services recited in the registration petitioner seeks to cancel.

Nor are we persuaded by petitioner's argument that the Bell logo mark has lost its significance as a mark and should be deemed abandoned because, since it is used by multiple, unrelated sources (i.e., the other RBOCs), it does not identify a single source. This argument ignores the fact that respondent's registration is a concurrent use registration. A concurrent use registration, by its very nature, contemplates that the registered mark can and does function to identify more than one source. The registered mark can identify more than one source because each source's use of the mark is subject to conditions and limitations which eliminate likelihood of confusion (such as, in the present case, the trade modifiers the RBOCs use in conjunction with the Bell logo mark). Petitioner's "single

source identifier" requirement would render every concurrent use registration invalid due to abandonment.<sup>15</sup> This is not to say that a concurrent use registration can never be cancelled on the ground of abandonment, but a petitioner asserting such ground must do more than merely show that the registered mark is being used concurrently by the concurrent use registrants in accordance with the conditions and limitations set forth in their concurrent use registrations.

In short, a mark is deemed to be abandoned only when it has lost all capacity as an indication of source. *Wallpaper Manufacturers, Ltd. v. Crown Wallcovering Corporation*, supra, 214 USPQ at 335-36. The goodwill of the Bell logo mark was assigned to the RBOCs concurrently, and there is nothing in the record which suggests that such goodwill no longer exists. The logo is not used by anyone other than the RBOCs, and there accordingly is no basis for concluding that the public regards the logo as anything other than a mark indicating source in one of the RBOCs. As contemplated by the concurrent use registrations, purchasers are able to distinguish source among the RBOCs by means of the trade

---

<sup>15</sup> Indeed, petitioner's "single source identifier" abandonment requirement is untenable even outside the context of a concurrent use registration. See *Wallpaper Manufacturers, Ltd. v. Crown Wallcovering Corporation*, 680 F.2d 755, 214 USPQ 327, 332-33 (CCPA 1982)(specifically rejecting as "bad law" the view that abandonment occurs "when a mark loses its capacity to point out uniquely the single source or origin of goods, that is, unless one maintains *exclusivity* of rights" (emphasis in original)).

**Cancellation No. 92030454**

modifiers which the RBOCs use in conjunction with the Bell logo mark. Petitioner concedes as much. (Reply brief at 11-12.)

In summary, we find that petitioner has failed to establish its standing, or that respondent's Bell logo mark is generic or has been abandoned, and that petitioner therefore is not entitled to prevail in this proceeding.

Decision: The petition to cancel is denied.