

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Hearing:
March 23, 2000

Paper No. 124
Bottorff

9/25/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Mankind Research Foundation, Inc., David Dobbie and
Essiac Products, Inc.

v.

Essiac Products Services, Inc.

Cancellation No. 22,218

Allen M. Lenchek for Petitioner Mankind Research
Foundation, Inc.

Donald L. Dennison of Dennison, Meserole, Scheiner &
Schultz for Petitioners David Dobbie and Essiac Products,
Inc.

Essiac Products Services, Inc., pro se.

Before Hohein, Hairston and Bottorff, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

On March 9, 1990, respondent Essiac Products
Services, Inc., a Florida corporation, filed an
application to register the mark ESSIAC, in typed form,
for "food supplements." The application eventually

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matured into Registration No. 1,625,600, issued to respondent on December 4, 1990.¹

On September 29, 1993, petitioners Mankind Research Foundation, Inc. ("Mankind" or "MRF"), a Maryland corporation, and David Dobbie ("Dobbie"), an individual Canadian citizen, filed a petition for cancellation of Registration No. 1,625,600.² In their petition for cancellation, petitioners allege as follows:

1. Petitioners, and their predecessors in interest Resperin Corporation, a Canadian company, and Rene M. Caisse, a Canadian citizen, now deceased, are recognized in the marketplace as distributors of a food supplement both in Canada and the United States bearing the mark ESSIAC. David Dobbie is the exclusive licensee, manufacturer and distributor of goods bearing the mark ESSIAC in the U.S. and elsewhere for Mankind Research Foundation. Long prior to registrant's use of the mark ESSIAC, Petitioners through their predecessors adopted and continuously used and is [sic] still using the mark ESSIAC for food supplements in the United States and Canada.

2. Petitioners obtained exclusive rights to make and sell ESSIAC food supplement from Resperin, a company that was selling that product in Canada

¹ Respondent filed a combined affidavit under Trademark Act Sections 8 and 15 on May 2, 1996. The Office accepted that affidavit on March 3, 1997. The propriety of the Section 15 affidavit is discussed *infra*.

² During the course of the proceeding, David Dobbie moved to substitute Essiac Products, Inc., a Canadian corporation, as petitioner in his place. However, in its order dated January 30, 1998, the Board joined, rather than substituted, Essiac Products, Inc. as a party plaintiff. In this opinion, the Board shall refer to both Dobbie and Essiac Products, Inc. as "Dobbie."

and the United States. Resperin, in turn, obtained its rights to make and sell food supplement under the ESSSIAC trademark from Rene M. Caisse, the product originator and distributor. On information and belief, Caisse adopted the name ESSSIAC (her name spelled backwards) beginning in about 1934 in connection with her herbal food supplement which was sold in Canada and the U.S. as a food supplement with potential anticancer properties.

3. On information and belief, from about 1934 until about 1977 Caisse maintained the exact formulation of her ESSSIAC food supplement as a trade secret at which time she conveyed the trademark ESSSIAC and its formulation to Resperin who later conveyed trademark rights to MRF. Dobbie is the manufacturing and marketing agent for MRF.

4. From at least about 1934 to date, the mark has been used continuously, and consumers in the United States and Canada have come to associate the mark ESSSIAC with a food supplement from a single source, i.e., from Caisse and thereafter her successors in interest.

5. On information and belief, Respondent's '600 registration was obtained fraudulently in that at the time the application papers were filed it was falsely stated under oath that the mark was first used by Respondent in interstate commerce "on or before 1922." Respondent's use of the subject mark, if any, occurred much later than 1922.

6. Respondent's '600 registration is void ab initio because, at the time of filing the application resulting in the '600 registration, the oath did not comply with 15 U.S.C. §1051(a)(1)(A), in that it omitted the statement that "no other person, firm, corporation or association has the right to use the mark in commerce." Thus, the oath is fatally defective.³

³ On December 30, 1994, petitioners moved for summary judgment in their favor on the claim asserted in Paragraph 6 of the petition to cancel. On March 26, 1996, the Board issued an order denying petitioners' motion for summary judgment and instead granting summary judgment to respondent on this claim. Paragraph 6 was ordered stricken.

7. On information and belief Respondent has violated 15 U.S.C. §§1052(a) and 1064(3) by misrepresenting the source of the goods and/or falsely associating its food supplement sold under the ESSIAC label with Rene Caisse and by falsely suggesting to the public that its product is made pursuant to formulation obtained from Caisse.

8. Respondent's ESSIAC mark for its food supplement is confusingly and deceptively similar to Petitioner's ESSIAC mark and, as the goods are closely related, is likely to create confusion, mistake and deception of purchasers into believing that Respondent's goods originate with or are in some way sponsored, licensed or authorized by or otherwise associated with Petitioner, resulting in loss of Petitioner's sales and goodwill.

9. If Respondent is permitted to retain the registration sought to be cancelled, a cloud will be placed in MRF's title in and to its ESSIAC trademark and on Petitioners' right to enjoy the free and exclusive use thereof in connection with its [sic] goods, all to the great injury of Petitioners and all inconsistent with the prior and established rights of Petitioners in the mark ESSIAC. In fact, such injury to MRF has already been demonstrated by the fact that the Patent and Trademark Office, in an Office Action dated April 14, 1993, has refused registration of MRF's ESSIAC trademark application on the Principal Register (filed on January 14, 1993; ser. No. 74/348,347) based on the existence of the '600 registration in connection with Class 5.

10. The concurrent use and registration of ESSIAC by Respondent and Petitioners is likely to cause confusion, mistake and deception of customers as to the source, sponsorship, or origin of the respective marks in derogation of the rights of Petitioners.

11. By reason of all of the foregoing, Petitioners have been and will continue to be gravely damaged by the continued existence of Registration No. 1,625,600.

Respondent filed an answer denying the allegations of the petition to cancel which are essential to petitioners' claims and asserting various affirmative defenses.

Petitioners and respondent presented testimony in support of their respective positions.⁴ Petitioner Dobbie's objections to certain of respondent's testimony depositions are discussed, *infra*. Petitioners filed two main briefs, one brief from each petitioner. Respondent likewise filed two briefs, i.e., one brief in opposition to each of petitioners' two briefs. Petitioners filed two reply briefs, one from each petitioner.⁵ An oral

⁴ It appears from the record that petitioners and respondent each enjoyed two full testimony periods in this case, the first in 1996 and the second in 1997-98. A single rebuttal testimony period was held in 1999.

⁵ Co-petitioner Dobbie objected, in its reply brief, to respondent's filing of two separate briefs. He argues, *inter alia*, that respondent is only entitled to file one brief. We find the objection to be not well-taken. The co-petitioners themselves filed two separate main briefs and two separate reply briefs, and we see no harm or prejudice arising from respondent's filing of two separate briefs. We likewise decline to sustain petitioners' other objections to the form and substance of respondent's briefs.

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hearing was requested and held, but Dobbie was the only party represented at the hearing.⁶

Petitioners' evidence of record in this case consists of: the August 8, 1996 testimony deposition of Pat Safriet; the August 8, 1996 testimony deposition of Harold Collins; the August 23, 1996 testimony deposition on written questions of David Dobbie; the October 17, 1997 testimony deposition of David Dobbie; the May 29, 1998 testimony deposition of Carl Schleicher; the April 8, 1999 rebuttal testimony deposition of Carl Schleicher; and the April 12, 1999 rebuttal testimony deposition of David Dobbie.⁷

Respondent's evidence of record consists of: the December 16, 1996 testimony deposition of Gilbert Blondin; the December 17, 1996 testimony deposition of

⁶ We are not persuaded by respondent's arguments in support of its request for reconsideration of the Board's order denying respondent's request for a rescheduling of the oral hearing, and accordingly deny that request for reconsideration.

⁷ Pursuant to the Board's order dated March 10, 1999, petitioners' rebuttal testimony period was set to close on April 10, 1999. Because that date fell on a Saturday, Mr. Dobbie's deposition on April 12, 1999, the next business day, was timely. See Trademark Rule 1.7, 37 C.F.R. §1.7. To the extent that respondent, in its brief, has objected to the deposition on the ground of untimeliness, that objection is overruled.

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Robert Strangi and the December 17, 1996 testimony deposition of Pierre Gaulin.⁸

We sustain petitioner Dobbie's objection to the admissibility of the July 24, 1998 testimony deposition, conducted by respondent, of co-petitioner MRF's principal Carl Schleicher as an adverse witness. The deposition transcript was never signed by the witness, as required by Trademark Rule 2.123(e)(5). Because that requirement was not waived on the record by agreement of all the parties, and because petitioner Dobbie properly and timely objected on that ground to the admissibility of the deposition, we have not considered the deposition as forming part of the record.

We likewise sustain petitioner Dobbie's objection to the admissibility of the July 31, 1998 testimony deposition of Pierre Gaulin. The deposition transcript is unsigned by the witness and, that requirement not having been waived and the objection having been properly

⁸ Respondent also has submitted a Court Reporter's "Certificate of Non-Appearance," purporting to set forth the non-appearance of a non-party, Kevin Maloney, for a testimony deposition noticed for December 9, 1997. The witness apparently was served with a subpoena from the United States District Court for the Southern District of Florida, but failed to appear pursuant thereto. However, respondent apparently took no action to compel the attendance of the witness. The Trademark Rules do not provide for the filing of a "Certificate of Non-Appearance" in lieu of a testimony deposition transcript, and we have given this filing no further consideration.

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and timely asserted, the deposition cannot be considered. See Trademark Rule 2.123 (e)(5). Additionally, we sustain petitioner Dobbie's objection to the deposition based on Federal Rule of Evidence 612. It appears that Mr. Gaulin, the witness, was improperly reading his pre-prepared answers into the record for much if not all of the deposition. See Fed. R. Evid. 612; *Hall v. American Bakeries Co.*, 873 F.2d 1133 (8th Cir. 1989).

We also sustain petitioner Dobbie's objection to the July 31, 1998 deposition based on Dobbie's lack of opportunity for full cross-examination of the witness. We find that this lack of opportunity resulted from respondent's delay in scheduling the deposition until the very last day of its testimony period, and not from Dobbie's counsel's reasonable termination of the deposition at six o'clock p.m. on a Friday evening, after a full day of Mr. Gaulin's pro se direct examination of himself. Further, having read the deposition transcript, we concur with Dobbie's contention that Mr. Gaulin's direct examination of himself was rife with irrelevant, hearsay, and otherwise objectionable matter. Dobbie's counsel's raising of objections to such matter was both proper and necessary, and we accordingly reject respondent's contention that Dobbie's counsel, by raising

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such objections, was responsible in any way for the undue prolongation of the deposition. For all of the reasons discussed above, we sustain Dobbie's objection to the July 31, 1998 deposition, and have given it no further consideration.⁹

We turn now to a consideration of the grounds for cancellation involved in this case. As noted above, the grounds for cancellation pleaded in the petition to cancel (and not previously stricken by the Board) are: that in the application which led to the registration involved herein, respondent fraudulently alleged first use of the mark on or before 1922; that respondent has violated Trademark Act Sections 2(a) and 14(3) by misrepresenting the source of the goods and/or falsely associating its food supplement sold under the ESSIAC label with Rene Caisse and by falsely suggesting to the public that its product is made pursuant to formulation obtained from Caisse; and that the registration should be cancelled under Trademark Act Section 2(d) in view of petitioners' asserted priority and the existence of a

⁹ We note that the December 17, 1996 testimony deposition of Mr. Gaulin suffered from many of the same deficiencies, and that petitioner Dobbie's former counsel had timely and properly raised objections at the deposition. However, those objections were not preserved in petitioners' briefs, and petitioners have treated the deposition as being properly of record. We shall do likewise.

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likelihood of confusion. At the oral hearing held in this matter, petitioner Dobbie's counsel also moved, pursuant to Fed. R. Civ. P. 15(b), to amend the petition to cancel to include a claim that respondent submitted to the Office a false and fraudulent affidavit under Trademark Act Section 15.¹⁰

Taking the last issue first, we deny Dobbie's Rule 15(b) motion for leave to amend the petition to cancel. We cannot conclude on this record that the issue of respondent's filing of a Section 15 affidavit was fully litigated by the express or implied consent of the parties, as required by Rule 15(b). Respondent filed the Section 15 affidavit on May 2, 1996, and it was accepted by the Office on March 3, 1997, prior to petitioners' second main testimony period. However, petitioners did not raise the issue at trial until Mr. Dobbie's rebuttal testimony deposition on April 12, 1999, during petitioners' rebuttal testimony period. Petitioners never filed a motion to amend the pleadings under Fed. R. Civ. P. 15(a), and have provided no explanation for such

¹⁰ At the oral hearing, Dobbie's counsel also argued, apparently in the alternative to petitioners' pleaded claims, that ESSIAC is a generic or merely descriptive term as applied to respondent's goods. Because the issues of genericness and mere descriptiveness were neither pleaded nor tried, we have not considered counsel's argument.

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failure. In these circumstances, we cannot conclude that petitioners should be allowed to amend their pleading to assert this new ground for cancellation.

As for petitioners' pleaded claim that respondent committed fraud when, in its application, it alleged first use of the mark on or before 1922, we have carefully reviewed the evidence of record and conclude that petitioners have failed to prove this ground for cancellation. In the first place, the ground, as pleaded by petitioners, is legally insufficient. An applicant's misstatement in the application of the dates of first use of its mark is not material to the Office's decision to grant a registration and does not constitute fraud, so long as valid use of the mark was made prior to the application filing date. See *Western Worldwide Enterprises Group Inc. v. Qingdao Brewery*, 17 USPQ2d 1137, 1141 (TTAB 1990); *Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A.*, 221 USPQ 73, 76 (TTAB 1983); J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition §31:74 (4th Ed. 6/99).

Petitioners, in their petition to cancel, did not allege that respondent had not made valid trademark use prior to the March 9, 1990 filing date of its application. Absent such an allegation, which must be made with

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particularity, see Fed. R. Civ. P. 9(b), the petition to cancel fails to state a claim for fraud.

This pleading issue aside, we also find that petitioners have failed to present evidence sufficient to support their pleaded fraud claim. Even assuming, *arguendo*, that respondent's allegation in the application of use of the mark since 1922 was false, there is no evidence in the record establishing that respondent made the misstatement with fraudulent intent. That is, there is no basis in the record for finding that respondent, when it made its allegation of use of the mark on or before 1922, made that allegation with knowledge of its falsity and with the intention of deceiving the Trademark Office. Absent such proof, petitioners' fraud claim must fail. See *Smith International, Inc. v. Olin Corporation*, 209 USPQ 1033, 1043-44 (TTAB 1981). Petitioners' fraud claim is dismissed.

We turn next to petitioners' pleaded ground for cancellation under Trademark Act Sections 2(a) and 14(3), by which petitioners claim that respondent is "misrepresenting the source of the goods and/or falsely associating its food supplement sold under the ESSIAC label with Rene Caisse and by falsely suggesting to the public that its product is made pursuant to formulation

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obtained from Caisse." (Petition to cancel, paragraph 7.) After careful review of the record, we conclude that petitioners have failed to prove this ground for cancellation.

Petitioners have not proven their claim, under Trademark Act Section 14(3), that respondent is misrepresenting the source of its goods. That statutory ground for cancellation requires a petitioner to plead and prove that registrant deliberately sought to pass off its goods as those of petitioner. Use, even willful use, of a confusingly similar mark is not sufficient. See *McDonnell Douglas Corporation v. National Data Corporation*, 228 USPQ 45 (TTAB 1985); McCarthy, *supra*, at §20:60. No such pleading or proof exists in this case.

We construe petitioners' alternative allegations that respondent is "falsely associating its food supplement sold under the ESSIAC label with Rene Caisse and ... falsely suggesting to the public that its product is made pursuant to formulation obtained from Caisse" to be claims, respectively, under the "false suggestion of a connection" and the "deceptiveness" prongs of Trademark Act Section 2(a). Both claims must fail.

The "false suggestion of a connection" ground set forth in Trademark Act Section 2(a) is essentially a

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statutory implementation of the rights of privacy and publicity. See *University of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). As such, the ground is personal to the person or institution named in the mark, and may only be asserted by that person or institution. See *Internet, Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435 (TTAB 1996); *Heroes, Inc. v. Boomer Esiason Hero's Foundation, Inc.*, 43 USPQ2d 1193 (D.D.C. 1997); McCarthy, *supra*, at §20:20.

In this case, there is no evidence that respondent's mark ESSIAC ("Caisse" spelled backwards) points uniquely to the persona or identity of Rene Caisse, as opposed to, for example, her herbal formulation. For that reason alone, petitioners' "false suggestion of a connection claim" fails. See *University of Notre Dame*, *supra*. However, even assuming *arguendo* that ESSIAC points uniquely to the persona or identity of Rene Caisse, only Rene Caisse or her estate would have standing to assert the Section 2(a) "false suggestion of a connection" ground for cancellation. See *Internet, Inc.*, *supra*, and *Heroes, Inc.*, *supra*. Nothing in the record establishes that petitioners are entitled to assert this statutory

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ground for cancellation on behalf of Rene Caisse or her estate. Certainly, the 1977 agreement between Caisse and Resperin Corporation, from which petitioners' pleaded rights in the mark are derived, makes no such provision. Accordingly, we find that petitioners are not entitled to prevail on their claim that respondent has violated Trademark Act Section 2(a)'s "false suggestion of a connection" provision by "falsely associating its food supplement sold under the ESSIAC label with Rene Caisse."

Likewise, we find that respondent's claim under the "deceptiveness" prong of Section 2(a), i.e., that respondent is "falsely suggesting to the public that its product is made pursuant to formulation obtained from Caisse," has not been proven. The Board cannot determine on this record which, if any, of the parties exclusively possesses the "true," "authentic," or "original" formulation obtained from Rene Caisse, nor can we conclude that any such formulation actually remains extant, if it ever existed at all. Both parties claim to be in possession of the original documentation purportedly obtained from Rene Caisse, but those claims are based solely on the wholly self-serving and uncorroborated testimony of the parties' respective principals and on the clearly inadmissible hearsay

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statements of various other persons. Despite the existence of a stipulated protective agreement in this case, neither party has made its purported documentation (and authenticating evidence) of record, not even for the Board's *in camera* inspection.

We cannot conclude on this record that respondent's product is not, in fact, manufactured pursuant to Caisse's original formulation. That is not to say that we are persuaded that respondent's product is, in fact, manufactured according to Caisse's original formulation. We simply have no evidentiary basis for making that determination one way or the other. In view thereof, and because the burden of proof on this pleaded claim rests on petitioners, we find that petitioners' Section 2(a) "deceptiveness" claim, like its Section 2(a) "false suggestion of a connection" and its Section 14(3) "misrepresenting the source of the goods" claims, must fail.

Thus, the only remaining pleaded ground for cancellation is petitioners' Section 2(d) claim of priority and likelihood of confusion. Respondent has not disputed that confusion is likely to result from the parties' use of the identical mark, ESSIAC, on identical goods, and we find that a likelihood of confusion clearly

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exists in this case. Thus, the only issue to be decided is which party has priority under Section 2(d).

Two preliminary comments are in order. First, the issue of which of the parties, if any, possesses or is using Rene Caisse's alleged "true" or "original" herbal food supplement formula is irrelevant to our priority analysis. The issue is priority of use of the trademark in commerce, not the alleged authenticity or inauthenticity of the product on which each party is using the trademark or the validity or invalidity of each party's claim to be the rightful heir of Rene Caisse's legacy. Second, we note that the co-petitioners appear to have had a falling out during the course of this proceeding, and that each is claiming rights in the mark which are adverse to the other's rights. However, our task in this case is not to determine the co-petitioners' respective rights in the mark, *inter se*. Rather, the only issue presented is whether continued registration of respondent's mark is barred under Section 2(d).¹¹

¹¹ Based on the pleadings and the evidence of record, we find that each co-petitioner has established its standing to petition to cancel respondent's mark. The apparent adversity of the co-petitioners' interests does not negate either co-petitioner's standing. Moreover, respondent's contentions regarding the alleged inauthenticity of co-petitioner's product are irrelevant to the issue of standing.

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We begin our priority analysis by noting that respondent filed the application which matured into Registration No. 1,625,600, the registration involved in this proceeding, on March 9, 1990. Respondent accordingly is entitled to rely, for priority purposes, on the statutory presumption of constructive use of its mark as of that filing date. See Trademark Act Section 7(c), 15 U.S.C. §1057(c); *J. C. Hall Company v. Hallmark Cards, Incorporated*, 144 USPQ 435 (CCPA 1965).¹² Thus, our initial inquiry is whether either of

¹² Respondent is entitled to rely on the statutory presumption of constructive use as of its application filing date because the issue of whether respondent had used the mark prior to the application filing date was neither pleaded by petitioners nor tried by the express or implied consent of the parties. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 at n.4 (TTAB 1993). As discussed above in connection with petitioners' fraud claim, petitioners did not plead, as a separate ground for cancellation, that respondent had not used its mark in commerce prior to the application filing date. Likewise, we cannot conclude on this record that the nonuse issue was tried by the express or implied consent of the parties as an additional ground for cancellation. Respondent's evidence of its use of the mark was presented for the purpose of defeating petitioner's pleaded Section 2(d) priority claim, not for the purpose of establishing its use of the mark prior to the application filing date in order to defeat an unpleaded nonuse claim. As discussed *infra*, petitioners' evidence in support of its priority claim centers on the alleged activities of Resperin Corporation and of Mankind Research Foundation commencing in the late 1970's. Not suprisingly, respondent's evidentiary efforts to defeat petitioners' priority claim likewise focus on the alleged activities of respondent or its predecessors during and prior to the late 1970's. In the absence of any pleading of nonuse as a separate ground for cancellation, respondent had no burden of specifically proving use of its mark prior to the 1990 application filing date, and it is entitled to rely on that filing date as its date of constructive first use, for purposes

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the petitioners have proven that the ESSIAC mark or trade name was "previously used [i.e., prior to March 9, 1990] in the United States ... and not abandoned" by the petitioner(s) or their predecessors-in-interest. If not, they cannot prevail on their Section 2(d) claim.

In the petition to cancel, petitioners base their priority claim on the alleged previous use of the ESSIAC mark in the United States by their predecessors-in-interest, i.e., Rene Caisse since 1934 and the Canadian company Resperin Corporation since 1977. Petitioner Dobbie, in his brief, continues to rely on this alleged previous use of the mark by Caisse and Resperin.

However, petitioner Mankind Research Foundation, in its brief, does not cite to or rely on any evidence of this pleaded previous use by Caisse and Resperin, but rather relies on its evidence of its own (unpleaded) use of the mark in the United States since October 1978.

We address first Dobbie's reliance on the alleged previous use of ESSIAC in the United States by Rene

of Section 2(d) priority. See *Levi Strauss & Co., supra*, and *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 36 USPQ2d 1328 (TTAB 1994). (Similarly, petitioners' arguments in their briefs that respondent has failed to prove that it has made any use at all of its mark are unavailing, even if we assume, *arguendo*, that they are correct. Abandonment, like nonuse, is not a pleaded ground for cancellation in this case, nor was it tried by the express or implied consent of the parties.)

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Caisse and Resperin Corporation. Petitioners presented no evidence to support a finding that Rene Caisse, prior to her death in 1978, ever used the mark ESSIAC in the United States. In fact, it was respondent, not petitioners, who attempted to prove and rely upon such use by Caisse, and petitioners objected (properly, in our view) on hearsay and other grounds to any and all such attempts by respondent.

Petitioner Dobbie also contends, however, that the Canadian company Resperin Corporation, petitioners' immediate predecessor-in-interest, used the mark in the United States beginning in 1977 and continuously until 1991, when it entered into a "representation agreement" with petitioner Mankind Research Foundation. In support of this contention, Dobbie relies on the "Statutory Declaration" of Resperin's former director and president Dr. Matthew Dymond, and on his own trial testimony.¹³

¹³ Although they are not cited to or relied upon in Dobbie's brief, the August 8, 1996 testimony depositions of petitioners' witnesses Harold Collins and Pat Safriet should be noted, if only to point out that neither witness' testimony is probative or corroborative evidence of use of the ESSIAC mark in the United States by Resperin Corporation. Pat Safriet, a resident of Tennessee, testified that she obtained a single shipment of ESSIAC for personal use in late 1989. She ordered it by placing a phone call from Tennessee to Canada, and the product was shipped from Canada to her in Tennessee. However, she could not identify from whom she bought the product, and she did not testify that the product came from Resperin Corporation or any of its principals. Harold Collins, a resident of Michigan,

We turn first to Dr. Dymond's "Statutory Declaration" (Dobbie Exhibit P-11).¹⁴ Petitioner Dobbie

testified that in Fall 1988 he placed a telephone call (from Michigan) to Dr. Dymond, a principal of Resperin Corporation who was located in Canada, and ordered ESSIAC for his personal use. Dr. Dymond shipped the product from his location in Canada to Windsor, Ontario, Canada, and Mr. Collins drove from Michigan to Windsor, picked up the product, and brought it back to Michigan. This incident did not constitute use of the ESSIAC mark by Resperin Corporation "in the United States," and is de minimus in any event.

¹⁴ This two-page document is entitled "STATUTORY DECLARATION" and begins: "I, Dr. Matthew Dymond, M.D.C.M., F.C.F.P., LL.D., of Port Perry, Ontario, Canada do solemnly and sincerely declare as follows:". The document then sets forth Dr. Dymond's *curriculum vitae* for the years 1935-1982, after which is set forth the following:

In summary I was actively involved in medical practice at both practical and administrative levels from 1942. Two Universities, the University of Western Ontario, London, Ontario and Queens University, Kingston, Ontario, both granted me an LL.D.

During my term as Minister of Health I became interested in Resperin Corporation and in the product Essiac through the then President, the late David Fingard. Following my resignation from the Ministry of Health I became more active in the company. I was a member of the Board of Directors of Resperin Corporation and also held the position of President of Resperin Corporation. The exclusive rights to Essiac were signed over to Resperin Corporation by Rene Caisse in 1977.

From 1979 until 1987 I devoted some time to the promotion, selling, taking orders for and shipping the product Essiac in Canada and to Greece, U.K., U.S.A. and other places. Essiac was sold into the U.S.A. at least as early as 1986 and into England [and] Greece at least as early as 1987. It was sent in the form of units of two bottles in a purpose made cardboard container, which in turn was packed in polystyrene chips in an outer box. I resigned from all activity with Resperin Corporation in 1993.

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relies, in particular, on Dr. Dymond's assertion, in the declaration, that "[f]rom 1979 until 1987 I devoted some time to the promotion, selling, taking orders for and shipping the product Essiac in Canada and to Greece, U.K., U.S.A. and other places. Essiac was sold into the U.S.A. at least as early as 1986 ..."

The declaration appears to have been signed by Dr. Dymond and notarized on August 25, 1994, after the commencement of this proceeding. Petitioner Dobbie testified as follows regarding how this document came to be prepared:

In 1994 I had been involved in Essiac for three years and we were trying to establish the provenance of Essiac and this was just one method of doing it or one link in the chain of doing it. Dr. Dymond was not in very good health, and he proposed that he make a declaration outlining his knowledge of Essiac and his - his business with it. And this was the - this was the result.

(Dobbie October 17, 1997 deposition, at 31.) It appears from the record that Dr. Dymond subsequently died over a year later, in late 1995 or early 1996.

Trademark Rule 2.123(b) allows for the testimony of a witness to be submitted in affidavit (or declaration)

AND I MAKE this solemn declaration conscientiously believing the same to be true and knowing that it is

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form only "by written agreement of the parties." No such written agreement covering the Dymond declaration is of record.¹⁵ Trademark Rule 2.123(1) provides that "[e]vidence not obtained and filed in compliance with these sections [including Trademark Rule 2.123(b)] will not be considered." Dr. Dymond's declaration was not obtained and filed in compliance with Trademark Rule 2.123(b), and it accordingly will not be considered. Moreover, the declaration clearly is hearsay to the extent that petitioner relies on it for the truth of the matters asserted therein.¹⁶

Petitioner Dobbie also cites to and relies on his own testimony as evidence that Resperin Corporation used the Essiac mark in the United States beginning in 1977.

of the same force and effect as if made under oath and by virtue of the Canadian Evidence Act.

¹⁵ Nor can we deem respondent to have waived the "written agreement" requirement of Trademark Rule 2.123(b). Although respondent did not object, during Dobbie's deposition, to introduction of the declaration as an exhibit to Dobbie's testimony, neither did respondent, in its brief on the case, treat the declaration or the assertions made therein as being properly of record. Distinguish, e.g., *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993). In these circumstances, we see no basis for disregarding the clear and express requirement for a written agreement set out in Trademark Rule 2.123(b).

¹⁶ Respondent also attempted to introduce into evidence the affidavits of several persons. We have not considered those affidavits for the same reasons we have not considered Dr. Dymond's declaration, i.e., because they are not offered in compliance with Trademark Rule 2.123(b) and because they constitute hearsay.

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By his own admission, however, Mr. Dobbie has no personal knowledge of Resperin's activities prior to 1991, and bases his testimony wholly on what he was told by the principals of Resperin Corporation and on the above-referenced declaration of Dr. Dymond. See, e.g., Dobbie August 23, 1996 testimony deposition on written questions at pp. 15-17; Dobbie October 17, 1997 testimony deposition at pp. 42-43, 153, 157-58, and 176; and Dobbie April 12, 1999 rebuttal testimony deposition at pp. 25-26. His testimony on this issue is inadmissible hearsay, and is not probative evidence that Resperin Corporation had ever used the ESSIAC mark in the United States prior to its February 18, 1991 agreement with Mankind Research Foundation or, more importantly for our purposes, prior to the March 9, 1990 filing date of respondent's application.

There is no other evidence in the record to corroborate the hearsay statements of Resperin's principals regarding Resperin Corporation's use of the mark in the United States. Moreover, we note that the February 18, 1991 agreement between Resperin and Mankind Research Foundation, which was drafted and executed prior to the commencement of this proceeding, in fact appears

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to bely any asserted previous use of the mark in the United States by Resperin. The agreement's recitals state only that Resperin "has a proprietary interest in a formulated product known as 'Essiac' and has for some time prior to the date hereof marketed the said product through various medical practitioners in Canada as a treatment for cancer..." (Emphasis added.) Pursuant to Paragraph 7 of the agreement, Mankind Research Foundation agreed "to assume all obligations of RCL [Resperin] to patients in Canada presently being treated with Essiac." (Emphasis added.) Inasmuch as Mankind Research Foundation is located in the United States, it is reasonable to assume that the agreement would have obligated Mankind to assume Resperin's obligations to Resperin's patients or customers in the United States, if any, as well as Resperin's obligations to its Canadian patients. The agreement makes no mention of any such United States patients or customers, nor does it recite any previous marketing of Essiac in the United States by Resperin.

Petitioner Dobbie, by his own admission, first learned of Essiac in April 1991 and did not begin his own use of the ESSIAC mark in the United States until September 1991, a date subsequent to respondent's March

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9, 1990 application filing date. (Dobbie Depo. on Written Questions, at 15.) As discussed above, the evidence of record, when taken as a whole, fails to establish that either of Dobbie's pleaded predecessors-in-interest, Rene Caisse and Resperin Corporation, had used ESSIAC as a mark or a trade name in the United States prior to respondent's March 9, 1990 application filing date. In view thereof, we conclude that petitioner Dobbie has failed to establish his priority, vis-à-vis respondent, and that his Section 2(d) ground for cancellation accordingly must fail. Likewise, to the extent that petitioner Mankind Research Foundation relies upon the pleaded but unproven previous use of the ESSIAC mark in the United States by Rene Caisse and Resperin Corporation, its Section 2(d) claim must fail.

As noted above, however, Mankind and Dobbie had a falling out during the course of this proceeding. Mankind appears in its briefs to have abandoned the theory of priority that it, along with Dobbie, pleaded in the petition to cancel. Rather than relying on any alleged use of the ESSIAC mark in the United States by Rene Caisse or by Resperin Corporation, Mankind now claims priority based on its own alleged use of the mark in the United States since October 1978.

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In support of this new priority claim, Mankind relies on the May 29, 1998 testimony deposition of its principal, Dr. Carl Schleicher. He testified that Mankind began using the mark in the United States on October 31, 1978, and has continued to use the mark without interruption since then. He introduced as exhibits to his testimony four invoices from October and November 1978, and testified that they document actual sales and/or shipments of goods marked ESSIAC from Mankind's offices in Maryland to purchasers in New York, Pennsylvania and Washington, D.C., as well as a shipment to the National Cancer Institute in Maryland for evaluation and testing purposes.¹⁷

This evidence is sufficient to prove Mankind's use of the mark in 1978. However, upon careful review of the entire record, the Board finds that Mankind's claim of continuous use of the mark after 1978 is problematic. Although Dr. Schleicher testified that Mankind has used the mark continuously since 1978, his testimony is quite vague on the details and is not corroborated by any documentary evidence dated after 1978.

For example, it is unclear from Dr. Schleicher's testimony where Mankind obtained the ESSIAC products it

¹⁷ We reject as unproven and unfounded respondent's contention

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is asserted to have sold or shipped after 1980. He testified that he received samples of the product, "not very many" bottles, from Resperin during 1978-1980, but does not identify Mankind's source for the product, if any, after 1980. He testified that he received the formula for the product from Resperin along with instructions on how to prepare the product, but he cannot recall, even generally, when that might have occurred. It is reasonable to assume, however, that Mankind did not receive Resperin's formula for the Essiac product until the parties entered into their 1991 agreement. That agreement specifically provides that the formula for the product is "attached hereto in a sealed envelope." No such attachment presumably would have been necessary if Mankind had already received the formula from Resperin prior to 1991. Indeed, it is not clear why Mankind would have entered into the agreement at all, and obligated itself to pay royalties to Resperin, if it already possessed the formula.

When he was asked why Mankind did not file a U.S. trademark application for registration of the ESSIAC mark until 1993, if it had been using the mark since 1978, Dr. Schleicher testified: "Well, we weren't sure if we were

that these invoices are false or fraudulent documents.

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going to proceed with this at all. It took us a while to sort out Essiac and see if it would be in our interest to make an agreement, which we eventually did. And we made a filing on the trademark." (Schleicher depo., at 117.) This testimony weighs against a finding that Mankind was making continuous commercial use of the mark prior to its 1991 agreement with Resperin Corporation. Additionally, the 1991 agreement itself, at Paragraph 8, deals with setting the royalty amounts to be paid by Mankind to Resperin. It speaks only prospectively of Mankind's production of the Essiac product: "Upon the said product being produced and marketed by MRF [Mankind], a selling price shall be determined"

Section 2(d) requires that a plaintiff's confusingly similar mark be shown to have been "previously used in the United States ... and not abandoned." Mankind has presented evidence sufficient to establish its use of the mark in the United States in 1978, and thus has proven that its mark was "previously used." However, the issue of whether Mankind's use of the mark was "not abandoned" is much less clear. Its claim of continuous use of the mark between 1978 and its 1991 agreement with Resperin Corporation rests solely on the vague and uncorroborated testimony of Dr. Schleicher.

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In a Section 2(d) case, it is not the plaintiff's burden to prove that its previously used mark is "not abandoned." Rather, it is the defendant's burden to plead and prove such abandonment. See *West Florida Seafood v. Jet Restaurants*, 31 F.3d 1122, 31 USPQ2d 1660 (Fed. Cir. 1994). In this case, respondent specifically pleaded abandonment as an affirmative defense.

Respondent also introduced evidence which, when combined with the inconclusiveness of Dr. Schleicher's testimony, leads us to conclude that a preponderance of the evidence supports a finding that Mankind abandoned its use of the mark prior to respondent's March 9, 1990 application filing date.

Specifically, respondent has made of record certain correspondence between Mankind and respondent, an exchange of cease and desist letters between the parties which occurred in 1991. In response to a cease and desist letter from respondent, Dr. Schleicher wrote a letter to respondent dated October 16, 1991 in which he stated, "We plan to distribute this [the Essiac product] in the U.S. commencing in about 30 days but we are already distributing this now in Canada." (Gaulin 12/17/96 depo., Exh. F.) Respondent, in its November 20, 1991 letter in response to Mankind's October 16, 1991

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letter, rejected Mankind's cease and desist request, stating "we have been in production since 1978 and you are the new kid on the block." (Gaulin 12/17/96 depo., Exh. K.) In response to that letter, Mankind sent another letter dated November 26, 1991, which stated, *inter alia*, "This letter is to put you and your company under advisement that our organization has been granted exclusive world-wide rights to ESSIAC by the Resperin Corporation." In response to respondent's claim, in its November 20, 1991 letter, that it had been distributing Essiac since 1978, Mankind asserted in its November 26, 1991 letter: "We are not 'the new kid on the block,' as you falsely and derogatorily assumed. We have followed ESSIAC since 1977, and have been in contact with the Resperin Corporation since 1980." (Gaulin 12/17/96 depo., Exh. AL.)

Mankind's October 16, 1991 and November 26, 1991 letters to respondent, which obviously were written and mailed prior to the commencement of this proceeding, contain admissions by Dr. Schleicher which cast serious doubt on Mankind's assertion that it has used the ESSIAC mark in the United States continuously since 1978. Indeed, that claim of use since 1978 is directly contradicted by Dr. Schleicher's statement, in the

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October 16, 1991 letter, that Mankind "plan[s] to distribute this [Essiac] in the U.S. commencing in about 30 days," i.e., on or about November 16, 1991. The only logical interpretation of this statement is that, as of October 16, 1991, Mankind had not been distributing Essiac in the United States.

Additionally, when confronted with respondent's claim in its November 20, 1991 letter that respondent had been distributing the Essiac product since 1978, one would think that, if Mankind too had in fact been using the mark in the United States since 1978 as it now claims, it would have made that assertion in its November 26, 1991 response to respondent's November 20, 1991 letter, in order to present its strongest case for priority. Instead, Mankind stated only that it has "followed" ESSIAC since 1977 and that it has "been in contact with Resperin Corporation since 1980." Likewise, in its November 26, 1991 letter, Mankind indicated that its rights in the ESSIAC mark arose from and were based on the rights it obtained from Resperin Corporation, not from any prior use of the mark by Mankind itself. That is completely consistent with Mankind's originally-pleaded claim that its priority is based on the previous use of the mark by its predecessor-in-interest Resperin

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Corporation, but it is inconsistent with Mankind's newly-asserted claim of priority based on its own alleged continuous use of the mark since 1978.

Upon review and consideration of the entire record, we find that even if Mankind had "previously used" the ESSIAC mark in the United States, i.e., in 1978, such use had been abandoned prior to respondent's March 9, 1990 filing date. Accordingly, we find that Mankind has not established its priority vis-à-vis respondent and thus its entitlement to judgment under Trademark Act Section 2(d).

In summary, we find that petitioners have failed to prove any of their pleaded grounds for cancellation of respondent's registration, i.e., fraud, misrepresentation of source under Trademark Act Section 14(3), false suggestion of a connection and deceptiveness under Trademark Act

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Section 2(a), or priority of use under Trademark Act
Section 2(d).

Decision: The petition to cancel is dismissed.

G. D. Hohein

P. T. Hairston

C. M. Bottorff

Administrative Trademark Judges
Trademark Trial and Appeal Board