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Hearing:
August 8, 2002

Paper No. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Yamaha Corporation of America
v.
Wrightwood Enterprises, Inc.

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Opposition No. 108,787
to application Serial No. 775/039,316
filed on December 26, 1995

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Paul Garrity, Margaret Ferguson and William R. Golden, Jr. of Kelley Drye & Warren for Yamaha Corporation of America.

Jeffery A. Handelman and Nicholas de le Torre of Brinks Hofer Gilson & Lione for Wrightwood Enterprises, Inc.

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Before Seeherman, Quinn and Bucher, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Wrightwood Enterprises, Inc. to register the mark EVERETT for "pianos."[1]

Registration was opposed by Yamaha Corporation of America under Section 2(d) of the Trademark Act on the

[1] Application Serial No. 75/039,316, filed December 26, 1995, alleging dates of first use of July 14, 1995.

ground that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used mark EVERETT for pianos as to be likely to cause confusion.

Applicant, although admitting that opposer used the mark EVERETT for pianos in years prior to 1990, went on in its answer to deny the salient allegations of likelihood of confusion. Applicant also set forth affirmative defenses, including that opposer abandoned its mark and, thus, opposer does not have superior rights in the mark.

The record consists of the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by each party; and official records introduced by applicant's notice of reliance. Both parties filed briefs on the case, and both were represented by counsel at an oral hearing held before the Board.

Evidentiary Objections

With respect to the record, there are a few evidentiary objections raised by opposer that require our attention before we turn to the merits of the opposition.

Opposer's first objection relates to the acceptability of a print-out from the Office's Trademark Electronic Search System (TESS) of opposer's expired

Registration No. 1,027,898, which applicant submitted as Exhibit 2 under its notice of reliance. The Trademark Trial and Appeal Board Manual of Procedure (TBMP) §707 provides for the introduction of an official record by way of an electronic copy generated from the Office's database. Accordingly, the expired registration was properly introduced, and it has been considered.

Opposer's other objections relate to three areas of inquiry covered in the testimony deposition taken by applicant of Terry Lewis, an adverse witness. In total, opposer requests that seventeen pages and three related exhibits be stricken. For essentially the reasons set forth by applicant in its brief, the objections are not well taken and are, accordingly, denied. We hasten to add that neither the testimony nor the exhibits sought to be stricken is critical to the outcome of this case; even if stricken, we would reach the same result on the merits in this case.

The Parties

Opposer is engaged in, inter alia, the manufacture, sale and servicing of pianos. Opposer is a leader in the piano market in this country, and annually expends millions of dollars in promoting its pianos. Although the specific information relating to market share was

designated as "confidential" during a testimonial deposition, the figures appear in opposer's brief. Thus, we view opposer as having waived the "confidential" designation. Opposer's pianos account for 25% of the United States piano market in units, and about 35% of the market in dollars.

Little is known about applicant, other than it is a Michigan corporation located in Lansing, Michigan.

The Issue

As indicated above, the pleaded ground in the notice of opposition is priority and likelihood of confusion, and applicant, in its answer, denied the allegations relating thereto. Applicant conceded in its brief, however, that "[t]here is no dispute as to likelihood of confusion." (brief, p. 2). Indeed, the parties claim rights in the identical mark, EVERETT, for the identical goods, pianos. Clearly, there is a likelihood of confusion between the marks, and we so find herein. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

It is applicant's contention, however, that opposer abandoned its mark EVERETT for pianos due to discontinued use of the mark with an intent not to resume use. Thus, applicant maintains, opposer has no superior rights in

the pleaded mark and because its claim of priority must fail, opposer cannot prevail on the Section 2(d) ground.

In view of the above, the parties agree that the only issue before us is whether opposer has abandoned its mark and, therefore, whether opposer lacks superior rights in the mark. In this connection, the effect of abandonment has been described as follows:

> Once abandoned, the mark reverts back to the public domain whereupon it may be appropriated by anyone who adopts the mark for his or her own use. Hence a party that is found to have abandoned its mark is deprived of any claim of priority in the mark before the date of abandonment and may regain rights in the mark only through subsequent use after the time of abandonment.

General Cigar Co., Inc. v. G.D.M., Inc., 988 F.Supp 647, 45 USPQ2d 1481, 1489 (SDNY 1997), quoting Dial-A-Matress Operating Corp. v. Mattress Madness, Inc., 841 F.Supp 1339, 33 USPQ2d 1961, 1972-73 (EDNY 1994).

The material facts in the present case are largely undisputed. Rather, the controversy in this case centers on the legal implications that arise from those facts. Applicant contends that opposer has not sold EVERETT pianos since the early 1990's, and that any activities since then do not evidence an intent to resume use of the mark. Opposer acknowledges that production of EVERETT

pianos ceased in 1989, and that its inventory of new pianos was sold off by 1996. Opposer maintains, however, that it has continued to use its mark and that, even in the event that nonuse for three years is found, opposer has an intent to resume use as shown by various business activities and, in large part, by residual goodwill in the mark EVERETT.

The Record

Opposer's predecessors in interest began manufacturing pianos under the mark EVERETT in 1882. According to the testimony of Terry Lewis, opposer's senior vice president, opposer acquired the assets of Everett Piano Company located in South Haven, Michigan in 1973.[2] These assets included a federal trademark registration, Registration No. 1,027,898 for the mark EVERETT for "pianos,"[3] that expired in 1996 for failure to renew. Over the years, pianos bearing the mark EVERETT were sold to a variety of classes of purchasers, but the pianos were particularly attractive to music departments of educational entities. The record shows that EVERETT

[2] The record includes two testimonial depositions of Terry Lewis. The first was taken by opposer on September 12, 2000, and is identified herein as "dep. 1." The second was taken by applicant on August 9, 2001, with Mr. Lewis as an adverse witness, and is identified as "dep. 2."

[3] The registration issued December 23, 1975, asserting dates of first use of March 1882.

pianos were purchased by more than 12,000 colleges, universities, music conservatories and similar institutions.

After acquiring Everett Piano Company, opposer continued to manufacture pianos under the mark EVERETT at the Michigan plant; at the same plant opposer also manufactured pianos under the YAMAHA mark. Paul Heid, president of Heid Music Company, a chain of four retail stores in Wisconsin, testified on behalf of opposer. Mr. Heid stated that when opposer acquired the Everett Piano Company, pianos sold under the mark EVERETT had an excellent reputation in the industry, and that the quality of the pianos improved further after opposer's acquisition. Opposer's EVERETT pianos were promoted through product literature, sell sheets, advertisements in trade publications, local newspapers, and on the radio. The pianos were also promoted at trade shows for the piano industry.

Subsequent to opposer's acquisition, in the years 1978-1985, Mr. Lewis testified that there was "a steep decline in sales of pianos" industry wide, pointing to reasons such as excess capacity in factories, severe competitive conditions and generally poor economic conditions. Due to this economic downturn, and the fact

that the South Haven, Michigan plant, in opposer's view, was a very old and inefficient facility, opposer decided to close this plant, and operations ceased there in April 1986. At the time of this factory's closure, opposer decided to transfer the Michigan plant's production of YAMAHA pianos to opposer's plant in Georgia, where there was excess capacity due to a downturn in opposer's organ business. According to Mr. Lewis, however, "there was not enough excess capacity there to begin making EVERETT pianos again." (dep 2., p. 25).

Opposer then made a decision to outsource the production of EVERETT pianos, and consequently entered into an original equipment manufacturer agreement with Baldwin Piano and Organ Company ("Baldwin") whereby Baldwin began production in early 1987 of EVERETT pianos on behalf of opposer. Reaction to these Baldwin-made pianos was "mixed," Mr. Lewis testifying that "the quality of the piano did not meet the traditional performance standards of the previous EVERETT piano." (dep. 1, p. 10). Although improvements in the product line were made and opposer and Baldwin remained on good terms, opposer made a decision in the summer of 1989 to end its relationship with Baldwin. Opposer was not meeting its sales goals for its EVERETT pianos, the

market position of EVERETT pianos was weak, and in late 1989, the contract between opposer and Baldwin was terminated. Manufacturing of EVERETT pianos quickly ceased and, according to Mr. Lewis, opposer has not produced a single EVERETT piano since then. (dep. 1, p. 14; dep. 2, p. 41). Opposer continued to manufacture its YAMAHA pianos at the plant in Georgia.

At least two printed publications documented the cessation of production of EVERETT pianos. The Piano Book (2d ed. 1990) indicated that "[w]hen Yamaha moved its U.S. piano manufacturing to Thomaston, Georgia, Everett did not go with it." The publication went on to state that "[t]he contract under which Baldwin was manufacturing these pianos for Yamaha ended in 1989 and the Everett name and piano line was dropped permanently." The third edition of The Piano Book, published in 1994, included the same information. Another piano reference book, Pierce Piano Atlas (10th ed. 1997), stated the following: "Yamaha closed the South Haven plant in September 1986 and moved to Thomaston, GA. Yamaha stopped production of Everett." Although Mr. Lewis acknowledged these specific statements during his second deposition, he went on to assert that there are factual mistakes appearing elsewhere in the publications.

After manufacturing ceased in 1989, opposer continued to sell off the excess inventory of new EVERETT pianos built under the contract with Baldwin. Mr. Lewis testified that "we sold out that inventory over a period of--of years and months after that, and again, I can't tell you exactly when that ceased, but we were actively engaged in selling those pianos sometime after that." (dep. 2, pp. 42-43). Mr. Lewis explained that turnover in piano inventory is slower than in other industries, and, in the specific case of EVERETT pianos, "there was a significant business momentum that took some time to disappear." (dep. 2, p. 43). More specifically, Mr. Lewis testified, at his first deposition, that the last EVERETT pianos were sold "in around 1992." (dep. 1, p. 31). In his second deposition, Mr. Lewis stated that "we sold our last EVERETT piano from inventory roughly around 1992, 1993. I don't have an exact date with me." (dep. 2, p. 19).

Regarding the sell-off of inventory, Bill Brandom, opposer's national piano service manager, testified that opposer had a substantial inventory of new EVERETT pianos through 1992, and that EVERETT pianos were sold as late as November 1996. In total, Mr. Brandom indicated that between April 1989 and November 1997 (that is, when the

notice of opposition was filed), opposer sold over 3,000 new EVERETT pianos. Upon closer inspection, we note that Exhibit 38 of Mr. Brandom's deposition reveals that of these 3,000 pianos, virtually all were sold before 1991, with only 9 sold in 1992, and only 3 sold after 1992. The last two sales occurred in September and November of 1996; Mr. Brandom explained that "[m]ost likely they would have been pianos sitting in one of our warehouses that Sales finally got around to selling." (dep., p. 22).

Mr. Heid, identified earlier, and Thomas Hoy, president and owner of five retail music stores and two warehouses, all located in Michigan, testified as to their sales of new EVERETT pianos. When EVERETT pianos were being manufactured, both Mr. Heid and Mr. Hoy sold new EVERETT pianos in their stores. Mr. Hoy recalled that he last sold a new EVERETT piano in 1989. Mr. Heid testified that the last shipment of new pianos to dealers occurred in 1992, although "I know we had EVERETT pianos on our sales floor even, you know, for years after they were no longer manufactured with the EVERETT name on them." Upon further questioning, Mr. Heid quantified these years to be "two to three years," and identified

his last sale of an EVERETT piano ("not the hottest seller") in October 1995. (dep., pp. 22-23; 27).

The bulk of the information relating to sales of used EVERETT pianos also comes from Messrs. Hoy and Heid. Mr. Hoy claimed that his stores have displayed an EVERETT piano on showroom floors every year since 1990, and he estimated that perhaps twenty pianos were on the floors over any one-year period. Messrs. Hoy and Heid also testified about the sale of EVERETT pianos coming off of rent-to-own programs (the customer ultimately converting to ownership after a rental period) and rent-to-rent programs (after a rental period and resulting depreciation, the piano is then sold to another customer). Mr. Hoy indicated that he sold such pianos through the mid-1990's. Mr. Hoy also testified as to warranties on opposer's pianos that he sold (whether new, used or in the rental programs), indicating that "we still potentially could have Everett pianos out there with warranties in existence today, which would--but certainly even in the late mid '90s, we certainly had Everett pianos out there with service warranties, which was a 10 or 12 year parts and warranty on that piano." (dep., p. 28). Mr. Hoy stated that his music company continued to service Everett pianos and that "probably

most of the warranties would have ended in 1999, or the year 2000." (dep., p. 29).

Mr. Heid recounted that, in addition to pianos coming off of the rent-to-own program, his company sold used EVERETT pianos. His company would purchase the piano from a seller and then resell it, or, if the seller and Mr. Heid could not agree on a price, the piano would be sold on a consignment basis. Although Mr. Heid testified that used EVERETT pianos were sold "every year," he could not estimate how many were sold each year; according to Mr. Heid, "it falls under our radar scope of brand sales." (dep., p. 29). Mr. Heid estimated, however, that his company had an EVERETT piano on its showroom floors in each of the last ten years. (dep., p. 30). Mr. Heid specifically mentioned the EVERETT "Style 11" pianos that were sold to schools, then traded in and resold by Mr. Heid.

Insofar as service and parts for EVERETT pianos are concerned, Mr. Brandom testified relative thereto. Mr. Brandom's duties, as opposer's national piano service manager, include management of warranty and service support for EVERETT pianos, as well as of parts for such pianos. Although Mr. Brandom acknowledged that no dealer is currently selling new EVERETT pianos, he estimated

that there are over 200,000 EVERETT pianos still in use today. He further estimated that 700-800 EVERETT pianos sold by opposer were still under warranty at the time of his testimony in September 2000. Mr. Brandom further indicated that opposer repairs EVERETT pianos beyond the life of the warranty period in order to maintain good customer service relations. Mr. Brandom also testified that opposer has "a portion of the Yamaha.com Web site that is there for consumers to be able to find out the specific age of their EVERETT piano." (dep., p. 7). According to Mr. Brandom, opposer also maintains an inventory of spare parts for EVERETT pianos. For parts not kept in inventory, opposer contacts outside entities to manufacture such parts that may be needed. In this connection, Mr. Heid indicated that many piano parts are generic, although some parts are specific to EVERETT pianos. There is no testimony, however, that any of the parts for the EVERETT pianos bears the mark EVERETT. Mr. Brandom stated that opposer annually receives approximately 100-150 service calls for EVERETT pianos. Service is then arranged by opposer, even after the warranty has expired. Opposer maintains contact with various service technicians with regard to servicing

EVERETT pianos, and opposer maintains service manuals for the pianos.

Mr. Lewis testified that opposer has given consideration to manufacturing EVERETT pianos at its plant in Georgia. Nothing was ever brought to fruition, however, "[b]ecause the piano market actually began to improve during the '90s, and we did not have the excess factory capacity to produce the instrument." (dep. 1, p. 15). Mr. Lewis also confirmed that no consideration has been given to outsourcing the EVERETT piano. Mr. Lewis indicated that "we did discuss the possibility of selling EVERETT [pianos] to different distribution channels than the existing Yamaha distribution channels as an opportunity to expand the market, but our sales and utilization of current factory capacity was so strong, that we were not sufficiently motivated to go further with that idea." (dep. 1, p. 16). Mr. Lewis testified as to other discussions regarding the use of EVERETT, the most recent of which occurred in 1997 relative to possible production at a factory in China.

Mr. Lewis testified that the life span of an upright console acoustic piano (the type sold under the mark EVERETT) is estimated by the piano manufacturers' trade association at 68 years. Mr. Hoy stated that "older

American pianos, like Everett, were built extremely well, so they hold up for 40, 50, 60 years. They don't have much of an obsolescence. So instead of people buying a new one, they are handed down through generations before the piano gets bad enough." (dep., p. 32). Mr. Lewis confirmed that opposer continues to repair and service EVERETT pianos, and that such activities extend beyond the warranty period of ten years.

In connection with the life span of pianos, Mr. Lewis went on to say that

> the EVERETT trademark was a valuable piano trademark, and piano trademarks have a very long shelf life in the piano industry.
>
> Piano trademarks tend to have a lot of long-term goodwill value associated with the name. Even brands that have remained dormant for years that have been picked up by others have been renewed with a high degree of market success because pianos are an instrument that lasts a very, very long time, have established a reputation over generations of piano teachers and piano technicians. And the goodwill associated with some of the better names has lasted a very long time even though the pianos may have not been continuously manufactured over a sustained period of time. (dep. 1, pp. 16-17)

Insofar as opposer's now-canceled registration of the mark EVERETT for pianos is concerned, it expired in

1996 for failure to renew under Section 9 of the Act. Opposer filed an intent-to-use application to register the mark EVERETT for pianos on August 29, 1996 (compared with the December 26, 1995 filing date of the involved application).

The Law

Section 45 of the Trademark Act provides, in pertinent part, that a mark is abandoned when the following occurs:

> When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for three consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

A party claiming abandonment has the burden of establishing the case by a preponderance of the evidence. Introduction of evidence of nonuse of the mark for three consecutive years constitutes a prima facie showing of abandonment and shifts the burden to the party contesting the abandonment to show either evidence to disprove the underlying facts triggering the presumption of three years nonuse, or evidence of an intent to resume use to disprove the presumed fact of no intent to resume use.

Rivard v. Linville, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); Imperial Tobacco Ltd. v. Philip Morris Inc., 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990); Cerveceria Centroamericana S.A. v. Cerveceria India Inc., 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989); and Stromgren Supports, Inc. v. Bike Athletic Company, 43 USPQ2d 1100 (TTAB 1997). The burden of persuasion remains with the party claiming abandonment to prove abandonment by a preponderance of the evidence. On-line Careline Inc. v. America Online Inc., 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).

ANALYSIS

The record establishes, and opposer does not dispute, that opposer ceased production of EVERETT pianos in 1989, and that opposer's last sales of new EVERETT pianos from its inventory of 3,000 pianos occurred in 1996. The specific breakdown in sales volume, as shown by Exhibit 38 (pages 0001337-38) to Mr. Brandom's testimony, is as follows: 1991--53 pianos; 1992--9 pianos; 1993--0 pianos; 1994--1 piano; 1995--0 pianos; and 1996--2 pianos. Thus, the evidence shows that all but 65 of the pianos were sold before 1991; and that only three pianos were sold after 1992. So as to be clear, only 65 pianos were sold under the EVERETT mark by

opposer after 1990; only three were sold after 1992; and no pianos were sold after 1996. As noted above, Section 45 of the Act provides that "use" of a mark means the bona fide use of that mark made in the ordinary course of trade, and not made merely to reserve a right in a mark. Here, we find that opposer's nonuse of the mark EVERETT for pianos began in 1992, and that the sales of three pianos over the next four years fall short of use of the mark in the ordinary course of trade. These sales are especially negligible given opposer's prominence in sales and market share in the piano trade.

Opposer's nonuse of the mark EVERETT for pianos since 1992 constitutes a prima facie showing of abandonment. Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); and Colgate-Palmolive Co. v. Sanford Chemical Co., 162 USPQ 424 (TTAB 1969). The burden thus shifts to opposer to show evidence of an intent to resume use to disprove the presumed fact of no intent to resume use. We find that the circumstances surrounding opposer's nonuse warrant a finding that the nonuse was accompanied by an intent not to resume use of the mark EVERETT.

As noted above, Mr. Lewis testified that after 1989 no new pianos were produced under the EVERETT mark. This

was a result of a decision made by opposer to cease production. Sales made after the cessation in production consisted only of the sell off of leftover inventory, virtually all of which occurred by the end of 1990. In addition, Mr. Lewis indicated that after the sell off of inventory, opposer did not actively advertise and promote the EVERETT brand; in point of fact, out of a considerable amount of advertising expenditures since that time, opposer has not spent any money in promoting pianos bearing the EVERETT mark. Further, opposer did not license use of the EVERETT mark to any third party, and opposer did not enter into any agreement with a third party to manufacture pianos under the mark EVERETT. (dep. 2, p. 43-44). The last trade show at which an EVERETT piano was exhibited was in January 1989. Simply put, after opposer stopped production of EVERETT pianos and the inventory was sold off, the record is devoid of evidence to show that the mark was used on pianos in the ordinary course of trade.

Due to a downturn in the piano market, opposer made a conscious decision to stop production of EVERETT pianos in 1989. The cessation in 1989 was total in nature, with apparently no thought given to scaling production to correspond with the reduced market demand. When opposer

later considered resumption of production of EVERETT pianos at its Georgia factory in light of an improved piano market in the 1990's, opposer decided against it because of the lack of any excess capacity at the factory. Thus, it is particularly telling that, in the face of an improved market, opposer chose to use the manufacturing capacity it did have to produce pianos under marks other than EVERETT. When the Georgia factory did have excess capacity in the mid-1990's, opposer made a decision not to resume production of EVERETT pianos because, in Mr. Lewis' words, opposer "did not want to disrupt traditional channels of distribution." Mr. Lewis also testified that opposer, in 1993-94, gave thought to producing a digital piano under the EVERETT mark. Opposer chose not to go forward with the idea due to prohibitive expense and uncertain market potential. In 1997, opposer considered production of EVERETT pianos at one of its factories located in China. Opposer declined to go further with this idea, however, because it had an existing contractual obligation to use another mark. Although Mr. Lewis testified that it is "possible" that in the future opposer may consider having EVERETT pianos manufactured in China, no further specifics were given.

The record reveals that when opportunities arose to use the EVERETT mark after 1989, even during times of an improved piano market, opposer made a business decision not to do so. Such deliberate decisions, made on at least four occasions, during the period of nonuse are not those that a reasonable businessman would make pursuant to a plan to resume use of the mark. Rivard v. Linville, supra at 1337. These business decisions undercut opposer's rights in the mark and any goodwill that might have attached to the mark in connection with pianos.[4]

Further, considerations regarding resumption of use were sporadic and appear to be casual in nature, with no specific details given about the depth of such discussions. The "considerations" are vague, and there is no documentation, as, for example, business plans or marketing studies relative thereto. In short, there are no concrete plans to resume use at any time in the future. See: Imperial Tobacco Ltd. v. Philip Morris Inc., supra at 1394 ["the Lanham Act was not intended to provide a warehouse for unused marks"].

A significant aspect of opposer's arguments in response to the claim of abandonment relates to the

[4] Further, opposer does not suggest, nor has it submitted any evidence, to indicate that it has deferred production of EVERETT

presence of EVERETT in the piano aftermarket by way of dealers' sales of used pianos, and of opposer's sales of parts, as well as by the servicing of EVERETT pianos. Opposer argues that notwithstanding cessation of production of EVERETT pianos in 1989, the mark continues to be in use and that, in any event, there remains considerable residual goodwill in the EVERETT mark.

With respect to opposer's provision of parts and repair services for previously sold EVERETT pianos, it would appear that such activities are not done under the EVERETT mark. As Mr. Heid testified, many piano parts for EVERETT pianos are generic. Moreover, it does not appear that any parts, including those specific to EVERETT pianos, bear the mark EVERETT, either directly on the part or on the packaging for the part. As to the repair services, again the record is devoid of any evidence showing use of the EVERETT mark in connection with the repair services. Thus, although opposer offers parts and repair services for its EVERETT pianos, the mark EVERETT has not been used in connection with either. Further, the use of EVERETT on opposer's web page is merely a reference so that an owner of a EVERETT piano can determine its age.

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pianos because of this litigation which has been pending since

Opposer also relies upon subsequent sales of used EVERETT pianos by dealers such as Messrs. Heid and Hoy. We recognize that when a manufacturer who owns a trademark is an active participant in the aftermarket for its goods, and continues to advertise, promote, and exploit the goodwill in the mark to the exclusion of others, abandonment generally will not be found. See discussion, infra. Residual goodwill, however, is not sufficient to avoid a finding of abandonment where the goodwill is generated through subsequent sales of a product by distributors or retailers. Societe des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L., 10 USPQ2d 1241, 1244 n. 5 (TTAB 1989). Further, residual goodwill in a mark by virtue of a long shelf life and continued sales by retailers is of little moment here. Opposer cannot rely on some residual goodwill through post-abandonment sales of used EVERETT pianos by distributors or dealers. Parfums Nautee Ltd. V. American International Industries, 22 USPQ2d 1306, 1309 (TTAB 1992). The sales by Messrs. Hoy and Heid do not inure to opposer's benefit, such that these sales show use of the mark by opposer in the ordinary course of trade. Further, there is little information relative to the

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1997.

volume of such sales; other than stating that used EVERETT pianos have been sold, no specific number has been made of record. What evidence we do have suggests very limited sales, with Mr. Heid remarking that his sales "fell under his radar scope."

The three publications on pianos submitted by applicant, which state that production of EVERETT pianos had ceased, suggest that there was a perception in the industry that the mark had been abandoned. In response to opposer's point that there is residual goodwill in the EVERETT mark among service technicians and piano teachers, we would point out that these classes of individuals may be the ones most likely to be aware of the subject publications that state the mark is no longer used by opposer. Although we recognize the probative limitations of the printed publications relied upon by applicant, these publications tend to support the view that use of the EVERETT mark was discontinued with an intent not to resume use.

Opposer's self-serving testimony that opposer never intended to abandon the mark is simply outweighed by the objective evidence supporting the conclusion that the mark was abandoned with an intent not to resume use. See: Imperial Tobacco Ltd. V. Philip Morris Inc., supra.

Given the entirety of the circumstances herein, any goodwill remaining in the EVERETT mark simply does not overcome the evidence bearing on opposer's lack of an intent to resume use of the mark. The record falls short of establishing that reasonable constancy of effort in marketing EVERETT pianos which would constitute persuasive evidence of an intention to resume use of the mark in the ordinary course of trade after 1990 when virtually all of the inventory of EVERETT pianos had been sold. The evidence simply does not establish that opposer is an active participant in the use of the mark EVERETT.

In arguing that it has not abandoned the EVERETT mark, opposer cites to several cases in support of its position, most of which appear in its reply brief. Opposer chose to highlight two of the cases during oral argument and, thus, these cases bear discussion, with the caveat, however, that "as is true with most issues of trademark law, the determination of abandonment is peculiarly dependent on the facts of each particular situation and remarks in prior opinions are of little help." Sterling Brewers, Inc. v. Schenley Industries, Inc., 441 F.2d 675, 169 USPQ 590, 593 (CCPA 1971).

The first case is American Motors Corporation v. Action-Age, Inc., 178 USPQ 377 (TTAB 1973) wherein the Board found a likelihood of confusion between opposer's mark RAMBLER for cars and applicant's mark SCRAMBLER for off-highway recreational vehicles. In deciding the case, the Board considered applicant's affirmative defense that opposer had abandoned its RAMBLER mark. The Board noted that production of RAMBLER brand automobiles ceased in mid-1970, and went on to make the following findings of fact relative to the abandonment claim:

> While opposer does not presently employ the mark RAMBLER on its new automobiles, approximately two hundred to two hundred and fifty of its dealers display the mark RAMBLER on signs in their windows or on their windows; about sixty dealers incorporate the mark RAMBLER in their company names or trade names; over two million RAMBLER automobiles are currently registered for vehicle licenses throughout the United States; opposer distributes a wide range of automobile accessories and replacement parts for the RAMBLER cars in cartons and envelopes prominently displaying the RAMBLER mark; and automobiles bearing the mark RAMBLER are presently being sold in South Africa, Mexico and Australia.

Based on the evidence before it, the Board found no abandonment:

> While opposer has discontinued the use of RAMBLER as a trademark for vehicles

> produced by opposer over the past few years, the record falls short of establishing any abandonment thereof. [footnote omitted] In fact, there is a considerable reservoir of goodwill in the mark RAMBLER in this country that inures to opposer as a consequence of the large number of RAMBLER vehicles still on the road; opposer's activities in supplying RAMBLER parts and accessories to owners of these vehicles; and the use by dealers of the term RAMBLER as a portion of their corporate or business names and their maintenance of RAMBLER signs on their premises.

The facts in the present case, quite simply, are not as compelling as those in the cited case. The uses of the mark RAMBLER by American Motors Corporation represented significant ongoing commercial activity. There is no evidence herein that opposer uses the mark EVERETT in the same manner or to the same extent. Dealers (the record includes evidence of only two) for opposer's used pianos do not display the mark EVERETT on any signs or displays; no dealers appear to use EVERETT as part of their names; and parts supplied by opposer for EVERETT pianos do not bear the EVERETT mark, and are not shipped in packaging bearing the mark. Further, and in any event, the record is silent as to the scope of revenue generated by sales of replacement parts and the rendering of repair services, and therefore opposer has

not shown that its activities are of the breadth of the activities in American Motors. Moreover, the period of nonuse in the present case is at least four years longer than that in American Motors.

The second case is Ferrari S.p.A. Esercizio Fabbriche Automobili e Corse v. McBurnie, 11 USPQ2d 1843 (SD Cal 1989). The court there found that although production of DAYTONA SPYDER automobiles ceased in 1974, the trademark owner continued to manufacture and sell and to license the manufacture and sale of mechanical and body parts for the automobile. The court also noted that the owner maintained original molds and tooling for the cars, and that the cars have continued to be driven, serviced, restored, sold and exhibited by Ferrari customers. The court concluded that the mark DAYTONA SPYDER remained in the public eye, and that the goodwill symbolized by the mark was still strongly associated with Ferrari.

We view the facts in Ferrari to be distinguishable from the ones in the present case. Quite simply, opposer's ostensible level of activity under the EVERETT mark does not rise to the levels undertaken by Ferrari. As the record indicates, many piano service and replacement parts, including those for EVERETT pianos,

are generic, and there is no indication that the parts supplied by opposer herein bear the trademark at issue. Opposer itself has done very little in the way of deliberate and continuous business activity to keep the EVERETT mark in the public eye.

Lastly, opposer accuses applicant of being an opportunist, with an intent to trade upon opposer's goodwill in the mark EVERETT. Opposer points to the fact that applicant originally was named "Everett Piano Company" with an address in South Haven, Michigan, that is, the town in which opposer's EVERETT pianos were manufactured. Opposer also points out that applicant filed its involved application a mere three days after opposer's registration expired for failure to file a renewal. Suffice it to say that, based on opposer's cessation of production of EVERETT pianos in 1989, de minimis sales after 1990, and the expiration of opposer's registration in 1995, it was reasonable for applicant to believe that opposer's mark was abandoned and now available for adoption by it. As succinctly stated by Professor McCarthy: "Once abandoned, a mark may be seized immediately and the person so doing may build up rights against the whole world." 2 J.T. McCarthy,

McCarthy on Trademarks and Unfair Competition, §17:2 (4th ed. 2001).

In sum, we find that opposer has abandoned the mark EVERETT for pianos and that, therefore, it does not have superior rights in the mark. Accordingly, opposer has not established one of the necessary elements of a claim of likelihood of confusion. See: American Standard Inc. v. AQM Corporation, 208 USPQ 840, 841 (TTAB 1980).

Decision: The opposition is dismissed.