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PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Mailed:

September 22, 2011

Faint

Cancellation No. 92051212

Cancellation No. 92051213

Cancellation No. 92051215

Karen L. Willis

v.

Can't Stop Productions, Inc.

**Before Seeherman, Walters and Taylor,  
Administrative Trademark Judges.**

**By the Board:**

Petitioner, the wife and manager of a former member of the musical recording group the Village People, has filed amended petitions for cancellation<sup>1</sup> of respondent's three

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<sup>1</sup> In Cancellation No. 92051212 petitioner filed a first amended petition to cancel on July 21, 2009, and a second amended petition to cancel on August 11, 2009. Respondent appears to have filed its answer as to the second amended petition to cancel. The proper procedure would have been for petitioner to file a motion to amend the petition to cancel with her second amended petition, or to file it with respondent's consent. See Fed. R. Civ. P. 15(a)(2). In view of respondent's answer, it appears that respondent has consented to the amendment of the pleading, and therefore we have accepted the second amended petition to cancel and respondent's answer thereto. However, petitioner is reminded that strict compliance with the rules is required in the future. We also note that petitioner has created some confusion by alleging damage in the original and amended petitions to cancel from two registrations, Nos. 1101013 and 2184290, although the petition to cancel filed in this proceeding relates only to Registration No. 2184290, and Registration No. 1101013 is the subject of Cancellation No. 92051213. To clarify, the Board deems the petition to cancel in Cancellation No. 92051212 as relating solely to Registration No. 2184290.

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registrations: two registrations are for the typed word mark, VILLAGE PEOPLE,<sup>2</sup> and one is for the design mark shown below:



This case now comes up for consideration of respondent's motions for summary judgment on petitioner's pleaded grounds of fraud, abandonment and genericness in each of the three cancellation proceedings.

***I. Single Order***

While there is no motion to consolidate these proceedings pending, Fed. R. Civ. P. 42(a), as made applicable to Board proceedings by 37 CFR Section 2.116(a) (Trademark Rule 2.116(a)), provides that when actions involving common questions of law and fact are pending before the Board, the Board may order all of the actions consolidated, and it may make any orders concerning

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<sup>2</sup> Registration No. 1101013, issued August 29, 1978, for "entertainment services rendered by a musical and vocal group" in Class 41, based on an application filed November 17, 1977 and asserting dates of first use and first use in commerce of July 11, 1977.

Registration No. 2184290, issued August 25, 1998, for "pre-recorded phonograph records, audio cassettes, audio tapes and compact discs featuring music and vocals" in Class 9, based on an application filed November 17, 1993 and asserting dates of first use and first use in commerce of 1978; goods in class 16 were cancelled pursuant to § 8 of the Trademark Act in 2008.

<sup>3</sup> Registration No. 2330857, issued March 21, 2000, for "entertainment services, namely, live performances by a musical and vocal group" in Class 41, based on an application filed April 3, 1998, and asserting dates of first use and first use in commerce of July 11, 1977.

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proceedings to avoid unnecessary costs or delay. In this case there is sufficient commonality of factual and legal issues in the proceedings that consolidation for consideration of the summary judgment motions is appropriate. All three cancellation proceedings involve the same parties and contain very similar pleadings. However, because Cancellation Nos. 92051213 and 92051215 are disposed of by this order, as explained more fully below, consolidation is unnecessary beyond the issuance of this single order applicable to all three proceedings.

## ***II. Sufficiency of Pleadings***

A decision on summary judgment necessarily requires a review of the operative pleadings of these three cases. *See, e.g., Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1478 (TTAB 2009). Therefore, we start by noting that the petitions do not properly plead claims of fraud.

The Court of Appeals for the Federal Circuit has held that a trademark registration is obtained, or maintained, fraudulently only if the respondent knowingly makes a false, material representation with the intent to deceive the USPTO. *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009). Under Fed. R. Civ. P. 9(b), any allegations of fraud based upon "information and belief" must be accompanied by a statement of facts upon which the

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belief is founded. See *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 91 USPQ2d 1656, 1670 n.7 (Fed. Cir. 2009); *Meckatzer Lowenbrau Benedikt Weiss KG v. White LLC*, 95 USPQ2d 1185 (TTAB 2010).

In order to properly plead a claim of fraud in a trademark cancellation proceeding, a petitioner must allege with particularity that the respondent knowingly made a false, material misrepresentation when applying for a trademark registration, or when renewing a registration, with intent to deceive the USPTO. *Enbridge Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1540 (TTAB 2009). It is the preferred practice of the Board that the element of intent be pled specifically, but intent, as a condition of mind of a person, may be averred generally. Fed. R. Civ. P. 9(b); see also *DaimlerChrysler Corp. v. American Motors Corp.*, 94 USPQ2d 1086, 1089 (TTAB 2010) (finding allegations of material misrepresentations knowingly made to procure a registration constitute sufficient allegation of intent element for pleading fraud).

Petitioner bases her claims of fraud on various theories that require some construction and which we summarize as follows: 1) respondent provided false dates of first use in its applications either in the application as originally filed or in a statement of use; 2) the marks have not been in use in commerce since the original Village People group disbanded and respondent's post-registration filings continued this fraud

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regarding dates of use; 3) the marks misrepresent the source of the goods because the Village People group disbanded about 1982; and 4) various claims relating to the nature of respondent's services, as discussed more fully below. To the extent petitioner considers each of these claims to allege a particular type of fraud, we consider them each in turn.

1. Dates of Use in the Applications/Statement of Use

Petitioner alleges in her amended petitions for cancellation that the dates of first use claimed in the applications which resulted in issuance of respondent's registrations, namely, July 11, 1977 in Registration Nos. 1101013 and 2330857, and 1978 in Registration No. 2184290, were false.

With regard to Registration Nos. 1101013 and 2330857, for the mark VILLAGE PEOPLE and the design mark for entertainment services rendered by a musical and vocal group, petitioner argues that the only member of the "group" as of the July 11, 1977 claimed date of first use was petitioner's husband, who was accompanied by professional background singers. To the extent petitioner is alleging that the date of use is false or inaccurate because her husband only performed with background singers as of the claimed date of first use and did not perform with others who would later become known as members of the Village People group until after July 11, 1997, we do not find this distinction to state a claim of fraud.

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With regard to Registration No. 2184290, also for the mark VILLAGE PEOPLE, but for various types of recordings, petitioner essentially argues that the first musical album was recorded in July 1977, not 1978. This claim also fails to state a claim of fraud because the dates of first use alleged by an applicant in a use-based application or statement of use filed in an intent-to-use application, even if false, do not constitute fraud, as long as there was technical trademark use on or before the filing date of the application or statement of use. Clearly, petitioner contends that there was use prior to the filing date of November 17, 1993.

With respect to the design mark shown in Registration No. 2330857 for entertainment services, the application was filed on April 3, 1998, and claimed a date of first use of July 11, 1977. Petitioner alleges, however, that the earliest date the mark could have been used was 1979, because all of the characters represented in the mark did not exist until that time, and the appearance of the characters changed over time. This claim, too, does not state a claim of fraud, because by petitioner's own reckoning, all the characters represented in the mark were part of the group by the time the application was filed. Again, a claim of fraud based on assertion of a false date of first use will not lie unless there is no use of the mark on or before the filing date.

Respondent contends that petitioner has not adequately alleged that the marks were not in use as of the filing dates of the applications or statements of use, submits further evidence of its claimed dates of use, and argues that, as a matter of law, there is no proper pleading of claims of fraud regarding the dates of use. We agree.

In view thereof, petitioner's fraud claims based on allegedly false dates of first use are stricken.

2. Non-use as of the Post Registration Filing Dates

Petitioner alleges that respondent was not using the marks on the filing dates of the respective Section 8 and 15 declarations, and the declarations filed in the Section 9 renewal applications, because the specimens submitted with the post registration declarations were not in continuous use for the five years immediately preceding the filing of the declarations. We construe these as claims of fraud for non-use. Fraud based on non-use of a mark occurs when a party knowingly, and with the intent to deceive the USPTO, represents that it is using the mark in connection with goods or services, when in fact no use of the mark has been made. *Herbaceuticals, Inc. v. Xel Herbaceuticals, Inc.*, 86 USPQ2d 1572 (TTAB 2008).

Specimens of use need only illustrate current use of the mark at the time of filing the Section 8 and 15 declarations and the application for renewal. In fact, a declaration of continuing use filed pursuant to Section 8 does not require

that the mark be in use for the five years preceding the filing of the declaration, only that the mark be in use at the time the declaration is executed. The same is true of the application for renewal. Even for a Section 15 declaration, which asserts five years of continuous use, there is no requirement that the *same* specimen be used for those five years, only that the mark be in use for five continuous years prior to the filing of the declaration. To the extent petitioner is claiming fraud on these grounds, petitioner simply misunderstands the law.<sup>4</sup> In view thereof, petitioner's fraud claims based on allegations that the specimens were not in use at the time of the post registration filings are stricken as insufficient.

### 3. Misrepresentation of Source

A claim of misrepresentation of source under Section 14(3) is a separate claim from fraud, and has not been separately pleaded by petitioner. It pertains to situations where a registered mark is used to deliberately misrepresent that goods or services originate from the registrant when in fact those goods or services originate from the petitioner. A pleading of misrepresentation of source must include allegations of blatant misuse of the mark by the registrant in a manner calculated to

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<sup>4</sup> Petitioner concedes that the use made by respondent's licensee Universal Music and Video Distribution inures to respondent's benefit and, in her opposing brief in Cancellation No. 92051212, withdraws her reliance on the claim that use was made by respondent's licensee, rather than by respondent.

trade on the goodwill and reputation of the petitioner. *Otto International Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007). Petitioner's allegations fall short of these requirements. In view thereof, to the extent petitioner bases her fraud claims on alleged misrepresentation of source, the claims are insufficient both as fraud claims and as separate misrepresentation of source claims, and are stricken.

#### 4. Nature of the Services

Petitioner makes various claims regarding the nature of respondent's services, including, the Village People is not a "musical and vocal group" but a "concept group;"<sup>5</sup> the design mark does not depict petitioner's husband, Victor Willis; subsequent groups did not include petitioner's husband as a member or performer; and the group members lip-sync when performing and this constitutes "Milli Vanilli fraud." The Board's jurisdiction is limited to the registrability of trademarks, and none of these claims constitutes a legally cognizable trademark claim within the Board's jurisdiction.

#### 5. Requirements for Adequate Fraud Pleading

Petitioner's claims recite that "upon information and belief" fraud has been committed, but these claims are largely devoid of any facts upon which the alleged belief can be reasonably based. Further, petitioner has not alleged fraud

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with the required particularity. It is only upon review of the declarations of petitioner and her husband, Victor Willis, attached to petitioner's papers opposing respondent's motion for summary judgment, that we discern a possible claim, but the claim is not adequately pleaded. With respect to Registration No. 2184290, that possible claim is non-use of the mark VILLAGE PEOPLE as of the underlying application filing date of November 17, 1993, and non-use of the mark as of the date of execution of all subsequent declarations of continued use, on pre-recorded phonograph records, audio cassettes and audio tapes featuring music and vocals.

We emphasize that, for the reasons set out above, petitioner has not properly pleaded any claim of fraud, but we nonetheless note that respondent has not presented evidence in support of its motion for summary judgment that would entirely preclude proper potential pleading by petitioner of non-use claims, and possibly a fraud claim based on allegations of non-use. While respondent has presented evidence of use on pre-recorded phonograph records for the years 1977-1982, there is no evidence offered that the mark was used beyond that date for those goods.

Therefore, petitioner's claims of fraud are legally insufficient and are hereby stricken from the pleadings.

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<sup>5</sup> To the extent petitioner intends this as a claim of abandonment for the identified services, the claim is addressed below in the section on abandonment.

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However, petitioner may, if appropriate, submit an amended petition to cancel asserting proper claims of non-use and/or fraud in Cancellation No. 92051212 only.

In view thereof, petitioner may, within **THIRTY DAYS** from the mailing date of this order, submit a third amended petition to cancel in Cancellation No. 92051212 which adequately pleads fraud and/or non-use.

We turn now to the claims of abandonment and genericness argued in respondent's motions for summary judgment as to all three cases.

### ***III. Summary Judgment***

Summary judgment is appropriate when there is no genuine dispute as to any material fact and the moving party is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(a). A party moving for summary judgment has the initial burden of demonstrating the absence of evidence to support the nonmoving party's case, and that it is entitled to judgment as a matter of law. *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1795-1796 (Fed. Cir. 1987), citing *Celotex Corp. v. Catrett*, 477 U.S. 317, 325, 106 S.Ct. 2548, 2554 (1986). When the moving party has supported its motion with sufficient evidence which, if unopposed, indicates there is no genuine dispute of material fact, the burden then shifts to the non-moving party to demonstrate the existence of a genuine dispute as

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to a material fact to be resolved at trial. *Enbridge*, 92 USPQ2d at 1540. A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. See, *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

A trademark registration more than five years old may be canceled at any time if, inter alia, the mark becomes generic or is abandoned, or if the registration was obtained through fraud. See 15 U.S.C. § 1064.

**A. Abandonment**

Petitioner makes similar allegations regarding abandonment of all three of the registered marks, namely that since the 1980's the marks have only been licensed for live performances and no new recordings have been made since 1985; that the mark is for a "concept group," not a musical group; and that changes have been made to the design mark because of changes to certain of the characters depicted in the mark. Petitioner alleges that these changes amount to abandonment of all three marks without an intent to resume use.

Under Section 45 of the Trademark Act, a mark is deemed abandoned if its use has been discontinued without intent to

resume use, and nonuse in the United States for a period of three consecutive years establishes a *prima facie* case of abandonment. See 15 U.S.C. § 1127. Thus, in order to prove abandonment, petitioner must be able to show that respondent's use of the mark has been discontinued for at least three consecutive years, or that respondent has discontinued use of the mark without an intent to resume use. *Id.*; see also, *On-Line Careline, Inc. v. America Online, Inc.*, 229 F.3d 1080, 1087, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000). Conversely, respondent, as the party moving for summary judgment dismissing the claims of abandonment, must establish continuous use of its marks for all of the goods and services named in the registrations, or that it has not ceased use without an intent to resume use. Respondent provides declarations from its managing director, Henri Belolo, declaring that Can't Stop Productions has offered pre-recorded musical recordings since 1977 and they are currently distributed, and that it has continually owned and used the marks with entertainment services since 1977. Also provided were the declarations of Mitchell Weiss, the manager of respondent's licensee, declaring that the licensed marks include VILLAGE PEOPLE and the design mark, and the marks have been continuously used by the licensee for over twenty years for musical performances. Attached to these declarations is evidence in the form of exhibits to

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show that the three marks have continuously been used and are still in use.

We must view respondent's motion for summary judgment on abandonment in a light most favorable to petitioner as the non-moving party. With regard to Registration No. 2184290, petitioner pleads that respondent cannot be offering recordings because the group has made no new recordings since the 1980's, and the mark has been licensed only for live performances since that time. Respondent has presented declarations and exhibits showing that compact discs have been continuously sold up to the present time, and petitioner does not dispute that point. Respondent has not shown, however, that it is still using the mark in connection with pre-recorded phonograph records, audio cassettes and audio tapes featuring music and vocals. At the least there is a genuine dispute of material fact as to whether respondent has ceased using its mark in connection with those goods. Accordingly, respondent's motion for summary judgment is denied in Cancellation No. 92051212.

With regard to Registration Nos. 1101013 and 2330857 for entertainment services, petitioner's arguments revolve around whether the performing group is a "real" musical and vocal group, or a "concept group," but petitioner does not allege or even argue that no performances are taking place. Petitioner presents her own declarations that she has seen

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the group perform, taking issue with the manner of performance, not the fact of it.<sup>6</sup> Respondent has submitted magazine and internet advertisements, supported by the declaration of Mitchell Weiss, showing that the mark VILLAGE PEOPLE and the design mark have been used in connection with musical performances in 1994, 1995, 1997, 1998, 2001, 2002, 2003, 2004, 2005, 2006, 2008 and 2010. Further, respondent has asserted that use has been continuous, as evidenced by the Belolo and Weiss declarations. Whether or not petitioner believes there is a distinction between a "real" musical and vocal group and a concept group, petitioner has not raised a genuine dispute that the performances by respondent's group are not the rendering of performances by a musical and vocal group. Accordingly, there is no genuine dispute that respondent has used its marks for entertainment services in commerce without any gap of three years of non-use, and prima facie evidence of abandonment therefore does not exist. Accordingly, respondent's motions for summary judgment on the grounds of abandonment are granted in Cancellation Nos. 92051213 and 92051215.

### ***B. Genericness***

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<sup>6</sup> The Board notes that petitioner filed two additional declarations in Cancellation No. 92051213 because of an alleged scanning and upload error in the e-filing of a declaration signed by Victor Willis in that proceeding. Respondent filed an objection to the filing as untimely. Under the circumstances of this case, where an essentially identical declaration was filed in the other two cancellation proceedings, the Board grants the

Although respondent has brought a motion for summary judgment regarding petitioner's genericness claims, in actuality respondent is arguing that this ground should be dismissed. Petitioner alleges in all three cases that the mark is generic because it identifies people in a village, and provides evidence attached to her response briefs to show the term VILLAGE PEOPLE is used to describe groups of people living in a community or small town. Respondent argues that petitioner does not allege that there are any other users of the mark for musical recordings or entertainment services, and provides evidence, supported by the Belolo declaration, that it has been the exclusive user of the VILLAGE PEOPLE marks in connection with musical recordings and performances for a significant period of time.

We note first that petitioner's allegations cannot apply to the design mark shown in Registration No. 2330857, because the words "Village People" do not appear in the mark.

A term is generic if it is the common descriptive name for a genus of goods or services, and should be refused registration because it does not function as a trademark or service mark. *Park' N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 194 (1985). But a term can be a generic

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motion to amend to the extent that the corrected declaration of

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term in one context and arbitrary or fanciful in another, and thus serve as a valid trademark when used as a mark for goods or services in another context. It is fallacious to allege that because a term is the generic name for one thing, it cannot serve as the trademark for another thing. *See, e.g., Eurotech, Inc. v. Cosmos European Travels Aktiengesellschaft*, 213 F.Supp.2d 612, 620, (E.D. Va. 2002) (rejecting as fallacious the argument that because COSMOS is generic for universe, it cannot serve as a trademark for travel agency services); *see also* 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 12:1 (4th ed. WESTLAW Update Aug. 2011).

We find that petitioner has not, and apparently cannot, raise any genuine dispute of material fact with regard to this ground as petitioner has submitted no evidence, nor even made allegations, to show the term VILLAGE PEOPLE is used as a generic term for musical recordings or performances. Accordingly, summary judgment is granted with respect to the ground of genericness in all three proceedings.

#### **IV. Summary**

In summary, respondent's motions for summary judgment are granted on petitioner's claims of abandonment in Cancellation Nos. 92051213 and 92051215, and as to

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Victor Willis is substituted in Cancellation No. 92051213.

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genericness in all three proceedings. Because there are no properly pleaded fraud or non-use claims in Cancellation Nos. 92051213 and 92051215, and there do not appear to be any such viable claims against Registration Nos. 1101013 and 2330857 in those proceedings, summary judgment on the grounds of abandonment and genericness in those proceedings are a final disposition of the cases. Accordingly, Cancellation Nos. 92051213 and 92051215 are dismissed with prejudice.<sup>7</sup>

**V. Schedule**

Within **THIRTY (30) DAYS** of the mailing date of this order petitioner may submit a third amended petition to cancel in Cancellation No. 92051212 which adequately pleads fraud and/or non-use of certain goods, failing which the cancellation proceeding will go forward solely on the issue of abandonment. In the event petitioner files and serves such an amended petition for cancellation, the Board will

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<sup>7</sup> Because this is a final decision of the Board, the decision as to Cancellation Nos. 92051213 and 92051215 may be appealed to the Court of Appeals for the Federal Circuit or to a U.S. District Court with appropriate jurisdiction. See Trademark Act Sections 21(a)(1) and 21(b)(1), 15 U.S.C. §§ 1071(a)(1) and 1071(b)(1); Trademark Rule 2.145, 37 C.F.R. § 2.145; and TBMP § 901.01 (3d ed. 2011). The decision in Cancellation No. 92051212 is interlocutory in nature, therefore, any appeal thereof can be raised only after final disposition of that proceeding. See *Copeland's Enterprises Inc. v. CNV Inc.*, 12 USPQ2d 1562 (Fed. Cir. 1989).

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assess the sufficiency of those pleadings and reset answer dates, if appropriate.<sup>8</sup>

Proceedings in Cancellation No. 92051212 are resumed and dates are reset as set out below.

Expert Disclosures Due	10/27/2011
Discovery Closes	11/26/2011
Plaintiff's Pretrial Disclosures Due	1/10/2012
Plaintiff's 30-day Trial Period Ends	2/24/2012
Defendant's Pretrial Disclosures Due	3/10/2012
Defendant's 30-day Trial Period Ends	4/24/2012
Plaintiff's Rebuttal Disclosures Due	5/9/2012
Plaintiff's 15-day Rebuttal Period Ends	6/8/2012

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<sup>8</sup> The parties should note that the evidence submitted in connection with the motions for summary judgment is of record only for consideration of those motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See, Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993). The parties may, however, stipulate that any or all of the summary judgment evidence be treated as properly of record for purposes of final decision. *See, e.g., Eveready Battery Co., Inc. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009) (parties stipulated that evidence submitted in connection with summary judgment motion shall be deemed of record for trial pursuant to Accelerated Case Resolution (ACR)); *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998) (parties stipulated that evidence submitted in connection with summary judgment motion shall be deemed of record for trial).