

**This Opinion is Not a
Precedent of the TTAB**

Mailed: April 19, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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Chaldean American Chamber of Commerce

v.

Ben Kalasho

—
Cancellation No. 92059277
—

Ronald G. Acho of Cummings, McClorey, Davis & Acho, P.L.C. for Chaldean
American Chamber of Commerce.

Ben Kalasho, pro se.

—

Before Kuhlke, Masiello and Lynch,
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Chaldean American Chamber of Commerce (Petitioner) seeks to cancel Ben Kalasho's (Respondent) registration on the Supplemental Register for the mark SAN DIEGO EAST COUNTY CHALDEAN AMERICAN CHAMBER OF COMMERCE (CHAMBER OF COMMERCE disclaimed) in standard characters for

“Chamber of commerce services, namely, promoting business and tourism in the san diego and east county area” in International Class 35.¹

PLEADINGS

As grounds for cancellation, Petitioner alleges likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on its use of the mark CHALDEAN AMERICAN CHAMBER OF COMMERCE since “as early as December 11, 2001 to the present” in connection with “chamber of commerce services, such as, promoting business and tourism in the United States.” Pet. to Cancel ¶ 1, 1 TTABVUE 3. Petitioner further alleges that it filed an application for its mark. Pet. to Cancel ¶ 2, 1 TTABVUE 3.

In his answer, Respondent admits the allegations regarding his registration (Ans. ¶¶ 3, 5, 4 TTABVUE 2, 3), and otherwise denies the salient allegations. Respondent asserted without specific allegations the affirmative defenses of “laches, estoppel, and/or acquiescence,” and “file wrapper estoppel.” Ans. ¶¶ 14, 15, 4 TTABVUE 3. Respondent’s other “affirmative defenses” are simply amplifications of his denials. Ans. ¶¶ 13, 17, 18, 19, 4 TTABVUE 4.

RECORD

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

¹ Supplemental Registration No. 4516721, filed on November 8, 2013, issued on April 15, 2014, claiming a date of first use and first use in commerce on September 1, 2013.

for cancellation.² Petitioner submitted the testimony with accompanying exhibits of Martin Manna, Petitioner's president (taken November 16, 2015). Petitioner also submitted "four letters of support." However, these letters were not submitted under testimony and are not proper subject matter for submission under notice of reliance. Trademark Rule 2.122, 37 C.F.R. § 2.122. In view thereof, they have not been considered.

Respondent did not submit any evidence or testimony during his assigned testimony period.³ Respondent's operative brief on the case was filed on July 7, 2016.⁴

STANDING

As discussed below, Petitioner has shown that it has used the mark CHALDEAN AMERICAN CHAMBER OF COMMERCE in connection with a variety of chamber of commerce services and has demonstrated a real interest in preventing registration of the proposed mark. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058 (Fed. Cir. 2014); *Cunningham v. Laser Golf*

² While Petitioner alleged in its pleading it has a pending application, a plaintiff's application or registration is not the subject of the proceeding and is not automatically part of the record under Trademark Rule 2.122(b). A plaintiff's application must be introduced into the record either under testimony or notice of reliance. *See TBMP* § 704.03(b)(2) (Jan. 2017).

³ In a prior order, the Board made clear that the material attached to Respondent's prior filings was not properly filed as evidence and will not be considered as "testimonial evidence." 43 TTABVUE 6-7.

⁴ This brief was accepted by Board order on December 2, 2016. 50 TTABVUE. Respondent had filed a prior brief that was not in compliance with Board rules in that it was single spaced. *See* 43 TTABVUE 12. Although the brief was filed early (even prior to Petitioner's timely-filed brief), as the Board noted in its prior order, there is no rule prohibiting the early filing of a trial brief.

Corp., 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Lipton Ind's, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Thus, Petitioner has established its standing.

LIKELIHOOD OF CONFUSION

Priority

Because Petitioner does not own a registration it must prove prior proprietary rights based on prior common law use. “To establish priority, [Petitioner] must show proprietary rights in the mark that produces a likelihood of confusion These proprietary rights may arise from ... prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights.” *Herbko Int'l., Inc., v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002) (internal citations omitted); *Hydro-Dynamics Inc. v. George Putnum and Company Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981). “Under the rule of *Otto Roth*, a party [challenging] registration of a trademark due to a likelihood of confusion with his own unregistered term cannot prevail unless he shows that his term is distinctive of his [services], whether inherently or through the acquisition of secondary meaning or through ‘whatever other type of use may have developed a trade identity.’” *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990) (citing *Otto Roth*, 209 USPQ at 43). Thus, in order to prevail, Petitioner must

establish that its CHALDEAN AMERICAN CHAMBER OF COMMERCE mark is distinctive, either inherently or through acquired distinctiveness, and that its use and acquisition of distinctiveness predates Respondent's acquisition of proprietary rights. *See Perma Ceram Enters., Inc. v. Preco Indus., Ltd.*, 23 USPQ2d 1134, 1138 (TTAB 1992) (“[w]here the mark relied upon by a plaintiff in support of its ... priority of use and likelihood of confusion claim ... [is] ... merely descriptive ... then the plaintiff must establish priority of acquired distinctiveness.”)

Respondent did not submit evidence to establish any use and because Respondent's mark issued on the Supplemental Register he cannot rely on the filing date of the underlying application. A Supplemental registration is not competent evidence to establish priority of use of Respondent's mark. It is entitled to no presumptions of validity, ownership, use or priority. *In re Federated Dep't Stores*, 3 USPQ2d 1541 (TTAB 1987) (Supplemental Registration not entitled to Section 7(b) presumptions including reliance on filing date as constructive use); *Andrea Radio Corp. v. Premium Import Co., Inc.*, 191 USPQ 232 (TTAB 1975); *Nabisco, Inc. v. George Weston Limited*, 179 USPQ 503 (TTAB 1973); *Nautalloy Products, Inc. v. Danielson Manufacturing Company*, 130 USPQ 364 (TTAB 1961). Petitioner's witness, Mr. Manna, testifies that he believes Respondent started his organization around 2013. Manna Test., 44 TTABVUE 25. In addition, Petitioner submitted Respondent's response to Interrogatory No. 2 in which Respondent states his first use of the mark was February 2, 2013. Manna Test., Exh. 8, 24 TTABVUE 43. However, there is no evidence to establish Respondent's acquired distinctiveness.

CHALDEAN AMERICAN CHAMBER OF COMMERCE is not inherently distinctive for chamber of commerce services directed to the Chaldean-American community. CHAMBER OF COMMERCE is a generic designation (and is properly disclaimed in Respondent's Supplemental Registration) for entities engaged in chamber of commerce services.⁵ See *In re Chamber of Commerce of the United States*, 675 F.3d 1297, 102 USPQ2d 1217, 1220 (Fed. Cir. 2012). CHALDEAN AMERICAN is merely descriptive of at least a portion of the target recipients or consumers of Petitioner's services.⁶ However, as discussed below, we find that Petitioner has proven by a preponderance of the evidence that it had established prior proprietary rights by acquired distinctiveness in the mark CHALDEAN AMERICAN CHAMBER OF COMMERCE long before 2013.

Petitioner's president, Mr. Manna, testifies that Petitioner is an organization formed to support causes of the Chaldean community and "educate the general public about the contributions Chaldeans are making; two, the organization also wants to be a network for others to understand who the Chaldean community is and give them the ability to do business together and also to help dispel the negative

⁵ "Chamber of commerce" is defined as "an association, primarily of people in business, to promote the commercial interest of an area," RANDOM HOUSE DICTIONARY (2017) (retrieved from dictionary.com), and as "an association of businesspeople to promote commercial and industrial interests in the community," MERRIAM-WEBSTER DICTIONARY (2017) (retrieved from www.merriam-webster.com). The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imp. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

⁶ According to Petitioner's witness, Chaldeans "by definition are eastern right Catholic, they speak Aramaic, the language of Christ, and have a history that spans some 5500 years. The Chaldeans are indigenous to Iraq, Syria, parts of Turkey and Iran. ..." Manna Test., 44 TTABVUE 11.

stereotypes that existed about Chaldeans, both here and abroad, and the organization also wants to act as an ambassador for the Chaldean, Assyrian, Syriac people throughout the world.” Manna Test., 44 TTABVUE 8. Petitioner has been operating continuously under the name CHALDEAN AMERICAN CHAMBER OF COMMERCE since 2001. Manna Test., 44 TTABVUE 8. Petitioner is an umbrella organization which includes affiliates and partner organizations including the Chaldean Chamber of Political Action Committee, Detroit Independent Grocers, the Chaldean Community Foundation, Chaldean, Syrian, Assyrian Council of America, and the Ninevah Council of America. Manna Test., 44 TTABVUE 8-9. Petitioner asserts acquired distinctiveness as to CHALDEAN AMERICAN CHAMBER OF COMMERCE in connection with its services based on its broad and continuous use of its mark in providing its services for approximately fifteen years at the time of the deposition. Manna Test., 44 TTABVUE 9. Petitioner uses the mark on envelopes, letterhead, handouts, brochures, folders, invoices, programs, newsletters and online. Manna Test., 44 TTABVUE 13, 40, 49. *See, e.g.*, Manna Test., Exhs. 91 (letterhead), 102 (brochure), 104 (membership application), 107 (invoice), 134 (letterhead) and 136 (program), 25 TTABVUE 4, 186, 192, 196, 238, 256; Exhs. 157 (annual awards dinner program book), and 158 (quarterly newsletter), 27 TTABVUE. Petitioner conducts annual mailings in which the mark is displayed on a local, national and international level. Manna Test., 44 TTABVUE 14. Petitioner has many professional and business owner members in a variety of fields (groceries, convenience and liquor stores, mobile phone and restaurant franchises). Manna

Test., 44 TTABVUE 13, 14. Petitioner hosts events and forums such as “an annual dinner, an annual business conference, an annual golf outing and also a cultural night to support many of the programs and initiatives that we’re involved with” and the events include hosting various county executives, U.S. senators, and delegates from the Turkish and Iraqi communities. Manna Test., 44 TTABVUE 17. Petitioner also has corporate members such as Dominos, Comerica Bank, Ford Motor Company, Dean Foods, PNC bank, Citizens bank, DTE Energy, and Consumers Energy. Manna Test., 44 TTABVUE 13, 14. In addition, Petitioner’s mark has had high profile exposure through Petitioner’s work with leaders from various countries (Iraq, Turkey, Lebanon, and the United States). Manna Test., 44 TTABVUE 9. Petitioner has worked with several United States government agencies for many years under the mark CHALDEAN AMERICAN CHAMBER OF COMMERCE, including the CIA, FBI, USAID, U.S. Army, and Department of Homeland Security. Manna Test., 44 TTABVUE 10, 16-18. Petitioner has been active in efforts to rebuild Iraq. Manna Test., 44 TTABVUE 18. In addition, Petitioner has worked with several state governments including Michigan, California, Illinois and North Carolina. Manna Test., 44 TTABVUE 10-11. Petitioner has also been involved in activities in San Diego, Respondent’s purported area of business, and “San Diego is probably the second largest concentration of Chaldeans in the United States and we were asked on many occasions, one in particular at – Wells Fargo Bank requested assistance in getting our community more involved and engaged in that part of the country. I mentioned earlier the CIA requested assistance in trying to identify

community leaders in San Diego in [sic] which they could work with. We have ongoing discussions with our religious and community leaders in that area.” Manna Test., 44 TTABVUE 17.⁷

Petitioner also receives media exposure in newspapers and on television. Manna Test., 44 TTABVUE 18. *See, e.g., The Washington Post* (February 16, 2004) (“The vast majority of the liquor store owners are Chaldeans, or Iraqi Christians, who fled their home country more than three decades ago because of persecution ... ‘These are honest people who feel as if they are getting harassed,’ said Martin Manna, executive director of the Chaldean-American Chamber of Commerce.”) 25 TTABVUE 118; *U – T San Diego* (December 30, 2005) (“Martin Manna, executive director of the Chaldean-American Chamber of Commerce in Michigan, the group of Iraqi-Americans that organized the conference at which Natsios unveiled the Iraq Partnership, says many of his members initially reacted coolly because they were more interested in getting government contracts than in giving money to a charitable program.”) 25 TTABVUE 141; *Wall Street Journal* (January 10, 2014) (“Martin Manna, a Chaldean-American and president of the Chaldean-American Chamber of Commerce in Detroit, are [sic] pushing for the creation of a protected

⁷ Mr. Manna further testifies that “In Southern California we talk about the Chaldean business community there and also have visited San Diego a few different times to explore the possibility of opening a chapter, and we did so in 2009. Q. And has there been continuous connections with San Diego even in 2013? A. Yeah, and even before that. As I mentioned earlier, the CIA requested assistance in California, Wells Fargo Bank requested assistance, other national corporations requested our assistance. I was asked to speak and attend the ADF annual Assyrian convention in San Diego as a special guest in 2013 in which I gave a – some- I did speak about the community in general and what needed to happen back in Iraq. Q. But you were speaking, were you not, as a representative of the Chaldean American Chamber of Commerce? A. Yes.” Manna Test., 44 TTABVUE 20.

region for religious and ethnic minorities that would also have a form of self-governance within Iraq.”) 25 TTABVUE 139; and *Oakland Business Review* (September 13, 2017) (“This area of Oakland County [Michigan] has one of the largest Chaldean populations outside of the Middle East,” said Martin Manna, executive director of the Chaldean-American Chamber of Commerce.”) 25 TTABVUE 50.

Finally, in his brief Respondent concedes that “It is not in dispute that first use of Plaintiff’s use of the disputed mark in commerce was before Defendant.” Resp. Brief, 46 TTABVUE 4.

With Petitioner’s standing and priority established, we turn to the issue of likelihood of confusion under Section 2(d). Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003) (listing thirteen factors). Two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Relatedness of the Services,
Channels of Trade, Classes of Consumers

We begin with the services, channels of trade and classes of consumers. We must make our determinations under these factors based on the services and channels of trade established by Petitioner through common law use and as they are recited in

Respondent's registration. *See Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed."); *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Respondent's services are "Chamber of commerce services, namely, promoting business and tourism in the san diego and east county area." Petitioner's services are also chamber of commerce services, including the promotion of business opportunities for its members and the Chaldean community generally on a local, national and international level. Petitioner's services also extend to non-members nationwide, including serving as a conduit to connect members to the United States government for, *inter alia*, government contracting opportunities.

Turning to the classes of consumers and trade channels, when recitations of services have no restrictions as to nature, type, channels of trade, or classes of consumers, we must presume that the services travel through all usual channels of trade and are offered to all normal potential consumers. *Paula Payne Prods. Co. v. Johnson Publ'g Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014). Respondent's identification is not limited to any specific trade channel and, therefore, we must consider all the usual trade channels for such

services. The identification specifies that Respondent's services promote business and tourism in the San Diego and east county area, but this simply restricts the subject matter of the services or, more specifically, the area that is being promoted, but it does not restrict use of the mark to a specific area. This identification encompasses use of the mark nationwide to promote the San Diego and east county area.⁸ The record shows that both parties operate in the field of chamber of commerce services and the trade channels for such services include local and national business communities. The consumers of both parties' services include businesses and professionals seeking to network with other businesses. Petitioner has shown nationwide use in promotion and provision of its services, including in California (San Francisco and San Diego). *Manna Test.*, 44 TTABVUE 17.

In view of the above, the *du Pont* factors of the similarity of the services, the channels of trade, and classes of consumers favor a finding of likelihood of confusion.

Similarity/Dissimilarity of the Marks

We turn to the *du Pont* factor of the similarities and dissimilarities between Respondent's mark in standard characters SAN DIEGO EAST COUNTY CHALDEAN AMERICAN CHAMBER OF COMMERCE and Petitioner's mark CHALDEAN AMERICAN CHAMBER OF COMMERCE. We analyze "the marks in their entireties as to appearance, sound, connotation and commercial impression."

⁸ As discussed below, a geographic use restriction may only be incorporated into a registration through a concurrent use proceeding, which is not available for registrations on the Supplemental Register.

In re Viterra Inc., 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *du Pont*, 177 USPQ at 567). See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005).

The marks are similar in appearance and sound in that they include the identical wording CHALDEAN AMERICAN CHAMBER OF COMMERCE. Indeed, Respondent's mark incorporates the whole of Petitioner's mark.

As to the element of appearance, because the mark in the registration is in standard characters, we must consider all depictions of the mark, regardless of the font style, size, or color. See *In re Viterra Inc.*, 101 USPQ2d at 1910; *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1353, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011). Petitioner has shown that, as used in commerce, Respondent arranges the wording so that CHALDEAN AMERICAN CHAMBER OF COMMERCE is larger and more pronounced than the wording SAN DIEGO EAST COUNTY as shown below:

**SAN DIEGO EAST COUNTY
CHALDEAN AMERICAN CHAMBER OF COMMERCE**



Manna Test., 44 TTABVUE 27; Exh. 9, 24 TTABVUE 52 (excerpt from Respondent's website.)

The marks also share the same meaning inasmuch as each describes a chamber of commerce directed at Chaldean Americans. The addition of SAN DIEGO EAST COUNTY in Respondent's mark does not provide enough to distinguish the marks and in fact gives the impression of one of Petitioner's chapters. Mr. Manna testifies as follows:

Q. But what about if there's, you know, like, well, you know, a San Diego or East San Diego, does that really matter?

A. Well sure it does. I think if you look historically in the context of other groups similar, or they may be ethnic in

nature. I give you one example, ... This Hispanic Chamber of Commerce like the National Women's Business Association wants to – creates chapters throughout the country, so there's one representing body that is affiliated with the core organizer, the host organization, the one that founded the name and has been continuously using that name for several years.

Q. And the San Diego people never did such a thing. They never approached you about –

A. They did not approach us. As a matter of fact, when we brought up the issue, not only did they not approach us, they caused a ton of confusion because although it might be San Diego East County, the San Diego East County portion of their name really was never visible ...

Manna Test., 44 TTABVUE 10.

We find the marks to be similar in appearance, sound, meaning and overall commercial impression. This factor weighs in Petitioner's favor.

Intent/Bad Faith

In its argument and testimony about the factor of actual confusion, Petitioner also points to various actions on the part of Respondent as evidence of Respondent's intent to confuse. For example, Mr. Manna testifies as follows:

[W]hen they initially launched, the reason we were so concerned immediately is most of their materials on their website was material that was just plagiarized from our website. The photos that they used for their events were actually the photos from our events and there's many other instances in which they were using our material.

Manna Test., 44 TTABVUE 10.

Well, since the beginning of what we – what we learned to believe this new organization taking shape, it is clear that their intent was always to cause confusion and to really trade upon the establishment, the credibility that we have created.

Manna Test., 44 TTABVUE 20.

The organization, the San Diego East County Chaldean American Chamber of Commerce in its launch and through its website used our – used photos of our events, they plagiarized language from our website, so they clearly knew that we existed and frankly tried to plagiarize everything and anything we have accomplished or done.

Manna Test., 44 TTABVUE 25.

Typically the San Diego East County organization has habitually used the name “Chaldean American Chamber of Commerce.” It’s purposeful. It’s meant to confuse people into thinking that the San Diego entity is the same organization as the Chaldean American Chamber of Commerce.

Q. Let’s clarify that. The full name of the Respondent’s organization includes “East San Diego Count,” correct?

A. Correct.

Q. But that is not how they frequently present themselves.

A. No. Well, let’s start by talking about the actual confusion. On their website, and I believe some of this may have changed more recently because of the pending issue in front of the appeals board, but photos of our organization and our events were on their website. The language that we used on our website was plagiarized and used on their website. If you look at the events they’ve hosted, they have no signage or did not have signage in the past that said East County San Diego. Their podium had a, all their signage, their podium, signage, always include[d] only “Chaldean American Chamber of Commerce.” The president of the organization used an Email that says “President” at Chaldean American Chamber and there’s many other examples that has caused actual confusion. ...

Q. I will show you what has been marked as Chaldean American Chamber of Commerce Exhibit Number 5 and ask you whether you’ve ever seen this document.

A. Yes, I have.

Q. And what is it?

A. It's a photo of Ben Kalasho and others standing behind a podium with the signage that says "Chaldean American Chamber of Commerce."

Q. First of all, did your organization, the Chaldean American Chamber of Commerce, approve or condone or allow this signage?

A. We did not allow it nor did we approve it. ... this photo will likely cause confusion for a number of reasons, one of which is the name "Chaldean American Chamber of Commerce" is prominently in the photo and there's no mention of San Diego or East County. Then otherwise they use the same colors, and almost the same, a logo that seems similar to ours; so our organization, again since its inception, which has been unique and exclusive since 2001, has always used a logo that is black and gold and the name "Chaldean American Chamber of Commerce." So this photo is one of many that causes confusion.

Q. And what is the color of that organization's colors?

A. Black and gold.

Q. Same as yours.

A. Yes.

Q. I will give you what is marked as Exhibit Number 6 on behalf of your organization. Have you seen that picture before?

A. I believe I have.

Q. And what is that picture?

A. It's a photo of Ben Kalasho and I'm assuming one of his members receiving an acknowledgment or a plaque from the Chaldean American Chamber of Commerce, which is on the plaque and also in front of a podium which again says "Chaldean American Chamber of Commerce," no mention of anything else. ...

Q. Does this Exhibit 7, this is from – associated with Respondent, correct?

A. Correct.

Q. Who is shown as the president of the Chaldean American Chamber of Commerce?

A. I remember this specifically because of the confusion it caused. This is an editorial in East County Magazine in which Mr. Ben Kalasho is stated as saying as “President” of the Chaldean American Chamber of Commerce, and then it is signed Ben Kalasho, Founder and President Chaldean American Chamber of Commerce. No reference to any other things.

Manna Test., 44 TTABVUE 26-27.

While these allegations stand unrebutted, there is no documentary evidence of Respondent’s use of Petitioner’s photos of events, or plagiarized language from Petitioner’s website. The record does include examples of Respondent’s use clearly showing Petitioner’s mark, *i.e.*, no use of the additional wording “SAN DIEGO EAST COUNTY.” A few examples are set forth below:⁹



⁹ Manna Test. Exhs. 5 (photograph at Respondent’s event), 6 (photograph at Respondent’s event), 7 (excerpt from Respondent’s editorial published in the East County Magazine), 24 TTABVUE 37-39.



My dear humanitarian friends, I felt compelled to write to you today as urgent as the need to breath or drink water. Seize the moment, the world is watching. I am fully convinced that the reason I am writing this humble release whereby I am calling for unity between Assyrians, Chaldeans & Syriacs is solely the by product Church Division which has trickled down through generations. I shouldn't need to call for unity, it should have already existed. I shouldn't need to coach anyone on the importance of our common history, it need not be said. It is merely fact, chiefly in this precious moment of literal life and death. I urge you not to look for leadership in these matters by means of clergy but by pragmatic reasoning and genuine care of human kind.

Sincerely,

Ben Kalasho,

Founder & President

Chaldean American Chamber of Commerce

Office 619-663-7710

However, because CHALDEAN AMERICAN CHAMBER OF COMMERCE is highly descriptive, it could be inferred that Respondent believed he was free to use it. In addition, Petitioner also submitted Respondent's response to Interrogatory No. 9 in which Respondent asserts that he was "unaware of the mark 'Chaldean

American Chamber of Commerce’ since [Petitioner] filed after [Respondent].”
Manna Test. Exh. 8, 24 TTABVUE 47.

The Board has recognized that we may consider bad faith in the likelihood-of-confusion analysis under the thirteenth *du Pont* factor. *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1890 (TTAB 2008). However, in view of the high evidentiary bar to establish bad faith intent we cannot conclude on this record that Respondent adopted his mark in bad faith.¹⁰

Actual Confusion

Petitioner asserts that there has been actual confusion. In support of this argument, Mr. Manna testifies, *inter alia*:

Q. Would that proactivity be harmed if there was a confusion with the name of the Chaldean American Chamber of Commerce with some other organization that uses that name?

A. Yes, it already has been. There’s been confusion created and it has already been created.

Q. Let’s just talk about that then briefly. Give us some examples, if you would, of some of the harm caused by the confusion because of the Respondent organization in San Diego.

A. Well, since the beginning of what we – what we learned to believe this new organization taking shape, it is clear that their intent was always to cause confusion and to really trade upon the establishment, the credibility that we have created. There was two different organizations in California which both used the name ‘Chaldean American Chamber of Commerce,’ and thankfully one realized that

¹⁰ We note, for example that Mr. Manna’s testimony regarding third parties informing him that they purportedly received emails sent by Respondent is hearsay. Moreover, such information without more could not conclusively establish bad faith intent to adopt the mark.

there is – their future was not going to be bright if they continued to use our name, so they changed their name. But Ben Kalasho on the other hand and the San Diego East County Chaldean Chamber of Commerce have done many things. A, there's been this ongoing battle in the general media there in San Diego in which the Chaldean American Chamber of Commerce name has been tarnished and because of the ongoing infighting and the reputation of Mr. Kalasho. B, Mr. Kalasho has attacked the Chaldean Catholic church and, as you know, Chaldeans, it's all about faith and family, and there was many people who assumed that the attacks were coming from the Chaldean American Chamber of Commerce, and so there was backlash against our own organization because of the perception that it was our organization that was attacking our own church. And if you don't know, you know, the organization will not survive without the support of our church. It is – they are our spiritual leaders and we work hand in hand with the Chaldean Catholic church. There was also incidences in which members of Congress or their staff and the Kurdistan regional government were confused because they were getting Emails from someone stating 'President' Chaldean American Chamber of Commerce in which they assumed it was me, or were inquiring who are these organizations, are they affiliated because they're requesting assistance and we assumed we already are working with your community and have a plan to assist them both here and abroad.

Manna Test., 44 TTABVUE 20-21.

Mr. Manna testifies more specifically that he has received telephone calls where third parties have been confused as to Respondent's connection to Petitioner:

The Kurdistan regional government, Mr. Dasko Shirwani, telephoned us confused and assumed that Mr. Ben Kalasho was an affiliate or a partner of ours because of the name "Chaldean American Chamber of Commerce." More recently the organization in Washington, D.C., In Defense of Christians, called and inquired if this is the same organization because Mr. Kalasho requested to be on a panel and speak at the conference on behalf of the Chaldean American Chamber of Commerce. Other

instances include previous members of Congress in which Mr. Kalasho and his organization, the San Diego entity, made reference to the Chaldean American Chamber of Commerce, so they're inquiring whether or not this is the same organization because he is causing confusion.

Q. Who has called? ...

A. Sure, so Dasko Shirwani I mentioned, who is in charge of outreach for the Kurdistan regional government; also Christina Olney, who handles legislative affairs for the In Defense of Christians organization, and Elyse Anderson who worked for former Congressman - ... Frank Wolf. We've also had inquiries from our parliament members, either the Iraqi Christian Parliament members and Iraqi Christian political organizations about who the organization is and why they're utilizing the same name.

Q. Well, they were thinking the Respondent's organization was yours?

A. Yes.

Q. Or connected.

A. So again, it provided them instant credibility because they assumed it was an affiliate or part of the Chaldean American Chamber of Commerce.

Manna Test. 44 TTABVUE 28-29.

“A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion.” *National Rural Electric Cooperative Ass'n v. Suzlon Wind Energy Corp.*, 78 USPQ2d 1881, 1887 (TTAB 2006) (quoting *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1200 (Fed. Cir. 2003)).

These instances are not highly probative on the issue of actual confusion between Petitioner's and Respondent's marks, inasmuch as the instances involve Respondent's use of Petitioner's mark and not the applied-for mark, *i.e.*, with the

additional wording SAN DIEGO EAST COUNTY. In view thereof, we find the factor of actual confusion to be neutral.

Respondent's Arguments

Respondent's primary argument against a finding of likelihood of confusion centers on his assertion that the parties use their respective marks in geographically distinct areas. *See* Resp. Brief, 46 TTABVUE 3 ("Defendant is at the very least entitled to continued use because of geographic distance..."). However, as Respondent acknowledges in the same sentence geographic restrictions "can only be considered and determined by the Board in the context of a concurrent use registration proceeding" *Id.* *See Stock Pot Restaurant, Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 222 USPQ 665, 669 (Fed. Cir. 1984) (attempt to interject possibility of concurrent use proceeding in connection with cancellation proceeding is unavailing.); *Rosso and Matracco, Inc. v. Giant Food, Inc.*, 720 F.2d 1263, 219 USPQ 1050, 1053 (Fed. Cir. 1983). This is a cancellation proceeding, not a concurrent use proceeding and Respondent's registration may not be the subject of a concurrent use proceeding inasmuch as it is on the Supplemental Register. Trademark Rule 2.99(g), 37 C.F.R. § 2.99, provides that "Registrations and applications to register on the Supplemental Register ... are not subject to concurrent use registration proceedings." We further observe the record shows nationwide use of Petitioner's mark, even in the San Diego region.

Respondent also argues that there is no confusion due to the descriptive nature of Petitioner's "trade marked name." Resp. Brief, 46 TTABVUE 11. However, as

discussed above, Petitioner has established acquired distinctiveness in its mark. To the extent Respondent is arguing that Petitioner's mark is conceptually weak, it is well established that even weak marks are entitled to protection, in particular when the marks are so similar and the services are closely related.¹¹ See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401 182 USPQ 108, 109 (C.C.P.A. 1974).

Balancing the Factors

We have considered all of the evidence pertaining to the relevant *du Pont* factors, as well as the parties' arguments with respect thereto (including any evidence and arguments not specifically discussed in this opinion). Although the common phrase in the marks is conceptually weak, in balancing the relevant factors, we conclude that because the services are related, the trade channels and customers overlap, and Respondent's mark SAN DIEGO EAST COUNTY CHALDEAN AMERICAN CHAMBER OF COMMERCE in its entirety is highly similar to Petitioner's mark CHALDEAN AMERICAN CHAMBER OF COMMERCE in its entirety, confusion is likely.

¹¹ We further note that Respondent's argument that he "does not need to demonstrate that [his] mark has acquired secondary meaning because the mark is entitled to protection" is misplaced. Resp. Brief, 46 TTABVUE 5. As noted above, because Respondent's mark is on the Supplemental Register, the registration is not accorded Section 7(b) presumptions and Respondent must prove acquired distinctiveness in order to withstand a challenge by the owner of a distinctive mark. In fact, registration on the Supplemental Register is an implied admission that the registered term was merely descriptive at least at the time of Respondent's first use of the term. *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d at 1134 n.11. See also *In re Eddie Z's Blinds and Drapery, Inc.*, 74 UPSQ2d 1037, (TTAB 2005) ("[A]pplicant has, by its amendment, conceded that its proposed mark is merely descriptive ...").

AFFIRMATIVE DEFENSES

Respondent's affirmative equitable defenses were never properly pleaded, supported or argued. In view thereof, these defenses fail. *See Nahshin v. Product Source Int'l LLC*, 107 USPQ2d 1257, 1264 n.13 (TTAB 2013) ("We note that respondent, in stating that it has asserted its various affirmative defenses, made the statement in its brief, 'Respondent pursues these defenses and does not waive these defenses.' It is not sufficient to simply make this statement. Respondent was under a burden to take some affirmative action if it actually wished to pursue them. To the extent that they have not been waived, we find that respondent has failed to prove them."), *aff'd*, 112 F. Supp. 2d 383 (E.D. Va. 2015). *See also Research in Motion Ltd. v. Defining Presence Mktg. Grp., Inc.*, 102 USPQ2d 1187, 1189-90 (TTAB 2012) (affirmative defenses not pursued at trial considered waived and given no further consideration).

CONCLUSION

We find that a likelihood of confusion exists between Respondent's designation SAN DIEGO EAST COUNTY CHALDEAN AMERICAN CHAMBER OF COMMERCE for "Chamber of commerce services, namely, promoting business and tourism in the san diego and east county area" and Petitioner's mark CHALDEAN AMERICAN CHAMBER OF COMMERCE for various chamber of commerce services. We have considered all of Respondent's arguments to the contrary, including any arguments not specifically discussed in this opinion, but we are not persuaded thereby.

Decision: The petition to cancel Respondent's Registration No. 4516721 is granted. Respondent's registration will be cancelled in due course.