

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Mailed: May 29, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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*Retrobrands USA LLC*  
v.  
*Intercontinental Great Brands LLC*  
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Cancellation No. 92066647  
—

Adam S. Goldman and Alexander D. Brown of The Concept Law Group PA  
for Retrobrands USA LLC

Barbara A. Solomon and Jason D. Jones of Fross Zelnick Lehrman & Zissu PC  
for Intercontinental Great Brands LLC  
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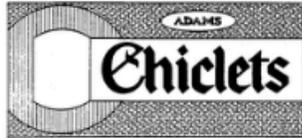
Before Kuhlke, Ritchie and Hudis,  
Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Intercontinental Great Brands LLC (Respondent) owns the Registrations for the following marks on the Principal Register shown below:<sup>1</sup>

 for chewing-gum in International Class 30,  
Registration No. 48005 issued on December 5, 1905,  
renewed;

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<sup>1</sup> Throughout the decision we refer to the registered marks collectively as “CHICLETS.”



(described as “a stylized “C” out of the mouth of which extends a white rectangle above and below which are yellow rectangles” the “drawing is lined for the colors yellow and red and a claim to color is made”) for “chewing gum” in International Class 30, Registration No. 1440100 issued on May 19, 1987, renewed;

CHICLETS TINY SIZE (typed drawing<sup>2</sup>; TINY SIZE disclaimed) for “confectionary products; namely, chewing gum” in International Class 30, Registration No. 1821567 issued on February 15, 1994, renewed;



(TINY SIZE disclaimed) for “confectionery products; namely, chewing gum” in International 30, Registration No. 1824532, issued on March 1, 1994, renewed; and

CHICLETS (typed drawing) for “confectionery products, namely chewing gum” in International 30, Registration No. 2862796, issued on July 13, 2004, renewed.

Retrobrands USA LLC (Petitioner) petitioned to cancel these registrations on the ground of abandonment through discontinuation of “use of the marks for a period of three years or more in the United States of America with no intent to resume use.” 1 TTABVUE 5.<sup>3</sup> Petitioner alleges it filed an intent-to-use application, Application

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<sup>2</sup> Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012); Trademark Manual of Examining Procedure (TMEP) § 807.03(i) (October 2018).

<sup>3</sup> Citations to the briefs and record are to the Board’s electronic docketing system TTABVUE where the publicly viewable trial record and briefs can be found. The first number is the docket entry and the second, if applicable, is the page within the entry.

Serial No. 87512869 for the mark CHICLETS for “chewing gum” which was refused registration based on these registrations. 1 TTABVUE 4. By its answer, Respondent denies the salient allegations of the Petition for Cancellation. 5 TTABVUE 4.

## I. The Record

The record includes the pleadings and, pursuant to Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the files of the registrations subject to the petition for cancellation. In addition, the parties submitted the following:

1. Petitioner’s submissions<sup>4</sup>
  - Notice of Reliance on the November 9, 2018 discovery deposition, with exhibits, of Katherine Williams, Vice President Marketing Transformation & Excellence, North America for Mondelēz International, Inc., Respondent’s parent company (“Williams Disc. Dep.”);<sup>5</sup>
  - Affidavit Testimony and exhibits of Jeffrey Kaplan, sole owner and president of Petitioner (“Kaplan Aff.”), and oral cross examination (“Kaplan Cross Dep.”);<sup>6</sup>
  - Affidavit Rebuttal Testimony and exhibits of Jeffery Kaplan (“Kaplan Rebuttal Aff.”).<sup>7</sup>

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<sup>4</sup> Petitioner’s uncontested request to remove the November 9, 2018 deposition of Katherine Williams (entries 41 TTABVUE (confidential) and 42 (public)) is granted to the extent they are not considered part of the trial record.

<sup>5</sup> 24 TTABVUE (confidential); 25 TTABVUE (public).

<sup>6</sup> 23 TTABVUE; 28 TTABVUE. Although Respondent introduced the cross-examination testimony deposition of Jeffrey Kaplan, we list it here so that it follows Jeffrey Kaplan’s testimony affidavit in the traditional presentation of direct testimony followed by cross-examination.

<sup>7</sup> 36 TTABVUE.

2. Respondent's Submissions

- Declaration Testimony and exhibits of Katherine Williams ("Williams Decl."), and oral cross examination ("Williams Cross Dep.");<sup>8</sup>
- Notice of Reliance on Petitioner's responses to Request for Admission Nos. 5 and 7 and response to Interrogatory No. 1;<sup>9</sup> and
- Notice of Reliance on excerpts from a book titled **CHICLE THE CHEWING GUM OF THE AMERICAS, FROM THE ANCIENT MAYA TO WILLIAM WRIGLEY**.<sup>10</sup>

The parties have designated some submissions of testimony and evidence as confidential and filed under seal. We discuss only in general terms the relevant evidence submitted under seal, when necessary. However, to the extent any testimony and evidence is improperly designated as confidential or has been made public by the parties, the Board will disregard the confidential designation when appropriate. *See* Trademark Rule 2.116(g), 37 C.F.R. § 2.116(g). While we address certain objections below, generally we have given the testimony and accompanying evidence their due weight, keeping in mind any objections. *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1479 (TTAB 2017).

**II. Standing**

Standing is a threshold issue that must be proved by a plaintiff in every inter partes case. *Empresa Cubana del Tabaco v. General Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *see also, Bell's Brewery, Inc. v. Innovation*

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<sup>8</sup> 29 TTABVUE (confidential); 30 TTABVUE (public); 40 TTABVUE. Petitioner introduced the cross-examination testimony deposition of Katherine Williams.

<sup>9</sup> 31 TTABVUE.

<sup>10</sup> 32 TTABVUE.

*Brewing*, 125 USPQ2d 1340, 1344 (TTAB 2017). There is a liberal threshold for determining standing. “A petitioner is authorized by statute to seek cancellation of a mark where it has both a real interest in the proceedings as well as a reasonable basis for its belief of damage.” *Empresa Cubana*, 111 USPQ2d at 1062 (quotations omitted). A “real interest” is a “direct and personal stake” in the outcome of the proceeding. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Petitioner’s owner, Jeffrey Kaplan, testifies that Petitioner is in the business of “acquiring and relaunching formerly famous, but abandoned brands that still have consumer recognition” and that it “currently owns and has successfully re-launched to the public many such brands ...” Kaplan Aff. ¶ 2, 23 TTABVUE 2. With regard to the CHICLETS brand he searched “the internet in an effort to determine who owned the CHICLETS trademark.” Kaplan Aff. ¶ 8, 23 TTABVUE 3. Mr. Kaplan further testifies that “on June 30<sup>th</sup>, 2017, [he] filed an application for the mark CHICLETS for chewing gum.” Kaplan Aff. ¶ 14, 23 TTABVUE 4. Petitioner did not enter into the record its application for CHICLETS and did not testify as to whether it was refused by the USPTO. Such evidence would have clearly proven Petitioner’s standing. *Lipton v. Ralston*, 213 USPQ at 189 (“Thus, to have standing in this case, it would be sufficient that [plaintiff] prove that it filed an application and that a rejection was made because of [defendant’s] registration”); *ShutEmDown Sports, Inc. v. Carl Dean Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012). However, Respondent submitted

Petitioner's responses to Respondent's Requests for Admission which include Petitioner's admission that it filed the application for CHICLETS. Notice of Reliance, 31 TTABVUE 6 ("Admit that at the time You filed the application, You were aware that the CHICLETS mark continued to be recognized by consumers in the U.S. in association with breath freshening confectionary.") In addition, Respondent's witness, Katherine Williams, testified that "The only way [Petitioner] can register the CHICLETS mark is to cancel our trademark registrations for the mark." Williams Decl. ¶ 52, 30 TTABVUE 16.

The parties do not dispute Petitioner's standing and we find the record sufficiently establishes that Petitioner has a real interest in this proceeding and, therefore, has standing.

### III. Abandonment

Under Section 45 of the Trademark Act, a mark shall be deemed to be abandoned:

When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

15 U.S.C. § 1127.

There are two elements to a nonuse abandonment claim: nonuse of the mark and intent not to resume use. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1131 (Fed. Cir. 2015), *cert. denied*, 136 S. Ct. 982 (2016); *Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 USPQ2d 1413, 1417 (TTAB 2016). Further, because

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a registration is presumed valid, 15 U.S.C. § 1057(b), the party seeking its cancellation bears the burden of rebutting this presumption by a preponderance of the evidence. *Cold War Museum v. Cold War Air Museum*, 586 F.3d 1352, 92 USPQ2d 1626, 1628 (Fed. Cir. 2009); *W. Fla. Seafood Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1665-66 (Fed. Cir. 1994).

If plaintiff can show three consecutive years of nonuse, it has established a prima facie showing of abandonment, creating a rebuttable presumption that the registrant has abandoned the mark without intent to resume use. The burden of production (i.e., going forward) then shifts to the respondent to produce evidence that it has either used the mark or that it has intended to resume use (e.g., a convincing demonstration of ‘excusable non-use’ that would negate any intent not to resume use of the mark). The burden of persuasion remains with the plaintiff to prove abandonment by a preponderance of the evidence.

*Noble House*, 118 USPQ2d at 1417 (citing *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390, 1393 (Fed. Cir. 1990)); *see also* 15 U.S.C. § 1127.

Abandonment is a question of fact. *See Stock Pot Rest., Inc. v. Stockpot, Inc.*, 737 F.2d 1576, 222 USPQ 665, 667 (Fed. Cir. 1984). Any inference of abandonment must be based on proven fact. *See Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1310 (Fed. Cir. 1989) (“The protection due the registrant is provided by requiring that the inference have an adequate foundation in proven fact. Whenever an inference is based on pure speculation and ‘there is no basis ... to infer nonuse,’ a prima facie case of abandonment must fail.”) (quoting *P.A.B. Produits et Appareils de Beaute v. Satinine Societa in Nome Collettivo di S.A. e. M. Usellini*, 570 F.2d 328, 196 USPQ 801, 804-05 (CCPA 1978)); *Stetson v. Howard D. Wolf & Assoc’s*, 955 F.2d 847, 21 USPQ2d 1783, 1785 (2d Cir. 1992) (A party

claiming that a mark has been abandoned must show “non-use of the mark by the legal owner and no intent by that person or entity to resume use.”).

Petitioner has not established that there were three years of nonuse. Thus, because Petitioner does not have the benefit of the presumption of abandonment, Petitioner retains the burden to prove **both** that Respondent discontinued use and that Respondent intended not to resume use. *Toufigh v. Persona Parfum, Inc.*, 95 USPQ2d 1872 (TTAB 2010). The burden to rebut abandonment does not shift to a defendant until a plaintiff has made a prima facie case of abandonment. *Id.* at 1875. If Petitioner does not establish both nonuse and intent not to resume use, it is not necessary for Respondent to submit rebuttal testimony or other evidence. *Id.* at 1876.

#### A. The Parties

As noted above in the standing section, Petitioner is in the business of acquiring and relaunching “formerly famous” abandoned brands. As it has done with other brands, Petitioner engaged in some research to see if CHICLETS branded gum was offered for sale in the United States.<sup>11</sup> Based on this research, Petitioner filed an

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<sup>11</sup> Petitioner’s research included the following: 1) a recollection that the Wikipedia page did not list the United States as an area where CHICLETS was being sold (Kaplan Aff. ¶ 7, 23 TTABVUE 3); 2) a 2019 Wikipedia.org excerpt that includes the following “As of 2016 the Chiclets gum brand has been discontinued. The website www.chiclets.com reroutes to the Mondelēz International website, but it is not listed on the ‘product family’ section of the site.” (Kaplan Rebuttal Aff. ¶ 8 Exh. A, 36 TTABVUE 4-5); 3) CHICLETS was not on the Mondelēz United States website and was only shown on the international web pages (Kaplan Aff. ¶¶ 9-10 Exhs. F-I, 23 TTABVUE 3, 53-59); 4) Mr. Kaplan did not find CHICLETS at local stores of major retailers such as Wal-Mart, Target, Publix, and CVS (Kaplan Aff. ¶ 11, 23 TTABVUE 3); 5) Kaplan only found Facebook and Twitter pages showing CHICLETS branded products for sale in countries other than the United States (Kaplan Aff. ¶ 12, 23 TTABVUE 3-4); 6) various candy wholesaler websites, including the OldTimeCandy.com website, represented that the CHICLETS product “is no longer made” (Kaplan Aff. ¶ 18-19 Exh. C-D, 23 TTABVUE 5, 16, 18); and 7) no party was selling authentic CHICLETS branded products intended for

intent-to-use application for the mark CHICLETS for chewing gum on June 30, 2017. Kaplan Aff. ¶ 14, 23 TTABVUE 4.

Respondent, along with Mondelēz North America and Mondelēz Exports, is part of the family of companies under Mondelēz International, Inc. Mondelēz International, Inc. (Mondelēz) is a multinational confectionery, food and beverage company that was formed when Kraft Food Groups split into two separate companies in 2011. Williams Decl. ¶ 3, 30 TTABVUE 3. Mondelēz International, Inc. is the successor to Kraft's global snack and food brands. Williams Decl. ¶ 3, 30 TTABVUE 3. Mondelēz International, Inc. manufactures and distributes those products by its various family members. Williams Decl. ¶ 9, 30 TTABVUE 4.

CHICLETS branded gum has been sold in the United States continuously by various predecessors-in-interest since around 1900. Williams Decl. ¶ 23, 30 TTABVUE 7. CHICLETS gum dates back to around 1900 when it was first introduced by the American Chicle Company. Williams Decl. ¶ 23, 30 TTABVUE 7. Over the years, the CHICLETS branded gum business has been acquired by various companies. Williams Decl. ¶ 26, 30 TTABVUE 8. "Mondelēz acquired the CHICLETS brand from Kraft in 2011 as part of the spinoff of Mondelēz from Kraft. Respondent is "wholly owned by, and is part of the corporate family owned by, Mondelēz International, Inc." Williams Decl. ¶ 1, 30 TTABVUE 2. "As the intellectual property holding company for Mondelēz, IGBL [Respondent] became the owner of the CHICLETS trademarks and registrations" (Williams Decl. ¶¶ 27-28, 30 TTABVUE

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the United States on ebay.com or amazon.com (Kaplan Aff. ¶ 20 Exh. E, 23 TTABVUE 5, 21-51).

8) and owns the trademarks for Mondelēz’s U.S. brands in the United States. Williams Decl. ¶¶ 21, 30 TTABVUE 7; *see also* assignments recorded in each registration. Respondent’s primary licensee is Mondelēz International Inc. 48 TTABVUE 11; Williams Decl. ¶ 22, 30 TTABVUE 7.<sup>12</sup> All use of Respondent’s trademarks is by its licensee within the family of companies under Mondelēz International, Inc. *Id.* Mondelēz North America is the division of Mondelēz International, Inc. responsible for selling products under “Mondelēz brands” within the United States. Williams Decl. ¶ 6, 30 TTABVUE 3.

More than one Mondelēz division may sell goods in the same territory. Specifically products may be sold in the United States by Mondelēz North America or Mondelēz Exports. A factor in determining which division will be responsible for a product is the size of the brand and the scope of where the brand is sold. Williams Decl. ¶ 10, 30 TTABVUE 4. The divisions make their separate business decisions about which brands to add and which to discontinue. A decision by Mondelēz North America to discontinue a product, does not reflect a decision to discontinue products across the

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<sup>12</sup> Although Respondent is the subsidiary of Mondelēz International Inc., in view of the licensing agreement this record does not raise a question of control. *Cf. Noble House*, 118 USPQ2d at 1413 (abandonment shown where use by registrant’s parent company did not inure to the benefit of subsidiary registrant where record showed parent company did not meet definition of related company i.e., an entity whose use of the mark is controlled by the registrant of the mark with respect to the nature and quality of the goods); *see also Great Seats Ltd. v. Great Seats, Inc.*, 84 USPQ2d 1235, 1242 (TTAB 2007). Further, Petitioner’s abandonment claim is based solely on nonuse with intent not to resume use. The issues of the relationships within Respondent’s corporate structure and the control over the use of the mark was not pleaded, tried or argued. *See Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1103 n.3 (TTAB 2007) (unpleaded allegations will not be heard); *see also Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (petitioner’s pleaded descriptiveness and geographical descriptiveness claims not argued in brief deemed waived), *aff’d*, 565 F. App’x 900 (Fed. Cir. 2014) (mem.)

entire Mondelēz family of companies. Williams Decl. ¶ 14, 30 TTABVUE 5. Other divisions often pick up products discontinued by Mondelēz North America. Williams Decl. ¶ 16, 30 TTABVUE 6.

As Ms. Williams testifies:

The brands offered by Mondelēz North America in the United States are always subject to change, with brands being added and discontinued on an annual basis. ... A decision by Mondelēz North America to discontinue a brand in the United States only means that Mondelēz North America will not distribute the brand in the United States in the immediate future. Mondelēz North America does not make any decisions for other Mondelēz divisions who distribute products in the United States. Therefore, even if Mondelēz North America decides to discontinue a brand, it does not mean that (i) the brand will not be made available in the United States by a Mondelēz division other than Mondelēz North America (such as the Mondelēz Exports division, discussed below) or (ii) that Mondelēz North America will not decide in the future to offer the brand again within the United States.

Williams Decl. ¶¶ 11, 14, 30 TTABVUE 5.

Ms. Williams explains that:

One of Mondelēz International's subsidiaries is the company called Mondelēz International Holdings, LLC which has a division called 'Mondelēz Exports.' Based in Coral Gables, Florida, Mondelēz Exports is responsible for importing Mondelēz products manufactured in other parts of the world and then selling these products in North America (including the United States), as well as parts of Central and South America. All products sold in the United States are packaged in compliance with U.S. packaging and labeling laws. It is not uncommon for Mondelēz Exports to pick up a brand that is no longer going to be distributed in the United States by Mondelēz North America and continue to distribute that brand in the United States. Mondelēz Exports typically picks up those brands that have a loyal customer base in the United States. ... On occasion, as a result of Mondelēz Exports'

activities in the United States, a brand may achieve sufficiently high sales levels that it can be reabsorbed by Mondelēz North America and its scope of distribution broadened.

Williams Decl. ¶¶ 15-18, 30 TTABVUE 6.

B. Respondent's Use

It is undisputed that Mondelēz North America, under license, sold CHICLETS branded gum in the United States in 2013, 2014, 2015 and 2016. It is also undisputed that in March 2016, Mondelēz North America decided to discontinue sales of CHICLETS in the United States. Williams Decl. ¶ 31, 29 TTABVUE. There is some dispute as to when sales actually ceased in 2016. Petitioner argues the beginning of nonuse is March 2016 when Mondelēz North America decided to discontinue the CHICLETS gum products. However, Respondent has sufficiently established that sales continued on through the end of 2016. Williams Decl. ¶ 31, 30 TTABVUE 9-10 (“CHICLETS products continued to be sold by Mondelēz North America in the United States through year-end 2016 and the products remained in our Confections product catalogue through year-end 2016.”); *see also* Williams Decl. ¶¶ 29-31, 30 TTABVUE 9; Exhs. DX 1-2,17-18, 29 TTABVUE (confidential); Williams Cross Dep., 40 TTABVUE 26.

As discussed in more detail below, during 2016, another division in the Mondelēz family “began considering whether to pick up and continue sales of CHICLETS in the United States once Mondelēz North America ceased its sales.” Williams Decl. ¶ 32, 30 TTABVUE 10. Mondelēz Exports first considered this in September, 2016. Thereafter, throughout 2017 Mondelēz Exports continued, at a minimum

intermittently, to assess selling CHICLETS in the United States. In the meantime, on August 9, 2017, Petitioner filed this petition for cancellation. By April 2018, Mondelēz Exports began to distribute CHICLETS gum in the United States “approximately 18 months after it first identified CHICLETS as a possible opportunity for Mondelēz Exports in September 2016.” Williams Decl. ¶ 37, 30 TTABVUE 11. Specifically “[o]n March 6, 2018, Mondelēz Exports entered into an agreement with a U.S. distributor, Stark Group International (“SGI”), in which it authorized SGI to import, represent, sell, distribute, merchandise and promote CHICLETS branded gum in the United States.” Williams Decl. ¶ 37, 30 TTABVUE 12. SGI has been purchasing and distributing CHICLETS branded gum in the United States. Williams Decl. ¶ 38, 30 TTABVUE 12. “CHICLETS gum is available for purchase in the United States primarily through independently-owned grocery stores.” Williams Decl. ¶ 39, 30 TTABVUE 12. While the sales figures were submitted under seal, suffice it to say they are not “token” sales as asserted by Petitioner.

### C. Petitioner’s Evidence and Argument to Establish Abandonment

As noted above, it has been established that there was a period of nonuse by Respondent from approximately January 2017 through April 2018 (even if we were to accept Petitioner’s position that the nonuse period began in March 2016, it is still under three years). The first element of Petitioner’s abandonment claim, therefore, is established. The remainder of our analysis focuses on the second element, that is, whether Respondent had an intent not to resume use of the CHICLETS mark.

Petitioner bases its assertion that Respondent did not have an intent to resume use on the following:

1. it was a dying brand based on, inter alia, the decision by Respondent's licensee Mondelēz North America to discontinue sales in 2016, the absence of the brand from the Mondelēz website in the United States and from its corporate annual reports, and it did not have brokers to market or sell CHICLETS;
2. the emails Petitioner received from Mondelēz customer service and printouts from third-party seller websites indicating the product was discontinued;
3. Respondent's single internal email from another Mondelēz division prior to Petitioner's filing date is not sufficient to establish intent to resume use; and
4. Respondent's evidence subsequent to Petitioner's application filing date is irrelevant.

In a nutshell, Petitioner argues that:

Mondelēz had been engaged in phasing out the brand for at least two years prior to March 2016 (46 TTABVUE 22-23), and admits it began discontinuing the CHICLETS brand even earlier in December 2015, and merely discontinued the last SKU in March 2016. [48 TTABVUE 17]. If Mondelēz did not have intent to permanently discontinue the brand by March 2016 – which decision is understandable due to IGBL's [Respondent's] admission that the product's popularity and sales were dropping precipitously – one is left to wonder why it engaged in such a lengthy and significant wind-down period. Indeed, to completely phase out and dismantle a multi-million-dollar brand with an over 100 year history over a two year period, and inter alia, inform an entire sales team and distribution network that the brand was being discontinued, liquidate outstanding inventory and cease all sales, and explicitly inform inquiring members of the public that CHICLETS had been “discontinued” and that there were “no plans” to bring the brand back, only to actually bring the brand back within 18 months, defies all reason and logic, and is entirely counterintuitive from a business perspective. This is especially true considering the ease with which a company can keep a brand in the mind of the public in today's social media age; yet, Mondelēz did nothing to inform the public that the brand was apparently being relaunched. All of the foregoing is demonstrative of the

reality that Mondelēz's intent was to permanently discontinue the CHICLETS brand. It does not appear coincidental that Mondelēz only expressed even a modicum of interest in potentially relaunching the brand after Retrobrands filed its ITU [application] on June 30, 2017.

Pet. Reply Brief, 50 TTABVUE 8-9.

In short, it is Petitioner's position that Respondent ceased use of the mark in 2016 with no intent to resume use and, thus, abandoned the mark prior to the filing date of Petitioner's application and Respondent's subsequent use in 2018 is "post abandonment" use. Therefore, despite the fact that Respondent and its predecessors in interest had been using the mark in the United States from the early 1900's through 2016 and Respondent has since been using the mark in the United States from April 2018, the registrations, one dating back to 1907, should be cancelled.

The fact that Petitioner filed an intent-to-use application for the mark CHICLETS in 2017, while it would confer priority if Respondent had abandoned the mark prior to that date, does not add to the weight of evidence to establish abandonment. Therefore, any activity by Respondent between the nonuse in 2016 and the subsequent use in 2018 is relevant to the question of whether Respondent has abandoned CHICLETS.<sup>13</sup> This includes not only the internal email within Mondelēz Exports dated before Petitioner's filing date, but also the emails after that date. The probative value of these emails is discussed below. We now address Petitioner's arguments based on its categorization of the evidence.

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<sup>13</sup> If abandonment were shown before the 2018 use, such use would be considered new use and an intervening intent to use application may have priority. However, here there is not a three-year nonuse period to establish a prima facie case and as discussed below Petitioner has not established abandonment prior to its June 30, 2017 filing date.

1. Dying Brand

Based on the evidence of record, Petitioner argues that CHICLETS was a declining brand for Mondelēz North America and “CHICLETS was not a brand Mondelēz had been focused on for several years ... and has generated the least amount of revenue of Mondelēz’s gum brands.” Pet. Brief, 46 TTABVUE 22. Also, during the relevant time period through 2017 Mondelēz:

... did not attend any trade shows or similar events in the United States for the purposes of marketing, promoting, and/or selling CHICLETS products in the United States ... did not hire or retain any advertising agency, public relations company, or corporate branding company to market, promote, and/or sell CHICLETS products in the United States ... did not identify the CHICLETS brand on its United States website ... nor did it market or sell CHICLETS products on any other website in the United States ... removed all mention of the CHICLETS brand from its corporate annual reports ... and ... did not hire or retain any brokers to market and/or sell CHICLETS products into the United States.

Petitioner Brief, 46 TTABVUE 22-23; *see also* Williams Disc. Dep. Exh. 3, 25 TTABVUE 264-265 (Responses admitting Requests for Admission Nos. 13, 17-18) (13. “Respondent has not hired or retained any advertising agency, public relations company, or corporate branding company to market, promote, and sell CHICLETS products into the United States of America during the years 2014, 2015, 2016 and 2017.” ... 17. “Respondent did not hire or retain any brokers to market and sell CHICLETS products into the United States of America during the years 2014, 2015, 2016 and 2017.” 18. “Respondent did not exhibit at any tradeshow, or similar event venues in the United States of America, for purposes of marketing, promoting, and

selling CHICLETS products into the United States of America during the years 2014, 2015, 2016 and 2017”).

Petitioner concludes that:

[I]t is not surprising that although Mondelēz Exports was aware of Mondelēz NA’s decision in early 2016 to discontinue sales of CHICLETS products in the United States..., at that time, no Mondelēz entity expressed any intent to re-launch the brand in the United States, nor were there any plans, agreements, or even discussions concerning whether Mondelēz Exports or any other entity would relaunch the product in the United States. ... In fact it is undisputed that at the time Mondelēz [North America] had discontinued the sale of all CHICLETS products in the United States by March 2016, Mondelēz [North America] did not know (nor could it have known) that CHICLETS products were ever going to be relaunched in the United States, whether via Mondelēz or otherwise. ... Thus, it is indisputable that as of March 2016 (at the latest) Mondelēz had discontinued all sale of the CHICLETS products and use of the CHICLETS marks in the United States with no intent to resume such use at that time.

Pet. Brief, 46 TTABVUE 23-24. Petitioner acknowledges that within six months in September 2016 Mondelēz Exports expressed a potential interest in the brand. *Id.*

The evidence showing a slowing and eventual discontinuation of CHICLETS branded gum by Mondelēz North America, even for economic reasons, does not by itself show abandonment. *Star-Kist Foods, Inc. v. P.J. Rhodes & Co.*, 769 F.2d 1393, 227 USPQ 44, 46 (9th Cir. 1985) (discontinuation of use due to unprofitable sales not abandonment); *see also* 3 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (“McCarthy”) § 17:16 (5th ed. March 2020 Update).

While this evidence establishes that one member of the licensed Mondelēz family of companies discontinued selling CHICLETS branded gum, it does not establish that

Respondent, as the owner and licensor of the marks, or the entire Mondelēz family of companies, intended not to resume use. In fact, the record shows that one member of the Mondelēz family resumed sales of CHICLETS in the United States by April, 2018.

2. Public Representation to Brokers and Retailers, and the General Public

Based on evidence in the record, Petitioner argues that “Mondelēz [North America] distributed its product lists to its sales organization, brokers and retailers, which lists specifically stated that the CHICLETS products had been discontinued, and which information was conveyed down to the retail store level, and ultimately to customers.” Pet. Brief, 46 TTABVUE 26.<sup>14</sup> In addition, Petitioner argues Mondelēz customer service made public representations in the form of two emails responding to Mr. Kaplan’s inquiries stating that CHICLETS had been “discontinued” and that there were “no plans to bring back this product.” Pet. Brief, 46 TTABVUE 27. In response to two separate inquiries from Mr. Kaplan through the Mondelēz website, Mr. Kaplan received the following customer service response emails:

The product form or variety you asked about is not one currently manufactured by our company. While I can’t guarantee this will be an item we’ll make in the future, our staff is constantly coming up with new food ideas. Kaplan Aff. ¶ 15 Exh. A, 23 TTABVUE 4, 12 (June 30, 2017 email from Mondelēz International Customer Service); and

The tough part comes when we have to share the news that the product you’re trying to find has been discontinued. If products are not popular with our consumers, and demand starts to drop, a decision is made to discontinue the item. Once this decision is made, we stop making the product and the remaining supply is shipped from our warehouse to the grocery stores. Unfortunately we do not have any

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<sup>14</sup> The evidence in support of this statement is from the confidential portion of the Williams Disc. Dep, Exs. 1 and 9, 24 TTABVUE. These facts are not in dispute.

information about which stores may still have our discontinued products in stock. I understand that knowing exactly when the product was discontinued is what you asked, however, that exact information is not available. At this time there are no plans to bring back this product, but we are always cooking up something new to help you live and eat better so you may discover a new favorite/favourite! Kaplan Aff. ¶ 16, 23 TTABVUE 4, Williams Disc. Dep. Exh. 29, 25 TTABVUE 295 (August 18, 2017 email from Mondelēz customer service).

As Respondent explains, Mr. Kaplan admitted he did not have a copy of the emails he sent inquiring about the availability of CHICLETS in the United States and the responses from Mondelēz customer service do not reference a brand. The only place CHICLETS appears on these printouts is Mr. Kaplan's hand written note. 48 TTABVUE 27-28; Kaplan Cross Dep., 28 TTABVUE 49. In addition, while on the face of the printouts the responses come from "Mondelēz" any response generated would have been by the Mondelēz North America customer service department and would have been limited to Mondelēz North America's activities. Williams Decl. ¶ 47, 30 TTABVUE 14; Williams Cross Dep., 40 TTABVUE 59.

These responses do reflect the undisputed fact that in 2017 Mondelēz North America had discontinued the products. However, they do not address whether Respondent or the Mondelēz family of companies would resume use of CHICLETS in the United States through another Mondelēz division. Moreover, the wording "While I can't guarantee this will be an item we'll make in the future" and "At this time there are no plans to bring back this product" does not unequivocally state that the mark will no longer be used. McCarthy, § 17:11. And, in fact, as discussed below, when

these emails were sent another entity within the family was already looking into selling CHICLETS in the United States.

Petitioner relies on *Hiland Potato Chip Co. v. Culbro Snack Foods, Inc.*, 720 F.2d 981, 222 USPQ 790 (8<sup>th</sup> Cir. 1983) where the Court stated: “[a] public announcement of intention to discontinue the sale of a product may be a circumstance from which an intent not to resume may be inferred.” *Id.* at 792. However, the catalogs indicating Mondelēz North America’s decision not to offer certain products is not sufficient under the circumstances of this case to prove an intent not to resume use. Here, Mondelēz North America is simply one member of the Mondelēz family that chose not to continue sales, but another one Mondelēz Exports resumed Respondent’s sales within two years of the discontinuance.

As summarized by Respondent:

The statements made by Mondelēz North America in its 2016 catalog and in the two customer service emails do not state at all (much less state unequivocally) that [Respondent] or [Mondelēz International, Inc.] intend to ‘eliminate’ the ‘CHICLETS brand name’ or re-brand the CHICLETS products under a new name. At most, these statements advise that Mondelēz North America – a single division of [Mondelēz International, Inc.] – is discontinuing its distribution of CHICLETS in the United States.

Resp. Brief, 48 TTABVUE 44. Even as to Mondelēz North America, the catalogs and emails are not “statement[s] expressly establishing [Mondelēz North America’s] intent not to resume use of the [CHICLETS] mark[s].” *See Double Coin Holdings Ltd. v. Tru Development*, 2019 USPQ2d 377409 \*14 (TTAB 2019).<sup>15</sup>

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<sup>15</sup> The other cases relied upon by Petitioner similarly have very different facts from the circumstances presented by this case. *Intrawest Financial Corp. v. Western National Bank of*

Petitioner relies on *Parfums Nautee Ltd. v. American International Industries*, 22 USPQ2d 1306 (TTAB 1992) and concludes that the “parallels between the material facts of *Parfums* and those sub judice are unmistakable.” Pet. Brief, 46 TTABVUE 32. Petitioner quotes the following from *Parfums*: “A party cannot defend against a claim of abandonment by relying on some residual goodwill generated through post-abandonment sales of the product by distributors or retailers.” *Parfums*, 22 USPQ2d at 1309. However, the facts in *Parfums* are distinguishable. There, the nonuse period had been for at least three years prior to an assignment and because the assignor had abandoned the mark the assignment was invalid. Thus, the purported use by the defendant assignee over two years after the assignment and two and one-half years after the filing of the petition for cancellation constituted a new and separate use. *Parfums*, 22 USPQ2d at 1310.

The facts in this case present a very different picture. In *Parfums*, a prima facie case of abandonment was already established. Here, the decision to discontinue by the Mondelēz North America in March 2016 on its own does not establish abandonment, therefore, the continuing sales of inventory and the 2018 sales are not “post abandonment” sales. In addition, in regard to Respondent’s sales through year-end 2016, the preceding sentence to the quote from *Parfums* is: “As to respondent’s contention that there somehow was residual goodwill in the registered mark by virtue

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*Denver*, 227 USPQ 27, 29 (D. Colo., 1985) (announcement of name change); *Blackwood v. Blackwood*, 03-CV-0691, 2005 WL 209685a7 \*2 (E.D. Tenn. Aug. 30, 2005) (Blackwood issued public announcement he was officially retiring the names “Blackwood Brothers” and “Blackwood Brothers Quartet”).

of the product's long shelf life and possible continued sales by retailers, this contention is wholly speculative and, in any event, unsupported.”

In this case, there is no speculation, Ms. Williams clearly testified on cross examination that:

Q. To your knowledge, did Mondelēz North America make any new sales after March 2016 of CHICLETS products in the United States?

A. Yes.

Q. Okay. What—where did they sell? What is the basis for that statement?

A. The basis is the selling data we have that shows through the end of 2016, the product was still available and selling in the United States.

Q. Okay, but – I understand that, but available and selling in the United States is different than Mondelēz North America selling the product, so what I'm trying to figure out is what evidence do you have to suggest that Mondelēz North America made new sales after March of 2016...?

A. Because the way that our process works is we make a discontinuance, and then we still have to work through inventory. ...

Q. ...Pursuant to your own testimony, the product was sold through the year-end 2016, correct? From Mondelēz North America, not residual sales or through product that had already been sold.

A. Yes, to my knowledge, yes.

Williams Cross Dep., 40 TTABVUE 27-29.

Petitioner argues that Mondelēz North America “did not know (nor could it have known) that CHICLETS products were ever going to be relaunched in the United States” by Mondelēz Exports. Resp. Brief, 48 TTABVUE 20 (quoting Pet. Brief, 45

TTABVUE 10).<sup>16</sup> This however misses the point. What one member of the company family knew or didn't know about another member's intent to take up the brand does not prove Respondent's intent to not resume use.

In addition, the evidence that Mondelēz North America chose to discontinue a brand in March of 2016 speaks only to that particular moment, as explained by Ms.

Williams on cross examination:

Q. That first sentence [in the Williams trial testimony declaration] reads, "A decision by Mondelēz North America to discontinue a brand in the United States only means that Mondelēz North America will not distribute the brand in the United States in the immediate future." What is the actual basis for that statement?

A. It means that typically when we make decisions to discontinue products or brands, we make those decisions based on various different factors, and they are solely the decisions of the Mondelēz North America division and the team. And that does not mean that we will never engage in selling that product again, it doesn't mean that other divisions within Mondelēz will not sell the product or brand, it is a decision specific to the decisions on those products and brands for that moment. And that -- ... is typical.

Q. Has Mondelēz, whether it's North America or International, any entity within Mondelēz, discontinued brands and then never brought them back?

A. Not that I'm aware of.

Q. You're not aware of any brands being permanently discontinued?

A. No. ...

A. Yeah, I think what you asked me was whether or not something had been discontinued and never, you know,

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<sup>16</sup> While this citation is to Petitioner's confidential brief, the redacted material is Respondent's information that it has made public in its public brief.

launched again, and based on my experience with the company, no, I have never – I’m not aware of a time where we’ve discontinued a brand and never launched it again.

Williams Cross Dep., 40 TTABVUE 9-11.

Petitioner summarizes that the evidence “depicts a clear portrayal of a rapidly declining CHICLETS brand, and an intentional decision by Mondelēz to discontinue the brand in the United States with no intent to resume use at the time of its discontinuance.” Pet. Brief, 46 TTABVUE 28. Intent is difficult to prove and, on balance, Petitioner’s position is based more on speculation than fact. *Cerverceria v. Cerverceria*, 13 USPQ2d at 1310. Based on this record, we find that Petitioner has not met its burden to establish that Respondent had no intent to resume use, and therefore Petitioner has not established abandonment. In view thereof, we may end the decision here. *Toufigh*, 95 USPQ2d at 1876. In other words, because Petitioner did not make a prima facie showing, Respondent need not come forward with any evidence because its registration is presumed valid. 15 U.S.C. § 1057(b); *Cold War Museum*, 92 USPQ2d 1628. However, while not necessary to our conclusion, we also make an alternative finding below that Respondent has shown an intent to resume use.

D. Evidence of Respondent’s Intent to Resume Use

As discussed below, while Mondelēz North America was still selling CHICLETS through 2016, Mondelēz Exports had already begun exploring selling CHICLETS branded gum in the United States. Even if we discount the 2016 sales after March, only six months later another potential member within the Mondelēz family showed

interest in the brand and by April 2018 at the latest had begun selling CHICLETS branded gum in the United States.

Petitioner argues:

... [Respondent's] narrative is a fiction, exposed by the lack of competent evidence to support it, as the record evidence is comprised solely of (1) a single email in September 2016, (2) a single email in July 2017, (3) a single email in November 2017, and (4) the sale of new CHICLETS products in mid-2018. That is all. Thus, there is no competent evidence to support the notion that Mondelēz engaged in continuous efforts to relaunch the brand, and [Respondent] cannot avoid a finding of abandonment merely by suggesting that because Mondelēz Exports actually relaunched the brand (albeit in 2018 after [Petitioner's] ITU), such means, ipso facto, that it engaged in continuous activities demonstrating that it did not have intent to abandon the CHICLETS Marks. Mondelēz's remedial efforts to relaunch the brand after abandoning it, and after [Petitioner] expressed a bona fide intent to use the CHICLETS Marks, are legally insufficient.

Pet. Reply Brief 50 TTABVue 6.

We first address Petitioner's objections to the admissibility of these three emails based on lack of authentication and hearsay.<sup>17</sup> As to authentication, Petitioner argues that because Ms. Williams did not send or receive the emails she is not capable of authenticating the emails under Fed. R. Evid. 901(b)(1) ("Testimony of a Witness with Knowledge. Testimony that an item is what it is claimed to be."). Petitioner relies on

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<sup>17</sup> Once a discovery deposition, or a part thereof, "has been made of record by one party it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence." Trademark Rule 2.120(k)(7), 37 C.F.R. § 2.120(k)(7). Here, Petitioner made these emails of record as exhibits to the Williams' discovery deposition, during its trial period. Therefore, by objecting to admissibility, Petitioner is objecting to evidence it entered into the record. In view thereof, these emails have been admitted into evidence and are a matter of record. However, in view of the challenges to these emails throughout the discovery deposition and maintained in the trial brief, we treat the objections as going to the probative value of the emails.

*United States v. Fluker*, 698 F.3d 988, 999 (7<sup>th</sup> Cir. 2012) and asserts that the court found “authentication of email was ‘impossible’ under Rule 901(b)(1) from a ‘witness with knowledge’ because the author of the email did not testify and no other evidence was offered that the emails were actually sent.” Pet. Brief, 46 TTABVUE 41.

There is more than one way to authenticate a document. While it is correct the court determined the emails could not be authenticated under Fed. R. Evid. 901(b)(1), the court went on to accept them under Fed. R. Evid. 901(b)(4) stating “the Government attempted to authenticate the emails using circumstantial evidence, which we think was sufficient.” *United States v. Fluker*, 698 F.3d at 999. Indeed, Respondent explains Ms. Williams is able to authentic these emails under Fed. R. Evid. 901(b)(4) (“Distinctive Characteristics and the Like. The appearance, contents, substance, internal patterns, or other distinctive characteristics of the item, taken together with all the circumstances.”).

In reply, Petitioner responds that even under Fed. R. Evid. 901(b)(4) because Ms. Williams was “unable to explain the irregularities with the email chains, which is a direct result of her lack of knowledge as to the document collection and production process ... and of Mondelēz Exports’ activities generally as it concerns CHICLETS. As such, she is entirely incapable of authenticating these emails, and conclusory statements from counsel that ‘no content was removed’ carry no weight.” Pet. Reply Brief, 50 TTABVUE 22. The “irregularities” asserted by Petitioner are “inexplicable gaps or white spaces [in the email printouts].” Pet. Brief, 46 TTABVUE 42. Further Petitioner asserts, “these inexplicable gaps strongly suggest the emails were

tampered with in some respect; and, because no individual with personal knowledge of these emails has submitted testimony, it is impossible to know how these blank spaces came to be. In reality, there is simply no scenario whereby these emails would have such significant alleged blank space on them without a user redacting or removing content. Ms. Williams' conclusory statement that the emails are 'true and correct copies' cannot rebut this reality, and is otherwise flatly insufficient to meet [Respondent's] burden of proving authenticity." *Id.*

Under Fed. R. Evid. 901, documents must be properly authenticated. The evidence of authentication must be sufficient "to support a finding that the item is what the proponent claims it is." Fed. R. Evid. 901(a). Authenticity may be established through circumstantial evidence. *United States v. Crosgrove*, 637 F.3d 646, 658 (6<sup>th</sup> Cir. 2011). The case relied upon by Respondent is instructive on this point. In *United States v. Bertram*, 259 F.Supp.3d 638 (E.D. Ky. 2017) the court stated:

[T]he weight of the case law suggests participation in a particular email is not a prerequisite to authenticating it. The case law on the whole suggests that the key consideration in email authentication is not simply whether the witness on the stand was a sender or recipient of the email, but whether the testifying witness can speak to the email's unique characteristics, contents, and appearance. After all, Federal Rule of Evidence 901 establishes a seemingly low bar for authenticating or identifying evidence in the first instance, and the characteristics set out in Rule 901(b)(4) are particularly useful in demonstrating that an email is, in fact, what it purports to be.

*United States v. Bertram*, 259 F.Supp.3d at 641.

First, the emails include the names and addresses of the various senders and recipients that include the corporate email address "MDLZ," the date and time they

were transmitted and the senders utilized the reply function which indicates the email was sent to the sender's listed email address.<sup>18</sup> See 5 Jack B. Weinstein & Margaret A. Berger, WEINSTEIN'S FEDERAL EVIDENCE § 900.07[3][c][i] (2019); *Corbin v. Sw. Airlines, Inc.*, 2018 WL 4901155 at \*8 (S.D. Tex. Oct. 9, 2018) ("Here, the emails include the sender's name, the recipient, the date, and the subject. They are sufficiently authenticated."); *U.S. v. Bertram* at 642 ("The email addresses themselves contained some identifying information.").

Ms. Williams testified, "In preparation for the case, Richard [Richardson] provided this e-mail" that the email came "from Richard's computer" and that Richard provided the email "as part of the materials in preparation for the case." Williams Cross Dep., 39 TTABVUE 34-35.<sup>19</sup> Therefore, she was aware as to the "document collection and production process" at least to the extent she knew the sender of the email, Richard Richardson, provided this email. In addition, she is familiar generally with Mondelēz Exports' business model and their pattern of operation picking up brands they can exploit within the context of their customer base. This knowledge is relevant as it shows a pattern of business that is aligned with picking up the CHICLETS brand for their consumer target base in the United States.

There is nothing in the record to question the content of the emails discussing picking up the CHICLETS brand. The white space Petitioner is concerned about

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<sup>18</sup> Although the emails were filed under seal, these general attributes are not confidential matter.

<sup>19</sup> Although this testimony was provided under seal, Respondent discusses the email from Mr. Richardson in these general terms in its public brief.

would only indicate the absence of material, but it does not impugn the statements in the email. These emails were first provided during discovery and Petitioner questioned Ms. Williams about the emails during the discovery deposition. If Petitioner believed these emails and the statements therein were wholly fabricated, Petitioner needed to address such a concern during discovery. *See Midwest Retailers Ass'n, Ltd. v. City of Toledo*, 582 F.Supp.2d 931, 934-35 (N.D. Ohio 2008) (calling a similar approach to challenging the admissibility of emails “hyper-technical and abstract,” and noting the challenge was “undercut by the lack of any allegation” that the emails were actually inauthentic).

As to the hearsay objection, Petitioner argues that “[t]hroughout Ms. Williams’ Trial Declaration and oral testimony, she made references to conversations which she ‘assumed’ had occurred amongst Mondelēz employees about the discontinuance and re-launching of the CHICLETS brand. However, such testimony should be excluded from the Board’s consideration as hearsay, and especially because Ms. Williams admittedly does not have any personal knowledge about such alleged conversations. There is simply no reliable evidence whatsoever of what and when conversations occurred, and what was discussed, or even who was present or otherwise involved in these alleged conversations.” Pet. Brief, 46 TTABVUE 43.

Respondent further argues that Ms. Williams, in her discovery deposition as Respondent’s corporate representative, was not required to have “personal knowledge” of the conversations that took place within Mondelēz Exports “since she was speaking for [Respondent], not herself personally.” Resp. Brief, 48 TTABVUE 37.

Additionally, Ms. Williams “testified that she spoke to both Richard Richardson and Mark Suomi (both of whom are officers of Mondelēz Exports) as part of her preparation for her discovery deposition. Her testimony was based also on her review of the emails that were sent between Mondelēz Exports officers in 2016 and 2017 concerning the pick-up of the CHICLETS brand.” *Id.* In addition, Ms. Williams as the Senior Director of Marketing for Mondelēz North America’s Confections portfolio for three years had personal knowledge of the process by which Mondelēz Exports picks-up distribution of a brand from Mondelēz North America.

Petitioner replies that Ms. Williams:

[G]eneral knowledge about how Mondelēz Exports may have operated in the past in certain unspecific situations is entirely irrelevant to what happened in this case ... [and] it is telling that [Respondent] can only represent that Ms. Williams may have spoken with two individuals from Mondelēz Exports prior to her deposition ... at no point has Ms. Williams or [Respondent] even attempted to argue or explain the nature, timing, or context of those conversations ... her testimony about what she claims occurred goes far above and beyond the actual content of the emails ... [and] [i]t is eminently clear that Ms. Williams speculated as to what happened because she lacked actual knowledge.

Reply Brief, 50 TTABVUE 24.

Ms. Williams did not “represent” that she “may have spoken” to “individuals from Mondelēz Exports.” Ms. Williams specifically testified that she “talked with Mark and Richard as part of [her] preparation [for the 30(b)(6) discovery deposition].” 25 TTABVUE 13. She testified that Richard Richardson “is in Business Development ... in Mondelēz Imports and Exports [and] Mark is also in Mondelēz Imports and

Exports ... in ... sales management, marketing...” *Id.* The “nature,” “timing” and “context” was to prepare for the discovery deposition the subject matter of which is the CHICLETS business.

As noted above, these emails were provided during discovery and were introduced at trial first by Petitioner attached to Ms. William’s discovery deposition. These emails were later introduced, a second time, by Respondent as exhibits attached to Ms. Williams testimony who testified:

This declaration and the facts and matters discussed are based on my own personal knowledge and the books and records maintained by Mondelēz to which I have access or for which I am a custodian. Unless otherwise noted, the exhibits to which I refer and which are attached to my declaration are copies of documents and other materials from Mondelēz’s business records regularly kept in the ordinary course of the company’s business, including those kept by myself or at my direction.

Williams Decl. ¶ 2, 30 TTABVUE 2.

While Ms. Williams testified that she is not the custodian of Mr. Richardson’s emails, as the Vice President – Marketing Transformation & Excellence, North America for Mondelēz International, Inc., we find this is sufficient to establish her as a “qualified witness” to establish these emails sent by another division in Mondelēz International Inc. as records kept in the ordinary course of business of Mondelēz International Inc. which includes both Mondelēz North America and Mondelēz Exports, and Petitioner’s inquiry as to “white spaces” in the submissions is not sufficient to show that “the source of information or the method or circumstances of preparation indicate a lack of trustworthiness.” Fed. R. Evid. 803(6)((D) and (E).

As to the hearsay objection about the ongoing conversations, the testimony alluding to conversations that may have happened within Mondelēz Exports about picking up the CHICLETS brand is speculative, not based on personal knowledge and has not been considered. However, the authenticated emails have been offered as business records and show the content of these messages going back and forth among Mondelēz Exports employees. We may infer from this information that in September 2016 some Mondelēz Exports employees discussed via email picking up the CHICLETS brand. Although Ms. Williams is in a different division and was not part of these discussions and has no personal knowledge as to specific conversations among Mondelēz Export employees about picking up the CHICLETS brand, we may infer from the emails and the ultimate sales in April 2018 that some conversations about exporting CHICLETS to the United States took place.

With regard to the September 2016 email Petitioner argues that “Mondelēz Exports’ own words demonstrate that any commercial activities it could **potentially** take at some **unknown time in the future** were aimed solely to reserve rights in the mark until Mondelēz NA re-launched the product at some **unknown time in the future**. This admission sinks IGBL’s [Respondent’s] effort to demonstrate [a] bona fide intent to resume **commercial** use of the CHICLETS marks.” Pet. Brief, 46 TTABVUE 37 (emphasis in original).

Respondent argues, “As early as September 2016, while Mondelēz North America was still selling CHICLETS products in the U.S., Mondelēz Exports expressed an interest in continuing sales of CHICLETS in the U.S. once Mondelēz North America

ceased sales.” Resp. Brief, 48 TTABVUE 20; Williams Decl. ¶ 32, 30 TTABVUE 10. This argument is supported by an email sent on September 20, 2016 from Richard Richardson, Head of Business Development of Mondelēz Exports, to other members of Mondelēz Exports. Williams Decl. ¶ 33, Exh. DX 3, 30 TTABVUE 10; 29 TTABVUE.<sup>20</sup> Mondelēz Exports continued this interest in 2017 as demonstrated by a subsequent email sent on July 21, 2017, from Mark Suomi, Director of Mondelēz Exports, to members of the Mondelēz Exports team. Later, on November 15, 2017, Natalie Almanza, Sales Operations Analyst at Mondelēz Export, sent an email to Mark Suomi related to selling CHICLETS branded gum in the United States. Resp. Brief, 48 TTABVUE 21; Williams Decl. Exh. DX 5, 29 TTABVUE.<sup>21</sup>

In April 2018, Mondelēz Exports began the distribution of CHICLETS gum in the United States. Williams Decl. ¶ 37, 30 TTABVUE 11-12. Since that time Mondelēz Exports has sold CHICLETS products to its U.S. distributor, Stark Group International. Williams Decl. ¶ 38, 30 TTABVUE 12. CHICLETS gum is available for purchase in the United States primarily through independently-owned grocery stores. Williams Decl. ¶ 39, 30 TTABVUE 12. Mondelēz Exports advertises and promotes CHICLETS products at confectionary tradeshows in the United States. Williams Decl. ¶ 40, 30 TTABVUE 11.

Petitioner argues that Mondelēz Exports’ actual sales in 2018 were only to its distributor and “were well-below stated expectations and demonstrates that

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<sup>20</sup> The specific contents of the email are marked confidential.

<sup>21</sup> The specific contents of the email are marked confidential.

Mondelēz did not engage in any serious business planning for the brand, and has not engaged in bona fide commercial use of the marks. Second, if Mondelēz had engaged in genuine commercial use of the CHICLETS marks by selling products to consumers or by marketing the products ... it should have furnished such documentation during this proceeding.” Pet. Brief, 46 TTABVUE 38. The sales by Mondelēz Exports do not constitute “token” sales and based on this record reveal sales on a commercial level. In short, the activities, as shown through the emails occurring during the period of nonuse and the subsequent resumption of use in 2018, show an intent to resume use.

#### E. Summary

Mondelēz North America sold CHICLETS branded gum in the United States until late 2016. Thereafter, in April of 2018, Mondelēz Exports began and continues to sell CHICLETS branded gum in the United States. In other words, the record shows one member of the licensed Mondelēz family of companies (Mondelēz North America) discontinuing use and another member of the corporate family (Mondelēz Exports) starting use; and there is no evidence to establish that Respondent as the owner and licensor of the CHICLETS brand or the Mondelēz family of companies intended not to resume use. As summed up by Respondent, “[t]he uncontradicted facts indicate that [Respondent] never expressed through word or deed any intent not to resume use of the CHICLETS mark. The law demonstrates that the actions taken by various divisions within the [Mondelēz] family of companies did not evidence an intent not to resume use.” Resp. Brief 48 TTABVUE 54.

On a final note, this cancellation proceeding is against five CHICLETS registrations, one standard character and four others with variations. Both parties

address the CHICLETS marks generally without providing specific argument and evidence as to each CHICLETS mark. However, as discussed above, Petitioner has not established abandonment coupled with an intent not to resume use for any of the CHICLETS marks. To the extent Petitioner's evidence is sufficient to establish a prima facie case of abandonment, while there is evidence of actual resumed use only for some of the CHICLETS marks, the other evidence of intent to resume use nevertheless supports such intent for all of them.

**Decision:** The petition to cancel is denied.