

ESTTA Tracking number: **ESTTA199866**

Filing date: **03/21/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91121040
Party	Defendant OSHO INTERNATIONAL FOUNDATION
Correspondence Address	MARY M. LURIA DAVIS & GILBERT LLP 1740 BROADWAY NEW YORK, NY 10019 UNITED STATES
Submission	Other Motions/Papers
Filer's Name	Sara Edelman
Filer's e-mail	sedelman@dglaw.com
Signature	/sedelman/
Date	03/21/2008
Attachments	Appendix B.PDF (148 pages)(9309902 bytes)

- Exhibit 1 *AT&T Corp. v. Overdrive, Inc.*
- Exhibit 2 *Baker v. Rio Props., Inc.*
- Exhibit 3 *Cash Haggadone v. Cavanna*
- Exhibit 4 *Eredi Chiarini S.R.L. v. Braemore Neckwear Co.*
- Exhibit 5 *Community Financial Services Association of America v. Payday Garden City, L.L.C.*
- Exhibit 6 *Corning Inc. v. Vitrocrisa S.A. de C.V. Co.*
- Exhibit 7 *Danone Asia Pte v. Happy Dragon Wholesale*
- Exhibit 8 *Food-Tek, Inc. v. Rhodia, Inc.*
- Exhibit 9 *Fridkin v. Minn. Mut. Life Ins. Co.*
- Exhibit 10 *Great Earth Cos., Inc. v. Intimate Beauty Corp.*
- Exhibit 11 *Leiner Health Servs. Corp. v. Time of Your Life, Inc.*
- Exhibit 12 *Minka Lighting, Inc. v. Ambiance Imps., Inc.*
- Exhibit 13 *Pacific Sunwear of Cal., Inc. v. AIT, Inc.*
- Exhibit 14 *Pinkerton Serv. Corp. v. Senior Tech.*
- Exhibit 15 *Ariel Remos v. Ariel Feierman*
- Exhibit 16 *Schlage Lock Co. v. Mark J. Staiano*
- Exhibit 17 *Tommy Hilfiger Licensing, Inc. v. Henri-Lloyd, Ltd.*
- Exhibit 18 *Walters Gardens, Inc. v. Pride of Place Plants, Inc.*
- Exhibit 19 *Warrior Lacrosse, Inc. v. STX, L.L.C.*

EXHIBIT 1



Analysis
As of: Mar 19, 2008

AT&T CORP., Plaintiff, vs. OVERDRIVE, INC., Defendant.

Case No. 1:05CV1904

**UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF
OHIO, EASTERN DIVISION**

2006 U.S. Dist. LEXIS 84836

**November 21, 2006, Decided
November 21, 2006, Filed**

SUBSEQUENT HISTORY: Motion granted by At&T Corp. v. Overdrive, Inc., 2007 U.S. Dist. LEXIS 661 (N.D. Ohio, Jan. 3, 2007)

CORE TERMS: business records, personal knowledge, deposition testimony, summary judgment, authenticated, deposition, inadmissible hearsay, qualified witness, dictionarary, moves to strike, admissible, well-taken, admissibility, inadmissible, authenticate, regularly, hearsay, signature, competent evidence, evidence admissible, fails to demonstrate, business activity, normal course, information transmitted, common meaning, proper foundation, regular course, competency, personally, testifying

COUNSEL: [*1] For AT&T Corp., Plaintiff: Paul R. Franke, III, LEAD ATTORNEY, Stephanie D. Loughner, William H. Eikenberry, Murray, Franke, Greenhouse, List & Lippitt, Denver, CO; Vincent J. Lodico, LEAD ATTORNEY, Jeffrey D. Houser, Crabbe, Brown & James, Columbus, OH.

For Overdrive, Inc., Defendant: Lester S. Potash, Cleveland, OH.

For Overdrive, Inc., Counter-Claimant: Lester S. Potash, LEAD ATTORNEY, Cleveland, OH.

For AT&T Corp., Counter-Defendant: Paul R. Franke, III, LEAD ATTORNEY, Stephanie D. Loughner, William H. Eikenberry, Murray, Franke, Greenhouse, List & Lippitt, Denver, CO; Jeffrey D. Houser, Vincent J. Lodico, Crabbe, Brown & James, Columbus, OH.

JUDGES: Kenneth S. McHargh, United States Magistrate Judge.

OPINION BY: Kenneth S. McHargh

OPINION

MEMORANDUM AND ORDER

McHARGH, Mag. J.

The plaintiff, AT&T Corp. ("AT&T"), a New York corporation, has filed an amended complaint against the defendant, Overdrive, Inc. ("Overdrive"), a Delaware corporation, alleging breach of contract and unjust enrichment. (Doc. 8.) In its answer, Overdrive asserted counterclaims alleging a breach of an implied covenant of good faith and fair dealing, fraudulent misrepresentation, and tortious interference. [*2] (Doc. 17.)

Overdrive has filed a motion for summary judgment on the amended complaint. (Doc. 37.) AT&T has responded to that motion, and filed a cross-motion for summary judgment. (Doc. 39-40.) Currently before the court are two motions to strike, filed by defendant Overdrive. (Doc. 42-43.)

I. OVERDRIVE'S MOTIONS TO STRIKE

Defendant Overdrive has filed two motions to strike exhibits attached to AT&T's response and cross-motion. Overdrive moves to strike Exhibit 2, the affidavit of Pam Gritchen, arguing that it "does not constitute competent evidence admissible for consideration by this court." (Doc. 42, at 1.) Overdrive also moves to strike Exhibits

1, 3, 5-8, and 10-14, arguing that they constitute "inadmissible hearsay." (Doc. 43, at 1.) AT&T has responded to each motion. (Doc. 46-47.)

Rule 56(e) sets the standards which affidavits to a motion for summary judgment must satisfy, but the rule makes no provision for "striking" those documents which do not conform. Fed. R. Civ. P. 56(e). Overdrive's "motions to strike" will be considered as objections to the affidavit and exhibits at issue.

II. GRITCHEN AFFIDAVIT

Overdrive moves to strike [*3] Exhibit 2, the affidavit of Pam Gritchen, arguing that it "does not constitute competent evidence admissible for consideration by this court." (Doc. 42, at 1.) Rule 56 provides that summary judgment affidavits "shall be made on personal knowledge, shall set forth such facts as would be admissible in evidence, and shall show affirmatively that the affiant is competent to testify to the matters stated therein." Fed. R. Civ. P. 56(e). Failure to comply with the mandatory requirements of Rule 56(e) "makes the proposed evidence inadmissible during the consideration of the summary judgment motion." Friedel v. City of Madison, 832 F.2d 965, 970 (7th Cir. 1987). Overdrive contends that the Gritchen affidavit is not made on personal knowledge, doc. 42, at 2, that it does not set forth facts which would be admissible in evidence, id. at 3, and that the affidavit fails to demonstrate Gritchen's competency to testify on the relevant matters, id. at 6.

To be considered as competent evidence, a summary judgment affidavit must be based on personal knowledge. Harriscom Svenska, AB v. Harris Corp., 3 F.3d 576, 581 (2d Cir. 1993); [*4] Citizens to Preserve Overton Park, Inc. v. Volpe, 432 F.2d 1307, 1319 (6th Cir. 1970), rev'd on other grounds by 401 U.S. 402, 91 S. Ct. 814, 28 L. Ed. 2d 136 (1971); Reddy v. Good Samaritan Hosp. & Health Ctr., 137 F.Supp.2d 948, 956 (S.D. Ohio 2000). Overdrive objects that the Gritchen affidavit is not made on personal knowledge, thus cannot be considered by the court. (Doc. 42, at 2.) In her affidavit, Gritchen avers:

I am the Final Dispute/Legal Manager for Revenue Management at AT&T Corp. I am over 18 years of age and am fully familiar with the facts and circumstances contained herein. I make this affidavit to the best of my knowledge and belief based upon the business records kept in the normal course and scope of business at AT&T Corp.

(Doc. 40, PX 2, at P 1.)

Overdrive objects to this choice of words, arguing that there is no evidence in the affidavit that Gritchen has personal knowledge of the "facts and circumstances." Overdrive contends that "familiarity" is not equivalent to "personal knowledge." (Doc. 42, at 3-4.) In addition, Overdrive asserts that the phrase "to the best of my knowledge and belief" does not meet the standard of knowledge [*5] required. Id. at 4.

An affidavit normally states the basis for the facts, but "personal knowledge may be inferred from the content of the statements." Reddy, 137 F.Supp.2d at 956. On the other hand, an affidavit "based, not on personal knowledge, but *only* on information and belief" is not competent evidence. Overton Park, 432 F.2d at 1319 (emphasis added). See also Reddy, 137 F.Supp.2d at 956 (same). The term "belief" is not a sufficient basis for the asserted facts. Reddy, 137 F.Supp.2d at 956. Unfortunately, Gritchen's affidavit confuses the issue by using parts of both phrases. For example, Gritchen states that she is "fully familiar with the facts and circumstances." (PX 2, at P 1.) She also makes the affidavit "to the best of [her] knowledge and belief" based upon AT&T's business records. Id.

The court determines the common meaning or common understanding of a word or phrase by reference to the standard dictionaries. See, e.g., Amoco Prod. Co. v. Southern Ute Indian Tribe, 526 U.S. 865, 874-875, 119 S. Ct. 1719, 144 L. Ed. 2d 22 (1999). The phrase "familiar with" is defined by one major dictionary as "having personal [*6] or intimate knowledge." Merriam-Webster's Collegiate Dictionary 419 (10<th> ed. 1993). Another respected dictionary defines "familiar" as "having an intimate knowledge of, closely acquainted (with)." Webster's New World Dictionary of American English 489 (3d college ed. 1988). In accordance with the common meaning of the phrase, the court construes Gritchen's averment that she is "fully familiar with the facts" to mean that she asserts she has personal knowledge of the facts.

Overdrive further argues that any knowledge that Gritchen possesses may have been obtained improperly, through "rumor, innuendo, hearsay, etc." (Doc. 42, at 3-4.) However, Gritchen avers that her knowledge is "based upon the business records kept in the normal course and scope of business at AT&T Corp.," which would be a proper basis. (PX 2, at P 1.)

"Personal knowledge . . . is not strictly limited to activities in which the declarant has personally participated." Washington Cent. R.R. Co., Inc. v. National Mediation Bd., 830 F.Supp. 1343, 1352-1353 (E.D. Wash. 1993) (citing Londrigan v. FBI, 216 U.S. App. D.C. 345, 670 F.2d 1164, 1174-1175 (D.C. Cir. 1981)). Personal knowledge can come from [*7] review of the contents of

business records, and an affiant may testify to acts that she did not personally observe but which are described in business records. Id.; Federal Sav. & Loan Ins. Corp. v. Griffin, 935 F.2d 691, 702 (5th Cir. 1991), cert. denied, 502 U.S. 1092, 112 S. Ct. 1163, 117 L. Ed. 2d 410 (1992).

Next, Overdrive contends that the Gritchen affidavit does not set forth facts which would be admissible in evidence. (Doc. 42, at 3.) Overdrive argues that the underlying "business records" relied upon by Gritchen are in fact inadmissible hearsay, because she cannot provide a proper foundation for their admission under Fed. R. Evid. 803(6). Id. at 4. Overdrive argues that the Gritchen affidavit fails to demonstrate Gritchen's competency to testify on the relevant matters. Id. at 6.

A business record must satisfy four requirements in order to be admissible under Rule 803(6): "(1) it must have been made in the course of a regularly conducted business activity; (2) it must have been kept in the regular course of that business; (3) the regular practice of that business must have been to have made the memorandum; and (4) the memorandum [*8] must have been made by a person with knowledge of the transaction or from information transmitted by a person with knowledge." United States v. Baker, 458 F.3d 513, 518 (6th Cir. 2006) (citing United States v. Jenkins, 345 F.3d 928, 935 (6th Cir. 2003)). The evidentiary foundation must be shown by "the testimony of the custodian or other qualified witness[.]" Fed. R. Evid. 803(6); Baker, 458 F.3d at 518.

Thus, under Rule 803(6), a witness does not have to be the custodian of the documents offered into evidence in order to meet the foundational requirements. United States v. Childs, 5 F.3d 1328, 1334 (9th Cir. 1993), cert. denied, 511 U.S. 1011, 114 S. Ct. 1385, 128 L. Ed. 2d 60 (1994); Brodersen v. Sioux Valley Memorial Hosp., 902 F.Supp. 931, 954-955 (N.D. Iowa 1995). "The phrase 'other qualified witness' is given a very broad interpretation." Baker, 458 F.3d at 518 (quoting 5-803 Weinstein's Federal Evidence § 803.08[8][a] (2006)). See also Childs, 5 F.3d at 1334 ("other qualified witness" broadly interpreted). [*9] It is not necessary for an "other qualified witness" to have personal knowledge of the preparation of business records. Baker, 458 F.3d at 518 (citing Dyno Constr. Co. v. McWane, Inc., 198 F.3d 567, 575-576 (6th Cir. 1999)); Jenkins, 345 F.3d at 935-936. All that's required is that the witness be capable of testifying that she is "familiar with the record-keeping procedures of the organization." Baker, 458 F.3d at 518 (citing Dyno Constr. Co., 198 F.3d at 576). See also Brodersen, 902 F.Supp. at 955 (person capable of testifying as to nature of regularly kept records of business) (citing cases).

Gritchen avers that her affidavit is "based upon the business records kept in the normal course and scope of

business at AT&T Corp." (Doc. 40, PX 2, at P 1.) Assuming arguendo that Gritchen may be an "other qualified witness" capable of providing a foundation for the exhibits at issue, her conclusory statement that the exhibits are "business records" is insufficient.

Documents submitted to support or oppose a summary judgment motion must be attached to an affidavit that both identifies and [*10] authenticates each document. Stuart v. General Motors Corp., 217 F.3d 621, 635 n.20 (8th Cir. 2000); Carmona v. Toledo, 215 F.3d 124, 131 (1st Cir. 2000); Klein v. Manor Healthcare Corp., 19 F.3d 1433, 1994 WL 91786, at *6 (6th Cir. 1994) (TABLE, text in WESTLAW). First of all, Gritchen's affidavit does not establish that she "is familiar with what is normally recorded and with the process whereby the records are created, recorded, and stored." See Brodersen, 902 F.Supp. at 955 (citing United States v. Kail, 804 F.2d 441, 449 (8th Cir. 1986)). In fact, Gritchen does not specifically establish that any particular exhibit was made in the course of a regularly conducted business activity, or that such documents were kept in the regular course of that business, or that the regular practice of AT&T was to have made such a record, or that the exhibits were made by a person with knowledge of the transaction or from information transmitted by a person with such knowledge. See generally Baker, 458 F.3d at 518.

AT&T essentially asks the court to infer from Gritchen's job title that she has [*11] certain responsibilities which would lead her to have the requisite knowledge. (Doc. 46, at 3-4.) However, her affidavit itself does not establish this, nor does it satisfy the requirements for admissibility of business records. The objections to Gritchen's affidavit are well-taken.

Overdrive argues that because the Gritchen affidavit has failed to properly authenticate Exhibits 1, 3, 5, 7-8, and 10-14, they are inadmissible as hearsay. (Doc. 42, at 5.) This argument substantially overlaps that made by Overdrive's second motion to strike.

III. EXHIBITS TO PLAINTIFF'S RESPONSE

In their second motion, Overdrive moves to strike Exhibits 1, 3, 5-8, and 10-14, arguing that they are "inadmissible hearsay." (Doc. 43, at 1.) Overdrive argues that these exhibits have not been properly authenticated, and are thus inadmissible as hearsay. Id. at 3. Overdrive contends that the Gritchen affidavit is insufficient for this purpose. In addition, Overdrive claims that the documents in question are not properly authenticated via the deposition testimony of either Ray Fassett or Lisa Pitagna. Id. at 5-6.

AT&T responds that the documents have been authenticated by Gritchen. (Doc. 47, at 2.) [*12] As dis-

cussed more fully above, the court finds that the Gritchen affidavit does not satisfy the requirements for admissibility of business records pursuant to Fed. R. Evid. 803(6).

In addition, AT&T asserts that Exhibits 3, 7, 8, 10, and 13 were signed by Fassett, Overdrive's Rule 30(b)(6) representative, and at his deposition "these contracts were all attached as exhibits and he specifically gave sworn testimony regarding the same." (Doc. 47, at 2.) However, AT&T does not cite to, or provide, those portions of Fassett's deposition testimony which would authenticate each of those exhibits, with two exceptions.

Attached to AT&T's response to the motion for summary judgment is Exhibit 4, which is a portion of Fassett's deposition testimony. In that portion, the court finds that Fassett vouches for his signature on the "AT&T Master Agreement, MA Reference No. 31574." See doc. 39, DX 4, Fassett dep., at 58, and DX 3 (Master Agreement). Although the parties refer, in deposition, to "Exhibit 6" [to the deposition], it is plain that the document in question is the same as Exhibit 3 here.

Fassett identified Deposition Exhibit 6 as "AT&T Master Agreement, [*13] " and confirms that his signature appears on the first page, "AT&T 005." (Doc. 39, DX 4, at 58.) He testified that he signed the document on Oct. 10, 2001. *Id.* This description is totally in accord with what is now identified as Exhibit 3. See DX 4, at 58, and DX 3 (Master Agreement). Thus, the court finds Fassett has authenticated Exhibit 3 through his deposition testimony.

In addition, Fassett identified Deposition Exhibit 13 as "AT&T Internet Transport Services Service Order Attachment," and confirms that his signature appears on the cover sheet, dated May 10, 2002. (Doc. 39, DX 4, at 74-75.) This description is totally in accord with what is now identified as Exhibit 7. See DX 4, at 74-75, and DX 7 (Service Order Attachment). Thus, the court finds Fassett has authenticated Exhibit 7 through his deposition testimony.

In the portion of Fassett's deposition testimony provided to the court, Fassett also refers to Deposition Exhibit 5, but no identifying information is provided. See DX 4, at 46-47. Similarly, a Deposition Exhibit 2 is referred to in passing, but no identifying information is provided. *Id.* at 58-59. Likewise, a Deposition Exhibit 9. *Id.* at 70-71. Several [*14] other exhibits were presented

to Fassett, which he did not recall signing. See, e.g. DX 4, at 72-75.

Thus, the only documents which are authenticated in Fassett's deposition testimony, insofar as a portion of it is before the court, are Exhibit 3, which is a five page document titled "AT&T Master Agreement, MA Reference No. 31574," between AT&T and Overdrive, dated Oct. 12, 2001, and Exhibit 7, which is a nine page document titled "AT&T Internet Transport Services, Service Order Attachment," signed by Ray Fassett (Overdrive) and Sandra Brown (AT&T) in May 2002. See DX 4, at 58, 74-75; DX 3 (Master Agreement), and DX 7 (Service Order Attachment).

Although Overdrive refers to Pitagna's deposition testimony, doc. 43, at 6-7, AT&T does not rely on her testimony in its response to the motion to strike. See generally doc. 47.

Overdrive's objections to Exhibits 1, 5-6, 8, and 10-14, as "inadmissible hearsay" are well-taken. The court finds that Exhibit 3, "AT&T Master Agreement," and Exhibit 7, "AT&T Internet Transport Services, Service Order Attachment," are authenticated by Fassett's deposition testimony.

IV. SUMMARY

Overdrive's motions to strike are addressed as objections [*15] to the affidavits and exhibits at issue. The objections to Gritchen's affidavit are well-taken, thus that motion (doc. 42) is granted. Gritchen avers that her affidavit is based upon AT&T's business records, but she does not provide a proper foundation for the admissibility of these records.

As to Overdrive's second motion (doc. 43), the objections to Exhibits 1, 5-6, 8, and 10-14, as "inadmissible hearsay" are well-taken. The court finds that Exhibit 3, "AT&T Master Agreement," and Exhibit 7, "AT&T Internet Transport Services, Service Order Attachment," are authenticated by Fassett's deposition testimony, and the objections to those exhibits are overruled. Thus, that motion is granted in part, and denied in part.

IT IS SO ORDERED.

Nov. 21, 2006

/s/ Kenneth S. McHargh

United States Magistrate Judge

EXHIBIT 2

LEXSEE

Robert P. Baker v. Rio Properties, Inc.

Cancellation No. 29,567

Trademark Trial and Appeal Board

2001 TTAB LEXIS 782

October 24, 2001, Decided

CORE TERMS: summary judgment, registrant, cross-motion, hotel, matter of law, hospitality, authenticated, misled, declaration, deceptiveness, deceptive, traveler, hearsay, deposition, Trademark Rule, registration, deception, guestroom, genuine issue of material fact, moving party, misdescriptive, personal knowledge, casino, self-authenticating, conclusory, consumer, usage, admissible, genuine, authentication

JUDGES: [*1]

Before Hanak, Bucher and Rogers, Administrative Trademark Judges.

OPINION BY: BUCHER

OPINION:

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

Bucher, Administrative Trademark Judge:

Robert P. Baker, an individual, has filed a petition to cancel Registration No. 1,757,490 for the mark RIO SUITE HOTEL & CASINO (with the words SUITE HOTEL & CASINO disclaimed apart from the mark as a whole), as shown below: [SEE ILLUSTRATION IN ORIGINAL] for "casino and night club services" in International Class 41, and for "hotel services operated in conjunction with a casino" in International Class 42. n1 As the ground for cancellation, petitioner alleges that this mark is deceptive under Section 2(a) of the Trademark Act inasmuch as the majority of the overnight accommodations that registrant calls "suites" and rents out to its customers at its Las Vegas Hotel are not actually suites.

n1 Registration No. 1,757,490, issued on March 9, 1993, Section 8 affidavit accepted, Section 15 affidavit acknowledged.

In its answer, registrant denied the salient allegations of the petition and raised a number of affirmative defenses.

Background

This extra-ordinary litigation grew [*2] out of an overnight stay in a Las Vegas hotel by a Los Angeles attorney, Mr. Robert P. Baker (hereinafter petitioner or "Baker"). On March 12, 1997, Baker spent the night at the Rio Suite Hotel & Casino in Las Vegas, Nevada - which hotel property is owned and operated by Rio Properties, Inc. (hereinafter registrant, respondent or "Rio"). Upon his return to California, Baker's written complaint to Rio about his accommodations led to more correspondence and then settlement discussions, including Baker's suggestion that in order not to deceive prospective customers, perhaps Rio should delete the word "Suite" from its name.

Claiming that Baker had raised a claim under the Lanham Act, Rio sued Baker in the United States District Court for Nevada, seeking declaratory relief action (hereinafter, the "Nevada Federal Action"). Baker counterclaimed based on false advertising under California's consumer protection laws. After two years of litigation, Rio moved to dismiss its complaint, depriving the federal court of supplemental jurisdiction over Baker's state counterclaim. Even before dis-

missing the Nevada Federal Action, Rio filed a similar lawsuit in a Nevada state court, in a proceeding [*3] that is still pending.

Allegedly fearing never-ending litigation without resolution in the Nevada state forum, Baker then filed the instant petition requesting the cancellation of Rio's above-listed federal trademark registration. In spite of an earlier interlocutory decision of this Board noting with displeasure the "over-litigious conduct" of the parties to this action, the fervor of each motion along with the heft of each submission promise much more litigation before this suite issue is resolved.

Current Disputes

This case now comes up on the parties' cross-motions for summary judgment and related motions. n2 Specifically, on August 7, 2000, Rio filed a motion for summary judgment on Baker's allegation of deceptiveness. On September 6, 2000, Baker filed a brief opposing Rio's motion, moved for summary judgment in his own favor on the ground of deceptiveness, as pleaded in his petition to cancel, and objected to certain documents submitted in the appendix to registrant's motion for summary judgment. On September 26, 2000, Rio filed a reply to Baker's opposition to Rio's motion and on September 29, 2000, Rio submitted its opposition to Baker's cross-motion for summary judgment. [*4] On September 29, 2000, Baker filed a motion to strike new evidence submitted by Rio in its reply to Baker's motion for summary judgment. Needless to say, each of these motions and objections has been fully briefed.

n2 It appears as if Baker's motion of July 13, 2000 to allow testimonial use of the depositions of Ms. Axelrod and Ms. Lockshin, which motion was filed before the motions for summary judgment, remains unopposed by Rio but has not been acknowledged or acted upon by this Board. Accordingly, we explicitly grant Baker's motion for this testimony of June 1998 from the Nevada Federal Action to be submitted as evidence during his case in chief. See *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 9 USPQ2d 1061 (TTAB 1988), rev'd on other grounds, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989); 37 CFR § 2.122(f); and TBMP § 715 - *Testimony From Another Proceeding*.

As evidence in support of its motion for summary judgment, registrant/respondent submitted exhibits including: Rio's Annual Report for the SEC (Form 10-K); Rio's king suite floor plan for room 548 (the room occupied by Baker); cover letter with [*5] attached awards and recognitions for Rio Suite Hotel and Casino; heading and statement of action in Nevada Federal District Court proceeding; photocopy of Baker's Rio folio, having room charges and credit; copy of letter from Rio to Ms. Axelrod, another of Rio's unhappy guests; a report by its expert, Leo M. Renaghan, on the relationship between the term "suite" and guest room products in U.S.; Baker's responses to Rio's first set of interrogatories; a copy of relevant pages of "Dictionary of Travel, Tourism and Hospitality"; and a copy of relevant pages of "Glossary of Hospitality Management Terms."

In response, petitioner asserts that registrant is not entitled to summary judgment, but in fact, that petitioner is himself entitled to summary judgment as a mater of law. Petitioner's brief in opposition to registrant's motion for summary judgment (and in support of his own cross-motion for summary judgment) is supported by the affidavits of Sheila Cohn, Bruce Baltin, Edward Perkins, William Christopher, and Robert P. Baker, and a voluminous appendix of exhibits submitted therewith.

Petitioner's objections to documents in appendix

Before addressing the respective motions for [*6] summary judgment, we turn briefly to Baker's objections to documents in the appendix to registrant's motion for summary judgment. n3 Baker's motion of September 6, 2000 asks us to rule on objections pertaining to the admissibility of nine exhibits under the Federal Rules of Evidence. n4

n3 Rio argues that Baker's objections herein are simply a clever attempt to get around his page limit on a brief in opposition to a motion for summary judgment. After considering the arguments on both sides of this question, we find it reasonable that these objections were made in a separate brief.

n4 Rio had attached ten exhibits to its motion for summary judgment, and Baker objected to nine of them, as follows:

. Exhibit A: Rio's Annual Report for the SEC (Form 10-K), [Baker contends that this exhibit is not authenticated; hearsay; conclusory; irrelevant];

- . Exhibit B: Rio's king suite floor plan for room 548, [Baker contends that this exhibit is not authenticated; hearsay];
- . Exhibit C: Cover letter with attached awards and recognitions for Rio Suite Hotel and Casino, [Baker contends that this exhibit is not authenticated; no foundation; opinions of lay witnesses; hearsay; conclusory; not best evidence; irrelevant];
- . Exhibit D: Heading and statement of action in Nevada Federal District Court action, [Baker contends that this exhibit is not authenticated; incomplete];
- . Exhibit E: Photocopy of Baker's room charges and credit, [Baker contends that this exhibit is not authenticated; irrelevant];
- . Exhibit F: Copy of letter from Rio to Ms. Axelrod, [Baker contends that this exhibit is not authenticated; no foundation; conclusory; opinions of lay witnesses];
- . Exhibit G: Report by Leo M. Renaghan on relationship between term "suite" and guestroom product in U.S., [Baker contends that this exhibit is not authenticated; author not qualified as an expert; merely opinions and conclusions; no foundation; reports of authorities are hearsay and not best evidence; statements not made under oath];
- . Exhibit H: Baker's responses to Rio's first set of interrogatories, (No objection);
- . Exhibit I: Copy of relevant page of "Dictionary of Travel, Tourism and Hospitality," [Baker contends that this exhibit is not authenticated; hotel usage of term is irrelevant; conclusory opinions; authors not shown to be experts];
- . Exhibit J: Copy of relevant page of "Glossary of Hospitality Management Terms," [Baker contends that this exhibit is not authenticated; hotel usage of term is irrelevant; conclusory opinions; authors not shown to be experts].

[*7]

As to the authentication of several of these exhibits, we find that the dictionary entry, glossary entry and Rio's Annual Report for the Securities and Exchange Commission (SEC Form 10-K) are self-authenticating under Trademark Rule 2.122(e). n5

n5 As to the issue of admissibility of documents in the context of a motion for summary judgment before the Board:

"By their qualification as printed publications or official records under Trademark Rule 2.122(e), Baker, the non-moving party, will be able to independently verify the authenticity of the documents, and hence, no further evidence of authenticity is required as a condition to the admissibility of these documents."

Raccioppi v. Apogee Inc., 47 USPQ2d 1368, 1369 (TTAB 1998).

For those exhibits not self-authenticating under Rule 2.122(e), we find that the later-filed affidavits cure any problems inasmuch as the affiant has asserted personal knowledge of the source thereof:

It is not mandatory, however, that any or all exhibits submitted in connection with a motion for summary judgment be self-authenticating and thus qualify as being admissible under Trademark Rule 2.122(e). Rather, [*8] documents and other exhibits which are not self-authenticating may be submitted in connection with a summary judgment motion, pursuant to the provisions of Rule 56(e). To be admissible under Rule 56(e), such documents and/or exhibits must be authenticated by and attached to an affidavit (or declaration in a Board proceeding) complying with the requirements of Rule 56(e) and the affiant must be a person through whom the exhibits could be admitted into evidence. Wright, Miller & Kane, Federal Practice and Procedure: Civil 2d Section 2722 (2nd ed. 1983). The requirement of authentication as a condition precedent to the admissibility of evidence is satisfied by evidence sufficient to support a finding that the matter in question is what the proponent claims. Fed. R. Evid. 901. Thus, in the same manner that depositions may be used during the testimony period to introduce documents which are not self-authenticating, affidavits or declarations may be used to introduce documents in support of a motion for summary judgment, so long as the declarant has personal knowledge of the source thereof...

The source of the information is within the personal knowledge [*9] of the declarant Baker and, thus, it has been adequately shown that Exhibit 7 is what opposer claims it to be, i.e., printouts of information accessed at specified Internet addresses. We find this sufficient to hold the proffered printouts admissible as evidence in support of opposer's motion for summary judgment. The declarant is not required to have personal knowledge of the information set forth in these printouts. He obviously does not have personal knowledge of these matters. Instead, the reliability of the information becomes a matter of weight or probative value to be given to the proffered evidence.

Raccioppi v. Apogee Inc., supra at 1369-1370, 1971.

We turn next to Baker's substantive objections under the Federal Rules of Evidence (i.e., those other than authentication issues discussed above) that have been raised to Rio's documentary evidence.

While we may not find it dispositive, neither can we agree with Baker that the usage of the term "suite" as reflected in the reference works of the hospitality industry are irrelevant under the rules of evidence. Furthermore, Rio's description of its own services in the SEC Form 10-K filed with [*10] the Securities and Exchange Commission would qualify as an admission of registrant, and thus would fall within the statements which are expressly excluded from the definition of hearsay in Fed. R. Evid. 801(d)(2). n6

n6 (d) Statements which are not hearsay.

A statement is not hearsay if--

...
(2) *Admission by party-opponent.* The statement is offered against a party and is

- (A) the party's own statement, in either an individual or a representative capacity
- or
- ...
- (C) a statement by a person authorized by the party to make a statement concerning the subject,

In light of our disposition of the instant cross-motions for summary judgment, we choose not to deal explicitly with each specific evidentiary objection raised in conjunction with the motion for summary judgment. Nonetheless, we have been able to reach our conclusions herein, relying only upon those documents that are clearly admissible under the Federal Rules of Evidence.

Petitioner's motion to strike declarations

We turn next to Baker's motion to strike new evidence submitted by Rio in its reply to petitioner's motion for summary judgment. Mr. Baker claims [*11] that we should strike these three declarations because they comprise new evidence to which he has not been able to respond, that there is not an adequate foundation for these declarations, and that there are continuing defects in the report and survey of Leo M. Renaghan.

In response to Baker's earlier objections to the authentication of certain exhibits making up Rio's motion for summary judgment, these declarations were submitted by registrant's counsel to "dispel any doubts as to the authenticity of the documents" which "had been produced previously to Baker... ." (Registrant's response of October 18, 2000 to petitioner's request to strike evidence). Hence, it appears as if Baker's earlier objections prompted the filing of these declarations, and that Baker has had adequate opportunity to respond to this evidence.

Furthermore, under Fed. R. Civ. P. 56(e), the Board may permit the parties to supplement their summary judgment affidavits or to submit additional affidavits. See Shalom Children's Wear Inc. v. In-Wear A/S, 26 USPQ2d 1516 (TTAB 1993). Accordingly, we exercise our discretion under the rule in favor [*12] of considering these three declarations offered with registrant's reply brief. And if, for example, the report and survey of Leo M. Renaghan are introduced into evidence at trial, Baker will certainly have opportunities to test their alleged defects.

Deceptiveness under Section 2(a) of the Lanham Act

The relevant statutory provision herein bars registration of a mark comprising deceptive matter. Congress has said that the advantages of registration may not be extended to a mark that, standing alone, deceives the public.

A mark may be established as a deceptive mark under Section 2(a) by showing that it is deceptively misdescriptive under Section 2(e) (1), and additionally showing that the misrepresentation is material to the decision to purchase the goods or services so marked. *See In re Budge Manufacturing Co. Inc.*, 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988) [whether the misdescription is likely to affect the decision to purchase]. Accordingly, our analysis must deal with the answers to the following series of questions:

(1) Does the use of "SUITE HOTEL" in this composite mark misdescribe registrant's services? Specifically, has Baker established [*13] that the mark RIO SUITE HOTEL & CASINO (stylized) is misdescriptive as used by registrant?

(2) Even if misdescriptive, will reasonable consumers be misled?

(3) If so, is the deception material to consumers? That is, has Baker demonstrated that the alleged misrepresentation would be a material factor in the decision of consumers to rent a room from Rio?

Registrant's (Rio's) Motion for Summary Judgment

This brings us to registrant's motion for summary judgment on the cancellation petition. We begin our discussion of this motion by noting that a motion for summary judgment is a pretrial device to dispose of cases based on the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any. "The purpose of summary judgment is one of judicial economy, that is, to save the time and expense of a useless trial where no genuine issue of material fact remains and more evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result." *Societe Des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L.*, 10 USPQ2d 1241, 1244 (TTAB 1989); [*14] *See also Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984).

Summary judgment shall be rendered forthwith if the pleadings and evidence of record show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. *Fed. R. Civ. P. 56(c)*. *National Cable Television Assoc., Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1578, 19 USPQ2d 1424, 1427 (Fed. Cir. 1991); and *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989); and cases cited in the foregoing cases. A dispute as to a material fact issue is genuine only if a reasonable fact finder viewing the entire record could resolve the dispute in favor of the nonmoving party. *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). In deciding a motion for summary judgment, the Board must view the evidence in the light most favorable to the nonmovant and must draw all reasonable inferences from underlying facts in favor of the nonmovant.

The moving [*15] party bears the burden, in the first instance, of specifying the basis for its motion and "identifying those portions of 'the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any,' which it believes demonstrate the absence of a genuine issue of material fact." *See Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548, 91 L.Ed.2d 265, 4 FR Serv. 3d 1024 (1986). When the moving party has met this burden, and the motion is sufficiently supported with evidence identified by the moving party, supporting the fact that the moving party is entitled to judgment, the nonmoving party may not rest upon the mere allegations or denials in its pleadings. Rather, at that point, the burden shifts to the nonmoving party, who must proffer countering evidence sufficient to demonstrate the existence of specific genuinely disputed facts that must be resolved at trial. *See Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

By its motion, registrant seeks judgment as a matter of law as to petitioner's allegation of deceptiveness. Registrant [*16] argues that no genuine issue of material fact exists as to the alleged deceptiveness of its mark. Specifically, registrant argues that:

The evidence of record establishes that the suite Baker received fits squarely within accepted modern industry usage and understanding of the term "suite." Moreover, Baker has failed to introduce any probative evidence of what the public understands the term "suite" to mean - as he must to prevail on his claim. To the contrary, the undisputed evidence of record evidences that the relevant consuming public does not share Baker's understanding of the term.

(Registrant's motion for summary judgment, p. 2).

Baker, in its brief in opposition to the motion (and in support of its own cross-motion), argues as follows:

There are three issues in this proceeding; and all of them are determinable in Petitioner's favor as a matter of law:

1. Rio's trademark "RIO SUITE HOTEL AND CASINO" is deceptive as a matter of law because most of the guestrooms at the Rio are not suites;
2. A reasonable traveler is likely to be misled by this deception; and
3. The deception pertains to a fact that is often objectively material to a reasonable traveler [*17] in selecting among competing hospitality services, and Rio has admitted that the fact is material.

...

In support of his Motion, Petitioner relies upon his Petition, Brief, supporting Affidavits of Sheila Cohn, Bruce Baltin, Edward Perkins, William Christopher, and Robert P. Baker, and the Appendix of Exhibits submitted simultaneously herewith.

The Petition alleges that many rooms at Rio's hotel, the Rio Suite Hotel and Casino in Las Vegas, Nevada ("Hotel"), are not suites and that Rio's name and mark "RIO SUITE HOTEL AND CASINO" is therefore deceptive. As set forth in Petitioner's accompanying Brief, most of the guestrooms at the Hotel are not suites. There is no dispute as to the nature of the subject guestrooms, and no dispute that they clearly are not suites as that word is commonly used and understood by the general public as reflected in all dictionaries of common usage. That is, the subject guestrooms do not consist of two or more connecting rooms functioning as a single living unit.

Rio argues that the hospitality industry has connived to agree on a new definition of "suite" that would include the subject rooms, or more specifically that deceptive practices in [*18] the hospitality industry have deprived "suite" of any meaning. However, Rio's own evidence shows that there is no agreement, even within the hospitality industry, on any anti-common usage definition of "suite." Whether the common usage of the word suite, as understood by a reasonable consumer, governs the issue of whether Rio's use of the word is deceptive, or whether some other definition advanced by a very small percentage of the hospitality industry can turn the meaning of the word "suite" on its head, and cause "suite" to mean the opposite of its dictionary meaning, is a question of law. The meaning of words is always a question of law. Accordingly, Petitioner is entitled to a finding as a matter of law that the subject mark is deceptive.

The question of whether a reasonable person would be misled by Rio's deception is answered by an objective test. Accordingly, it too is a question of law. It cannot reasonably be disputed by Rio that a person could reasonably be misled by the use of "suite" to mean the opposite of its dictionary meaning. Petitioner has also presented uncontradicted expert testimony to the effect that travelers are likely to be misled by Rio's misuse of the [*19] word "suite."

Finally, the materiality of this deception has been admitted by Rio. The whole thrust of Rio's advertising is to convince travelers that its "suites" present a value above and beyond the value of standard rooms, and that they should pick the Rio because of these suites. This strategy is presented in Rio's annual report, and is supported by statements in the expert report of Registrant's own expert. [Rio's Exhibit G.] Thus, Registrant has admitted the materiality of the deception. In any event, the question of whether a reasonable traveler would likely consider two rooms to be better than one poses an objective test that is determinable as a matter of law.

Since all three questions at issue in this case are either admitted by Registrant and/or are matters of law to be resolved by reference to an objective test, there is no need to inquire as to how many persons have actually been misled by Rio's lies. However, if the Board intends to inquire as to how many persons have actually been misled, then Petitioner seeks a continuance pursuant to Rule 56(f) on the ground that evidence exists that cannot be presented at this time.

Specifically, in related litigation, Rio [*20] admitted that it kept no records of complaints by guests about rooms, and, in fact, destroyed those complaints. Nonetheless, Petitioner has discovered approximately 12 persons who have been deceived. After the close of discovery, Rio belatedly identified an employee who had knowledge of Rio's system of reviewing and destroying guest complaints. Petitioner noticed her testimonial deposition, but it was stayed by Registrant's motion for summary judgment. Accordingly, that deposition should proceed if the Board intends to consider any evidence as to the number of people actually deceived.

(Petitioner's cross-motion for summary judgment, pp. 1-5)

Baker's cross-motion for summary judgment

As seen above in the extensive quotations from Baker's cross-motion for summary judgment, petitioner asserts that there are no genuine issues of material fact with respect to his pleaded ground of deceptiveness and that he is entitled to judgment as a matter of law.

In deciding Baker's cross-motion for summary judgment, we must view his evidence in the light most favorable to Rio and must draw all reasonable inferences from underlying facts in favor of Rio.

Decision:

Rio brought [*21] its motion for summary judgment on the basis that its registration may not, as a matter of law, be canceled on the ground of deceptiveness because, *inter alia*, Baker's room at the Rio fits the hospitality industry's understanding of the term "suite." Rio argues that "suite" has become a most amorphous term in modern parlance.

However, Baker has presented a large volume of evidence, including the affidavits of experts from a variety of distinct disciplines, testifying to the fact that Mr. Baker's room cannot be considered to be a "suite." In fact, many general dictionary definitions submitted by Baker, combined with the affidavits of Sheila Cohn, Bruce Baltin, Edward Perkins and William Christopher, demonstrate that the majority of guestrooms rented by Rio may not meet the traditional definition of a hotel suite. In our view, the mere fact that this hotel clearly offers a number of large suites is not sufficient to find for Rio on its motion. At the very least, we find that Baker has raised a genuine issue of material fact as to what constitutes a hotel suite, and whether a sufficient number of Rio's rooms meet the test.

As to the question of whether reasonable travelers are [*22] likely to be misled, this issue is inexorably tied to the prevailing understanding of what constitutes a "suite." We certainly have the views of several third-party travelers who reserved a "suite" at the Rio Suite Hotel & Casino, and just like Mr. Baker, felt misled when they found that their overnight accommodations did not have distinct sleeping and living areas. Accordingly, we find that Baker has raised a genuine issue of material fact as to whether reasonable consumers would be misled by this practice.

Furthermore, in evaluating Rio's motion, we view many of Baker's evidentiary objections alone as contributing further to the existence of issues of fact.

In view of these genuine disputes as to specific issues of fact, Rio's motion fails. Accordingly, Rio's motion for summary judgment is denied.

We turn next to Baker's cross-motion for summary judgment. While Baker makes several compelling arguments in his cross-motion for granting judgment in his favor as a matter of law, most flow directly from the understanding of a "suite" as comprising a distinct sleeping room and living room. However, Rio has submitted dictionaries and glossaries from the hospitality industry as well [*23] as an extensive survey suggesting a trend in the hotel industry of renovating, if not demolishing, the traditional dictionary meaning of the word "suite." n7 Hence, we cannot find, as a matter of law, that no reasonable fact finder could rule in Rio's favor on this issue.

n7 As this dispute proceeds to trial, the parties will want to focus more on the issue of the relevant timing of the claimed deceptiveness. This registration issued in 1993 but the dispute may well be decided a decade later, based in part on evidence that may have been produced at various points in the interim. See *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894 (TTAB 1992).

Additionally, we note that the word "Suite" is just one component of Rio's composite mark. Even if a fact-finder were to find the word "Suite" alone to be misdescriptive of the subject room, the focus in a cancellation proceeding must be on whether the entire mark [RIO SUITE HOTEL & CASINO (stylized)] is misdescriptive of such rooms.

Finally, we note that in considering Baker's motion for summary judgment, even the existence of Rio's evidence to which Baker has objected, [*24] while it may not provide probative support for Rio's own motion, can be considered to create genuine issues of fact precluding judgment in favor of Baker.

Accordingly, the basis for Baker's cross-motion fails, and Baker's cross-motion for summary judgment is denied.

Certainly, where both parties have moved for summary judgment, as is the case herein, the mere fact that they have done so does not establish that there is no genuine issue of material fact, and that judgment should be entered in favor of one of them. See *Scripps Clinic & Research Foundation v. Genentech Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, clarified, on recon., 18 USPQ2d 1896 (Fed. Cir. 1991), and *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385 (TTAB 1994).

Resumption of Trial

In view of our denial of the cross motions, proceedings herein are resumed. Proceedings will be conducted in accordance with the Trademark Rules of Practice, set forth in Title 37, part 2, of the Code of Federal Regulations.

The parties' testimony periods are re-set as indicated below. In each instance, a copy of the transcript of testimony, [*25] together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Testimony period for party in position of plaintiff to close: (opening thirty days prior thereto)	January 24, 2002
Testimony period for party in position of defendant to close: (opening thirty days prior thereto)	March 25, 2002
Rebuttal testimony period to close (opening fifteen days prior thereto)	May 9, 2002

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b).

An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark Law Infringement Actions Summary Judgment General Overview Trademark Law Subject Matter Names General Overview Trademark Law U.S. Trademark Trial & Appeal Board Proceedings Cancellations General Overview

GRAPHIC:

Illustration, no caption

EXHIBIT 3

LEXSEE

Cash Haggadone v. Joseph A. Cavanna

Opposition No. 115,867 to Application No. 75/550,732 filed on September 10, 1998

Trademark Trial and Appeal Board

2002 TTAB LEXIS 581

September 10, 2002, Decided

CORE TERMS: opposer, band, music, web, site, recording, musical, notice, entertainment, deposition, commerce, excerpt, radio, clear and convincing evidence, authenticated, downloaded, hearsay, supporting documentation, trademark, documentation, stations, retail, played, album, songs, tape

DISPOSITION:

[*1]

Decision: The opposition is sustained and registration to applicant is refused.

COUNSEL:

Eric M. Trelz and Ashley Ratcliffe Beumer of Polsinelli, Shalton & Welte for Cash Haggadone.

Joseph A. Cavanna, Pro se.

JUDGES:

Before Quinn, Hohein and Walters, Administrative Trademark Judges.

OPINION BY: WALTERS

OPINION:

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Opinion by Walters, Administrative Trademark Judge:

Cash Haggadone filed his opposition to the application of Joseph A. Cavanna to register the mark ABERDEEN for "entertainment services, namely, live performances by a musical group," in International Class 41. n1

n1 Application Serial No. 75/550,732, filed September 10, 1998, based upon use of the mark in commerce, alleging first use as of February 1, 1997 and first use in commerce as of February 17, 1998.

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's services, so resembles opposer's previously used mark ABERDEEN for "entertainment services, namely, live performances by a musical group" as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

Applicant, in his answer, admitted that the marks are [*2] identical, but denied the remaining salient allegations of the claim.

The Record

The record consists of the pleadings; the file of the involved application; opposer's discovery deposition of applicant, specified responses of applicant to opposer's requests for admissions, and applicant's filing receipt, all made of

record by opposer's notice of reliance; opposer's responses to applicant's interrogatories and document requests, and an excerpt from an Internet web site, n2 all made of record by applicant's notice of reliance; the testimony depositions of Cash Haggadone, opposer, with accompanying exhibits; and the testimony deposition of Joseph Cavanna, with accompanying exhibits. Both parties filed briefs on the case but a hearing was not requested.

n2 Opposer objects to the authenticity of the Internet web site excerpt submitted by applicant and further contends that it is inadmissible on the ground of hearsay. Opposer mistakenly relies on *Raccioppi v. Apogee, Inc.*, 47 USPQ2d 1368 (TTAB 1998,) for the proposition that an Internet web site excerpt must be authenticated by the testimony of the person who downloaded the page. However, *Raccioppi* is distinguished from the situation herein because it pertains to an interlocutory motion, rather than to a document submitted during trial under notice of reliance. The Internet web page is clearly a publicly available document and it contains, on its face, the date and the web site from which it was downloaded. Therefore it is adequately authenticated and we have considered it to be part of the record. We agree with opposer that the information contained therein is hearsay for the truth of that information and we have not considered it for that purpose.

[*3]

Analysis

The parties' marks are identical, as applicant admits, and their entertainment services are identical. Both opposer and applicant have musical groups that provide live performances; they have both produced and sold CDs of their music; and the evidence establishes that they both market their services and their music to the same classes of purchasers through the same channels of trade. For example, they both market their music directly to radio stations and via the Internet and through record stores and live performances, among other methods, to the general public.

In view of the undisputed facts that the marks and services of the parties are identical, it is clear that confusion as to the source of these services is likely.

Thus, the issue remaining to be decided, and the primary issue in this case, is priority of use. Applicant's filing date of September 10, 1998 is, of course, a constructive date of first use for the purpose of this proceeding. In the application, applicant claims first use as of February 1, 1997 and use in commerce as of February 17, 1998. However, applicant seeks, in this proceeding, to establish earlier dates of first use, which he must establish [*4] by clear and convincing evidence, rather than a mere preponderance of the evidence. See *Hydro-Dynamics, Inc. v. George Putnam & Co., Inc.*, 811 F.2d 1470, 1473, 1 USPQ2d 1772, 1773-74 (Fed. Cir. 1987); and *Elder Mfg. Co. v. International Shoe Co.*, 194 F.2d 114, 118, 92 USPQ 330, 332 (CCPA 1952).

We begin with applicant's evidence. Applicant has established, by clear and convincing evidence, that he first used ABERDEEN as a trademark to identify his band in June or July 1996; that for the second half of 1996, applicant was writing music and promoting the band, and the band was practicing and recording; that ABERDEEN finished its first recording in December 1996 and released the recording in January 1997; that the first live performance of applicant's band ABERDEEN was on February 15, 1997 n3; and that applicant's band has continued to perform live regularly, and has released songs and albums on tape, CD and on the Internet, has had its music played on radio, and has sold its CDs over the Internet, at performances, and in retail stores. Applicant's band has performed in New York, New Jersey and Pennsylvania.

n3 Applicant's band's first live performance for which they received monetary compensation was October 16, 1997. Applicant sold CDs at each of its performances regardless of the band's compensation for the performance.

[*5]

Turning to opposer, opposer alleged in his notice of opposition that he has been using the mark ABERDEEN in connection with the same services as applicant since at least October 1997. During trial, opposer sought to establish his use of ABERDEEN in connection with his band since 1994. Applicant contends that opposer has not met his burden of establishing use earlier than October 1997.

Opposer testified that he formed his band, called ABERDEEN, in July or August 1994; that, from August to October 1994, he wrote songs and distributed tapes to coworkers to promote the band; that the band's first live performance was on October 31, 1994, in Overland Park, Kansas, followed by a performance on November 17, 1994, in Kansas City, Missouri. While opposer states that the band was paid for its performances, most of the performances from 1994 to

1997 were house parties, so opposer has no documentation in support of these statements. Opposer stated that the band continued to perform about once a month; that opposer created the band's web site in late 1995; and that, in 1997, the band became successful and began playing in clubs, for which opposer has supporting documentation. Opposer's band [*6] has performed in Kansas, Missouri, Nebraska, Iowa, Illinois and Minnesota, and had its music played by radio stations. Opposer has sold most of the band's music recordings through its website and Amazon.com, with additional sales at performances and retail stores in areas where the band has performed. The band's first professionally produced CD was released in September 1997, and its first full-length album was released September 19, 1999.

Although opposer does not support his testimony about the band's pre-1997 performances with paper documentation such as fliers or receipts, applicant does not present evidence that reasonably challenges opposer's credibility. Further, opposer's explanation as to why he has no supporting documentation is reasonable. Therefore, we find that opposer has established his use of the mark ABERDEEN in connection with a band that has been providing live musical performances since October 1994. n4 Applicant's evidence demonstrates that his band's first live performance, the services identified in the application, was February 15, 1977. Since opposer's first use date significantly precedes applicant's first established date of use, opposer has priority in [*7] this case.

n4 Such use is actual use, not use analogous to trademark use, as suggested by applicant.

Therefore, in view of opposer's priority and the fact that applicant and opposer use identical marks in connection with identical services, a likelihood of confusion exists and registration is denied to applicant.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawLikelihood of ConfusionGeneral OverviewTrademark LawProtection of RightsRegistrationGeneral OverviewTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsGrounds

EXHIBIT 4

LEXSEE

Eredi Chiarini S.R.L. v. Braemore Neckwear Company

Opposition No. 111,483 to Application No. 75/269,411

Filed on April 4, 1997

Trademark Trial and Appeal Board

2002 TTAB LEXIS 95

January 16, 2002, Decided

COUNSEL:

[*1]

Theresa W. Middlebrook and Charles R. Halloran of Christie, Parker & Hale for opposer.

Bruce A. Tassan, Esq. for applicant.

JUDGES:

Before Simms, Walters and Holtzman, Administrative Trademark Judges.

OPINION BY: WALTERS

OPINION:

Opinion by Walters, Administrative Trademark Judge:

Eredi Chiarini S.R.L. filed its opposition to the application of Braemore Neckwear Company to register the mark CHIARINI for "clothing, namely, neckties, ascots, scarves, pocket squares, bow ties, belts, suspenders, braces, cummerbunds, vests, socks, gloves, dress shirts, sports shirts, knit shirts, boxer shorts, briefs, sweaters, pullovers, knit ties, and leather ties" in International Class 25. n1

n1 Application Serial No. 75/269,411, filed April 4, 1997, based upon use of the mark in commerce, alleging dates of first use and first use in commerce as of December 1996.

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and famous marks EREDI CHIARINI and CHIARINI for men's clothing items, including neckties, as to be likely to cause confusion, under Section 2(d) of the Trademark Act. n2

n2 Opposer appears to assert in its notice of opposition a claim under Section 2(a) of the Trademark Act, based on a false suggestion of a connection with opposer's company and its founders. However, this issue is not raised again by opposer, nor has it been tried by the parties. Therefore, we consider any claim under Section 2(a) to have been abandoned by opposer.

[*2]

Applicant, in its answer, denied the salient allegations of the claim; although applicant admitted "it was aware of one retail store in Italy using the mark EREDI CHIARINI and Design."

The Record

The record consists of the pleadings; the file of the involved application; a certified status and title copy of applicant's Registration No. 2,421,357; applicant's responses to opposer's first set of interrogatories; and excerpts from printed publications, all made of record by notices of reliance. The record also includes the testimony depositions by

opposer of Stefano Larese DeSanto, president of UniSource, the U.S. distributor of opposer's neckwear under the ERIDI CHIARINI mark; Massimo Somenzini, a co-owner of Big Ben, opposer's licensee for design and manufacture of its neckwear; and Marco Chiarini, a member of opposer's board of directors, all with accompanying exhibits. Both parties filed briefs on the case n3 but a hearing was not requested.

n3 Because the Board reopened applicant's testimony period, the parties were given time to supplement their briefs. Opposer declined to do so. Applicant's brief entitled "Supplemental Reply Brief" has been considered by the Board as a properly submitted supplement to its originally filed brief. However, the photocopies of trademark registrations in Mexico and Canada, which are attached to this brief, are untimely and have not been considered. Furthermore, registration in Mexico and Canada is not relevant to the issue of registrability before us.

[*3]

Facts and Analysis

As a preliminary matter, we address applicant's assertion for the first time in its "supplemental reply brief" of a *Morehouse* defense. *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969). Applicant is the owner of a prior United States trademark registration, No. 2,421,357, for the CHIARINI mark shown below.

[SEE ILLUSTRATION IN ORIGINAL]

This mark registered on January 16, 2001 and has a filing date, its constructive date of first use, of February 4, 2000. The goods listed in the registration are almost identical to the goods recited in the application in this case. Applicant alleges that opposer had the opportunity to oppose or petition to cancel applicant's registration, but did not do so; that the marks and goods in applicant's registration and its pending application are substantially the same; and that, therefore, opposer cannot be damaged by the issuance of a registration in this case. A *Morehouse* defense is an equitable defense. *O-M Bread, Inc. v. United States Olympic Committee*, 65 F.2d 933, 36 USPQ2d 1041 (Fed. Cir. 1995) [wherein the Federal Circuit discusses [*4] the burden necessary to successfully prove such a defense.] It is an affirmative defense, which applicant did not plead; and it was not tried by the parties by consent, implicit or otherwise. Thus, without addressing the merits of applicant's late claim, we have given applicant's contentions in this regard no consideration.

Turning to the facts of the case before us, the record establishes that opposer is an Italian company that sells men's clothing, labeled EREDI CHIARINI, through its retail men's boutique of the same name in Florence Italy. Since 1993, another Italian company, Big Ben, has been opposer's exclusive licensee for the design, manufacture and worldwide distribution of opposer's EREDI CHIARINI collection of products. Big Ben, in turn, has an agreement with UniSource, a United States company, to be Big Ben's agent for the distribution of neckwear, including opposer's EREDI CHIARINI collection, in, at least, the United States and Canada. Neckwear, specifically, men's ties, is the only EREDI CHIARINI product from opposer available in the United States. n4 UniSource is primarily a marketing company with the main objective of distributing European consumer goods, particularly, [*5] men's and women's clothing and accessories.

n4 There is insufficient evidence in the record to support a finding that opposer uses the term CHIARINI as a mark without EREDI. Thus, we base our decision on consideration of opposer's mark EREDI CHIARINI for neckwear.

In the United States, UniSource sells EREDI CHIARINI collection ties directly to retailers from its New York showroom; it shows the collection at trade shows, where it takes orders from retailers; and it sells the collection through visits to retail clients. Upon receipt of an order through UniSource, Big Ben produces a sample collection of the order, which is sent to the purchaser, either directly or through UniSource. The full order is shipped within four months. Approximately 20% of the ties from the EREDI CHIARINI collection, which consists of designs particular to the collection, are sold to the ultimate consumer under other trademarks. The remaining 80% of EREDI CHIARINI collection ties sold in the United States have the EREDI CHIARINI label sewn directly on the ties. The mark also appears on packaging for ties sold at retail and on shipping cartons to the retailer. The same logo, shown below, is used on all [*6] ties sold under the EREDI CHIARINI mark.

[SEE ILLUSTRATION IN ORIGINAL]

The evidence supporting opposer's use of the EREDI CHIARINI mark on ties includes facts not pertinent to use of the mark for ties in the United States. For example, the evidence includes sales figures and invoices for EREDI CHI-

ARINI ties sold in Canada and for ties sold in the United States from the collection, but not identified by the EREDI CHIARINI mark. n5 We have considered only the evidence pertaining to use of the mark EREDI CHIARINI in the United States. n6

n5 Applicant has objected to opposer's invoice evidence as not the best evidence because it consists of photocopies rather than originals. For the same reason, applicant has objected to evidence excerpted from magazines, and because several of the excerpts are from magazines not for the U.S. market. Opposer's witnesses have testified that these are authentic copies and applicant has not presented any evidence indicating otherwise. Additionally, opposer's witnesses have translated or explained pertinent portions of those invoices not in English. The magazines are similarly acceptable. Those magazines not distributed in the United States are not relevant to establish use of the mark on ties in the United States; however, the excerpts are relevant to opposer's claim that its mark is famous in the United States. Therefore, we have considered this evidence to the extent indicated.

[*7]

n6 While both the documentary evidence and the testimony evidence are, at times, confusing, taking the evidence as a whole we find it sufficient to establish the facts of opposer's use of its EREDI CHIARINI mark on ties in the United States.

Regarding opposer's first use in the United States of its mark EREDI CHIARINI on ties, Mr. DeSanto, UniSource's president, testified that UniSource first presented EREDI CHIARINI ties in January 1995 at a trade show in Florence, Italy, where UniSource made its first sales; and that UniSource first made sales to U.S. companies in January and March 1995, with delivery in July 1995. The evidence shows continuous sales from January 1995 to the present of EREDI CHIARINI-labeled ties to retailers in the United States.

Opposer has alleged, but not established, that its mark is famous. The evidence and testimony concerning sales figures are confidential and, therefore, have not been disclosed in this opinion. Considering only those ties sold in the United States under the EREDI CHIARINI mark, opposer's sales in the United States are not substantial. n7 Opposer has provided no statistics regarding overall men's tie sales in the United States to [*8] form a basis for comparison. Nonetheless, considering the large number of men in the United States who purchase ties, and who presumably purchase more than one tie, opposer's sales figures are relatively small. Other than its own conclusory testimony, opposer has submitted no evidence regarding the significance of the EREDI CHIARINI name to consumers. n8 We cannot conclude that it is a famous mark for ties in the United States.

n7 Although opposer's sales are not substantial, opposer has established valid use of its mark in commerce. Applicant's argument that opposer's use is merely unacceptable token use is not well taken.

n8 The appearance of EREDI CHIARINI ties in a few pictures and endorsements in a couple of magazines distributed in the United States does not establish fame.

Applicant is a Canadian company. Besides evidence, *supra*, of applicant's existing registration, the only additional facts concerning applicant in the record are its admission in its answer that "it was aware of one retail store in Italy using the mark EREDI CHIARINI and design"; and its answers to opposer's first set of interrogatories, which were submitted by opposer's notice of reliance. [*9]

In its answers to interrogatories, applicant stated that it sells only men's neck ties under the mark CHIARINI (No. 2); that applicant first began selling goods under the mark CHIARINI in January 1997 and started shipping goods in May 1997 n9 (No. 3); and that applicant's goods are sold through retail stores (No. 13). Regarding its choice of the CHIARINI mark, applicant, in its responses to these interrogatories, stated that "the term CHIARINI was selected by the applicant because of the sound of the name and also the fact that it is of Italian origin and therefore consistent with the origin of the fabric used for the product" (No. 6); that "on a trip to Florence, Italy, [applicant's principals] visited a menswear boutique by the name of Eredi Chiarini ... to purchase some personal items [and that] this trip would have taken place some time in 1995 and 1996" (No. 10); and that applicant's guidance or inspiration in the creation of the logo format in the application herein was "[a] business card from the Eredi Chiarini menswear boutique" (No. 12).

n9 Applicant is a Canadian company and these dates of use neither specify whether this first use was in the United States nor distinguish between its use in the United States and Canada. Thus, this statement does not establish applicant's first use in the United States of its mark in connection with any of the identified goods.

[*10]

Turning to consider the issues of priority and likelihood of confusion, applicant, in both its original brief and its "supplemental reply brief," argues only procedural matters dealt with *supra* and the issues of use and priority, appearing to concede the issue of likelihood of confusion. We find that the record before us clearly establishes opposer's priority. Whether we consider opposer's agent's first sales to retailers of January 1995 or its first deliveries of July 1995, opposer's dates of use of the mark EREDI CHIARINI on men's ties pre-date the constructive use date available to applicant, the April 4, 1997 filing date of the application in this case. n10

n10 Applicant has not otherwise established dates of use in this proceeding.

Considering the issue of likelihood of confusion, it is clear that opposer's goods, men's ties, are identical to the same goods listed in applicant's identification of goods. Regarding the marks, both marks contain the identical term CHIARINI. The initial term EREDI does not sufficiently distinguish opposer's mark from applicant's mark, CHIARINI. The marks are substantially similar in sound, appearance, connotation and overall commercial [*11] impression. This conclusion is supported by the clear evidence that applicant based its mark on opposer's mark. Consumers are likely to consider men's ties identified by CHIARINI and EREDI CHIARINI to be different styles or collections from the same source.

Thus, we conclude that opposer has established its priority of use of its pleaded mark EREDI CHIARINI on its goods; and that there exists a likelihood of confusion as to source with respect to the parties marks on the goods involved herein.

Decision: The opposition is sustained.

Legal Topics:

For related research and practice materials, see the following legal topics:
Trademark LawProtection of RightsPriorityGeneral OverviewTrademark LawSubject MatterLabels, Packaging & Trade DressTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsGrounds

EXHIBIT 5

LEXSEE



Positive
As of: Mar 19, 2008

Community Financial Services Association of America n1 v. Payday Garden City, L.L.C.

n1 On January 22, 2001, the parties filed a stipulation that due to a clerical mistake, several papers filed in this case, including the petition to cancel, erroneously refer to petitioner using the word "Consumer" instead of the correct word "Community," and that all such references are understood to refer to petitioner.

Cancellation No. 29,232

Trademark Trial and Appeal Board

2003 TTAB LEXIS 33

January 29, 2003, Decided

CORE TERMS: payday, customer, generic, com, registration, deposition, notice, consumer, short-term, printed, pay-check, deferred, interrogatory, genericness, maxoutloan, web, competitor, cash advance, fast, payday-advance, registered, regulators, deposit, site, See Trademark Rule, genus, authentication, presentment, reproduced, relevance

DISPOSITION:

[*1]

Decision: The petition to cancel is granted, and Registration No. 2,243,154 will be cancelled in due course.

COUNSEL:

David J. Hill and Alicia Brown Oliver of Chambliss, Bahner & Stophel, P.C. for Community Financial Services Association of America.

Ken J. Pedersen of Pedersen and Company, PLLC for Payday Garden City, L.L.C.

JUDGES:

Before Seeherman, Hairston and Chapman, Administrative Trademark Judges.

OPINION BY: CHAPMAN

OPINION:

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Opinion by Chapman, Administrative Trademark Judge:

Community Financial Services Association of America (a Maryland corporation) (hereinafter petitioner) has filed a petition to cancel a registration issued on the Principal Register to Payday Garden City, L.L.C. (an Idaho limited liability company) (hereinafter respondent) for the mark PAYDAY ADVANCES for "cash advances without credit checks up to five hundred dollars (\$ 500) for off-the-street customers with their post-dated checks as promissory note[s], and wire funds transfers for such customers" in International Class 36. n2

n2 Registration No. 2,243,154, issued on May 4, 1999 from an application filed on October 2, 1996, originally based on the assertion of a bona fide intention to use the mark in commerce, and ultimately a statement of use was accepted, with a claimed date of first use and first use in commerce of May 15, 1997. Respondent disclaimed the word "advances."

[*2]

Petitioner alleges that "a 'payday advance' is a service provided by Petitioner's members for which the customer pays a flat fee and receives a small amount of cash for a short period of time against the customer's next paycheck. Petitioner's members hold the customer's check for an agreed-upon time period and then deposit the check, or if the customer repays with cash, the check is returned to the customer." (Paragraph 1). Petitioner asserts as grounds for cancellation that it is a national trade association which represents the payday advance industry; that petitioner's members are currently and have been for many years engaged in providing payday advances; that petitioner's members have extensively advertised these services nationwide, and the public recognizes the term "payday advance" as a generic term for petitioner's members' services; that the term is a generic term for the services provided by petitioner's members and by respondent; and that petitioner believes it will be damaged by the involved registration.

In its answer respondent denied the salient allegations of the petition to cancel.

The Record/Evidentiary Objections

Before we describe what the record consists [*3] of in this case, we must address evidentiary objections made by respondent in its brief on the case. First, respondent objects to petitioner's July 27, 2001 testimony of William M. Webster, IV, a member of petitioner's board of directors, current president of petitioner association and chief executive officer of one of petitioner's members, because the testimony (i) was not taken during petitioner's testimony period, and (ii) cannot be submitted by notice of reliance as the deposition is not of an adverse party.

Upon review of the trial date schedule as set and reset in this case, n3 we concur that the testimony was taken outside of any of petitioner's testimony periods. See Trademark Rule 2.121(a). However, respondent's attorney attended the deposition, did not object thereto on the basis of timeliness, and cross-examined the witness. Further, respondent included the Webster testimony in the list of items (exhibit E) in respondent's own notice of reliance. In addition, one of petitioner's attorneys has stated in a declaration (submitted with petitioner's reply brief on the case) that the July 27, 2001 deposition date was ultimately chosen because of scheduling conflicts involving [*4] both parties' attorneys as well as the witness. It would have been the better practice for petitioner to either move to extend its testimony period, or to have obtained a written stipulation from respondent that the untimely taken deposition could be considered of record. But, in any event, in the circumstances herein we find that respondent waived its objection to the timeliness of petitioner's testimony deposition of William M. Webster, IV, and we consider the testimony (with exhibits) to be of record. See Of Counsel Inc. v. Strictly of Counsel Chartered, 21 USPQ2d 1555, footnote 2 (TTAB 1991). See also, TBMP § 718.04.

n3 During this review it came to the Board's attention that one of petitioner's consented motions to extend dates (filed June 8, 2001) had not been granted. That motion is hereby granted.

Further, contrary to respondent's contention, this testimony deposition is that of a party. At the time of his deposition, Mr. Webster was the president of petitioner association. Moreover, a party need not file a notice of reliance on a trial testimony deposition (party or non-party) at all. See Trademark Rule 2.125(c).

Second, respondent objects to petitioner's [*5] September 10, 2001 notice of reliance on numerous printed publications because (i) the relevance thereof has not been set forth, (ii) the publications lack foundation and authentication, and (iii) they constitute hearsay.

While it is true that petitioner did not set forth the relevance of the printed publications, this would generally be a curable defect and respondent should have raised such an objection promptly, preferably by way of motion to strike during the trial. See TBMP § 718.02(b). Respondent waited to object thereto until the filing of its brief on the case. Moreover, we note that the only pleaded ground in this case is that of genericness of the registered mark, and the relevance of the involved printed publications is obvious.

With regard to foundation and authentication of these publications, petitioner provided photocopies of stories from newspapers and other printed publications, each one identified as to source and date (e.g. The Cincinnati Post, January 25, 2000, The St. Louis Post-Dispatch, September 18, 2000). These publications comply with the normal requirements.

Respondent pointed to no specifics for its objections as to authentication and foundation, or [*6] to any specific publication as specifically lacking authenticity.

Respondent's hearsay objection is also not well taken with regard to these printed publications because such materials are admissible and probative for what they show on their face, not for the truth of the matters contained therein. See Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc., 12 USPQ2d 1267, footnote 5 (TTAB 1989), aff'd 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990). See also, TBMP § 708. Here, these publications are admissible to show uses of the phrase "payday advance(s)" within those publications, but not for the truth of the stories themselves.

Respondent's objections to petitioner's notice of reliance on printed publications are overruled. n4

n4 We note that exhibit No. 14 to the Webster deposition is a collection of numerous print and electronic media articles, many of which were also submitted under petitioner's notice of reliance on printed publications. Respondent's attorney cross-examined the witness with regard to these articles.

The record consists of the pleadings; the file of respondent's registration; the testimony, with exhibits, of William [*7] M. Webster, IV; petitioner's notices of reliance on (i) a certified copy of respondent's Registration No. 2,243,154, n5 (ii) respondent's answers to petitioner's interrogatory Nos. 1, 2 and 4, and the documents attached thereto n6, and (iii) photocopies of numerous stories appearing in printed publications; and respondent's notice of reliance on (i) a photocopy of its Registration No. 2,243,154, (ii) petitioner's responses to respondent's first set of interrogatories, (iii) petitioner's supplemental responses to respondent's first set of interrogatories, (iv) petitioner's responses to respondent's document requests, n7 (v) the July 27, 2001 testimony of William M. Webster, IV, and (vi) the August 29, 2001 testimony depositions of Shannon Fontenot and Darrell Fontenot, members of respondent (both Fontenot depositions were taken by petitioner during its testimony period).

n5 Respondent's registration is of record pursuant to Trademark Rule 2.122(b), and neither party needed to submit a notice of reliance on a copy of the registration page.

n6 Normally, documents produced in discovery may not be made of record by way of notice of reliance. See Trademark Rule 2.120(j)(3)(ii). However, inasmuch as respondent provided these documents to petitioner as part of its answers to petitioner's interrogatories, they are received into evidence. Moreover, respondent did not object thereto. See TBMP § 711.

[*8]

n7 With regard to respondent's notice of reliance on petitioner's responses to respondent's document requests and the attached documents, these have also been considered because petitioner did not object thereto and-treated them of record.

Both parties filed briefs on the case, but neither party requested an oral hearing.

The Parties

Petitioner, Community Financial Services Association of America, is "the national trade association for the payday advance industry" (Webster dep., p. 7). According to petitioner, a "payday advance" is a service for which the customer pays a flat fee and receives a cash advance against his next paycheck. (Webster dep., exhibit No. 5.) Petitioner was formed in early 1999 by five founding members -- Advance America, National Cash Advance, Check Into Cash, Check-N-Go and A.C.E. Cash Express; and it currently has 66 members representing approximately 60% of the industry. These members operate a combined total of approximately 6500 stores nationwide. The largest provider of these services in the United States is Advance America with 1414 stores.

Petitioner disseminates educational information to local, state and federal legislators, government [*9] regulators, news media and its own members. Petitioner also produces a document titled "Best Practices for the Payday Advance Industry" n8 requiring that members abide by these practices in order to remain a member in good standing. (One of petitioner's founding members, A.C.E. Cash Express, left the association because they did not follow the "Best Practices" guidelines.) The "Best Practices" document is posted (generally appearing in a size of three feet by five feet) in each member's outlet stores, and it also appears on counter cards and brochures prepared for the customers, as well as being distributed to all state and federal legislators and members of the federal regulatory community. Petitioner also

provides to its members a brochure titled "The Facts About Cash Advance Services" (on which each member can fill in their company logo) to give to each customer at the time of their first transaction. (This document includes the "Best Practices" list, as well as questions and answers about the service in which "payday advance" [without quotation marks] is used to refer to the service. n9

n8 This document specifies, for example, "full disclosure" compliance with all state and federal requirements including disclosing the cost of the transaction to the customer; "compliance" with all applicable laws, including not charging any fee not authorized by law; "truthful advertising"; "encourage consumer responsibility" by implementing procedures to inform customers of the intended use of this service; "right to rescind" giving customers the right to rescind, at no cost, a transaction on or before the close of the following business day; "appropriate collection practices" collecting past due accounts in a professional, fair and lawful manner; "no criminal action" will be threatened or pursued based on non-payment of the account; and "enforcement" by participating in self-policing of the industry through reporting violations of the "Best Practices" to petitioner and by maintaining a toll-free customer hotline in each outlet store.

[*10]

n9 For example, "Q. How often do most people use this service? A. Since a payday advance is a short-term solution to an immediate need, it is not intended for repeated use in carrying an individual from payday to payday. When an immediate need arises, we're here to help. But a payday advance is not a long-term solution for ongoing budget management."; and "Q. Getting a payday advance is such a simple and easy process, why is there so much information in the Customer Agreement? A. The Agreement you read and sign prior to receiving a payday advance is a contract between you and [name of member company, e.g., United Cash Advance]. Our contract complies with all applicable state or federal disclosure requirements. It fully outlines the terms of the payday advance transaction,"

Petitioner attends and provides exhibits at various legislative trade shows and conferences (e.g., National Conference of State Legislators).

Respondent, a limited liability company organized under the laws of Idaho, provides cash advances through a procedure whereby a customer writes a post-dated check and respondent holds the check for two weeks. Respondent also sells money orders, wires money [*11] transfers, and, at one location, respondent cashes payroll checks. (Shannon Fontenot dep., pp. 5-6). Respondent uses the mark PAYDAY ADVANCES in approximately 15 different store locations in Idaho, Colorado, Utah, Kansas and New Mexico, under various names such as Triumph, Checkmate, and Payday. (Respondent's answer to petitioner's interrogatory No. 4.)

Respondent has taken action against a few third-party uses of "payday advances," doing so in 1996 during the pendency of respondent's then application. Some of those third parties ceased use (e.g., Nationwide Finance) and some did not. Respondent did not follow up on those that did not. (Darrell Fontenot dep., pp. 5-7.)

Standing

Respondent contends that petitioner has neither pleaded nor proven standing. We disagree. Petitioner pleaded and proved that it is a national trade association representing the industry which provides short-term small loans without credit checks; that each of its members engages in this service; and that petitioner and its individual members use the words "payday advance(s)" to refer to the service whereby customers receive a short-term loan for a short period of time against the customer's next [*12] paycheck.

The claimed use of a term in a generic sense (or in certain time frames under Section 14, a descriptive sense) is sufficient to impart standing to a competitor in a petition to cancel a registration based on the ground of genericness. Moreover, the Court of Appeals for the Federal Circuit [the successor court to the Court of Customs and Patent Appeals (CCPA)] has discussed the standing of a trade association representing its members in the case of Jewelers Vigilance Committee Inc. v. Ullenberg Corp., 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987). See also, Mars Money Systems v. Coin Acceptors, Inc., 217 USPQ 285 (TTAB 1983); and 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §§ 20:46 and 20:50 (4th ed. 2001).

Petitioner, as a trade association representing members which offer cash advances for paychecks, has shown the requisite standing in this case.

Genericness

Section 14(3) of the Trademark Act, 15 USC § 1064(3), permits cancellation if the "registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered"

The test for [*13] determining whether a designation is generic, as applied to the goods or services in the registration, turns upon how the term is perceived by the relevant public. See Loglan Institute Inc. v. Logical Language Group, Inc., 962 F.2d 1038, 22 USPQ2d 1531 (Fed. Cir. 1992). Determining whether an alleged mark is generic involves a two step analysis: (1) What is the genus of the goods or services in question? and (2) Is the term sought to be registered understood by the relevant public primarily to refer to that genus of goods or services? See H. Marvin Ginn Corporation v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

Evidence of the public's understanding of a particular term may be obtained from any competent source, including direct testimony of consumers, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications. See Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); In re Merrill, Lynch, Pierce, Fenner, and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987); and In re Northland Aluminum Products, Inc., 777 F.2d 1566, 227 USPQ 961 (Fed. Cir. 1985). [*14] The party asserting genericness must prove its claim by a preponderance of the evidence. See Magic Wand Inc. v. RDB, Inc., supra, at 1554.

The key consideration in determining genericness is the relevant public's understanding of the term. That is, do the members of the relevant public understand or use the term sought to be protected to refer to the genus of goods or services in question. In this case, the relevant public consists of persons who currently need or those who might need a short-term advance of small amounts of money.

Respondent contends that the relevant services are "cash advances"; that the ultimate question then becomes "do consumers understand PAYDAY ADVANCES(R) primarily to refer to 'cash advances'"; and that "a 'yes' answer requires that 'payday' be identical to 'cash'" (brief, pp. 12-13). Respondent argues that there is no equivalency between those two words; and that consumers must make a mental leap between "cash" and "payday," making respondent's mark suggestive, not generic.

Petitioner contends that a preponderance of the evidence establishes that "payday advances" has become generic for deferred presentment or cash advance services as identified in [*15] the involved registration; and that respondent has not objected to competitors' uses of the term. Petitioner references and categorizes its evidence showing that the term "payday advance(s)" is widely used by all of the following: (i) respondent's competitors in the industry to describe their services; (ii) the news media to describe the industry occupied by petitioner's members and respondent; (iii) petitioner to describe the services offered by its members; (iv) legislators and regulators in referring to the involved industry; and (v) surveys, polls and third-party reports relating to the involved service industry.

Petitioner's witness, Mr. Webster, testified regarding a group of documents (exhibit No. 21) which are all taken from various companies' web pages. The text of examples of uses of the term "payday advance(s)" from those web pages are reproduced below:

Get \$ 200 Fast

Welcome to the best payday loan site on the Internet. We've been in business since 1994 and have successfully completed over 65,000 payday advance transactions for our satisfied customers
"payadvance.com";

AmeriCash Advance

Payday advances up to \$ 500 overnight

Need cash before payday? [*16]

Secure, fast & easy

No credit checks

No hassles

Our payday advance service can help you with life's little emergencies . . .

Apply for a payday advance online via our secure website . . .

Upon FAST approval notification, your cash advance will be sent to your . . .
"americashadvance.com";

Pay Advances Dollar

\$ mart Checks Cashed Welcome to the Dollar\$ mart web site
. . . Our company specializes in payday advances, check cashing and Western Union wire services.
We take great pride in providing fast, friendly and hassle-free services. This web site provides information about our
company and instructions for applying for payday advances.
"dollarsmartinc.com";

Uca TM Payday Advance

. . . U Cash has subsidiary divisions which operate "traditional" payday advance retail offices in South Carolina and
Texas.
Our recently established online agent-supported payday advance program is rapidly expanding through Georgia and
Texas.
We fund all payday advances from internal resources which is testimony of our financial strength.
"ucashpayday.com";

MaxOutLoan.com

Borrow up to \$ 500!
MaxOutLoan.com can help with a Cash Loan, available overnight, . . . loan you up [*17] to \$ 500 with a MaxOutLoan
Payday Advance.
No credit check is required! . . . Click here now to apply for a new MaxOutLoan . . .
"maxoutloan.com";

ChecKing Check Cashing Centers

Our Centers offer fast, friendly service, while providing a wide range of financial services. ChecKing Check Cashing
Centers will cash any good check for a fee, as well as providing payday advances to the community . . .
"check-king.com";

ezcashnow.com

Access Payday Advance
"Online Cash Advance Center"
. . . Apply for a loan: Click here to apply for a payday advance loan
. . . More Information: Click here to find out more information about a payday loan.
"excashnow.com";

Yourfinancelink.com

Payday Advance Services
Site Links
AmeriCash Advance - Delaware-based firm provides payday advance services
Bell Financial Services - Provides payday advances in the state of California
. . . Cash Now - Provides payday advance services, based in Carlsbad, CA . . .
"yourfinancelink.com"; and

Welcome to ePacific

eP Products
eP PayCard
A Payday Advance Card
. . . Remember, when you get your short-term financing on an eP card, you get . . .
"epacific.com."

Also, there is of record [*18] much general circulation media evidence (exhibit No. 14 to Mr. Webster's testimony,
and the publications submitted under petitioner's notice of reliance) which shows generic uses of "payday advance(s)."
Examples of these stories are reproduced below:

Headline: Advancing into Debt; State Needs Stricter Regulation of Payday Advance Stores
Payday advance stores do exactly what their name implies. They give short-term advances on paychecks -- or "deferred entitlements" -- as they're called - and assess hefty finance charges . . .
Although it's illegal, many shops extend the loan further, thus beginning a cycle of payday advances, with the fees eventually climbing higher than the amount of the initial loan . . .
"Sarasota Herald-Tribune," November 30, 1999;

Headline: In Business
. . . Business Agreement: Pinnacle Business Management and Fast PayCheck Advances has made an agreement with Mail Boxes Etc. to offer payday advances at participating Mail Boxes Etc . . .
"The Tampa Tribune," December 13, 1999;

Headline: Landing a loan shark; Legislature harpooned a voracious species of predatory lender
. . . Loan sharks have found Florida's waters hospitable, but they [*19] don't have quite as much to grin about these days.
Five years after consumer advocates began pleading for help, the Legislature finally decided to hurl a harpoon at one of the most voracious species of predatory lenders -- the title-loan company.
. . . The sharks, of course, still have plenty of prey in Florida. The Legislature did nothing to curb payday advance shops, which charge up to 400 percent for short-term advances on paychecks.
"Sarasota Herald-Tribune," May 16, 2000;

Metro Desk
Supporters call it a last resort that rescues working people in sudden need of cash. Opponents call it a legal loan-sharking operation that entangles poor people in an endless web of debt.
It is the "payday loan" industry, a fast-growing offshoot of the check-cashing business that is exempt from usury laws and provides advance money to its customers at annualized interest rates as high as 911%.
. . . One of the most controversial aspects of the payday business is that it allows customers who cannot pay off their loans to roll them over repeatedly, . . .
Payday advance companies deny that rollovers are common . . .
"Los Angeles Times," May 17, 2000;

Headline: The Pen Is Mightier; [*20] After Signing Legislation to Put an End to Consumer-Gouging by Car-Title Lenders, Gov. Jeb Bush Rightly Pointed Out the Need for Regulation of the Payday-Advance Business
. . . Counties and cities throughout Florida began imposing their own restrictions, . . .
Nothing in existing law appears to prohibit a local government's taking similar action against payday-advancers. That's why some already have jumped into action. The Longwood City Commission may consider as early as June 5 a proposed ordinance that would slap a 30 percent annual rate on payday advances but allow a one-time \$ 5 fee.
. . . Mr. Bush should send an unmistakable signal that he's in on reforming the payday-advance business from the start . . .
"The Orlando Sentinel," May 19, 2000;

CNN Financial Network July 7, 2000: Payday Loans: fast bucks
. . . Smith is a lawyer who has studied the payday-advance industry and is fighting it . . .
Other lawyers and state regulators have also taken a stand. Smith and others believe payday-advance companies will continue to proliferate . . . ;

Headline: Payday Loans Offer Option, But at a Cost
. . . Typically, customers who take out a payday loan - also known [*21] as deferred deposit or payday advance - must prove they have a job and a bank checking account . . .

"The Idaho Statesman," August 20, 2000;

Headline: Cashing In on Cash Advances

. . . Supporters call payday advances a lifeline for countless Americans . . .

Critics counter that payday advances are no bargain at all, but rather exorbitant loans that take advantage of those struggling to make ends meet.

. . . The only legislator to vote against the 1999 payday advance law, State Rep. Jo Carson, . . .

"The Arkansas Democrat-Gazette," July 16, 2000;

Headline: Money Matters

"Payday Advances" Are Step Backward

. . . Every place I have gone in recent months - with the possible exception of the commute to the office - I was offered a "payday advance," as if this is something I need.

. . . If you haven't brushed up against the payday advance phenomenon, it may be because you live in a state such as Massachusetts, where laws are considered "unfavorable" by the rapidly expanding payday advance industry

Payday advances are sometimes known by the more demure name "deferred deposits," and the practice is popular with cash-strapped consumers. . . . The state of New York, [*22] for example, recently issued a warning against payday advances, even though there were no firms known to be in the state offering them Payday advances are ultra-small loans, and they are increasingly popular because most banks won't loan less than \$ 1000

"The Boston Globe," May 7, 2000; and

Headline: Payday loans draw a hefty price, heavy criticism

. . . The cost of that two-week payday advance loan is equivalent to roughly 400 annual percent percent-age rate, but

"Crain's Detroit Business," May 22, 2000.

While we acknowledge that much of the evidence is dated 1999 or later, Mr. Webster testified that a critic of the industry, the Consumer Federation of America, has used "payday advances" to describe this service since at least one year prior to the formation of petitioner in 1999. (Dep., p. 35.) Moreover, it is clear in the record that this particular industry has expanded significantly in a very short time frame, thus accounting for the amount of media coverage in the recent past.

We note that the record includes numerous other uses of "payday advance(s)" not only by petitioner in its trade publications [e.g., petitioner's article titled "Payday [*23] Advance Services: The 'Financial Taxi' of America's Middle-Class" - (Webster dep., p. 34, and exhibit No. 16)], but also by others (e.g., in surveys and reports, and by legislators and regulators), all referring generically to the "payday advance" industry. Excerpts showing these uses are not reproduced here because our focus is on the evidence showing generic uses of the term which are available to and may be seen by the relevant purchasing public. See Magic Wand Inc. v. RDB Inc., *supra*. Petitioner submitted ample evidence establishing the meaning of the term "payday advances" to the consumer.

Respondent has done nothing to refute this evidence. In fact, in its cross-examination of petitioner's witness William M. Webster, IV, respondent did not question the witness with specific regard to the publication and website generic uses directed to the consumer. Rather, respondent simply argues that one cannot tell from the words alone what the services are because the word "payday" is not the word "cash." However, we must consider not whether "payday" is the equivalent of "cash," but whether the term PAYDAY ADVANCES would be viewed as an alternative generic term for [*24] CASH ADVANCES. The evidence of record, some of which has been set forth in this opinion, persuades us that it would be viewed in this manner.

To the extent respondent contends that the services it offers are known as "cash advances" and therefore "payday advances" cannot be generic for such services, such an argument is unpersuasive. There can be multiple generic names for a single product or service. That is, any product or service may have many generic designations; and all of the generic names for the product or service belong in the public domain. See 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 12:9 (4th ed. 2001). It appears that the involved services may be called "deferred pre-shipment," "payday loans," "payday advances," "paycheck loans" and the like, n10 but the record clearly establishes that the term "payday advances" is one generic name for these services.

n10 In explaining the use of different generic names for the same service, Mr. Webster testified that in certain states a payday advance is referred to as a payday loan or deferred deposit or deferred presentment "because of the [state] regulatory structure." (Dep., p. 59.)

Importantly, [*25] the record also establishes that with only a few exceptions, respondent has not taken action against competitors' uses of the term "payday advances." In 1996 respondent sent a few cease and desist letters, including one to Nationwide Finance located in Garden City, Idaho (respondent's business address is in Garden City, Idaho) regarding use of the term "payday advances." Some of the entities contacted (including Nationwide Finance) agreed to cease use, but several did not so agree, and respondent took no further action. Respondent's attempts to enforce rights in its mark ended around 1996, and no action has ever been taken against petitioner. (Darrell Fontenot deposition.)

Based on this record, we find that the term "payday advances" names the services which are identified in respondent's registration, and are offered to the public by respondent as well as by the members of petitioner association. We also find that the relevant public understands the term to refer to the involved services. That is, the primary significance to the relevant public of the term "payday advances," used in connection with this type of cash advance, is as the name of the service itself. The members of [*26] the relevant public, i.e., those people who are or may be in need of such short-term loans, would understand the term to refer to the service, and not to the source of the service.

We hold that the term "payday advances" is generic for the services identified in respondent's registration.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark Law Federal Unfair Competition Law General Overview Trademark Law Protection of Rights General Overview Trademark Law Subject Matter Names Generic Names Tests

EXHIBIT 6

LEXSEE

Corning Incorporated v. Vitrocrisa S.A. de C.V. Company

Opposition No. 91119107 to application Serial No. 75590697 filed on November 13, 1998.

Trademark Trial and Appeal Board

2005 TTAB LEXIS 135

February 2, 2005, Hearing

March 14, 2005, Mailed

CORE TERMS: opposer, glass, registration, notice, bakeware, fame, objected, famous, tube, trademark, dictionary, baking, ovenware, pyr, consumer, deposition, glassware, renewal, plates, trays, dish, cups, third-party, industrial, casseroles, register, tubing, heat, judicial notice, excerpt

DISPOSITION:

[*1]

Decision: The opposition is sustained. As noted in footnote 1, should applicant ultimately prevail in this proceeding, the application will be remanded to the Examining Attorney to determine whether the Mexican registration upon which it is based has been renewed.

COUNSEL:

Mark D. Robins of Nixon Peabody LLP for Corning Incorporated.

James E. Shlesinger and Daniel T. Earle of Shlesinger, Arkwright & Garvey, LLP for Vitrocrisa S.A. de C.V. Company.

JUDGES:

Before Seeherman, Quinn and Walters, Administrative Trademark Judges.

OPINION BY: SEEHERMAN

OPINION:

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Opinion by Seeherman, Administrative Trademark Judge:

Corning Incorporated has opposed the application of Vitrocrisa S.A. de C.V., a Mexican corporation, to register PYR-O-REY for "ovenware, namely glass casseroles and bakeware. n1 As grounds for opposition, opposer has alleged that since prior to any date of use upon which applicant can rely, opposer has used PYREX and related terms as trademarks for glass baking ware and related goods; that opposer owns, inter alia, registrations for PYREX, including Registration No. 153430 for glass baking ware and Registration No. 317096 [*2] for glass baking ware and covers; that PYREX has become a very distinctive and famous mark; that as early as 1984, when opposer first learned of applicant's intent to use PYR-O-REY, opposer has consistently advised applicant that it viewed PYR-O-REY as infringing PYREX in the United States and Canada; that in June 1984 applicant agreed not to sell PYR-O-REY products in the United States and Canada; that in June 1995, after receiving objections from opposer, applicant informed opposer that it would not export PYR-O-REY products to the United States and Canada; that applicant's mark so resembles opposer's previ-

ously used and registered mark so as to be likely, when applied to the goods identified in applicant's application, to cause confusion, mistake or deception; that applicant made its application in bad faith and in an attempt to cause confusion and trade off of the fame and good will associated with opposer's mark; and that applicant's use of PYR-O-REY will cause dilution of opposer's mark.

n1 Application Serial No. 75590697, filed November 13, 1998, pursuant to Section 44(e) of the Trademark Act, based on a Mexican registration which issued on October 3, 1958. It is noted that this registration expired on November 17, 2003. Therefore, should applicant ultimately be successful in this proceeding, the application will be remanded to the Examining Attorney, pursuant to Trademark Rule 2.131, to determine whether the foreign registration has been renewed. See TMEP § 1004.01(a)(3d ed., rev. May 2003).

[*3]

Applicant has admitted that there was correspondence between Crisa, a division of Vitro S.A., and Corning Consumer Products, Co. in 1995 in reference to the mark PYR-O-REY, and has admitted that it is not using PYR-O-REY in interstate commerce, and otherwise has denied the salient allegations in the notice of opposition.

The record includes the pleadings; the file of the opposed application; the testimony deposition, with exhibits, of opposer's witness, Paul Burke, and the deposition on written questions of applicant's witness, Luis Miranda Bonilla. Opposer has submitted, under notice of reliance, applicant's responses to opposer's interrogatories and requests for admission, and certain printed publications, and applicant has submitted, also under notice of reliance, copies of third-party registrations taken from the official records of the U.S. Patent and Trademark Office, and certain dictionary definitions.

The proceeding has been fully briefed, and both parties attended an oral hearing before the Board. n2

n2 Applicant's request for an extension of time to file its brief is granted.

Both parties have raised objections to certain of the other's exhibits and testimony [*4] in connection therewith. Opposer has objected to the questions (and therefore to the answers) propounded to applicant's witness in his testimony deposition taken on written questions that refer to information concerning markets outside of the United States. The basis for this objection is that, during discovery, applicant refused to answer any questions regarding any markets outside of the United States. Applicant does not deny that it refused to provide information concerning markets outside the United States, but states that the information presented in the witness's testimony was simply submitted as background information. As for information concerning Canada, applicant states that it submitted this testimony to rebut testimony submitted by opposer.

We agree with applicant that much of its witness's testimony referring to activities in Mexico is background information, for example, in response to the question as to when applicant first began using PYR-O-REY, the witness stated that the company that began using the mark had previously produced ovenware in Mexico. Moreover, applicant did provide some information in discovery regarding its activities in Mexico, for example, that [*5] PYR-O-REY products are manufactured in Mexico, and that the mark was created in Mexico. In addition, some of the testimony provided by applicant's witness was not the subject matter of a discovery request, and therefore applicant cannot be accused of not providing such information (e.g., the countries where PYR-O-REY is registered). However, with respect to specific information as to applicant's marketing plans in other countries, we agree with opposer that, because applicant refused to provide such information during discovery, it should not be considered. As for testimony regarding applicant's application in Canada, this information was initially made of record by opposer during the testimony deposition of its witness, and such information was also the subject matter of some of opposer's cross questions. Accordingly, we have considered the testimony relating to applicant's attempts to register its mark in Canada.

Opposer has also objected to certain questions (or more particularly, the responses to the questions,) which opposer characterizes as hearsay. This objection is overruled. It is clear that the witness was testifying as to his own understanding of what occurred, based on [*6] his knowledge of the company's activities. For the same reason, we overrule opposer's objections that claim the questions call for speculation. In fact, some of the questions to which opposer has objected actually include the phrases, "based on your understanding" (Question No. 30) and "to the best of your knowledge" (Question No. 34).

Opposer has also objected to the third-party registrations referenced in applicant's notice of reliance, stating that copies of such registrations were not attached to the notice. In its brief, applicant asserted that it did attach such copies, but on the possibility that, through inadvertence, copies were not provided to opposer, it furnished them to opposer with

the service copy of its brief. At the oral hearing, opposer stated that it was maintaining its objection only if applicant had failed to submit copies of the registrations with its notice of reliance as filed with the Board. Because Board records show that the exhibits were filed with the notice of reliance, this objection is overruled.

Applicant has objected to Exhibit Nos. 10, 11 and 12 to the deposition of opposer's witness. Applicant also objects to these same exhibits, marked as Exhibits [*7] F, G and H, which were filed with the notice of reliance, as well as Exhibits I through L, also submitted under notice of reliance. These documents are all articles taken from the NEXIS database, and therefore qualify as printed publications under Trademark Rule 2.122(e). However, it is clear from applicant's comments that it is not asserting that such documents are inappropriate for submission by notice of reliance, but is criticizing their probative value because they do not provide current information, and because they are hearsay. In general, articles taken from periodicals are not admissible for the truth of the statements contained therein, but only for the fact that the articles appeared. With respect to the survey results reported in these articles, opposer has argued that, because the surveys were not conducted for the purposes of litigation, they have sufficient indicia of reliability to qualify for admission under Fed. R. Evid. 807 and 803(17). However, it is not the surveys themselves which opposer seeks to introduce, but articles reporting the results of the surveys. Therefore, we have not considered [*8] the articles as establishing the truth of the statements made therein, except insofar as those statements were confirmed by opposer's witness. n3 As for the timeliness of the articles, and their consequent probative value, we have, needless to say, taken into consideration the dates the articles appeared in reaching our decision.

n3 To the extent the opposer's witness was aware of survey results from his knowledge of opposer's business records, that knowledge is not considered hearsay even if he was not aware of the methodology of the surveys.

Applicant has also objected to the exhibits that opposer submitted for the first time with its brief, pointing out that they were not properly made of record. These exhibits consist, for the most part, of excerpts from various dictionaries of the page on which "Pyrex" appears. Applicant is correct that these exhibits are not of record. However, the Board may take judicial notice of dictionary definitions, and in this case we elect to do so. University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). We do not, however, [*9] take judicial notice of excerpts from volumes that do not appear to be dictionaries or encyclopedias, specifically "The Chicago Manual of Style."

Opposer, either itself, its subsidiary Corning Consumer Products Company, or its predecessors-in-interest, has used the mark PYREX since 1915 when the glass, which can withstand a certain level of heat, was created. The mark is used on a variety of glass products, including oven bakeware and measuring cups. The goods are sold throughout the United States, in mass merchandising stores such as Wal-Mart and Target, specialty kitchen shops, and factory outlet stores. In 1996 sales of PYREX products were in the range of \$ 169 million, and opposer spent over \$ 800,000 on television advertising. In 1995 its sales were approximately \$ 125 million, and opposer had a \$ 3 million print and advertising budget. Opposer has advertised in such magazines as "House Beautiful," "Redbook," "Family Circle" and "Women's Day." Opposer also distributes a housewares catalog featuring its PYREX products to the buyers at retail merchants, and promotes its goods at trade shows. It also provides displays and fixtures to retailers which are used to promote PYREX products [*10] to retail customers. Opposer's witness testified, based on his knowledge of both internal and external surveys, that in 1994-95 PYREX had a 92% awareness, that is, that 92% of the people surveyed had heard of the brand.

Applicant produces and sells products for the consumer, food service, institutional and industrial markets. The products include glassware, including tableware -- dinnerware such as table plates, bowls and cups; drinkware, such as drinking glasses and cups; ovenware such as heat-resistant glass plates, bowls and casseroles; barware and stemware, including wine cups and ice trays; blender jars and coffee carafes; microwave oven plates; ornamental glassware such as glass candlesticks, figurines and oil lamps made of glass; cutlery, including knives, forks and spoons; and disposable products, including plastic cups, plates and flatware. In the United States applicant sells glass tableware, including drinking glasses, bakeware, dinnerware, coffee carafes, stemware and microwave trays, for the retail, food service, premium, industrial, floral, candle and OEM markets, although none of these products are sold under the mark PYR-O-REY.

The mark PYR-O-REY was first used [*11] for ovenware in 1958 by applicant's predecessor-in-interest, and in 1959 by applicant itself. The products were sold both in Mexico and in some European countries. The mark was chosen to indicate that the glassware was produced in Monterrey, in the same manner as other marks, such as CEL-O-REY, CERREY and PANEL-REY, of companies located in Monterrey. Applicant has never used the mark PYR-O-REY on products sold in the United States.

There has been some history between the parties. First, Applicant's witness acknowledged that he was aware that opposer sold products bearing the PYREX mark in the United States since the 1930's. In 1983, opposer objected to a Canadian distributor's soliciting sales for PYR-O-REY products in Canada; and in 1985 Corning Glass Works filed an opposition to the application of Vitrocrista Crimesa S.A., to register PYR-O-REY in Canada. That application was subsequently abandoned. There is some dispute as to why it was abandoned, with opposer stating it was the result of its protest, and applicant stating that it was the result of a marketing department decision that it was not convenient at that time to sell ovenware in that market under any of applicant's marks. [*12]

In the early 1990's opposer and applicant created a joint venture in which they set up two separate entities. The U.S. entity, Corning Vitro, was controlled 51% by opposer, and the Mexican company, Vitro Corning, was controlled 51% by applicant. The purpose of this joint venture was to bring to opposer glass lines, such as drinkware and vases, that it did not have, while applicant was able to sell Corning ware in Mexico. Corning Vitro was licensed by opposer to use the mark PYREX in the United States, but PYR-O-REY was not allowed to be used in the United States.

The joint venture was in existence for approximately one and one half years, and after it was dissolved the parties continued to interact to deal with marketplace issues arising from the dissolution. In 1995 there was some correspondence between them regarding the mark PYR-O-REY, in which opposer made it clear that it considered the use of PYR-O-REY in the United States as likely to cause confusion and infringe opposer's trademark. On the other hand, applicant stated in correspondence that, although it had "unilaterally decided," for market reasons, not to export products under the mark PYR-O-REY to the United States, it [*13] was reserving the right to change that decision should market conditions warrant.

Opposer has made of record status and title copies of four registrations for the mark PYREX for "glass"; n4 "glass baking ware"; n5 and the "following articles made from glass-namely, lenses and glasses for illuminating, signaling, and condensing apparatus; polished disks, reflector blanks, cylinders, pipes, tubes, tubing, and fillings therefore; gauge glass tubes and gauge protector glasses; dishes, bowls, tubs, plates, and sheets; distilling, condenser, and absorbing apparatus for use in various industrial arts, and parts therefor; beakers, flasks, funnels, stop-cocks, cascade dishes, drying trays, retorts, reagent bottles, ampoules, bulbs, food and pharmaceutical containers, pipettes, table and baking ware and covers therefor; utility dishes, trays, tubing for gaseous discharge tubes"; n6 and for the mark PYREX PORTABLES for "bakeware with a heating/cooling pad sold as a unit." n7

n4 Registration No. 115846, issued March 13, 1917 (with a filing date of June 22, 1915); republished under Section 12(c); Section 8 & 15 affidavits accepted and acknowledged; 4th renewal.

n5 Registration No. 153430, issued March 21, 1922 (with a filing date of October 6, 1921); republished under Section 12(c); Section 8 & 15 affidavits accepted and acknowledged; 4th renewal. (At the time the USPTO prepared the status and title copy during opposer's testimony period, the fourth renewal had not yet been effected by the Office. In accordance with Board policy, we have checked the updated Office records to ascertain that the registration has been renewed and that the registration is still in effect. See Time Warner Entertainment Co. v. Jones, 65 USPQ2d 1650 (TTAB 2002); TBMP § 704.03(b)(1)(A) (2d ed. rev. 2004).

[*14]

n6 Registration No. 317,096, issued September 11, 1934; republished under Section 12(c); Section 8 & 15 affidavits accepted and acknowledged; 4th renewal. (At the time the USPTO prepared the status and title copy during opposer's testimony period, the registration was not due for a fourth renewal. In accordance with Board policy, as set forth in footnote 5, we have checked the updated Office records to ascertain that the registration has been renewed and that the registration is still in effect.

n7 Registration No. 2032882, issued January 21, 1997; Section 8 & 15 affidavits accepted and acknowledged. Again, at the time, during opposer's testimony period, that the Office prepared the status and title copy of the registration, the Section 8 affidavit was not yet due. Accordingly, we have confirmed from Office records that the Section 8 affidavit was accepted and the Section 15 affidavit was received.

Opposer also introduced, through the testimony of its witness, Paul Burke, copies of additional registrations for PYREX for glass products for scientific and electrical usages. n8 Mr. Burke testified to opposer's ownership of these registrations, and to their current [*15] status. n9 In view of these various registrations, priority is not in issue. See King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, the re-

cord shows that opposer has been using the mark PYREX for glass articles, including bakeware and ovenware, for many decades prior to the filing date of applicant's application.

n8 Registration No. 195029 for condenser lenses, light filters, navy sight glasses and vacuum pumps for laboratory use; Registration No. 311001 for tubing for electrical fuses; No. 417987 for glass wool, namely fibres and filaments of glass; Registration NO. 182301 for beakers, flasks, test tubes, extraction tubes and apparatus, ignition tubes, centrifuge tubes, evaporating dishes, distilling apparatus, condensers, volumetric ware, funnels, stopcocks, tubing, tube joints, and fixtures, cascade dishes, desiccators, drying trays, covers, retorts, slight glasses and gauges, graduated ware, stoppers, graduated seals for uniting glass parts of different composition, and sheet glass for laboratory work.

n9 Although opposer specifically referred to only Registrations Nos. 153430 and 317096 in its notice of opposition, because the notice of opposition indicated that opposer owned additional registrations, and because applicant has not objected to their consideration, we deem the pleadings to be amended pursuant to Rule 15(b) of the Federal Rules of Civil Procedure to include the additional registrations.

[*16]

This brings us to a consideration of the issue of likelihood of confusion. Our determination 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 & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

We begin with the factor of fame since fame of the prior mark plays a dominant role in cases featuring a famous or strong mark. Kenner Parker Toys Inc. v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). As a mark's fame increases, the Act's tolerance for similarities in competing marks falls. Id., 22 USPQ2d at 1456. Applicant has acknowledged that opposer's mark PYREX is a strong mark and "may be considered to be well known." Brief, p. 22. We agree with applicant that opposer's mark is strong, and further, we find that it is a famous mark. The extraordinary amount of time that it has been used for cookware products, the amount of sales and the expenditures on advertising, the strong brand awareness, and household penetration, [*17] all go to demonstrate the fame of the mark. n10 Moreover, the dictionary definitions of which we take judicial notice identify PYREX as a trademark, e.g., "a trademark applied to a variety of glasses and glassware usually resistant to heat, chemicals, or electricity; hence [*sometimes not cap.*], glass or glassware bearing this trade-mark." n11 See also, "Pyrex: a trademark for any of various types of heat-resistant and chemical-resistant glass." n12 When a trademark attains dictionary recognition as a part of the language, we take it to be reasonably famous. B.V.D. Licensing v. Body Action Design, 846 F.2d 727, 6 USPQ2d 1719, 1720 (Fed. Cir. 1988). This duPont factor strongly favors opposer.

n10 Much of the information that demonstrates the fame of opposer's mark is found in Exhibit 18, which was filed under seal. Accordingly, we have not set forth these figures in our opinion.

n11 Webster's New International Dictionary of the English Language, 2d ed. unabridged.

n12 The American Heritage Dictionary of the English Language, (c) 1973.

With respect to the goods, they are, in part, identical. Applicant has identified its goods [*18] as glass casseroles and bakeware; opposer's Registration No. 153430 is for "glass baking ware" and its Registration No. 317096 includes "baking ware and covers therefor". Because the goods are legally identical, they must be presumed to travel in the same channels of trade to the same classes of customers. In this case, opposer's evidence shows that the trade channels would include mass merchandisers, specialty kitchen stores and outlet stores, and the customers would include virtually anyone who cooks. The factors of the similarity of the goods and of the trade channels favor opposer.

There is some argument between the parties as to the factor of the conditions under which and buyers to whom sales are made. There is no evidence as to the cost for either party's products, but it is common knowledge that glass casseroles and bakeware can be relatively inexpensive items. The fact that opposer sells its products through mass merchandisers such as K-Mart and Target supports this view. Applicant acknowledges that "the price of Applicant's and Opposer's goods are not extreme." Brief, p. 20. These goods can also be purchased by anyone who cooks, which would include both serious cooks and [*19] those who simply need a container in which to heat up food in a microwave oven. The latter group is not likely to exercise a great deal of care in the selection of cooking products, or to research such products before purchasing them. Rather, such a consumer may simply see a glass baking dish during a trip to a supermarket or retail store, realize that he or she has a use for it, and purchase it without giving it a great deal of thought or

examination. In this respect, at least some of the sales of the identified goods fall into the category of impulse purchasing, and this factor therefore favors opposer.

We turn next to a consideration of the marks, keeping in mind that, when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Although, as applicant has pointed out, there are specific differences between the marks, "a purchaser is less likely to *perceive* differences from a famous mark." B.V.D. Licensing v. Body Action Design, *supra*, 846 F.2d at 730, 6 USPQ2d at 1722 [*20] (Nies, J., dissenting)(emphasis in original), and quoted with approval in Kenner Parker, *supra*. Both marks begin with the letters PYR, and because of the fame of opposer's PYREX mark, many consumers are likely to see these beginning letters and not look beyond them. Although we acknowledge that there are differences in the appearance and pronunciation of the marks, these differences fade in light of the fame of opposer's mark, the legally identical goods, and the fact that the goods may be purchased without care or deliberation. Moreover, in some respects the connotation of the marks can be considered the same. Applicant has pointed out that the term PYREX can be seen as being composed of the Greek word for "fire" and the Latin word for "king," and the etymology of PYREX given in Webster's dictionary, *supra*, ("Gr. *pyr* fire + L. *rex* king") supports this view. The literal translation of applicant's mark, as applicant has stated in its response to Interrogatory No. 2, is "Fire of the King." Although we believe that opposer's mark has become so famous that it will be regarded solely as the trademark PYREX, without any other meaning, to the extent that consumers [*21] do engage in analyzing the marks they will conclude that they have the same meaning.

We have taken into consideration applicant's argument that there are numerous third-party registrations of marks beginning with the letters "PYR." These registrations do not, of course, show that the marks are in use and, indeed, we note that many of them have expired or have been cancelled. Most are also for goods very different from glass bakeware. The fact that these "PYR" marks were adopted for goods such as convection furnaces, heaters and industrial burners indicates that the marks may have been adopted because they suggest the dictionary meaning of the prefix "PYRO-" as "fire or heat." n13 However, even if we accept that there is some suggestive connotation to the PYR portion of opposer's mark PYREX, the mark in its entirety has achieved such fame that it is entitled to a broad scope of protection. In this respect, the present situation is different from those in the cases cited by applicant in support of its argument that "in cases where the common elements of the marks include highly suggestive terms, the Board has taken particular note of the dissimilarity and the overall commercial impression [*22] of the marks, in finding no likelihood of confusion. . . ." Brief, p. 18. In the three cases cited by applicant -- Hard Rock Cafe Licensing Corp. v. Elsea, 48 USPQ2d 1400 (TTAB 1998); General Mills Inc. v. Health Valley Foods, 24 USPQ2d 1270 (TTAB 1992); and Red Carpet Corp. v. Johnstown American Enterprises Inc., 7 USPQ2d 1404 (TTAB 1998)-opposer was not able to establish that it had a famous mark. Moreover, in the General Mills case, there was evidence of numerous third-party uses of the element FIBER which was common to both marks, and a finding that FIBER is a generic term in the food industry.

n13 Webster's, *supra*.

The sixth duPont factor is the number and nature of similar marks in use on similar goods. Applicant has acknowledged that there is no evidence of use of any such marks, and therefore this factor favors opposer, in that it provides further support that opposer's mark is a strong mark.

The factors regarding actual confusion or the lack thereof must be considered neutral in view of the fact that applicant has not used its mark in the United States.

With one exception, we will mention only briefly the remaining [*23] duPont factors. With respect to the factor of the variety of goods on which opposer uses its mark, although applicant asserts that the mark is used only on goods related to the glass industry, we find that the mark is used on a variety of cookware and kitchen items and that, because these are the same items for which applicant seeks to register its mark, this factor must either be viewed as favoring opposer or being neutral; it does not favor applicant. The factor of the extent of potential confusion favors opposer, since the parties' goods are, in part, identical and because bakeware is an item bought by millions of consumers.

The prior history between the parties falls under both the factor of market interface and of "any other established fact." Applicant has admittedly known of opposer's use of PYREX since the 1930s. Applicant has also had a business relationship with opposer, and has been aware of opposer's view that applicant's use of PYR-O-REY on glass products in the United States is likely to cause confusion. Despite this, applicant decided to apply for registration of this mark in the United States. Although it is our view, after considering the various duPont factors, [*24] that confusion is likely, to the extent that any doubt exists, this history reinforces that we should apply the well-established principle that doubt

must be resolved in favor of opposer, as the registrant and prior user of the famous PYREX mark. See In re Pneumatiques, Caoutchouc Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729 (CCPA 1973).

In view of our finding that opposer has established that it is entitled to judgment on the ground of likelihood of confusion, we elect not to consider opposer's additional ground of dilution.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawLikelihood of ConfusionConsumer ConfusionCircuit Court FactorsFederal Circuit CourtTrademark LawLikelihood of ConfusionSimilarityAppearance, Meaning & SoundGeneral OverviewTrademark LawProtection of RightsGeneral Overview

EXHIBIT 7



Cited

As of: Mar 19, 2008

Danone Asia Pte. Ltd. and Amoy Food, Ltd., Plaintiffs, - against - Happy Dragon Wholesale, Inc. and Jimmy Wang, Defendants.

CV-05-1611 (CPS)

UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF NEW YORK

2006 U.S. Dist. LEXIS 22484

March 29, 2006, Decided

CORE TERMS: counterfeit, soy sauce, food, summary judgment, Lanham Act, trademark, container, registration, registered, attorney fees, designation, infringement, inquest, registered trademarks, offering, notice, willful, statutory damages, package, common law, trademark infringement, trade dress, counterfeiting, willfulness, deposition, injunction, registrant, partial, unfair, patents

COUNSEL: [*1] For Danone Asia Pte. Ltd., Amoy Food, Ltd., Plaintiffs: Daniel H. Weiner, Natasha Nate Reed, Hughes Hubbard & Reed LLP, New York, NY; Julius Rabinowitz, Hughes Hubbard & Reed, New York, NY.

For Happy Dragon Wholesale, Inc., Jimmy Wang, Defendants: Anne Seelig, Wu & Kao, P.L.L.C., New York, NY US; Harold W. Suckenic, Wu & Kao, PLLC, New York, NY.

JUDGES: Charles P. Sifton, United States District Judge.

OPINION BY: Charles P. Sifton

OPINION

MEMORANDUM OPINION AND ORDER

SIFTON, Senior Judge.

Plaintiffs Danone Asia Pte. Ltd. ("Danone") and Amoy Food Ltd. ("Amoy Food") bring this trademark action against defendants Happy Dragon Wholesale, Inc. ("Happy Dragon") and Jimmy Wang ("Wang"). Specific-

cally, plaintiffs allege the following claims against the defendants: (1) infringement of plaintiffs' registered trademarks in violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114 (Count I); (2) counterfeiting of plaintiffs' registered trademarks in violation of Section 34(d) of the Lanham Act, 15 U.S.C. § 1116(d) (Count II); (3) false designation of origin in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) [*2] (Count III); (4) trademark infringement and unfair competition under common law (Count IV); (5) dilution of the distinctive quality of plaintiffs' marks under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c) (Count V); and (6) dilution under New York state law. Plaintiffs' claims arise out of defendants' sale of counterfeit soy sauce bearing trademarks that are unauthorized copies of plaintiffs' trademarks.

Plaintiffs move for partial summary judgment ¹ pursuant to Rule 56 of the Federal Rules of Civil Procedure. For the reasons set forth below, the motion for summary judgment is granted in part and denied in part.

1 Plaintiffs do not move for summary judgment on the dilution claims. They have, however, undertaken to discontinue those claims if they prevail on this motion.

BACKGROUND

The following facts are taken from the parties' depositions, affidavits, and exhibits and plaintiff's Local Rule 56.1 statement of undisputed facts. ² [*3]

2 Defendants have failed to submit a Rule 56.1 statement.

Plaintiff Amoy Food is a Hong Kong-based corporation engaged in the production, advertising, promotion and sale of Asian food products, including soy sauce products. Plaintiff Danone, a Singapore-based company, is the parent company of plaintiff Amoy Food. Defendant Happy Dragon is a corporation organized under the laws of New York, with a place of business in Flushing, New York. Happy Dragon is engaged in the distribution of food products to the restaurant trade. Defendant Jimmy Wang is the president of Happy Dragon and its sole owner and officer.

Amoy Food has used the mark "AMOY" on soy sauce products in the United States since 1954. Danone registered this mark with the United States Patent and Trademark Office ("PTO"), Registration Nos. 1,095,359, 2,178,809, and 2,715,913 (collectively, the "AMOY MARKS"), for several goods, including soy sauce products. Amoy Food has used the mark "GOLD LABEL SOY SAUCE" on soy sauce products in the United States [*4] since 1983. Danone has registered this mark with the PTO, Registration No. 3,002,623, for soy sauce products.

Amoy Food sells a version of its GOLD LABEL SOY SAUCE products in 63-ounce metal containers primarily to the restaurant trade. This container, sold only in the United States, has a unique trade dress (hereinafter "Amoy Food Metal Container"). This "trade dress" consists of the following characteristics: (1) AMOY trademark; (2) the GOLD LABEL SOY SAUCE trademark in both English and Chinese characters; (3) orange color lettering for AMOY and GOLD LABEL SOY SAUCE marks; (4) black color for the generic product information; (5) yellow background color. Amoy Food also sells these containers in a corrugated package that holds six cans. The corrugated packaging also bears a unique trade dress (hereinafter "Amoy Food Six-Pack"). The trade dress consists of the following elements: (1) the AMOY trademark, and the GOLD LABEL SOY SAUCE trademark in both English and Chinese characters; (2) a five digit alphanumeric code, printed in a "dot-matrix" format, which identifies that date when the products were packaged. The AMOY MARKS, the GOLD LABEL SOY SAUCE MARK, the Amoy Food Metal Container, [*5] and the Amoy Food Six-Pack are collectively referred to as the "AMOY FOOD MARKS." The corrugated packaging that plaintiffs have used in the Washington, D.C. - Boston corridor for the last few years contains five cans of soy sauce and one can of oyster sauce (the "'5 + 1' package"). The product information on this package appears in green.

In the United States, Amoy Foods sells these products to its exclusive importer, Mon Chong Loong Trading Corp. ("Mon Chong"). In the last five years, Amoy Foods sold approximately \$ 30 million worth of soy sauce products bearing the AMOY MARKS and the GOLD LABEL SOY SAUCE mark in the United States, and spent approximately \$ 600,000 on advertising and promotional efforts in the United States.

Defendant Happy Dragon sells vegetables, canned foods, seafood, and dry goods to restaurants. Happy Dragon has approximately 15 employees and sales of more than \$ 1 million annually.

Happy Dragon purchases products for resale, normally by check. Defendant Wang testified that prior to the transactions at issue in this litigation, Happy Dragon never gave cash to the driver delivering products from its sellers out of fear that the driver would steal the cash.

[*6] Happy Dragon has been selling plaintiffs' GOLD LABEL SOY SAUCE products since 1995. Until 2005, Happy Dragon regularly purchased approximately 80 cases per month from two authorized distributors. For a few years before 2005, Happy Dragon bought and resold the "5 + 1" package, in place of the six pack.

On February 26, 2005, defendants purchased soy sauce products bearing marks that were counterfeit copies of plaintiffs' AMOY MARKS and GOLD LABEL SOY SAUCE mark (the "counterfeit containers") from a man who identified himself as "Mr. Chan." Wang testified that before that date, he had never met or spoken with Mr. Chan. Wang asked Mr. Chan for his telephone number; but he refused to provide it. Wang also asked him for the name of his company, but he similarly refused to provide it. Wang did not ask Mr. Chan for the location of Mr. Chan's business, its nature, or the source of the products. Happy Dragon purchased 467 cases of the counterfeit soy sauce product, and Wang testified that it would have purchased more had it been available. Happy Dragon offered to purchase the product with a check, but Mr. Chan insisted on cash. Accordingly, Wang paid Mr. Chan \$ 11,441.50 in cash in exchange [*7] for the products.

The counterfeit containers were packed in a corrugated container with black printing. Prior to this purchase, Wang testified that he had not seen a six pack with black printing, as opposed to the "5 + 1" package with green printing, for at least the previous two to three years.

On March 12, 2005, Mr. Chan returned to Happy Dragon, and defendants again purchased all of his inventory. They purchased 173 cases, for which they paid Mr. Chan \$ 4,238.50 in cash, and Wang testified that they would have purchased more had it been available.

Wang testified that before defendants began selling the counterfeit containers, they made a profit of \$ 1 per case; afterwards, they made a profit of \$ 5 per case.

In 2004, Amoy Food's authorized importer, Mon Chong, was alerted to the availability of "supposed" Amoy Food soy sauce products in the 63-ounce container size at lower prices than those for authorized Amoy Food products. Amoy Food assumed that these complaints resulted from an isolated situation of an authorized Amoy Food wholesaler having significantly discounted its prices. However, in February 2005, Mon Chong again received the same complaints.

On two separate occasions, [*8] Mon Chong's employees purchased from Happy Dragon purported GOLD LABEL SOY SAUCE containers. Happy Dragon also sold the product to an investigator that plaintiffs had retained.

The soy sauce products sold by defendant Happy Dragon bear a trademark and trade dress which contain features of the Amoy Food Metal Container: the AMOY MARKS and the GOLD LABEL SOY SAUCE marks, orange and black lettering, and a background yellow color. The defendant also uses the six-pack packaging which has the following distinctive features that appear on the Amoy Food Six Pack: the AMOY MARKS and GOLD LABEL SOY SAUCE mark, the legend "MANUFACTURED BY: AMOY FOOD, LTD.," and a 5-digit dot matrix alphanumeric code. There are differences between the products, which would not be easily recognizable to a customer, such as small differences in lettering and punctuation in the words "Percent Daily Values" and the address on the back of the metal containers.

Defendant Happy Dragon is using the AMOY MARKS without plaintiffs' authorization or consent. In the six month period prior to the commencement of this action, sales of Amoy's GOLD LABEL SOY SAUCE products by Mon Chong decreased as compared with the same six-month [*9] period in the previous year. In contrast, Mon Chong's sales of the product in preceding years showed steady increases in sales.

Further, plaintiffs allege that the defendants' sale of the counterfeit product has resulted in a loss of credibility among Amoy Food's customers, because the customers have mistakenly concluded that Amoy Food has established a separate line of lower-priced distribution to the detriment of its long-standing customers.

On March 29, 2005, in accordance with an Order to Show Cause, plaintiffs served upon defendants a deposition notice and request for documents for April 4, 2005. On April 4, Happy Dragon neither appeared nor produced any documents. This Court subsequently issued an

order pursuant to Federal Rule of Civil Procedure 37(a) requiring Happy Dragon to appear for a deposition on April 8, 2005. Happy Dragon again failed to appear or produce any documents.

Also on April 8, this Court ordered Happy Dragon to cease and desist from further sale of the counterfeit soy sauce products. Notwithstanding their receipt of the preliminary injunction order on April 12, defendants continued selling the counterfeit products. [*10] This Court subsequently granted plaintiffs' request for an order allowing plaintiffs, with the assistance of the Marshals Service, to seize any counterfeit soy sauce remaining in Happy Dragon's possession, and on April 18, 2005, the Marshals Service seized more than 3,000 cans of counterfeit soy sauce from Happy Dragon.

Plaintiffs were subsequently able to depose Wang and gather documents from defendants.

DISCUSSION

Jurisdiction

The Court has jurisdiction over this action pursuant to 15 U.S.C. § 1121 and 28 U.S.C. § 1338, which confers jurisdiction over actions involving violations of patents and trademarks, 28 U.S.C. § 1331, which authorizes jurisdiction over civil actions arising under federal law, and principles of pendent jurisdiction over the state law claims.

Motion for Partial Summary Judgment

Summary Judgment Standard

A motion for summary judgment may be granted only where "the pleadings, depositions, answers to interrogatories, and admissions on file, together with affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled [*11] to judgment as a matter of law." Fed. R. Civ. P. 56(c); Celotex Corp v. Catrett, 477 U.S. 317, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986). A motion for summary judgment may be defeated by the non-moving party if that party produces sufficient specific facts to establish that there is a material issue of fact for trial. See Montana v. First Federal Sav. & Loan Ass'n of Rochester, 869 F.2d 100, 103 (2d Cir.1989). The role of the court on such a motion is "not to resolve disputed issues of fact but to assess whether there are any factual issues to be tried." Knight v. United States Fire Ins. Co., 804 F.2d 9, 11 (2d Cir.1986). The "court must view the evidence in the light most favorable to the party against whom summary judgment is sought and must draw all reasonable inferences in his favor." L.B. Foster Co. v. America Piles, Inc., 138 F.3d 81, 87 (2d Cir.1998); Anderson v. Liberty

Lobby, Inc., 477 U.S. 242, 255, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986).

Defendants' Failure to Respond to Plaintiffs' Rule 56.1 Statement

Local Rule 56.1 of the Eastern and Southern Districts of New York requires that all summary judgment motions [*12] be accompanied by a "short or concise statement of material facts as to which the moving party contends there is no genuine issue to be tried." Local Rule 56.1(a). The rule also requires that the party opposing summary judgment file a response setting forth the material facts about which it contends there exists a triable issue. Because defendants have failed to file any response, all facts contained in plaintiffs' Rule 56.1 statement are deemed admitted. See Local Rule 56.1(b) and (d). However, the moving party must "nevertheless offer facts supporting its Rule 56.1 Statement. . . ." Smith v. Principi, 2004 U.S. Dist. LEXIS 16418, 2004 WL 1857582, at *1, n.1 (S.D.N.Y. 2004).³

3 Although defendants have not submitted a responsive Rule 56.1 statement, defendants, in their Memorandum of Law in Opposition to Plaintiffs' Motion for Summary Judgment argue that plaintiffs base many of their factual assertions in the inadmissible affidavits of Bertrand Austruy and John Lao. In support of their argument, they cite Union Ins. Soc. v. William Gluckin & Co., 353 F.2d 946 (2d Cir.1965). They argue first that Austruy is General Counsel to Danone and therefore has no relationship to Amoy Foods. However, as stated above, Danone is the parent company of Amoy Foods. Moreover, although Austruy is General Counsel of Danone, he is not the litigating attorney, as was the case in Union Ins. Soc. of Canton. Austruy, as an officer of Danone includes statements in his affidavits from personal knowledge and from review of the company's records, both of which are admissible. See, e.g., Searles v. First Fortis Life Ins. Co., 98 F.Supp.2d 456, 461 (S.D.N.Y.2000) (stating, "an affiant's conclusions based on personal observations over time. . . may constitute personal knowledge, and an affiant may testify as to the contents of records [he] reviewed in [his] official capacity."). Similarly, Lao, regional sales manager for Amoy Foods is competent to testify as to issues such as Amoy Food's sales, products, and packaging. Finally, defendants argue that the portions of the affidavits relating to a lab analysis of the counterfeit soy sauce should be stricken, since no additional evidence as to the lab analysis was provided. I need not decide on this argument because for the purposes of this motion, the chemi-

cal composition of the contents of the cans is irrelevant.

[*13] Plaintiffs' Motion for Partial Summary Judgment

Plaintiffs seek partial summary judgment against defendants on their First, Second, Third and Fourth Claims for relief, which allege (1) infringement of plaintiffs' registered trademarks in violation of Section 32 of the Lanham Act, 15 U.S.C. § 1114 (Count I); (2) counterfeiting of plaintiffs' registered trademarks in violation of Section 34(d) of the Lanham Act, 15 U.S.C. § 1116(d) (Count II); (3) false designation of origin in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a) (Count III); (4) trademark infringement and unfair competition under common law (Count IV). Plaintiffs also seek permanent injunctive relief, damages, and recovery of attorney fees.

Counts I, II, and IV

Section 32 of the Act prohibits the use in commerce, without consent, of any "reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods," in a way that is likely to cause confusion with plaintiff's registered trademarks. 15 U.S.C. § 1114 (1)(a) [*14]. Section 43(a) prohibits similar conduct, though it is not limited to registered trademarks, and deems liable for false designation of origin "any person who...uses in commerce any container for goods...name, symbol, device...or any false designation of origin ..which is likely to cause confusion." 15 U.S.C. § 1125(a); see also Chambers v. Time Warner, Inc., 282 F.3d 147, 155 (2d Cir.2002). Liability is established under both Sections 32 and 43(a) of the Lanham Act if a plaintiff can demonstrate (1) that it has a valid trademark entitled to protection under the Act, and (2) defendant's actions are "likely to cause confusion." Arrow Fastener v. Stanley Works, 59 F.3d 384, 390 (2d Cir.1995).

In this case, plaintiff's certificates of registration with the U.S. PTO for the AMOY MARKS and GOLD LABEL SOY SAUCE mark are "prima facie evidence that the mark[s] [are] registered and valid (i.e. protectible), that the registrant owns the mark[s], and that the registrant has the exclusive right to use the mark[s] in commerce." Lane Capital Management, Inc. v. Lane Capital Management, Inc., 192 F.3d 337, 345 (2d Cir. 1999); [*15] 15 U.S.C. § 1067(b) ("A certificate of registration of a mark...shall be prima facie evidence of the validity of the registered mark"). Thus, the plaintiff has established that its marks are valid and entitled to protection under the Act.

In considering the likelihood of confusion, district courts generally apply eight nonexclusive factors, known as the *Polaroid* factors:

- (1) the strength of the plaintiff's mark;
- (2) the similarity of plaintiff's and defendant's marks;
- (3) the competitive proximity of their products;
- (4) the likelihood that plaintiff will "bridge the gap" and offer a product like defendant's;
- (5) actual confusion between products;
- (6) defendant's good faith;
- (7) the quality of defendant's product as compared to plaintiff's;
- and (8) the sophistication of the purchasers.

Streetwise Maps, Inc. v. VanDam, Inc., 159 F.3d 739, 742-43 (2d Cir.1998) (citing *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir.1961)). However, in cases involving counterfeit marks, "the Court need not undertake a factor-by-factor analysis under *Polaroid* because counterfeits, by their very nature, cause [*16] confusion." *Gucci America, Inc. v. Duty Free Apparel, Ltd.*, 286 F.Supp.2d 284, 287 (S.D.N.Y. 2003); *Phillip Morris USA Inc. v. Felizardo*, 2004 U.S. Dist. LEXIS 11154, 2004 WL 1375277, at *5 (S.D.N.Y. 2004). Thus, the Court "need only determine the more fundamental question of whether there are items to be confused in the first place--that is, whether the items at issue here are, in fact, counterfeit, and whether Defendants sold those items." *Gucci America, Inc.*, 286 F.Supp.2d at 287. In this case, it is uncontroverted that the items at issue are counterfeit Amoy Foods soy sauce containers, and that defendant Wang sold and distributed these items. ⁴ Accordingly, defendant Wang's actions caused a likelihood of consumer confusion, and plaintiff has established liability under Sections 32 and 43(a) of the Lanham Act. See *Phillip Morris Inc. v. Felizardo*, 2004 U.S. Dist. LEXIS 11154, 2004 WL 1375277 at *5. Accordingly, plaintiffs' motion for summary judgment as to Counts I and III of the complaint is granted.

4 Although Wang denies that he had knowledge at the time he purchased them that the products were counterfeit, he does not now deny that the products were indeed counterfeit. Nevertheless, in his affirmation in support of the motion for summary judgment, defendant's attorney, Allen Wu, states, "there are material issues of fact concerning whether or not...the marks on the containers purchased by the Defendants are counterfeit...The differences in the alleged authentic package and those in possession of the Defendants is *de minimus* at best." However, as stated

above, defendants have failed to respond to plaintiffs' Rule 56.1 statement of facts and, as such, the facts listed therein are deemed uncontroverted. Moreover, defendants fail to provide any evidence--testimonial or otherwise--to support Wu's assertion that the containers may not have been counterfeit, and Wu, as defendant's litigating attorney, does not purport to have personal knowledge of the events at issue.

[*17] The analysis for Count IV of plaintiffs' complaint, trademark infringement and unfair competition under common law, is subsumed within the analysis of the Lanham Act claims; therefore, plaintiffs' motion for summary judgment on this claim is also granted. See, e.g., *Bi-Rite Enterprises, Inc. v. Button Master*, 555 F.Supp. 1188, 1193 (D.C.N.Y.1983) (citing *American Footwear Corp. v. General Footwear Co.*, 609 F.2d 655, 664 (2d Cir.1979), cert. denied, 445 U.S. 951, 100 S. Ct. 1601, 63 L. Ed. 2d 787 (1980); *New West Corp. v. NYM Co. of California, Inc.*, 595 F.2d 1194, 1201 (9th Cir.1979); *Damn I'm Good, Inc. v. Sakowitz, Inc.*, 514 F.Supp. 1357, 1360 (S.D.N.Y.1981); 15 U.S.C. §§ 1063 et seq. (1976); *International Society for Krishna Consciousness, Inc. v. Stadium Authority*, 479 F.Supp. 792, 798 (W.D.Pa.1979); *National Lampoon, Inc. v. American Broadcasting Cos.*, 376 F. Supp. 733, 747 (S.D.N.Y.1974); *Allied Maintenance Corp. v. Allied Mechanical Trades, Inc.*, 42 N.Y.2d 538, 542, 369 N.E.2d 1162, 1164, 399 N.Y.S.2d 628, 630 (1977)).

Count II

Plaintiffs also allege [*18] that "defendants have committed acts of counterfeiting in violation of Section 34(d) of the Lanham Act." However, this Court notes, *sua sponte*, that Section 34(d) of the Lanham Act does not create a separate cause of action for trademark violations. Instead, Section 34(d) provides that:

In the case of a civil action arising under section 1114(1)(a) of this title...with respect to a violation that consists of using a counterfeit mark in connection with the sale, offering for sale, or distribution of goods or services, the court may, upon ex parte application, grant an order under subsection (a) of this section pursuant to this subsection providing for the seizure of goods and counterfeit marks involved in such violation and the means of making such marks, and records documenting the manufacture, sale, or receipt of things involved in such violation.

15 U.S.C. § 1116(d)(1)(A). Plaintiffs are not currently seeking a seizure order, having already been issued such an order. Instead, plaintiffs move for summary judgment on their claim that defendants have engaged in counterfeiting *in violation of 15 U.S.C. § 1116(d)* [*19]. Presumably, plaintiffs seek a finding that defendants have engaged in counterfeiting *as defined by Section § 1116(d)* ⁵ for the purposes of being awarded damages pursuant to 15 U.S.C. § 1117. ⁶

5 15 U.S.C. § 1116(d)(1)(B) provides that "the term 'counterfeit mark' means...a counterfeit of a mark that is registered on the principal register in the United States Patent and Trademark Office for such goods or services sold, offered for sale, or distributed and that is in use, whether or not the person against whom relief is sought knew such mark was so registered...."

6 15 U.S.C. § 1117(b) provides: "In assessing damages under subsection (a) of this section, the court shall, unless the court finds extenuating circumstances, enter judgment for three times such profits or damages, whichever is greater, together with a reasonable attorney's fee, in the case of any violation of section 1114(1)(a) of this title...that consists of intentionally using a mark or designation, knowing such mark or designation is a counterfeit mark (as defined in section 1116(d) of this title), in connection with the sale, offering for sale, or distribution of goods or services."

15 U.S.C. § 1117(c) provides: "In a case involving the use of a counterfeit mark (as defined in section 1116(d) of this title) in connection with the sale, offering for sale, or distribution of goods or services, the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits under subsection (a) of this section, an award of statutory damages for any such use in connection with the sale, offering for sale, or distribution of goods or services"

[*20] Because no independent cause of action under § 1116(d) exists, plaintiffs' motion for summary judgment as to this claim must be denied, and the claim must be dismissed. Plaintiffs' arguments appearing in this section of their Memorandum of Law and defendants' corresponding arguments are discussed in the "Damages" section below.

Injunctive Relief

Plaintiffs seek to permanently enjoin defendants from future infringement of their marks. ⁷ Section 34(a) of the Lanham Act provides courts with the "power to grant injunctions according to the principles of equity

and upon such terms as the Court may deem reasonable, to prevent the violation of any right of the registrant of a mark registered in the Patent and Trademark Office." 15 U.S.C. § 1116(a). To obtain a permanent injunction, plaintiff must demonstrate (1) actual success on the merits and (2) irreparable harm. *See e.g., Gucci America, Inc.*, 286 F.Supp.2d at 290; *Wojnarowicz v. American Family Ass'n*, 745 F.Supp. 130, 148, n.13 (S.D.N.Y. 1990). As previously discussed, plaintiff has established success on the merits on its Lanham Act claims. Moreover, in this Circuit, [*21] "proof of a likelihood of confusion establishes both likelihood of success on the merits and irreparable harm." *Brennan's Inc. v. Bennan's Rest.*, 360 F.3d 125, 129 (2d Cir.2004); *Genesee Brewing Co., Inc. v. Stroh Brewing Co.*, 124 F.3d 137, 142 (2d Cir.1997). Accordingly, plaintiff is entitled to a permanent injunction. *See e.g., Phillip Morris v. Felizardo*, 2004 U.S. Dist. LEXIS 11154, 2004 WL 1375277 at *7; *Gucci America, Inc.*, 286 F.Supp.2d at 290.

7 Specifically, plaintiffs seek to permanently enjoin defendants from "manufacturing, importing, buying, promoting, advertising and selling any products bearing the AMOY MARKS, the GOLD LABEL SOY SAUCE mark, the Amoy Food Metal Container or the Amoy Food Six-Pack, or any other mark confusingly similar to any one of them, or impliedly or expressly representing that any of the products manufactured or sold by defendants are genuine products sourced with plaintiffs."

Damages

Plaintiff seeks an award of \$ 2,000,000 in statutory damages pursuant [*22] to 15 U.S.C. §§ 1117(b), and (c).

Section 35(b) of the Lanham Act provides that:

In assessing damages...the court shall, unless the court finds extenuating circumstances, enter judgment for three times such profits or damages, whichever is greater, together with a reasonable attorney's fee, in the case of any violation of section 1114(1)(a) of this title...that consists of intentionally using a mark or designation, knowing such mark or designation is a counterfeit mark (as defined in section 1116(d) of this title), in connection with the sale, offering for sale, or distribution of goods or services.

15 U.S.C. § 1117(c). Section 35(c) of the Lanham Act provides that:

In a case involving the use of a counterfeit mark (as defined in section 1116(d) of this title) in connection with the sale, offering for sale, or distribution of goods or services, the plaintiff may elect, at any time before final judgment is rendered by the trial court, to recover, instead of actual damages and profits under subsection (a) of this section, an award of statutory damages for any such use in connection with the sale, offering for sale, [*23] or distribution of goods or services....

15 U.S.C. § 1117(c). Congress added the statutory damages provision of the Lanham Act in 1995 because "counterfeiters' records are frequently nonexistent...making proving actual damages in these cases extremely difficult, if not impossible." See Gucci Am., Inc. v. Duty Free Apparel, Ltd., 315 F. Supp. 2d 511, at 520. A plaintiff may recover "not less than \$ 500 or more than \$ 100,000 per counterfeit mark per type of goods or services sold..." 15 U.S.C. § 1117 (c)(1). If the Court finds that "the use of the counterfeit mark was willful," then the plaintiff may recover "not more than \$ 1,000,000 per counterfeit mark..." Id. at 1117(c)(2). "The standard for willfulness is whether the defendant had knowledge that [his] conduct represented infringement or perhaps recklessly disregarded the possibility." Kepler Tregoe, Inc. v. Vroom, 186 F.3d 283, 289 (2d Cir. 1999). Plaintiffs, arguing that defendants' use of the counterfeit marks was willful, seek the maximum statutory award of \$ 1,000,000 for each of the AMOY MARKS⁸ and GOLD LABEL SOY SAUCE marks, for a total of \$ 2,000,000.

⁸ Although plaintiffs own three registrations for the AMOY mark, defendants' products incorporate a counterfeit copy of only one of them.

[*24] A plaintiff must substantiate a claim with evidence to prove the extent of damages. Although an evidentiary hearing may be held, "it is not necessary for the district court to hold a hearing, as long as...there was a basis for the damages specified..." Transatlantic Marine Claims Agency, Inc. v. Ace Shipping Corp., 109 F.3d 105, 111 (2d Cir.1997); Tamarin v. Adam Caterers, Inc., 13 F.3d 51, 54 (2d Cir.1993) (district judges are given much discretion to determine whether an inquest need be held).

District courts have wide discretion in awarding statutory damages. See Cable/Home Communication Corp. v. Network Prod., Inc., 902 F.2d 829, 852 (11th Cir.1990). Although Section 1117(c) "does not provide

guidelines for courts to use" in determining an appropriate statutory damage award, "many courts have found guidance in the caselaw of an analogous provision of the Copyright Act, 17 U.S.C. § 504(c), which also provides for statutory damages for willful infringement." Gucci America, 315 F.Supp.2d at 520; Sara Lee Corp. v. Bags of New York, Inc., 36 F.Supp.2d 161, 165-67 (S.D.N.Y.1999); [*25] Rodgers v. Anderson, 2005 U.S. Dist. LEXIS 7054, 2005 WL 950021, at *2 (S.D.N.Y.2005). Under the Copyright Act, courts look to factors such as: (1) "the expenses saved and the profits reaped;" (2) "the revenues lost by the plaintiff;" (3) "the value of the copyright;" (4) "the deterrent effect on others besides the defendant;" (5) "whether the defendant's conduct was innocent or willful;" (6) "whether a defendant has cooperated in providing particular records from which to assess the value of the infringing material produced;" and (7) "the potential for discouraging the defendant." Fitzgerald Pub. Co., Inc. v. Baylor Pub. Co., 807 F.2d 1110, 1117 (2d Cir.1986).

Upon consideration of those factors with respect to the case at bar, I find that an inquest as to damages is warranted. First, there exist issues of fact as to the amount of profits defendants gained as a result of their infringing activities. In his deposition, defendant Wang admitted to purchasing products from "Mr. Chan" on two occasions; however, plaintiffs contend, and defendants dispute, that defendants purchased and sold additional quantities of the counterfeit product. For example, plaintiffs present the affidavit [*26] of Kevin Tay, a customer of Happy Dragon, to demonstrate that defendants sold hundreds of cases of the counterfeit six-pack to Tay from January 2005 to March 2005. ⁹ Because the first time Wang admits to purchasing products from Mr. Chan was in February 2005, plaintiffs assert, and defendants dispute, that Wang purchased products from Mr. Chan on other occasions. Plaintiffs assert that they do not have complete records of defendants' sales because defendants have not cooperated with discovery requests for those records, another consideration under the factors set forth above. Accordingly, an inquest on this issue is warranted.

⁹ Defendants seek to file a sur-reply with respect to the present motion in order to respond to the allegations in Tay's affidavit. Because this matter is being referred for an inquest, defendants will have an opportunity to respond at that time.

Similarly, an inquest on the issue of plaintiffs' lost revenues is warranted. Plaintiffs have failed to provide the Court with evidence of lost [*27] profits. They contend that Mon Chong's profits decreased during the time that defendants sold the counterfeit product; however they do not provide any evidence of their own losses.

They also have failed to provide the Court with evidence concerning the value of their mark.

The extent of defendants' "willfulness" is also at issue. Although plaintiffs concede that they cannot demonstrate the defendants actually knew that the products were counterfeit, they maintain that they were "willfully blind" to the counterfeit nature of the products and that willful blindness constitutes knowledge for the purposes of this issue. See, e.g., *Tanning Research Laboratories, Inc. v. Worldwide Import & Export Corp.*, 803 F.Supp. 606, 610 (E.D.N.Y.1992), quoting *Louis Vuitton S.A. v. Lee*, 875 F.2d 584, 590 (7th Cir.1989) ("willful blindness is knowledge itself"); see also *Gucci America, Inc. v. Duty Free Apparel, Ltd.*, 315 F.Supp.2d 511, 521-522 (S.D.N.Y.2004); *Nike, Inc. v. Top Brand Co. Ltd.*, 2005 WL 1654859 (S.D.N.Y.2005); *Levi Strauss & Co. v. Diaz*, 778 F.Supp. 1206, 1208 (S.D.Fla.1991). Plaintiffs argue that defendant [*28] Wang was willfully blind to the counterfeit nature of the products in that Mr. Chan arrived at Happy Dragon on announced visits, he refused to disclose the name of his company to Wang, he sold the six-pack, rather than the "5 + 1" pack, he demanded cash payments for the product, and he provided "generic" invoices for the product.

Wang, however, asserts that he compared the products sold to him by Mr. Chan with Amoy Foods soy sauce he had previously purchased and found them to be identical. Further, he states that the price he paid for the counterfeit cans was not significantly lower than the price he paid for the real cans. He further testified that he was aware that the six-pack was being sold in California, and he believed Mr. Chan to be from California. Finally, defendants argue that Wang did not perceive Mr. Chan to be a driver, to whom he would not normally give cash; rather, he thought he was a vendor. Because the extent of defendants' willfulness is in dispute, an inquest on this issue is also warranted.

Accordingly, this matter is referred to the Magistrate Judge to conduct an inquest and issue a Report and Recommendation on damages.¹⁰

10 Defendants do not argue that plaintiffs are not entitled to damages in light of the factors set forth above. Instead, they argue that plaintiffs are not entitled to damages because their products did not have any marks indicating that they constituted registered trademarks and they cannot prove that defendants had actual knowledge of the trademark. See 15 U.S.C. § 1111 ("in any suit for infringement under this chapter by...a registrant failing to give...notice of registration, no profits and no damages shall be recovered under the provisions of this chapter unless the defendant had actual notice of the registration.) However,

registration is not required for suits under section 43(a) and for common law trademark infringement and unfair competition; therefore, plaintiff's failure to indicate on the products that they were registered trademarks is irrelevant with respect to those claims. See *Bambu Sales, Inc. v. Sultana Crackers, Inc.*, 683 F. Supp. 899, 911 (E.D.N.Y.1988) Moreover, damages for a section 32 violation may be recovered for the period after the defendant received notice of the registration, and here, defendants received notice, at the latest, when plaintiffs filed their complaint, yet they continued to sell the counterfeit products after that date. Accordingly, plaintiffs can recover profits for that time period. *Id.* (stating "the holder of a mark is...under no legal obligation to give advance notice of its rights to an infringer before seeking damages....The only consequence of a holder failing to give such notice is that damages might start running later than if the notice had been given.") Defendants also argue, without citing any authority, that the GOLD LABEL SOY SAUCE mark was not registered until well after the alleged infringement occurred. However, if a trademark is eventually registered, then a plaintiff's right of priority over the mark vests at the time the application to register the mark was filed. See 15 U.S.C. § 1057(c) ("Contingent on the registration of a mark..., the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration"); see also *Talk To Me Products, Inc. v. Larami Corp.*, 804 F.Supp. 555, 559-560 (S.D.N.Y.1992); *First Nat'l. Bank of Omaha, Inc. v. Mastercard Intern. Inc.*, 2004 U.S. Dist. LEXIS 13162, 2004 WL 1575396, *3 (S.D.N.Y.2004). It is not disputed that the GOLD LABEL SOY SAUCE mark was eventually registered and that plaintiffs applied for registration in advance of the incidents complained of. Accordingly, defendants' argument fails. And, as stated above, registration is not required for section 43(a) claims or for common law trademark infringement and unfair competition claims.

[*29] *Attorney Fees*

Finally, plaintiffs move for attorney fees pursuant to sections 35(a) " and (b) of the Lanham Act. Pursuant to section 35(a), attorney fees are only available in "exceptional circumstances," and pursuant to 35(b), attorney fees are available when a defendant "intentionally used a mark or designation, knowing such mark or designation [was] a counterfeit mark." 15 U.S.C. 1117(b). Deliberate

and willful infringement can render a case "exceptional" and accordingly support an award of attorneys' fees under section 35(a). See Quaker State Oil Ref. Corp. v. Kooltone, Inc., 649 F.2d 94, 95 (2d Cir.1981); Springs Mills, Inc. v. Ultracashmere House Ltd., 724 F.2d 352, 357 (2d Cir.1983). Thus, whether to award attorney fees under both sections of the statute turns on the willfulness of the infringement.

11 Section 35(a) provides: "When a violation of any right of the registrant of a mark registered in the Patent and Trademark Office, a violation under section 1125(a) or (d) of this title, or a willful violation under section 1125(c) of this title, shall have been established in any civil action arising under this chapter, the plaintiff shall be entitled, subject to the provisions of sections 1111 and 1114 of this title, and subject to the principles of equity, to recover (1) defendant's profits, (2) any damages sustained by the plaintiff, and (3) the costs of the action. The court shall assess such profits and damages or cause the same to be assessed under its direction. In assessing profits the plaintiff shall be required to prove defendant's sales only; defendant must prove all elements of cost or deduction claimed. In assessing damages the court may enter judgment, according to the circumstances of the case, for any sum above the amount found as actual damages, not exceeding three times such amount. If the court shall find that the amount of the recovery based on profits is either inadequate or excessive the court may in its discretion enter judgment for such sum as the court shall find to be just, according to the cir-

cumstances of the case. Such sum in either of the above circumstances shall constitute compensation and not a penalty. **The court in exceptional cases may award reasonable attorney fees to the prevailing party.**" 15 U.S.C. 1117(a) (emphasis added).

[*30] As described above, the extent of defendants' willfulness is an issue to be determined after inquest. Accordingly, the motion for attorney fees should be considered by the Magistrate Judge and addressed in the Report and Recommendation.

CONCLUSION

For the reasons set forth above, (1) plaintiffs' motion for partial summary judgment against defendants on Counts I, III, and IV alleged in the complaint is granted; (2) plaintiffs' motion for summary judgment on Count II is denied, and that claim is dismissed in its entirety; (3) plaintiffs' motion for a permanent injunction is granted; and (4) the matter is referred to Magistrate Judge Mann to conduct an inquest and issue a Report and Recommendation as to damages.

The Clerk is directed to transmit a copy of the within to all parties and to the Magistrate Judge.

SO ORDERED.

Dated: March 29, 2006

Brooklyn, New York

By: /s/ Charles P. Sifton (electronically signed)

United States District Judge

EXHIBIT 8

LEXSEE 1999 TTAB LEXIS 614

Food-Tek, Inc. v. Rhodia, Inc. n1

n1 By assignment from Rhone-Poulenc, Inc., recorded July 22, 1998 at Reel
1758, Frame 0879.

Opposition No. 99,676 to application Serial No. 74/529,590 filed on May 25, 1994

Cancellation No. 24,523 (consolidated case)

Trademark Trial and Appeal Board

1999 TTAB LEXIS 614

November 3, 1999, Decided

DISPOSITION:

[*1]

Decision: Opposition No. 99,676 and Cancellation No. 24,523 are dismissed. Application Serial No. 74/529,590 shall be remanded to the Trademark Examining Attorney for reexamination pursuant to Trademark Rule 2.131.

COUNSEL:

Norman E. Lehrer of Norman E. Lehrer, P.C. for Food-Tek, Inc.

Mark I. Feldman of Rudnick & Wolfe for Rhodia, Inc.

JUDGES:

Before Seeherman, Wendel and Bottorff, Administrative Trademark Judges.

OPINION BY: BOTTORFF

OPINION:

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

Opinion by Bottorff, Administrative Trademark Judge:

Applicant/respondent Rhodia, Inc. (hereinafter "defendant") is the owner of application Serial No. 74/529,590, by which it seeks to register on the Principal Register the mark YOUR FOOD TECH PARTNER, in the stylized lettering depicted below, for services recited as "information services, namely providing information regarding food ingredient use."

[SEE ILLUSTRATION IN ORIGINAL]

Defendant also owns Registration No. 1,896,675, which is of the mark YOUR FOOD TECH PARTNER, in typed form, for services recited in the registration as "providing information regarding food-ingredient use."

In these consolidated opposition and [*2] cancellation proceedings, opposer/petitioner Food-Tek, Inc. (hereinafter "plaintiff") has opposed issuance of the registration sought by defendant in the above-referenced application, and also has petitioned to cancel defendant's above-referenced registration. As grounds for opposition and cancellation, plaintiff has alleged that it is the prior user of the service mark and trade name FOOD-TEK for services recited in the notice of opposition and petition to cancel as "consulting services in the field of food manufacturing and food product research and development." Plaintiff also has alleged that defendant's marks, as used in connection with defendant's recited ser-

vices, so resemble plaintiff's previously-used service mark and trade name as to be likely to cause confusion, to cause mistake, or to deceive. *See* Trademark Act Section 2(d), 15 U.S.C. § 1052(d).

Defendant has filed answers to the notice of opposition and the petition to cancel, by which defendant has denied those allegations which are essential to plaintiff's Section 2(d) claims. Plaintiff and defendant have filed main briefs, and plaintiff has filed a reply brief. No oral hearing was requested. [*3]

The evidence of record in this case consists of the pleadings; the files of the application and registration involved in these opposition and cancellation proceedings; plaintiff's testimony deposition of plaintiff's president Gilbert Finkel, and exhibits attached thereto; defendant's testimony depositions of defendant's employees Joseph Downes and Debbie Remillard, and exhibits attached thereto; a status and title copy of defendant's involved registration, submitted by defendant under notice of reliance; portions of the discovery deposition of plaintiff's president Gilbert Finkel, submitted by defendant under notice of reliance; various documents and other materials asserted to be "printed publications," submitted by defendant under notice of reliance; and the stipulated rebuttal testimony of plaintiff's president Gilbert Finkel, and exhibits attached thereto.

Before turning to the merits of the parties' dispute, the Board rules as follows on the numerous evidentiary objections made by each of the parties.

Defendant's objections to the stipulated rebuttal testimony of Gilbert Finkel, and to plaintiff's Exhibits 46-50 attached thereto, are overruled. This evidence regarding plaintiff's [*4] knowledge of, and its actions taken against, certain third parties shall be considered for whatever probative value it might have.

Plaintiff, in its briefs, has raised hearsay objections to Debbie Remillard's testimony (transcript pp. 48-60) regarding her investigation of certain third parties' uses of FOOD TECH, and likewise objects to defendant's corresponding Exhibit Nos. 62-80 on the grounds of hearsay, lack of foundation and lack of authentication. Initially, the Board rejects defendant's contention that plaintiff waived its hearsay objections by failing to raise them during Ms. Remillard's deposition. Hearsay is a substantive objection going to a defect in the evidence which could not have been cured by defendant even if plaintiff had raised the objection during the deposition. *See* Trademark Rule 2.123(k) and *Fed. R. Civ. P. 32(d)(3)(A)*, and TBMP § 718.04. n2

n2 To the extent that defendant is relying on *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845 (TTAB 1984) for the proposition that hearsay objections are waived if not timely raised, defendant's reliance is misplaced. In that case, the defendant waited until its brief on the case to object to certain exhibits introduced by the plaintiff during a testimony deposition. The grounds for the objections included, inter alia, that the exhibits were inadmissible hearsay and that the plaintiff had failed to lay a proper foundation for establishing that the exhibits fell within the "business records" exception to the hearsay rule. Because the foundation objection to the exhibits could have been cured if seasonably raised, and because the hearsay objection was based solely on the exhibits' lack of proper foundation as "business records," the Board held that the defendant had waived both the foundation and the hearsay objections. Thus, *Pass & Seymour* actually involved a foundation objection, not a hearsay objection, and the case does not stand for the proposition that hearsay objections, in general, are waived if not raised promptly.

[*5]

The Board agrees with plaintiff that Ms. Remillard's testimony concerning what she was told by other persons during her telephone conversations with such persons, and her notes of those telephone conversations, are inadmissible hearsay. *See Fed. R. Evid. 802; Tiffany & Co. v. Classic Motor Carriages Inc.*, 10 USPQ2d 1835, 1839 n.5 (TTAB 1989). Accordingly, the Board sustains plaintiff's objection to such testimony from Ms. Remillard, and to defendant's Exhibit Nos. 62, 66, 68, 71-75 and 77-78. As for Exhibits 63-65, 67, 69-70 and 76, which are materials which Ms. Remillard testified that she had asked for and received from certain of the third parties she spoke with, the Board has considered these materials, but only to the extent that they prove that the third parties send out such materials upon request. *See Tiffany & Co., supra*.

Next, plaintiff has objected to consideration of defendant's Exhibit Nos. 85-111, which are documentary materials submitted by defendant under notice of reliance. Plaintiff contends that these documents are irrelevant to the extent that they fail to demonstrate third-party use of [*6] FOOD TECH in connection with the specific services rendered by plaintiff and defendant, and that they also are irrelevant to the extent that they demonstrate use of FOOD TECH by third par-

ties in foreign countries. Plaintiff further contends that certain of the exhibits consist of materials which are not "printed publications" and which therefore cannot be made of record by notice of reliance under Trademark Rule 2.122(e).

Plaintiff's relevancy objections are overruled. The evidence pertaining to use of FOOD TECH by third parties in foreign countries is derived from trade publications and other proper sources which are published or made available in the United States and which are directed to the relevant purchasing public in the United States. This evidence is relevant and admissible to the extent that it shows that purchasers in this country are exposed to these articles, listings and other published items concerning use of the term FOOD TECH by third parties, including use in foreign countries. As for the documents which pertain to third-party use of FOOD TECH in connection with goods and services which assertedly are not the same as plaintiff's and defendant's services, plaintiff's [*7] objection goes to the proper probative weight of the evidence, not to its admissibility. The Board accordingly has considered this evidence, and has taken care to accord it the proper probative weight.

As for plaintiff's objection on the ground that the materials submitted by defendant under notice of reliance are not "printed publications" admissible under Trademark Rule 2.122(e), we overrule the objection in part and sustain it in part. Defendant's Exhibit Nos. 85-89 are standard reference works and thus are admissible as printed publications. Defendant's Exhibit Nos. 91-95, 98-99 and 103 are electronically generated printouts, obtained from the NEXIS(R) and DIALOG(R) databases, of articles from publications of general circulation, and thus are admissible as printed publications. *See Weyerhaeuser v. Katz*, 24 USPQ2d 1230 (TTAE 1992); TBMP § 708. Defendant's Exhibit Nos. 96 and 97 are photocopies of the articles appearing in the actual printed publications of general circulation. Defendant's Exhibit Nos. 104 and 105 are Dun & Bradstreet reports, which have been held in the past to be admissible. *See Tiffany & Co., supra; Stagecoach Properties Inc. v. Wells Fargo & Co.*, 199 USPQ 341, 354-57 (TTAB 1978). [*8] Accordingly, we overrule plaintiff's objections as to Exhibit Nos. 85-89, 91-99 and 103-105 and have considered this evidence for whatever probative value it is worth.

However, we sustain plaintiff's objection to defendant's Exhibit Nos. 90, 100-102 and 106-111. Exhibits 101-102 and 106-111 are advertising and promotional materials obtained from third parties' Internet home pages. Advertising and promotional materials are not printed publications admissible under Trademark Rule 2.122(e). *See, e.g., Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881 (TTAB 1979); *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33 (TTAB 1976); TBMP § 708. Such advertising and promotional materials are not made admissible merely by virtue of their accessibility via the Internet. Next, defendant's Exhibit No. 90 appears to be a printout of an edition of an association's newsletter which is published on the Internet, and Exhibit No. 100 appears to be a printout from the Internet of a current list of publications published by and available from the Canadian Agricultural Library. We cannot determine on this record that Exhibit Nos. 90 and 100 were obtained [*9] from permanent-source printed publications. Accordingly, they are not the equivalent of NEXIS(R) articles which would be admissible under notice of reliance, but rather must be introduced by way of the testimony of the person who performed the Internet search and printed out the documents. *Cf. Raccioppi d/b/a Apogee Learning v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998). No such testimony is of record in this case. In short, for the reasons discussed above, we have not considered defendant's Exhibit Nos. 90, 100-102 and 106-111.

Having ruled on the parties' respective evidentiary objections, we now shall address the merits of plaintiff's Section 2(d) claims. First, we find that plaintiff has established that it has used the designation FOOD-TEK, at least as a trade name, since a time prior to defendant's first use of its YOUR FOOD TECH PARTNER mark. Defendant concedes as much. (Defendant's Brief at p. 21.) Plaintiff's prior trade name use is sufficient to establish plaintiff's priority in this case. *See Trademark Act Section 2(d)*. n3

n3 In its brief, defendant has argued that the designation FOOD-TEK is either generic for plaintiff's services or that it is merely descriptive and without secondary meaning as applied to those services. Defendant has made these arguments as alternatives to a third argument, i.e., that the designation FOOD-TEK or FOOD TECH is weak and diluted by numerous third-party uses, and that the mere presence of this designation in the parties' respective marks is an insufficient basis for finding the marks to be confusingly similar. However, defendant did not affirmatively allege in its answers to the notice of opposition and the petition to cancel that FOOD-TEK is generic or merely descriptive; those contentions were specifically made for the first time in defendant's brief on the case. Moreover, we cannot conclude on this record that those issues were tried by the express or implied consent of the parties, under *Fed. R. Civ. P. 15(b)*. Because plaintiff was not on notice that the asserted genericness and/or mere descriptiveness of the designation FOOD-TEK would be at issue in this case, we have not considered defendant's arguments and evidence as to those matters. Likewise, to the extent that defendant's generic-

ness and mere descriptiveness arguments are intended to support a contention that plaintiff does not have the requisite proprietary rights in the designation FOOD-TEK which are essential to plaintiff's standing and to its Section 2(d) ground of opposition, *see generally Otto Roth & Company, Inc. v. Universal Foods Corporation, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981)*, we have not considered the arguments. However, as part of our likelihood of confusion analysis, we have considered all of the admissible evidence of record as it pertains to the strength of, and the scope of protection to be afforded to, the FOOD-TEK designation. *See discussion infra.*

[*10]

We turn next to the issue of likelihood of confusion. Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See In re E.I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).*

Defendant's services, as recited in its application and in its registration, are "providing information regarding food ingredient use." Plaintiff's services, according to the testimony of plaintiff's president, include "prototype development, product development, solv[ing] technical problems, provid[ing] advice to food manufacturers as to food processes and ingredients and regulatory guidance, prototypes, and do[ing] reformulations." (Finkel testimony deposition at 3.) Likewise, plaintiff's marketing brochure states that plaintiff has "expertise in ingredient technology" and specializes "in solving technical problems relating to food preparation," including in the areas of product development, reformulation, cost control, regulatory guidance, nutrition labeling, and pilot and prototype production. (Plaintiff's Exhibit No. 6.)

Defendant's [*11] services, as recited in the application and in the registration, are encompassed within and are essentially identical to the services rendered by plaintiff. Additionally, given the legally identical nature of the parties' respective services and the absence of any restrictions in defendant's recitations of services, we also find that defendant's recited services and plaintiff's services are offered in the same trade channels and to the same classes of purchasers. These facts all weigh in support of a finding of likelihood of confusion in this case.

However, we find that defendant's mark YOUR FOOD TECH PARTNER and plaintiff's trade name FOOD-TEK, when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression, are sufficiently dissimilar that confusion is not likely to result from their contemporaneous use, even if such use is in connection with identical services offered in the same trade channels to the same classes of customers. *See Kellogg Co. v. Pack'Em Enterprises Inc., 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).*

Our finding that defendant's mark is dissimilar to plaintiff's trade name is based primarily on the [*12] evidence of record which establishes that FOOD TECH, the only element of defendant's mark which is at all similar to plaintiff's trade name FOOD-TEK, is at the very least a highly suggestive term as applied to the parties' services and as used in the food industry. It is undisputed that "food technology" is a generic term as applied to plaintiff's and defendant's services, and the evidence of record establishes that "food tech" would be understood by relevant purchasers to be a shorthand way of saying "food technology." It appears from the record that:

--"tech" is a recognized and commonly-used abbreviation for "technology." (Dictionary definition, defendant's Exhibit No. 88.)

--Plaintiff's president identifies himself as a "food technologist"; he stated that in adopting the name FOOD-TEK, he was trying to connote "food technology"; he stated that he probably has used "food tech" as a term of art to refer to "food technology." (Finkel Disc. Dep. at 30, 117.)

--"Surfin' the Food Tech Net" was used and advertised as the theme of the Eastern Food Science Conference X, held November 2-5, 1997 in Newport, Rhode Island. (Defendant's Exhibit No. 91.)

--In an article from the January 25, 1995 edition [*13] of *Journal* (Ogden Newspapers 1995), it was reported that Tim Louie, whose family manufactures fortune cookies and other food products in Seattle, Washington, "went to the University of Washington, where he majored in small business administration. He also took as many food tech classes as he could." (Defendant's Exhibit No. 95.)

Moreover, the evidence of record shows that the term FOOD TECH, and variants thereof, appear in the names of numerous third parties throughout the food industry, including third parties engaged in services of the very type provided by plaintiff and defendant:

--from Prepared Foods (November 1997): "FMC Food Tech is the new name of FMC's expanded food machinery business." (Defendant's Exhibit No. 94.)

--from Dallas/Ft. Worth Business Journal (Feb. 29 - March 6, 1988): "However, for its new microwave products, Zebbie's turned to Food Tech, a research and development company in Waxahachie [Texas]." (Defendant's Exhibit No. 96).

--from Food & Drink Daily (Dec. 5, 1994): "Food Tech's irradiation facility is located ten miles from headquarters in Plant City [Florida] . . ." (Defendant's Exhibit No. 97.)

--from The Des Moines Register [*14] (Dec. 1, 1996): "The three basic components of a successful new food product are experience, time and money, says Carol Lloyd of Austin Food Tech Inc., an Anaheim, Calif., contract food-product developer." (Defendant's Exhibit No. 98.)

--from Milling & Baking News (Oct. 21, 1997): "Thomas E. Belshaw, Food Tec, Inc., Renton Wash., chairman of the International Baking Industry Exposition Committee. . ." (Defendant's Exhibit No. 103.)

--from the 1997 IFT (Institute of Food Technologists) Annual Meeting Program and Food Expo Exhibit Directory (held June 14-18, 1997 in Orlando, Florida): "FOODTECH DENMARK" is listed in the Directory of Exhibitors (at p. 364). (Defendant's Exhibit No. 18.)

--from the July 1998 issue of Food Technology ("A Publication of the Institute of Food Technologists") at page 97: the magazine's "Reader Service Reply Center" for information on products and services advertised in the magazine features an electronic inquiry service called "IFT FOODTECH EXPRESS." (Defendant's Exhibit No. 17.)

Finally, it appears that numerous trade shows in the food industry use variations of the term "food tech" in connection with their trade shows, as is evidenced [*15] by the references to such shows found in the U.S. trade press:

--from the 1997 IFT (Institute of Food Technologists) Annual Meeting Program and Food Expo Exhibit Directory (held June 14-18, 1997 in Orlando, Florida): "FOOD TECH EXPO ONLINE" is the name of IFT's "online exhibition containing easily searchable virtual booths displaying exhibitor information on food industry products and services to professionals throughout the world." (Defendant's Exhibit No. 18.)

--Trade Shows Worldwide - An International Directory of Events, Facilities & Suppliers (Gale Research, 13th Ed. 1998) includes listings for ten different international trade shows directed to the food technology, food processing, and food packaging industries:

- "Anuga FoodTec" (Germany)
- "China Foodtech" (Hong Kong)
- "Foodtech" (New Zealand)
- "Foodtech Bangkok" (Bangkok)
- "Foodtech" Hong Kong
- "Foodtech" (Poland)
- "Foodtech Russia" (Russia)
- "Foodtech Shanghai" (China)
- "Levant Foodtech" (Germany)
- "PFP Expo/Foodtech South China (China)

--from Food Engineering News (Dec. 1994): an article about a trade show in Japan known as "Foodtech"

--from Dairy Foods (Jan. 1993): an article [*16] about a trade show in Germany called "DLG-Food Tech"

Based on this evidence that the term FOOD TECH is at least highly suggestive and also used by numerous third parties in the relevant industry, we find that purchasers are not likely to assume, merely because plaintiff's trade name is

FOOD-TEK and because the words FOOD TECH also appear in defendant's mark, that a source, sponsorship or other connection exists between defendant's and plaintiff's respective services.

Moreover, we agree with defendant's contention that its mark YOUR FOOD TECH PARTNER, viewed in its entirety and in light of the industry meaning and usage of the term FOOD TECH, connotes that defendant is available to be the customer's partner in the customer's endeavors in the field of food technology. That "partnership" connotation is not present in plaintiff's trade name FOOD-TEK.

The difference in the respective connotations of defendant's mark and plaintiff's trade name, along with the other obvious differences between the respective designations in terms of their appearance and sound, give defendant's mark and plaintiff's trade name overall commercial impressions which are sufficiently dissimilar to preclude [* 17] a finding of likelihood of confusion.

Because plaintiff has failed to establish the existence of a likelihood of confusion, its Section 2(d) claims in the opposition and the cancellation proceedings fail. No ground for opposition or cancellation having been established, the opposition and the cancellation accordingly are hereby dismissed.

However, it is apparent from defendant's arguments and evidentiary submissions that defendant deems the words FOOD TECH to be generic and/or merely descriptive as applied to services in the field of food technology. n4 We note that the recitation of services in defendant's application Serial No. 74/529,590, the application involved in this opposition proceeding, includes such services.

n4 See *supra* at footnote 3.

In view thereof, and assuming that defendant ultimately prevails in this opposition proceeding (that is, assuming that plaintiff does not appeal our dismissal of the opposition within the time allotted by the rules and that plaintiff does not prevail on any such appeal), the Board shall remand application Serial No. 74/529,590 to the Trademark Examining Attorney for a determination of whether it is appropriate to require defendant [* 18] to disclaim the words FOOD TECH apart from the mark as shown, pursuant to Trademark Act Section 6, 15 U.S.C. § 1056. See Trademark Rule 2.131, 37 C.F.R. § 2.131; see generally TBMP § 805. n5

n5 Defendant's Registration No. 1,896,675, involved in Cancellation No. 24,523, is not affected by the Board's remand of application Serial No. 74/529,590.

E. J. Seeherman

H. R. Wendel

C. M. Bottorff

Administrative Trademark Judges Trademark Trial and Appeal Board

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawSpecial MarksTrade NamesGeneral OverviewTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsCancellationsGroundsTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositions-Grounds

GRAPHIC:

Picture 1, no caption

EXHIBIT 9



Cited

As of: Mar 19, 2008

ALAN FRIDKIN and SANFORD DISHMAN, Plaintiffs, v. MINNESOTA MUTUAL LIFE INSURANCE COMPANY, INC., & ILLINOIS DIRECTOR OF INSURANCE, as AGENT for SERVICE OF PROCESS, Defendant.

No. 97 C 0332

UNITED STATES DISTRICT COURT FOR THE NORTHERN DISTRICT OF ILLINOIS, EASTERN DIVISION

1998 U.S. Dist. LEXIS 1017

**January 28, 1998, Decided
January 29, 1998, Docketed**

DISPOSITION: [*1] Plaintiffs' Motion to Compel GRANTED, in part, and DENIED, in part.

CASE SUMMARY:

PROCEDURAL POSTURE: Plaintiff insureds brought an action to recover benefits under several disability insurance policies, which they purchased from defendant insurer. The insureds alleged bad faith refusal to honor the terms of their policies, breach of contract, and unreasonable delay of benefit payments. The insurer had produced some redacted documents without a privilege log. The insureds propounded more discovery requests and a motion to compel.

OVERVIEW: The insurer objected to an interrogatory requesting information concerning the setting of reserves with respect to the disability insurance policies. The court overruled the objections because the information sought was relevant to the determination of bad faith. The insurer objected to the interrogatory seeking information about instances that the insurer was held liable for extra contractual or statutory damages. The court overruled the objections and found that the interrogatory was not overbroad and could lead to the discovery of relevant evidence. The insurer objected to providing the number of disability insurance policy holders as to whom claims had been denied on the ground that the earned income of the claimant was greater than 50 percent of the claimant's predisability earned income. The court over-

ruled the objection because the information was relevant to the bad faith claim and the insurer failed to show burdensomeness. The court overruled the insurer's objections to document requests, in part, and ordered it to produce documents, excluding legal authority and any other documents which were privileged, and that was to be indicated on an accompanying privilege log.

OUTCOME: The court granted the insureds' motion to compel the insurer's answers to interrogatories, it granted the insureds' request for production of responsive documents, and denied the insureds' request for documents that constituted legal authority or were privileged.

CORE TERMS: interrogatory, discovery, disability, legal authority, immaterial, responsive, aggregate, claimant, disability insurance, bad faith, work-product, burdensome, coverage, individual claim, relevant evidence, earned income, produce documents, computerized, reinstated, overbroad, automated, lapsed, adjusts, unduly, log, denied coverage, denial of coverage, discovery request, documents relating, course of conduct

COUNSEL: For ALAN FRIDKIN, SANFORD DISHMAN, plaintiffs: Michael Lee Brooks, Brooks, Cahill & Hanley, Ralph Edward Wilhoite, Jr., Frederick Martin Lerner, Lerner & Wilhoite, Chicago, IL.

For ILLINOIS DIRECTOR OF INSURANCE, MINNESOTA MUTUAL LIFE INSURANCE COMPANY

INC., defendants: Catherine A.T. Nelson, Blatt, Hammesfahr & Eaton, Chicago, IL.

For MINNESOTA MUTUAL LIFE INSURANCE COMPANY INC., defendant: Julia H. Perkins, Jenner & Block, Stephen Ryan Meinertzhagen, Blatt, Hammesfahr & Eaton, Chicago, IL.

JUDGES: ARLANDER KEYS, United States Magistrate Judge. Judge Ann C. Williams.

OPINION BY: ARLANDER KEYS

OPINION

MEMORANDUM OPINION AND ORDER

This matter comes before the Court on Plaintiffs' Motion to Compel. For the following reasons, the Court grants, in part, and denies, in part, the motion to compel.

Plaintiffs Alan Fridkin and Sanford Dishman¹ brought suit to recover benefits under several disability insurance policies which they purchased from Defendant Minnesota Mutual Life Insurance Company, Inc., ("Minnesota Mutual"). Each Plaintiff purchased two separate disability policies with Minnesota Mutual in April [*2] of 1975²

1 It appears that Plaintiffs are co-owners of the pharmacy at which they have worked for approximately the past thirty years.

2 This background discussion is in no way intended to constitute findings of fact. Rather, it is simply contextual information that has been gleaned from the parties' pleadings.

Mr. Fridkin's coverage under one policy lapsed, due to nonpayment of premiums, on October 11, 1993. That policy was reinstated on November 22, 1993. His other policy lapsed on March 10, 1994, and was reinstated on May 9, 1994. On November 20, 1995, Mr. Fridkin filed a notice of disability with Minnesota Mutual. Minnesota Mutual denied coverage under both of his policies.

Mr. Dishman's coverage under one policy lapsed for non-payment of premiums on March 10, 1994. That policy was subsequently reinstated. Mr. Dishman filed a disability notice claim with Minnesota Mutual on December 11, 1995. Minnesota Mutual denied coverage under that policy.³

3 It appears that there was no denial of coverage under the other (non-lapsed) policy.

[*3] On January 16, 1997, Minnesota Mutual removed the case from state court to the United States District Court for the Northern District of Illinois. On March

11, 1997, Plaintiffs filed their Amended Complaint. On July 14, 1997, Plaintiffs filed their Second Amended Complaint.

Plaintiffs seek damages for Minnesota Mutual's alleged bad faith refusal to honor the terms of their disability insurance policies. Plaintiffs allege breach of contract, as well as unreasonable and vexatious delay of benefit payments. It appears that Minnesota Mutual's denial of coverage stems chiefly from its interpretation of two provisions in the Plaintiffs' policies concerning lapses in coverage.

Pursuant to Judge Ann Williams' discovery procedures, Minnesota Mutual had provided Plaintiffs with documents prior to May 1, 1997. However, some of those documents were redacted, yet were unaccompanied by a privilege log. On May 1, 1997, Plaintiffs propounded the discovery that is at issue here. Minnesota Mutual did not respond by May 30, 1997. Plaintiffs sent a letter, on June 10, 1997, requesting a response to the discovery. Another similar letter was sent on July 14, 1997 -- the same date that the Second Amended [*4] Complaint was filed. On July 15, 1997, during a telephone conference, the parties mutually agreed to extend the deadline to August 4, 1997.⁴ On August 5, 1997, Plaintiffs received Minnesota Mutual's responses. The next day, Plaintiffs sent a letter indicating that there were problems with some of Minnesota Mutual's responses. Plaintiffs' Motion to Compel was filed on September 15, 1997.

4 In August of 1997, the firm of which Minnesota Mutual's attorney was formerly a partner decided to cease the practice of law. Minnesota Mutual's attorney left the firm on August 15, 1997.

During the briefing period, Minnesota Mutual supplemented its responses. Therefore, it appears that the only remaining dispute concerns: Interrogatories 4, 5, 8, 9, and 10; and Document Requests 7, 8, and 10.

Interrogatory 4

Interrogatory 4 requests the names of those individuals who have information concerning the setting or modifying of reserves, with respect to the disability insurance policies Plaintiffs purchased. Minnesota [*5] Mutual objects to this interrogatory on the grounds that it is irrelevant, immaterial, and not likely to lead to the discovery of relevant evidence. Notwithstanding Minnesota Mutual's characterization of the discovery request, the information sought is relevant to a determination of bad faith.

Gerald Agrimson's affidavit states that, "in setting reserves, Minnesota Mutual does not individually analyze or evaluate the claim or coverage based on factual

or legal considerations routinely made in claims analysis." (Minnesota Mutual's Resp. to Pls.' Mot. to Compel, Ex. A.) That affidavit further states that Minnesota Mutual adjusts its reserves "to reflect aggregate company experience." (Id.)

Minnesota Mutual has not indicated specifically how it sets or adjusts its reserves. Initially, the Court finds it improbable that, in all circumstances, Minnesota Mutual would never consider an individual claim (in setting reserves) no matter how large or how repercussive its effect could be on the aggregate. Furthermore, the Court notes that the fact that Minnesota Mutual adjusts its reserves to reflect "aggregate company experience" -- which was not defined in the affidavit -- might somehow involve [*6] taking individual claims into account.

It is entirely possible that whether or not the company expects to pay claims of the type at issue here (although not necessarily these specific claims) might be reflected in setting an aggregate reserve. Certainly, the method used to compute the "aggregate" reserve would be indicative of how Minnesota Mutual thinks its likely liability would be calculated under a policy. For example, in calculating reserves, Minnesota Mutual might account for the possibility of denying claims because claimants have substantial income from other sources: This would not require determination of any specific individual claims. Finally, the information concerning the setting of reserves and adjustments may illustrate how Minnesota Mutual interpreted its own policy at a time when there was no litigation surrounding it. Thus, the information sought is relevant to Plaintiffs' bad faith claim. Minnesota Mutual's objections are overruled, and it is ordered to answer Interrogatory 4.

Interrogatory 5

Interrogatory 5 seeks information about each instance, since January 1, 1987, in which a court of law or equity, or arbitration panel in the United States held [*7] Minnesota Mutual liable for extra contractual or statutory damages of any kind. Minnesota Mutual objects to this interrogatory on the grounds that it is overbroad, burdensome, irrelevant, immaterial, and not likely to lead to the discovery of relevant evidence.

Minnesota Mutual argues that Plaintiffs should do their own computer research on Westlaw or Lexis to get this information. Moreover, it argues that Plaintiffs do not allege an unreasonable or vexatious course of conduct and, therefore, this information is merely a fishing expedition. Notwithstanding Minnesota Mutual's objections, the Court finds that interrogatory 5 is not overbroad, unduly burdensome, or irrelevant; and finds that it may, in fact, lead to the discovery of relevant evidence. The fact that Plaintiffs have not yet alleged a continuing

course of conduct is not determinative; Plaintiffs have already alleged bad faith and, if Plaintiffs discover a pattern, may seek to amend their complaint to allege a continuing violation. Finally, many opinions are not reported on Lexis or Westlaw.⁵ Minnesota Mutual's objections are overruled, and it is ordered to answer Interrogatory 5.

5 See, *infra*, discussion of Document Request 7.

[*8] Interrogatory 8

Interrogatory 8 requests the number of Minnesota Mutual disability insurance policy holders as to whom claims or benefits have been denied on the ground that the "earned income" of the claimant was greater than fifty percent of the claimant's predisability earned income. Minnesota Mutual objects that this interrogatory is irrelevant and immaterial. It further objects that responding would be unduly burdensome, since it would have to "review virtually every claim, pending or not, by every insured." (Pls.' Mot. to Compel, Ex. 3.) Affiant Cheryl Wolf states that Minnesota Mutual would have to review every "existing" claim file, which will "exceed several thousand". (Minnesota Mutual's Resp. to Pls.' Mot. to Compel, Ex. C.)

First, the Court disagrees that the information sought in the interrogatory is irrelevant or immaterial -- again, this information is relevant to the bad faith claim, by showing what Minnesota Mutual did in similar cases. Next, it appears, at a minimum, that Minnesota Mutual's objection is overstated; the worst case scenario is not that every file would have to be reviewed -- only the files where claims were denied. Also, it seems likely [*9] that this information would be computerized or stored in some other automated form.⁶ In any event, it seems likely that some demographic information is kept computerized or in some other automated form regarding the holders of Minnesota Mutual's policies. The use of such information should enable the pool of denied claimants to be substantially narrowed. Minnesota Mutual has not revealed what demographic information, if any, is available in a computerized or automated format. By taking the position that a review would be unduly burdensome, without more information or explanation, Minnesota Mutual has failed to show overburdensomeness. Minnesota Mutual's objections are overruled, and it is ordered to answer Interrogatory 8.

6 The objection fails to state that each file would have to be manually reviewed. Indeed, by "review", Minnesota Mutual could very well mean that they would simply have to run a computer search.

Interrogatory 9

Interrogatory 9 requests the number of individuals, identified [*10] in response to Interrogatory 8, for whom Minnesota Mutual, in calculating their earned income, included any income received by a closely-held corporation in which the policyholder held a stock interest. Minnesota Mutual's objection for this Interrogatory is the same as its objection to Interrogatory 8. Because the Court's reasoning is the same as in the aforementioned Interrogatory, Minnesota Mutual's objections are overruled, and it is ordered to answer Interrogatory 9.

Interrogatory 10

Interrogatory 10 requests that Minnesota Mutual state each and every basis for its denial of Plaintiffs' disability claims. Minnesota Mutual did not object to this Interrogatory. Rather, it merely stated that a response could be derived from business records which had already been produced to Plaintiffs. Interrogatory 10 is a contention interrogatory, which is intended to narrow the issues for trial. This contention interrogatory asks Minnesota Mutual to indicate precisely its reasons for denying Plaintiffs' disability claims. Because the response to this interrogatory is vague and inadequate, Minnesota Mutual is ordered to properly, and completely, answer Interrogatory 10.

Document [*11] Request 7

Document Request 7 seeks all documents relating to any lawsuit or arbitration identified in Minnesota Mutual's response to Interrogatory 5. Minnesota Mutual's objection merely states that this request is "not applicable." (Pls.' Mot. to Compel, Ex. 3.) This objection is insufficient and is overruled. Minnesota Mutual must produce documents responsive to Document Request 7. Although it need not produce any documents which are available in the public domain, Minnesota Mutual must still identify the claimant, nature of the claim, court rendering judgment, case number, and date of judgment for those documents which are in the public domain. Thus, Minnesota Mutual is ordered to produce all non-publicly available documents which are responsive to Interrogatory 5, but need only identify other responsive documents which are a matter of public record.

Document Request 8

Document Request 8 seeks all documents identified in response to Interrogatories 11 and 12. As an initial matter, the Court notes that in its supplemental response, Minnesota Mutual failed to properly respond to Document Request 8. It merely referred to its prior response to Interrogatory [*12] 11 (and failed to make any mention of Interrogatory 12).

Interrogatory 11 seeks, with regard to each and every basis (for denial of Plaintiffs' disability claims)

identified in response to Interrogatory 10, all supporting documents, witnesses, and legal authority or industry/company policy. Minnesota Mutual's objection to Interrogatory 11: "subject to the General Objection" (objecting to Plaintiffs' Interrogatories to the extent that they seek information protected under the attorney-client privilege or attorney work-product privilege) is that the business records as well as other documents already produced answer Interrogatory 11 and, therefore, Document Request 8. (Minnesota Mutual's Sur-reply in Opp. to Mot. to Compel, Ex. A.) Minnesota Mutual also objects to identifying or producing any legal authority, because of the attorney work-product privilege.

Interrogatory 11 is a contention interrogatory, which is intended to narrow the issues for trial. This contention interrogatory asks Minnesota Mutual to indicate (and then, pursuant to Document Request 8, provide) the specific documents, witnesses, legal authority, or industry/company policy which supports its asserted bases for [*13] denying Plaintiffs' disability claims (and upon which it, presumably, will rely at trial). Minnesota Mutual is correct that the attorney work-product privilege protects it from identifying or turning over any legal authority. However, with respect to the documents, witnesses, and industry/company policy, Plaintiffs are entitled to a definitive answer and any documents in support thereof. Additionally, the Court notes that Minnesota Mutual's answer should not be made "subject to the General Objection". Rather, any document that Minnesota Mutual seeks to withhold based upon attorney-client privilege or attorney work-product privilege should be included on a privilege log; the privilege log should be provided to Plaintiffs.

Interrogatory 12 is also a contention interrogatory which seeks the bases for Minnesota Mutual's denial of certain allegations in Plaintiffs' Amended Complaint. Minnesota Mutual objected to Interrogatory 12 by stating that it was "not applicable." (Pls.' Mot. to Compel, Ex. 3.) It appears that the reason for this objection was that Interrogatory 12 specifically pointed to allegations in the Amended Complaint (however, before Minnesota Mutual answered the propounded [*14] discovery, Plaintiffs filed their Second Amended Complaint). (Pls.' Mot. to Compel, Ex. 1, August 6, 1997 letter.) However, this is not a valid reason to object. Minnesota Mutual should either have answered the discovery, even though it referred to the Amended Complaint, or should have compared/contrasted the Amended Complaint to the Second Amended Complaint and omitted any answers that appeared to be no longer relevant or likely to lead to the discovery of relevant information.

Thus, for the foregoing reasons, Minnesota Mutual's objections are overruled, in part, and it is ordered to produce documents responsive to Document Request 8, ex-

cluding legal authority, as well as any other documents which are privileged.

Document Request 10

Document Request 10 seeks, to the extent not produced pursuant to any other discovery request, all documents relating to Plaintiffs. Minnesota Mutual objects to this request as overbroad, overburdensome, irrelevant and immaterial. The Court finds that the Plaintiffs are entitled to all documents, unless privileged, which relate to them. Therefore, Minnesota Mutual's objections are overruled, and it is ordered to produce documents responsive [*15] to Document Request 10.

Fees and Costs

Finally, Plaintiffs' seek reasonable fees and costs associated with this Motion to Compel. Although Minnesota Mutual's discovery responses were deficient, the Court notes that much of it was likely due to the break-up of Minnesota Mutual's attorney's firm around the time responses were due. Thus, the Court declines to award any fees or costs in this matter.

IT IS THEREFORE ORDERED that Plaintiffs' Motion to Compel be, and the same hereby is, **GRANTED**, in part, and **DENIED**, in part, consistent with this Opinion.

DATED: January 28, 1998

ENTER:

ARLANDER KEYS

United States Magistrate Judge

EXHIBIT 10

LEXSEE

GREAT EARTH COMPANIES, INC. v. INTIMATE BEAUTY CORPORATION

Opposition No. 91160752

Trademark Trial and Appeal Board

2005 TTAB LEXIS 442

September 26, 2005, Mailed

CORE TERMS: opposer, registration, lotion, hair, declaration, summary judgment, commerce, dietary, cream, anywhere, channels, nutritional, website, pleaded, genuine issue of material fact, skin, nonmoving party, preparations, oil, gel, non-medicated, makeup, soap, matter of law, identification, hearsay, Trademark Act, personal use, third-party, referenced

JUDGES: [*1]

Before Hohein, Rogers, and Zervas, Administrative Trademark Judges

OPINION:

THIS DISPOSITION IS UNITED STATES PATENT AND TRADEMARK OFFICE NOT CITABLE AS PRECEDENT OF THE TTAB

WINTER/GREENBAUM

By the Board:

Applicant, Intimate Beauty Corporation d/b/a Victoria's Secret Beauty, seeks to register the mark "GREAT BODY" for use in connection with various personal body care products. n1 Great Earth Companies, Inc. opposes registration on the grounds that applicant's mark, when used on the goods identified in the application, will cause a likelihood of confusion among consumers, in view of opposer's previously used and registered mark "GREAT BODY" for "dietary food supplements." n2

n1 Application Serial No. 78284374 was filed on August 7, 2003 and seeks registration under Section 1 (b) of the Trademark Act. The goods set forth therein are as follows: personal care products, namely, aftershave gels, aftershave lotion, antiperspirant, artificial nails, astringent for the face, astringent for the skin, bath beads, bath oil, bath salts, blush, body glitter, body mist, body oil, body scrub, body wash, bubble bath, cologne, cream for the body, cream for the cuticles, cream for the eyes, cream for the face, cream for the feet, cream for the hands, deodorants for personal use, essential oils for personal use, exfoliating preparations for the skin, eye gels, eye makeup pencils, eye masks, eye shadow, face highlighter, face masks, face mist, face scrub, non-medicated foot soaks, face toners, foundation, fragrant body splash, fragrant body mist, hair conditioner, hair dyes, hair glitter, hair highlighter, hair mascara, hair pomade, hair rinses, hair removing creams, hair shampoo, hair spray, hair straightener, hair styling gel, hair styling mousse, lotion for the body, lotion for the face, lotion for the feet, lotion for the hands, lip balm, lip gloss, lip liner, lip makeup pencils, lipstick, makeup for the body, makeup for the face, makeup remover, mascara, massage cream, massage lotion, massage oil, nail polish, nail polish remover, nail stencils, non-medicated blemish stick, non-medicated cleanser for the face, non-medicated foot spray, non-medicated massage ointment, oil blotting sheets for the skin, perfume, powder for the body, powder for the face, powder for the feet, pumice stones for personal use, salt scrubs for the skin, shaving cream, shaving gels, shower cream, shower gel, skin bronzing cream, soap for the body, soap for the face, soap for the hands, sun block for the body, sun block for the face, suntan lotion for the body, suntan lotion for the face, sunless tanning lotion for

the body, sunless tanning lotion for the face, pre-suntanning lotion for the body, pre-suntanning lotion for the face, post-suntanning lotion for the body, post-suntanning lotion for the face and talcum powder.

[*2]

n2 Reg. No. 1333943, issued on May 7, 1985, claiming dates of first use anywhere and first use in commerce in February 1984. Sections 8 & 15 affidavits accepted and acknowledged.

In its answer, applicant denied the salient allegations in the notice of opposition and alleged, as putative affirmative defenses, that the goods on which it intends to use the mark are not related to opposer's goods, and that the channels of trade for the parties' respective goods are different because applicant only intends to sell its "GREAT BODY" personal care products in its "VICTORIA'S SECRET" retail stores, its mail order catalogs, and on-line at the "VICTORIA'S SECRET" website, located at <http://www.victoriasecret.com>.

This case now comes up on opposer's motion for summary judgment filed on September 30, 2004, on the issue of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d). The parties have fully briefed the issue, n3 and we have considered opposer's reply brief. *See* Trademark Rule 2.127(a).

n3 The parties' stipulation (filed October 29, 2004) to extend the time for applicant to respond to the motion for summary judgment until December 2, 2004, is approved.

[*3]

Standard of Review

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. *See Fed. R. Civ. P. 56 (c)*. A dispute as to a material fact is genuine only if a reasonable fact finder viewing the entire record could resolve the dispute in favor of the nonmoving party. *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). In deciding a motion for summary judgment, the Board must view the evidence in the light most favorable to the non-movant, and must draw all reasonable inferences from underlying facts in favor of the nonmovant. *Id.*

A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), and *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). When the moving party's motion is supported [*4] by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial.

The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial. In general, to establish the existence of disputed facts requiring trial, the nonmoving party "must point to an evidentiary conflict created on the record at least by a counterstatement of facts set forth in detail in an affidavit by a knowledgeable affiant." *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 941, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990), *citing Barmag Barmer Maschinenfabrik AG v. Murata Machinery, Ltd.*, 731 F.2d 831, 836, 221 USPQ 561, 564 (Fed. Cir. 1984). If the nonmoving party fails to make a sufficient showing on an essential element of its case with respect to which it would have the burden of [*5] proof at trial, judgment as a matter of law may be entered in favor of the moving party. *Fed. R. Civ. P. 56(c)*. *Celotex Corp.*, 477 U.S. at 322-323.

Opposer's Evidence

In support of its motion for summary judgment, opposer argues that there is no genuine issue of material fact inasmuch as the marks are identical, the goods are closely related, and the channels of trade are identical. As evidence thereof, opposer submitted the following:

(1) a "Notice of Reliance" n4 to which are attached USPTO TARR n5 database printouts regarding opposer's pleaded registration for the mark "GREAT BODY," n6 opposer's assertedly related registrations for trademarks and service marks that contain the term "GREAT," n7 and third-party registrations that set forth the same or related goods as those referenced in opposer's pleaded registration and in the subject application;

n4 Opposer did not need to submit the referenced materials under a notice of reliance in order to make them of record for present purposes. Rather, for purposes of a motion for summary judgment, the materials may be submitted as attachments or exhibits to a party's brief on the motion. *See* Trademark Rules 2.122(b), 2.122(d) (2), 2.122 (e), 2.122 (f), and 2.127 (e) (2). TBMP § 528.05(a) (2d ed. rev. 2004).

[*6]

n5 Trademark Application and Registration Retrieval (TARR), <http://tarr.uspto.gov/>.

n6 *See supra* note 2 regarding opposer's pleaded registration, Reg. No. 1333943.

n7 Opposer's other registrations referenced in its "Notice of Reliance" that contain the term "GREAT" include the following: "GREAT EARTH" (Reg. No. 975801, issued January 1, 1974, claiming March 9, 1972 as its dates of first use anywhere and first use in commerce for "vitamin and mineral supplements," Sections 8 & 15 affidavits accepted and acknowledged; and Reg. No. 1206686, issued August 31, 1982, claiming dates of first use anywhere and first use in commerce in April 1971 for various nutritional supplement and body care products, Sections 8 & 15 affidavits accepted and acknowledged); "GREAT EARTH" with Earth design (Reg. No. 1282027, issued on June 19, 1984, claiming January 10, 1976 as the dates of first use anywhere and first use in commerce, Sections 8 & 15 affidavits accepted and acknowledged); "GREAT EARTH" with stylized globe design (Reg. No. 1626545, issued on December 11, 1990, claiming dates of first use anywhere and first use in commerce in July 1989 for body and skin care products, and claiming dates of first use anywhere and first use in commerce in January 1989 for various dietary supplements and healthcare products, Sections 8 & 15 affidavits accepted and acknowledged); "GREAT SHAPE" (Reg. No. 1181818, issued on December 15, 1981, claiming June 17, 1980 as its dates of first use anywhere and first use in commerce, for a dietary supplement; Reg. No. 1598051, issued on May 29, 1990, claiming July 26, 1988 as its date of first use anywhere and August 18, 1988 as its date first use in commerce, for various body care preparations, and claiming June 17, 1980 as its dates of first use anywhere and in commerce for dietary and nutritional supplements and liquid meal replacements; and Reg. No. 2510624, issued on November 20, 2001, claiming dates of first use anywhere and first use in commerce in June, 2000 for magazines, newsletters and informational sheets in the fields of dietary supplements, health, nutrition, and the like); and "GREAT BREAKFAST" (Reg. No. 1644924, issued on May 21, 1991, claiming April 16, 1990 as its dates of first use anywhere and first use in commerce for dietary and nutritional supplements in the form of a drink mix).

[*7]

(2) status and title copies n8 of opposer's above-referenced pleaded and assertedly related registrations, which show that such registrations are subsisting and owned by opposer;

n8 The Board acknowledges receipt of the status and title copies of opposer's registrations, which were submitted on October 12, 2004, after opposer filed its motion for summary judgment. The Board prefers that an opposer, as the moving party, provide a status and title copy of its pleaded registration(s) with the notice of opposition under Trademark Rule 2.122(d)(1), or with the summary judgment motion. *See* TBMP § 528.05(d)(2d ed. rev. 2004). The Board discourages piecemeal submissions for summary judgment motions.

(3) declarations of Mel Rich, President of Phoenix Laboratories, Inc. ("Phoenix"), and Hallie Rich, a Phoenix employee, to which are attached numerous exhibits, including information downloaded from the Internet; and

(4) the declaration of Jay Geller, opposer's counsel.

In Mr. Rich's declaration, he states that Phoenix is related to opposer in that Phoenix and opposer are currently owned by the same parent entity, Evergood Products. He states further that Phoenix has continuously [*8] manufactured dietary supplements for opposer and its predecessor-in-interest, Great Earth International, Inc., since 1983. Attached to his declaration are, *inter alia*, printouts from several websites on the Internet, which are offered in support of opposer's contention that nutritional supplements and personal body care products have been advertised in connection with the same marks at the same websites on the Internet.

The declaration of Ms. Rich, which was submitted as an attachment to opposer's reply brief, comprises a series of statements documenting her Internet research on and telephone calls to various companies to confirm that they sell both cosmetics and supplements. Attached to the declaration are exhibits of downloaded materials printed in connection with Ms. Rich's searches on the Internet. n9

n9 Ms. Rich's declaration has little probative value inasmuch as she did not ask during her telephone calls whether any of the companies sell dietary supplements and cosmetic products under the same mark. Further, the Internet evidence attached thereto was largely repetitive of the evidence attached to the declaration of Mr. Rich and, thus, merits only limited consideration.

[*9]

Internet Evidence

Applicant objects to the Internet evidence attached to Mr. Rich's declaration, arguing that this evidence is "improperly authenticated hearsay" under Fed. R. Evid. 801. n10 In regard to the objection that the Internet evidence was not properly authenticated, we disagree with applicant's argument. *See Fed. R. Civ. P. 56(e)*. Internet materials submitted for purposes of summary judgment may be authenticated by an affidavit or declaration of the person who accessed the information on the Internet and who can identify the materials, including the nature, source and date of the materials. *See Raccioppi v. Apogee, Inc.*, 47 USPQ2d 1368, 1371 (TTAB 1998)(personal knowledge of content is not required; only the source of the information must be within the personal knowledge of the declarant). *See also* TBMP §§ 528.05(b) and (e) (2d ed. rev. 2004). Mr. Rich's declaration satisfies the requirements for authentication. To the extent that applicant objects to the Internet evidence as hearsay, the Board regards the Internet evidence for what it [*10] shows on its face, *i.e.* that the information was available to the public at the time the declarant accessed the Internet, and not as evidence of the truth of the statements made therein. For that reason, hearsay is not an issue with regard to the summary judgment motion. Instead, "the reliability of the information becomes a matter of weight or probative value" to be given to the proffered evidence by the Board. *Raccioppi*, 47 USPQ2d at 1371.

n10 Applicant specifically alleged that the Internet materials are "improperly authenticated hearsay under Federal Rule of Evidence 801 as they are being offered by Mr. Rich for the truth of the assertion" contained therein, namely, that the sites depicted do actually sell the products displayed (see applicant's opposition to the motion for summary judgment, page 7, n.4).

Priority

Inasmuch as opposer has pleaded a valid and subsisting registration for the mark "GREAT BODY," and has submitted a status and title copy thereof showing that the registration is currently subsisting and owned by opposer, priority is not an issue in this proceeding. *See King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). [*11] n11

n11 Mr. Geller's declaration includes a single exhibit that comprises segments of applicant's answers to opposer's first set of written interrogatories, and specifically highlights the interrogatory wherein opposer requested that applicant identify all products on which it has used the mark "GREAT BODY." Presumably, opposer submitted this evidence in support of its claim of priority and, specifically, in support of its contention that applicant has not commenced use of the mark "GREAT BODY" for any goods. Inasmuch as priority is not an issue in this proceeding, the Board need not address this evidence.

Likelihood of Confusion

As with any case in which likelihood of confusion is at issue, we analyze whether there exists a likelihood of confusion under the thirteen factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003); and *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). However, while we have considered each factor for which [*12] we have evidence, we focus our analysis herein on the relevant *du Pont* factors in this proceeding, namely, the appearance of the marks, the related nature of the goods, and the similarity of trade channels. *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1338, 57 USPQ2d 1557, 1559-1560 (Fed. Cir. 2001).

There is no dispute that the parties' marks, "GREAT BODY," are identical in appearance, sound, meaning and commercial impression. The identical nature of the marks weighs heavily against the applicant in the likelihood of confusion analysis. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566, 223 USPQ 1289, 1289-90 (Fed. Cir. 1984).

In regard to whether the parties' goods are related, it is well settled that when the marks at issue are identical, the relationship between the involved goods need not be as great or as close as in the situation where the marks are not identi-

cal or strikingly similar. *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981). It is "only necessary that there be a viable relationship between the goods [. . .] in order to support a holding of likelihood of confusion. [*13] " *In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983). See also *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989)("the greater the degree of similarity in the marks, the lesser the degree of similarity that is required of the products"). Moreover, "the use of identical marks can lead to the assumption that there is a common source," even when goods are not competitive or intrinsically related. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1983).

The evidence of record establishes that there is more than merely a viable relationship between applicant's goods and the goods set forth in the cited registration, such that a reasonable consumer, when viewing the identical marks, would be confused as to the source or sponsorship of the goods. *Id.* In particular, opposer's registrations for the marks "GREAT EARTH," n12 "GREAT EARTH" (with Earth design) n13 and "GREAT EARTH" (with stylized globe design) n14 set forth goods that are the same as, or highly similar to, the goods identified in both the subject application and the pleaded registration, thus illustrating [*14] that consumers would expect the involved goods to be marketed under a single mark. In the same manner, the following third-party registrations n15 also illustrate the related nature of the parties' goods:

. Reg. No. 2863532 n16 for the mark "SHANKARA", for *after-shave lotions, after-sun lotions, astringents for cosmetic purposes, bath beads, antiperspirants, essential oils for personal use, sun screen, sun tanning preparations*, and numerous other goods in International Class 3, which are set forth in the subject application; and for *dietary food supplements, nutritional supplements*, and vitamin and mineral supplements in International Class 5.

. Reg. No. 2771649 n17 for the mark "NATURE'S PICK" (and design) for *herbal skin soap*, in International Class 3, and *food supplements* in International Class 5.

. Reg. No. 2850755 n18 for the mark "L" with "mortar and pestle" design, for a full line of cosmetics and cleaning preparations, including *bubble bath, shampoo, hair styling gels, sun screen preparations, and after-shave lotions* in International Class 3, all of which are set forth in the subject application; and for a full line of pharmaceuticals, [*15] including *dietary and nutritional supplements*, vitamin and mineral supplements and herbal supplements in International Class 5.

. Reg. Nos. 2713751 n19 and 2079465 n20 for the mark "NATURAL MD" for, respectively, a full line of nonmedicated skin care, hair care and nail care preparations, including *after shave lotion, antiperspirants, suntanning creams and lotions, body and face soap, hair coloring creams and lotions*, and numerous other goods set forth in the subject application in International Class 3; and for *dietary supplements* in International Class 5.

Thus, the numerous registrations of opposer and the third-parties show that the goods listed therein, namely, various personal body care products and dietary and nutritional supplements, are of a type that may emanate from a single source in connection with the same mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993); *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). Accordingly, we find that the parties' goods are highly related.

n12 Reg. Nos. 975801 and 1206686, *supra* note 7.

n13 Reg. No. 1282027, *supra* note 7.

[*16]

n14 Reg. No. 1626545, *supra* note 7.

n15 Two of the nineteen third-party registrations referenced by opposer in its "Notice of Reliance" claim Section 44 (e) of the Trademark Act, 15 U.S.C. § 1126(e), as a basis for registration, without any use in commerce. For that reason, those registrations were accorded little probative value by the Board. See *In re Albert Trostel & Sons*

Co., 29 USPQ2d 1783, 1786 (TTAB 1993); In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988).

n16 Reg. No. 2863532, issued on July 13, 2004.

n17 Reg. No. 2771649, issued on October 7, 2003.

n18 Reg. No. 2850755, issued on June 8, 2004.

n19 Reg. No. 2713751, issued on May 6, 2003.

n20 Reg. No. 2079465, issued on July 15, 1997, Sections 8 & 15 affidavits accepted and acknowledged.

The evidence of record also shows that the channels of trade of the involved goods are highly similar, if not identical. Specifically, the Internet evidence attached to Mr. Rich's declaration illustrates that personal body care products and nutritional supplements have been advertised in connection [*17] with the same trademarks, and that such goods have been available for on-line purchase at some of those same websites. For example, a portion of Exhibit E to Mr. Rich's declaration shows that at the website of the "Melaleuca Wellness Center" (at www.melaleuca.com), a potential purchaser could view numerous nutritional health supplements and body care products under the "Health" and "Body" categories of the website, and could select any of those products for purchase. Similarly, the segment of Exhibit E related to "Dr. Murad" products shows that a potential purchaser could review various skincare products and healthcare supplements offered at the website (at www.murad.com) and could purchase them using the website's "Catalog Quick-order" feature. In view of this and similar evidence attached to Mr. Rich's declaration, we find that the involved goods are not only related, but they also have highly similar, if not identical, channels of trade.

Applicant argues that opposer's evidence is *de minimus* and insufficient to show the absence of a genuine issue as to whether the parties' respective goods are related. However, in stark contrast to opposer's submission of evidence, applicant [*18] did not designate specific portions of the record nor did it provide any evidence to show that there is a genuine factual issue as to whether the respective goods are related. n21 In view of the extensive evidence provided by opposer, applicant's unsupported argument is unpersuasive. See Octocom, 918 F.2d at 941, 16 USPQ2d at 1786 (Court determined that applicant's argument was "without evidentiary foundation" and "no more than [applicant's] disagreement with the board's [*sic*] ultimate conclusion on the likelihood-of-confusion issue").

n21 As we discussed more fully on page 4 herein, the nonmoving party must point to an evidentiary conflict created in the record, and cannot rely on mere allegations to show that there is a genuine issue as to a material fact. See Octocom, 918 F.2d at 941, 16 USPQ2d at 1786.

Applicant also argues that there is a genuine issue of material fact as to whether the channels of trade of the respective goods are different because its personal body care products will only be sold through its "VICTORIA'S SECRET" retail stores, website and catalog. Applicant's argument is not well taken. It is well settled [*19] that the determination of whether there is a likelihood of confusion must be based on the goods as they are identified in the involved application and pleaded registration. Octocom, 918 F.2d at 942, 16 USPQ2d at 1787. See also J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 1463, 18 USPQ2d 1889, 1882 (Fed. Cir. 1991); and Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Where there is no limitation on the channels of trade in the identification of goods in either the subject application or the pleaded registration, as in this proceeding, it is presumed that the identifications encompass all goods of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. Paula Payne Products Co. v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76 (CCPA 1973); Kalart Co. v. Camera-Mart, Inc., 258 F.2d 956, 119 USPQ 139 (CCPA 1958); In re Elbaum, 211 USPQ 639, 640 (TTAB 1981). For these reasons, the mere allegation in applicant's answer and the contention in [*20] its brief in opposition to the motion for summary judgment that the channels of trade for its goods will be limited are insufficient to raise a genuine issue of material fact. Fed. R. Civ. P. 56(e). See Octocom, 918 F.2d at 941, 16 USPQ2d at 1786 (nonmoving party's response was not supported by contradictory facts). Given the unrestricted identification of goods in the involved application and lack of evidence from applicant to contradict the evidence provided by opposer, n22 there is no basis for the Board to find that a genuine issue of material fact exists as to channels of trade.

n22 Notably, applicant did not plead a defense under Section 18 of the Trademark Act, 15 U.S.C. § 1068, that there would be no likelihood of confusion if its identification were restricted, and applicant did not attempt to amend its application to limit the channels of trade of its goods.

Upon careful consideration of the pleadings, the parties' arguments, the evidence submitted by opposer, and the absence of any evidence from applicant, and drawing all justifiable inferences in favor of applicant as the nonmoving [*21] party, we find that no genuine issue of material fact remains for trial, that opposer has established that there is likelihood of confusion between its mark and applicant's mark, and that opposer is entitled to judgment as a matter of law.

In view thereof, opposer's motion for summary judgment is **GRANTED**.

Accordingly, the opposition is sustained, and registration to applicant is refused.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark Law Likelihood of Confusion Similarity Appearance, Meaning & Sound General Overview Trademark Law-
Protection of Rights Registration Federal Registration Trademark Law U.S. Trademark Trial & Appeal Board Proceeding-
s Oppositions Grounds

EXHIBIT 11

LEXSEE

Leiner Health Services Corp. v. Time of Your Life, Inc.

Opposition No. 115,937 to Application No. 75/585,561 filed on November 12, 1998

Trademark Trial and Appeal Board

2002 TTAB LEXIS 461

February 19, 2002, Hearing

July 16, 2002, Decided

CORE TERMS: opposer, registration, vitamin, registered, dietary, herbal, third-party, food, skin, entirety, notice, shampoo, brand, soap, purchasers, pleaded, hearsay, channels, advertising, nutritional, deposition, appetite, generic, weak, hair, proper foundation, cross examination, likely to cause, judicial notice, deodorant soap

DISPOSITION:

[*1]

Decision: The opposition is sustained.

COUNSEL:

Michael A. Painter of Isaacman, Kaufman & Painter for Leiner Health Services Corp.

Richard L. Fortner, President, Time of Your Life, Inc., Pro se

JUDGES:

Before Simms, Hairston and Walters, Administrative Trademark Judges.

OPINION BY: WALTERS

OPINION:

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Opinion by Walters, Administrative Trademark Judge:

Leiner Health Services Corp. filed its opposition to the application of Time of Your Life, Inc. to register the mark shown below for "hair shampoo, skin soap, deodorant soap," in International Class 3, and "herbal supplements, herbal teas for medicinal use and medicated facial and body lotions and oils," in International Class 5. n1 The application includes a disclaimer of NUTRACEUTICALS apart from the mark as a whole.

[SEE ILLUSTRATION IN ORIGINAL]

n1 Application Serial No. 75/585,561, filed November 12, 1998, based upon an allegation of a bona fide intention to use the mark in commerce in connection with the identified goods.

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and [*2] registered word mark, YOUR LIFE, n2 and its design marks, shown below, for the goods identified in its respective registrations as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

[SEE ILLUSTRATION IN ORIGINAL] n3

[SEE ILLUSTRATION IN ORIGINAL] n4

n2 Registration No. 1,029,138, registered January 6, 1976 (Sections 8 and 15 affidavits accepted and acknowledged, respectively; renewed for a 10 year period as of January 6, 1996), for YOUR LIFE for "vitamins," in International Class 5; Registration No. 1,267,613, registered February 21, 1984 (Sections 8 and 15 affidavits accepted and acknowledged, respectively) for YOUR LIFE for "appetite suppressant," in International Class 5; and Registration No. 2,084,936, registered July 29, 1997, for YOUR LIFE for "providing information regarding vitamins and dietary food supplements by means of a global computer network" in International Class 42.

Opposer's notice of reliance included a certified copy of its Registration No. 2,084,936, noted above, which was not pleaded in the notice of opposition. In view of applicant's lack of objection, we find that the parties have tried, by implied consent, any issues which arise this additional registration, and we therefore deem the pleadings to be amended to include opposer's claim of ownership of this additional registration. See Fed. R. Civ. P. 15(b); Hewlett-Packard Co. v. Human Performance Measurement Inc., 23 USPQ2d 1390, fn. 7 (TTAB 1991); cf. Long John Silver's, Inc. v. Lou Scharf Incorporated, 213 USPQ 263, 266, fn. 6 (TTAB 1982); Boise Cascade Corp. v. Cascade Coach Company, 168 USPQ 795, 797 (TTAB 1970).

[*3]

n3 Registration No. 1,402,829, registered July 29, 1986 (Sections 8 and 15 affidavits accepted and acknowledged, respectively), for the design mark shown above for "vitamins and dietary food supplements," in International Class 5.

n4 Registration No. 1,596,015, registered May 15, 1990 (Sections 8 and 15 affidavits accepted and acknowledged, respectively; renewed for a period of 10 years as of May 15, 2000), for the design shown above for "vitamins and dietary food supplements," in International Class 5.

Applicant, in its answer, denied the salient allegations of the claim. Applicant admitted that opposer "has been in the business of manufacturing and selling vitamins and dietary food supplements, over-the-counter pharmaceutical products and skin and hair care products, all of which constitute personal care products which are related to one another"; and that "opposer is the owner of the marks identified in [paragraphs 2(a) through 2(d) of its notice of opposition, *i.e.*, the marks in opposer's claimed registrations]." Applicant asserted, affirmatively, that the parties' trademarks are dissimilar and that opposer's mark YOUR LIFE "is weak in that it is generic." n5 [*4]

n5 The allegation that opposer's mark is generic is a collateral attack on opposer's claimed registrations. This allegation has not been considered because applicant did not file a petition to cancel any of opposer's claimed registrations.

The Record

The record consists of the pleadings; the file of the involved application; certified status and title copies of opposer's pleaded registrations, made of record by opposer's notice of reliance; the responses of applicant to opposer's interrogatories and requests for admissions, made of record by opposer during its cross examination of applicant's testimony witness, Albert Sousa; the testimony deposition by opposer of Norbert Guziewicz, vice president of opposer's parent corporation, Leiner Health Products, Inc., with accompanying exhibits; and the testimony deposition by applicant of Albert Sousa, with accompanying exhibits. Both parties filed briefs on the case and an oral hearing was held, although applicant did not appear at the oral hearing.

Evidentiary Motions by Opposer

In its brief, opposer moved to exclude applicant's exhibits 3 - 9 to Albert Sousa's testimony and Mr. Sousa's testimony relating thereto. Opposer [*5] contends that the exhibits are irrelevant and immaterial, lack proper foundation, and that Mr. Sousa's testimony is hearsay. Applicant does not, in its brief, respond to opposer's evidentiary objections. Rather than consider the objections conceded, we address the merits of opposer's objections.

Applicant's testimony witness, Albert Sousa, described himself as a "retired senior health care executive" and a consultant "to national health care companies." Mr. Sousa, as part of his testimony, read portions of exhibits 3 - 9 into the record. On cross examination, Mr. Sousa acknowledged that he has no familiarity with the documents or the statements contained in those documents. As opposer notes, the exhibits objected to are copies of public records, i.e., print-outs from the PTO's U.S. Trademark Electronic Search System (TESS). These documents are amenable to submission with a notice of reliance. It follows that these documents are also amenable to submission in connection with testimony and that what constitutes proper foundation for public records is different from the necessary foundation for applicant's own business records. Because these TESS records include the official website [*6] from which they were downloaded and the date, we find these exhibits to be acceptable on their face as copies of third-party registrations and lists of third-party registrations. Third-party registrations are relevant in a case involving likelihood of confusion. Mr. Sousa's reading of the TESS documents is not hearsay. Therefore, these documents are properly of record and we deny applicant's motion to exclude exhibits 3 - 9.

However, applicant's exhibits 3 - 9 are of little, if any, probative value. Exhibits 3 and 9 are merely lists of third-party registrations with no reference to the goods or services or other pertinent registration facts. Such listings do not make the individual registrations of record and give us no information from which we can draw conclusions about other marks registered in the field of goods involved herein. Mr. Sousa stated, from his personal knowledge, that he was aware of the use of one of the listed marks on supplements sold at a gym where his children exercised. This is insufficient evidence to establish the nature or extent of use of that mark. Similarly, exhibits 4 - 8, copies of five third-party registrations of marks containing the phrase "your life, [*7] " do not establish the use of those marks. Finally, each case must be decided on its merits and we have no information in this record regarding the facts pertaining to the registration of these five marks.

Regarding Mr. Sousa's testimony, we have not considered any statements made based on speculation or hearsay. Those statements based simply on what Mr. Sousa had been told by Mr. Richard Fortner, applicant's president and representative conducting the testimony deposition, are hearsay.

Finally, in its brief, opposer asks the Board to take judicial notice of prior oppositions that opposer has brought against third parties seeking to register marks, that are referred to for the first time in opposer's brief. The evidence submitted is untimely. Therefore, this is not proper material for judicial notice and opposer's request is denied.

The Parties

Opposer manufactures vitamins, nutritional supplements and over-the-counter drugs. Opposer is the largest supplier of private label vitamins in the United States; and markets 223 vitamin and nutritional supplement products under its "flagship" brand, YOUR LIFE. Additionally, opposer has two lines of skin care products marketed under [*8] the marks BODYCOLOGY and NATURAL LIFE. Opposer's gross sales of its YOUR LIFE products went from approximately \$ 55 million in 1993 to more than \$ 100 million in 2000.

Opposer first began using the mark YOUR LIFE in 1972. It markets and sells its YOUR LIFE products to food, drug and mass retailers, selling to over 23,000 stores throughout the United States. Opposer advertises nationally both to the trade in numerous trade journals and to consumers through television and print media, including a substantial amount of cooperative advertising with retailers. Opposer's advertising costs ranged from more than \$ 4 million in 1993 to approximately \$ 11 million in 2000.

Opposer was a licensee of the U.S. Olympic Committee for its YOUR LIFE nutritional supplements between, at least, 1992 and 1996. YOUR LIFE vitamins are part of a 100-brand market segment called "broadline brands" and the YOUR LIFE brand ranks third nationally in this category (which translates to a 1.9% share of the entire vitamin market). Opposer also sells vitamin daily packs and has been a leader in this category since the 1970's, with a 53% market share. Opposer participates in market and brand awareness research and [*9] studies. A 1999 Gallup study of vitamin use in the United States concluded that 11% of all regular vitamin users in the United States are aware of the YOUR LIFE line of vitamins.

Applicant manufactures, distributes and retails dietary supplements and has been in this business since 1996 or 1997. n6

n6 In applicant's answers to opposer's interrogatories there are several apparent discrepancies regarding the dates applicant commenced its business and its use, if any, of its mark. Thus, no conclusions can be drawn in this regard.

Analysis

Inasmuch as certified copies of opposer's pleaded registrations are of record, there is no issue with respect to opposer's priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "the fundamental [*10] inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). See also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

With respect to the goods of the parties, we observe that there is a substantial overlap in the goods identified in the application and in the pleaded registrations and with opposer's established use. Applicant's "herbal supplements" are subsumed within opposer's "dietary food supplements" and "appetite suppressants," which encompasses herbal supplements to suppress appetite. Opposer's evidence establishes that its YOUR LIFE mark is used in connection with herbal supplements; and that its herbal supplements are advertised together with its "vitamins." Thus, applicant's goods in International Class 5 are identical, and closely related, to opposer's goods identified in its registrations.

Applicant's goods in International Class 3, hair shampoo, skin soap and deodorant soap, are personal care products. [*11] The evidence indicates that opposer also produces and sells skin care products, but under different marks. The evidence shows that opposer's NATURAL LIFE skin care products are advertised in print media as containing vitamin E and are shown in advertisements beside its dietary supplements. Applicant's shampoo and soaps encompass herbal and vitamin-enriched shampoo and soaps. Thus, we find that applicant's identified shampoo and soaps are sufficiently related to opposer's goods identified by its YOUR LIFE marks that confusion is likely if both parties' goods are identified by substantially similar marks. Further, in its answer, applicant admitted that opposer's goods are personal care products that are related to one another.

Both opposer's and applicant's identifications of goods are broadly worded, without any limitations as to channels of trade or classes of purchasers. We must presume that the goods of applicant and opposer will be sold in all of the normal channels of trade to all of the usual purchasers for goods of the type identified. See *Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In other words, we conclude that [*12] the channels of trade and class of purchasers of the parties' goods will be the same.

Turning to the marks, we note that while we must base our determination on a comparison of the marks in their entirety, we are guided, equally, by the well established principle that, in articulating reasons for reaching a conclusion on the issue of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Opposer contends that its mark is a strong and well known mark that is entitled to a broad scope of protection; that applicant's mark appropriates opposer's mark YOUR LIFE in its entirety; and that YOUR LIFE is the dominant portion of applicant's mark.

Applicant contends that opposer's mark is weak; that the design element of applicant's mark is significant and distinguishes the parties' marks; and that the parties' marks are significantly different when compared in their entirety.

Based on the evidence in this record [*13] we cannot agree with applicant that opposer's YOUR LIFE mark is weak. There is no credible evidence of third-party use or registration of similar marks and there is no evidence suggesting that YOUR LIFE is even minimally suggestive in connection with the goods identified in opposer's registrations. Rather, the evidence establishes that opposer's YOUR LIFE mark has been in use for almost 30 years; that significant sums of money have been spent over the years on advertising; that opposer's sales under the mark are substantial; and that the mark enjoys considerable renown in connection with the identified goods. Thus, opposer's YOUR LIFE mark is entitled to a broad scope of protection in this field of goods.

Although applicant's mark includes a design, the word portion, TIME OF YOUR LIFE NUTRACEUTICALS, is likely to be perceived as the dominant portion. The word portion of a mark comprised of both a word and a design is normally accorded greater weight because it would be used by purchasers to request the goods. *Ceccato v. Manifattura*

Lane Gaetano Marzotto & Figli S.p.A., 32 USPO2d 1192 (TTAB 1994); In re Appetito Provisions Co., 3 USPO2d 1553, 1554 (TTAB 1987); [*14] and Kabushiki Kaisha Hattori Tokeiten v. Scutto, 228 USPQ 461, 462 (TTAB 1985).

As an admittedly descriptive, if not generic, term, NUTRACEUTICALS does not add any distinguishing feature to applicant's mark. The phrase TIME OF YOUR LIFE in applicant's mark incorporates opposer's YOUR LIFE mark in its entirety. While the additional words lend a different connotation to "your life," it is a derivative connotation that still pertains to "your life," and, if used on identical or closely related goods in the same field, is likely to be perceived as a derivative line of products related to opposer's YOUR LIFE products and originating from the same source.

Therefore, we conclude that in view of the similarity in the commercial impressions of applicant's mark and registrant's marks, their contemporaneous use on the same and closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

It is well established that one who adopts a mark similar to the mark of another for the same or closely related goods or services does so at his own peril, and to the extent that we have any doubt as to likelihood of confusion, we [*15] must resolve that doubt against the newcomer and in favor of the prior user or registrant. See J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPO2d 1889 (Fed. Cir. 1991); In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPO2d 1025 (Fed Cir. 1988); and W.R. Grace & Co. v. Herbert J. Meyer Industries, Inc., 190 USPQ 308 (TTAB 1976).

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark Law Likelihood of Confusion Similarity Appearance, Meaning & Sound General Overview Trademark Law-
Protection of Rights General Overview Trademark Law U.S. Trademark Trial & Appeal Board Proceedings Oppositions-
Grounds

GRAPHIC:

Illustrations 1 through 3, no caption

EXHIBIT 12

LEXSEE

Minka Lighting, Inc. v. Ambiance Imports, Inc.

Opposition No. 91125325 to application Serial No. 75519110 filed on July 15, 1998

Trademark Trial and Appeal Board

2004 TTAB LEXIS 469

August 6, 2004, Mailed

CORE TERMS: opposer, ambience, furniture, deposition, registration, showroom, catalog, accessory, product line, lighting, distributing, featuring, notice, customer, entirety, import, impression, decorative, wholesale, discovery, designer, assigned, lamp, ambience, distributorships, retailer, fixtures, invoices, generic, mirrors

DISPOSITION:

[*1]

Decision: The opposition is sustained.

COUNSEL:

Lisa H. Meyerhoff, Susan E Powley and Timothy G. Ackermann of Jenkins & Gilchrist for Minka Lighting, Inc.

James E. Davis and Robert McCutcheon of Davis Munck, P.C. for Ambiance Imports, Inc.

JUDGES:

Before Quinn, Hairston and Drost, Administrative Trademark Judges.

OPINION BY: HAIRSTON

OPINION:

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Opinion by Hairston, Administrative Trademark Judge:

Minka Lighting, Inc. (opposer) has opposed the application of Ambiance Imports, Inc. (applicant) to register the mark AMBIANCE IMPORTS for "wholesale distributorships featuring furniture; [and] import agency services featuring furniture." n1

n1 Application Serial No. 75519110, filed July 15, 1998, and asserting first use and first use in commerce on February 28, 1995.

As grounds for opposition, opposer has alleged that since prior to the filing date of applicant's application, opposer has been engaged in the business of importing, distributing and selling a wide variety of products, including electric lighting fixtures, lamps, and home decorative items, including furniture, mirrors, wall art and accessories; that it [*2] is the owner of Registration No. 2,225,601 (issued February 23, 1999) for the mark AMBIENCE for "electric lighting fixtures and lamps;" that it is the owner of application Serial No. 75698326 filed May 5, 1999 for the mark AMBIENCE for "furniture, mirrors, wall art and accessories, namely carvings, decorative figures, figurines and sculptures made of foam, wood and resins and decorative furniture corbels and sculpture reliefs made of foam, wood and resin;" that opposer acquired the above registration and application by assignment from L. D. Kichler Co. (Kichler) on July 31, 2001; and that applicant's mark, when used in connection with its services, is likely to cause confusion, or to cause mistake or deceive.

Applicant, in its answer, has denied the salient allegations of the notice of opposition. In addition, as "affirmative defenses", applicant has asserted that opposer and its predecessor-in-interest knew of applicant's use of the mark AMBIENCE IMPORTS and that "opposer is guilty of acquiescence, estoppel, laches and unclean hands;" and that opposer has used the phrase AMBIENCE LIGHTING, not AMBIENCE per se, and thus opposer's registration for the mark AMBIENCE is a mutilation. [*3]

PRELIMINARY MATTERS

Before turning to the record and the merits of the case, there are several preliminary matters, including evidentiary objections, we must discuss.

At the outset, we note that applicant did not pursue at trial its affirmative defenses of acquiescence, estoppel, laches and unclean hands. Thus, we have given no consideration to these defenses.

We note that accompanying applicant's brief is a "Documentary Appendix" that consists of six documents produced by applicant in response to opposer's discovery requests. Materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony. See TBMP § 704.05 (2d ed. rev. 2004). Since these documents were not previously made of record during applicant's testimony period, they are not properly of record and we have given them no consideration in reaching our decision herein.

Applicant has filed a motion for leave to file a surreply brief along with a surreply brief. Opposer has filed a brief in opposition to applicant's motion. There is no provision in the Trademark Rules of Practice for filing a reply brief by a party in the [*4] position of defendant. See TBMP § 801.02 (2d ed. rev. 2004). Applicant's motion is accordingly denied and its surreply brief will be given no consideration.

On February 4, 2004, applicant filed a paper styled "Applicant's Objections to Opposer's Trial Evidence," wherein applicant moves to strike the testimony depositions of opposer's witnesses Marguerite Capozzi, Harvey Salgado, and Dee Moss in their entireties; and to strike portions of each of these testimony depositions and the testimony depositions of opposer's witnesses Roy Minoff and Tom Kubek. As grounds for the motion to strike the testimony depositions of Capozzi, Salgado and Moss in their entireties, applicant argues that pursuant to a consented motion for an extension of time, opposer's testimony period was extended until May 13, 2003 for the limited purpose of taking the testimony depositions of opposer and its predecessor-in-interest Kichler; that during this extension opposer took the testimony depositions of Capozzi, Salgado, and Moss who are "independent contractors" and not representatives of opposer or Kichler; and that since opposer was not entitled to take the testimony of these "non-party" witnesses during the [*5] extension, the testimony depositions should be stricken in their entireties.

Opposer, on the other hand, contends that although Capozzi, Salgado and Moss are not officers or employees of opposer or Kichler, opposer designated the witnesses to testify on its behalf as corporate representatives of opposer; and that the witnesses are independent sales representatives who appeared voluntarily.

A review of the agreed-upon extension reveals that it was for the purpose of "conducting additional depositions of Minka Lighting, Inc. and Kichler Lighting. . . ." We do not view this extension as limiting opposer to taking the depositions of officers or employees of opposer or Kichler. Moreover, it does not appear that applicant raised this objection at the time of the depositions. In fact, applicant's counsel cross-examined each of the witnesses. Under the circumstances, applicant's motion to strike the Capozzi, Salgado and Moss depositions in their entireties on this basis is denied. Thus, we consider the depositions to be properly of record.

As noted above, applicant also has objected to specific portions of the testimony of opposer's witnesses. The objections are simply too numerous to [*6] allow individual rulings thereon. In reading the record, we have considered the testimony and exhibits in light of applicant's objections. Where we have relied on testimony or evidence to which applicant raised an objection, it should be apparent to the parties that in doing so we implicitly have deemed the material to be admissible.

There are, however, several objections we specifically address here. Applicant has objected to the testimony of Ms. Capozzi regarding the purchase of Ambience Lighting & Accessories by Kichler and the transfer of the rights to the AMBIENCE mark on the ground that the testimony violates Fed. R. Evid. 1002 because the actual purchase agreement was not produced.

We do not find applicant's objection to the testimony based on Fed. R. Evid. 1002 to be well-taken. This rule provides as follows:

To prove the content of a writing, recording, or photograph, the original writing, recording, or photograph is required, except as otherwise provided in these rules or by an Act of Congress.

None of Ms. Capozzi's testimony purported to recite the content of the written agreement between [*7] Ambience Lighting & Accessories and Kichler. In any event, as noted in the Advisory Committee Notes with respect to Fed. R. Evid. 1002, "an event may be proved by nondocumentary evidence, even though a written record of it was made."

Applicant also has objected to the testimony of Roy Minoff concerning the transfer of the assets of Ambience Lighting & Accessories to Kichler and from Kichler to opposer. Applicant complains that Mr. Minoff lacks personal knowledge concerning the actual negotiations between the parties and that his testimony likewise violates Fed. R. Evid. 1002. Mr. Minoff did not testify about the content of any particular document, rather he testified to the fact that the transfer of assets and records from Ambience Lighting & Accessories to Kichler and from Kichler to opposer occurred. For the reasons stated above, we find that the testimony does not violate Fed. R. Evid. 1002. Also, as Kichler's Chief Administrative Officer, Mr. Minoff was certainly in a position to have the requisite knowledge of the transfers. Thus, applicant's objection to Mr. Minoff's [*8] testimony on the ground of lack of personal knowledge is not well taken.

Further, applicant objects to the testimony of opposer's witnesses Minoff, Moss, Salgado, and Kubek concerning purported instances of actual confusion. Applicant's objections are based on hearsay and are discussed infra in our likelihood of confusion analysis.

We note that Exhibit 4 to opposer's notice of reliance consists of two of opposer's invoices. Invoices generally are not proper subject matter for a notice of reliance and thus we have not considered them in reaching our decision herein. See Trademark Rule 2.122(e).

THE RECORD

The record thus consists of the file of the involved application; and opposer's first notice of reliance on applicant's responses to certain of opposer's interrogatories and request for production of documents, and the discovery deposition of the president and owner of applicant, George Moussa. In addition, opposer submitted the testimony depositions of its witnesses Roy Minoff, Ron Rotenberg, Marguerite Capozzi, Tom Kubek, Dee Moss, and Harvey Salgado (with exhibits).

Applicant did not take testimony. The only evidence properly made of record by applicant is a notice [*9] of reliance on its certificate of incorporation and copies of notices issued by the Department of Treasury advising applicant that it has been assigned an employee identification number and accepted as an "S" corporation.

Both parties filed briefs on the case, but an oral hearing was not requested.

PRIORITY

We turn first to the question of priority. Opposer's witness Marguerite Capozzi, a designer and manufacturer of home accessories, testified that she began working for Ambience Lighting & Accessories in 1986. In 1988 she and Zoltan Kovacs became co-owners of Ambience Lighting & Accessories. The company, which was headquartered in California, subsequently incorporated in 1994, with Mr. Kovacs and Ms. Capozzi each owning 50% of the stock. Ms. Capozzi testified that during her association with Ambience Lighting & Accessories, the company continuously used the mark AMBIENCE in connection with lighting, home accessories and furniture. In particular, the AMBIENCE mark appeared on hang tags for furniture, on boxes in which products were shipped, in catalogs, on invoices, and on signs in the windows of the Ambience Lighting & Accessories showrooms. The company did business throughout [*10] the United States and had wholesale showrooms in both Dallas, Texas and High Point, North Carolina.

Ms. Capozzi testified that in late 1997 Kichler purchased Ambience Lighting & Accessories. The sale included the entire AMBIENCE product line as well as the rights to the AMBIENCE mark.

Ron Rotenberg was General Manager of Kichler at the time of Kichler's purchase of Ambience Lighting & Accessories. Mr. Rotenberg testified that Kichler continued to sell many of the products that Ambience Lighting & Accessories had sold under the AMBIENCE mark. In particular, Kichler used the AMBIENCE mark on lamps, chandeliers, home accessories, statues, mirrors and furniture such as benches, tables, end tables, and accent tables. In addition, Kichler used independent sales representatives to market its products and continued to do business with many of the same

customers. Mr. Rotenberg testified that Kichler used the AMBIENCE mark in catalogs distributed nationwide to lighting and furniture showrooms, on hang tags and cartons in which products were sold, and on invoices and other business documents. n2

n2 The sales and advertising figures of Kichler were submitted under seal.

Roy Minoff [*11] is the Chief Administrative Officer of Kichler. Mr. Minoff testified that Kichler used independent sales representatives to sell its products and that such products were sold throughout the United States. Kichler's customers included furniture retailers of all sizes and lighting showrooms. In July 2001, Kichler sold the AMBIENCE product line, including all rights to the AMBIENCE mark to opposer.

Tom Kubek is vice president of sales and marketing for the Ambience Division of opposer, Minka Lighting, Inc. Opposer is headquartered in Corona, California and opposer conducts business throughout the United States. Opposer itself first used the AMBIENCE mark in September 2001 after it acquired the AMBIENCE product line and mark from Kichler. Opposer primarily uses independent sales representatives to sell its AMBIENCE products which include lighting fixtures, chandeliers, fans, furniture, decorative accessories and mirrors.

Opposer sells its AMBIENCE products through independent sales representatives to retail furniture stores, lighting showrooms, designers and interior decorators. Opposer advertises its AMBIENCE products in trade magazines, through invitations to retailers to visit opposer's [*12] product showrooms, and at its wholesale showrooms where the products are displayed. n3 The AMBIENCE mark appears on hangtags, packaging, on signs at the showrooms, and in opposer's catalogs. Opposer also promotes its products through attendance at trade shows in Dallas, Texas and High Point, North Carolina.

n3 Opposer's sales and advertising figures also were submitted under seal.

The information we have about applicant comes from the discovery deposition of its president and owner, George Moussa, and applicant's responses to opposer's interrogatories. Applicant is headquartered in Dallas, Texas and is an importer/wholesaler of furniture. Applicant sells furniture to furniture retailers, designers and design studios throughout the continental United States. Applicant uses independent sales representatives to market its products. Applicant presently markets its goods and services through its showroom in Dallas, Texas, and by way of catalogs, attendance at trade shows and advertisements in trade publications.

For purposes of priority, opposer claims that it and its predecessors in interest have used the AMBIENCE mark since as early as 1986 for furniture and the services [*13] of distributing furniture. In particular, opposer claims "the record evidence establishes an unbroken chain of use of the "AMBIENCE" mark in connection with furniture products and the distribution of furniture products starting with Ambience Lighting & Accessories (from 1986-1997); continuing with Kichler (from 1997-2001); and continuing with Minka (from 2001 through the present)." Brief at 8. n4

n4 We note that in discussing priority in its brief, opposer includes a reference to its pleaded Registration No. 2, 225, 601: "Minka also owns the federal 601 Registration for "AMBIENCE" for "electric lighting fixtures and lamps." (Brief, p. 29). Opposer attached a plain copy of the registration to the notice of opposition. However, opposer failed to make the registration properly of record during its testimony period. That is, opposer did not submit a status and title copy of the registration under notice of reliance, and although a plain copy of the registration is part of opposer's exhibit 17, opposer did not offer evidence that the registration is still subsisting and owned by opposer. See TBMP § 704. 03 (b) (1) (A) (2d ed. rev. 2004). Under the circumstances, opposer may not rely on this registration for purposes of priority, but rather must rely on its common law rights in the AMBIENCE mark.

[*14]

With respect to applicant, it claims that it first used the mark AMBIANCE IMPORTS in February 1995. Further, applicant argues that the earliest date of first use on which opposer may rely is 1997, the date on which Kichler began use of the AMBIENCE mark. Applicant argues that opposer may not rely on any use of AMBIENCE by Ambience Lighting & Accessories because opposer did not make of record the assignment of the AMBIENCE mark from Ambience Lighting & Accessories to Kichler. Moreover, applicant argues that there is no evidence that Ambience Lighting & Accessories used the mark AMBIENCE per se. Rather, according to applicant, the record shows that Ambience Lighting & Accessories only used the mark "Ambience Lighting & Accessories" which is not the legal equivalent of AMBIENCE; and thus opposer may not tack Ambience Lighting & Accessories to AMBIENCE.

Contrary to applicant's contention, the record establishes that Ambience Lighting & Accessories did use AMBIENCE per se in a trademark manner. In this regard, we note the following use of AMBIENCE in Ambience Lighting & Accessories' 1989 catalog:

Dear Ambience Customer:

It is our pleasure to present our 1989 Catalogue.

Each [*15] lamp and accessory has been created for Ambience by the Capozzi Kovacs Design Firm, carefully crafted and hand finished in our studio.

Our aim is to provide you with the best Quality, Design, Service and Selection.

The results are beautifully appealing. Make Ambience the pride of your store and for your customer.

We look forward to serving you.

Thank you.

Marguerite Capozzi

Also, reproduced below is an example of a hangtag which was placed on furniture, lighting and accessories that Ambience Lighting & Accessories sold from 1986 through 1997. As used on these hangtags, AMBIENCE projects a separate and distinct commercial impression from "Ambience Lighting Accessories".

[SEE ILLUSTRATION IN ORIGINAL]

With respect to the assignment of the AMBIENCE mark from Ambience Lighting & Accessories to Kichler, we observe that "an assignment in writing, however, is not necessary to pass common law rights to trademarks." Gaylord Bros. v. Strobel Products Co., 149 USPQ 72, 74 (TTAB 1963). See also Hi-Lo Manufacturing Corp. v. Winegard Co., 167 USPQ 295, 296 (TTAB 1970). In the event that there is no written assignment:

An assignment [*16] or transfer of interest in a trade designation may be established by clear and uncontradicted testimony by a person or persons in a position to have knowledge of the transactions affecting said designations; and the common law rights in a mark will be presumed to have passed, absent contrary evidence, with the sale and transfer of the business with which the mark has been identified.

Sun Valley Co. v. Sun Valley Manufacturing Co., 167 USPQ 304, 309 (TTAB 1970).

In this case, the testimony of opposer's witnesses is sufficient to establish that Ambience Lighting & Accessories assigned the AMBIENCE mark to Kichler. In this regard, Marguerite Capozzi testified as follows:

Q. Okay. So in 1997 you and Mr. Kovacs sold the company to Kichler and you sold the assets of the company to them?

A. Yes.

Q. And you also sold the Ambience mark and the goodwill associated with that mark to Kichler?

A. Yes.

(Dep., p. 31).

Also, in this regard, Roy Minoff testified as follows:

Q. Who did Kichler acquire the Ambience product line from in the 1997-98 time frame?

A. We bought the assets from two individuals, I believe. I don't think there [*17] was a corporate entity there. Marguerite Kapozi [sic] and Zoltan Kovacs.

Q. At the time Kichler acquired the mark and product line from those two individuals, did they, in fact, transfer all of their rights in the mark to Kichler.

A. Yes, I believe so.

(Dep., pp. 11-12). n5

n5 Mr. Minoffs belief that the assets and mark were purchased from Capozzi and Kovacs rather than the corporate entity Ambience Lighting & Accessories is understandable inasmuch as these two individuals were the sole stockholders of the corporation.

Further, there is no dispute and the record establishes that Kichler assigned its rights in the AMBIENCE mark to opposer. In this regard, we note the following testimony of Mr. Minoff:

Q. Up to a certain point in time, did Kichler have a product line that it offered and sold under the mark Ambience?

A. Yes, it did.

Q. And was that up to the time of approximately July 2001?

A. Yes.

Q. I'd like to focus our remaining questions on Kichler's Ambience product line. Did you sell that product line, including the mark to Minka?

A. Yes, we did.

Q. In July of 2001.

A. Yes, we did. Approximately late in [*18] 2001. I'm not sure of the exact date, maybe July, might be a few months later.

Q. To your understanding, did Kichler transfer all of its rights in the Ambience mark to Minka in connection with that asset sale?

A. That is my understanding.

(Dep., pp. 10-11).

In view of the foregoing, we find that Ambience Lighting & Accessories used the mark AMBIENCE at least as early as 1986 in connection with furniture and distributing furniture. Further, the record establishes that Ambience Lighting & Accessories assigned the mark to Kichler in 1997 and that Kichler assigned the mark to opposer in 2001. Moreover, there is no dispute and the record establishes that since 2001 opposer has continuously used the mark AMBIENCE in connection with furniture and distributing furniture. Thus, for purposes of priority, opposer is entitled to rely on use of the mark AMBIENCE in connection with furniture and distributing furniture at least as early as 1986.

In the absence of any testimony or evidence, the earliest date of use upon which an applicant may rely is the filing date of its application. See, e.g., Lone Star Mfg. Co., Inc. v. Bill Beasley, Inc., 498 F.2d 906, 182 USPQ 368, 369 (CCPA 1974) [*19] and Chicago Corp. v. North America Chicago Corp., 20 USPQ2d 1715 (TTAB 1991). As previously noted, applicant did not take testimony herein nor did it properly make any other evidence of record concerning its claimed date of first use. The only evidence of record concerning applicant's claimed date of first use, namely, February 28, 1995, comes from the discovery deposition of applicant's president George Moussa. When asked about its first use of the AMBIANCE IMPORTS mark, Mr. Moussa testified as follows:

Q. And you first offered goods and services under the mark for sale in October of 95, correct?

A. We traveled in the Philippines in February of 95, so that's when we first started marketing our name of Ambiance Imports. We did not actually have any product to sell until October of 95 when we present - when we showed at the High Point Furniture Show.

Q. So February 95 was the first date of use of Ambiance Imports mark?

A. Yes, you could say that.

(Moussa discovery dep., pp. 30-31).

This testimony, however, is conclusory and it is unclear as to the services in connection with which the AMBIANCE IMPORTS mark was purportedly used. Thus, the [*20] earliest date of use upon which applicant may rely for purposes of priority is July 15, 1998.

Opposer, therefore, clearly has priority in this proceeding.

LIKELIHOOD OF CONFUSION

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 likelihood of confusion factors set forth in In re E. I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "the fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of the differences in the essential characteristics of the goods [and services] and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

First, we turn to a determination of whether applicant's mark and opposer's mark, when compared in their entireties in terms of appearance, sound, and connotation, are such that they create similar overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather [*21] whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods and services offered under the respective marks is likely to result. See Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975).

Opposer contends that its AMBIENCE mark and applicant's AMBIANCE IMPORTS mark are highly similar in commercial impression.

Applicant, on the other hand, argues that the inclusion of the word IMPORTS in its mark serves to distinguish the parties' marks. Further, applicant contends that opposer's AMBIENCE mark is "a commonly-used, generic word and as such, it is a very weak mark that is entitled to little protection." Brief, at 12.

Based on the evidence in this record, we cannot agree with applicant that opposer's AMBIENCE mark is weak. There is no credible evidence of third-party use or registration of similar marks and there is no evidence suggesting that AMBIENCE is generic in connection with furniture and the services of distributing furniture. Rather, the evidence establishes that opposer and its predecessors in interest have used the AMBIENCE mark for over ten years; that a good amount of money [*22] has been spent over the years on advertising and promotion; and that sales under the mark are fairly significant. Thus, opposer's AMBIENCE mark is entitled to the normal scope of protection in opposer's field.

We find that opposer's AMBIENCE mark and applicant's AMBIANCE IMPORTS mark are highly similar in sound, appearance, meaning and overall commercial impression. In considering opposer's mark vis-a-vis applicant's

mark, we recognize that the highly descriptive, if not generic, (and disclaimed) IMPORTS portion of applicant's mark cannot be ignored. Giant Food, Inc. v. National Food Service, Inc., 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1993). However, although we have resolved the issue of likelihood of confusion by a consideration of the marks in their entireties, there is nothing improper in giving more weight, for rational reasons, to a particular feature of a mark. In this case, we have given more weight to the AMBIANCE portion of applicant's mark which is virtually identical to the entirety of opposer's AMBIENCE mark. n6 This is so because of the highly descriptive, if not generic, nature of the disclaimed word IMPORTS. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). [*23] See also Cunningham v. Laser Golf Corp., 222 F. 3d 943, 55 USPQ2 1842, 1845 (Fed. Cir. 2000) [Court held that the addition of the descriptive word "swing" to registrant's LASER mark still resulted in a likelihood of confusion].

n6 We take judicial notice that "ambience" is an alternative spelling of "ambiance" and that "ambiance" is defined as "the atmosphere surrounding one; environment." The American Heritage Dictionary of the English Language (1976). The Board may take judicial notice of dictionary entries. See, e.g., University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

We turn then to the parties' goods and services. Opposer argues that its goods and services, namely, furniture and distributing furniture are identical and otherwise closely related to the services identified in applicant's application, namely "wholesale distributorships featuring furniture" and "import agency services featuring furniture."

Applicant, on the other hand, argues that:

Moreover, Applicant and Opposer deal in substantially different types [*24] of goods, with only minimal overlap. Specifically, applicant deals mainly in large furniture or "case goods", such as armoires, chests of drawers, vanities and fireplace mantles and does not sell lighting and decorative accessories, whereas, in contrast, Minka sells primarily lighting and decorative accessories and does not sell large furniture or "case goods."

(Brief, p. 12)

It is well settled that the issue of likelihood of confusion in a proceeding such as this must be determined on the basis of the goods or services specified in the subject application vis-a-vis those set forth in opposer's registration and/or those to which opposer has proved prior use of its pleaded mark. Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); CTS Corp. v. Cronstoms Manufacturing, Inc., 514 F.2d 780, 185 USPQ 773 (CCPA 1975); and Tony Lama Co., Inc. v. Anthony Di Stefano, 206 USPQ 176 (TTAB 1980).

In the present case, opposer has proved prior use of its AMBIENCE mark in connection with furniture [*25] and the distribution of furniture. The recitation of services in applicant's application reads: "wholesale distributorships featuring furniture; [and] import agency services featuring furniture", without any restrictions as to the type of furniture which applicant features. Thus, we must presume that applicant's services include the distribution and importation of all kinds of furniture, including the types of furniture marketed and sold by opposer, e.g., occasional tables and end tables.

Moreover, the record shows that opposer and applicant market their goods and services in the same manner, namely by way of independent sales representatives and showrooms. Also, the parties offer their goods and services to the some of the same classes of customers, namely retail furniture stores and interior designers.

There is no question that opposer's services consisting of distributing furniture are virtually identical to applicant's wholesale distributorships featuring furniture and otherwise closely related to applicant's import agency services featuring furniture. Further, we find that opposer's furniture itself is closely related to applicant's identified services.

We recognize that [*26] owners of retail furniture stores and interior designers would exercise a degree of care in their purchasing decisions. However, because of the substantial similarity in the marks and the virtual identity/close relationship of the parties' goods and services, even careful purchasers are likely to be confused.

Opposer points to many instances of what it contends is actual confusion. One instance involves Harvey Salgado, opposer's northern California and northern Nevada sales representative. Mr. Salgado testified that when he visited his customer Ellie Berman in her showroom, she took out her AMBIENCE catalog binder to update opposer's product line

catalog. Upon inspecting the binder, Mr. Salgado found that it contained not only opposer's catalogs but one of applicant's catalogs as well. When Mr. Salgado asked Ms. Berman why applicant's catalog was in the binder with opposer's catalog, she indicated that she thought they were the same.

Dee Moss, another one of opposer's sales representatives, testified that when she made a sales call on one of her customer's shops and stated that she was an AMBIENCE representative, the customer told her that there was a damaged piece of furniture [*27] to show her. Upon inspection, Ms. Moss recognized that the damaged piece of furniture was not part of opposer's AMBIENCE line, but rather was a piece from applicant's line of furniture.

In addition, Ms. Moss testified that a furniture retailer in High Point, North Carolina called her asking whether she had a particular piece of AMBIENCE furniture available. Mr. Moss advised him that the piece was not one of opposer's products. According to Ms. Moss, he indicated that he obviously was confused.

Further, opposer's vice president of sales and marketing Tom Kubek testified that three individuals came into opposer's AMBIENCE showroom at the High Point, North Carolina furniture show in 2002 thinking that they were in applicant's AMBIENCE IMPORTS showroom. Additionally, Mr. Kubek testified that he has had sales representatives ask him if Ambiance Imports was another company that Kichler had purchased and why there were two Ambiences.

The weight of the testimony tends to suggest that there has been some actual confusion. In any event, actual confusion is but one factor in a likelihood of confusion analysis and an opposer is not required to prove actual confusion in order to prevail in [*28] an inter partes proceeding. We would find a likelihood of confusion in this case independent of alleged actual confusion.

We conclude that in view of the substantial similarity in the sound, appearance, meaning and overall commercial impression of applicant's mark and opposer's mark, their contemporaneous use on the virtually identical and closely related goods and services in this case is likely to cause confusion as to the source or sponsorship of such goods and services.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawLikelihood of ConfusionSimilarityAppearance, Meaning & SoundGeneral OverviewTrademark Law-Protection of RightsGeneral OverviewTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositions-General Overview

GRAPHIC:

Illustration 1, no caption

EXHIBIT 13

LEXSEE

Pacific Sunwear of California, Inc. v. AIT, Inc.

Opposition No. 91111244 to application Serial No. 75323781

Trademark Trial and Appeal Board

2004 TTAB LEXIS 76

February 18, 2004, Decided

CORE TERMS: opposer, registration, clothing, notice, purchasers, trademark, advertising, clothing store, common law, deposition, retail, identification, customers, jackets, Trademark Rule, third-party, convinced, famous, labels, shirts, intent-to-use, constructive, confusingly, similarity, island, personal knowledge, witness testified, current status, unsophisticated, authentication

DISPOSITION:

[*1]

Decision: The opposition is dismissed.

COUNSEL:

Matthew D. Murphey of Murphey & Murphey, A.P.C. for Pacific Sunwear of California, Inc.

Ira S. Dorman, Esq. for AIT, Inc.

JUDGES:

Before Hohein, Rogers and Drost, Administrative Trademark Judges

OPINION BY: DROST

OPINION:

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Opinion by Drost, Administrative Trademark Judge:

AIT, Inc. (applicant) applied to register the mark PAC AIT in typed form for "men's, women's and children's clothing, namely, shirts, sweatshirts, T-shirts, jackets, coats, robes, sweaters, hats, caps, skirts, dresses, sweatpants, trousers, slacks, shorts, sleepwear, and neckwear" in International Class 25. n1

n1 Serial No. 75323781, filed July 14, 1997. The application contains an allegation of a bona fide intention to use the mark in commerce.

Pacific Sunwear of California, Inc. (opposer) opposed the registration of applicant's mark. In its notice of opposition, opposer alleges that it "has engaged, is now engaged, and plans to continue to engage in the services of advertising, sale, and marketing of clothing, namely, pants, shirts, shorts, hats, swimwear, T-shirts, jackets, sweat shorts, tank tops, sport shirts, [*2] wind resistant jackets, jogging suits and shoes" under the mark PAC SUN in typed form in International Class 25. n2 Opposition at 2. Opposer also maintains that it "has used and is now using the trademark 'PAC SUN(R)' in doing business in the clothing industry" and that potential customers have "come to know and recognize Opposer's service mark and services and to associate them with Opposer and the goods sold by Opposer." Opposition at 2-3. Applicant denied the salient allegations of the notice of opposition.

n2 Registration No. 1,613,010, issued September 11, 1990, renewed. The registration contains an allegation of a date of first use and first use in commerce of October 21, 1987.

The Record

The record consists of the following items: the file of the involved application; the testimony deposition of opposer's president, Timothy Harmon, with accompanying exhibits; opposer's notices of reliance on the discovery deposition of applicant's principal, Conrad J. Kronholm, Jr. with exhibit and applicant's answers to opposer's interrogatories; the "agreed upon" testimony of Conrad J. Kronholm, Jr., with accompanying exhibits; and applicant's notice of reliance on opposer's responses [*3] to applicant's request for admissions, opposer's response to interrogatories, and copies of third-party federal trademark registrations.

Procedural Matters

Both parties have raised numerous evidentiary objections to the other party's evidence. Opposer "objects to the testimonial Affidavit of Conrad J. Kronholm, Jr. and exhibits ... on the grounds of lack of foundation and authentication under Rule 901, and lack of personal knowledge." Opposer's Brief at 39. This affidavit was submitted under an "Agreement as to Testimony." The parties' attorneys agreed that the "testimony shall be submitted in this Opposition in the form of the attached Affidavit." Trademark Rule 2.123(b) ("By written agreement of the parties, the testimony of any witness or witnesses may be submitted in the form of an affidavit"). n3

n3 In opposer's reply at 1 (which we will consider), opposer argues that "while it is true that Pac Sun stipulated to Pac Ait's request to use affidavit testimony, Pac Sun's stipulation did not include the inclusion of improper or objectionable exhibits in that affidavit." While opposer is perhaps technically correct, it is a poor practice to agree to the submission of testimony by affidavit without indicating in advance that the party intends to raise a plethora of objections to the affidavit after the defendant's testimony period closes. Cf. Hercules Casualty Ins. Co. v. Preferred Risk Ins. Co., 337 F.2d 1, 4 n.3 (10th Cir. 1964) ("*Subject to the objections of materiality and relevancy it was stipulated that certain affidavits could be, and were, received as the testimony of the affiants*") (emphasis added).

[*4]

Any "objection to testimony in affidavit form, which is waived if not made at deposition, must be raised promptly after receipt of the affidavit submission." TBMP § 707.04. Applicant's notice of reliance was submitted on November 9, 2001, applicant's testimony period closed on November 11, 2001, and opposer's objections were filed on December 18, 2001. We find that the objections as to foundation and lack of authentication are untimely. We also note that opposer's objection as to lack of personal knowledge of the witness is based on the witness's use of the passive voice in the affidavit. Again, this objection should have been raised earlier because it is likely that it could have been obviated or removed at that time. Pass & Seymour, Inc. v. Syrelec, 224 USPO 845, 847 (TTAB 1984) ("With respect to respondent's objections on the grounds of improper identification and/or authentication of exhibits and/or that the exhibits were inadmissible hearsay with no foundation laid for an exception to the hearsay rule[,]... it is our view that that all of respondent's objections are of a type that could have been remedied or obviated had they been made during the taking [*5] of the deposition"). In addition, simply because a witness uses the passive voice does not establish that the statement is not based on personal knowledge and opposer's objection to this testimony on this ground is overruled.

Opposer's objection as to the relevance of third-party registrations and responses to requests for admissions are overruled. While third-party registrations, by themselves, cannot be used to justify the registration of a confusingly similar mark, they are not irrelevant. They may be used in connection with evidence of use to show that a term is not entitled to a broad scope of protection and they may be used to show the meaning of a term much as a dictionary is used. In re Nashua Corporation, 229 USPO 1022, 1023 (TTAB 1986) ("Third-party registrations may provide some evidence as to the meaning of a mark or portion of a mark in the same way dictionaries are used. In this case they provide some evidence that applicant and registrant, as well as others, adopted marks beginning with "THERM" to convey a suggestion of heat" (citation omitted)).

Opposer's other objections to the admission of the cross-examination of its witness, which are on the [*6] grounds that it exceeds the scope of the direct examination, it calls for speculation, or that it calls for a lay opinion, are overruled. While we are not convinced that most of this testimony is entitled to much weight, we will not exclude it.

We also overrule applicant's motion to strike opposer's notice of reliance submitting the complete set of its discovery responses, and as provided in Trademark Rule 2.120(j)(5), we will exercise our discretion and consider these responses. We also overrule applicant's objections to Mr. Harmon's testimony on the ground of hearsay, lack of foundation and relevance. Mr. Harmon, as the president of opposer who was employed by opposer for ten years, could testify regarding sales and advertising. Harmon dep. at 7.

Finally, we note that on December 17, 2003, the Deputy Commissioner for Trademark Examination Policy denied opposer's motion to reverse the Board's previous order granting applicant's motion to strike opposer's reply brief. Therefore, we have not considered opposer's reply brief.

Priority

In its notice of opposition, opposer refers to its Registration No. 1,613,010 and attaches a plain copy of the registration to its notice of opposition. [*7] Applicant, in its answer, admitted that a copy of the registration was attached to the notice of opposition. A plain copy of the registration was also introduced during opposer's president's testimony. Opposer's witness answered in the affirmative when asked whether he was familiar with the registration and whether the dates of use in the registration were correct. Harmon dep. at 11. Opposer, however, did not submit a status and title copy of the registration.

Trademark Rule 2.122(d) provides that:

(1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies (originals and photocopies) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. For the cost of a copy of a registration showing status and title, see § 2.6(b)(4).

(2) A registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification and introduction during the taking of testimony or by filing a notice of reliance, [*8] which shall be accompanied by a copy (original and photocopy) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. The notice of reliance shall be filed during the testimony period of the party that files the notice.

While opposer has alleged ownership of a registration and has attached a copy thereof to its notice of opposition, the registration is not properly of record. There are several ways for a party to introduce a registration that it owns into evidence in a Board proceeding. The most common way is to attach to the notice of opposition two copies of the registration prepared and issued by the USPTO showing both current status and title or to submit such copies under notice of reliance. Trademark Rule 2.122(d). Opposer has not provided such copies. Other ways a party's registration will be considered to be of record include by identification and introduction during the testimony period by a qualified witness who testifies concerning the status and title of the registration; by admission in the applicant's answer; or by the applicant treating the registration as being of record [*9] in its brief. TBMP § 704.03(b)(1)(A) (2d ed. 2003). Inasmuch as opposer's witness did not testify as to the status and title of its pleaded registration, and because applicant did not admit the existence of the registration in its answer, in its admissions or in its brief, the registration was not made of record by any of these means. Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991) (Federal Circuit affirmed the Board's dismissal of an opposition for failing to present a prima facie case of likelihood of confusion).

Therefore, opposer will not be permitted to rely on such registration as a basis to oppose the registration of the application in this case.

Applicant also maintains that "opposer cannot rely upon common law or trade name rights" and that the notice of opposition "makes no mention whatsoever of common law trademark rights." Applicant's Brief at 9. However, while the notice of opposition did not use the term "common law" rights, it did put applicant on notice that opposer was relying on the use of its mark prior to applicant's use. See Notice of Opposition at 2 (Opposer "has engaged, is now engaged, and [*10] plans to continue to engage in the services of advertising, sale, and marketing of men's, women's and children's clothing..." and opposer "has used and is now using the trademark 'PAC SUN(R)' in doing business in the clothing industry"); and Notice of Opposition at 3 ("Because of this investment in the advertising, sale and marketing of Opposer's products bearing the trademark 'PAC SUN(R),' customers, potential customers and others in or familiar with the

clothing industry have come to know and recognize Opposer's service mark and services and to associate them with Opposer and the goods sold by Opposer"). Therefore, we hold that opposer can rely on its pleading of common law rights in the mark PAC SUN.

In a case involving common law rights, "the decision as to priority is made in accordance with the preponderance of the evidence." Hydro-Dynamics Inc. v. George Putnam & Company Inc., 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987). Applicant's mark was filed on July 14, 1997. Its application is an intent-to-use application. Such an application has its filing date as a constructive use date. Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542, 1544 (TTAB 1991) [*11] ("There can be no doubt but that the right to rely upon the constructive use date comes into existence with the filing of the intent-to-use application and that an intent-to-use applicant can rely upon this date in an opposition brought by a third party asserting common law rights").

The next question is whether opposer has demonstrated that it has used its mark for its goods or services prior to applicant's July 14, 1997, priority date. Opposer's witness testified in 2001 that he has worked for opposer since 1991. Harmon dep. at 7 ("Q. How long have you worked for Pacific Sunwear? A. Ten years"). He has been president of opposer for four years prior to his deposition. Harmon dep. at 58. There is nonetheless little definitive evidence that shows use of the mark PAC SUN on clothing items prior to applicant's constructive use date. We note that while opposer has also testified that it operates 684 stores (Harmon dep. at 52), the testimony regarding its use of its mark on goods is less clear. Most of the exhibits appear to refer to retail clothing store services. There is an exhibit (# 10) that consists of garment labels but the testimony regarding these labels consists of the following [*12] statement: "These are PacSun labels that are sewn into garments that are sold in our stores." Harmon dep. at 37. There is no testimony as to when these labels were used or on what goods they were used. Some exhibits refer to a different mark, PACIFIC SUNWEAR. Harmon Ex. 13 at 2-10; 14 at 2, 5, 7, and 9.

However, we find that at the very least one exhibit demonstrates that opposer was using the mark PAC SUN in association with retail clothing store services. Harmon Ex. 9-1. Opposer's witness testified that this exhibit was part of a program that started in 1995. Harmon dep. at 35. There is other evidence that supports opposer's use of the mark as a service mark for retail sales of clothing. See Harmon Ex. 14 at 4 (PACSUN Stores, PACSUN gift certificates, an 888-4PACSUN telephone number). n4

n4 The goods in the exhibit were identified by different trademarks (VANS shoes, SURF DIVA T-shirts, ANGEL sunglasses).

The exhibits and testimony support a conclusion that opposer began using its mark, at least in connection with retail store services, prior to July 14, 1997. The evidence regarding use of opposer's marks on goods consists of its president stating that the dates of use in [*13] its registration were correct. However, the dates of use preceded the president's tenure with the company. We decline to assume that the PAC SUN mark was in use on the goods identified in the pleaded registration at the time of the witness's employment by opposer because the testimony was not very clear and the documentary evidence provides little support for this statement.

Likelihood of Confusion

The central question in this case is whether there is a likelihood of confusion. In likelihood of confusion cases, we look to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

We start by considering whether the goods and services of the parties are similar. We must consider the goods as they are identified in the identification of goods in the application. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the [*14] issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). The application in this case is for men's, women's and children's clothing, namely, shirts, sweatshirts, T-shirts, jackets, coats, robes, sweaters, hats, caps, skirts, dresses, sweatpants, trousers, slacks, shorts, sleepwear, and neckwear. Regarding opposer's mark, we will consider that opposer's retail clothing store services involve many of applicant's clothing items. We find that clothing items are related to retail clothing store services for the identical clothing items. n5 In re United States Shoe Corp., 229 USPQ 707, 708 (TTAB 1985) ("The goods must, for our purposes, be considered to be identical and the services are closely related to the goods. Applicant sells women's clothing and renders women's retail clothing store service under its mark. Registrant

also sells clothing under its mark"); In re Gerhard Horn Investments Ltd., 217 USPQ 1181, 1182 (TTAB 1983) ("Confusion and mistake as to the origin of 'MARIPOSA' clothing store services and fabric goods would be equally likely.").

n5 For the sake of completeness, we add that, even if opposer had proven that it was using its mark PAC SUN on clothing items, including some of the same goods as applicant, this fact would not change the outcome in this case. The other factors strongly support the outcome in this case. See Bost Bakery, Inc. v. Roland Industries, Inc., 216 USPQ 799 (TTAB 1982) (HERITAGE HEARTH and OLD HEARTH, both for bread, not confusingly similar).

[*15]

The next important factor in a likelihood of confusion analysis is the similarity or dissimilarity of the marks. When we compare the marks, we must compare them in their entireties rather than the individual features of the marks. In re Shell Oil, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). Here, opposer's mark is PAC SUN while applicant's mark is PAC AIT. The only feature that the marks have in common is the initial word PAC. The second words in the marks are completely different except for the fact that they contain three letters (SUN and AIT). Applicant indicates that the word "ait" is defined as "a small island, esp. in a river (Brit. Dial.)" and that it is "also homonymous with the word 'eight.'" Applicant's Notice of Reliance, Ex. 7; Applicant's Answers and Objections at 2. This is not a case in which the parties' respective uses of generic or highly descriptive terms create a situation where the marks become very similar. Cf. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985):

To illustrate, assume the following pairs of hypothetical marks for identical financial services: AC-COUNT and EXCHANGE; CASH [*16] ACCOUNT and CASH EXCHANGE or MANAGEMENT ACCOUNT and MANAGEMENT EXCHANGE; CASH MANAGEMENT ACCOUNT and CASH MANAGEMENT EXCHANGE; and, finally, CASH MANAGEMENT ACCOUNT BANK and CASH MANAGEMENT EXCHANGE BANK. That these pairs are of progressively greater similarity is readily apparent, with the result that likelihood of confusion of the public becomes a closer question at each step of the progression, until it becomes virtually undeniable even though only a "generic" word, "BANK," has been added to the final stage.

We find that there are significant differences in the pronunciation and appearance of the marks PAC SUN and PAC AIT. The word, PAC, which opposer acknowledges is an abbreviation of the word PACIFIC, is hardly a unique or arbitrary term in the United States. Harmon dep. at 13.

Regarding the meaning of the marks, opposer acknowledges that its mark is a shortened version of its name, PACIFIC SUNWEAR. Harmon Dep. at 13 ("Kids starting calling the company PacSun instead of Pacific Sunwear"). The term, as a shortened form of sunwear, is again not an arbitrary or unique term when applied to clothing items. Applicant argues that the term "A-I-T" is a play on words in that it sounds [*17] like the number, and you had Pac 8 on the West Coast and Big Ten and the Big West, and it's really just a take-off on that concept of various sports leagues." Applicant's Brief at 15, citing Kronholm disc. dep. at 14. n6 We tend to agree, at least, in part with applicant that prospective purchasers may pronounce the word "ait" as the number "eight" similar to the former PAC 8 (now the PAC 10). To the extent that purchasers would not pronounce the mark as the number "eight," they would likely just spell out the letters as if they were an acronym, "A.I.T." While a few people may be familiar with the British Dialect definition of "ait" as an island chiefly in a river, it is unlikely that even this definition would lead the purchasers to view applicant's and opposer's mark as similar in meaning as opposer argues. Opposer's Brief at 21 ("Sun" in 'PAC SUN' accentuates the pacific island effect. Similarly, 'Ait' in 'PAC AIT' also accentuates the pacific island effect"). We conclude that, regardless of the interpretation of the word "ait," the meanings of the marks PAC SUN and PAC AIT would be different.

n6 Applicant's witness also cryptically asserted that "there are eight Pacific islands." Kronholm disc. dep. at

14

[*18]

When we view the marks as a whole, we conclude that their commercial impressions are substantially different. PAC SUN and PAC AIT have significant differences in sound, appearance, and meaning and their overall commercial impressions are not similar. Furthermore, there is little evidence to suggest that PAC, the abbreviation for "pacific," is itself associated with opposer in such a way that it would dominate both marks and lead consumers to associate applicant's mark with opposer's mark. n7

n7 We grant opposer's request to take judicial notice of the definitions of "Pacific." University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Applicant's addition of the word "AIT" is hardly a term that would be glossed over by prospective purchasers or simply substituted for "SUN." It would likely cause purchasers to pause and consider its meaning and pronunciation. It would also diminish the significance of the initial word "PAC." See Jacobs v. International Multifoods Corp., 668 F.2d 1234, 212 USPQ 641, 642 (CCPA 1982) quoting, National Distillers and Chemical Corp. v. William Grant & Sons, Inc., 505 F.2d 719, 184 USPQ 34, 35 (CCPA 1974) [*19] ("We here consider as marks a commonly known term, BOSTON TEA PARTY, and an uncommon term, BOSTON SEA PARTY. Although appellant argues that there exist similarities in sight, sound, and meaning (which are self-evident), and that appellee admits that its term is a play on 'Boston Tea Party,' we remain convinced that 'the familiar is readily distinguishable from the unfamiliar'"). See also Colony Foods, Inc. v. Sagemark, Ltd., 735 F.2d 1336, 222 USPQ 185, 186 (Fed. Cir. 1984) ("Stated otherwise, the fact that both marks [HUNGRY HOBO and HOBO JOE'S] play on the hobo theme is not enough to make confusion likely, in light of the differences in the marks as a whole") (quoting and affirming Board).

We now look at other factors that are important in a likelihood of confusion determination. Opposer argues that its "mark is famous as determined by its sales, advertising, and length of use." Brief at 30. Opposer's witness testified that it advertises on Warner Brothers television (WB) as well as on MTV, ESPN, and ESPN2. Harmon dep. at 47. In addition, its advertising budget was \$ 10,000,000 in 2000 and \$ 13,000,000 in 2001. Harmon dep. at 51. Opposer has 684 stores now (Harmon [*20] dep. at 52) and opposer's sales have increased from \$ 112,000,000 in 1996 to \$ 436,800,000 in 2000. We also note that much of the increase in opposer's sales and advertising occurred after the filing of the application in this case. In his 2001 deposition, opposer's witness indicated that he has been running the advertising "for the last three years" and opposer "really didn't advertise prior to that." Harmon dep. at 65. n8

n8 Interestingly, opposer has also introduced nine questionnaires from several consumers. Harmon Ex. 18. In response to the question, "Of all the stores you shop for casual clothes, which ones are your favorites," none of the respondents used the mark PAC SUN to refer to opposer's stores. They all identified the store as Pacific Sunwear or Pacific Sun. In response to the request to rank their favorite brand of clothing, no respondent listed PAC SUN or even Pacific Sunwear as their favorite brand. Inasmuch as the respondents "are customers that have shopped within a Pacific Sunwear store in the last 90 days prior to the event," the total lack of identification of opposer's PAC SUN mark by its own customers is surprising.

The Federal Circuit "has acknowledged [*21] that fame of the prior mark, another du Pont factor, 'plays a dominant role in cases featuring a famous or strong mark.'" Century 21, 23 USPQ2d at 1701, quoting, Kenner Parker Toys v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). "Famous marks thus enjoy a wide latitude of legal protection." Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000) (FIDO LAY for edible dog treats confusingly similar to FRITO-LAY snack foods). When we review the evidence that opposer has submitted regarding the fame of its mark, we are convinced that opposer's mark is not weak and that it has obtained some public recognition or renown, but there is little evidence that opposer's recognition extends to the term "Pac" alone. We also find that the public recognition and renown is not so great that the public would be likely to confuse these otherwise significantly different marks.

Another factor that the parties dispute is the sophistication of the purchasers of the respective goods and services. Opposer argues that purchasers of clothing of the type sold by opposer n9 and applicant are impulsive. [*22] Opposer also argues that its purchasers are "young, relatively unsophisticated consumer[s]." Brief at 28. Applicant argues that the "purchasers for the goods are not impulsive or unsophisticated." Brief at 16. We find that the evidence does not support opposer's argument that the purchasers would be impulsive or unsophisticated. Opposer has indicated that the price of its goods range from \$ 18 for T-shirts to \$ 130 for jackets. Harmon dep. at 26-27. In addition, opposer's own questionnaires of its purchasers pertaining to trademark recognition do not provide any basis to infer that these purchasers, who identified their ages as ranging from 15-18, were less sophisticated than other purchasers.

n9 Patrons of opposer's retail stores would apparently be similar to the purchasers of its goods.

When we analyze this case and consider all the factors on the issue of likelihood of confusion, we are convinced that there is no likelihood of confusion in this case. The marks have little in common other than the term PAC, which opposer's evidence does not indicate is a dominant term associated with opposer. The overall commercial impressions of the marks PAC SUN and PAC AIT are different. [*23] Kellogg Co. v. Pack'em Enterprises Inc., 951 F.2d 330, 21 USPQ 1142, 1143-44 (Fed. Cir. 1991) (FROOTEE ICE and elephant design is so different from FROOT LOOPS that, even if goods were closely related and opposer's mark were famous, there was no likelihood of confusion).

Legal Topics:

For related research and practice materials, see the following legal topics:
Trademark LawConveyancesGeneral OverviewTrademark LawProtection of RightsRegistrationCorrectionsTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsGrounds

EXHIBIT 14

LEXSEE

Pinkerton Service Corporation v. Senior Technologies, Inc.

Opposition No. 108,377 to application Serial No. 75/129,205 filed on July 2, 1996

Trademark Trial and Appeal Board

2002 TTAB LEXIS 475

February 12, 2002, Hearing

July 26, 2002, Decided

CORE TERMS: opposer, registration, alarm, purchasers, door, notice, stylized, surveillance, famous, health care facilities, database, impression, pleaded, objected, dissimilar, third-party, all-seeing, appearance, patient, advertising, health care, channel, ownership, historic, depicted, specimen, brochure, printout, dilution, machine

DISPOSITION:

[*1]

Decision: The opposition is dismissed.

COUNSEL:

Gordon E. Gray III and Albin H. Gess of Price and Gess for Pinkerton Service Corporation.

Vincent L. Carney for Senior Technologies, Inc.

JUDGES:

Before Quinn, Hairston and Rogers, Administrative Trademark Judges.

OPINION BY: HAIRSTON

OPINION:

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Opinion by Hairston, Administrative Trademark Judge:

Senior Technologies, Inc. has filed an application to register the mark depicted below, [SEE ILLUSTRATION IN ORIGINAL] for "alarms for health care facilities, namely, door alarms to prohibit unauthorized exit or unauthorized entry." n1

n1 Serial No. 75/129,205 filed July 2, 1996, alleging dates of first use of January 23, 1989.

Pinkerton Service Corporation has opposed registration. As grounds for the opposition, opposer alleges that it and its predecessors in interest have used the mark WE NEVER SLEEP along with a realistic depiction of a human eye since before 1884 in connection with the rendering of security and investigation services to customers of every type; that a stylized eye design has been in use at least since 1976 in connection with security and investigation services [*2] and the protection of people and property; and that it is the owner of the following valid and subsisting trademark registrations:

(a) WE NEVER SLEEP and the depiction of a human eye shown below, [SEE ILLUSTRATION IN ORIGINAL] for "private detective investigations and property surveillance;" n2

(b) PINKERTON and the stylized eye design depicted below, [SEE ILLUSTRATION IN ORIGINAL] for "making private investigations and security surveys for others; maintaining surveillance, control and protecting people and physical property; providing uniformed security forces;" n3

(c) PINKERTON and the stylized eye design depicted below, [SEE ILLUSTRATION IN ORIGINAL] for "providing guard services, security patrol services, and investigation services; namely, service quality investigations, background investigations, financial conditions investigations, fact verification investigations, personal protection, surveillance undercover investigation;" n4

(d) PINKERTON and the stylized eye design depicted below, [SEE ILLUSTRATION IN ORIGINAL] for "risk assessment service; namely, providing reports and information regarding potential threat and vulnerability to harm to persons [*3] travelling abroad;" n5 and

(e) PINKERTON and the stylized eye design depicted below, [SEE ILLUSTRATION IN ORIGINAL] for "servicing of automatic financial teller machines (ATMS) and point of sale machines for financial institutions; namely, restocking of cash and supplies;" and "repair of automatic financial services machines; namely, automatic teller machines (ATMS) and point of sale machines for financial institutions." n6

n2 Registration No. 539,452 issued March 13, 1951; renewed.

n3 Registration No. 1,078,654 issued November 29, 1977; renewed.

n4 Registration No. 1,778,207 issued June 22, 1993; affidavits under Sections 8 and 15 accepted and acknowledged, respectively.

n5 Registration No. 1,780,710 issued July 6, 1993; affidavits under Sections 8 and 15 accepted and acknowledged, respectively.

n6 Registration No. 1,790,672 issued August 31, 1993; affidavits under Sections 8 and 15 accepted and acknowledged, respectively.

Opposer alleges that applicant's mark, when used in connection with its identified goods, so resembles opposer's previously used and registered marks set forth above, as to be likely to cause confusion. n7

n7 Opposer also pleaded ownership of Registration No. 1,788,407 for the mark PINKERTON and a stylized eye design for "employment agency services." Office records show that this registration was canceled December 23, 2000 under Section 8 of the Trademark Act. Thus, we will give no consideration to this registration.

[*4]

In addition, although not pleaded in the notice of opposition, opposer made of record by means of notice of reliance a status and title copy of Registration No. 1,077,153 issued November 8, 1977 (renewed) for the stylized eye design shown below, [SEE ILLUSTRATION IN ORIGINAL] for "making private investigations and security surveys for others; maintaining surveillance, control and protecting people and physical property; providing uniformed security forces." The status and title copy of Registration No. 1,077,153 was submitted with the notice of reliance which included, inter alia, status and title copies of opposer's pleaded registrations. The registration was specifically identified in the "Exhibit List" accompanying the notice of reliance. In view thereof, and inasmuch as applicant has not objected to the registration, we deem the notice of opposition amended pursuant to Fed. R. Civ. P. 15(b) to plead ownership of this registration and a likelihood of confusion therewith.

Applicant, in its answer, denied the salient allegations of the opposition.

The Briefs and Arguments

Before turning to the record and the merits [*5] of this case, we must discuss several preliminary matters.

First, applicant has filed a motion to strike certain arguments in opposer's brief on the case. Applicant maintains that these arguments relate to issues which have been raised for the first time in opposer's brief. In particular, applicant seeks to strike arguments relating to the dilution of opposer's marks and a purported deficiency in the specimen submitted with applicant's application. n8 It is applicant's position that neither of these issues should be interjected into this proceeding at this late date.

n8 Opposer maintains that the specimen is a brochure "that Applicant cannot attest was even used in interstate commerce or actually affixed to [applicant's] product." (Opposer's brief, p. 21, footnote 3).

Opposer, on the other hand, citing Estate of Biro v. Bic Corp., 18 USPQ2d 1382, 1385-6 (TTAB 1991), argues that once it established its standing in this proceeding, it was entitled to assert any argument in its trial brief, constrained only by the bounds of Rule 11 of the Federal Rules of Civil Procedure (FRCP).

While it is true that an opposer who has [*6] properly pleaded its standing in an opposition is entitled to plead any available ground for opposition, the opposer may not assert the ground for the first time in its brief on the case. Where, as here, a claim of dilution was not pleaded in the notice of opposition, such a claim cannot be relied upon by opposer unless the notice of opposition was amended (or deemed amended), pursuant to FRCP 15(a) or (b), to assert the claim. See TMPB Sections 321 and 507.01. In this case, the notice of opposition was not amended to plead dilution and we do not deem the notice of opposition amended to assert the matter. Opposer presented no particular evidence during the trial of this case that would have put applicant on notice that opposer was asserting a claim of dilution. n9

n9 We should point out that opposer's reliance on *Estate of Biro* is misplaced. That case dealt with the issue of whether the plaintiff therein had properly pleaded its standing; not whether the plaintiff could plead additional grounds for opposition.

With respect to opposer's contention in its brief that the specimens submitted with applicant's application are "deficient," we should point out that a claim that [*7] specimens were not used on or in connection with the goods is not a ground for opposition and, therefore, not a matter which the Board would entertain. In this regard, a proper ground for opposition would be that applicant did not use the mark on or in connection with its goods prior to the filing date of the application. However, before the Board could consider such a ground, the notice of opposition would have had to be amended (or deemed amended) to assert the matter. Obviously, in this case, the notice of opposition was not amended to plead this ground and the notice of opposition is not deemed amended to assert such a ground.

In view of the foregoing, applicant's motion to strike is granted to the extent that, in deciding this opposition, we will give no consideration to the arguments in opposer's brief relating to the issues of dilution and the purported deficiency in the specimen submitted with applicant's application. Thus, the only issue before us is that of likelihood of confusion, there being no issue as to priority in view of opposer's ownership of valid and subsisting registrations.

An additional matter that requires comment concerns opposer's statement in its brief [*8] on the case that it is a holding company, which "owns each of the registrations at issue in the present action and licenses these marks to Pinkerton's Inc." (Brief, p. 9). Applicant, in its brief on the case, characterizes this statement as an "admission against interest." Applicant argues that there is no evidence of record which shows that the use of the marks by Pinkerton's Inc. inures to the benefit of opposer and that this raises a question as to whether opposer is entitled to rely upon use of the marks by Pinkerton's Inc.

Opposer has submitted, by means of notice of reliance, copies of its pleaded registrations. Each of the registrations shows ownership in opposer. Thus, there is no question that opposer is entitled to rely upon the registrations in this proceeding. As noted by the Board in Liberty & Co. Ltd. v. Liberty Trouser Co., Inc., 216 USPQ 65, 66-67 (TTAB 1982) (citations omitted), ownership of a subsisting registration constitutes prima facie evidence of the use of the mark shown therein for the goods or services recited in the registration since the filing date of the application which matured into the registration. Moreover, there is nothing in this [*9] record to indicate that Pinkerton Inc.'s use of the marks does not inure to opposer.

Objections to Testimony and the Record

Applicant has raised objections to certain aspects of the testimony of opposer's witness, Jane Adler. Ms. Adler is an archivist who once worked for opposer and much of her testimony is devoted to recounting the history of opposer and the life of its founder, Allan Pinkerton. Applicant has essentially objected to this testimony on the ground that Ms. Adler does not have personal knowledge of the events to which she has testified.

Obviously, Ms. Adler does not have personal knowledge of events which are alleged to have occurred during Allan Pinkerton's life (1819-1884) and opposer's early beginnings. Also, we recognize that much of Ms. Adler's testimony was based on information derived from the videotapes, books and publications introduced as exhibits during her testimony. n10 While in certain instances it is somewhat difficult to discern whether certain of the events Ms. Adler testified about are factual or are more akin to legend, we are nonetheless inclined to allow all of Ms. Adler's testimony and accord it appropriate [*10] probative value.

n10 The exhibits introduced during Ms. Adler's testimony consist of the following: excerpts from the book titled *The Pinkertons: The Detective Dynasty That Made History*, James D. Horan (1967); excerpts from the book *The Eye That Never Sleeps*, Frank Morn (1982); a publication titled *History and Evidence of Passage of Abraham Lincoln from Harrisburg, Pa. To Washington D.C. on the 22nd and 23rd of February 1861* authored by Allan Pinkerton in 1868 and published by the Pinkerton National Detective Agency in 1906; a videotape titled "Inside the Pinkertons" broadcast on the Discovery Channel network in 2000; a videotape titled "Allan Pinkerton The Original Private-Eye" broadcast on the A&E network in 1996; *Detective Agency's Papers Open Window on American Social History*, The Gazette (Library of Congress, Washington D.C.) June 30, 2000; and a printout of information about Allan Pinkerton downloaded from the Biography Online Database.

Applicant has also objected to the testimony of opposer's witness Alex Felipe concerning the number of contracts opposer has with health care providers. Mr. Felipe testified that during the course of his job as opposer's [*11] direct marketing information supervisor, he reviews opposer's database of information concerning opposer's active and inactive clients. According to Mr. Felipe, he obtained the information regarding the contracts with health care providers from opposer's database. Applicant has objected to the testimony on the ground of hearsay, arguing that there is no indication that Mr. Felipe is responsible for the entry of information in opposer's database or that the database is kept in the regular course of business.

It is opposer's position, however, that its database is "business information" and, thus, falls into the business records exception to the hearsay rule.

In this case, we are inclined to agree with opposer that a database containing information about client contracts is a business record and, as such, falls within the business records exception to the hearsay rule. Thus, applicant's objections to Mr. Felipe's testimony are not well taken.

Finally, opposer has objected to certain aspects of the testimony of applicant's witness, Kathleen Dowding and applicant's Exhibit 5 thereto. Ms. Dowding is a legal assistant in the office of applicant's counsel. According to Ms. Dowding, she [*12] conducted a search of the U.S. Patent and Trademark Office's TESS database for "trademark applications and registrations which had an eye design" and "the search provided 2,871 records of applications and registrations, which contained the eye design." (Dep. 11, 12). Applicant's Exhibit 5 is a list of these marks with the serial and/or registration numbers. Opposer objected to the testimony and the exhibit as hearsay during the deposition and renewed the objections in its brief. In addition, opposer argues that the submission of a mere list of third-party applications/registrations is not the proper way to make such applications/registrations of record.

Applicant has not responded to the objections in its brief. Moreover, opposer is correct that the submission of a mere list of third-party applications/registrations is not the proper way to make such applications/registrations of record. Rather, actual copies of the applications/registrations or the equivalent thereof, i.e., printouts of the applications/registrations which have been taken from the USPTO's own computerized database, must be submitted. In the absence thereof, the testimony and the list of applications/registrations [*13] is of no probative value.

The record therefore consists of the pleadings; the file of the opposed application; and the trial testimony, with accompanying exhibits of opposer's witnesses Patricia Carlson, Dr. John Brasch (as an adverse witness), Jane Adler, and Alex Felipe. In addition, opposer submitted notices of reliance on, inter alia, status and title copies of its pleaded registrations; printed publications and excerpts from printed publications; a copy of opposer's 1997 annual report; copies of promotional brochures; printouts of information downloaded from opposer's website n11; and applicant's responses to opposer's interrogatories.

n11 While materials such as an annual report, promotional brochure and a printout retrieved from the Internet do not qualify as printed publications under Rule 2.122(e) and generally may not be introduced in an opposition by means of a notice of reliance, in this case, applicant has not objected to these materials on the basis that they were improperly submitted. Thus, we consider applicant to have stipulated to the entry of the annual report, promotional brochures and printouts into the record. *Cf. Racine Industries Inc. v. Bane-Clene Corp.*, 35 USPQ2d 1832, 1834 n.4 (TTAB 1995); and *JSB International, Inc. v. Auto Sound North, Inc.*, 215 USPQ 60 n.3 (TTAB 1982). Indeed, at page 10 of its brief, applicant states that such materials "may come into evidence."

[*14]

Applicant submitted the trial testimony with related exhibits of its witnesses Dr. John Brasch, Thomas Benes, and Kathleen Dowding. Applicant submitted under notice of reliance, inter alia, opposer's responses to applicant's interrogatories; copies of third-party registrations for marks which include an eye design; a certificate of incorporation for Pinkerton Systems Integration, Inc.; a dictionary entry for the word "security"; and a status and title copy of its registration for the mark WANDERGUARD and design.

The case has been fully briefed and an oral hearing was held. n12

n12 We note that opposer's reply brief is twenty-eight pages in length, including the table of contents and index of cases. Trademark Rule 2.128(b) provides, in pertinent part, that a reply brief shall not exceed twenty-five pages in its entirety. Inasmuch as opposer's reply brief exceeds the page limit set by Rule 2.128(b), it is hereby stricken and has been given no consideration. See *United Foods Inc. v. United Air Lines Inc.*, 33 USPQ2d 1542 (TTAB 1994). Under the circumstances, opposer's motion to extend the time in which to file a reply brief is denied as moot.

The Parties [*15]

Opposer

The record shows that opposer is the largest security firm in the United States with over 393 branch offices throughout the country. Opposer offers a wide range of security services, including guard services, pre-employment and employee screening; crisis management, threat assessment, and security systems integration. Opposer's security systems integration services involve selection and deployment of a combination of hardware and software technology to provide security to opposer's clients. Such hardware may include access control devices, closed circuit television cameras, optical turnstiles, intrusion detection, electronic imaging, custom security consoles, remote monitoring, video image enhancement, and badging supplies.

Opposer provides its services to a wide range of customers including Toyota and General Motors and other Fortune 1000 companies, the Oscar and Emmy awards, and health care providers.

Opposer's archivist, Ms. Adler, traced opposer's beginnings to the mid-1800's and its founder Allan Pinkerton. Pinkerton immigrated from Scotland to the United States in 1842. In 1850 at the age of 31, Pinkerton founded the Pinkerton National [*16] Detective Agency in Chicago, Illinois. It was the first detective agency in the United States and it focused on providing security for people and property. Pinkerton and his agents had an advantage over local police departments in that they could cross city, county and state lines to pursue and capture criminals. They quickly developed a reputation for honesty and integrity. The agency used the depiction of a human eye and the motto "We Never Sleep" as its trademark, and a sign bearing this mark hung over the agency's entrance. The agency came to be known as "The Eye That Never Sleeps" or simply "The Eye."

The agency prospered, receiving contracts to provide security services to six major railroads. The railroads had been losing substantial sums of money to conductor embezzlement and Allan Pinkerton established an undercover operation using "spotters" to spot and capture embezzlers. Pinkerton came to know two influential men during this time, George McClellan and Abraham Lincoln. According to a book authored by Pinkerton, his agents learned of a plot to assassinate then President-elect Lincoln during his trip from Pennsylvania to Washington D.C. on the eve of his inauguration. Pinkerton [*17] devised a plan whereby he disguised Lincoln and changed his travel arrangements, thereby assuring Lincoln's safe arrival for his inauguration.

During the Civil War, Pinkerton and his agents gathered intelligence for the Union army and General McClellan and they were dubbed the "Secret Service". They were the precursor to the present day government protective agency which bears this name.

In the post Civil War era, Pinkerton and his agents were best known for pursuing train robbers and other outlaws. After Pinkerton's death in 1884, his sons William and Robert took over operation of the agency. Following their deaths, the agency was operated by two of Pinkerton's grandsons. Around the time of World War I, the agency began to move away from police work and expand its role in the protection of factory plants and premises. In 1982, the agency was purchased by American Brands who in turn sold it in 1988 to California Plant Protection, Inc. Securitas, a Swedish security firm, recently acquired the agency.

Applicant

Senior Technologies, Inc., is a manufacturer and seller of products to the long-term health care industry. Applicant's products are designed to inform the staff [*18] of long-term health care facilities, such as nursing homes, of certain circumstances that may indicate a danger to the patients. Generally, applicant's products are intended for the safety of wanderers, such as Alzheimer patients. Applicant has four product lines - the Arial line for a nurse calling system, the Wanderguard line that indicates unauthorized departure of a patient, the Micro-Tech line that detects motion of a patient, such as a wheelchair or a bed, and the Tabs product line that alerts the staff if a patient falls or moves into a dangerous position.

Applicant's involved mark CATCH-ALL and design is used on door alarms for health care facilities, to prohibit unauthorized exit or entry. This product is for infrequently used doors, such as fire doors, and is intended to sound an alarm if a patient (or anyone else) passes through the door. Applicant's CATCH-ALL product is a companion to its Wanderguard product, which is for frequently used doors. Applicant first used the CATCH-ALL and design mark in 1989. According to the testimony of its president, it was applicant's intent in selecting the CATCH-ALL and design mark to choose a mark with an eye design similar to that [*19] already in use as part of its WANDERGUARD and design mark since they were to be companion products. Applicant's sales have totaled \$ 400,000 to \$ 500,000 since the introduction of its CATCH-ALL and design door alarms.

Priority

As indicated above, opposer made of record status and title copies of its pleaded registrations. Thus, there is no issue with respect to opposer's priority of its registered marks. King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

We turn our attention to the issue of likelihood of confusion. Our determination under Section 2(d) of the Trademark Act is based on analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. DuPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The relevant factors for which there is probative evidence of record are discussed below.

Relatedness or Lack Thereof Between the Goods/Services

We turn first to a consideration of the relatedness or lack thereof between opposer's services and applicant's [*20] goods. At the outset, we note that the surveillance services identified in opposer's pleaded registrations are the most relevant of opposer's services in this case. Opposer maintains that its surveillance services and applicant's door alarms for health care facilities are related. Applicant, on the other hand, maintains that these goods and services are specifically different in nature, and thus are not related.

As noted by our primary reviewing court in Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987), "the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-a-vis the goods and/or services recited in opposer's registration, rather than what the evidence shows the goods and/or services to be." Further, in the absence of specific limitations in an application or registration, the goods and/or services identified therein must be considered to travel in all "the normal and usual channels of trade and methods of distribution" to all the normal and usual purchasers of the goods and/or services. CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983). [*21]

Moreover, in order to support a finding of likelihood of confusion, it is not necessary for the goods or services of the parties to be similar or competitive, or even that they move in the same channels of trade. It is sufficient that the

respective goods or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods or services are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1987).

In this case, opposer's surveillance services, including the protection of people and property, are broad enough to include the installation, monitoring, and maintenance of door alarms for all types of facilities, including health care facilities. In fact, opposer's witness, Mr. Felipe, testified that opposer offers access control services that include devices such as close-captioned televisions and alarms. Although there are specific differences between opposer's surveillance services [*22] and applicant's door alarms for health care facilities, they are nonetheless complementary goods and services, and we find that they are sufficiently related if offered under the identical or substantially similar marks, confusion as to source or sponsorship would be likely. With respect to the other of opposer's services identified in its registrations, namely, private detective services; security guard services; service and repair of automated teller machine services; investigation services; and risk assessment services, we are not persuaded on this record that they are related to applicant's door alarms for health care facilities. In view of the foregoing, this *du Pont* factor favors opposer in regards to its surveillance services.

Channels of Trade/Purchasers

Although applicant's identification of goods contains a restriction such that applicant's door alarms are sold only to "health care facilities," opposer's registrations contain no restriction as to channels of trade or purchasers. Thus, we must presume that opposer's surveillance services would move in all the normal channels of trade and be offered to all the usual purchasers, including health care facilities. [*23] Thus, for purposes of our analysis, the parties' trade channels and purchasers are identical. Thus, we find that this *du Pont* factor favors opposer.

Degree of Care Exercised by Purchasers of the Goods/Services

The next factor in this case concerns the degree of care exercised by the purchasers of opposer's services and applicant's goods. Clearly, purchasers and prospective purchasers of surveillance services would exercise care in their selection. Such services involve the protection of persons and property and there is no question that a great deal of attention would be paid to selecting a company to provide these services. Also, we would expect purchasers and prospective purchasers of door alarms for health care facilities to exercise care in the selection of these products. Health care facilities have a responsibility to provide a safe and secure environment for their residents. Not only must they comply with government regulations, but they have liability concerns as well. Thus, there is simply no question that health care facilities would exercise care in the selection of door alarms that would alert staff to an unauthorized entry or exit. Accordingly, we find [*24] that this *du Pont* factor favors applicant. With respect to this factor, our primary reviewing court in Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1392, stated:

Where the purchasers are the same, their sophistication is important and often dispositive because "sophisticated consumers may be expected to exercise greater care." (Citing Pignons S.A. de Mecanique de Precision v. Polaroid Corp., 657 F.2d 482, 489, 212 USPQ 246, 252 (1st Cir. 1981).)

Fame of Opposer's Marks

The next *du Pont* factor we consider is the asserted fame of what opposer characterizes as the "all seeing eye of Pinkerton." Opposer maintains that its "historic [eye design] form" and "modern [eye design] form", as shown below, are famous. [Opposer's brief, p. 11].

Historic Form n14

[SEE ILLUSTRATION IN ORIGINAL]

Modern Form

[SEE ILLUSTRATION IN ORIGINAL]

n14 This design does not reproduce adequately. Surrounding the human eye design in large print are the words "PINKERTON NATIONAL DETECTIVE AGENCY." Directly below the design in small print is the slogan "We never sleep." On the left are the names of the Pinkerton detectives, including of course, Allan Pinkerton.

[*25]

Fame, of course, is a significant factor in the determination of likelihood of confusion, and can play a dominant role in cases featuring a famous or strong mark. Kenner Parker Toys, Inc. v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

There is no dispute that the Pinkerton name is famous. Indeed, applicant's president has acknowledged, "Pinkerton is a well-established brand name." (Brasch dep., p. 43, line 21). Nonetheless, there is insufficient evidence in this record from which we may conclude that either the historic or modern form of the all-seeing eye is famous for opposer's services.

With respect to the historic form of the all-seeing eye, the evidence of record establishes use of this design by Allan Pinkerton and the Pinkerton National Detective Agency in connection with detective services in the late 19th and early 20th century. It is not clear from the record, however, the extent to which this design has been used in connection with the surveillance services identified in opposer's registrations since that time. In other words, this record shows the historical significance of opposer's historic all-seeing eye design, but not [*26] current use of this design as a mark. While there is no question that the design is referred to in the books/publications of record and in the two television documentaries, this does not establish that the design is so well known among purchasers and prospective purchasers of opposer's services that the design may be said to be famous. So as to be clear, the fact that historians who are knowledgeable about Allan Pinkerton are well aware of the design does not mean that the design is famous in a trademark sense among relevant purchasers.

Further, with respect to the modern form of the all-seeing eye design, there is no testimony or other evidence concerning the length of time opposer has used this design either alone or as part of opposer's composite marks. Moreover, there is no testimony or other evidence concerning the extent of opposer's advertising or promotion of any of its services under this design either alone or as part of opposer's composite marks. Although opposer has made of record copies of promotional brochures and an issue of its Solutions magazine wherein the design appears, there is no testimony concerning the extent of distribution of these materials. We recognize [*27] that opposer is the leading security firm in the United States, and that it has estimated its goodwill at \$ 86.4 million. However, this is not enough for us to conclude, as opposer urges, that its modern form of the all-seeing eye design is famous, as opposed to the Pinkerton name. Compare e.g., Bose Corporation v. QSC Audio Products, Inc., No. 01-1216, F.3d , USPQ2d (Fed. Cir., June 14, 2002); (The marks ACOUSTIC WAVE and WAVE held famous in view of 17 years use of the ACOUSTIC WAVE mark on table-top loudspeaker music system and \$ 5 million annually in advertising; 8 years use of the WAVE mark on table-top radio with total advertising expenditures of over \$ 60 million; "vast evidence of public notice given to the marked products"; and "considerable record evidence of advertising and sales literature that also decouples the product marks from the famous [BOSE] house mark"); and Toro Co. v. ToroHead Inc., 61 USPQ2d 1164 (TTAB 2001) [The mark TORO held famous in view of "testimony that [opposer] has over \$ 1.3 billion in annual sales, that it spends \$ 35 to \$ 40 million annually on advertising, and that it advertises in [*28] trade journals, daily newspapers, national publications, and on national television."]

In sum, opposer has not established on this record that either the "historic" or "modern" form of its all-seeing eye design is famous. Thus, neither its mark which consists of the modern design or its composite marks which include versions of these designs, are in our eyes, famous marks. Accordingly, this *du Pont* factor is neutral.

Third-party Use and/or Registration of Similar Marks

Applicant maintains that marks which include an eye design are weak marks and thus not entitled to a broad scope of protection. In support of its position, applicant submitted sixty third-party registrations for marks that include an eye design for various goods and services. We note that fifty of these registrations cover goods or services not of a type involved in this case or even arguably related thereto. However, ten of the registrations do cover goods and/or services of a type involved in this case or at the very least related to the security field. n15

n15 For example, Registration No. 949,649 is for the mark GUARDWARE and the design of a house and an eye for security hardware, burglar alarms and fire alarms; Registration No. 1,244,789 is for the mark SECURITY SYSTEMS, INC. and the design of a pair of eyes for the installation of business and home security alarm systems, providing security guard security services, and private investigations and lie detection testing; Registration No. 1,566,744 is for the mark ARGUS SECURITY GROUP, INC. and the design of an eye for security guard services; and Registration No. 1,753,158 is for the mark SMART BOX and the design of an eye for security and key controlled monitoring systems for new car dealerships.

[*29]

Although third-party registrations are not evidence of use of the involved marks or the extent to which the relevant purchasing public is aware of them, as the Board noted in American Hospital Supply Corp. v. Air Products and Chemicals, Inc., 194 USPQ 340, at 343, they are "competent to establish that a portion common to the marks involved in a proceeding has a normally understood and well-known meaning; that this has been recognized by the Patent and Trademark Office by registering marks containing such a common feature for the same or closely related goods where the remaining portions of the marks are sufficient to distinguish the marks as a whole; and that therefore the inclusion of [the common element] in each [involved] mark may be an insufficient basis upon which to predicate a holding of likelihood of confusing similarity."

In this case, we find that the pertinent ten third-party registrations are probative of the fact that eye designs have appealed to others in the security field; that such designs are not particularly distinctive in the field; and that an eye design has a readily understood meaning in the field making the inclusion of such a design, per [*30] *se*, an insufficient basis on which to predicate a likelihood of confusion. See Bost Bakery, Incorporated v. Roland Industries, Inc., 216 USPQ 799 (TTAB 1982) and cases cited therein. Accordingly, this *du Pont* factor favors applicant.

Similarity/Dissimilarity of the Marks

Finally, we turn to a determination of what we find to be the key likelihood of confusion factor in this case, namely, whether applicant's mark and opposer's marks, when compared in their entirety in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impression.

In comparing the marks, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods/services offered under the respective marks is likely to result. Furthermore, although the marks at issue must be considered in their entirety, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining [*31] the commercial impression created by the mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

We consider first opposer's mark WE NEVER SLEEP and the design of a human eye shown below,

[SEE ILLUSTRATION IN ORIGINAL] and applicant's mark CATCH-ALL and the stylized eye design shown below. [SEE ILLUSTRATION IN ORIGINAL]

The words WE NEVER SLEEP are the dominant element of opposer's mark and the term CATCH-ALL is the dominant element of applicant's mark. It is appropriate to give greater weight to the word portions of the marks, because it is by the words that purchasers will refer to opposer's services and applicant's goods, rather than the respective eye designs. In terms of sound, there are obvious differences between WE NEVER SLEEP and CATCH-ALL, and the marks vary greatly in appearance, not only because they include very different words, but also because opposer's realistic depiction of a human eye has a different look from applicant's stylized eye design. In terms of connotation, opposer's mark, as used in connection with its services, suggests a security company with an always watchful eye over persons and property, whereas applicant's [*32] mark, as used in connection with its product, suggests an alarm, which will "catch all" persons entering or exiting a door without authorization. We find, therefore, that these marks are dissimilar in their overall commercial impression.

Comparing next opposer's mark PINKERTON and the stylized eye design shown below, [SEE ILLUSTRATION IN ORIGINAL] and applicant's mark, for the same reasons as discussed above we find that PINKERTON is the dominant element of opposer's mark and CATCH-ALL is the dominant element of applicant's mark. Similarly, in terms of sound, appearance and meaning, there are obvious differences between PINKERTON and CATCH-ALL. Further, even a comparison between the stylized eye designs in applicant's and opposer's marks reveals certain differences. In applicant's mark, the stylized eye design forms part of the beginning letter "C" in the term CATCH-ALL. It is a profile type of design and more open in nature, whereas in opposer's mark, the stylized eye design looks somewhat like the letter "P," is a more frontal type of design and is more closed.

In terms of connotation, as noted above, applicant's mark suggests an alarm which will "catch all" persons entering [*33] or exiting a door without authorization. Opposer's mark, on the other hand, suggests that the Pinkerton Company is keeping a watchful eye over persons and property. We conclude therefore that these marks also have dissimilar overall commercial impressions.

Turning next to opposer's mark, which consists of the stylized eye design alone shown below, [SEE ILLUSTRATION IN ORIGINAL] and applicant's mark, in view of the differences noted above between the stylized eye designs in these respective marks, and more importantly because of the inclusion in applicant's mark of the term CATCH-ALL, we find that the overall commercial impressions of these marks are likewise dissimilar.

Turning finally to opposer's mark PINKERTON and the stylized eye design shown below, [SEE ILLUSTRATION IN ORIGINAL] and applicant's mark, again we find that PINKERTON is the dominant element of opposer's mark and the term CATCH-ALL is the dominant element of applicant's mark. And, in terms of sound, appearance and meaning, there are obvious differences between PINKERTON and CATCH-ALL. In terms of the respective stylized eye designs, opposer's design appears above PINKERTON and is more open in appearance whereas [*34] applicant's design forms part of the beginning letter "C" in the term CATCH-ALL. These marks have different connotations as discussed above, and we conclude that they likewise have dissimilar commercial impressions.

In sum, when we compare applicant's mark and each of opposer's marks in their entireties as to appearance, sound and meaning, we find that they are dissimilar in terms of their overall commercial impressions. In view thereof, we conclude that this *du Pont* factor weighs in favor of applicant.

In summary, after careful consideration of the evidence of record with respect to the relevant *du Pont* factors and the parties' arguments with respect thereto, we conclude that there is no likelihood of confusion in this case. That is, notwithstanding the fact that opposer's surveillance services and applicant's door alarms for health care facilities are related and may be marketed to the same purchasers, we find that opposer's marks and applicant's mark are too dissimilar to support a determination that confusion is likely. Moreover, we find that the design of an eye, which is the only feature the marks have in common, is routinely adopted in the security field, and thus [*35] not a feature of opposer's marks which is entitled to a broad scope of protection. Additionally, we find that the respective purchasers of opposer's surveillance services and applicant's door alarms for health care facilities would be discriminating, thus making confusion unlikely.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark Law Likelihood of Confusion Similarity Appearance, Meaning & Sound General Overview Trademark Law Protection of Rights General Overview Trademark Law U.S. Trademark Trial & Appeal Board Proceedings Oppositions-Grounds

GRAPHIC:

Pictures 1 through 14, no caption

EXHIBIT 15

LEXSEE

Ariel Remos v. Ariel Feierman

Opposition No. 114,000

Trademark Trial and Appeal Board

2001 TTAB LEXIS 304

April 17, 2001, Decided

CORE TERMS: opposer, band, declaration, entertainment, advertising, musical, summary judgment, promotion, booking, music, registration, handle, third parties, distributed, genuine issue of material fact, genuine, above-referenced, advertisement, contradiction, third-party, issues of material fact, invitation, ticket, nonmoving party, evidentiary, performing, abandoned, secondary meaning, personal name, cross-motion

DISPOSITION:

[*1]

Decision: The opposition is sustained.

JUDGES:

Before Quinn, Hairston and Bottorff, Administrative Trademark Judges.

OPINION BY: BOTTORFF

OPINION:

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

Opinion by Bottorff, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register of the mark ARIEL, in typed form, for services recited in the application as "entertainment services, namely, live performances rendered by a musical group." n1 Opposer filed a timely notice of opposition to registration of applicant's mark, alleging that opposer is the prior user of the mark ARIEL in connection with musical entertainment services and that applicant's use of her mark in connection with her recited services is likely to cause confusion. See Trademark Act Section 2(d), 15 U.S.C. § 1052(d). Applicant filed an answer by which she denied the allegations of the notice of opposition which are essential to opposer's claim.

n1 Serial No. 75/476,262, filed April 29, 1998. In the application, applicant alleges use of the mark since January 14, 1996, and use of the mark in commerce since April 1, 1996.

This case now comes up on the parties' [*2] cross-motions for summary judgment as to opposer's Section 2(d) claim. The motions have been fully briefed. n2 The evidence of record on summary judgment includes: the file of the opposed application; the pleadings; the two declarations of opposer Ariel Remos and the exhibits attached thereto; the declaration of opposer's witness Cliff Walker and the exhibits attached thereto; the declaration of applicant Ariel Feierman and the exhibits attached thereto; the declaration of applicant's witness Robert Torsello and the exhibits attached thereto; and the two declarations of applicant's counsel Lana Fleishman and the exhibits attached thereto. Applicant has objected to certain of opposer's documentary exhibits; those objections will be discussed *infra*.

n2 Applicant's objection to opposer's sur-reply brief is well-taken, and we have given that paper no consideration. See Trademark Rule 2.127(e)(1).

We have carefully considered all of the parties' arguments and all of the evidence properly made of record, including any arguments or evidence not specifically discussed in this opinion. For the reasons discussed below, we grant opposer's motion for summary judgment and deny applicant's [*3] cross-motion for summary judgment. See Fed. R. Civ. P. 56(c).

Generally, summary judgment is appropriate in cases where the moving party establishes that there are no genuine issues of material fact which require resolution at trial and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). An issue is material when its resolution would affect the outcome of the proceeding under governing law. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986). A fact is genuinely in dispute if the evidence of record is such that a reasonable factfinder could return a verdict in favor of the nonmoving party. *Id.* When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute [*4] for trial. See Fed. R. Civ. P. 56(e); Copelands' Enterprises Inc. v. CNV Inc., 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). In deciding a motion for summary judgment, the Board may not resolve an issue of fact; it may only determine whether a genuine issue of material fact exists. See Meyers v. Brooks Shoe Inc., 912 F.2d 1459, 16 USPQ2d 1055 (Fed. Cir. 1990). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See Opryland USA, Inc. v. Great American Music Show, Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

There is no genuine issue of material fact that opposer is the owner of application Serial No. 75/477,155, by which [*5] he seeks registration of the mark ARIEL for "entertainment in the nature of a live or recorded performing musical group," or that applicant's prior-filed application has been cited against opposer's application as a potential Section 2(d) bar to registration of opposer's mark. In view thereof, we find that opposer has standing to oppose registration of applicant's mark in this proceeding. See Hartwell Co. v. Shane, 17 USPQ2d 1569 (TTAB 1990).

We turn next to the question of priority, which is an issue in this case because opposer does not own an existing registration upon which he can rely under Section 2(d). *Distinguish, e.g., King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). To establish his priority under Section 2(d), opposer must prove that, vis-a-vis applicant, he owns "a mark or trade name previously used in the United States... and not abandoned...."

There is no dispute that the date of applicant's first use of her mark, and the earliest date upon which she can rely for purposes of priority, is January 14, 1996. Accordingly, opposer's Section 2(d) priority claim requires proof that opposer owns [*6] a mark or trade name used in the United States prior to January 14, 1996 and not abandoned.

In his first summary judgment declaration, opposer Ariel Remos avers as follows, in pertinent part:

1. My name is Ariel Remos and I am the leader of a four person club band called "Ariel." I sing lead vocals, play keyboard and drums and write, arrange and produce all our original songs.
2. I began to use the mark "Ariel" for the band on December 12, 1981.
3. The band originally began playing in South Florida nightclubs and in festivals throughout the southeast. We now play throughout the country, in the Caribbean and in Central America. The band has been featured on "CBS This Morning" and on the Univision and Telemundo Spanish Television Networks. I have continued to use the mark "Ariel" throughout the United States for the band since 1981. In addition, I am creating a Web site under the name "ariel-band.com" to market the band on the Internet. I currently use it and have never abandoned it.
4. We have recently finished our first album in both Spanish and English which will be distributed worldwide under the "Ariel" mark.
5. On January 8, 1991 I registered the trademark "Ariel" for [*7] Entertainment Services in the nature of a musical group.
6. My registration was cancelled on July 14, 1997 for failure to file a Section 8 Affidavit.

7. I applied to reregister the mark on April 30, 1998.

8. I first learned of Applicant's use of the mark "Ariel" when its application was cited against mine on February 1, 1999.

In his second summary judgment declaration, submitted with his response to applicant's cross-motion for summary judgment, opposer Ariel Remos avers as follows, in pertinent part:

1. My name is Ariel Remos and I am the leader of a four-person club band called "Ariel." The band's name encompasses and refers to all the members of the band. It has also become associated with the type of high energy performing we do. As the band's leader I handle most of the financial matters, the advertising and promotion for the band's performances and some of the booking of the band myself.

2. In addition, the band has several booking agents who book the band and also handle advertising and promotion of the band always under the "Ariel" mark. These include Walker Entertainment, Fantasma, Deco Productions, Southern Nights, Adam Productions, and Vega (Louisiana) (See [*8] Declaration of Cliff Walker).

3. Since 1981, I estimate that we have spent approximately \$ 5,000.00 per year on advertising and promotion of the band under the trademark "Ariel." Unfortunately, I have not saved copies of many of the materials that have accompanied our performances over the years or retained many old records. It has consisted in the past and now consists of yellow pages advertising, press releases and promotional flyers, distribution of business cards and correspondence on Ariel stationery.

4. Since the band was formed in 1981, the band has averaged one hundred and four (104) dates or two dates a week a year including 1995, 1996, 1997, 1998, 1999 and 2000. We play at hotels, on cruise ships, in clubs and restaurants, at Disney World, at corporate events, and at country clubs. We have performed in music festivals, on English and Spanish television, in Las Vegas, New Orleans, Nashville and San Antonio as part of a national tour for the television program "Entertainment U.S.A." in 1993. At all performances, the "Ariel" mark is prominently displayed.

5. Total sales from entertainment services have ranged from \$ 30,000.00 to \$ 100,000.00 a year.

6. The band is well [*9] known in Miami and the Southeast by the "Ariel" mark.

7. We have begun distributing worldwide our first CD under the "Ariel" mark.

8. Performing with the band "Ariel" has been my only job since the early 90's. It's the only work I do. It pays my rent. It supports my family. I intend to continue writing, playing and performing as long as possible.

Opposer also has submitted the declaration of Cliff Walker, who avers as follows, in pertinent part:

2. My company, Walker Entertainment, Inc. has represented the band Ariel since 1983 as its booker and promoter. Since that time I have booked the band in approximately two to ten venues a year from 1983 to the present. In addition, I am responsible for providing information regarding the entertainment services of the band Ariel to potential venues and engagements.

3. Upon request, I provide to potential venues promotional materials, flyers, and direct mails. The materials are all provided under the "Ariel" trademark.

4. I have most recently booked entertainment services under the mark "Ariel" to the Sunfest Festival held May 3-7, 2000 in West Palm Beach, Florida. The Sunfest Festival is Florida's largest music, art and waterfront [*10] festival drawing 300,000 people. The performance by the band was held under a prominently displayed "Ariel" mark.

5. I also refer potential bookings to the "ariel-band.com" Web site for information regarding the band.

We find that the averments contained in these declarations are sufficient, if unopposed, to establish that opposer has used ARIEL as a mark for his musical entertainment services since a date prior to applicant's first use of the mark in January 1996, and that opposer's use of the mark has not been abandoned.

Applicant has not presented any counter-declarations or other evidence which rebuts the factual averments made in opposer's declarations, nor has applicant identified any genuine issue of material fact with respect to those averments. Instead, applicant argues that the declarations submitted by opposer are entitled to no probative weight on the question of opposer's use and priority because they contain certain alleged internal contradictions which render the declarations untrustworthy in their entireties, and because opposer allegedly has failed to present sufficient corroborating documentation for all of the averments made in the declarations. We disagree. [*11]

Regarding the alleged internal contradictions in the declarations, applicant first contends (at page 4 of her reply brief) that "in his Second Declaration, Opposer claims that he handles the advertising and promotion for the band's performances. (Remos Second Dec. P1). Opposer then claims that booking agents are actually responsible for the band's advertising and promotional activities." However, in paragraphs 1-2 of his second declaration, opposer actually avers as follows: "As the band's leader I handle most of the financial matters, the advertising and promotion for the band's performances and some of the booking of the band myself. In addition, the band has several booking agents who book the band and also handle advertising and promotion of the band always under the 'Ariel' mark." (Emphasis added.) Thus, opposer states that he handles "most of" the advertising and promotion for the band, in addition to several booking agents who "also" handle the advertising and promotion. These statements are not contradictory. n3

n3 To arrive at her conclusion that the statements in PP1 and 2 of opposer's second declaration are contradictory, applicant apparently construes opposer's statement (in P1 of his declaration), i.e., "I handle most of the financial matters, the advertising and promotion for the band's performances and some of the booking of the band myself," such that the words "most of" modify only the words "the financial matters" and not the words "the advertising and promotion." Another valid construction, however, and one which is more likely to be correct because it allows PP1 and 2 to be read together without contradiction, is that the words "most of" modifies both "the financial matters" and "the advertising and promotion."

[*12]

Likewise, and contrary to applicant's contention, there is no contradiction between opposer's statement (in P4 of his second declaration) that "the band has averaged one hundred and four (104) dates or two dates a week a year," and Mr. Walker's statement (in P2 of his declaration) that he has "booked the band in approximately two to ten venues a year." As is apparent from PP1-2 of Mr. Remos' second declaration, Mr. Walker is not the only booking agent for opposer's band. Opposer handles some of the booking himself, and the band also engages several other booking agents in addition to Mr. Walker. Thus, the fact that Mr. Walker books opposer's band for two to ten dates per year is not inconsistent with Mr. Remos' assertion that the band plays 104 dates per year.

In short, applicant's contentions regarding the alleged internal contradictions in opposer's declarations are not borne out by the declarations themselves. We are not persuaded by applicant's argument that the declarations as a whole should be disregarded on account of the alleged contradictions.

Applicant also argues that the three declarations submitted by opposer should be disregarded in their entireties because the averments [*13] contained therein (as to the details of the nature, duration and extent of opposer's advertising and sale of his services under his mark) are not adequately corroborated by admissible, probative documentary evidence. For the reasons discussed below, we disagree.

Among the documentary exhibits to Mr. Remos' two declarations and to Mr. Walker's declaration are photocopies of programs, invitations, tickets and advertisements pertaining to various events and functions at which performances by opposer and his band were the featured musical entertainment. n4 These documents, which were prepared and distributed by the third-party sponsors of such events and functions, include, in chronological order of performance:

- (1) invitation to the April 30, 1988 Florida Customs Brokers and Forwarders Association "Gala Installation Banquet" in Miami, Florida, which states "Music by 'Ariel'";
- (2) invitation to the November 17, 1990 Cuban American National Foundation "Gala Dinner Dance" in Miami, Florida, which states "Music by Ariel";
- (3) ticket to the February 2, 1991 "LBA" benefit event in Miami, Florida, which states "Music by: Ariel";
- (4) program for the February 8, 1991 St. Thomas the Apostle [*14] "Eighth Annual Dinner Dance" in Key Biscayne, Florida, which states "Music by Ariel";

(4.A) ticket to the same February 8, 1991 St. Thomas the Apostle Dinner Dance, which states "Music by: Ariel";

(5) program for the March 7, 1992 Saint Patrick School "Gala Dinner Dance" (location undisclosed) which states "Music by Ariel";

(6) ticket to the May 14, 1994 "Baptist Hospital Ball" in Miami, Florida, which states "Dancing to Music by Varon and Ariel";

(7) invitation to the April 27, 1996 Florida Customs Brokers & Forwarders Association "Gala Installation Banquet" in Miami, Florida, which states "Music by 'Ariel'";

(8) newspaper advertisement for the December 31, 1997 Doral Golf Resort and Spa "New Year's Eve Gala" in Miami, Florida, which states "Dance the Night Away with Renowned 6 pc. Band "Ariel";

(9) program for the 1998 Asociacion Latinoamericana "Latin Fever Ball" in Atlanta (Buckhead), Georgia, which states "Dancing throughout the evening to the sound of Ariel"; and

(10) Sunfest 2000 advertisement depicting the "Performance Schedule" for Saturday May 6, 2000, which includes a listing for a performance by "Ariel."

n4 As discussed *infra*, we find that these third-party documents are sufficient to corroborate and establish opposer's claim of prior, non-abandoned use of his mark. Opposer has submitted various other documents as well, to which applicant has objected on various grounds. In general, we are not persuaded by applicant's objections. However, because we find that opposer's priority claim is sufficiently established by the documents discussed in the text of this opinion, we need not and do not base our decision on these other documents of opposer's, nor do we rule specifically on applicant's objections thereto.

[*15]

Applicant has not contended, nor has she presented any evidence which would suggest, that opposer and his band did not actually render musical performances at the events and functions identified in the above-referenced third-party documents. Instead, applicant asserts various evidentiary arguments against the admissibility of certain of the documents, and various legal arguments for the proposition that none of the documents establish that opposer has any service mark or other proprietary rights in ARIEL.

We turn first to a consideration of applicant's evidentiary objections to certain of the above-referenced documents. Specifically, applicant has objected to the admissibility of the above-numbered documents (3), (4.A), (6), (7), and (9), which were attached as Exhibit Nos. 2(a)-(d) to Mr. Remos' second declaration. n5 Applicant objects to these documents under Fed. R. Evid. 403, on the ground that they are merely cumulative of the documents which were attached to the first Remos declaration and are accordingly a waste of time. The objection is overruled. These additional documents, even if cumulative, are not so numerous as to be wasteful of [*16] the parties' or the Board's time and efforts.

n5 Applicant raised no specific evidentiary objections to the admissibility of above-numbered documents (1), (2), (4), (5), (8) and (10), and any such objections to those documents are deemed waived. See Fed. R. Evid. 103(a). Applicant's various substantive legal arguments regarding the probative value of all of the above-referenced documents (Nos. (1)-(10)) will be discussed below.

Applicant also objects to these documents under Fed. R. Evid. 901, on the ground that they are not properly authenticated. This objection is overruled. Applicant has not contended that these documents were manufactured or fabricated by opposer. Indeed, as applicant herself has argued, these documents were independently prepared and distributed by third parties, not by opposer. Any technical defect in the manner in which opposer introduced and authenticated these documents via his declaration is not dispositive, inasmuch as there simply exists no basis in the record for concluding that these documents are other than what they appear to be. See Fed. R. Evid. 901(a) [*17] and 901(b)(4).

Finally, applicant has objected to documents (3), (4.A), (6), (7), and (9) under Fed. R. Evid. 401 and 402, on the ground that they are not relevant to this action. This evidentiary objection is premised on applicant's substantive legal arguments regarding the alleged lack of probative value of all of the above-referenced third-party documents. For the

reasons discussed below, we reject applicant's substantive legal arguments; we accordingly also overrule applicant's relevancy objections which are based on those arguments.

Applicant's first substantive argument is that none of the above-referenced documents are evidence of service mark use of ARIEL by opposer because they were not created or distributed by or on behalf of opposer for the purpose of advertising or promoting opposer's entertainment services to prospective purchasers of those entertainment services, i.e., to those who might engage opposer to provide musical entertainment services. Rather, the documents are advertisements, programs, invitations and tickets which were created and distributed by the [*18] various third-party organizations and sponsors themselves, to advertise and promote their own hotel, banquet, school dance and restaurant services to their members and/or to the general public. According to applicant, the designation ARIEL, as it appears in the documents, is not used as a service mark by opposer; rather, it is used by the third parties in a merely informational sense, to identify the musical entertainment the third parties are presenting as part of their hotel, banquet, school dance and restaurant services.

We are not persuaded by this argument. Applicant cites no case law or statutory authority which supports her contention that these documents must be disregarded as evidence of opposer's use of the mark ARIEL merely because they were created and distributed by the third parties, rather than by opposer. n6 Indeed, applicant herself has submitted and relies upon numerous documents of exactly the same type as evidence of her use of her own mark. On their face, opposer's documents show that opposer was engaged by the various third parties to provide musical entertainment services under the mark ARIEL at the identified events and functions. There is no basis in the [*19] record for concluding that opposer and his band did not, in fact, render musical entertainment services under the mark at those events and functions. The fact that the advertisements were prepared and distributed by third parties rather than by opposer is inconsequential.

n6 Applicant cites to TMEP § 1304.01, which sets forth a non-exclusive list of types of documents which are acceptable as specimens in service mark applications. That section is not apposite to or dispositive of the priority dispute in this opposition proceeding.

Applicant's second substantive argument with respect to these third-party documents submitted by opposer is that the designation ARIEL is used in these documents solely to identify opposer personally, and not as a service mark for opposer's entertainment services. We disagree. The newspaper advertisement for the Doral New Year's Eve Gala (document no. (8) above) specifically refers to the "Renowned 6 pc. Band 'Ariel.'" Likewise, there is no reasonable basis in the record for inferring that the other documents, when they use the designation ARIEL, are referring to opposer personally, rather than to the band.

In summary, we find that the above-referenced [*20] documents establish that opposer and his band were engaged to render, and did render, live musical performances under the mark ARIEL in 1988, 1990, 1991, 1992, 1994, 1996, 1997, 1998 and 2000. We find that the averments in opposer's summary judgment declarations regarding opposer's prior use and non-abandonment of the mark have been corroborated, at least to that extent. n7 Taken together, the documents and the declaration averments are sufficient to establish opposer's Section 2(d) priority in this case.

n7 It is not dispositive that opposer's documents do not corroborate each and every detailed averment made in opposer's declarations, i.e., as to the specific dollar amounts of opposer's sales and advertising, or as to the geographic scope of opposer's use of the mark. Opposer need not substantiate each of those specific averments in order to establish his Section 2(d) priority, vis-a-vis applicant.

Applicant makes two other arguments with respect to the priority issue which require comment. First, applicant has cited various authorities in support of the proposition that personal name marks, such as opposer's, are merely descriptive and not entitled to protection absent a [*21] showing of secondary meaning. However, applicant has not cited to any prior decisions of the Board or of its primary reviewing court in which this proposition has been stated or followed, and we are aware of no such decisions. For the reasons discussed below, we are not persuaded that we should follow the authorities cited by applicant on this issue.

A personal name mark, unless it is primarily merely a surname, is registrable on the Principal Register without a showing of secondary meaning, and thus is deemed to be inherently distinctive under the Lanham Act. Indeed, applicant's own mark ARIEL, which is also applicant's personal name, was not refused registration as merely descriptive, and was forwarded to publication by the Office without any requirement for a showing of acquired distinctiveness. We see

no logical basis for holding that a personal name mark which is inherently distinctive for registration purposes must nonetheless be shown to have acquired secondary meaning before it can be relied upon by an opposer in an opposition proceeding. Thus, we reject applicant's argument regarding opposer's alleged failure to establish secondary meaning in his mark.

Applicant also argues [*22] that she is entitled to an "adverse inference," and to dismissal of the opposition, due to opposer's alleged failure, despite the pendency of this proceeding, to retain discoverable documents. Applicant cites Supreme Oil Co. v. Lico Brands, Inc., 39 USPQ2d 1695 (TTAB 1996) in support of this argument. However, Supreme Oil Co. involved a fully-briefed motion for discovery sanctions under Fed. R. Civ. P. 37. No such motion was filed by applicant in this case; rather, the request for an adverse inference was raised by applicant for the first time in her reply brief. Opposer has had no opportunity to respond on the merits of applicant's request. In view thereof, we deny applicant's request for an unspecified "adverse inference" and her request for dismissal based thereon.

Having found that opposer has established his priority for purposes of Section 2(d), we turn now to the issue of likelihood of confusion. Our likelihood of confusion determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re E.I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). [*23] In any likelihood of confusion analysis, two key considerations are the similarities between the respective marks and the similarities or relatedness of the respective goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

There is no genuine issue of material fact that applicant's mark and opposer's mark are identical, i.e., ARIEL. There also is no genuine issue of material fact that applicant's services, as recited in the application, are legally identical to opposer's services. In view of the absence of any limitations or restrictions in applicant's recitation of services, the purported differences in the parties' respective musical styles are immaterial. Likewise, we must presume from the absence of restrictions in applicant's recitation of services that applicant's services are offered in all normal trade channels and to all normal classes of purchasers for such services, including the trade channels and classes of purchasers in which and to whom opposer offers his legally identical services. See In re Elbaum, 211 USPQ 639 (TTAB 1981). There is no evidence of any use by third parties [*24] of similar marks for similar services. These *du Pont* factors, as to which there are no genuine issues of material fact, all weigh heavily in favor of a finding of likelihood of confusion in this case.

The only *du Pont* factor which appears to favor applicant is the absence of evidence of actual confusion. However, we cannot conclude that the nature and extent of the parties' respective uses of their marks, to date, have been such that the absence of actual confusion should be accorded any significant weight in our likelihood of confusion analysis. See Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768 (TTAB 1992). Certainly, that single factor is insufficient to overcome the numerous other *du Pont* factors which, as discussed above, clearly weigh in favor of a finding of likelihood of confusion.

In summary, we find that there are no genuine issues of material fact as to any of the *du Pont* likelihood of confusion evidentiary factors. Having carefully considered all of the evidence of record as to those factors, we find that a likelihood of confusion exists. Having also found that no genuine issues of material fact exist with respect to opposer's standing [*25] and his Section 2(d) priority, we conclude that opposer is entitled to judgment as a matter of law on his Section 2(d) claim. Therefore, we grant opposer's motion for summary judgment, and deny applicant's cross-motion for summary judgment.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawProtection of RightsGeneral OverviewTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsGroundsTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsStanding

EXHIBIT 16

LEXSEE 2005 TTAB LEXIS 543

Schlage Lock Company v. Mark J. Staiano

Opposition No. 91152703 to application Serial No. 76278459, filed on June 29, 2001

Trademark Trial and Appeal Board

2005 TTAB LEXIS 543

December 12, 2005, Mailed

DISPOSITION:

[*1]

Decision: The opposition is dismissed as to all claims.

COUNSEL:

Dyann L. Kostello of Michael Best & Friedrich LLP for Schlage Lock Company

Robert C. Faber of Ostrolenk, Faber, Gerb & Soffen, LLP for Mark J. Staiano

JUDGES:

Before Walters, Bucher and Kuhlke, Administrative Trademark Judges.

OPINION BY: KUHLMKE

OPINION:

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Mark J. Staiano, seeks registration of the mark shown below

[SEE ILLUSTRATION IN ORIGINAL]

for goods ultimately identified in the application as "sunglasses" in International Class 9, "tote bags, luggage trunks, wallets" in International Class 18, "clothing, namely, underwear, jeans, mitten, pants, sleepwear, sweaters, sweat shirts without hoods, sweat shirts with hoods, swim wear, tank tops, socks, sport shirts, sweat pants, t-shirts, bathing trunks, undershirts and footwear, namely thongs" in International Class 25, and "cigars, cigarettes, tobacco, cigarette rolling papers, smoking pipes, matches, tobacco pouches" in International Class 34. n1 The design element is described in the following manner, "the mark consists of the design [*2] of an aloe plant."

n1 Serial No. 76278459, filed June 29, 2001. The application is based on bona fide intent-to-use in each international class under Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

Opposer, Schlage Lock Company, opposed registration of applicant's mark, on the following grounds: (1) that, as applied to applicant's goods, the mark so resembles opposer's previously used and registered marks KRYPTONITE and KRYPTO formative marks for a wide variety of goods, including tote bags, as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. § 1052(d); (2) that applicant's mark is likely to and has diluted opposer's famous marks under Trademark Act Section 43(c), 15 U.S.C. § 1125(c); and (3) that applicant's mark is immoral and scandalous under Trademark Act Section 2(a), 15 U.S.C. § 1052(a). Opposer also pleaded several registrations and set forth allegations that its marks compose a family of KRYPTO formative marks and achieved fame prior to applicant's filing date.

Alleged Admissions

As a preliminary [*3] matter, we address opposer's argument that applicant has admitted the allegations regarding the Section 2(a) claim. Opposer's original complaint was filed on August 15, 2002 and applicant filed its answer thereto on November 12, 2002. Thereafter, opposer's motion to amend the complaint filed June 2, 2003 to add paragraph nos. 21 and 22, the Section 2(a) claim, was granted as conceded, applicant was allowed time in which to file an answer to the amended complaint and the trial schedule was reset. Applicant did not file an answer to the amended complaint; however, opposer went forward with its trial period, including submission of material in support of its 2(a) claim. Applicant then took testimony and submitted evidence during its trial period. For the first time, in its main brief on the case, opposer argues that applicant "by its failure to deny the averments in the Amended Notice of Opposition has admitted them, and those admissions alone are sufficient to enter judgment in [opposer's] favor." Brief p. 9. Applicant, in response, argues that "laying in wait to complain about a formal matter and proceeding through trial as though the formal matters were correct is not proper procedure [*4] and is a waiver by opposer." Brief p. 5. Further, applicant states that "applicant's attorney never received an order mailed from the TTAB that the Motion to file an Amended Notice of Opposition was granted or that Applicant had a set time to answer it" thus applicant has "an explained error, an oversight which neither Opposer commented upon by timely seeking entry of default, nor the Board commented upon by giving notice of failure to file an Answer, and which Applicant was unaware of." Applicant concludes that "Opposer should be viewed as having waived its now late asserted claim of a default, or the fact that Applicant has throughout disputed Opposer's allegations should be sufficient to avoid an effective judgment by default here." Brief p. 5. In reply, opposer essentially argues that it did not waive its right to assert that by operation of the Federal Rules, specifically, *Fed. R. Civ. P. 8(d)*, applicant has admitted the allegations that its mark "consists of immoral and scandalous matter." Reply Brief p. 3.

Paragraph nos. 1-20 in the amended complaint are identical to the original complaint and applicant answered those allegations on [*5] November 12, 2002; therefore, the only allegations that could possibly present an issue here, which opposer apparently concedes in its reply brief, are set forth in paragraph nos. 21 and 22, the Section 2(a) allegations of scandalous and immoral matter. Whether we consider this issue under the good cause standard of *Fed. R. Civ. 55* (in the case of default) or under *Fed. R. Civ. P. 8(d)* regarding admissions of claims by operation of the Rules, we find that, under these circumstances, those allegations have been denied. It is the policy of the law to decide cases on their merits, particularly here, where the matter has been tried and opposer did not seek to move for default on that claim prior to trial or rest its case at trial on the alleged admissions or even acknowledge applicant's failure to respond to the Section 2(a) claim but rather submitted evidence during its trial period and cross-examined during applicant's trial period on that claim. In sum, the issue has been tried and, to the extent necessary, we consider the answer to be amended to conform to the evidence to include denials of paragraph [*6] nos. 21 and 22. *Fed. R. Civ. P. 15(b)*.

Evidentiary Objections

We now turn to the evidentiary issues presented by both parties. Opposer, in its main brief, moves to strike applicant's exhibits 1-21 and the testimony of Annette Staiano and accompanying exhibits. Opposer's objections to this evidence and testimony are overruled.

With regard to exhibits 1-21 opposer states that during the discovery period opposer requested applicant to produce "All documents supporting any affirmative defense raised in Applicant's Answer," (Document Request No. 20) and to "Identify all marks which Applicant contends are relevant to this proceeding" (Interrogatory No. 17). Brief p. 8. Although not specifically articulated, we understand opposer's argument to be that exhibits 1-21 constitute responsive documents that should have been produced during discovery and opposer only first received them during applicant's testimony period under notice of reliance. Exhibit nos. 1-19 consist of printouts of third-party registrations from the Trademark Electronic Search System (TESS). A party need not investigate third-party registrations in response to discovery [*7] requests, *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1788 (TTAB 2001) (no obligation to search for third-party uses), nor is a party required to specify in detail the evidence it intends to present or identify the witnesses it intends to call. *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1657 (TTAB 2002) (interrogatory requesting that opposer "identify each and every fact, document and witness in support of its pleaded allegations was equivalent to a request for identification of fact witnesses and trial evidence prior to trial and therefore improper). Therefore, the TESS printouts in exhibit nos. 1-19 and the dictionary definitions in exhibit nos. 20-21 were properly submitted under notice of reliance.

With regard to the testimony deposition of Annette Staiano and accompanying exhibits opposer argues that it did not have time to prepare for the deposition because the documents presented at the deposition were not received by opposer until the eve of the deposition and, with regard to some documents, at the deposition. Again, opposer objects to applicant's timing of trial preparation stating that "many of the documents [*8] used in Annette Staiano's deposition consisted of Internet printouts showing third party uses of the marks KRYPTO' and KRYPTONITE,' some of which were dated in August and September, and provides no explanation as to why its investigation of third party use did not commence until several months after the close of discovery and eight months after applicant responded to Kryptonite's discovery requests" and "had applicant timely conducted its investigation and produced its documents during the discovery period, Kryptonite would have had an opportunity to consider those documents and consider whether it should conduct further discovery or an additional investigation of its own." Brief p. 8. As stated above, applicant had no duty to conduct an investigation of third-party use during discovery. See *Sports Authority, supra*; see also, *Polaroid Corp. v. Opto Specs, Ltd.*, 181 USPQ 542, 543 (TTAB 1974) (opposer need not describe evidence it will rely on to support allegations in opposition) and *Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040, 2041 (TTAB 1989) (motion to exclude testimony of witness for failure to identify witness [*9] during discovery denied). Opposer is put at no disadvantage here in a Board trial. Opposer had thirty days between the close of applicant's testimony period and the opening of its rebuttal period to prepare any rebuttal against evidence of third-party use. Notably, opposer did not submit rebuttal evidence or take rebuttal testimony.

Applicant moves to strike exhibits 12 and 15 "because they are inappropriate for a Notice of Reliance" and are "the rankest form of hearsay." Brief p. 3. Exhibit nos. 12 and 15 are excerpts from websites. The Board notes, in addition, that exhibit nos. 16 and 24 are also excerpts from websites, exhibit no. 17 is a copy of an article from an online news source and exhibit no. 23 is a listing from a search conducted on the Google search engine. None of these items may be submitted under a notice of reliance. Opposer cites to a 1976 decision to support the proposition that it may submit the printout of a page from a website under a notice of reliance. Opposer also looks to *International Assoc. of Fire Chiefs, Inc. v. H. Marvin Ginn Corp.*, 225 USPQ 940 (TTAB 1985) for support; however, that decision dealt with NEXIS printouts of excerpted stories [*10] published in newspapers, magazines, etc. The case on point is *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 1370 (TTAB 1998). In short, the element of self-authentication cannot be presumed to be capable of being satisfied by information obtained and printed out from the Internet and web pages are not considered the equivalent of printouts from a NEXIS search inasmuch as such printouts are the electronic equivalents of the printed publications, and permanent sources for the publications are identified. In view thereof, applicant's objections are sustained and exhibit nos. 12 and 15 are hereby stricken from the record. *Raccioppi, supra*; Furthermore, for the same reasons, the additional specified exhibit nos. 16, 17, 23 and 24 have been given no consideration. See *Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc.*, 201 USPQ 881 (TTAB 1979) (improper subject matter excluded, although no objection.).

Applicant has also moved to strike the deposition of Chantalle Stocco and accompanying exhibits because the witness conducted her investigation "during the pretrial discovery period and [the documents] could have and should have been supplied to applicant's [*11] attorney during or even right after discovery." Brief p. 3. Applicant has failed to state and prove that it served discovery on opposer requesting such information. In view thereof, applicant's objection to the Chantalle Sacco deposition and accompanying exhibits is overruled.

The evidence of record, therefore, includes the pleadings herein, the file of the opposed application, the testimony depositions of Chantalle Stocco and accompanying exhibits and Annette Saiano and accompanying exhibits.

In addition, opposer properly submitted, under a notice of reliance, the status and title copies of its pleaded registrations, dictionary definitions of the words "toke" and "grass," pages from Relix and Headquest magazines, and the file history of Registration No. 2244791. Applicant submitted, under notice of reliance, printouts from the USPTO TESS database of several third-party registrations, the dictionary definition of KRYPTONITE, and opposer's response to applicant's interrogatories nos. 28 and 29.

We will now address each claim in turn.

Likelihood of Confusion under Section 2(d)

As noted above, opposer pleaded several registrations. The registrations, all of which are in [*12] full force and effect and owned by opposer, are summarized as follows:

-- Registration No. 1002571, which is of the mark KRYPTONITE (in typeset form) for "locking mechanisms, namely, locks for bicycles and the like" in International Class 6 filed April 1, 1974, issued on January 28, 1975;

-- Registration No. 1352416, which is of the mark KRYPTONITE-5 (in typeset form) for "metal locking mechanisms, namely, locks for bicycles, mopeds, motorcycles, and the like" in International Class 6, filed on January 24, 1985 issued on August 6, 1985;

-- Registration No. 2244791, which is of the mark KRYPTONITE (in typeset form) for "bicycle parts specially adapted for mounting on bicycles, namely, the following, duffel bags and carriers for mounting on bicycle racks, crossbars, and handlebars: in International Class 12 and for "commuter bags for bicyclists, namely, tote bags, travel bags, duffel bags, briefcases, messenger bags" in International Class 18 filed January 9, 1995, issued on May 11, 1999;

-- Registration No. 2269238, which is of the mark KRYPTONITE (in typeset form) for "metal locks, metal locking mechanisms, metal security cable, metal integrated locks and cable" in International [*13] Class 6, filed October 5, 1998, issued on August 10, 1999;

-- Registration No. 2332840, which is of the mark KRYPTO (in typeset form) for "metal locks, and integrated locks and cable" in International Class 6, filed May 17, 1999, issued on March 21, 2000;

-- Registration No. 2330279, which is of the mark KRYPTO DISCO (in typeset form) for "metal locks for scooters and motorcycles" in International Class 6, filed June 1, 1998, issued on March 14, 2000;

-- Registration No. 1416395, which is of the mark KRYPTO LOK (in typeset form) for "metal locking mechanisms, namely, locks and carrying brackets for use therewith for bicycles, mopeds, motorcycles, and the like" in International Class 6, filed February 10, 1986, issued on March 13, 1990;

-- Registration No. 1416395, which is of the mark KRYPTO LOK (in typeset form) for "metal locking mechanisms, namely, locks and carrying brackets for use therewith for bicycles, mopeds, motorcycles, and the like" in International Class 6, filed February 10, 1986, issued on March 13, 1990;

-- Registration No. 2003582, which is of the mark KRYPTOFLEX (in typeset form) for "metal security cable" in International Class 6, filed November 14, 1994, issued [*14] on September 24, 1996;

-- Registration No. 2247281, which is of the mark KRYPTOKOIL (in typeset form) for "metal integrated lock and cable" in International Class 6, filed October 6, 1997, issued on May 25, 1999; and

-- Registration No. 2254953, which is of the mark KRYPTOVAULT (in typeset form) for "metal locks" in International Class 6, filed October 6, 1997, issued on June 22, 1999.

Because opposer has made its pleaded registrations of record, and because its likelihood of confusion claim is not frivolous, we find that opposer has established its standing to oppose registration of applicant's mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Additionally, because opposer has made its pleaded registrations of record, priority is not an issue in this proceeding. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

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 [*15] 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., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "the fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). Moreover the goods need not be identical or directly competitive in order for there to be a likelihood of confusion. Rather, the respective goods need only be related in some manner or the conditions surrounding their marketing be such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Opposer pleaded and argued that its marks comprise a family of marks incorporating the KRYPTO element and that its marks are famous. [*16] The only evidence applicant has submitted in support of these two allegations are the above-listed registrations. "Simply using a series of similar marks does not of itself establish the existence of a family."

J & J Snackfoods Corp. v. McDonald's Corp., 932 F.2d 1360, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). In order to prove a family of marks, opposer would need to submit evidence or testimony to show that it promotes its marks together. *Id.* Opposer has not submitted any evidence with regard to how its marks are promoted and perceived by consumers; therefore, we find that opposer has not established a family of marks. Similarly, as to fame, the fact that opposer's mark KRYPTONITE has been registered since 1978 and that the registrations for that mark are incontestable does not, without more, lead to the conclusion that they are famous; therefore, we find that opposer has not established that its marks are famous.

Turning now to consider the goods identified in all of opposer's pleaded registrations, except for Registration No. 2244791, we find that the record does not establish that such goods are sufficiently similar or related to applicant's identified goods that, [*17] if used on or in connection with confusingly similar marks, confusion as to source is likely. Opposer's testimony and accompanying exhibits showing registrant's various metal locks, cables and carrying brackets sold in the same large discount retail establishment (e.g., Target) as applicant's sunglasses, clothing and footwear, is not sufficient evidence, without more, upon which the Board may find the goods to be similar or related. By opposer's logic, based on the evidence of record we could also find swimsuits and bicycle tires to be related goods. The mere fact that a consumer can purchase a gallon of milk and a car battery at these establishments does not lead to the conclusion that car batteries and milk are related under relevant trademark law.

With regard to Registration No. 2244791, we find that applicant's tote bags and luggage trunks in International Class 18 are related and/or similar to opposer's "duffel bags and carriers for mounting on bicycle racks, crossbars, and handlebars" in International Class 12 and opposer's "commuter bags for bicyclists, namely, tote bags, travel bags, duffel bags, briefcases, messenger bags" in International Class 18. In particular, applicant's [*18] tote bags encompass opposer's tote bags for bicyclists and, as such, are legally identical goods.

In addition, inasmuch as there are no limitations in the applicant's identification of goods we presume that the trade channels overlap, at a minimum, to the extent that applicant's goods encompass opposer's goods in Registration No. 2244791, and that the goods would be offered to all normal classes of purchasers. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

We now turn to the first du Pont factor, i.e., whether applicant's mark and opposer's marks are similar or dissimilar when compared in their entireties in terms of appearance, sound, connotation and commercial impression. We make this determination in accordance with the following principles. The test, under the first du Pont factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source [*19] of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

The appearance of applicant's mark is substantially different from opposer's marks in view of the prominent design portion of applicant's mark, which is larger than the words and includes the stylized lettering KK that frames the word portion. In addition, the word portion is stylized in a manner that emphasizes the K's which ties the word into the KK leaf design. The word portion of applicant's mark shares a similar beginning, KRYPTO, with registrant's marks but the similarity in sound ends there. The connotation [*20] of applicant's mark is also different from opposer's marks in view of the second portion of applicant's mark, KING. As used in each mark, the connotation of KRYPTO is simply not clear from this record, thus we cannot find that there is a similar connotation. Rather the connotations come from the other elements in the marks which are wholly different (KING v. LOK, KOIL, FLEX and VAULT). Further, we find the overall commercial impressions of the marks are not similar. The similarity of the first part of the word portion of the parties' marks is overshadowed by the visual and phonetic dissimilarities, and further distinguished by the stylized KK lettering incorporated in the design element in applicant's mark. With regard to opposer's KRYPTONITE marks, we find that the shared KRYPTO portion has even less significance inasmuch as KRYPTONITE is one word that is defined as "any surviving fragment of the exploded mythological planet Krypton, home of Superman." Webster's Millennium Dictionary of English, Lexico Publishing Group, LLC (2003). Therefore, we find that KRYPTO is not the dominant portion of KRYPTONITE. In view of the above, we find, as to each of opposer's registrations, that the [*21] parties' marks are not similar. n2

n2 We note that applicant has submitted several examples of third-party registrations and use of KRYPTO formative marks, but very few are of probative value. See e.g., Exhibit No. 7 Registration No. 1803187 for the mark KRYPTONICS for shock absorbers, compression bumpers, and brake pads for bicycles; and Registration No. 1239506 for the mark KRYPTONITE for clothing, namely, t-shirts. Many of these registrations and examples of use are for use in connection with goods different from opposer's and applicant's respective goods and thus are of no probative value as to the du Pont factor of "the number and nature of similar marks in use on similar goods." *Du Pont, supra*.

Finally, we note applicant's argument regarding opposer's agreement with a third-party that may limit opposer's use of the mark KRYPTONITE to locks. First, to the extent applicant is arguing a defense of unclean hands, this defense was not pleaded or tried and cannot be considered. Moreover, to the extent applicant's argument that opposer's use on goods other than locks is "illegal," this would constitute an impermissible attack on a pleaded registration and no [*22] counterclaim has been filed.

We conclude that the evidence of record as it pertains to the relevant du Pont factors does not support a finding of likelihood of confusion as to any of opposer's registrations. With regard to Registration No. 2244791 we also find that confusion is unlikely to result from contemporaneous use of opposer's mark and applicant's mark, even where the marks are used on identical goods marketed in the same trade channels to the same class of purchasers. We find that the dissimilarity of the marks simply outweighs the other relevant du Pont factors. *Kellogg Co. v. Pack'em Enterprises Inc., 14 USPQ2d 1545 (TTAB 1989)*, *aff'd, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991)*.

Dilution Under Section 43(c)

A prerequisite for a dilution claim is that the plaintiff's mark is famous. *Toro Co. v. ToroHead Inc., 61 USPQ2d 1164 (TTAB 2001)*. As noted above, opposer has not proven fame, therefore its dilution claim must fail.

Immoral and Scandalous Under Section 2(a)

Registration of a mark which consists of or comprises immoral or scandalous matter is prohibited under Section 2(a) of the *Trademark Act*. *In re Boulevard Entertainment, Inc., 334 F.3d 1336, 1339, 67 USPQ2d 1475, 1477 (Fed. Cir. 2003)* [*23] citing *In re Mavety Group, Ltd., 33 F.3d 1367, 31 USPQ2d 1923 (Fed. Cir. 1994)*. Further, our reviewing court stated as follows:

... the PTO must consider the mark in the context of the marketplace as applied to the goods described in the application for registration. [citation omitted] In addition, whether the mark consists of or comprises scandalous matter must be determined from the standpoint of a substantial composite of the general public (although not necessarily a majority), and in the context of contemporary attitudes, [citation omitted], keeping in mind changes in social mores and sensitivities.

In re Boulevard Entertainment, Inc., 334 F.3d 1336, 1339, 67 USPQ2d 1475, 1477. See also *In re McGinley, 660 F.2d 481, 485, 211 USPQ 668, 673 (CCPA 1981)*.

Thus, whether a mark comprises immoral and scandalous matter is to be ascertained in the context of contemporary attitudes, and the relevant viewpoint is not necessarily that of a majority of the general public, but of a "substantial composite." *Ritchie v. Simpson, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999)* citing *In re Mavety, 33 F.3d 1367, 1371, 31 USPQ2d 1923, 1925 (Fed. Cir. 1994)*. [*24] Further, we must consider the mark in the context of the marketplace as applied to only the goods described in the application for registration. *In re Mavety Group, Ltd., 33 F.3d 1367, 1371, 31 USPQ2d 1923, 1925 (Fed. Cir. 1994)*.

In this case, opposer has not submitted any evidence concerning the viewpoint of a substantial composite of the general public or contemporary attitudes. Based solely on opposer's speculation and dissection of the mark, opposer argues that the mark contains the design of a marijuana leaf and the word "toking," which is defined as "a puff on a marijuana cigarette or pipe." Merriam-Webster Dictionary (2003). Opposer attempts to put the mark into the context of the marketplace by submitting examples of advertising in a magazine and concludes that "it is quite clear" that applicant's goods "are designed for marijuana smoking." n3 Brief p. 16.

n3 We note that some of opposer's evidence submitted in support of its Section 2(a) claim has been stricken. However, this evidence does not address the viewpoint of a substantial composite of the general public as to the mark for which application is sought; therefore, even if we considered that evidence it would not alter our decision.

[*25]

We note that the goods for which applicant seeks registration are legal and may be used in connection with legal goods. Thus, taken in the context of the goods for which application is sought, there is no evidence in the record to support a finding that: (1) a substantial composite of the general public would perceive the leaf design in this mark as a marijuana leaf rather than, for example, an aloe leaf, as the mark is described in the application; n4 (2) a substantial composite of the general public would parse out the single stylized word KRYPTOKING with emphasis on the double KK's to find the word toking and know its meaning; and, most critically, (3) a substantial composite of the general public would find use of the mark immoral or scandalous as used on the identified goods. In view thereof, we find that opposer has not met its evidentiary burden to succeed on this claim.

n4 Four excerpts from two publications do not provide sufficient evidence to make any determination as to how the general public views this mark, and, in particular, in connection with the goods listed in the application. Nor is there any evidence to establish what a marijuana leaf looks like.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawLikelihood of ConfusionConsumer ConfusionCircuit Court FactorsFederal Circuit CourtTrademark LawProtection of RightsGeneral OverviewTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsStanding

GRAPHIC:

[*26]

Illustration 1, no caption

EXHIBIT 17

LEXSEE

Tommy Hilfiger Licensing, Inc. v. Henri-Lloyd, Limited

Opposition No. 118,396 to Application Serial No. 75/489,129

Trademark Trial and Appeal Board

2003 TTAB LEXIS 441

September 3, 2003, Decided

CORE TERMS: opposer, laurel, registration, notice, crest, pleaded, composite, similarity, prominent, clothing, shirt, bags, hat, registered, ribbon, jacket, common law, dissimilarity, consumer, sprigs, socks, pants, caps, trademark, impression, surrounded, appearance, channels, unpleaded, conform

DISPOSITION:

[*1]

Decision: The opposition as to International Classes 18 and 25 is dismissed, and the application will be forwarded for the issuance of a notice of allowance in all three classes, namely International Classes 9, 18 and 25, at the appropriate time.

COUNSEL:

Mary L. Greico, Louis S. Ederer and Charu Narang of Gursky & Ederer, LLP for Tommy Hilfiger Licensing, Inc.
Alan H. Levine and Howard F. Mandelbaum of Levine & Mandelbaum for Henri-Lloyd, Limited.

JUDGES:

Before Chapman, Bucher and Rogers, Administrative Trademark Judges

OPINION BY: BUCHER

OPINION:

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Opinion by Bucher, Administrative Trademark Judge:

An application has been filed by Henri-Lloyd, Limited to register the composite mark shown below. [SEE ILLUSTRATION IN ORIGINAL] At the request of the Trademark Examining Attorney, applicant described its mark as consisting of "an open crown, the letters H and L and a wreath, all placed upon a diamond background."

According to the application papers, applicant intends to use the mark on the following goods:

"marine, life saving, and emergency equipment and garments, namely, life saving belts, inflatable suits, buoys, jackets, [*2] nets and rafts, safety harnesses, safety ropes, and safety lines," in International Class 9;

"articles made from leather and imitation leather, namely, wallets, purses, handbags, and briefcases, trunks, traveling bags, suit cases, holdalls, overnight bags, sail bags, and duffle bags," in International Class 18; and

"clothing, footwear and headgear, namely, coats, suits, jackets, trousers, salopettes, overtrousers, pants, shorts, shirts, sweatshirts, t-shirts, vests, waistcoats, cagoules, anoraks, smocks, sweaters, pullovers, bodywarmers, scarfs, ties, gloves, belts, socks, hoods, caps, hats, headbands, underwear, neckwear, sandals, shoes, slippers, boots, and sneakers," in International Class 25. n1

n1 Application Serial No. 75/489,129 was filed on May 21, 1998, based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

Registration has been opposed by Tommy Hilfiger Licensing, Inc., but only as to the goods in International Classes 18 and 25, on the ground that it has previously used and registered its Hilfiger crest design as shown below; [SEE ILLUSTRATION IN ORIGINAL] n2 as well as the same Hilfiger crest design lined for [*3] color shown below; [SEE ILLUSTRATION IN ORIGINAL] n3 and its TH and laurel design shown below. [SEE ILLUSTRATION IN ORIGINAL] n4 Opposer also asserts various common law uses of a letter "H," examples of which will be discussed later in this opinion. Opposer asserts that each of these marks have been used since long prior to applicant's filing date herein. Opposer then asserts that applicant's mark, when used on its goods in International Classes 18 and 25, so resembles opposer's previously used and registered trademarks as to be likely to cause confusion, to cause mistake, or to deceive.

n2

- (1) Reg. No. 1,673,527 for "clothing for men and boys, namely, shirts, sweaters, sportcoats, pants, sweatshirts, shorts, sports jackets, raincoats, parkas, overcoats, bathing suits, vests, turtle-necks," in International Class 25, issued on January 28, 1992, renewed;
- (2) Reg. No. 1,816,430, for "ties, socks, suspenders, hats, caps, suits and blazers," in International Class 25, issued on January 11, 1994, Section 8 affidavit accepted and Section 15 affidavit acknowledged;
- (3) Reg. No. 1,879,005, for "retail store services," in International Class 42, issued on February 14, 1995, Section 8 affidavit accepted and Section 15 affidavit acknowledged;
- (4) Reg. No. 1,935,702, for "articles of leather and imitation leather; namely wallets, credit card cases, umbrellas, traveling bags, billfold," in International Class 18, issued on November 14, 1995, Section 8 affidavit accepted and Section 15 affidavit acknowledged;
- (5) Reg. No. 2,120,621, for "footwear, namely, shoes, boots, sneakers, sandals and slippers," in International Class 25, issued on December 9, 1997;
- (6) Reg. No. 2,153,151, for "sunglasses, eyeglasses and eyeglass frames," in International Class 9, issued on April 21, 1998;
- (7) Reg. No. 2,179,671, for "jewelry made of precious and nonprecious metals and stone, namely, cuff links," in International Class 14, issued on August 4, 1998.

[*4]

n3 Reg. No. 1,940,821, for "articles of clothing, namely, shirts, sweaters, sportscoats, pants, sweatshirts, shorts, sports jackets, raincoats, parkas, overcoats, bathing suits, vests, turtle-necks, ties, socks, suspenders, hats, caps, suits and blazers," in International Class 25, issued on December 12, 1995, Section 8 affidavit accepted and Section 15 affidavit acknowledged.

n4 Reg. No. 2,050,013, for "shirts, hats, caps, pants, shorts and socks," in International Class 25, issued on April 1, 1997, Section 8 affidavit accepted and Section 15 affidavit acknowledged.

Applicant, in its answer, denied the salient allegations of the notice of opposition.

The record consists of the pleadings; the file of the opposed application; opposer's notice of reliance and supplemental notice of reliance; and the testimony, with exhibits, of opposer's Vice President and Associate Counsel, Jade H.J. Huang. Applicant took no testimony and offered no evidence at trial. The parties have fully briefed the case but an oral hearing was not requested.

Before turning to the merits of this case, we must discuss several preliminary matters.

First, applicant has objected to much of the testimony [*5] of opposer's only trial witness, Ms. Jade H.J. Huang. Although Ms. Huang testified that she was hired as associate counsel and vice president of opposer in March 1999, her testimony related to opposer's use of its various marks since 1985. Accordingly, applicant has objected to much of her testimony on the ground of hearsay.

In the face of repeated objections to this testimony by applicant's counsel at the time the deposition was being taken, opposer's counsel elicited detailed information from Ms. Huang about how her job duties had permitted her to acquire her personal knowledge of relevant facts to which she was testifying. She explained her role as opposer's primary intellectual property manager, and how she gathered information regarding opposer's trademarks and franchising agreements. For example, she described her orientation to the firm in 1999 through contact with her predecessor and visits with the heads of each of opposer's divisions. She testified to her participation in discussions of Tommy Hilfiger's annual design directives, and of her review of existing files in the legal department she heads as well as the files existing in opposer's other divisions. n5

n5 Trial testimony of Jade H.J. Huang, pp. 4 - 5, 7 - 8, 34 - 35.

[*6]

In this case, we find that applicant's objections to Ms. Huang's testimony are not well taken. As opposer's primary in-house trademark counsel, she plays a distinct role in opposer's overall marketing function, and specifically in promoting opposer's brand image. She testified as to how she became aware of the history of the selection and use of opposer's various marks. The documents and files she relied upon are business information, and as such, fall within the business records exception to the hearsay rule. Accordingly, this witness is competent to testify to those matters of which she had personal knowledge, including her knowledge of company history based upon her personal and repeated review of, and familiarity with, company business records.

Next, we note that opposer has filed a motion to amend its notice of opposition to conform to the evidence under Fed. R. Civ. P. 15(b). Opposer has no federal trademark registration of a mark consisting of a letter "H," and while the notice of opposition discusses opposer's "crest design" and its "TH and laurel" design, nowhere in the notice of opposition does opposer allege rights in the letter [*7] "H" alone. Nonetheless, during the trial testimony of its witness, opposer's counsel spent substantial time eliciting information about opposer's use for more than a decade of a letter "H," such testimony being supported by exhibits demonstrating such usage.

[SEE ILLUSTRATIONS IN ORIGINAL] n6

n6 Trial testimony of Jade H.J. Huang, pp. 60 - 72, and Exhibit # 14, pp. 1 and 4, letter "H" as applied to a jacket, rugby shirt and hat.

We also find that all of opposer's exhibits were clearly intended to be offered into evidence during this testimony period deposition. See 37 C.F.R. § 2.123(e)(2) and TBMP § 713.08 (2d ed. June 2003).

Although applicant objected to this testimony on the basis of hearsay, etc., as discussed above, opposer made clear during its trial testimony that in addition to the "crest design" and the "TH and laurel design" marks it had initially pleaded, it was also basing its likelihood of confusion argument on the use of a prominent letter "H" as well.

Under Fed. R. Civ. P. 15(b), when issues not raised by the pleadings are tried by express or implied consent of the parties, the pleadings may [*8] be amended to conform to the evidence. Implied consent to the trial of an unpleaded issue can be found only where the non-offering party (1) raised no objection to the introduction of evidence on the unpleaded issue and (2) was fairly apprised that the evidence was being offered in support of the unpleaded issue. See Colony Foods, Inc. v. Sagemark, Ltd., 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984); Levi Strauss & Co. v. R. Josephs Sportswear Inc., 36 USPQ2d 1328 (TTAB 1994); and Devries v. NCC Corporation, 227 USPQ 705 (TTAB 1985).

We find that the issue of whether opposer has established common law rights in the letter "H" *per se* was tried by the implied consent of applicant. Applicant did not raise objections to the introduction of this evidence on the ground that it was irrelevant or outside the scope of the proceeding; and applicant was fairly apprised that the evidence was being offered in support of the issue of likelihood of confusion. See TBMP Section 507.03(b)(2d ed. June 2003) and

cases cited therein. In this case, there is direct testimony supported by evidence appropriately [*9] made of record from which we can say that applicant was or should have been on notice that opposer was asserting common law rights in the letter "H" *per se*. Applicant had the opportunity to meet this showing as it saw fit, and in fact, cross-examined the witness on this evidence. Amending the notice of opposition to include this claim does not create prejudice to applicant, and hence we grant opposer's motion and consider the notice of opposition to be amended to conform to the evidence pursuant to Fed. R. Civ. P. 15(b).

We turn next to applicant's objection to opposer's supplemental notice of reliance. Applicant argues that this notice was not timely and should be excluded. We disagree. Opposer's Registration No. 2,050,013 (TH and laurel wreath design) issued on April 1, 1997. Immediately upon receiving the registration certificate, opposer filed a Section 7 request for a corrected certificate because the mark was incorrect. The records of the United States Patent and Trademark Office (USPTO) demonstrate that the new registration certificate was reprinted on June 30, 1997 to correct the USPTO's error. Opposer thought the error had been [*10] corrected until such time as it sought a certified copy of the registration from the USPTO to file with its Notice of Reliance in this proceeding dated March 14, 2002, but such copy did not reflect the correction. Opposer noted this problem in an extensive footnote of its Notice of Reliance, and the USPTO has since effected the change. The corrected registration appeared in the *Trademark Official Gazette* of July 9, 2002, and opposer submitted its supplemental Notice of Reliance on August 22, 2002. We find this involves a timely attempt on opposer's part to provide a certified copy of a subsisting registration despite USPTO error. Moreover, we find that permitting opposer to supplement its original Notice of Reliance in this manner does not involve prejudice to applicant.

Opposer's Priority

With respect to priority of use, because opposer has submitted proper status and title copies of its pleaded registrations (e.g., its "crest design" marks and its "TH and laurel design" mark), the issue of priority with regard to these marks does not arise. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). With regard [*11] to opposer's claim of common law rights in the mark "H," the undisputed evidence of record establishes that opposer has used variations of the letter "H" in connection with specific clothing items for several years prior to the earliest date upon which applicant can rely, i.e., its May 21, 1998 application filing date.

In view of the above, opposer has established its priority.

Likelihood of Confusion

We turn then to the question of likelihood of confusion.

Opposer contends that its registered goods include a line of sailing apparel similar to applicant's identified goods; that opposer has created one of the best known lifestyle brands in the United States; and that a consumer familiar with opposer's "crest design," "TH and laurel design," and single letter "H" designations will associate applicant's applied-for mark with opposer's well-known marks.

By contrast, applicant contends that the parties' marks are dissimilar; that opposer's so-called "sailing" line of clothing does not even use any of the three marks claimed by opposer; that even if HILFIGER, TOMMY and TOMMY HILFIGER may be famous marks, the same has not been shown for the "crest design" or the "TH and laurel design"; [*12] and that the goods of both parties are not "impulse" items, but rather would be purchased only after a period of deliberate and careful decision-making.

After careful consideration of the facts before us and the relevant law on the issue of likelihood of confusion, we hold that opposer has failed to show a likelihood of confusion herein, and that applicant is entitled to the registration it seeks.

In the course of determining the question of likelihood of confusion herein, we have followed the guidance of *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). The *du Pont* case sets forth each factor that should be considered, if relevant information is of record, in determining likelihood of confusion.

We turn first to the similarity or dissimilarity and nature of the goods as described in applicant's application and as listed in opposer's claimed registrations and in connection with which its prior marks have been in use as shown by the record for its unregistered but previously used "H" mark. As listed in the involved application and registrations, we find that the travel bags and luggage items, as well as the [*13] items of clothing must be deemed to be legally identical. Likewise, the "H" mark of opposer has been proven to have been used, *inter alia*, on jackets, shirts and hats, which are

legally identical to the same listed items in the involved application. This factor favors finding a likelihood of confusion as to these goods, as argued by opposer.

In a related *du Pont* factor focusing on the similarity or dissimilarity of established, likely-to-continue trade channels, we must assume that these identical and closely related goods identified in the application and registrations will be moving in identical channels of trade to the same types of consumers inasmuch as the identifications are not restricted to any specific classes of consumers or channels of trade. n7

n7 Similarly, while the extrinsic evidence made part of this record suggests both parties' goods may be pricier than the average lines of luggage and clothing, there are no restrictions to this effect in the identification of goods in the involved application or in the pleaded registrations. Thus, we much presume conditions of the level of care exercised by ordinary purchasers of articles of leather and traveling bags in International Class 18 as well as items of wearing apparel in International Class 25.

[*14]

We turn next to the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. The parties spend considerable time discussing the similarities or the dissimilarities of the marks:

[SEE ILLUSTRATIONS IN ORIGINAL]

Opposer argues as follows:

...Henri [-] Lloyd's [applicant's] Laurel Design Mark consists of a crest design comprised of a prominent letter "H" and a much smaller, less prominent, small interlocking "L," surrounded by laurel leaves, with a crown above and a ribbon below the two letters. ... The Hilfiger Crest Design Mark is a stylized crest design comprised of a heraldic lion surrounded by laurel leaves with a crown above and a ribbon below the lion...

By contrast, applicant argues as follows:

The differences between Applicant's Mark and Opposer's Lion Design mark are numerous:

- (a) The most prominent feature of Opposer's Lion Design mark is the Lion Design at the Center. Applicant's Mark has no such element;
- (b) Applicant's Mark has the letters H and L at the center, and Opposer's Lion Design mark includes no letters whatsoever;
- (c) The sprigs of the laurel leaf designs of the two marks [*15] are different in shape as are the laurel leaves themselves;
- (d) Applicant's Mark includes a crown beneath the middle of the upper ends of the laurel leaf springs, whereas Opposer's Lion Design has a castle Design located between the ends of the laurel sprigs;
- (e) The two laurel sprigs of Applicant's Mark abut each other at their lower ends, whereas the lower ends of the laurel sprigs of Opposer's mark are spaced apart;
- (f) The ribbon designs of the two marks are totally different; and
- (g) Opposer's Lion Design mark has no element comparable to applicant's black diamond background.

Keeping in mind that the comparison of marks is not made on a side-by-side basis and that recall of purchasers is often hazy and imperfect, this decision cannot turn on the minimal differences in the laurel sprigs and ribbons (applicant's arguments (c), (e) and (f) above). On the other hand, we agree with applicant that there are significant differences between the appearances of these two marks that should obviate any likelihood of confusion. The central element in opposer's crest design is a lion while the central element of applicant's composite mark consists of the letters HL. Opposer's self-described [*16] crown design actually appears more to be a turret of a castle and hence is different from applicant's crown design. Accordingly, when considered in their entireties, the appearance and overall commercial impression of these two marks is quite different and, we find, would not lead to a likelihood of confusion.

The parties have also disagreed about the similarities between the second of opposer's pleaded marks (registered for shirts, hats, caps, pants, shorts and socks in International Class 25 only) and the mark for which applicant seeks registration:

[SEE ILLUSTRATIONS IN ORIGINAL]

Opposer argues as follows:

...Henri [-] Lloyd's [applicant's] Laurel Design Mark consists of a crest design comprised of a prominent letter "H" and a much smaller, less prominent, small interlocking "L," surrounded by laurel leaves, with a crown above and a ribbon below the two letters. The Hilfiger Laurel Design Mark consists of a capital "T" and capital "H" surrounded by virtually identical leaves. ...

By contrast, applicant argues as follows:

The differences between Applicant's Mark and TH and Design mark are as follows:

- (a) Opposer's Mark has no black diamond background;
- (b) [*17] Applicant's Mark includes the letters H and L superimposed on each other, whereas Opposer's mark has the letters TH adjacent to each other;
- (c) Opposer's mark includes no crown;
- (d) Opposer's mark includes no ribbon.

Again, when considered in their entirety, while both marks do include a letter "H" within a laurel wreath, the two composite marks are dissimilar enough in appearance that we find they create very different overall commercial impressions. Specifically, the letters "TH" are a significant part of opposer's mark while the crown and the large letter "H" are significant features of applicant's mark.

Finally, turning to opposer's common law marks, even though opposer has shown a variety of forms of usage of the letter "H" on items of outerwear, there is no consistency in overall commercial impression of these various usages permitting us to conclude that the letter "H" dominates each of these marks. n8 Accordingly, we cannot find that opposer's composite marks containing the letter "H" are confusingly similar to applicant's composite mark, which clearly contains other arbitrary and prominent elements.

n8 In some of these cases, for example, consumers may well find the HILFIGER or TOMMY HILFIGER portion more dominant.

[*18]

Opposer's theory of the case seems to turn on the fact that "[a] consumer familiar with the three Hilfiger marks upon which this opposition is based, all of which contain key elements that are found in the Henri [-] Lloyd Laurel Design Mark, will naturally associate the Henri [-] Lloyd Laurel Design with Hilfiger." (Opposer's trial brief, p. 9).

In response to this line of reasoning, applicant argues that "apparently recognizing the weakness of its case, Opposer ... attempts to pick and choose various elements from three different marks to contrive some similarity between such a composite and Applicant's Mark. Clearly, there is no basis in law for selecting portions of different marks in order to create an imaginary mark, i.e., a mark which does not exist in reality, so as to fabricate a basis for a likelihood of confusion." (Applicant's trial brief, p. 11).

We need not agree or disagree with the premise of applicant's argument (i.e., opposer's recognizing the weakness of its case), to concur with applicant's position that opposer cannot take elements of several distinct marks and then argue that a combination of these elements creates a likelihood of confusion. n9 In looking [*19] at the similarity of the marks, we must compare applicant's applied-for mark separately against each of opposer's pleaded marks. Accordingly, as to this *du Pont* factor, the overall dissimilarity of the parties' marks favors applicant's position that there is not a likelihood of confusion.

n9 Cf. *H. D. Hudson Manufacturing Company v. Food Machinery and Chemical Corporation*, 230 F.2d 445, 109 USPQ 48 (CCPA 1956) [Opposer cannot rely upon argument that respondent wrongfully combined parts of two or more different marks when creating a new composite mark when that combination of elements was never previously used by opposer.]

Turning to the fame of opposer's claimed marks, it is clear from this record that opposer has experienced significant sales, has spent large sums on advertising, and has created a strong brand awareness within the relevant market sectors. However, this general level of marketing and sales volume is in no way correlated with these pleaded, registered marks. In fact, opposer's catalogues, advertisements and annual reports prominently and frequently feature not the pleaded

marks but the HILFIGER, TOMMY and TOMMY HILFIGER [*20] marks alone and in combination with opposer's red, white and blue nautical flag logo, as shown below:

[]

Accordingly, while we treat opposer's pleaded, registered marks as distinctive and strong marks, we cannot, on this record, find them to be famous or accord them the broad scope of protection to which opposer argues they are entitled.

Finally, in looking at any other established fact probative of the effects of use, we note opposer's suggestion of bad faith intent on the part of applicant in choosing this composite mark: "To bolster the evidence of Henri [-] Lloyd's intent, it is apparent that Henri [-] Lloyd copied elements from several of Hilfiger's marks to create its own mark. Hilfiger is not picking and choosing bits and pieces from its marks." (Opposer's reply brief, p. 8). Absent compelling and objective evidence of bad faith, however, we cannot infer such intent from the adoption of a mark that arguably only moves applicant close to an imaginary composite of opposer's several pleaded marks. n10

n10 Opposer seeks to make this point by contrasting the instant opposition with several of applicant's/Henri Lloyd's other marks to which opposer/Hilfiger does not object:

[SEE ILLUSTRATIONS IN ORIGINAL]

[*21]

In conclusion, we find that while the goods are identical or otherwise closely related and will move through the same channels of trade, the marks themselves are not confusingly similar, we do not regard opposer's pleaded marks as famous marks, and we do not impute any bad faith to applicant in adopting its applied-for mark.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawLikelihood of ConfusionSimilarityAppearance, Meaning & SoundGeneral OverviewTrademark Law-Protection of RightsRegistrationFederal RegistrationTrademark LawU.S. Trademark Trial & Appeal Board Proceeding-sOppositionsGrounds

GRAPHIC:

Pictures 1 through 13, no caption

EXHIBIT 18

LEXSEE

Walters Gardens, Inc. v. Pride of Place Plants, Inc.

Opposition No. 91153755

Trademark Trial and Appeal Board

2004 TTAB LEXIS 301

May 20, 2004, Decided

CORE TERMS: opposer, piilu, plant, cultivar, printout, summary judgment, trademark, database, generic, unauthenticated, declaration, registration, discovery, varietal, website, notice, periodical, genus, generic name, registered, rose, Trademark Rule, terms used, domestic, species, protective, catalogue, excerpt, printed, naming

JUDGES: [*1]

Before Quinn, Hohein and Bucher, Administrative Trademark Judges

OPINION:

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

By the Board:

Applicant is seeking to register the mark PIILU for "live plants." n1 As grounds for the opposition, opposer alleges that applicant's mark is the cultivar name and, thus, the generic name for a *Clematis* plant. n2 Applicant, in its answer, denies the salient allegations of the notice of opposition. n3

n1 Application Serial No. 76201447, filed on January 29, 2001, claiming a *bona fide* intention to use the mark in commerce. Applicant includes a statement that PIILU translates into English as "little duckling."

n2 Although opposer articulates language which appears to invoke Section 2(d) of the Trademark Act, likelihood of confusion with a previously used or previously used and registered mark, opposer does not plead a mark, and further combines such language with allegations that applicant's mark is a cultivar name for live *Clematis* plants. See paragraph no. 5 of the notice of opposition. Such allegations appear to be amplifications of opposer's claim that applicant's mark is generic. Thus, the only pleaded claim, and the claim before us, is that applicant's mark, as a cultivar name, is the generic name for the goods.

[*2]

n3 Opposer's consented motion, filed September 28, 2003, to extend discovery and trial dates is granted.

This case now comes up on opposer's fully-briefed motion, filed November 21, 2003, for summary judgment in its favor on the ground that applicant's mark is the cultivar name of a *Clematis* plant and, thus, the generic name of the goods. n4 In addition, applicant has filed objections to most of the evidence submitted by opposer, which we address first.

n4 To the extent that opposer argues (at p. 12 of its brief) that applicant's mark is deceptive or deceptively misdescriptive, said issues have not been pleaded and are not before us. See Fed. R. Civ. P. 56(a); and TBMP Section 528.07(a) (2nd ed. Rev. 1 March 2004).

Applicant's objections to evidence

Applicant's objection to opposer's Exhibit Nos. 1 and 2 (photocopies of books) as unauthenticated is overruled. Applicant's objection to Exhibit No. 2 as not being introduced by way of a witness testifying to the truth, identification, or authenticity of such exhibit is overruled. Trademark Rule 2.122(e) allows the introduction of printed publications, including [*3] books. On summary judgment, said materials need not be introduced by way of notice of reliance or affidavit or declaration of a witness. *See* TBMP Section 528.05(e) (2nd ed. Rev. 1 March 2004). Both submissions contain appropriate information for self-authentication, including: title, editor or compiler, organization for whom materials were compiled, publisher, city of publishing, and copyright date. *Cf.* Wright & Gold, 31 Federal Practice and Procedure: Evidence § 7140 (2000), discussing *Fed. R. Evi. 902(6)*, ("The rule extends to both domestic and foreign publications.") We note that Exhibit No. 1 is published in the United Kingdom and is in English. Applicant's objections to opposer's Exhibit No. 1 that it allegedly evidences foreign use by applicant and that it may contain references in a language other than English are overruled. n5 To the extent applicant is objecting to Latin references to the genus and species of plants, and foreign terms used as the cultivar names of plants, applicant objection is without merit. Such references go to the practice in the field of naming plants and may be highly relevant to public perception in the [*4] United States of the term applicant seeks to register, and of the ultimate issue before us: whether the PIILU is the generic name of a *Clematis* plant.

n5 The Board notes in passing the some of applicant's exhibits also are in foreign languages, at least in part.

Applicant's objection to opposer's Exhibit Nos. 3, 6, 7, 8 and 9 (Internet printouts) as unauthenticated, and thus as hearsay, is overruled. Opposer has now submitted a declaration in support of said exhibits. *See Raccioppi v. Apogee Inc.*, 47 USPO2d 1368 (TTAB 1998). *Cf. Tampa Rico Inc. v. Puros Indios Cigars Inc.*, 56 USPO2d 1382 (TTAB 2000) ("... this defect is curable..."). Applicant's objections to Exhibit Nos. 6-10 and 13 as allegedly evidencing foreign use by applicant and because they may contain references in a language other than English are overruled. For the most part, the references are also in English. In addition, as stated previously, Latin terms for genus and species, and foreign terms used as cultivar names, may be relevant to this proceeding.

Applicant's objection to opposer's Exhibit Nos. 4, 10, 11, 12, 13, 14 and 17 (responses to discovery requests, including [*5] produced documents) as unauthenticated is overruled. Trademark Rule 2.127(e)(2) permits the filing of responses to discovery requests, including produced documents, for purposes of summary judgment. *See also* TBMP Section 528.05(c) (2nd ed. Rev. 1 March 2004). Applicant's objections to Exhibit No. 13 as irrelevant because it allegedly evidences foreign use by applicant and because it may contain references in a language other than English are overruled for reasons stated previously. Applicant's objection to opposer's Exhibit No. 16 (copy of a periodical article) as unauthenticated is overruled. Trademark Rule 2.122(e) allows the introduction of printed publications, including excerpts from periodicals. On summary judgment, said materials need not be introduced by way of notice of reliance or affidavit or declaration of a witness. *See* TBMP Section 528.05(e) (2nd ed. Rev. 1 March 2004). The submission contains appropriate information for self-authentication: name of periodical, date of publication, page numbers, title to article, and author of article. *Cf.* Wright & Gold, *supra*, discussing *Fed. R. Evi. 902(6)*, ("... no extrinsic evidence [*6] is required to authenticate printed materials purporting to be newspapers or periodicals.")

Applicant's objection to opposer's Exhibit No. 5 (affidavit of Clarence H. Falstad, III) is overruled. Affidavits may be submitted on summary judgment even though they may be self-serving in nature and there is no opportunity for cross examination. *See* TBMP Section 528.05(b) (2nd ed. Rev. 1 March 2004).

Applicant's objection to opposer's Exhibit No. 15 as unauthenticated is sustained. The exhibit is composed of an apparent letter from applicant to opposer, dated 1998, and an accompanying press release. While such information may be introduced by way of affidavit or declaration or as discovery responses, the exhibit in question does not appear to be part of any discovery response. Although an affidavit was submitted in support of the exhibit, it does not establish the affiant's personal knowledge of the documents and his competency to testify to the matters therein. Instead, the affiant, who identifies himself as opposer's laboratory director, states only that he is familiar with the submissions by way of written and verbal correspondence with another of opposer's employees and by way [*7] of examination of the documents at issue. However, this does not establish affiant's. Why, for example, the affidavit of the addressee, an apparent employee of opposer, was not submitted is not explained. n6 *See* TBMP Sections 528.05(a)-(c) (2nd ed. rev'd March 2004).

n6 At trial, the business records of a party are to be introduced by way of a testimonial deposition as exhibits thereto. *See* TBMP Sections 702 and 703 (2nd ed. Rev. 1 March 2004). The Board notes that consideration of Exhibit 15 would not have changed our decision on summary judgment.

Applicant's objection to opposer's Exhibit No. 18 as unauthenticated is moot. The exhibit appears to be a TESS printout from the Office database of the status of applicant's subject application Serial No. 76201447. At this time, such printouts may only be introduced on summary judgment by way of affidavit or declaration or by way of a discovery deposition. *See Id.* at subsections (a), (b), (c), and (e). Nonetheless, the application file is of record for all purposes, including summary judgment, in this opposition. *See* Trademark Rule 2.122(b); and TBMP Section 528.05(a) (2nd ed. Rev. 1 March 2004). Thus, the TESS printout [*8] is simply redundant information.

Applicant did not object to opposer's Exhibit No. 19, a copy of the notice of opposition, which is, of course, of record.

Applicant's objection to the cover pages of opposer's Exhibit Nos. 6-9 as out-of-court statements by an unidentified declarant offered for the truth thereof is overruled. The cover page to each exhibit is no more than an index identifying the submissions made with the exhibit.

Opposer's motion for summary judgment

As general background in the plant naming field, opposer argues that plants are scientifically named according to the International Code of Botanical Nomenclature by providing a Latin genus and species name; that cultivars, or cultivated varieties, are plants that originated and persist due to human manipulation; that the International Code of Nomenclature for Cultivated Plants (hereinafter ICNCP), established in 1953, provides a framework for identifying, naming, registering and using cultivar names; that the ICNCP recognizes the difference between scientific names, which must be available in all countries for use by any person, and trademarks, which are not universally available for any person to use; [*9] that a cultivar status of a term is identified by placing the term between single quotation or downward vertical marks following the Latin genus name; that the Royal Horticultural Society (hereinafter RHS) is the international cultivar registration authority for *Clematis* names; and that the RHS registered the term PIILU as a cultivar for *Clematis* in the year 2000.

With respect to this particular case, opposer argues that Uno and Aili Kivistik, of Estonia, first developed the plant *Clematis* 'PIILU' in 1984, which they flowered in 1987 and named in 1988. n7 According to opposer, PIILU was registered by Aili Kivistik with the Estonian Plant Production Inspectorate Variety Control Department, which is the identified registering party of PIILU with the RHS; and The International Clematis Register and Checklist for 2002, published by RHS, acknowledges the Kivistik family and identifies the first published reference to *Clematis* 'Piilu' in a 1992 catalogue.

n7 Opposer notes that Uno Kivistik died in 1998.

It is opposer's position that the plant industry is composed of four identifiable groups: organizations, businesses, hobbyists, and the media. Opposer contends [*10] that, because Internet offerings and catalogues are commonplace ways in which plants are marketed, purchasers in the United States often purchase plants from distant sellers, and have been exposed to use of the term PIILU used as a cultivar since as early as 1992, the first known published (foreign) reference and, as to references in the United States, at least since 1999. According to opposer, it has been offering the cultivar *Clematis* 'Piilu' since 2000. Opposer argues that applicant's own use of the term PIILU, like that of the Kivistik family, demonstrates that, until recently, they treated *Clematis* 'Piilu' as a cultivar name and not as a trademark. Opposer argues that, in response to its interrogatory request seeking from applicant information concerning "...the genus, species, subspecies, varietal, cultivar, common, and commercial names, if any, for the cultivar of *Clematis* sold and promoted in association with the PIILU mark," applicant stated it "...does not know the answer to this interrogatory request...." Subsequently, opposer argues, applicant, on September 19, 2003, submitted a notification of name change, apparently to opposer's attorney, which, opposer argues [*11] further, contradicts applicant's response to opposer's discovery request.

Opposer argues that, as the cultivar name for a *Clematis* plant, PIILU is the generic name for the plant and cannot be registered. Opposer's motion is accompanied by the following exhibits: International Code of Nomenclature for Cultivated Plants 1995; The International Clematis Register and Checklist 2002; printouts from applicant's website; various e-mail exchanges between the Kivistiks and applicant's president, Rick Sorenson; the affidavit of Clarence H. Falstad, III, laboratory director for opposer, describing, in part, his perception of and experience in the plant industry; website

printouts from various *Clematis* organizations, both foreign and domestic, copies of web catalogues and Internet sites, both foreign and domestic, selling *Clematis* 'Piilu' without trademark designation; hobbyist websites including references to *Clematis* 'Piilu', such site appearing to be exclusively foreign; published articles from periodicals, accessed from websites, both foreign and domestic, referencing *Clematis* 'Piilu' from 2000-2003; *Clematis* Catalog 1999 from J. van Zoest, Holland; opposer's [*12] spring catalogs for the years 2000-2003 referencing *Clematis* 'Piilu'; copies of e-mail exchanges between applicant's president and third parties concerning awards won by the *Clematis* 'Piilu'; a copy of Aili Kivistik's 2003 authorization for Australian agent, identifying 'PIILU' as the variety and leaving blank "also known as," further specified as "breeder's code, trade name etc. for variety"; a copy of applicant's responses to opposer's second set of discovery requests; a copy of a signed 1998 letter and accompanying press release from Mr. Sorenson, applicant's president, to opposer; n8 a copy of Mr. Sorenson's 1999 article in "American Nurseryman," Climbing the Walls, inconsistently referring to *C.* 'Piilu' and Piilu TM; a copy of applicant's notification of change of name of cultivar; a TESS printout of the status and accompanying information of applicant's application; and a copy of the notice of opposition.

n8 Inasmuch as applicant's objection to this submission as unauthenticated was sustained, the submission was not considered.

In response, n9 applicant indicates that it is the exclusive U.S. distributor and the owner of the trademark rights for the [*13] *Clematis* plants originating with the Kivistik family of Estonia. Applicant argues that PIILU is a well established trademark, its first international use being since 1992, and its use in the United States being since 1998. Applicant accuses opposer of using applicant's mark as a generic term, and of submitting no evidence that applicant's "...well-known mark PIILU is ... generic." Applicant argues that it widely licenses its mark in the U.S.; and that its mark is not found as a cultivar name in any U.S. or international database. Applicant argues that the RHS does not list applicant's mark as a cultivar in its database; that any alleged "registration" on an RHS checklist was done by a third party; that there is no requirement that applicant use a trademark notice every time it uses its mark; that use of its mark in single quotes does not result in "automatic genericide"; that opposer has not produced any surveys of consumer perception of the term PIILU; that the foreign uses establish the strength of applicant's mark; and that the foreign uses do not show that PIILU is a cultivar name in the United States.

n9 Applicant's objections to opposer's evidentiary submissions have already been ruled on.

[*14]

Applicant's response is accompanied by the declaration of its attorney in support of twenty Internet printouts including: order forms from opposer's website wherein *Alcea r.* 'Peaches 'n' Dreams' is displayed inconsistently with *Alcea r.* 'Peaches 'n' Dreams' TM; various catalogue or website sales offerings of applicant's *Clematis* plant showing uses of applicant's mark as Piilu, *Clematis* 'Little Duckling' "Piilu" TM (Patens), *Clematis* Kivistik, Piilu, The Kivistik Collection Piilu t.m.; printouts from the Estonian Plant Production Inspectorate; a printout from the RHS plant selector database which found zero entries for the term piilu; a TESS printout and accompanying article concerning a mark (END-LESS SUMMER) for live ornamental plants; a printout from opposer's website; an excerpt from the International *Clematis* Register for the disclaimer that "Information given in the Register can only be as good as that supplied by the registrant"; an excerpt of guidance notes for International Cultivar Registration Authorities; printouts showing the inconsistent uses of *Helleborus* Royal Heritage TM and *Helleborus* 'Royal Heritage', of *Weigela Florida* 'wine & [*15] roses' and Wine & Roses(R) *Weigela*, of *Penstemon* 'Red Rocks' and *Penstemon x mexicali* 'Red Rocks' TM, of Ambridge Rose(R) Cv. Auswonder, Pat Austin TM Cv. Ausmum, Wenlock(R) Cv. Auswen and 'Ambridge Rose' (Auswonder), 'Wenlock' (Auswen) and a TARR printout for the registration of WENLOCK for live rose plants; various printouts showing terms used as trademarks and terms used as cultivars; printouts from various U.S. databases where plant names may be registered or listed; and search results from various databases. In addition, applicant's response is accompanied by a copy of a January 6, 2003 email from the Kivistik family to opposer expressing the Kivistik's position that Piilu has not become generic for their *Clematis* cultivar; that plants of the cultivar were given to members of The International *Clematis* Society during the 1998 visit, but no permission was given to members to propagate and sell in North America; that any sales by non-licensed growers are being done without permission; and that applicant may agree to sub-license opposer to grow the *Clematis* cultivars. The declaration of applicant's president also accompanies applicant's response, and is made [*16] in support of applicant's position as exclusive distributor in the United States of the Kivistik's plants; indicating further that applicant distributes plant licenses, including four in Canada, one in Australia, and eight in the United States; and that applicant began use in the United States of the mark in 1998, importing the first

plants in the spring of 1999. A copy of the parties' executive protective agreement for the exchange of confidential information also accompanies applicant's response.

In reply, opposer maintains its position that 'Piilu' is a generic term as the term was set aside as the taxonomic name for a *Clematis* cultivar to give the worldwide community a uniform way to identify a specific plant. Opposer argues that applicant's "database arguments" are misleading as exemplified by applicant's position that the RHS "does not list PIILU anywhere in its plants keyword search database." Opposer contends that applicant misleadingly searched only RHS's "Plant Selector" database, which does not list the term "piilu," but RHS's "Plant Finder" database does yield a citation to *Clematis* 'Piilu' as a cultivar name. Opposer argues that applicant inflates opposer's foreign [*17] submissions by stating, "...from everywhere in the world except the United States," when opposer has submitted ample evidence of use of the term "piilu" in the United States. Opposer contends that its foreign sources help clarify how the term "piilu" is perceived in the United States, are relevant in light of the doctrine of foreign equivalents, and are relevant in view of the international effort in establishing taxonomic names, including cultivar names, for plants. Opposer also argues that applicant's own inconsistent use of PIILU demonstrates that it is the cultivar name, and that applicant recently has made attempts to remove this generic term from the public domain and make the term its trademark.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. *See Fed. R. Civ. P. 56*. The movant is held to a stringent standard. *See* 10A Wright, Miller & Kane, Federal Practice and Procedure: Civil 3d § 2727 (1998). Summary judgment is not a substitute for the trial of disputed issues of fact. *Id.* at [*18] 2712. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. *See Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ 1542 (Fed. Cir. 1992).

Cultivar names, designations given to cultivated varieties or subspecies of plants or agricultural seeds, are the generic names of the plant or seed variety as known to the public. Market realities and lack of laws concerning the registration of varietal and cultivar names have created a number of problems in this area. Some varietal names are not attractive or easy to remember by the public. As a result, many arbitrary terms are used as varietal names. Problems arise when trademark registration is sought for varietal names, when arbitrary varietal names are thought of as being trademarks by the public, and when terms [*19] intended as trademarks by plant breeders become generic through public use. These problems make this a difficult evidentiary area. *See* TMEP § 1202.12 (3rd ed. Rev. 2, June 24, 2002). *Cf. In re Delta and Pine Land Co.*, 26 USPQ2d 1157 (TTAB 1993), where registration of the word DELTAPINE, identifying the prominent portion of applicant's acknowledged varietal names which combined the term DELTAPINE with another term, was refused ("...this is an unusual case and ... little or no precedent exists...")

After careful consideration of the extensive record submitted by both parties, we find that genuine issues of material fact exist, at a minimum, with respect to the public perception in the United States of the term PIILU.

Accordingly, opposer's motion for summary judgment is denied. Moreover, given the nature of the intense factual considerations which are necessary to ascertain whether PIILU is a trademark or a cultivar name, we find the matter unsuitable for determination on summary judgment. Thus, this case is going to trial (or settlement). No further summary judgment motions are to be filed.

Protective agreement noted

The stipulated protective [*20] agreement accompanying applicant's response to opposer's motion for summary judgment is noted. The parties are referred, as appropriate, to TBMP §§ 412.03 (Signature of Protective Order), 412.04 (Filing Confidential Materials With Board), 412.05 (Handling of Confidential Materials by Board) (2nd ed. Rev. 1, March 2004).

The parties are advised that only confidential or trade secret information should be filed pursuant to a stipulated protective agreement. Such an agreement may not be used as a means of circumventing paragraphs (d) and (e) of 37 CFR § 2.27, which provide, in essence, that the file of a published application or issued registration, and all proceedings relating thereto, should otherwise be available for public inspection.

Proceedings resumed; dates reset

Proceedings are resumed. Discovery closed on November 6, 2003, in accordance with applicant's consented motion to extend dates, filed September 8, 2003. Trial dates are reset as indicated below:

THE PERIOD FOR DISCOVERY TO CLOSE:	CLOSED
30-day testimony period for party in position of plaintiff to close:	August 31, 2004
30-day testimony period for party in position of defendant to close:	October 30, 2004
15-day rebuttal testimony period to close:	December 14, 2004

[*21]

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

Legal Topics:

For related research and practice materials, see the following legal topics:
Trademark LawInfringement ActionsSummary JudgmentBurdens of ProofTrademark LawSubject MatterNamesGeneral
OverviewTrademark LawU.S. Trademark Trial & Appeal Board ProceedingsOppositionsGrounds

EXHIBIT 19



Caution
As of: Mar 19, 2008

**WARRIOR LACROSSE, INC., A Michigan Corporation, Plaintiff, v. STX, L.L.C., a
Maryland Limited Liability Company, Defendants.**

Case Nos. 04-70363 & 04-71842

**UNITED STATES DISTRICT COURT FOR THE EASTERN DISTRICT OF
MICHIGAN, SOUTHERN DIVISION**

2006 U.S. Dist. LEXIS 31822

May 22, 2006, Decided

May 22, 2006, Filed

SUBSEQUENT HISTORY: Patent interpreted by, Summary judgment denied by Warrior Lacrosse, Inc. v. STX, L.L.C., 2006 U.S. Dist. LEXIS 38492 (E.D. Mich., June 12, 2006)

DISPOSITION: [*1] Warrior's motion for partial summary judgment concerning validity of U.S. Patent No. 6,561,932, motion for summary judgment of infringement of U.S. Patent No. 6,561,932 denied.

CASE SUMMARY:

PROCEDURAL POSTURE: Plaintiff patent hold accused defendant lacrosse equipment manufacturer of infringing upon two of its patents. In its responsive pleadings, the manufacturer denied all of the claims of infringement. The patent holder filed a motion for partial summary judgment relating to the validity of one of the patents and also filed a motion for summary judgment on the issue of the alleged infringement of that patent by the manufacturer.

OVERVIEW: The 932 patent application was filed on May 21, 2001 and issued on May 13, 2003, for a lacrosse stick head. The manufacturer asserted that it products, which had been challenged by the patent holder, qualified as prior art. Citing Fed. R. Evid. 902(7), the manufacturer submitted that the inscriptions on certain lacrosse heads were self-authenticating because they established the existence of these products at least one year prior to the 932 patent filing date. Furthermore, it had

produced evidence such as proffered testimony, expert testimony, and physical exhibits to support its position that the 932 patent was a prior art, which, in turn, created a genuine issue of a material fact regarding this issue. Therefore, the court held that the partial summary judgment concerning the validity of the 932 patent had to be denied. When comparing the accused products to three claims in the patent, both parties submitted contradictory evidence in order to support their respective arguments; therefore, a genuine issue of a material fact existed and the motion for summary judgment of infringement of the 932 patent had to be rejected.

OUTCOME: The patent holder's (1) motion for partial summary judgment concerning the validity of U.S. Patent No. 6,561,932 and (2) motion for summary judgment of infringement of U.S. Patent No. 6,561,932 were denied.

CORE TERMS: lacrosse, sidewall, ball, summary judgment, frame, rim, patent, pair, infringe, distance, upper, rear, prior art, infringement, retention, genuine, channel, handle, pocket, scoop, arcuate, recessed, inner, lacrosse sticks, material fact, filing date, measurement, competitor, invention, catching

LexisNexis(R) Headnotes

*Civil Procedure > Summary Judgment > Burdens of
Production & Proof > Movants*

Civil Procedure > Summary Judgment > Standards > Appropriateness

[HN1]The language within Fed. R. Civ. P. 56(c) provides that a motion for summary judgment should be granted only if a party shows that there is no genuine issue as to any material fact and that it is entitled to a judgment as a matter of law. The burden is upon the movant to demonstrate the absence of a genuine issue of a material fact.

Civil Procedure > Summary Judgment > Standards > Appropriateness

[HN2]In assessing a summary judgment motion, the court must examine any pleadings, depositions, answers to interrogatories, admissions, and affidavits in a light that is most favorable to the non-moving party. Fed. R. Civ. P. 56(c). It is not the role of the court to weigh the facts. Rather, it is the duty of the court to determine whether there are any genuine factual issues that properly can be resolved only by a finder of fact because they may reasonably be resolved in favor of either party.

Civil Procedure > Summary Judgment > Burdens of Production & Proof > Absence of Essential Element of Claim

Civil Procedure > Summary Judgment > Burdens of Production & Proof > Movants

Civil Procedure > Summary Judgment > Burdens of Production & Proof > Scintilla Rule

Civil Procedure > Summary Judgment > Standards > Genuine Disputes

[HN3]A dispute is genuine only if the evidence is such that a reasonable jury could return a verdict for the non-moving party. Hence, the moving party can show that a genuine factual issue is lacking if it presents evidence which is sufficient to make the issue so one-sided that it must prevail as a matter of law or point to a failure by the non-moving party to present evidence sufficient to establish the existence of an element essential to its case, and on which it will bear the burden of proof at trial. Upon such a showing, the non-moving party must act affirmatively to avoid the entry of a summary judgment. Fed. R. Civ. P. 56(e). The proffer of a mere scintilla of supporting evidence is insufficient. Indeed, if the evidence is merely colorable or is not significantly probative, summary judgment may be granted.

Patent Law > Anticipation & Novelty > General Overview

Patent Law > Infringement Actions > Defenses > Patent Invalidity > Validity Presumption

[HN4]Typically, an issued patent is presumed valid. 35 U.S.C.S. § 282. In order to prove that a claimed invention is invalid, a defendant must prove that the claimed invention and the prior art are identical by clear and convincing evidence. In order to establish a device as prior art, a defendant must prove that it pre-dates the patent. 35 U.S.C.S. § 102. Additionally, the controverted specimen must also be in public use or on sale in the United States more than one year prior to the date of the application for patent in the United States. 35 U.S.C.S. § 102(b).

Evidence > Authentication > Self-Authentication

[HN5]See Fed. R. Evid. 902(7).

Patent Law > Infringement Actions > Claim Interpretation > Fact & Law Issues

[HN6]The determination of whether an accused product infringes upon a patent claim is a two-step process. The first step involves a judicial determination of the scope and meaning of the asserted patent claims. The second step entails the comparison of the accused products to the claims, as construed, and a subsequent determination regarding whether the accused product contains each and every limitation of the claims. The United States Court of Appeals for the Federal Circuit has declared this second step to be a factual determination.

COUNSEL: For Warrior LaCrosse, Incorporated, Plaintiff: John A. Artz, John S. Artz, Robert P. Renke, Artz & Artz (Southfield), Southfield, MI.

For STX, L. L. C., Defendant: Lawrence J. Gotts, Pillsbury, Winthrop, (New York), New York, NY; Lawrence R. Jordan, Jaffe, Raitt, (Ann Arbor), Ann Arbor, MI; Scott R. Torpey, George A. Sumnik, Jaffe, Raitt, (Southfield), Southfield, MI.

For Brine, Incorporated, Intervenor: George D. Moustakas, Harness, Dickey, (Troy), Troy, MI.

For STX, L. L. C., Counter Claimant: Lawrence R. Jordan, Jaffe, Raitt, (Ann Arbor), Ann Arbor, MI; Scott R. Torpey, George A. Sumnik, Jaffe, Raitt, (Southfield), Southfield, MI.

For STX, L. L. C., Counter Claimant: George A. Sumnik, Jaffe, Raitt, (Southfield), Southfield, MI.

JUDGES: Honorable Julian Abele Cook, Jr.

OPINION BY: Julian Abele Cook, Jr.

OPINION

ORDER

The issues in this case relate to claims by the Plaintiff, Warrior Lacrosse, Inc. ("Warrior"), who has accused the Defendant, STX L.L.C ("STX") of infringing upon two of its [*2] patents; namely, U.S. Patent No. 6,561,932 ("932 Patent") and U.S. Patent RE 38, 216 ("216 Patent"). In its responsive pleadings, STX has denied all of Warrior's claims of infringement. On October 12, 2005, Warrior filed two dispositive motions, both of which are directed to the alleged encroachment activities by STX. In its first motion, Warrior seeks the entry of a partial summary judgment relating to the validity of the "932 Patent." In its second dispositive motion, Warrior seeks to obtain a summary judgment on the issue of the alleged infringement of the 932 Patent by STX.

For the reasons that have been set forth below, both of Warrior's motions will be denied.

I.

Warrior is a Michigan corporation which maintains its principal offices in Warren, Michigan. The primary business of this Company consists of the manufacturing and the sale of lacrosse equipment, including lacrosse heads, handles, protective equipment, and related accessories. STX maintains its principal place of operations in Baltimore, Maryland, from which it - like its business competitor, Warrior, - sells lacrosse heads, handles, protective equipment, and other related accessories.

According to the Complaint, [*3] STX has been, and is, manufacturing and selling its products that unlawfully use trade designations which incorporate various features of Warrior's lacrosse heads. Warrior has identified twenty-three STX lacrosse heads that, in its judgment, encroach upon its protected rights under the "932 Patent." All of the allegations have been denied by STX.

1 Although Warrior claims that some of STX's products infringe upon more than twenty claims of the 932 Patent, it has only focused upon independent Claims 7, 31, and 42 in its motion. Hence, the Court will direct its attention to these three independent claims.

II.

The Supreme Court has opined that "[o]ne of the principle purposes of the summary judgment rule is to isolate and dispose of factually unsupportable claims or defenses" Celotex Corp. v. Catrett, 477 U.S. 317, 323-24, 106 S. Ct. 2548, 91 L. Ed. 2d 265 (1986). [HN1]The language within Federal Rule of Civil Procedure 56(c) provides that a motion for summary judgment

[*4] should be granted only if a party "show[s] that there is no genuine issue as to any material fact and that [it] is entitled to a judgment as a matter of law." Here, the burden is upon the movant to demonstrate the absence of a genuine issue of a material fact. See Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248, 106 S. Ct. 2505, 91 L. Ed. 2d 202 (1986).

[HN2]In assessing a summary judgment motion, the Court must examine any pleadings, depositions, answers to interrogatories, admissions, and affidavits in a light that is most favorable to the non-moving party. Fed. R. Civ. P. 56(c); see United States v. Diebold, Inc., 369 U.S. 654, 655, 82 S. Ct. 993, 8 L. Ed. 2d 176 (1962); Boyd v. Ford Motor Co., 948 F.2d 283, 285 (6th Cir. 1991); Bender v. Southland Corp., 749 F.2d 1205, 1210-11 (6th Cir. 1984). It is not the role of the Court to weigh the facts. 60 Ivy Street Corp. v. Alexander, 822 F.2d 1432, 1435-36 (6th Cir. 1987). Rather, it is the duty of the Court to determine "whether . . . there are any genuine factual issues that properly can be resolved only by a finder of fact because they [*5] may reasonably be resolved in favor of either party." Anderson, 477 U.S. at 250.

[HN3]A dispute is genuine only "if the evidence is such that a reasonable jury could return a verdict for the nonmoving party." Id. at 248. Hence, the moving party can show that a genuine factual issue is lacking if it presents evidence which is sufficient to make the issue "so one-sided that [it] must prevail as a matter of law," id. at 252, or point to a failure by the non-moving party to present evidence "sufficient to establish the existence of an element essential to its case, and on which it will bear the burden of proof at trial." Celotex Corp., 477 U.S. at 322. Upon such a showing, the non-moving party must act affirmatively to avoid the entry of a summary judgment. Fed. R. Civ. P. 56(e). The proffer of a mere scintilla of supporting evidence is insufficient. See Anderson, 477 U.S. at 252, quoted in Street v. J.C. Bradford & Co., 886 F.2d 1472, 1477 (6th Cir. 1989). Indeed, "[i]f the evidence is merely colorable or is not significantly probative, summary [*6] judgment may be granted." Anderson, 477 U.S. at 249-50 (citations omitted).

III.

A. The "932 Patent"

On May 13, 2003, the "932 Patent" was issued to Warrior for an invention entitled "Lacrosse Stick Head." In general, this Patent, which grants Warrior the exclusive right to make and use lacrosse heads, consists of fifty seven claims and generally pertains to a lacrosse head for mounting on a handle, whereas the head includes a catching area that is larger than the pocket area. It also relates to recessed channels that are formed along

the inner portions of the sidewalls to assist in the retention of a lacrosse ball.

The "932 Patent" specification describes the lacrosse heads as having "an open frame with a base that has a concave interior surface, a pair of sidewalls that diverge from the base, and a scoop that interconnects the sidewalls of the base." STX's Mem. in Opp'n to Warrior's Mot. for Summ. J. of Infringement of U.S. Patent No. 6,561,932 at 4. Additionally, "openings carried by the frame are used to secure a lacrosse net around the back side of the frame, leaving the front side open. A throat projects back from the base of the frame, and has an [*7] open socket for receiving a handle." *Id.*

B. STX's Accused Products

Warrior points to eight STX lacrosse heads (Bionic, Deuce, Fuse, GForce, Hype, Liquid, Profile, and Surge) that, in its judgment, infringe upon the "932 Patent." However, STX adopts an opposing view point by asserting that all of these products, which have been challenged by Warrior, qualify as prior art and, thus, are not subject to legally enforceable accusations of infringement.

In the advertisements relating to its "Fuse" lacrosse head, STX notes that this product possesses a "tapered and specifically angled inner elastomer-lined sidewalls guide and direct the ball into the passing, carrying, and shooting sweet spot." This "Fuse" lacrosse head also includes a "pinched opening for vice-like ball retention and control." However, Warrior maintains that this description indicates that the angled sidewalls maintain the catching area of the head while the narrow channel pocket improves ball retention and control.

STX, in its promotional material relating to the "Hype" lacrosse head, describes it as including "bounce back surface angles [to] help retain the ball." Warrior challenges this description, [*8] contending that all of the lacrosse heads include the patented features of a catching area that is larger than the pocket area (Claims 7 and 31) and/or a recessed channel formed in a lower portion of the sidewalls to assist in retaining a lacrosse ball within the pocket (Claim 42).

Warrior also asserts that the Bionic, Deuce, GForce, Liquid, Profile, and Surge lacrosse heads feature a similar ball retention channel in the lower portion of the sidewall and/or a larger catching area as compared to the pocket area. STX rejects this argument, pointing out that its expert, Paul Kolada used an optical scanning process to produce digital data which accurately calibrates the geometry of the lacrosse head. This optical scanning process produced data that, when calibrated, has the capacity to record a measurement of up to approximately 0.0007- 0.0001 inches. The data was subsequently col-

lected and used to generate different views and sections of the heads, and to make accurate measurements of the lacrosse head dimensions. Moreover, STX submits that Kolada, after reviewing the structural design limitations within Claims 7, 31, and 42, concluded that none of Warrior's claims had been infringed.

[*9] IV.

[HN4]Typically, an issued patent is presumed valid. 35 U.S.C. § 282 (2006). In order to prove that a claimed invention is invalid, a defendant must prove that the claimed invention and the prior art are identical by clear and convincing evidence. Lisle Corp. v. A.J. Mfg. Co., 398 F.3d 1306, 1316 (Fed. Cir. 2005); Scripps Clinic & Research Foundation v. Genentech, 927 F.2d 1565, 1576 (Fed. Cir. 1991). In order to establish a device as prior art, a defendant must prove that it pre-dates the patent. See 35 U.S.C. § 102 (2006). Additionally, the controverted specimen must also be "in public use or on sale in this country . . . more than one year prior to the date of the application for patent in the United States . . ." 35 U.S.C. 102(b) (2006).

Thus, the issue that must be addressed in connection with these two motions is whether the "932 Patent" is prior art. According to STX, it is prior art. However, Warrior disagrees, contending that STX has failed to provide any evidence which supports its position on this narrow, but important, issue.

Warrior contends that STX has (1) failed [*10] to establish a date of manufacture, sale, or use for any of the challenged lacrosse heads, (2) been unsuccessful in demonstrating the authenticity of these lacrosse heads, and (3) not shown that the lacrosse heads were in public use or were on sale at least one year prior to the date of the filing of the "932 Patent."

The critical date regarding the "932 Patent" for the purpose of assessing the merit of these motions is May 21, 2000.² Since its inception, STX maintains that it has conducted its business operations from three different locations within the Baltimore area, with its archived lacrosse heads being stored and locked in a specific area. According to STX, these archived lacrosse heads constitute a collection of its own commercial lacrosse heads and those of its competitors,³ none of which have modified in any way.⁴ STX also submits that the manufacture of most, if not all of these lacrosse sticks, pre-date the May 21, 2001 filing date of the "932 Patent" application⁵.

² The "932 Patent" application was filed on May 21, 2001.

³ David Emala, vice president, secretary, and general counsel of STX maintains that, since he

joined the Company in 1993, he has been responsible for the collection and storage of its competitors' lacrosse heads. Additionally, he submits that some of these lacrosse heads were the subject of prior litigation involving STX in 1991-92, which ostensibly substantiates their existence prior to the filing date. Finally, Emala asserts that STX acquired their competitors' lacrosse heads through routine commercial purchases.

[*11]

4 Paul Kolada ("Kolada"), an expert on the manufacturing of products made by molding plastic, submits that he has inspected the archived lacrosse heads and has failed to detect any modifications and changes to their physical structure.

Warrior does not agree that the twenty-three items in question are indeed "lacrosse heads" because, in its opinion, some are toys, while others have been altered. However, for the purpose of this motion only, it concedes that these specimens are "lacrosse heads."

5 STX maintains that Warrior's own lacrosse heads also constitute prior art because its patents seek to claim structures that it placed in the stream of commerce during the time period prior to the filing date of the patents.

Citing Rule 902(7) of the Federal Rules of Evidence,

⁶ STX submits that the inscriptions on certain lacrosse heads are self-authenticating because they establish the existence of these products at least one year prior to the "932 Patent" filing date. Furthermore, and when utilizing the standard of review that must necessarily accompany an [*12] evaluation of a dispositive motion, STX has produced evidence such as proffered testimony, expert testimony, and physical exhibits to support its position that the "932 Patent" was a prior art, which, in turn, creates a genuine issue of a material fact regarding this issue. Therefore, Warrior's motion for partial summary judgment concerning the validity of U.S. Patent No. 6,561,932 must be denied.

6 Fed. R. Evid. 902(7) reads as follows: [HN5]"extrinsic evidence of authenticity . . . is not required with respect to . . . inscriptions, signs, tags, or labels purporting to have been affixed in the course of business and indicating ownership, control, or origin."

IV.

[HN6]The determination of whether an accused product infringes upon a patent claim is a two-step process. North American Container, Inc. v. Plastipak Packaging, Inc., 415 F.3d 1335, 1344 (Fed. Cir. 2005). The first step involves a judicial determination of the scope

and meaning of the asserted patent claims. *Id.* The second step entails the [*13] comparison of the accused products to the claims, as construed, and a subsequent determination regarding whether the accused product contains each and every limitation of the claims. *Id.* The Federal Circuit Court of Appeals has declared this second step to be a factual determination. Research Plastics, Inc. v. Federal Packaging Corp., 421 F.3d 1290, 1295 (Fed. Cir. 2005). Significantly, all claims are presumed to be valid. 35 U.S.C. § 282 (2006). With recognition of Warrior's position that the STX lacrosse heads infringe upon Claims, 7, 31, and 42, the Court will now examine them seriatim.

A. Claim 7

According to Warrior, the improved pocket feature of the invention is embodied in all of the claims. Claim 7 of the "932 Patent" describes a particular relationship between the two sidewalls of the frame.⁷ Warrior argues that the Bionic, Deuce, Fuse, Liquid, and Profile lacrosse heads infringe upon Claim 7 of the "932 Patent." Warrior contends that all of these lacrosse heads readily satisfy elements (a), (b), and (c) of Claim 7. Additionally, Warrior asserts that the distance between the upper rims in each of the lacrosse heads is [*14] greater than the distance between the lower rims, thereby satisfying element (d) of this Claim. Finally, Warrior contends that element (e) has also been satisfied because the lower rims of the sidewalls in the Bionic, Deuce, Fuse, Liquid, and Profile lacrosse heads are generally parallel to each other in the rear portion (near the throat) of the head.

7 Claim 7 states that:

A lacrosse head for attachment to a lacrosse handle, comprising:

(a) an open frame having a rearward arcuate wall, a pair of sidewalls that extend generally forwardly from said rearward arcuate wall, and a scoop that connects said pair of sidewalls opposite said rearward arcuate wall;

(b) a throat projecting rearwardly from said open frame and having a socket for receipt of the lacrosse handle therein;

(c) a plurality of net attachment structures associated with said open frame allowing a net to be secured to said open frame;

(d) each of said pair of sidewalls having a lower rim and an upper rim, and wherein at least one location along said open frame a first distance defined by the distance between said upper rims of said sidewalls is greater than a second distance defined by the distance between said lower rims of said sidewalls;

(e) wherein said sidewalls define a rear portion and a forward portion and wherein said lower rims of said sidewalls are generally parallel to one another in said rear portion.

[*15] Warrior points to the measurements that were conducted by Kolada, who determined that STX's Bionic+, Deuce, Fuse, GForce, GForce (overmold), Hype, Profile++, and Surge lacrosse heads do not "flare" outward at any point along the sidewalls. ⁸ However, STX takes issue with this argument, contending that these lacrosse heads have a geometry of a "reverse flare" which suggests that the distance between the lower rims is actually greater than the corresponding distance between the upper rims. Moreover, STX points out that Kolada's responses to Warrior were given within the context of a fact witness before he had an opportunity to analyze the drawings of the actual heads in this case.

8 STX concedes that the original Bionic did have some "flare." However, the head was redesigned and reintroduced as the Bionic+, which, according to STX, no longer contains the "flare."

STX counters by stating that Warrior's placement of parallel lines in its exhibits is self-serving and misplaced. Rather, STX maintains that the sidewalls [*16] curve away from the centerline of the head, and are, therefore, not generally parallel.

B. Claim 31

This Claim differs only slightly from Claim 7. Claim 31 relates to the physical relationships between the upper and lower portions of the sidewalls. ⁹ Warrior contends that the Bionic, Fuse, Liquid, Profile, and Surge lacrosse heads infringe upon Claim 31 of the "932 Patent." Additionally, Warrior asserts that the same evidence, which pertained to the encroachment of the Bionic, Fuse, Liquid, Profile, and Surge lacrosse heads in Claim 7, also supports its charge of an infringement of Claim 31 by STX. Furthermore, Warrior contends the lacrosse heads include sidewalls "generally diverge," which, in turn, satisfy element (d). In addition, Warrior asserts that element (e) is supported by the evidence which demonstrates that the lower portions of the sidewalls, along some point in the rear portion of the head, are closer together than the upper portions of the sidewalls.

9 Claim 31 states as follows:

A lacrosse stick head for attachment to a lacrosse stick, comprising:

(a) a frame element defining an open area for receiving a lacrosse ball including:

(b) a rear arcuate wall;

(c) a scoop located opposite said rear arcuate wall; and

(d) a pair of opposing sidewalls that generally diverge from said arcuate wall to said scoop, said pair of opposing sidewalls each having an inner surface with an upper section and a lower section, said pair of sidewalls each being broadly divisible into a rear portion and a forward portion;

(e) wherein at least a portion of each of said lower sections in said rear portion are disposed further inwardly than a corresponding portion of said upper sections.

[*17] C. Claims 42

The language in Claim 42 ¹⁰ of the "932 Patent" pertains to a "recessed channel" in the lower portion of the sidewall for aiding the retention of the lacrosse ball in the head. Warrior argues that the Bionic, Fuse, Liquid, Gforce and Hype lacrosse heads literally infringe upon Claim 42 of the "932 Patent," which, in turn, supports its view that elements (a), (b), and (c) have been met. Warrior also submits that these lacrosse heads satisfy the requirements of element (d), noting that a recess formed along a lower edge of the inner side of the sidewall to assist in retaining a lacrosse ball in the head. However, STX asserts that its expert, Gary Gait, analyzed the Bionic lacrosse head and concluded that it did not provide the ball retention benefits as required by the claim construction of the Court. It is his opinion that the slight set back portion of the head is not of sufficient length and depth to assist in the retention of the lacrosse ball in the head.

10 Claim 42 states:

The lacrosse head comprising:

(a) a base;

(b) a scoop;

(c) a throat area extending rearwardly from said base for accommodating a lacrosse handle therein; and

(d) a pair of spaced apart sidewalls extending between said scoop and base defining a ball receiving area, at least one of said pair of sidewalls having a recessed channel formed in a lower portion of an inner side thereof to assist in retaining a lacrosse ball therein.

[*18] On the other hand, Kolada, following his examination of the Fuse, Gforce, GForce (overmold), Hype, and Liquid lacrosse heads, concluded that there was no recessed channel in the sidewall. Accordingly,

STX contends that the Fuse, GForce, GForce (over-mold), Hype, and the Liquid do not infringe upon claim 42 of the "932 Patent."

When comparing the accused products to Claims 7, 31, and 42, both parties have submitted contradictory evidence in order to support their respective arguments. Additionally, Warrior has neither provided literal measurements from the actual lacrosse heads nor explained how the locations shown in its Claim charts were selected. Specifically, Warrior has not provided any dimensions in order to establish that the lower rims are indeed "generally parallel to one another." Therefore, a genuine issue of a material fact exists in this cause. As a consequence, Warrior's motion for summary judgment of infringement of the "932 Patent" must be rejected.

V.

For the reasons that are stated above, Warrior's (1) motion for partial summary judgment concerning the validity of U.S. Patent No. 6,561,932 and (2) motion for summary judgment of infringement of U.S. Patent No. 6,561,932 [*19] must be, and are, denied.

IT IS SO ORDERED.

Dated: May 22, 2006

Detroit, Michigan

s/ Julian Abele Cook, Jr.

United States District Court Judge