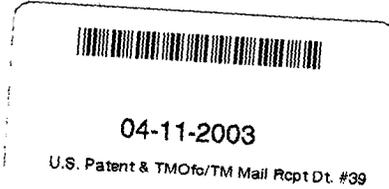


TTAB

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

**In The Matter of Application Serial Nos. 76/103,447 and 76/103,448
Published In The Official Gazette of May 22, 2001
and April 24, 2001, Respectively**

Mark: HYPERSONIC



-----X

Central Mfg. Co., :

Opposer, : Opposition No. 123,765

- against- :

Paramount Parks Inc., :

Applicant. :

-----X

TRADEMARK TRIAL AND APPEAL BOARD
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**BOX TTAB
NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513**

**Applicant's Memorandum in Opposition to
Opposer's Motion for Summary Judgment and in
Support of Applicant's Cross-Motion**

Applicant Paramount Parks Inc. ("Paramount") submits this memorandum of law in opposition to Opposer Central Mfg. Co.'s ("Central") motion for summary judgment, and in support of Applicant's cross-motion to dismiss for lack of standing and to be awarded sanctions against Opposer based on its willful disregard of discovery obligations.

Central's motion is premature, and factually and legally inaccurate. Not only are its

allegations unsupported by what little relevant evidence is in the record, but Opposer has not come close to meeting its burden of proof with respect to any of its allegations, and even a cursory review of those allegations reveals numerous disputed issues of fact. In particular, Opposer has not established: (1) its standing to pursue this opposition; (2) its own use of the mark HYPERSONIC¹; (3) a likelihood of confusion between the marks; or (4) that any of its technical challenges to Paramount's application have any basis in fact or law. Contrary to being entitled to summary judgment, Opposer's complete disregard for its discovery obligations is sanctionable conduct, and the Board should sanction Opposer by the entry of judgment in Applicant's favor.

PROCEDURAL BACKGROUND

Paramount has filed a number of Intent-to-Use trademark applications in connection with a thrill ride known as "Hypersonic XLC: Xtreme Launch Coaster", or "Hypersonic" for short. Hallie Aff't, ¶ 3; Nail Aff't, ¶¶ 9-10. The ride is a revolutionary type of roller coaster located at Paramount's Kings Dominion amusement park in Virginia, and has received a tremendous amount of unsolicited press attention. Nail Aff't, ¶ 9. Paramount's applications are for the trademarks HYPERSONIC alone, and for HYPERSONIC XLC XTREME LAUNCH COASTER (the "Applications"), in various international classes, including classes related to souvenir goods to be sold at its amusement park in connection with this ride. Hallie Aff't, ¶¶ 4-5; Nail Aff't, ¶ 10. (Paramount has also registered design marks incorporating the above marks. (Hallie Aff't, ¶ 4)).

¹ Although generally, the validity of an opposer's application is not relevant on an opposition unless the applicant has filed a counterclaim challenging that registration (see Cosmetically Yours, Inc. v. Clairol, Inc., 424 F.2d 1385 (C.C.P.A. 1970)), as Paramount has lodged just such a counterclaim, the issue of whether Opposer is in fact using the registered mark on certain goods is indeed relevant. General Shoe Corp. v. Lerner Bros. Mfg. Co., 254 F.2d 154 (C.C.P.A. 1958).

The two Applications that are the subject of this opposition are: (1) Application Serial No. 76/103,447 in International Class 25, for "t-shirts, sweatshirts, hats, jackets, pajamas, masquerade costumes, tank tops, footwear, sweatpants, shorts"; and (2) Application Serial No. 76/103,448 in International Class 16, for paper goods and printed matter, namely calendars, fiction magazines, comic books, greeting cards, posters, a series of fiction books, trading cards, stickers, notepads, notebooks, postcards, gift wrapping paper, bumper stickers, rubber stamps".

Although Opposer has produced virtually no discovery, this proceeding already has a tortured history. Because that history demonstrates both that Opposer's summary judgment motion is premature and devoid of merit and that Opposer should be sanctioned, the facts are set forth at length in the accompanying Koonce Affidavit, and summarized below.

This Opposition was filed on or about September 7, 2001 by Opposer "Central Mfg. Co." ("Central"), and Paramount filed its answer on or about October 15, 2001. Koonce Aff't, ¶¶ 4-5, Exs. 1, 3. Opposer served discovery requests on Paramount, and shortly thereafter Paramount served its own discovery requests. Id., ¶ 5, Exs. 4, 5. Paramount produced written responses to Opposer's requests, along with responsive documents, on November 5, 2001, advising that it would produce additional confidential documents if Central agreed to an appropriate stipulated protective order, a draft of which was enclosed to facilitate agreement. Id., ¶ 5.

It was at this point, after Paramount complied with its discovery obligations, that Opposer began a concerted campaign to obstruct Applicant's every effort to conduct discovery. Opposer's discovery responses were originally due on December 3, 2001. When no responses had been received by December 8, Applicant wrote reminding Opposer of its obligations and requesting its response to the draft protective order. Id., ¶ 6, Ex. 6. In lieu of either complying with its

discovery obligations or responding to that letter, Opposer took the position, contrary to the applicable procedural rules, that one or all of the three then pending motions filed by Opposer stayed discovery, and therefore refused to respond to discovery requests for eight months. Id., ¶ 7. By order of July 24, 2002, the Board denied all of Opposer's motions, rejected Opposer's argument that discovery was stayed, and ordered Opposer to respond to Paramount's discovery requests within thirty days. Id., ¶ 8, Ex. 7.

Opposer did not timely comply with that order. On September 3, 2002,² Applicant finally received written responses to its discovery requests, but no documents were produced. Id., ¶ 9, Ex. 8. Instead, Opposer filed yet another motion, this one to dismiss Applicant's counterclaim for abandonment. Id., ¶ 10. Deeming Opposer's September 2002 submissions "responses" to Paramount's discovery requests is more than just charitable: its interrogatory "response" was a one-page document consisting of the lone statement that Applicant's 28 interrogatories exceeded the permitted limit. Id., ¶ 10, Ex. 9. In Opposer's response to the document requests, Central admitted that it has absolutely no documents relating to the date of first use of each product sold or distributed under Opposer's mark; no documents demonstrating actual confusion between Opposer's and Applicant's marks; no documents sufficient to identify the potential or targeted class of customers sold under Opposer's mark; and no documents sufficient to identify the annual dollar volume of goods sold by its predecessor-in-interest, prior to assignment of Opposer's Mark. Id., ¶ 11, Ex. 8.

² Consistent with Opposer's deceptive and dilatory practices, the certificate of service on that motion showed a date of August 21. This is not a lone typographical error or case of mishandled mail. Throughout the prosecution of this Opposition, Applicant's papers have been received many days or weeks after the date of service shown on the documents. In response to one complaint in regard to these apparently deliberate delaying tactics, Mr. Stoller responded by facsimile that "The mail outside of Chicago is slow." Koonce Aff't, ¶ 16, Ex. 19.

In an effort to get discovery on track notwithstanding Opposer's obfuscations, counsel for Applicant had numerous conversations with Opposer's president, Leo Stoller ("Stoller") over the next two months, as detailed in the Koonce Affidavit (¶¶ 12-17). These efforts were wholly unavailing, as Stoller repeatedly made promises as to when documents would be produced and subsequently broke them. In addition, the "revised" written discovery responses Opposer finally produced were nearly as non-responsive as the original. In the midst of Opposer's efforts to derail discovery, it filed the instant, over-length motion for summary judgment. Because this motion -- and the earlier motion to dismiss Applicant's counterclaim -- have suspended all discovery, no further discovery has been taken in this proceeding and to date, Opposer has not produced any documents or any meaningful discovery at all. Nor has it responded to the draft protective order.

Opposer has manipulated the process at every turn in a transparent effort to avoid its discovery obligations. The instant motion for summary judgment motion is but the latest such maneuver. It is made upon an obviously incomplete factual record -- e.g. without any evidence whatsoever of Opposer's use of its mark. It should be denied for this reason alone.

ARGUMENT

Opposer's motion papers are not the model of clarity. Its "Verified Motion for Summary Judgment" contains nine separate argumentative sections, purporting to address supposed deficiencies in Applicant's Applications. Despite an abundance of arguments, almost none of them refers to record evidence and none warrants rejection of the Applications.³ The separate Stoller

³ In particular, many of Opposer's arguments are grounded in the Trademark Rules, rather than the Trademark Act. As noted recently by the Board in the context of a challenge purportedly pursuant to Rule 2.38(b), "[a]ny opposition to the registration of a mark brought under Section 13 of the Trademark Act (15 U.S.C. §§ 1063) must be rooted in the Act, that is to say, upon one of the statutory provisions thereof. The Board notes, however, that the Trademark Rules are not

declaration is equally devoid of factual underpinnings. Opposer's memorandum addressing likelihood of confusion does nothing to cure those factual deficiencies, and woefully fails to carry Opposer's burden of proof. We try to discern and address these various arguments below.

1. **Central Mfg Co. is Not the "Opposer"**

As an initial matter, it is not entirely clear who is opposing Paramount's Applications and therefore whether Opposer has standing. Although previous papers filed in this proceeding have listed Central Mfg. Co. as Opposer, and Central Mfg. Co. is listed as owner of Registration No. 1,593,157 with the Patent and Trademark Office, in his declaration supporting this motion Stoller states that "[t]he undersigned, Leo Stoller, declares that he is the Opposer and President of Central Mfg. Co.", and that "he is the owner of all of the said HYPERSONIC registrations that are relied upon in the Notice of Opposition." He also declares that he is "the creator of the mark HYPERSONIC and the Opposer herein". Stoller is not a party to this Opposition.

It is clear that the above statements are not mere mistakes: Stoller also declares that "although the Registrant of Record is Central Mfg. Co., the Opposer's corporation, the PTO Rules do not require that the Owner of Record must record a notice with the Board." Stoller signed the declaration in his own name, individually, and also on behalf of Central. Although S Industries, Inc., the original registrant, assigned Registration No. 1,593,157 to Central, it is not clear whether or when Central transferred the mark to Stoller. Koonce Afft, ¶ 3, Ex. 2.

If there was an assignment from Central to Stoller, and if it occurred prior to the filing

part of the statute. Rather, they facilitate examination of applications for registration..... Even if there was an examination error in not requiring applicant to comply with 2.38(b), examination error is not a ground for opposition." The Sports Authority Michigan, Inc. v. Kalle, 2002 TTAB Lexis 252 (Mar. 29, 2002).

of the opposition, then the wrong party is currently prosecuting the opposition. Only a party who can show that it will be damaged by the registration in question has standing to bring an opposition, see Lanham Act § 13, 15 U.S.C.A. § 1063. If Central did not own Registration No. 1,593,157 on the date the opposition was filed, it is difficult to imagine how it could claim to have been damaged by Paramount's marks, and thus have had standing to file this opposition in the first instance. Correlatively, if Stoller is the owner, he is time-barred from pursuing an opposition since he failed to file a notice of opposition during the statutory time period.

Even if there has been an assignment of Registration No. 1,593,157 during the pendency of this opposition, Stoller cannot simply deem himself the Opposer at this late stage of the proceedings. If Mr. Stoller is indeed now the owner of the registration, he must move to join or substitute the proceedings, pursuant to 37 C.F.R. §§ 3.71 and 3.73(b). See also TBMP § 512.01.

In any event, at a minimum, whether Central has standing to pursue this opposition creates sufficient factual issues to defeat Opposer's motion on this point alone. However, there are numerous other grounds for denying the instant motion.

2. There is No Likelihood of Confusion

In analyzing the likelihood of confusion between an applicant's and opposer's marks, the Board is charged with considering the pertinent evidentiary factors of the thirteen listed in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).⁴ See Dent Doctor,

⁴ The thirteen factors relevant to the issue of likelihood of confusion are: (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use. (3) The similarity or dissimilarity of established, likely-to-continue trade channels. (4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing. (5) The fame of the prior mark (sales, advertising, length of use). (6) The number and nature of similar

Inc. v. Michael D. Bates, 2003 TTAB Lexis 84 (Feb. 26, 2003). Pursuant to Rule 56(c) of the Federal Rules of Civil Procedure, it is the moving party's burden to establish the absence of any genuine issues of material fact, and that it is entitled to judgment as a matter of law. Id. Moreover, all doubts as to whether or not particular factual issues are genuinely in dispute must be resolved against the moving party, and the evidence of record and any inferences which may be drawn from the underlying facts must be viewed in the light most favorable to the nonmoving party. See Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Opposer has not met that burden. Rather, it confines its argument to wholly unsupported statements that Opposer uses and licenses its mark on a "broad range of goods" which has "created substantial consumer identification" of its mark, and that it has used its mark "for a long time on goods that are similar to the Applicant in interstate commerce". Opp. Mem., at 7. Opposer presents absolutely no support for any of these claims. Instead, it bases its motion solely on the listing of goods in its registration: sports racquets and sports balls of different varieties, crossbows, tennis racquet string and shuttlecocks, with no evidence of use on these goods (or any goods at all). Opp. Mem., at 2. In fact, it is Applicant's contention that Opposer does not use its mark on the goods specified in its registration at all. Applicant has reviewed public sources of information and

marks in use on similar goods. (7) The nature and extent of any actual confusion. (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion. (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark). (10) The market interface between applicant and the owner of a prior mark: (a) a mere "consent" to register or use. (b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party. (c) assignment of mark, application, registration and good will of the related business. (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion. (11) The extent to which applicant has a right to exclude others from use of its mark on its goods. (12) The extent of potential confusion, i.e., whether de minimis or substantial. (13) Any other established fact probative of the effect of use. In re E. I. du Pont de Nemours & Co., 476 F.2d at 1361.

can find no evidence of such use. Koonce Aff't, ¶ 19. It has, however, been deprived of the opportunity to conduct any discovery on this point. For this reason alone, the motion fails as premature or should be continued pursuant to F.R.Civ.P. Rule 56(f).

Moreover, Opposer does not meet its burden of proving a likelihood of confusion, and does not even try to explain how the sporting goods on which it allegedly uses its mark could possibly be sold through similar channels of trade or be confused with the goods on which Applicant uses its marks: namely, paper goods and printed matter of various types, and several types of clothing. It has presented no evidence of the channels of trade through which the goods on which it allegedly uses its mark are sold and therefore no evidence of similarity to the channels of trade through which Applicant's goods are sold. It has presented no evidence of actual confusion. In short, Opposer has presented no evidence other than the fact that the marks consist of the same word.

Finally, even assuming arguendo that Opposer actually uses its mark on goods in interstate commerce, Paramount denies that the goods on which the parties' have used their marks are similar, that the channels of trade are similar, that the circumstances of their purchase are similar, and that Opposer's mark is known to the public at all. Paramount has submitted herewith an affidavit demonstrating issues of fact for discovery on the relevant likelihood of confusion factors, but to summarize: the goods on which Paramount uses its marks are inexpensive souvenirs consisting of apparel such as hats and t-shirts, and paper products such as bumper stickers and photographs. These products are sold only in its amusement park as a tie-in to its Hypersonic ride. Nail Aff't, ¶¶ 11. That it is unaware of any instances of actual confusion between the parties' marks or goods during the two years since Applicant's goods have been on the market is further evidence of no likely confusion. Nail Aff't, ¶ 14. Although as noted previously, Applicant has virtually no

information about Opposer's use of its marks, based on Opposer's registration it is impossible to imagine how the sale of sports equipment in the outlets where such goods are typically sold could possibly be any more dissimilar to Paramount's use. Applicant further notes that there are several other third party word marks for HYPERSONIC that have been registered since Opposer registered its mark, in International Classes no less similar to the one in which Opposer's mark is registered. Koonce Aff't, ¶ 18, Ex. 20.

3. **Paramount is the Correct Applicant**

Opposer also argues that because Paramount is a "related company" to Viacom Inc. ("Viacom"), Paramount is not the proper applicant. This argument was not pleaded in Opposer's Notice of Opposition, and therefore cannot be raised at summary judgment. See TBMP § 528.07(a) (citing, inter alia, FRCP 56(a) and 56(b); Paramount Pictures Corp. v. White, 31 U.S.P.Q.2d 1768 (TTAB 1994)). In addition to this procedural deficiency, this argument is baseless under basic corporate law, as well as the relevant provisions of the Trademark Manual of Examination and Procedure ("TMEP").

Paramount is an independently incorporated entity. Nail Aff't, ¶ 3. While it is a wholly-owned subsidiary of Viacom, it is a fully functioning, separate company in the business of operating a group of theme parks, and has standing to own federal trademarks. Cf. TMEP § 1201.02(d) (unincorporated divisions of corporate parent deemed not to have standing to register marks). Paramount registers trademarks in its own name, and uses them for its own goods and services. Id., ¶ 4. In this instance, Paramount conceived of, registered for, and uses the HYPERSONIC trademarks on goods that it sells. Id., ¶ 5. Paramount therefore controls the use of the marks, and the benefits of that use inure to Paramount, not its ultimate corporate parent. Nail

Aff't, ¶ 10. Under Section 1201.01 of the TMEP, “[t]he owner of a mark is the party who controls the nature and quality of the goods sold or services rendered under the mark.” As such, Paramount is the proper applicant. Indeed, Section 1201.03 of the TMEP provides that control and ownership under such circumstances is to be presumed:

Frequently, related companies comprise parent and wholly-owned subsidiary corporations. Either a parent corporation or a subsidiary corporation may be the proper applicant depending upon the facts concerning ownership of the mark. The filing of an application either by the parent or by the subsidiary should be considered by the examining attorney to be the expression of the intention of the parties as to ownership in accord with the arrangements between them.

TMEP § 1201.03(c). Opposer points to nothing that rebuts that assumption.⁵ Opposer’s only argument to the contrary is an unsupported, conclusive statement that it is Viacom “who controls the nature and quality of the goods or service with which the mark is used, and who is thereby the owner of the mark”. Opp. Mot., at 6-7. This claim is factually and legally inaccurate.

4. **The First Use Date in the Amendments to Allege Use is Correct, but Irrelevant**

Paramount inadvertently filed its Amendments to Allege Use in an untimely fashion, on October 25, 2001, during the pendency of this Opposition. Pursuant to 37 C.F.R. §§ 2.76(a) and 2.88(a), an Amendment to Allege Use filed during the so-called “Blackout Period” – after the mark is published for opposition but prior to the issuance of a Notice of Allowance – is ineffective and will be returned. See TMEP § 1104.03(b). Paramount intends to file new Amendments to Allege

⁵ To the extent Opposer argues that Viacom is the owner of the marks because he has received correspondence from counsel for Viacom, or because counsel for Viacom prepared some portions of the Applications or Amendments to Allege Use, this argument is without merit. While certain aspects of Paramount’s legal work in connection with trademark registration and compliance is handled by Viacom corporate counsel, in those circumstances, Viacom attorneys are acting as counsel for Paramount. Hallie Aff’t, ¶ 8.

Use once a Notice of Allowance issues. Hallie Aff't, ¶6-7. For the purpose of this opposition, however, the previous Amendments to Allege Use are a nullity.

Although a nullity, Opposer argues that those Amendments to Allege Use constitute a misrepresentation to the United States Patent & Trademark Office ("PTO") sufficient to justify denial of Applicant's registration⁶ (Opp. Mot., at 8-9, 12-14, 15-16), because the first use date alleged in them was earlier than the date on which Kings Dominion opened for the season.

Initially, the law is clear that an erroneous first use date is not proper grounds for rejection of a registration, or for an opposition. See McCarthy on Trademarks (2002) § 19.52 ("An alleged error in the claimed date of first use is neither a ground for ex parte rejection nor a ground for an inter partes challenge by opposition or cancellation. There is no statutory basis for refusing a registration on the ground that the claimed date of first use is not supported by the specimens of use....") (citing Burger King Corp. v. Pilgrim's Pride Corp., 705 F. Supp. 1522 (S.D. Fla. 1988)). Moreover, the first use date is not erroneous.⁷ While Kings Dominion did not officially open until March 24, 2001, there were events there prior to that date, during which souvenir goods were available. Further, Kings Dominion advertised and promoted Hypersonic widely, in several states,

⁶ This argument was also not pleaded in the Notice of Opposition, although Opposer did plead misrepresentation with respect to Paramount's bona fide intent to use its marks.

⁷ Opposer states that "Applicant has provided this Board with no corroborating evidence and/or persuasive evidence that Applicant's alleged first use date of March 17, 2001, was anything more than a fabrication...." Opp. Mot., at 8. It is not, of course, Applicant's burden to "present evidence" on Opposer's motion (except to rebut Opposer's allegations). Here, Applicant provided evidence to the PTO along with its Amendment to Allege Use: a declaration and samples of the goods.

on or before March 17, 2001. Nail Aff't, ¶ 13.⁸

5. **Applicant Uses and/or Intends to Use its HYPERSONIC Mark in Interstate Commerce**

Although couched in a number of ways in its motion, Opposer seems to argue that Paramount did not have a valid intent to use its HYPERSONIC marks in interstate commerce, because Paramount's alleged current use is purely an intrastate one. Opp. Mot., at 8, 13, 16. Of course, when this Opposition concludes and Paramount is permitted to file its Amendments to Allege Use, those Amendments will specify the nature of the commerce, as required by Section 904.03 of the TMEP.⁹

But even based on Paramount's current use which is limited to sale of goods under the HYPERSONIC marks at Kings Dominion in Virginia, this use is not solely intrastate pursuant to applicable law. Many of the goods sold under the HYPERSONIC mark are manufactured in other states, affixed with Paramount's trademarks out-of-state, and shipped to Virginia for sale at Kings Dominion. Nail Aff't, ¶ 12. Those products are sold to visitors from many states, including the neighboring states of Maryland, North Carolina, West Virginia and the District of Columbia, and other nearby states such as Pennsylvania, Delaware, New Jersey and New York. Id., ¶ 8. A significant portion of the visitors to Kings Dominion are from those states/district. Id., ¶ 8.

⁸ Opposer also advances the novel argument that Paramount's first use date constitutes an attempt at "pre-marketing"; not only is this ludicrous on its face, it distorts the concept of pre-marketing, which involves nominal uses of a trademark designed to give the impression of actual use in commerce. See, e.g., Allard Enters. v. Advanced Programming Res., Inc., 146 F.3d 350, 358-59 (6th Cir. 1998). Even accepting Opposer's erroneous allegations as true, all Opposer has alleged is a de minimis error of seven days that could be corrected when the amendments are re-filed, if necessary.

⁹ Indeed, although Opposer conveniently fails to mention it, Paramount's ineffective Amendments to Allege Use discussed above, did specify use in interstate commerce.

Paramount also advertises extensively in those territories, with full expectation that consumers will cross state lines, purchase souvenirs at Kings Dominion, and return to their home state/district. Id., ¶¶ 6-7. Further, King's Dominion is situated adjacent to Interstate 95, the primary north-south route from Maine to Florida, and receives a significant portion of its visitors from interstate vacationers. Id., ¶ 5.

The Lanham Act defines "use in commerce", with respect to goods, as those that are "sold or transported in commerce." 15 U.S.C. § 1127. Under the Lanham Act, the scope of federal trademark protection was expanded to include all commerce that may be regulated by Congress. See Larry Harmon Pictures Corp. v. The Williams Restaurant Corp., 929 F.2d 662, 18 USPQ2d 1292 (Fed. Cir. 1991); see also Steele v. Bulova Watch Co., 344 US 280 (1952) (liberally construing the "broadened commerce provisions" of the Act and recognizing their "sweeping reach"). Use of a trademark in commerce does not require that the owner actually ship goods across state lines itself. Abracadabra International, Ltd. v. Abracadabra Creations Inc., 172 U.S.P.Q. 142 (TTAB 1971). Rather, intrastate commerce that has interstate consequences is sufficient. In particular, goods that are manufactured for the trademark owner in other states, and later sold in only one state, have been held to have been used in interstate commerce for registration purposes. See In re Application of Silenus Wines, Inc., 557 F.2d 806(C.C.P.A. 1977) (finding that where applicant ordered French wine to be labeled with applicant's trademark, received shipments of the wine, and sold it in a single state, there was a use in commerce). The United States Court of Customs and Patent Appeals, in a decision that has been followed by the Board, has also held that gas stations, motels and similar

establishments¹⁰ situated along interstate highways are providing services in interstate commerce. In re Gastown, Inc., 326 F.2d 780 (C.C.P.A. 1964) (finding a "direct effect" on interstate commerce); see, e.g., The United States Shoe Corporation v. J. Riggs West, Inc., 221 U.S.P.Q. 1020 (T.T.A.B. 1984). Finally, in cases involving goods sold in one state and carried across state lines by consumers, the Board has held that specific foreknowledge that out-of-state customers would purchase goods and take them back for use in the other state is sufficient. Pneutek, Inc. v. Scherr, 211 U.S.P.Q. 824 (T.T.A.B. 1981) (contrasting facts of In re The Bagel Factory, Inc., 183 U.S.P.Q. 553 (TTAB 1974), in which purchases by out-of-state customers were unforeseen and incidental).

Here, where all of the foregoing circumstances are present, there can be no doubt but that Paramount's goods bearing the HYPERSONIC marks are sold in interstate commerce. In fact, in a case involving a service mark in which the only evidence of interstate use was advertising, the Board still found in favor of the applicant:

Here, the record contains uncontroverted evidence that applicant's billiard parlor services were advertised in both Kansas and New York.... Accordingly, the Board is constrained to find that opposer has failed to carry its burden of proof as to non-use in commerce. It is true that such evidence is highly nonspecific and, perhaps, the claim of interstate advertising would have been demonstrated to be defective or spurious or de minimis had opposer sought particulars of the claimed promotion outside of applicant's home state (which it was free to do by discovery deposition or supplemental interrogatory and, indeed, virtually compelled to do when faced with this assertion in clear contradiction to opposer's position). The burden, after all, was upon opposer as party plaintiff to establish non-use in commerce by a clear preponderance of the evidence. Concluding that it failed to do

¹⁰ Gastown and similar decisions are based on the federal government's ability to regulate "places of public accommodation" under the Civil Rights Act. See In re Dennis James Conti, 220 U.S.P.Q. 745 (T.T.A.B. 1983). Section 201(b) of that act defines such places to include "any motion picture house, theater, concert hall, sports arena, stadium or other place of exhibition or entertainment"; this definition would clearly encompass theme parks.

this, the Board finds for applicant on this ground of opposition.

United States Shoe Corporation, 221 U.S.P.Q. 1020, (T.T.A.B. 1984). See also Bonaventure Associates v. Westin Hotel Company, 218 U.S.P.Q. 537 (TTAB 1983) (finding large expenditure on interstate advertising to draw customers to Florida persuasive). It is clear that Paramount's use satisfies the "in commerce" requirement.

6. **Discrepancy Between Specimens and Word Marks**

Opposer claims that the marks in the drawings in Paramount's applications do not conform with the specimens submitted with Paramount's Amendments to Allege Use. Opp. Mot., at 9-11. As noted above, since those Amendments to Allege Use are ineffective, Opposer's allegations are premature. A Trademark Examiner will have the opportunity to review specimens submitted by Applicant at the appropriate time.

But even if those Amendments to Allege Use somehow could be construed as evidence of the specimens that will ultimately be submitted by Paramount, Opposer's allegations are misguided. As stated in TMEP § 807.09(a), "[a]s a general rule, applicants may register marks in typed form when the word, letter, numeral, or combination thereof creates a distinct commercial impression apart from any stylization in presentation or design element appearing on the specimens." A typed mark covers all design variations, see In re Fisher Tool Co., 224 U.S.P.Q. 796 (T.T.A.B. 1984), and is "not limited to any particular rendition of the mark and, in particular, [is] not limited to the mark as it is used in commerce". See Cunningham v. Laser Golf Corp., 222 F.3d 943 (Fed. Cir. 2000). While specimens of use may be considered in comparing the applicant's use with the opposer's mark, see In re Richardson Ink Co., 171 U.S.P.Q. 818 (T.T.A.B. 1971), they are not determinative of the totality of the ways in which applicant's word mark may be represented.

Opposer seems to suggest that Paramount's Application for the word mark HYPERSONIC is a "mutilation" of Paramount's actual trademark; that is, that Paramount seeks registration of something less than the whole of its mark. Opp. Mot., at 10. In self-serving fashion, Opposer defines Paramount's mark as the entire design on the goods shown in Paramount's misfiled specimens of use. Id., at 11. Yet Opposer makes no effort to explain why "HYPERSONIC" in those designs does not represent a separate and distinct trademark, which can be separately registered. As noted in McCarthy on Trademarks, this Board has recognized that "[e]ven where a word is presented as an integral part of a composite, it may be registrable alone." McCarthy § 19.59 (citing In re Dempster Bros., Inc., 132 U.S.P.Q. 300 (T.T.A.B. 1961)). That a product label contains several different marks does not mean that each mark cannot be registered individually. See In re Serval, Inc., 181 F.2d 192 (C.C.P.A. 1950). The question is whether the mark for which registration is sought creates a "separate commercial impression." In re National Institute for Automotive Service Excellence, 218 U.S.P.Q. 744 (T.T.A.B. 1983).

The "separate commercial impression" question is a factual one, and Opposer cannot foreclose this inquiry on summary judgment by relying solely upon misfiled specimens of use to prove that the HYPERSONIC portion of the mark on those specimens does not create such an impression on the average buyer. See In re Berg Electronics, Inc., 163 U.S.P.Q. 487 (T.T.A.B. 1969). In point of fact, Applicant has used the HYPERSONIC designation in formulations other than those shown in the specimens, including uses of the word HYPERSONIC alone. See Nail Aff't, ¶ 10. Although Applicant believes that the commercial impression of HYPERSONIC, as it appears on the specimens is separate and distinguishable, at the very least there is an issue of fact in this regard precluding summary judgment.

7. **Paramount's Application is for the Correct Type of Mark**

Opposer alleges that Paramount's Application were "not applied for in its [sic] correct type", supporting this allegation with the lone statement that "[i]t is critical that a mark be registered according to its correct type for, if it is not, the registration may be subject to cancellation." Opp. Mot., at 14. Opposer's allegation is indecipherable; it does not explain which aspect of Paramount's Applications supports this contention. The legal support Opposer cites is inapposite, as the reference to "types" of marks in the TMEP and cases noted therein relate to distinctions between collective marks, service marks and marks used on goods. See TMEP § 108; National Trailways Bus System v. Trailway Van Lines, Inc., 222 F. Supp 143, 139 USPQ 54 (E.D.N.Y. 1963), and 269 F. Supp. 352, 155 USPQ 507 (E.D.N.Y. 1965). There is no support in the record for any allegation that the HYPERSONIC marks applied for are actually used on services, or should be collective marks, or the like, and therefore Opposer's contention must fail.

8. **Opposer Has Disregarded its Discovery Obligations**

As set forth above and detailed in the Koonce Affidavit, while Applicant timely fulfilled its discovery obligations almost a year-and-a-half ago, Opposer has yet to produce a single document in this proceeding. First, Opposer refused to produce documents and sought a protective order on the grounds that certain motions it filed suspended discovery, despite clear authority to the contrary. Koonce Aff't, ¶ 7. When the Board denied Opposer's request for a protective order and set a deadline for compliance with Applicant's discovery requests, Opposer missed that deadline, did not produce documents, served wholly inadequate written responses after the deadline, and filed a motion to dismiss in an attempt to stay discovery yet again. Id., ¶¶ 8-11. Upon being pressured by Applicant, Opposer agreed to produce responsive documents by a particular date, along with

written responses to interrogatories. Id., ¶ 12-13. Opposer missed that deadline. It did not produce any documents, and its interrogatory responses consisted primarily of refusals to answer. Id., ¶ 14, Ex. 11. Opposer then made vague promises to allow inspection of documents, but when Applicant demanded specifics, Opposer sought more time and in the interim, filed the instant motion. Id., ¶¶ 15-17.

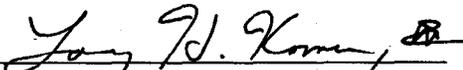
Opposer's manipulation of the opposition process in order to avoid discovery is a waste of the time and effort of Applicant and the Board. Applicant seeks sanctions in the form of an entry of judgment in Applicant's favor.

CONCLUSION

For the foregoing reasons, Opposer's motion for summary judgment should be denied, and judgment should be granted in favor of Applicant.

Dated: **New York, New York**
 April 11, 2003

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