

**Exhibit**

**TTAB**

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

J.B.S. LIQUIDATORS, INC.	)	
	)	
-against-                      Opposers,	)	Opposition No.    124,963
	)	
MICHAEL D. COLEY d/b/a	)	
AMAZING-BARGAINS.COM,	)	
	)	
Applicant.	)	

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MOTION BY OPPOSER FOR SUMMARY JUDGMENT  
AND ALTERNATIVELY TO PRECLUDE

Opposer, J.B.S. LIQUIDATORS, INC. ("Opposer" or "JBS") hereby moves, pursuant to Fed. R. Civ. P. Rule 56, for summary judgment sustaining this opposition to the application for the mark AMAZING-BARGAINS.COM, Serial No. 78-037,201 on the grounds that Applicant has defaulted in responding to discovery and there are no genuine issues as to the material facts and Opposer is entitled to judgment as a matter of law.

In the alternative, if Applicant opposes this motion and it is denied, then Opposer moves under Fed. R. Civ. P. Rule 37 to preclude applicant from offering evidence in view of its default in discovery, and requests that the testimony periods be reset.

The Opposed Application and Prior Proceedings.

Application Serial No. 78/037,201, was filed by Applicant on November 30, 2000 to register the mark AMAZING-BARGAINS.COM, claiming first use and first use in commerce on

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June 1, 1999, in International Class 35 "for providing a web site featuring information in the nature of coupons, discounts and bargains for online stores via the global computer network." The application was published for opposition on September 25, 2001 in the United States Official Gazette at page TM 492

The application was timely opposed by JBS by filing, after the granting of requested extensions of time, a Notice of Opposition, dated December 24, 2001 and received by the USPTO on December 27, 2001, based inter alia on ownership of U.S. Trademark Registration No. 2,354,959 registered on the Principal Register on June 6, 2000 for the mark AMAZING SAVINGS, in international class 35, for retail variety outlet services with a date of first use at least as early as July 9, 1987 and a date of first use in commerce at least as early as August 26, 1987 and based on Opposer's actual use of said mark long prior to Applicant's application or claimed date of use. Opposer's registration is valid and subsisting and is prima facie evidence of Opposer's right to use its registered mark in commerce in connection with the services in said registration.

By Order dated February 1, 2002, Paper No. 3, the TTAB set dates for answer, discovery and trial. Discovery was to be completed by August 20, 2002.

On or about March 11, 2002, Applicant served an undated Answer to the Notice of Opposition, through counsel, Fletcher & Associates.

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On August 11, 2002, Opposer served Opposer's First Request for Production of Documents and Opposer's First Set of Interrogatories to Applicant, copies of which are annexed hereto as Exhibit A, with proof of service by first class U.S. Mail addressed to Applicant's counsel of record, Fletcher & Associates. Applicant took no discovery.

Applicant's responses to Opposer's discovery were due to be served September 16, 2002. No responses were served by Applicant.

In view of Applicant's failure to respond and Opposer's clear priority, and the imminent commencement of the testimony period, Opposer moves for summary judgment under Fed R. Civ. P. Rule 56.<sup>1</sup> In the alternative, if that motion is opposed and denied, Opposer moves to preclude Applicant's evidence and to extend testimony dates.

I. SUMMARY JUDGMENT SHOULD BE GRANTED BECAUSE  
THERE IS A LIKELIHOOD OF CONFUSION

A. The Standard on the Motion

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<sup>1</sup>. In preparation of the motion, Opposer's undersigned counsel called Applicant's counsel on October 16, 2002, who stated that his office had moved to 2600 Michelson Drive, Irvine, CA, that he was still receiving mail from the prior address in Costa Mesa, CA, but that he had not received applicant's discovery requests. Opposer's counsel advised that he had received no notice of change of address from applicant's counsel (see requirements of 37 C.F.R. §2.18) and that in view of the TTAB Order scheduling dates, Opposer would have to proceed with this motion.

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The law is well settled that "[a]s in court litigation, summary judgment in trademark proceedings is designed to avoid useless trials where there is no genuine issue as to any material fact." 3 McCarthy on Trademarks and Unfair Competition §20.132 (4th ed., 2001). While reasonable inferences must be resolved against the moving party, the non-moving party has the burden to lay bare its proofs to raise a genuine issue of material fact. Celotex Corp. v. Catrett, 477 U.S. 317 (1986).

As the Supreme Court explained in Celotex, supra: "Summary judgment procedure is properly regarded not as a disfavored procedural shortcut, but rather as an integral part of the Federal Rules as a whole, which are designed 'to secure the just, speedy and inexpensive determination of every action.' Fed. Rule Civ. Proc. 1." 106 S.Ct. at 2555.

Thus, summary judgment is appropriate in trademark opposition proceedings when there is no issue as to likelihood of confusion under Lanham Act §2(d). By reason of the Supreme Court's mandate in Celotex, the TTAB has not hesitated to grant such motions in favor of Opposers, finding likelihood of confusion and sustaining the opposition. See for example, Bongrain International (American) corp. v. Moquet, Ltd., 230 U.S.P.Q. 626 (TTAB 1986) (summary judgment granted for opposer where identical marks ALOUETTE held to be likely to cause confusion as between wine and cheese); Turner Entertainment v. Nelson, 38 U.S.P.Q.2d 1942 (TTAB 1996) (summary judgment for

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opposer based on mark GILLIGAN'S ISLAND against application for same mark for suntan lotion).

B. Ownership and Priority.

As the record now shows, Opposer is the owner of all right, title and interest in and to U.S. Registration No. 2,354,959 for the mark AMAZING SAVINGS pleaded in this opposition, copy annexed as Exhibit B.<sup>2</sup> It is well settled that where Opposer owns an existing registration, there is no issue as to priority over the application which is opposed. Lanham Act §2(d); Contour Chair-Lounge Co. v. The Englander Co., 139 U.S.P.Q. 285 (C.C.P.A. 1963); Block Drug Co. v. Den-Mart, Inc., 17 U.S.P.Q.2d 1315, 1317 (TTAB 1989) (question of priority "does not arise" where opposer owns subsisting registrations). Although the registration itself represents priority over the applicant as a matter of law under Lanham Act Section 2(d), Opposer also notes that the Registration recites a first use and first use in commerce in 1987. Thus, both the use and registration of Opposer's mark predates applicant's application date and Opposer's use predates applicant's claimed first use date.

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<sup>2</sup>. A true copy of Opposer's registration for AMAZING SAVINGS is annexed hereto as Exhibit B. To further document the registration, Opposer's counsel has also placed an order for a Status and Title copy of said registration, as shown by the USPTO on line order receipt also annexed as part of Exhibit B.

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C. Likelihood of Confusion Exists Under the DuPont Factors.

Where Opposer relies on its registration which is valid and subsisting, likelihood of confusion is to be judged based on the mark and services applied for as compared to the mark and services shown in the Opposer's registration.

In Application of E.I. Dupont De Nemours & Co., 476 F.2d 1357, 1361 (C.C.P.A. 1973), the Court set out the factors to be considered by the Board in assessing likelihood of confusion under §2(d). Based on the evidence, different factors may be decisive. Kenner Parker Toys, Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 352 (Fed. Cir. 1992), cert. denied, 113 S. Ct. 181 (1992). Applying those factors here shows that there is no issue of fact that there is a likelihood of confusion because of the near identity of the marks - applicant's AMAZING-BARGAINS.COM and Opposer's AMAZING SAVINGS and the close similarity and relatedness of Opposer's registered services to the applicant's services, both involving retail sales to consumers, Applicant's retail sales information being through an internet web site and Opposer's retail sales being through actual physical outlets.

1. The Marks Are Nearly Identical.

The parties' marks are nearly identical, when viewed as a whole. Applicant's AMAZING-BARGAINS.COM has the same meaning as Opposer's registered mark AMAZING SAVINGS, and the sight and sound are confusingly similar. DuPont, supra, 476 F.2d at 1361.

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Both start with the identical dominant word AMAZING following by "ing" ending nouns having the same meaning. Webster's Universal College Dictionary (1997) at p. 63 states the first definition of "bargain" as "an advantageous purchase, esp. one acquired at less than usual cost." This means the same as a "saving," defined in the same dictionary at p. 699 as "a reduction or lessening of expenditure." Both words, with the same sounding ending, mean less cost or expenditure and are synonymous.

Even identity of an overlapping dominant portion of the marks, here the word "AMAZING," would be sufficient for confusion. Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 876 (Fed. Cir. 1992) (CENTURY portion of marks was central and dominant in applicant's and opposer's marks). The words have identical meaning and nearly identical sight and sound. Moreover, Applicant's services expressly use the words "discounts" and "bargains" as part of the specification of services, further showing the likelihood of confusion.

2. Similarity of Goods and Services

The second DuPont factor calls for a comparison of the similarity 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." 476 F.2d at 1361. The marks must be compared on the basis of the goods and services described in the application and the prior cited registration. In re Drug Research Reports, Inc., 200 U.S.P.Q. 554, 555 (TTAB 1978); Octocom

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Systems, Inc. v. Houston Computer Services, 918 F.2d 937, 942 (Fed. Cir. 1990).

Here, there can be no issue of fact that the parties' services are related, both in International Class 35. Opposer's services of "retail variety outlets" are closely related to Applicant's services of providing "information for on line stores" over the internet. Both relate to stores and both relate to retail sales, meaning sales to consumers. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463 (Fed. Cir. 1988) (retail grocery and general merchandise store services held likely to be confused with prior registration for virtually same mark for "furniture" because the services would include sale of the goods); In re Concordia International Forwarding Corp., 222 U.S.P.Q. 355 (TTAB 1983) (where marks are similar, it is "only necessary that there be a viable relationship between the goods or services in order to support a holding of likelihood of confusion.") Here, there is more than a viable relationship of the services under similar marks.

In sum, under DuPont, there can be no dispute that the similarity and relatedness of the parties' services, marketed under nearly identical marks, warrant a finding of likelihood of confusion.

3. Similarity of Established Channels of Trade

As noted, under DuPont, the application must be taken as written, without restriction to any particular channel of

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trade. It is evident that providing information on the internet about "on line stores" is similar to Opposer's services of actual retail variety stores. Both appeal to consumers and there is no substantial distinction between consumers approached on the internet or consumers approached by brick and mortar stores. Retail consumers are the same target channel of trade for the applicant's and registrant's respective services.

4. Other DuPont Factors Favor Summary Judgment

The above factors are decisive showing a likelihood of confusion. Opposer notes that other DuPont factors also favor Opposer. Thus, retail consumers who purchase at variety stores or seek discounts on the internet are not likely to be sophisticated or discriminating since such purchases imply bargains and savings of relatively inexpensive items. Finally, Applicant filed its application either without the diligence of a prior trademark search or in bad faith disregard of the prior Registration of record for the very similar mark of Opposer, AMAZING SAVINGS. See In re Concordia International Forwarding, supra, 222 U.S.P.Q. at 357 (ruling against "junior user who does not search. . . . The obligation is to check out possible conflicts" in advance).

II. IN THE ALTERNATIVE, APPLICANT SHOULD BE PRECLUDED

If Applicant opposes this motion for summary judgment and it is denied, then Opposer moves under Fed. R. Civ. P. Rule 37 to preclude Applicant from offering evidence in view of its

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default in discovery, and requests that the testimony periods be reset. The record recited above and Exhibit A shows that Applicant's counsel was duly served by mail to its address of record, no change of address was ever served, and Applicant's counsel reports continuing to receive mail from its prior address (see footnote 1, supra). There is thus no excuse for Applicant, either because it failed to advise Opposer's counsel of a new address as required which accounts for the claimed non-receipt, or because the papers were received and not responded to. It is well settled that the Board may order a party precluded from offering evidence on matters that should have been but were not produced during the discovery period. 37 C.F.R. § 2.120(g)(1); Fed. R. Civ. P. 37(b)(2)(B). That is the case here through no fault of Opposer. Thus, if summary judgment is not granted, Applicant should be precluded and testimony dates should be reset.

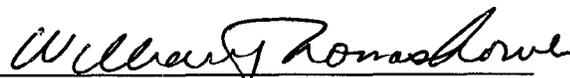
CONCLUSION

Summary judgment should be granted in favor of Opposer based on its prior U.S. Registration No. 2,354,959 and the opposition should be sustained.

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In the alternative, if Applicant opposes this motion and it is denied, then Opposer moves under Fed. R. Civ. P. Rule 37 to preclude applicant from offering evidence in view of its default in discovery, and requests that the testimony periods be reset.

Respectfully submitted,



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Dated: October 17, 2002