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

COLUMBIA INSURANCE COMPANY and
H.H. BROWN SHOE COMPANY, INC.,

Opposers,

vs.

LENWORTH ALEXANDER HYATT

Applicant.



12-23-2002

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #77

Opposition No. 91151757

NOTICE OF MOTION FOR SUMMARY JUDGMENT

Pursuant to F.R.C.P. 56(a) and 37 C.F.R. 2.116, the undersigned, attorneys for Opposers COLUMBIA INSURANCE COMPANY and H.H. BROWN SHOE COMPANY, INC. (collectively "Opposers"), hereby move this Honorable Board for an Order granting Opposers Summary Judgment against Applicant Lenworth Alexander Hyatt.

Please take further notice that in support of the motion, Plaintiff will rely upon the within Memorandum of Law, the Declaration of Mark J. Speciner and all pleadings and exhibits heretofore filed in this matter.

Respectfully submitted,

Gene S. Wirtler
Mark J. Speciner
St. Onge Steward Johnston & Reens LLC
986 Bedford Street
Stamford, Connecticut 06905-5619
Telephone: (203) 324-6155
Facsimile: (203) 327-1096
Attorneys for Plaintiff

12-18-02

Date

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TRADEMARK TRIAL AND APPEAL BOARD

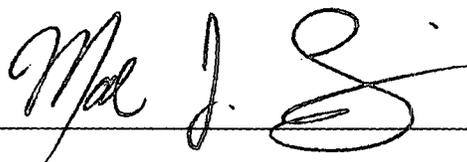
CERTIFICATE OF SERVICE

This is to certify that a true and correct copy of the foregoing **NOTICE OF MOTION FOR SUMMARY JUDGMENT** is being served this 18th day of December, 2002, via First-Class mail to:

Lenworth Alexander Hyatt
P.O. Box 4864
Hollywood, FL 33083

12-18-02

Date



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

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COLUMBIA INSURANCE COMPANY and
H.H. BROWN SHOE COMPANY, INC.,

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vs.

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12-23-2002
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**MEMORANDUM OF LAW IN SUPPORT
OF MOTION FOR SUMMARY JUDGMENT**

I. INTRODUCTION

Opposers Columbia Insurance Company ("Columbia") and H.H. Brown Shoe Company, Inc. ("H.H. Brown") (Columbia and H.H. Brown shall hereinafter collectively be referred to as "Opposers"), by their attorneys, hereby move for summary judgment on the ground that there is no confusion between the parties' products, and, therefore, no infringement.

In support of its motion, Harco submits the instant Memorandum of Law and Declaration of Mark J. Speciner, dated December 18, 2002 (hereinafter "Speciner Dec"):

II. BACKGROUND

Opposer Columbia is the owner of a trademark for a distinctive H & Crown design. Speciner Dec., ¶ 2. Columbia has been using its H & Crown design trademark

continuously since March 5, 1994. *Id.* H.H. Brown is the exclusive licensee of the H & Crown design trademark. *Id.* On June 18, 1996, H.H. Brown obtained a registration for the H & Crown design trademark from the United States Patent and Trademark Office. The H & Crown design trademark was given Registration No. 1,981,495, and is registered in respect of "footwear" in Class 25. Since its registration, it has been used continuously, and on July 29, 2002, the registration became incontestable. *Speciner Dec.*, ¶¶ 2 – 3.

On April 17, 2001, Applicant Lenworth Alexander Hyatt (hereinafter "Applicant") applied to register a "crown design" trademark based on an intent-to-use the mark in respect of "clothing for men, women, children and infants, namely; footwear, pants, headwear, underwear, swimwear, lingerie, shirts, jackets, socks, dresses, blouses, stockings, sweaters, blazers, pajamas, robes, trench coats, sports jerseys, gloves, overall, skirts, jump-suits, leotards, tank-tops, neck-ties, bow-ties, shorts, suits, scarves, hankkerchiefs (sic), vest, shawls, blazers" in Class 25. Applicant's crown design application was granted Application Serial No. 76/242,606. It was published for opposition on October 16, 2001, and on February 13, 2002, Opposers filed a Notice of Opposition of the registration of Applicant's crown design mark.

On July 22, 2002, Opposers served Interrogatories, Requests for Production of Documents and Requests for Admissions to Applicant. The deadline for Applicant to serve responses to the outstanding discovery was August 26, 2002. To date, no responses of any kind have been received by either Opposers or their counsel. Because Applicant has failed to provide a response to the outstanding discovery, specifically, the Requests for Admission, the statements contained therein are deemed admitted by Applicant. As such, Applicant has admitted, *inter alia*, that Applicant's

mark is confusingly similar to Opposers' H & Crown design trademark. Accordingly, summary judgment is appropriate.

III. LAW

A. Standard for Summary Judgment

Summary judgment is appropriate when "there is no genuine issue as to any material fact and ... the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c); *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1116, 227 USPQ 577, 581 (Fed. Cir. 1985) (en banc). "The movant bears the burden of demonstrating absence of all genuine issues of material fact." *SRI*, 775 F.2d at 1116, 227 USPQ at 581; *Armco, Inc. v. Cyclops Corp.*, 791 F.2d 147, 149, 229 USPQ 721, 722-23 (Fed. Cir. 1986). In this action, through the Applicant's failure to respond to interrogatories, document requests and, especially, requests for admission, likelihood of confusion may be found to have been admitted by the Applicant.

B. Opposers' Requests for Admissions May Be Deemed Admitted" Due to Applicant's Failure to Provide Responses

Requests for Admission are covered by Rule 36 of the Federal Rules of Civil Procedure.¹ It states, in pertinent part:

Each matter of which an admission is requested shall be separately set forth. **The matter is admitted unless, within 30 days after service of the request . . . the party to whom the request is directed serves upon the party requesting the admission a written answer or objection addressed to the**

¹ 37 C.F.R. § 2.1116 provides that inter party proceedings, unless otherwise provided, should be governed by the Federal Rules of Civil Procedure.

matter signed by the party or by the party's attorney (emphasis supplied).

Fed.R.Civ.P. Rule 36(a). Rule 36(b) adds that "[a]ny matter admitted under this Rule is conclusively established unless the court on motion permits withdrawal or amendment to the admission."

In the instant case, Opposers, on July 22, 2002, served Opposers' First Set of Requests to Admit to Applicant. See Speciner Dec., ¶ 7 and Exhibit D thereto). Request No. 1 asks Applicant to "Admit that Applicant's Mark is confusingly similar to Opposers' Mark."² Since Applicant did not submit a response to this request, it is deemed admitted. Moreover, such an admission warrants the entry of summary judgment. See *Johnson v. Tuff N Rumble Management Inc.*, 54 U.S.P.Q.2d 1871 (E.D. La. 2000) (quoting *American Auto Ass'n v. AAA Legal Clinic of Jefferson*, 19 U.S.P.Q. 2d 1142, 1144 (5th Cir. 1991)("The conclusive effect of Rule 36(b) 'applies equally to those admissions made affirmatively and those **established by default, even if the matters admitted relate to material facts that defeat a party's claim.**").

Since Applicant has admitted that his mark and that of the Opposers are confusingly similar, summary judgment is not only appropriate, it is warranted.

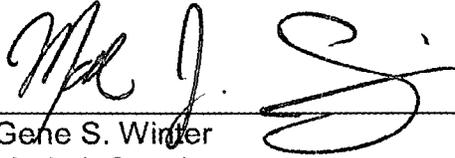
IV CONCLUSION

Through the use of standard discovery tools, Opposers have clearly demonstrated that there is a likelihood of confusion between their mark and that of the Applicant. For the

² "Opposers' Mark" had been defined as "the CROWN DESIGN trademark of Columbia Insurance Company, registered at the United States Patent and Trademark Office, and granted Registration No. 1,981,495." A depiction of this registration is annexed to the Speciner Dec. as Exhibit ___.

foregoing reasons, plaintiff's motion for summary judgment for a declaratory judgment of non-infringement should be granted.

Respectfully submitted,



December 18, 2002

Date

Gene S. Winter
Mark J. Speciner
St. Onge Steward Johnston & Reens LLC
986 Bedford Street
Stamford, Connecticut 06905-5619
Telephone: (203) 324-6155
Facsimile: (203) 327-1096
Attorneys for Opposers

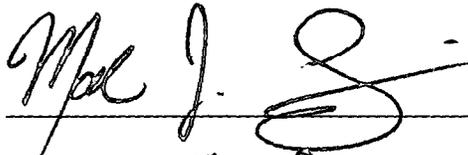
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This is to certify that a true and correct copy of the foregoing Memorandum Of Law In Support Of Motion For Summary Judgment is being served this 18th day of December, 2002, via First-Class mail to:

Lenworth Alexander Hyatt
P.O. Box 4864
Hollywood, FL 33083

12-18-02

Date



Mark J. Speciner

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



12-23-2002

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COLUMBIA INSURANCE COMPANY and
H.H. BROWN SHOE COMPANY, INC.,

Opposers,

vs.

LENWORTH ALEXANDER HYATT

Applicant.
-----X

Opposition No. 91151757

DECLARATION OF MARK J. SPECINER

I, MARK J. SPECINER, pursuant to 28 U.S.C. § 1746, declares as follows:

1. I am an attorney for the firm of St. Onge Steward Johnston & Reens, LLC, attorneys for Opposers Columbia Insurance Company ("Columbia") and H.H. Brown Shoe Company, Inc. ("H.H. Brown") (Columbia and H.H. Brown will be collectively referred to hereinafter as "Opposers"). I submit this declaration in support of Opposers' Motion for Summary Judgment.

2. Opposer Columbia is the owner of the H & Crown Design trademark ("Opposers' Mark"). On June 18, 1996, H.H. Brown obtained a registration for Opposers' Mark from the United States Patent and Trademark Office. The H & Crown design trademark was granted Registration No. 1,981,495, and is registered in respect of "footwear" in Class 25.

3. Subsequently, H.H. Brown assigned the H & Crown design trademark and registration to Opposer Columbia. Since its registration, Opposers' Mark has been used

continuously, and on July 29, 2002, the registration became incontestable. A depiction of that registration is annexed hereto as Exhibit A. Opposers have been using Opposers' Mark continuously since 1979.

4. On April 17, 2001, Applicant Lenworth Alexander Hyatt ("Applicant") filed an application to register a crown design trademark (hereinafter "Applicant's Mark"). It was granted Application Serial No. 76/242,606, and published for opposition on October 16, 2001.

5. On February 13, 2002, Opposers filed the instant Notice of Opposition, alleging, *inter alia*, likelihood of confusion. A copy of the Notice of Opposition is annexed hereto as Exhibit B. The opposition was given number 91151757.

6. On June 4, 2002, the Trademark Trial and Appeal Board mailed notification of the instant opposition to Applicant. Within the notification was an order setting forth trial dates. Among the dates contained therein was the opening of discovery on June 24, 2002. A copy of the Board's Notice to Applicant is annexed hereto as Exhibit C.

7. On July 22, 2002, Opposers served Interrogatories, Document Requests and Requests for Admission to Applicant. A copy of the Requests for Admission is annexed hereto as Exhibit D. Under Trademark Rules, Applicant's deadline by which to respond to the Requests for Admission was August 26, 2002. To date, no response from Applicant has been received.

I hereby declare under penalty of perjury that the foregoing is true and correct.

Executed at Stamford, Connecticut, this 18th day of December, 2002.



Mark J. Speciner



UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Electronic Search System (TESS)

TESS was last updated on Wed Dec 18 04:10:43 EST 2002

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Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

Check Status *(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)*



Word Mark	H
Goods and Services	IC 025. US 022 039. G & S: footwear. FIRST USE: 19940305. FIRST USE IN COMMERCE: 19940305
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	241101
Serial Number	74505576
Filing Date	March 28, 1994
Filed ITU	FILED AS ITU
Published for Opposition	August 1, 1995
Registration Number	1981495
Registration Date	June 18, 1996
Owner	(REGISTRANT) H.H. Brown Shoe Company, Inc. CORPORATION DELAWARE 124 West Putnam Avenue Greenwich CONNECTICUT 06830 (LAST LISTED OWNER) COLUMBIA INSURANCE COMPANY CORPORATION BY ASSIGNMENT NEBRASKA 3024 HARNEY STREET OMAHA NEBRASKA 68131

Assignment Recorded ASSIGNMENT RECORDED
Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR).
Live/Dead Indicator LIVE

[PTO HOME](#) [TRADEMARK](#) [TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DICT](#) [TOP](#) [HELP](#)

B

Attorney's Docket No.: 10294-602PP1

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

COLUMBIA INSURANCE COMPANY and
H.H. BROWN SHOE COMPANY, INC.,

Opposer,

v.

LENWORTH ALEXANDER HYATT

Applicant.

Opposition No.

In the matter of
Application Serial No. 76-242,606

Published in the Official Gazette on October
16, 2001

Mark: H & Crown Design

BOX TTAB
FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

NOTICE OF OPPOSITION

Columbia Insurance Company, a Nebraska corporation, having its principal place of business at 4016 Farnam Street, Omaha, Nebraska 68131, and H.H. Brown Shoe Company, Inc., a Delaware corporation, having its principal place of business at 124 West Putnam Avenue, Greenwich, Connecticut, believe that they will be damaged by the registration of the mark shown in the above-identified application, and hereby oppose same.

The grounds for opposition are as follows:

1. Columbia Insurance Company is the owner of U.S. Trademark Registration No. 1,981,495 for the H & Crown Design trademark.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

February 13, 2002

Date of Deposit

Signature

Karen B. Lacerda

Typed or Printed Name of Person Signing Certificate

2. H.H. Brown Shoe Company, Inc. is licensed by Columbia Shoe Company to use the H & Crown Design trademark.

3. Hereinafter Columbia Insurance Company and H.H. Brown Shoe Company, Inc. will be referred to collectively as Opposers.

4. Opposers use and have used since 1979, the H & Crown Design trademark in interstate commerce in connection with footwear and the like.

5. Applicant, Lenworth Alexander Hyatt, filed Application Serial No. 76-242,606 on April 17, 2001 on an intent-to-use basis for the mark Crown Design, to be used in connection with clothing for men, women, children and infants, namely footwear, pants, headwear, underwear, swimwear, lingerie, shirts, jackets, socks, dresses, blouses, stockings, sweaters, blazers, pajamas, robes, trench coats, sports, sports jerseys, gloves, overall, skirts, jump-suits, leotards, tank-tops, neck-ties, bow-ties, shorts, suits, scarves, handkerchiefs, vest, shawls, blazers in Int. Class 25. Said application was published in the Official Gazette of October 16, 2001.

6. Applicant's mark Crown Design, as applied to footwear, so resembles the previously used H and Crown Design trademark of Opposers, as used in connection with Opposers' goods, as to be likely to cause confusion or cause mistake, or to deceive consumers as to any association between Opposers' and Applicant.

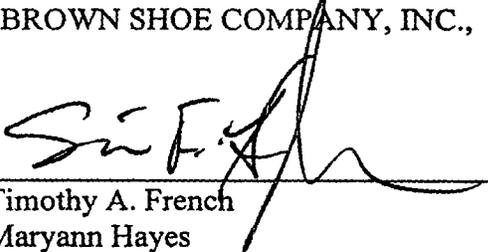
7. Applicant's mark Crown Design, as applied to footwear, so resembles the previously used H and Crown Design of Opposers, as used in connection with Opposers' goods, will likely dilute the distinctiveness of Opposers' trademark.

8. Based upon the foregoing, the registration of the mark depicted in Application Serial No. 76-242,606, filed on April 17, 2001, on the Principal Register of the United States Patent and Trademark Office, will cause injury and damage to Opposers.

WHEREFORE, Opposers requests that registration of Applicant's mark Crown Design,
Application Serial No. 76-242,606, be denied.

COLUMBIA INSURANCE COMPANY and
H.H. BROWN SHOE COMPANY, INC.,

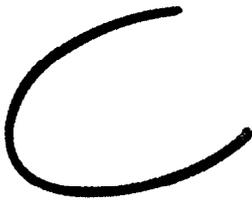
By:



Timothy A. French
Maryann Hayes
Seán F. Heneghan

Opposer attorneys
Fish & Richardson, P.C.
225 Franklin Street
Boston, MA 02110-2804
(617) 542-5070

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UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: June 4, 2002

Opposition No 91151757
Serial No. 76242606

LENWORTH ALEXANDER HYATT

PO BOX 4864
HOLLYWOOD, FL 33083-4864

H.H. Brown Shoe Company, Inc.

v.

HYATT, LENWORTH ALEXANDER

Timothy A. French
Fish & Richardson
225 Franklin Street
Boston, MA 02110-2804

Kimberly Linton, Legal Assistant:

A notice of opposition to the registration sought in the above-identified application has been filed. A copy of the notice is attached.

ANSWER IS DUE FORTY DAYS after the mailing date hereof. (See Patent and Trademark Rule 1.7 for expiration date falling on Saturday, Sunday or a holiday).

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 are reminded of the recent amendments to the Trademark Rules that became effective October 9, 1998. See Notice of Final Rulemaking published in the *Official Gazette* on September 29, 1998 at 1214 TMOG 145. Slight corrections to the rules, resulting in a correction notice, were published in the *Official Gazette* on October 20, 1998 at 1215 TMOG 64. A copy of the recent amendments to the Trademark Rules, as well as the *Trademark Trial and Appeal Board Manual of Procedure (TBMP)*, is available at <http://www.uspto.gov>.

Discovery and testimony periods are set as follows:

Discovery period to open:	June 24, 2002
Discovery period to close:	December 21, 2002
30-day testimony period for party in position of plaintiff to close:	March 21, 2003
30-day testimony period for party in position of defendant to close:	May 20, 2003
15-day rebuttal testimony period for plaintiff to close:	July 04, 2003

A party must serve on the adverse party a copy of the transcript of any testimony taken during the party's testimony period, together with copies of documentary exhibits, within 30 days after completion of the taking of such testimony. See Trademark Rule 2.125.

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.

NOTE: The Board allows parties to utilize telephone conferences to discuss or resolve many interlocutory matters that arise in inter partes cases. See the *Official Gazette* notice titled "Permanent Expansion of Telephone Conferencing on Interlocutory Matters in Inter Partes Cases Before the Trademark Trial and Appeal Board," 1235 TMOG 68 (June 20, 2000). A hard copy of the *Official Gazette* containing this notice is available for a fee from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402 (Telephone (202) 512-1800). The notice is also available at <http://www.uspto.gov>. Interlocutory matters which the Board agrees to discuss or decide by phone conference may be decided adversely to any party which fails to participate.

If the parties to this proceeding are also parties to other Board proceedings involving related marks or, during the pendency of this proceeding, they become parties to such proceedings, they should notify the Board immediately, so that the Board can consider consolidation of proceedings.

D

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

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COLUMBIA INSURANCE COMPANY and)
H.H. BROWN SHOE COMPANY, INC.,)
)
Opposers,)
)
v.) Opposition No. 91151757
)
LENWORTH ALEXANDER HYATT,)
)
Applicant.)
-----X

**OPPOSERS' FIRST SET OF
REQUESTS TO ADMIT TO APPLICANT**

Pursuant to Rule 2.210 of the Trademark Rules of Practice and Rules 26 and 36 of the Federal Rules of Civil Procedure, Opposers, COLUMBIA INSURANCE COMPANY AND H.H. BROWN SHOE COMPANY, INC. request that Applicant, LENWORTH ALEXANDER HYATT (hereinafter "Applicant"), respond fully to the following Requests to Admit within the time set forth in Rule 36. If Applicant fails to respond to these Requests within the time for response, these requests will be deemed admitted as a matter of law pursuant to Rule 36. The definitions set forth in Opposers' First Set of Interrogatories to Applicant are incorporated herein by reference.

REQUESTS TO ADMIT

REQUEST NO. 1

Admit that Applicant's Mark is confusingly similar to Opposers' Mark.

REQUEST NO. 2

Admit that use of Applicant's Mark by Applicant or any licensee thereof will cause confusion in the marketplace among the consuming public as to the source or origin of Applicant's goods.

REQUEST NO. 3

Admit that Applicant was aware of Opposers' Mark when it filed to register Applicant's Mark with the United States Patent and Trademark Office.

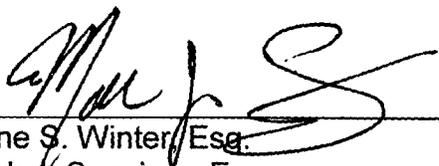
REQUEST NO. 4

Admit that Applicant does not have a bona fide intent to use Applicant's Mark in connection with the goods listed under Applicant's Mark.

Respectfully submitted,

COLUMBIA INSURANCE COMPANY
H.H. BROWN SHOE COMPANY, INC.

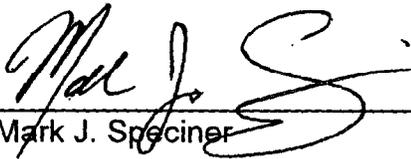
Date: July 22, 2002

By: 
Gene S. Winter, Esq.
Mark J. Speciner, Esq.
ST. ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905
(203) 324-6155
Attorneys for Opposers

CERTIFICATE OF SERVICE

I hereby certify that on this 22nd day of July, 2002, I placed a true and correct copy of the foregoing Opposer's First Set of Requests to Admit to applicant by placing same in the U.S. mail, postage prepaid, addressed to:

Lenworth Alexander Hyatt
P.O. Box 4864
Hollywood, FL 33083



Mark J. Speciner