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03-27-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #30

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

MONSTER CABLE PRODUCTS, INC.,

Opposer,

v.

JOEL BARRY SHAMITOFF,

Applicant.

Opposition No. 91152044

**APPLICANT'S MOTION FOR  
SUMMARY JUDGMENT**

TRADEMARK TRIAL AND  
APPEAL BOARD  
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**I. INTRODUCTION**

Applicant Joel Shamitoff seeks a federal trademark registration based on his intention to use the trademark MONSTERSNAPS in connection with a line of plush toys. His application is opposed by Monster Cable Products, Inc. ("Monster Cable"), manufacturer of a line of computer, audio and video cables and related electronic equipment. Monster Cable alleges that registration and use of MONSTERSNAPS on plush toys is likely to confuse consumers, and will dilute Monster Cable's registered MONSTER trademark as well as a purported "family" of MONSTER marks.

Monster Cable's opposition can, and should, be disposed of by this Board on summary judgment. It is undisputed that Monster Cable does not use any of its marks on plush toys; indeed, it owns no mark that is registered in International Class 28, and its products are so

different from Shamitoff's products that consumer confusion is impossible. There is extensive third-party registration *and* use of trademarks that incorporate the word "MONSTER" (the only point of similarity between Applicant's and Opposer's marks) on a variety of toys. As a result, this Board should conclude as a matter of law that consumers would not confuse MONSTERSNAPS toys with Monster Cable or its products.

Even assuming for purposes of this motion that Monster Cable's MONSTER mark is entitled to protection under federal dilution law, Monster Cable certainly cannot prove that it is famous or distinctive in the field of toys -- a field that Monster Cable does not even purport to occupy. Its claim to the contrary would be tantamount to Apple Computers (certainly "famous" in one field) successfully opposing "Applejacks" on children's cereal. Moreover, Monster Cable cannot show actual harm as required by the Supreme Court's recent opinion in Moseley v. V Secret Catalogue, 123 S. Ct. 1115 (2003). Shamitoff respectfully requests that this Board enter judgment against Monster Cable on the dilution claim as well.

## II. SUMMARY OF FACTS

### A. The Pleadings

On or about June 29, 2001, Shamitoff filed an intent-to-use application to register the trademark MONSTERSNAPS in International Class 28, for use in connection with "toys and playthings, namely dolls and plush toys."

Monster Cable filed its opposition on or about May 1, 2002. Monster Cable allegedly owns a number of trademarks that incorporate the word "MONSTER" in International Classes 6, 9, 16, 25, 41 and 42, as well as a "family of MONSTER marks." Monster Cable claims that MONSTERSNAPS is "confusingly similar to Opposer's above-stated individual trademarks and the MONSTER family of marks," and that registration and use of MONSTERSNAPS "is likely to cause confusion, deception and mistake" and to cause Monster Cable damage. Monster Cable further alleges that "Opposer's MONSTER and family of MONSTER marks are entitled to famous mark protection, and Applicant's use will dilute or tend to dilute said marks."

**B. Use and Registration of Trademarks Incorporating the Word "MONSTER"**

In the international classes in which Monster Cable owns trademarks – 6, 9, 16, 25, 41 and 42 – there are at least 125 active, registered trademarks that incorporate the word "MONSTER" and are *not* owned by Monster Cable. (Selvan Dec. ¶ 5.) Overall, there are over 275 active, registered trademarks on the Principal Register that incorporate the word "MONSTER" and are *not* owned by Monster Cable. (*Id.* ¶ 6.)

Monster Cable does not own any trademarks registered in International Class 28. (*Id.* ¶ 2.) Nor does it use any of its registered trademarks in connection with dolls, plush toys, or indeed any toys other than electronic games. Monster Cable's own evidence indicates that its use of its MONSTER trademarks focuses on audio, video and computer cables and related equipment. (*Id.* Exs. C, D.)

On the other hand, there are 45 active trademarks registered in International Class 28 that incorporate or include the word "MONSTER" and are *not* owned by Monster Cable. There is extensive third-party use on a variety of toys, including plush toys, of these registered marks, as well as other trademarks and product designations that include the word "MONSTER." (*Id.* ¶¶ 3-4, Exs. A, B, E)

**III. ARGUMENT**

**A. Standard for Summary Judgment**

This Board has observed that "the purpose of summary judgment is 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." Kellogg Co. v. Pack 'Em Enterprises, Inc., 14 U.S.P.Q.2d (BNA) 1545 (TTAB 1990) (citations omitted), aff'd, 951 F.2d 330 (Fed. Cir. 1991). The Federal Circuit has similarly noted that summary judgment "is a salutary method of disposition designed to secure the just, speedy and inexpensive

determination” of trademark disputes. Sweats Fashions, Inc. v. Pannill Knitting Co., 833 F.2d 1560, 1562 (Fed. Cir. 1987) (internal quotations and citations omitted).

Indeed, the Federal Circuit has gone so far as to encourage this Board to dispose of cases on summary judgment wherever possible, observing that *inter partes* cases before the Board “seem particularly suited to this type of disposition. Too often we see voluminous records which would be appropriate to an infringement or unfair competition suit but are wholly unnecessary to resolution of the issue of registrability of a mark.” Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 739 F.2d 624, 627 n.2 (Fed. Cir. 1984).

“Summary judgment is appropriate when, after reviewing the evidence in the light most favorable to the non-moving party, there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law.” Nabisco, Inc. v. Warner-Lambert Co., 220 F.3d 43, 45 (2d Cir. 2000); Fed. R. Civ. P. 56(c); 37 C.F.R. § 2.116(a).

**B. Shamitoff Is Entitled to Summary Judgment on Monster Cable’s Claim of Likelihood of Confusion, Because the Parties’ Products Are Entirely Different.**

“While it has been said that the issue of likelihood of confusion is not usually susceptible to disposition by way of summary judgment, it may and should be done when it appears to be a certainty that confusion is not likely.” Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 221 U.S.P.Q. (BNA) 151 (TTAB 1983), aff’d, 739 F.2d 624 (Fed. Cir. 1984).

In particular, the Board has granted summary judgment in cases where the parties’ products were so different as to make it clear, as a matter of law, that even the use of identical trademarks would not cause confusion. In Pure Gold, the opposer, which used the trademark PURE GOLD on citrus fruits, challenged the registration of the mark FERMODYL PURE GOLD for hair treatment preparations. The Board granted summary judgment for the applicant, holding:

In the instant case, applicant seeks to register its mark for hair treatment preparations, namely, shampoos, rinses and conditioners. Opposer filed an opposition based on the ownership of its registered marks for citrus fruits. We believe, on these facts, that applicant is entitled to judgment as a matter of law. Specifically, it is clear that the goods to which the parties apply their marks are so

different in nature that confusion is unlikely to result from the contemporaneous use of the marks in connection with such goods. . . . In reaching this decision, the Board is aware that there are genuine issues of fact outstanding, such as whether the mark of the applicant is substantially similar to the marks owned by opposer and whether or not the goods of the parties are sold in the same channels of trade and to the same consumers. Although these are genuine issues of fact, we do not find them to be material facts. Even if the Board were to resolve these issues in favor of opposer, the Board would still find that there would be no likelihood of confusion, given the difference in the goods involved here.

Id. (emphasis added).

A number of federal district courts have followed suit. For example, in Moore Business Forms, Inc. v. Rite Aid Corp., 21 U.S.P.Q.2d (BNA) 2024 (W.D.N.Y. 1991), the plaintiff owned the mark COMPURITE for business forms. It alleged infringement based on Rite Aid's use of the mark CompuRITE for a computer system designed to handle pharmacy work. The court granted Rite Aid's motion for summary judgment, holding that "the products that Moore markets under its COMPURITE mark and the products that Rite Aid markets under its CompuRITE mark are so dissimilar that this alone is supportive of Rite Aid's motion for summary judgment." Id.; see also Toyota Motor Sales, U.S.A., Inc. v. Profile Cocktail Lounge, Inc., 2001 U.S. Dist. LEXIS 1393 (N.D. Ill. 2001) (granting summary judgment where "[t]he parties' products are so completely unrelated [cars vs. nightclub] that no reasonable consumer" would see an affiliation); Safe Flight Instrument Corp. v. Stencil Aero Engineering Corp., 323 F. Supp. 279 (W.D.N.C. 1970) (granting summary judgment where parties' products were different [aircraft safety systems and instruments vs. parachutes], even though marks were identical).

Here, the products on which the parties use or intend to use their marks are totally different. Shamitoff's intent-to-use application specifies use of the MONSTERSNAPS mark on dolls and plush toys. Monster Cable's products are used to connect electronic components to one another. No reasonable consumer would be confused over the source of MONSTERSNAPS toys. Certainly, if identical marks can co-exist on products as closely related as aircraft safety systems and parachutes, MONSTERSNAPS on plush toys can co-exist with MONSTER on consumer electronic products without causing any confusion – particularly in light of the extensive third-party use of marks incorporating the word "MONSTER" on toys and other

products. Obviously, in the field of toys, consumers do not rely on the word "MONSTER" as an indication of source. See Miles Laboratories, Inc. v. Naturally Vitamin Supplements, Inc., 1 U.S.P.Q.2d (BNA) 1445 (TTAB 1986) ("widespread, significant and unrestrained use by third parties of marks" that contain common elements with the mark that is opposed may indicate that consumers do not rely on those common elements as source indicators, and thus there is no likelihood of confusion). Accordingly, under the cases cited above, Shamitoff is entitled to summary judgment on Monster Cable's claim of likelihood of confusion.

**C. Shamitoff Is Entitled to Summary Judgment on Monster Cable's Claim of Dilution, Because Monster Cable's Marks Are Not Famous in the Field of Toys.**

The Board has set forth a rigorous standard that an opposer alleging dilution must meet in order to show that its mark is famous and distinctive, and therefore entitled to protection under the Federal Trademark Dilution Act of 1995 ("FTDA"):

To be vulnerable to dilution, a mark must be not only famous, but also so distinctive that the public would associate the term with the owner of the famous mark even when it encounters the term apart from the owner's goods or services. . . . [A] mark can be a famous mark in a particular field but not be distinctive outside that field. If the same mark is used by others on a wide variety of unrelated products, the mark may be famous for a particular item but not very distinctive. . . . If a term has achieved fame, but the evidence of distinctiveness indicates that there are numerous other uses of the term, the fame of the mark may be limited.

Toro Co. v. ToroHead, Inc., 61 U.S.P.Q.2d (BNA) 1164 (TTAB 2001). In order to establish the requisite level of fame, the trademark owner must demonstrate that "the common or proper noun uses of the term and third-party uses of the mark are now eclipsed by the owner's use of the mark. . . . To achieve this level of fame and distinctiveness, the party must demonstrate that the mark has become the principal meaning of the word." *Id.* (emphasis added). The Board made clear that this is a very high standard. See *id.* ("Fame for dilution purposes is difficult to prove.").

Monster Cable cannot make the required showing here. Monster Cable alleges that its MONSTER mark, and its supposed "family" of MONSTER marks, are famous. Even if we assume for purposes of this motion that that allegation is true, surely the fame of the MONSTER

mark cannot extend outside the field of Monster Cable's primary products: computer, audio and video cables and related electronic equipment, where use of the word may be merely descriptive of "monster-like" qualities. Given that Monster Cable makes *no* use of any MONSTER mark in connection with dolls or plush toys, it is difficult to believe Monster Cable would ever be able to prove that consumers would associate the word "MONSTER," in the context of plush toys, with Monster Cable. See id. ("Traditionally, identical marks owned by different parties have been able to co-exist when they are used on unrelated products.").

The insurmountable difficulty of making such a showing becomes even more apparent in light of the extensive use by parties *other* than Monster Cable, in connection with toys, of marks that incorporate the word "MONSTER." To cite some obvious examples:

- The Disney/Pixar hit movie *Monsters Inc.*, released in 2001, spawned an extensive line of "monster" plush toys. (Selvan Dec. Ex. E.)
- The famous Cookie Monster from Sesame Street, which has been around since 1969, has also been embodied in a variety of plush toys. (Id.)
- Even a cursory search of the Internet reveals numerous "monster" plush toys, none of which has any connection with Monster Cable or its products. (Id. Exs. B, E.)

Plainly, in this field, Monster Cable's mark has not "become the principal meaning of the word." To argue that Monster Cable's MONSTER mark is so famous that consumers associate *any* use of the word "monster" with Monster Cable is absurd on its face. Accordingly, even assuming the allegations of the opposition to be true, Monster Cable cannot establish the degree of fame and distinctiveness that is a required element of its claim.<sup>1</sup> Shamitoff is therefore entitled to summary judgment.

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<sup>1</sup> At most, Monster Cable can only hope to establish what this Board has termed "niche market fame" – that is, fame within a particular field. But as the Board has held, "niche market fame" is not relevant "unless somehow the goods or services with which the allegedly diluting mark is used are in the same market." Toro, supra. That is not the case here.

**D. Shamitoff Is Entitled to Summary Judgment on Monster Cable's Claim of Dilution, Because Monster Cable Cannot Establish Actual Harm From an Intent-to-Use Application.**

The United States Supreme Court has recently decided the question whether a party claiming dilution under federal law must prove actual harm. In Moseley v. V Secret Catalogue, Inc., 123 S. Ct. 1115 (2003), the Court held that in order to prevail on a federal dilution claim, the FTDA "unambiguously requires a showing of actual dilution, rather than a likelihood of dilution." Id. The owner of the famous mark must prove not only that a consumer associates the junior user's mark with the famous mark, but also that there has been a lessening of the capacity of the famous mark "to identify and distinguish" the owner's goods or services. Id.

It is impossible for Monster Cable to prove actual dilution here, for the simple reason that Shamitoff has not yet used his MONSTERSNAPS mark. The application opposed by Monster Cable is an intent-to-use application, and therefore by definition, there has been no actual harm. Under the holding of Moseley, it would appear that dilution can no longer be the basis for an opposition to an ITU application.<sup>2</sup>

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<sup>2</sup> In Toro, the Board held that an ITU application "satisfies the commerce requirement of the FTDA for proceedings before the Board." Toro, supra. The Board based this conclusion on the legislative history of the Trademark Amendments Act of 1999 ("TAA"), which provided that opposition proceedings may be based on claims of dilution. Id. (citing H.R. Rep. No. 106-250 at 5 (1999)). In a footnote, the Board noted the split among the circuits as to whether actual dilution must be proved, but stated that that issue was "irrelevant" to its determination that it could resolve allegations of dilution relating to ITU applications: "If we interpreted the TAA in a wooden manner, most owners of famous marks would not be able to bring dilution claims at the Board against an application based on an intent to use or even limited actual use. . . . Such an interpretation would render the TAA virtually meaningless." Id. (citation omitted). However, similar arguments were made in Moseley, and there is at least a serious question whether the Board's conclusion on this point in Toro can withstand the language of the Supreme Court's Moseley opinion. See Moseley, 123 S. Ct. 1115 (FTDA "unambiguously requires a showing of actual dilution").

#### IV. CONCLUSION

For the reasons discussed above, Applicant Shamitoff asks that the Board enter summary judgment against Monster Cable on its opposition.

Dated: March 27, 2003

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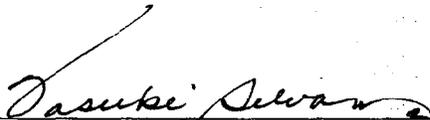
CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **APPLICANT'S MOTION FOR SUMMARY JUDGMENT** was served by first class mail on:

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this 27th day of March, 2003.

  
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