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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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Classic Media, Inc.
v.
Jean-Claude Lewis

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Opposition No. 91159034 to application Serial No. 78114516
filed on March 13, 2002

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Sonja Keith, Esq. for Classic Media, Inc.

Jean-Claude Lewis, *pro se*.

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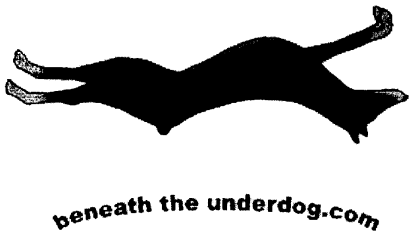
Before Quinn, Hohein and Hairston, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Jean-Claude Lewis has filed an application to register the mark "BENEATH THE UNDERDOG.COM" and design, as shown below,




on the Principal Register for "clothing for men, women and children, namely, t-shirts, underwear, socks, hats, pants, shoes,

belts, longjohns, uniforms and headbands" in International Class 25.[1]

Classic Media, Inc. has opposed registration on the ground that, long prior to the filing date of applicant's application, opposer adopted and used in commerce the mark "UNDERDOG ... on a variety of goods and services, namely, as an entertainment property featured on television"; that such "entertainment property has a long merchandising history, which includes, but is not limited to, the use of UNDERDOG on garments sold to men, women and children for several decades"; that opposer "is the owner of the UNDERDOG trademark, and substantially similar variations thereof (hereinafter referred to as 'UNDERDOG Marks'), including UNDERDOG, Reg. NO. 2,388,045; UNDERDOG, Reg. No. 2,457,509; UNDERDOG, Reg. No. 2,145,933; Underdog Design and Word Mark U, Reg. No. 2,517,632; Underdog Design, Reg. No. 2,388,046[;] and Underdog Design, Reg. No. 2,385,865"; that opposer, "and its related companies and predecessors in interest and licensees, have continuously used the UNDERDOG Marks, and/or variations thereof, in interstate commerce since at least as early as March 24, 1960"; that opposer's "use, via its predecessors in interest, precedes the filing date of applicant's application by over 40 years"; that applicant's mark "is highly similar to Opposer's marks in sound, meaning, appearance, and commercial impression in that the word UNDERDOG is the prominent feature of the mark"; that applicant's

[1] Ser. No. 78114516, filed on March 13, 2002, which is based on an allegation of a bona fide intention to use such mark in commerce.

mark, in addition, "includes a confusingly similar depiction of a flying dog" inasmuch as opposer's "use of its UNDERDOG [property] often includes drawings of Underdog flying"; that applicant's intended use of its mark for items of clothing "is highly related to items offered under Opposer's UNDERDOG marks"; and that "[b]ecause of the similarity of the marks and the relatedness of goods and services through overlapping audiences, the sale of garments to men, women and children under Applicant's proposed UNDERDOG trademark is likely to cause confusion, to cause mistake or to deceive the purchasing public into believing, contrary to fact, that there is an association with, sponsorship by, or license from Opposer."

Applicant, in his answer, has specifically admitted among other things that, "prior to Applicant's filing date, Opposer adopted and used in commerce a character named Underdog as a trademark [for use] as an entertainment property featured on television"; that opposer "is the owner of a muttly-looking-hound-dog superhero named Underdog"; and that "the Opposer's use of its character named Underdog often includes drawings of Underdog flying."[2] Moreover, by his failure to admit or deny, applicant has in effect admitted opposer's allegation that it is the owner of its six specifically pleaded registrations for its "UNDERDOG Marks." Fed. R. Civ. P. 8(d). Applicant, however, has denied the remaining salient allegations of the opposition,

[2] Applicant, however, denies that "its mark, beneath the underdog.com, [with] an upside-down dead Doberman Pinscher, is similar to the Opposer's mark, a muttly-hound-dog-looking superhero" and denies that "the word underdog is the prominent feature of its mark."

including in particular that "[o]pposer, its related companies and predecessors in interest and licensees have continuously used a mark for their muttly-looking-hound-dog superhero character named Underdog[,] and/or variations thereof, in interstate commerce since 1960"; and that "said entertainment property has a long merchandising history, which includes, but is not limited to, the use of Underdog on garments sold to men, women and children for several decades."

The record consists solely of the pleadings, the file of the involved application, and those exhibits accompanying opposer's notice of reliance which constitute proper subject matter under the rules of practice for a notice of reliance.[3]

[3] Curiously, the file for this proceeding contains two papers which are denominated as opposer's notice of reliance. The first of such papers was timely filed during opposer's initial testimony period on May 26, 2006 and contains 13 pages of attachments, none of which pertains to any of the referenced "[s]amples of Opposer's recent trademark use of its collective UNDERDOG trademarks on T-shirts and other garments classified in IC 25" upon which opposer purports to rely. Instead, the attachments pertain solely to the referenced "[c]opies of Opposer's trademark registrations related to Opposer's famous UNDERDOG character and proof of recordal [sic] of most recent Assignment from Golden Books Publishing to Classic Media, Inc." The second notice of reliance, in stark contrast, was belatedly filed on November 21, 2006 (after opposer's brief on the case had been submitted) and contains 54 pages of attachments. Such attachments, besides pertaining to the same two items mentioned previously, also include those in reference to the following items which were not listed as part of the notice of reliance filed on May 26, 2006: "Representative Licensing Agreements for UNDERDOG property"; "Opposer's Answers to Interrogatories No. 1-6"; "Applicant's [Informal] Answer to Notice of Opposition ..."; "Applicant's Amended Answer to Notice of Opposition ..."; and "Applicant's Answers to Interrogatories No. 1-17." However, because it was not timely submitted, opposer's second notice of reliance will be given no further consideration other than to note that, with the exception of applicant's answers to opposer's interrogatories, none of the additionally listed items constitutes proper subject matter for a notice of reliance in any event, see Trademark Rules 2.120(j)(5) and 2.122(e), and that, even if considered, the evidence attached to opposer's second notice of reliance would make no difference in the outcome of this proceeding.

Trial dates have expired without either party having taken testimony and only opposer filed a brief on the case.[4]

Of its six pleaded registrations, opposer has properly made of record only one of such registrations by submitting, with its notice of reliance, a certified copy showing that its registration for the character design mark reproduced below,

which is registered on the Principal Register for "toys, namely, action figures, toy vehicles, stuffed toys, plush toys, dolls and doll accessories, balloons, bath toys, flying saucers, cube puzzles, jigsaw puzzles, manipulative puzzles, and frame tray puzzles, board games, costume masks, hand-held unit for playing electronic games and Christmas tree ornaments" in International Class 28,[5] is subsisting and (as also admitted by applicant in

[4] As to certain of opposer's arguments set forth therein, it is pointed out that TBMP §704.06(b) (2d ed. rev. 2004) states that "[f]actual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial."

[5] Reg. No. 2,385,865, issued on September 12, 2000, which sets forth a date of first use anywhere and in commerce of November 1997; combined affidavit §§8 and 15. (Status information updated in accordance with TBMP §704.03(b)(1)(A) (2d ed. rev. 2004), which indicates in pertinent part that "when a ... registration owned by a party has been properly made of record ..., and the status of the registration changes between the time it was made of record and the time the case is decided, the Board ... will take judicial notice of, and rely on, the current status of the registration, as shown by the records of the Office.

his answer) is owned by opposer. Priority, therefore, is not in issue with respect to such mark and goods. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). As to its five other pleaded registrations, however, opposer submitted only a plain copy of each and thus failed to make such registrations, including the three for the mark "UNDERDOG," properly of record.[6] Thus, and notwithstanding

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[6] Trademark Rule 2.122(d)(2) provides in relevant part that:

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

As explained in TBMP §704.03(b)(1)(A) (2d ed. rev. 2004) (footnotes omitted; italics in original; emphasis added):

> A party that wishes to rely on its ownership of a Federal registration of its mark that is not the subject of a proceeding before the Board may make the registration of record by offering evidence sufficient to establish that the registration is still subsisting, and that it is owned by the party which seeks to rely on it. This may be done in a number of different ways.
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> ....
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> A Federal registration *owned by any party* to a Board inter partes proceeding will be received in evidence and made part of the record in the proceeding if that party files, during its testimony period, a notice of reliance on the registration, accompanied by a copy of the registration prepared and issued by the Office showing both the current status of and current title to the registration.
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> ....
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> The registration copies "prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration," as contemplated by ... [Trademark Rule] 2.122(d), are printed copies of the registration on which the Office has entered the information it has in its records, at the time it prepares and issues the status and title copies, about the current status and title of the registration. That information includes

applicant's admission in his answer of opposer's ownership thereof, priority is in issue with respect to the marks and associated goods and services which are the subjects of such registrations. Opposer has offered no proof, however, to establish its use thereof on or prior to the March 13, 2002 filing date of applicant's application, which is the earliest date upon which applicant, in the absence of any testimony or other proof that he has commenced use of his mark, is entitled to rely in this proceeding. See, e.g., Lone Star Mfg. Co., Inc. v. Bill Beasley, Inc., 498 F.2d 906, 182 USPQ 368, 369 (CCPA 1974); Columbia Steel Tank Co. v. Union Tank & Supply Co., 277 F.2d 192, 125 USPQ 406, 407 (CCPA 1960); Zirco Corp. v. American Tel. & Tel. Co., 21 USPQ2d 1542, 1544 (TTAB 1991); and Miss Universe, Inc. v. Drost, 189 USPQ 212, 213 (TTAB 1975). Such registrations therefore need be given no further consideration. Finally, as to prior common law rights, we again note that applicant has admitted only that, "prior to Applicant's filing date, Opposer adopted and used in commerce a character named Underdog as a trademark [for use] as an entertainment property featured on television." No proof, however, has been offered by opposer as to any of the additional common law rights which were pleaded in the opposition.

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information about the renewal, cancellation ...; affidavits or declarations under Sections 8, 15 and 71 of the Act ...; and recorded documents transferring title. **Plain copies of the registration, and the electronic equivalent thereof, such as printouts of the registration from the electronic records of the Office's trademark automated search system, are not sufficient.**

Turning to the issue of likelihood of confusion between applicant's mark for his goods and those marks of opposer for its goods and services for which priority is, respectively, either not in issue or has been admitted, we find that opposer has failed to prove that it is entitled to relief. Plainly, the character design mark which is the subject of the sole pleaded registration which is properly of record looks nothing like the dog design in applicant's mark, much less such mark when considered as a whole, including the wording "BENEATH THE UNDERDOG.COM." Thus, irrespective of the absence of any evidence showing that applicant's articles of clothing are commercially or otherwise related in the minds of consumers to opposer's various toys, applicant's mark does not so resemble opposer's character design mark in appearance, sound, connotation or overall commercial impression that confusion as to the source or sponsorship of such goods would be likely to occur. While, as to opposer's prior common law rights in "a character named Underdog as a trademark [for use] as an entertainment property featured on television," suffice it to say that even if applicant's "BENEATH THE UNDERDOG.COM" and design mark for articles of clothing were considered, because of the shared presence of the word "UNDERDOG," to be sufficiently similar in sound, appearance, connotation and/or overall commercial impression to a character named Underdog which is used as a service mark for a television entertainment property, there is no proof on this record that consumers would view applicant's goods as collateral products emanating from or sponsored by opposer's television entertainment

property. Absent proof, for example, that consumers are accustomed to encountering such merchandising of products in connection with television entertainment properties, there is no basis to find such goods and services to be commercially or otherwise related and, hence, a likelihood of confusion as to origin or affiliation has not been demonstrated.

Accordingly, because opposer, as the party bearing the burden of proof in this proceeding,[7] has failed on this record to establish that there is a likelihood of confusion, it is adjudged that opposer cannot prevail on its claim of priority of use and likelihood of confusion and that the opposition must fail.

**Decision**: The opposition is dismissed.

[7] It is settled that opposer, as the plaintiff in this proceeding, bears the burden of proof with respect to its claim of priority of use and likelihood of confusion. See, e.g., Bose Corp. v. QSC Audio Products Inc., 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002) ["[t]he burden of proof rests with the opposer ... to produce sufficient evidence to support the ultimate conclusion of [priority of use] and likelihood of confusion"]; Hoover Co. v. Royal Appliance Mfg. Co., 238 F.3d 1357, 57 USPQ2d 1720, 1722 (Fed. Cir. 2001) ["[i]n opposition proceedings, the opposer bears the burden of establishing that the applicant does not have the right to register its mark"]; Champagne Louis Roederer S.A. v. Delicato Vineyards, 143 F.3d 1373, 47 USPQ2d 1459, 1464 (Fed. Cir. 1998) (Michel, J. concurring); Sanyo Watch Co., Inc. v. Sanyo Elec. Co., Ltd., 691 F.2d 1019, 215 USPQ 833, 834 (Fed. Cir. 1982) ["[a]s the opposer in this proceeding, appellant bears the burden of proof which encompasses not only the ultimate burden of persuasion, but also the obligation of going forward with sufficient proof of the material allegations of the Notice of Opposition, which, if not countered, negates appellee's right to a registration"]; and Clinton Detergent Co. v. Proctor & Gamble Co., 302 F.2d 745, 133 USPQ 520, 522 (CCPA 1962) ["[o]pposer ... has the burden of proof to establish that applicant does not have the right to register its mark"]. It remains opposer's obligation to satisfy its burden of proof, regardless of whether applicant offers any evidence.