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Mailed: October 24, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Monster Cable Products, Inc.
v.
Euroflex S.R.L.

Opposition No. 91161150

Brent A. Capehart and Robert W. Payne of LaRiviere, Grubman & Payne, LLP for Monster Cable Products, Inc.

John S. Egbert of Egbert Law Offices for Euroflex S.R.L.

Before Quinn, Holtzman and Rogers, Administrative Trademark Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Euroflex S.R.L. (applicant) has filed an application to register the mark shown below for "multi-purpose steam cleaners for domestic use" in Class 7.¹

monster

Monster Cable Products, Inc. (opposer) filed a notice of opposition on the ground of priority and likelihood of

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confusion.² Opposer alleges that it has used the mark MONSTER in connection with goods "such as electrical and musical items," since May 18, 1978, long prior to the filing date of the involved application. Opposer has also asserted ownership of 50 registrations for marks that consist of or include the term "MONSTER." Opposer alleges that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used and registered "MONSTER" marks and family of "MONSTER" marks as to be likely to cause confusion.

The registrations pleaded by opposer include the following: Registration No. 1342164 for the mark MONSTER CABLE ("Cable" disclaimed) for "electrical signal transmitting cable and connectors therefor" in Class 9; Registration No. 2197793 for the mark MONSTER for "newsletters, magazines, catalogs and newspapers providing entertainment industry and cable industry news" in Class 16; Registration No. 1690903 for the mark MONSTER STYLE for "educational services, namely, conducting classes and seminars in the field of audio systems" in Class 41; Registration No. 1340229 for the mark MONSTER CABLE ("Cable" disclaimed) for "musical and voice signal transmitting cable and connectors therefor" in Class 9; Registration No. 1537306 for the mark MONSTER MUSIC ("Music" disclaimed) for "compact discs" in class 9; Registration No.

¹ Application Serial No. 78260191, filed June 9, 2003, based on an allegation of a bona fide intention to use the mark in commerce.

² Opposer also alleges dilution as a ground for opposition. Inasmuch as opposer submitted no argument on this claim, the claim will be given no further consideration.

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1812892 for the mark MONSTER CONNECTION for "newsletter about consumer electronics" in Class 16; Registration No. 2215211 for the mark MONSTER MICROPHONE ("Microphone" disclaimed) for "microphones" in Class 9; Registration No. 2213346 for the mark MONSTER POWER ("Power" disclaimed) for "batteries, power strips, power line conditioners, and electrical power extension cords" in Class 9; and Registration No. 2627042 for the mark MONSTER for "clothing, namely, sweatshirts, t-shirts, pants, jackets and caps" in class 25.

Applicant, in its answer, has denied the salient allegations in the notice of opposition.

The record includes the pleadings and the file of the involved application. In addition, opposer has submitted the testimony, with exhibits, of Rusty Everett, opposer's director of product development. Applicant did not attend the deposition. Applicant filed a notice of reliance on opposer's responses to interrogatories and opposer's written responses to applicant's document requests. Both parties have filed briefs, and each party has raised objections in its brief to the evidence submitted by the other.

As background for some of these objections, the Board on January 4, 2007, granted, as conceded, applicant's motion to strike all six of the notices of reliance filed by opposer during its testimony period. These notices of reliance included soft copies of opposer's pleaded registrations and applicant's

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responses to opposer's interrogatories and admission requests. Over two months later, on March 19, 2007, opposer filed a request for reconsideration of that order, which the Board, on April 4, 2007, denied as untimely under Trademark Rule 2.127(b).³

Opposer argues that because the notice of reliance on applicant's discovery responses was stricken by the Board, applicant likewise should be precluded from relying on opposer's discovery responses. Opposer maintains that the Board, in granting the motion to strike, "must have agreed [that the documents were improper], notwithstanding clear authority to the contrary." Reply Brief, p. 4.

Opposer did not file a response to the motion to strike, and the Board, in the exercise of its discretion and as permitted by Trademark Rule 2.127(a), granted the motion as conceded.⁴ The Board made no determination as to the merits of applicant's arguments or whether its reasons for the motion to strike were valid. Nor, under the circumstances, was the Board required to do so. Thus, opposer's objection on this basis is overruled.⁵

³ Opposer filed the request for reconsideration concurrently with its brief on the case.

⁴ Trademark Rule 2.127(a) provides in relevant part that "When a party fails to file a brief in response to a motion, the Board may treat the motion as conceded."

⁵ We note that Trademark Rule 2.120(j)(3)(ii) does not prohibit introduction of written responses to requests for production, and that, in any event, opposer did not object to the evidence on this basis. See, e.g., *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718, 1722 n.6 (TTAB 1998).

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In addition, opposer has objected to applicant's submission arguing that although applicant "did file copies" of the discovery responses, the documents were not accompanied by a notice of reliance as required by Trademark Rule 2.120(j). Brief, p. 2. This objection is denied as untimely, having been raised for the first time in opposer's brief. See *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1291 (TTAB 1986) (objection waived where respondent received notice of reliance without referenced publications appended thereto but did not raise the issue until briefing); and TBMP 707.02(b) (2nd ed. rev. 2004). Furthermore, the objection is not well taken on its merits. The record shows that the discovery responses filed with the Board were indeed accompanied by the required notice of reliance. We also note that opposer does not dispute that it received a service copy of at least the documents submitted under the notice of reliance.

Applicant, for its part, has objected to Exhibits A-D to the deposition of Mr. Everett, which consist of printouts from the websites of bestbuy.com and target.com, arguing that opposer did not provide proper authentication for their introduction. This is a deficiency that could have been cured if the objection had been timely raised during the deposition. The objection is therefore waived. See *Pass & Seymour, Inc. v. Syrelec*, 224 USPQ 845, 847 (TTAB 1984) (objection on grounds of improper identification or authentication of exhibits waived since defects

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could have been cured if made during the deposition); and TBMP §707.03(b)(1) (2nd ed. rev. 2004).

Applicant has also objected to these exhibits on the ground that such documents were not produced by opposer during discovery. The objection on this basis is not well taken.⁶ First, applicant has not pointed to the relevant request that would have sought such documents. Furthermore, this is not a situation where opposer refused to produce the documents or indicated that the documents did not exist. In fact, opposer did not provide any substantive answers to the document requests, but instead responded to the requests with general and specific objections. If applicant believed that the objections were unwarranted, applicant should have filed a motion to compel. See *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197, 1201 (TTAB 1993) (where applicant gave partial answers and otherwise objected to requests as cumulative or burdensome but opposer did not file motion to compel, modify discovery requests, or otherwise pursue material, evidence introduced by applicant at trial was considered), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994).

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⁶ However, contrary to opposer's contention, this objection is not waived by applicant's failure to appear at the deposition because the deficiency is not one that could have been cured even if it had been raised at that time.

We turn then to the merits of opposer's claim, and first to the question of priority. Opposer has submitted, in connection with the testimony of Mr. Everett, plain photocopies of opposer's 50 pleaded registrations, as well as TESS and TARR printouts of those registrations.⁷ Applicant objected to this evidence on the ground that the evidence was previously stricken by the Board and because the registrations were not properly introduced during testimony by opposer's witness. Opposer, on the other hand, argues that "this type of objection is directed toward alleged improper identification, which is an error that could have been cured had [applicant] attended the deposition and made it at that time." Reply Brief, p. 2.

Contrary to applicant's apparent belief, the fact that the notice of reliance on opposer's registrations was previously stricken by the Board (as conceded) does not preclude opposer from properly making the registrations of record through some other means. Thus, the only question here is whether the registrations have been properly introduced.

Under the Trademark Rules, a party basing its claim of damage on ownership of a pleaded registration may make the registration of record in any one of several ways. See Trademark Rule 2.122(d). One way is for the party to identify and

⁷ Opposer also submitted copies of several registrations which were not pleaded in the notice of opposition. For reasons which will become apparent, these registrations need not be addressed.

introduce a status and title copy of the registration through the testimony of a witness having knowledge thereof, or the witness,

through testimony, may establish the current status of the registration and that it is owned by the party.⁸

Opposer has not followed the proper procedure for introducing copies of its registrations. First, neither plain photocopies of the registrations nor TESS/TARR printouts of the registrations constitute proper status and title records as contemplated by Trademark Rule 2.122(d). Furthermore, no testimony was elicited from Mr. Everett as to opposer's ownership of the registrations or as to their validity. Mr. Everett was simply asked to identify the mark and indicate as to each registration whether the mark is still in use, which is all he did. In fact, according to Office records, at least one of the registrations (Registration No. 1824258) was cancelled long prior to the deposition and other registrations (for example, Registration Nos. 1738114 and 2227322) show title to be in the name of an entity other than opposer.

⁸ The Board's new rules allow proof of a pleaded registration by submission of a "current printout of information from the electronic database records of the USPTO showing the current status and title of the registration" as an alternative to submission of a status and title copy of the registration. See Trademark Rule 2.122(d); 37 CFR §2.122(d) (effective August 31, 2007, by Final Rule Notice, 72 Fed. Reg. 42242 (August 1, 2007)). However, the rule, as now amended,

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Contrary to opposer's contention, applicant did not waive this objection by failing to attend the deposition and object at that time. This is distinguished from the situation discussed earlier regarding an inadequate foundation for evidence where opposer had a reasonable expectation that the evidence was properly of record. By contrast, opposer may not reasonably presume evidence is of record when that evidence is not offered in accordance with the Trademark Rules. Original Appalachian Artworks Inc. v. Streeter, 3 USPQ2d 1717, 1717 n.3 (TTAB 1987). See Trademark Rule 2.123(1) ("Evidence not obtained and filed in compliance with [the rules of practice governing inter partes proceedings] will not be considered"); and Hard Rock Cafe International (USA), Inc. v. Thomas D. Elsea, 56 USPQ2d 1504, 1511 (TTAB 2000) ("It was opposer's burden, if it wished to rely on its registrations to establish priority, to provide evidence as to the status as well as the title of those registrations as part of its testimony-in-chief" and noting that "although applicant first objected in its trial brief to the staleness of the registrations, he was under no obligation to point out to opposer, during Mr. Coutu's testimony deposition, that opposer had not elicited testimony from Mr. Coutu as to the current status of the registrations"). See also Industrial Adhesive Company v. Borden, Inc., 218 USPQ 945, 948 (TTAB 1983) ("There can be no doubt but that these portions of the Trademark Rules of

applies only to cases filed on or after the effective date of August

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Practice providing for the introduction into evidence of a plaintiff's pleaded registrations are mandatory rather than permissive in nature").

Although opposer cannot rely on the registrations to remove priority as an issue in this case, opposer is still entitled to rely on any common law rights in the registered marks, to the extent the record shows actual prior use of the registered marks for particular goods or services. However, the extent of Mr. Everett's testimony in this regard is limited to indicating current use of the marks in each registration ("it's actually still in active use" (Dep., p. 11); "yes, we are still using that mark" (Id.); "That is also a mark that we're using today" (Id., p. 12); etc.). There is no testimony or other evidence as to when the marks were first used, or whether the marks were used prior to the filing date of the involved application.

Opposer has failed to properly introduce any evidence that its mark was used prior to the June 19, 2003 filing date of the involved application. Accordingly, inasmuch as we find that opposer has not established its priority, opposer cannot prevail on its claim of likelihood of confusion.⁹

Decision: The opposition is dismissed.

31, 2007 and it is not applicable here.

⁹ Opposer's baseless argument that Trademark Rule 2.132 should apply to applicant has not been considered. We also point out that the burden is on opposer, as plaintiff in the proceeding, to come forward with proof of the essential elements of its claims, regardless of whether applicant offers any evidence.