

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

jk

Mailed: March 16, 2009

Opposition No. 91164764

BRINK'S NETWORK, INCORPORATED

v.

THE BRINKMANN CORPORATION

**Hairston, Kuhlke and Ritchie,
Administrative Trademark Judges.**

By the Board:

The Brinkmann Corporation ("applicant") seeks registration of the mark BRINKMANN, in standard characters, for goods in International Classes 4, 6, 7, 8, 9, 11, 12, 21 and 30.¹ Brink's Network, Incorporated ("opposer") has opposed registration of the mark for the International Class 9 goods identified as "home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets; batteries; wall mount brackets for battery chargers and flashlights, cooking thermometers," and pleads ownership of nine registrations for the marks BRINKS, BRINK'S, and BRINKS HOME SECURITY, ("BRINKS mark" or "BRINKS marks") registered for various commercial and residential

¹ Application Serial No. 76483115, filed January 17, 2003, for the mark BRINKMANN, alleging a June 12, 1978 date of first use

security related systems, products and services.² Opposer asserts the grounds of priority and likelihood of confusion under Trademark Act Section 2(d), and dilution under Trademark Act Section 43(c).

In its answer, applicant denied the salient allegations in the notice of opposition, and asserted the affirmative defense of laches.

This proceeding is before the Board for consideration of opposer's motion (filed August 12, 2008) for partial summary judgment dismissing applicant's laches defense, and applicant's motion (filed September 25, 2008) for partial summary judgment to dismiss opposer's dilution claim. The motions are fully briefed.

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material facts, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

and date of first use in commerce on the goods in International Class 9.

² Specifically, opposer pleads ownership of the Registration No. 2476114 (BRINKS HOME SECURITY), Registration No. 1313790 (BRINKS), Registration No. 529622 (BRINKS), Registration No. 1309375 (BRINK'S), Registration No. 1412587 (BRINK'S HOME SECURITY), Registration No. 1411610 (BRINKS), Registration No. 2330884 (BRINKS HOME SECURITY), Registration No. 2691470 (BRINK'S), and Registration No. 2646784 (BRINKS).

Opposer's motion for partial summary judgment

Opposer seeks judgment as a matter of law with respect to applicant's laches defense, asserting that, inasmuch as the time period for calculating the essential element of unreasonable delay runs from the date the mark was published for opposition, there is no genuine issue that applicant cannot establish this element, and thus cannot maintain its defense. Specifically, opposer argues that a period of six months, that is, from October 5, 2004, the date the subject mark was published for opposition, to April 1, 2005, the date opposer filed its opposition, is insufficient to establish that opposer unreasonably delayed in asserting its claims.

In response, applicant argues that its laches defense is viable against opposer's claims of likelihood of confusion and dilution because determination of delay for laches purposes may be based on opposer's failure to oppose or otherwise object to applicant's prior registration of substantially the same mark for substantially the same goods, citing *e.g.*, *Aquion Partners L.P. v. Envirogard Products Ltd.*, 43 USPQ2d 1371 (TTAB 1997). Specifically, applicant asserts that it can establish unreasonable delay inasmuch as opposer did not object to either of applicant's two prior registrations, Registration No. 1153730 for the mark BRINKMANN for "electrical extension cords, brackets, and electric connectors for use therewith" in International

Class 9, and "charcoal fired and electric roasting, grilling and barbecue cookers for domestic use and portable electric lights and filters, and replacement lamps" in International Class 11, or Registration No. 2779986 for the mark BRINKMANN BACKYARD KITCHEN (BACKYARD KITCHEN disclaimed) for "combined outdoor grill and kitchen appliance units comprised of gas grills, sinks and coolers" in International Class 11.

In reply, opposer maintains that applicant cannot rely on either of its existing registrations inasmuch as the goods covered therein are not the same or substantially the same as those which are subject to the current opposition.

The affirmative defense of laches is generally not available in opposition proceedings before the Board. See, e.g., *Turner v. Hops Grill & Bar Inc.*, 52 USPQ2d 1310 (TTAB 1999). Under certain limited circumstances, the equitable defense of laches in an opposition proceeding may be based on opposer's failure to object to an earlier registration of substantially the same mark for substantially the same goods. See *Aquion Partners*, *supra* at 1373, and cases cited therein. In this case, however, we find no genuine issue that the goods subject to opposition are not substantially the same as the goods covered in applicant's two prior registrations. Accordingly, applicant cannot rely on either of its prior registrations to establish that opposer

unreasonably delayed in asserting its rights against opposer's BRINKMANN mark.

In this proceeding, the element of delay for laches purposes runs from the date the mark in the application was published for opposition. *See National Cable Television Association Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991). Applicant cannot, as a matter of law, establish unreasonable delay, and thus cannot assert the affirmative defense of laches against opposer's grounds of likelihood of confusion or dilution.³

We find that opposer has met its burden of demonstrating that no genuine issue of material fact exists with respect to whether applicant can maintain laches as an affirmative defense. Accordingly, opposer's motion for partial summary judgment dismissing applicant's laches defense is hereby granted, and applicant's affirmative defense is stricken from its answer.

Applicant's motion for partial summary judgment

To the extent that applicant moves for summary judgment on the basis that its laches defense defeats opposer's claim that the mark BRINKMANN dilutes or is likely to dilute the

³ Moreover, the six month period between the publication date of October 5, 2004 and the opposition filing date of April 1, 2005 is insufficient to establish unreasonable delay for purposes of applicant's laches defense. *See, e.g. Charrette Corp. v. Bowater Communication Papers Inc.*, 13 USPQ2d 2040 (TTAB 1989) (14-month delay is insufficient); *Ralston Purina Company v. Midwest Cordage Company, Inc.*, 153 USPQ 73 (CCPA 1967) (six-month delay is insufficient in the absence of substantial prejudice); *Plymouth*

distinctiveness of opposer's BRINKS mark, applicant's motion is denied in view of our determination that, under the circumstances in this case, the affirmative defense is not available to applicant. Furthermore, we find unpersuasive applicant's argument that opposer cannot prevail on its dilution claim because it opposes registration of BRINKMANN for only some of applicant's identified goods. Applicant cites no case law in support of its position, no such requirement is imposed, and the USPTO treats each international class of goods or services in a multi-class application as a separate application.

To prevail on a claim of dilution under Trademark Act Section 43(c), an opposer must demonstrate that its mark is famous, that its mark became famous prior to applicant's use of the opposed mark, and that use of applicant's mark is likely to dilute the distinctive quality of opposer's mark. *See Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1173 (TTAB 2001).

To the extent that applicant moves for summary judgment on the merits of opposer's dilution claim, applicant has not met its burden of demonstrating that opposer cannot prove the elements of its dilution claim. Inasmuch as the record includes the declaration of applicant's president indicating that applicant has used the BRINKMANN mark on a variety of consumer products since 1975, as well as the declaration of a former supervisor, manager and curator of opposer indicating

Cordage Company v. Solar Nitrogen Chemicals, Inc., 152 USPQ 202 (TTAB 1966) (three-year delay is insufficient).

that opposer used the BRINK'S mark to promote various products as early as 1950, applicant has not met its burden of showing that no genuine issue of material fact remains with respect to the element of whether opposer's BRINKS mark became famous prior to applicant's use of its BRINKMANN mark. See *Toro Co. v. ToroHead Inc.*, *supra*. Thus, applicant has not made a sufficient showing to support judgment in its favor.

We cannot conclude that applicant is entitled to judgment as a matter of law with respect to the dilution claim, and applicant's motion for partial summary judgment to dismiss opposer's claim of dilution is denied.⁴

Schedule

Proceedings are hereby resumed. The close of discovery, and testimony periods, are reset as follows:

DISCOVERY PERIOD TO CLOSE:	05/29/09
30-day testimony period for party in position of plaintiff to close:	08/27/09
30-day testimony period for party in position of defendant to close:	10/26/09
15-day rebuttal testimony period to close:	12/10/09

⁴ The fact that we have identified a genuine issue of material fact in denying applicant's motion for summary judgment should not be construed as a finding that such issue is necessarily the only issue that remains for trial. Also, the parties should note that the evidence submitted in connection with the motions for summary judgment is of record only for consideration of those motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400 (TTAB 1998); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>