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

Proceeding	91164764
Party	Plaintiff Brink's Network, Incorporated
Correspondence Address	ALAN S COOPER HOWERY SIMON ARNOLD & WHITE LLP 1299 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004 UNITED STATES lapidusn@howrey.com, ipdocketing@howrey.com, figginsl@howrey.com
Submission	Reply in Support of Motion
Filer's Name	Alan S. Cooper
Filer's e-mail	IPDocketing@howrey.com, CooperA@howrey.com, MyersT@howrey.com, RenneM@howrey.com
Signature	/alan s. cooper/
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BRINK'S NETWORK, INCORPORATED)
)
 Opposer)
)
 vs.) Opposition No. 91164764
)
BRINKMANN CORPORATION)
)
 Applicant)

REPLY MEMORANDUM IN SUPPORT OF OPPOSER'S
MOTION FOR SUMMARY JUDGMENT DISMISSING
APPLICANT'S PRIOR REGISTRATION DEFENSE

I. INTRODUCTION

The prior registration defense articulated in *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969), has been an established part of jurisprudence in *inter partes* proceedings before the Board for more than forty years. In opposing Opposer's motion for partial summary judgment, Applicant takes the position that the Board should recognize some analogous "prior registration" defense applicable only to dilution claims under § 43(c) of the Federal Trademark Act. However, even apart from the fact that the prior registration predicate for this defense based on Applicant's prior registrations was rejected by the Board in its Order of March 16, 2009, the fundamental flaw is that Applicant's new "modified" *Morehouse* defense directed to dilution is principally predicated on the existence of third-party registrations, rather than use of any third-party marks, which is a fundamentally insufficient evidentiary basis for challenging a dilution claim.

For these and other reasons discussed below, the Board should decline Applicant's invitation to create a new defense to dilution based on prior registrations owned by Applicant and/or third parties.

II. ARGUMENT

A. THERE ARE NO GENUINE MATERIAL FACTS IN DISPUTE

Contrary to Applicant's position, there are no material facts in dispute with respect to the present motion.¹ Rather, the present motion presents only a legal issue: is the "prior registration" affirmative defense pleaded in ¶ 28 of Applicant's Answer a legally cognizable defense to a § 43(c) dilution claim in an opposition context. As discussed below, that issue should be resolved in the negative.

B. PRIOR REGISTRATIONS ARE AN INSUFFICIENT BASIS FOR CHALLENGING A § 43(c) DILUTION CLAIM

A party asserting a § 43(c) dilution claim in an opposition proceeding has the burden of proving, *inter alia*, that the use of the mark which is the subject of the opposed application in connection with the goods or services described therein is likely to cause dilution. *E.g.*, *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1727 (TTAB 2007); *Toro Co. v. ToroHead, Inc.*, 61 USPQ2ds 1164, 1173 (TTAB 2001). In determining whether dilution by blurring is likely, § 43(c)(2)(B) lists six factors that are appropriate for consideration. In the context of Applicant's arguments contesting the present motion, the most relevant factor is

¹ The origin of the *Morehouse* defense as discussed at p. 9 of Applicant's Memorandum does not rise to the level of a genuine issue of material fact.

set forth in § 43(c)(2)(B)(iii), namely, the extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark alleged to be diluted.²

The weight given to the § 43(c)(2)(B)(iii) factor depends on whether there is evidence showing that the opposer has not engaged in substantially exclusive use of its mark. To the extent that an applicant contends that the opposer has not made substantially exclusive use of its mark, that contention is highly analogous to attacking the strength of the opposer's mark in a likelihood of confusion context by showing that there is relevant third-party use of the same or similar marks. It is well settled in a likelihood of confusion context that evidence consisting merely of third-party registrations is not an acceptable basis for challenging the strength or scope of protection of the party-plaintiff's mark because such registrations are not evidence that the third-party marks are in use and that they have had some limiting impact on the scope of protection of the opposer's mark. *E.g., San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683 (CCPA 1977); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915 (CCPA 1976); *In re Helene Curtis Industries, Inc.*, 305 F.2d 492 (CCPA 1962); *see also, Waples-Platter Cos. v. General Foods Corp.*, 439 F. Supp. 551 (N.D. Tex. 1977); *Chips 'n Twigs, Inc. v. Chip-Chip, Ltd.*, 414 F. Supp. 1003 (E.D. Pa. 1976).

² Applicant's Memorandum, at p. 2, essentially acknowledges this point by arguing that the dilution claim is precluded because "Opposer has failed to challenge Applicant Brinkmann's other registrations for its BRINKMANN and BRINKMANN-formative marks, not to mention numerous third-party registrations of BRINK-formative marks." Also, at p. 11 of its Memorandum, Applicant specifically acknowledges that the § 43(c)(2)(B)(iii) factor should be considered in determining whether dilution is likely.

The lack of probative value of third-party registrations in a likelihood of confusion context was clearly stated as follows in the case of *Scarves by Vera, Inc. v. Todo Imports, Ltd.*, 544 F.2d 1167, 1173 (2d Cir. 1976), quoting in part from *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324 (CCPA 1967):

“The significance of third-party [registrations of] trademarks depends wholly upon their usage. Defendant introduced no evidence that these trademarks were actually used by third parties, that they were well-promoted or that they were recognized by consumers. . . . ‘[T]he existence of these registrations is not evidence of what happens in the market place or that customers are familiar with their use.’”

Similarly, in *Express Funding, Inc. v. Express Mortgage, Inc.*, 894 F. Supp. 1095, 1101 (E.D. Mich. 1995), the District Court held that third-party registrations do not evidence weakness of the plaintiff’s mark where nothing in the record “allows the Court to determine if the marks are actually in use, what services are provided by the owners of the marks, or the geographic areas in which the marks are used”.

The same conclusion has been reached in numerous decisions in an *inter partes* proceeding context by the U.S. Court of Appeals for the Federal Circuit and its predecessor court. This point was clearly stated in the concurring opinion of Chief Judge Markey in *In re Clorox Co.*, 578 F.2d 305, 311 (CCPA 1978):

“Third party registrations are often cited in an effort to prove that, because the marks appearing in those registrations are similar to the mark in use by an applicant, an opposer, or cancellation petitioner, the public has learned to distinguish among them and would not be confused by the addition to the marketplace of the mark sought to be registered or by continued use of the mark sought to be maintained on a register. *Whether the public has been so conditioned turns on whether it has been actually exposed to the similar third party marks in the marketplace, and on the extent and*

intensity of that exposure. A registration does not inherently evidence that exposure, and the presumption that registered marks of third parties are in use does not clothe the cited registrations with that evidentiary effect." (Emphasis added)

See also, Smith Bros. Mfg. Co. v. Stone Mfg. Co., 476 F.2d 1004 (CCPA 1973).

The Board similarly has held that third-party registrations "do not provide evidence that the marks have been used to such an extent that customers have become accustomed to seeing the marks and hence have learned to distinguish them based on minor differences in the marks." *ProQuest Information and Learning Company v. Jacques R. Island*, 83 USPQ2d 1351, 1357 (TTAB 2007); *see also, In re Hub Distributing, Inc.*, 218 USPQ 284, 286 (TTAB 1983) ("third party registration evidence proves nothing about the impact of the third-party marks on purchasers in terms of dilution of the mark in question"); *American Hospital Supply Corp. v. Air Products & Chemicals, Inc.*, 194 USPQ 340, 343 (TTAB 1977). This point is well-stated in Sams, "Third Party Registrations in T.T.A.B. Proceedings," 72 *Trademark Rep.* 297, 299 (1982):

"One of the principal shortcomings of third party registrations is their failure to serve as evidence of the extent to which the mark shown on the registration certificate actually has been used. Certificates of registration offered to show use of terms, words etc. and/or public familiarity with them are no evidence at all. The registrations establish only what appears on their faces: the registrants made application to the Patent and Trademark Office claiming that they had adopted and used the marks shown in commerce and the registrations were granted."

The Board considered the impact of the lack of evidence of use of third-party marks in a dilution context in *7-Eleven Inc. v. Wechsler, supra*, which involved an opposition to an intent-to-use application to register the mark GULPY

based in part on a claim of likelihood of dilution. After determining that the opposer's mark BIG GULP is famous for dilution purposes, the Board turned to a consideration of whether dilution is likely based on an analysis of the relevant § 43(c)(2)(B) dilution by blurring factors. The Board found that the § 43(c)(2)(B)(iii) substantially exclusive use factor favored the opposer because although the applicant did rely on third-party registrations, it failed to present any evidence showing the nature and extent of the third-party use which precluded any assessment as to whether any such use has any impact on the relevant public perceptions. 83 USPQ2d at 1729. Similarly, in *Coach Services, Inc., v. Triumph Learning LLC*, 96 USPQ2d 1600 (TTAB 2110), the Board noted that while the applicant introduced 25 third-party registrations of marks that included the word "Coach," it did not introduce any evidence with respect to the extent of the use and promotion of such marks. Based on the lack of evidence of such use, the Board concluded that "we cannot assess whether third-party use has been so widespread as to have had any impact on consumer perceptions." 96 USPQ2d at 1614. These decisions fundamentally contradict the argument at p. 16 of Applicant's Memorandum that Applicant's prior registrations of BRINKMANN and "[t]he various third-party registrations for the formative BRINK have presumably 'diluted' Opposer's mark"

Applicant's "prior registration" defense is predicated solely on prior registrations of marks owned by Applicant and third parties. There is no allegation in ¶ 28 that such marks are in use, much less that they are being used in such a manner as to have some negative impact on the public perception of

Opposer's pleaded marks that would defeat a dilution claim based on the § 43(c)(2)(B)(iii) substantially exclusive use factor.

Opposer does not disagree with the general statements at pp. 10-13 of Applicant's Memorandum regarding the general nature of a § 43(c) dilution claim. However, Opposer respectfully submits that Applicant's reliance on evidence consisting solely of prior registrations is totally misplaced in a dilution context because such registrations, as established by well-settled precedent, are not probative evidence that the marks covered by those registrations are in use or have had some negative impact on the public perception of Opposer's marks, much less establish that Opposer's use of the mark BRINK'S in various forms has not been substantially exclusive. Thus, the registrations relied upon by Applicant are a fundamentally flawed premise for the assertion at p. 18 of Applicant's Memorandum that "[t]here simply cannot be any 'dilution' of an already diluted mark"³

Accordingly, Applicant's effort to establish a new defense to a § 43(c) dilution claim based on prior registrations is misplaced as a matter of law and

³ Applicant's reliance on *Astra Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 220 USPQ 786 (1st Cir. 1983), is misplaced because the Court of Appeals relied on both third-party registrations and usage of that mark ASTRA in reaching its conclusion regarding the diminished uniqueness of the plaintiff's mark. Applicant's "prior registration" defense as pleaded in ¶ 28 of its Answer does not encompass evidence of such use. Moreover, the *Astra* decision is clearly distinguishable because the court was applying the Massachusetts Anti-Dilution Statute, not § 43(c), and was focused on the dissimilarity of plaintiff's and defendant's goods as precluding both likelihood of confusion and dilution. Indeed, the decision predates the enactment of § 43(c) by thirteen years. Thus, the case is irrelevant in a § 43(c) context where, as Brinkmann recognizes, dilution may be likely when the goods are essentially dissimilar.

should be rejected by the Board, as it has rejected other improper defenses to a dilution claim.⁴

C. THE MARCH 16, 2009 ORDER IS RELEVANT TO THE CURRENT MOTION AND HAS LAW OF THE CASE EFFECT

The Order entered on March 16, 2009 (“Order”) rejected Applicant’s contention that Opposer cannot prevail on its dilution claim because the present opposition is not directed to all of the goods in the opposed application and Opposer did not contest Applicant’s earlier registrations of BRINKMANN for goods different from those which are the subject of the opposition. The Order was based on Applicant’s failure to cite any case law to support its position and the fact that the USPTO treats each international class of goods in a multi-class application as a separate application.

To the extent that the Order rejected Applicant’s reliance on its prior registrations of BRINKMANN as a basis for contesting Opposer’s dilution claim based on laches or any other ground, that Order is clearly relevant to the present motion. Moreover, the Order is clearly entitled to substantive weight under the law of the case doctrine. This doctrine does not only apply to final decisions.⁵ Instead, the law of the case doctrine recognizes that litigation proceeds through multiple stages. *See Arizona v. California*, 460 U.S. 605, 618 (1983) (noting that

⁴ *See American Express Marketing & Development Corp. v. Gilad Development Corp.*, 94 USPQ2d 1294 (TTAB 2010) (noncommercial use defense is not available in an opposition proceeding).

⁵ The case cited by Applicant for this proposition, *Moses H. Cone Mem. Hosp. v. Mercury Construction Corp.*, 460 U.S. 1 (1983), concerned whether a District Court order was final for purposes of appellate jurisdiction and did not make mention of the law of the case doctrine.

the law of the case doctrine was crafted with the course of ordinary litigation in mind and that litigation proceeds through preliminary stages, trial, and final judgment). A court's decision on a rule of law at one stage of the litigation should thus "continue to govern the same issues in subsequent stages in the same case." *Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800, 815-816 (1988). The law of the case doctrine is applicable only *until* final judgment has been entered in the case. 18 *Moore's Federal Practice*, § 134.20[2] ("After a final judgment has been entered, a court's ability to grant relief from the judgment is governed by the rules pertaining to direct and collateral attack on the judgment and habeas corpus procedures."). And while the doctrine does allow some flexibility to revisit a previously decided issue of law, "as a rule courts should be loathe to do so in the absence of extraordinary circumstances." *Christianson v. Colt Indus. Operating Corp.*, 486 U.S. at 816.

At pp. 17 and 20-21 of its Memorandum, Applicant asserts that the Order constitutes an incorrect ruling. Applicant's mere assertion does not rise to the requisite level of "extraordinary circumstances". Equally important, any request for reconsideration or modification of the Order is clearly untimely because any such request with respect to a Board decision on a motion must be filed within one (1) month from the date of the decision. See Rule 2.127(b) of the Trademark Rules of Practice, 37 CFR § 2.127(b); *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000).⁶ Moreover,

⁶ At p. 19 of its Memorandum, Applicant also attacks as improper the Board's decision of November 18, 2010, granting Opposer's motion for leave to file the Third Amended Notice of Opposition. That attack similarly is precluded by Rule 2.127(b).

Applicant has not presented any showing of excusable neglect as required by Rule 6(b)(2) Fed. R. Civ. P. to obtain any extension of the Rule 2.127(b) deadline after that due date has expired.

III. CONCLUSION

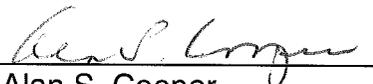
Applicant's attack on the present motion as a misguided effort on the part of Opposer to prolong this opposition proceeding is totally unfounded. This motion was necessitated by the fact that Applicant pleaded a "new" affirmative defense not articulated in any prior Board decision which, as discussed above, is fundamentally flawed and should be rejected by the Board at this stage before the parties begin to develop and present their evidence directed to the merits of this proceeding.

For all of the reasons stated above and in Opposer's original supporting Memorandum, summary judgment should be entered dismissing Applicant's ill-founded prior registration defense to Opposer's likelihood of dilution claim.

Respectfully submitted,

BRINK'S NETWORK, INC.

Date: February 24, 2011

By: 

Alan S. Cooper
Alesha M. Dominique
Leigh Kobrinski
Howrey LLP
1299 Pennsylvania Avenue, NW
Washington, DC 20004-2402
202.783.0800
202.383.7195 (Facsimile)

Attorneys for Opposer

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the foregoing Reply Memorandum in Support of Opposer's Motion for Summary Judgment Dismissing Applicant's Prior Registration Defense was served on the following attorneys of record for Applicant by U.S. mail on this 24th day of February, 2011:

Gary A. Clark, Esq.
Susan Hwang, Esq.
Sheppard, Mullin, Richter & Hampton LLP
333 South Hope Street, 48th Floor
Los Angeles, California 90071

