

**THIS DECISION 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

GCP

Mailed: May 21, 2012

Opposition No. 91164764

Brink's Network, Incorporated

v.

The Brinkmann Corporation

**Before Bucher, Mermelstein, and Bergsman,
Administrative Trademark Judges.**

By the Board:

The Brinkmann Corporation ("applicant") seeks to register the mark BRINKMANN for "home security systems and components therefor, namely, motion sensitive home security lights, detectors, receivers, transmitters, adapters and wall mount brackets" in International Class 9.¹

Brink's Network, Incorporated ("opposer") has opposed the registration of applicant's BRINKMANN mark on the grounds of priority and likelihood of confusion based upon

¹ Application Serial No. 76483115, filed on January 17, 2003, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, claiming June 12, 1978, as both the date of first use and the date of first use in commerce.

its prior common law use and ownership of registrations for the marks BRINKS and BRINK'S, alone or in combination with other words and design(s), used in connection with various residential and commercial security products. Opposer has also asserted a claim of dilution.²

Applicant, in its answer, has denied the salient allegations of opposer's third amended notice of opposition filed on June 10, 2010, which is the operative pleading in this case. In its answer, applicant has also asserted various affirmative defenses, including the affirmative defense that opposer's dilution claim is precluded by the prior registration or *Morehouse*³ defense based upon applicant's ownership of the following three prior registrations:

1. Registration No. 1153730 for the mark **BRINKMANN** for "electrical extension cords, brackets" 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;⁴

² Opposer's counsel's change of correspondence address filed on February 24, 2011, is noted. Board records have been updated accordingly to reflect this new correspondence address.

³ *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969).

⁴ Registration issued on May 12, 1981, Section 8 accepted/Section 9 acknowledged on August 27, 2010.

2. Registration No. 2779986 for the mark BRINKMANN BACKYARD KITCHEN for "combined outdoor grill and kitchen appliance units comprised of gas grills, sinks and coolers" in International Class 11;⁵ and
3. Registration No. 3797964 for the mark BRINKMANN for "batteries; wall mount brackets for battery chargers and flashlight; cooking thermometers; electrical extension cords; electric connectors; electric converters; electronic mineral and metal detectors, flashlight and spotlight accessories sold together or separately, namely, transmitters, lighter plugs and filter caps" in International Class 9, as well as various goods relating to barbecue, grilling and cooking, as well as various hand tools, housewares and garden items in International Classes 4, 6, 7, 8, 11, 12, 21 and 30.⁶

Applicant also bases its *Morehouse* defense on the existence of a number of third-party registrations for the marks BRINK, BRINK'S or BRINKMAN, alone or in combination with other words and design(s). Additionally, applicant has asserted a counterclaim seeking to cancel certain registrations pleaded by opposer on the ground of abandonment.

⁵ Registration issued on November 4, 2003, Section 8 and 15 affidavits accepted and acknowledged on December 2, 2008.

⁶ Registration issued on June 8, 2010.

Opposer's Motion for Summary Judgment and Motion to Strike

This case now comes before the Board for consideration of (1) opposer's motion for partial summary judgment on applicant's *Morehouse* or prior registration affirmative defense regarding opposer's dilution claim and (2) opposer's motion to strike applicant's sur-reply brief in support of its opposition to opposer's motion for summary judgment. The motions are fully briefed.

We first turn to opposer's motion to strike applicant's sur-reply to opposer's motion for summary judgment. In that the Board does not consider sur-replies, opposer's motion to strike is granted and applicant's sur-reply is hereby stricken.⁷ See Trademark Rule 2.127. We add, however, that we have not considered any new issue which opposer may have discussed in its reply brief in support of its motion for summary judgment.

We now turn to opposer's motion for summary judgment. In support of its motion, opposer argues that to the extent applicant predicates its *Morehouse* or prior registration defense on its ownership of Registration Nos. 1153730 and 2779986 for the marks **BRINKMANN** and BRINKMANN BACKYARD KITCHEN, respectively, that defense is precluded as a matter of law under the law of the case doctrine based on the

⁷ Opposer's motion to strike was unnecessary - the Board will not consider a sur-reply even in the absence of an objection.

decision issued by the Board in this matter on March 16, 2009, which held that applicant's Registration Nos. 1153730 and 2779986 do not cover essentially the same goods which are the subject of the opposed application.⁸ Opposer also argues that the same conclusion would apply to applicant's prior Registration No. 3797964 for the mark BRINKMANN because the goods identified in that registration are not the same or essentially the same as the goods recited in applicant's involved application. Additionally, opposer contends that applicant's reliance on opposer's alleged failure to challenge a number of third-party registrations of marks that applicant maintains are confusingly similar to opposer's pleaded BRINKS mark is fundamentally misplaced because the basic predicate for the *Morehouse* defense is that the party asserting the defense owns the prior registrations upon which that defense is based. Opposer additionally argues that applicant's reliance on these third-party registrations is flawed to the extent that certain of those registrations are no longer subsisting and others issued on the Supplemental Register and, therefore,

⁸ In its March 16, 2009, order, the Board, *inter alia*, granted opposer's motion for partial summary judgment regarding applicant's affirmative defense of laches, in part, on the ground that the goods identified in applicant's involved application are not substantially the same as the goods recited in applicant's prior Registration Nos. 1153730 and 2779986.

applicant is precluded from relying upon these registrations for its *Morehouse* defense.

In view of the foregoing, opposer contends that there are no genuine disputes of material fact with respect to whether the goods listed in applicant's prior Registration Nos. 1153730, 2779986 and 3797964 are not the same or essentially the same as the home security systems and components therefore covered by applicant's involved application. Opposer further maintains that there is no genuine dispute of material fact with respect to applicant's non-ownership of the third-party registrations listed in its affirmative defense. For these reasons, opposer argues that it is entitled to judgment as a matter of law dismissing the *Morehouse* defense asserted in applicant's answer.

In response, applicant maintains that it is not asserting the traditional *Morehouse* defense as a defense to opposer's likelihood of confusion claim. Instead, applicant argues that it is asserting a modified *Morehouse* defense that is explicitly directed only to opposer's dilution claim. Applicant maintains that the basis for this modified *Morehouse* defense is opposer's alleged inconsistent assertion of dilution as a basis for opposition, given that opposer failed to challenge applicant's prior registrations for its BRINKMANN and BRINKMANN-formative marks, as well as numerous third-party registrations of BRINK-formative marks.

Applicant further contends that its modified *Morehouse* defense to opposer's dilution claim is a natural and logical extension of a traditional *Morehouse* defense and that the Board, therefore, should take the lead in extending the *Morehouse* defense to dilution claims. Applicant maintains that any differences between goods or services identified in the prior registrations relied upon by applicant in support of its modified *Morehouse* defense, as compared to those identified in applicant's involved application, are irrelevant in the context of a dilution claim and that the mere existence of these registrations should preclude opposer's dilution claim. In further support of its modified *Morehouse* defense, applicant argues that its requested modification to the *Morehouse* defense is justified because it is absolutely clear that there would be no added harm to opposer's alleged famous BRINKS marks in view of opposer's failure to oppose or seek to cancel, on the ground of dilution, applicant's prior registered BRINKMANN marks or any of the numerous third-party registrations of BRINK-formative marks identified by applicant.

With regard to the third-party registrations for BRINK-formative marks to which opposer has objected on the ground that some of these registrations are cancelled and therefore are not applicable to a *Morehouse* defense, applicant maintains that these registrations were cancelled after the

institution of this proceeding and, therefore, opposer could have opposed or petitioned to cancel on dilution grounds prior to the commencement of this action but failed to do so. In fact, applicant contends that there are yet other third-party registrations for BRINKS-formative marks, not identified in its answer in support of its modified *Morehouse* defense, but which were valid and subsisting when this proceeding was first instituted, but have since been cancelled, that opposer could have opposed or petitioned to cancel on dilution grounds but did not.

Lastly, applicant argues that opposer's contention that applicant's modified *Morehouse* defense is precluded by the doctrine of the law of the case is misplaced since – according to applicant – the law of the case doctrine applies to final decisions, not interlocutory decisions.

In view of the foregoing, applicant requests that the Board deny opposer's motion for partial summary judgment and instead *sua sponte* grant partial summary judgment in applicant's favor dismissing opposer's dilution claim based upon applicant's modified *Morehouse* defense.⁹

⁹ While the Board may, under some circumstances, grant summary judgment *sua sponte* in favor of a non-movant, applicant's "suggestion" that we do so is essentially a motion. If applicant desired such relief, it should have filed a properly-identified (and properly-supported) cross-motion, rather than urging us to use our own authority to do what it failed to do for itself.

In reply, opposer essentially argues that applicant's sole reliance on its prior BRINKMANN registrations, as well as the existence of third-party registrations for BRINK-formative marks, as a basis for its modified *Morehouse* defense, is misplaced in a dilution context. Opposer contends such registrations are not probative evidence that the marks covered by the registrations are in use or have some negative impact on the public perception of opposer's marks, much less establish that opposer's use of its pleaded BRINK'S marks has not been substantially exclusive. In view thereof, opposer contends that applicant's efforts to establish a new defense to a dilution claim based on prior registrations is misplaced as a matter of law and should be rejected by the Board. Finally, opposer argues that the law of the case doctrine is not limited to final decisions; rather, opposer argues that the law of the case doctrine recognizes that litigation proceeds through multiple stages and, therefore, a court's decision on a rule of law at one stage of a litigation should continue to govern the same issues in subsequent stages in the same case. Accordingly, opposer maintains that the Board's March 16, 2009, ruling that applicant's Registration Nos. 1152739 and 2779986 do not cover essentially the same goods which are the subject of the opposed application is relevant to opposer's present motion.

For these reasons, opposer requests that the Board decline applicant's invitation to create a new defense to dilution based on prior registrations owned by applicant or third parties.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine dispute of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

In the present case, we find that opposer has adequately met its burden of proof of showing that no genuine dispute of material fact exists, and that only a legal issue exists as to whether the modified *Morehouse* or prior registration defense asserted by applicant is a legally cognizable affirmative defense to a dilution claim.

Opposer, by way of its motion for partial summary judgment, is essentially requesting that the Board render an advisory opinion as to whether or not applicant's modified *Morehouse* defense is applicable to opposer's dilution claim. We decline to do so for the following reasons.

As noted above, opposer has asserted both a claim of likelihood of confusion, as well as dilution. Without making a determination on the merits of either claim, we note that the goods recited in applicant's involved application and opposer's identified goods and services appear to be competitive in nature and that a determination of likelihood of confusion will therefore turn more on the similarity of the marks (and possibly other *du Pont* factors)¹⁰ than on the goods and services. Moreover, to the extent this case goes to final briefing on the merits and, if the Board finds that a likelihood of confusion exists, the Board would then need not reach the merits of opposer's dilution claim. See *e.g.*, *The B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500 (TTAB 2007) (when finding likelihood of confusion, no need to reach dilution claim); *Miss Universe L.P. v. Community Marketing, Inc.*, 82 USPQ2d 1562 (TTAB 2002).

¹⁰ See *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

If the Board, however, does not find that a likelihood of confusion exists, it would most likely be the result of a finding that the marks at issue are not sufficiently similar, and even though the Board has relaxed the degree of similarity that marks must have for dilution to lie, see *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1888 (TTAB 2011) (marks do not need to be substantially similar for dilution claim to succeed); *Nike Inc. v. Maher*, 100 USPQ2d 1018 (TTAB 2011), if opposer cannot prevail on its likelihood of confusion claim because of the differences in the parties' respective marks, it would, in all likelihood, also not prevail on its dilution claim.

To the extent it is necessary, however, to decide whether applicant's modified *Morehouse* defense is applicable to opposer's dilution claim, the parties may argue it in their final briefs on the case with the full benefit of dilution jurisprudence that may exist at that time. By not making a determination now as to whether applicant's modified *Morehouse* defense is a legally cognizable affirmative defense to opposer's dilution claim, opposer will not be prejudiced inasmuch as opposer will nonetheless be required to prove its dilution claim. Similarly, applicant will not be prejudiced since it still will have little to do to prove the existence of its prior registrations upon which it bases, in part, its modified

Morehouse defense. Accordingly, by not reaching the legal issue at this time, we do not shoulder either party with any significant burden in discovery or at trial.

In view of the foregoing, we defer, until final determination, the potential applicability of applicant's requested modified *Morehouse* defense to opposer's dilution claim.

To be clear, however, this decision does not preclude applicant from defending against the dilution claim by introducing evidence of third-party use, as well as applicant's own use, to negate opposer's claim of fame or substantially exclusive use. See Trademark Act § 43(c)(2)(A) and (B)(iii).

Accordingly, opposer's motion for partial summary judgment is denied to the extent that consideration of whether applicant's modified *Morehouse* defense is a legally cognizable defense to opposer's dilution claim is deferred until final determination. Similarly, applicant's request that the Board *sua sponte* grant partial summary judgment in its favor regarding opposer's dilution claim based upon its requested modified *Morehouse* affirmative defense is also declined.

Proceedings herein are resumed. Trial dates are reset as follows:

THE PERIOD FOR DISCOVERY TO CLOSE:	6/15/2012
Testimony period for plaintiff in the opposition to close (opening thirty days prior thereto):	9/13/2012
Testimony period for defendant in the opposition and as plaintiff in the counterclaim to close (opening thirty days prior thereto):	11/12/2012
Testimony period for defendant in the counterclaim and its rebuttal testimony as plaintiff in the opposition to close (opening thirty days prior thereto):	1/11/2013
Rebuttal testimony period for plaintiff in the counterclaim to close (opening fifteen days prior thereto):	2/25/2013
Briefs shall be due as follows [See Trademark rule 2.128(a)(2)]. Brief for plaintiff in the opposition shall be due:	4/26/2013
Brief for defendant in the opposition and as plaintiff in the counterclaim shall be due:	5/26/2013
Brief for defendant in the counterclaim and its reply brief (if any) as plaintiff in the opposition shall be due:	6/25/2013
Reply brief (if any) for plaintiff in the counterclaim shall be due:	7/10/2013

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.