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

Mailed: March 29, 2006

Opposition No. **91165876**

Opposition No. **91165899**

Opposition No. **91165901**

House of Blues Brands Corp.

v.

Celebrities Publishing
Corporation

Before Hohein, Walters, and Walsh, Administrative Trademark
Judges.

By the Board:

On June 24 and 25, 2004, applicant, Celebrities
Publishing Corporation ("Celebrities"), filed three intent-
to-use based applications to register the mark IN ROCK WE
TRUST.¹ Opposer, House of Blues Brands Corp. ("House of

¹ Serial No. 78441156, for the mark IN ROCK WE TRUST for
"jewelry, and belt buckles made of precious metal," filed June
24, 2004 on the basis of applicant's bona fide intent to use the
mark in commerce; Serial No. 78441158 for the mark IN ROCK WE
TRUST for "handbags, shoulder bags, purses, wallets, bill folds,
credit card holders, coin purses, tote bags, backpacks,
briefcases, attaches, travel bags, duffel bags, satchels,
suitcases, key cases, leather key chains," filed June 25, 2004 on
the basis of applicant's bona fide intent to use the mark in
commerce; and Serial No. 78441161 for the mark IN ROCK WE TRUST
for "clothing for men, women and children, namely, coats,
jackets, vests, pants, slacks, trousers, jeans, gym suits,
jogging suits, sweat pants, shorts, skirts, dresses, blouses,
halter tops, tank tops, t-shirts, sweatshirts, camisoles, under
garments, robes, pajamas, socks, head wear, hats, caps, bandanas,

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Blues") filed notices of opposition to each of applicant's three marks. Each opposition was based on the grounds of likelihood of confusion and dilution.

On September 19, 2005, opposer filed a motion to consolidate the cases. Opposer's motion is hereby granted as conceded.²

On August 29, 2005, in lieu of filing an answer, applicant filed, in each opposition, a motion to dismiss the oppositions for failure to state a claim upon which relief may be granted under Fed. R. Civ. P. 12(b)(6). In each case, applicant requested that the Board consider its motion, in the alternative, as a motion for summary judgment. The motions were fully briefed as both motions to dismiss and for summary judgment.

Opposition No. 91165901

In Opposition No. 91165901, by order dated February 17, 2006, the Board denied applicant's motion for summary judgment and partially granted its motion to dismiss. Opposer was allowed time to amend its notice of opposition

scarves, belts, beach coverups," filed June 25, 2004 on the basis of applicant's bona fide intent to use the mark in commerce.

² The cases may now be presented on the same records and briefs. Papers should bear the number of each of the consolidated cases, although Opposition No. 91165876 is treated as the "parent" case, and most of the papers filed by the parties, or issued by the Board, will be placed only in the file of the parent case. The parties need not file a copy for each consolidated case; a single copy, bearing the number of each consolidated case, normally is sufficient.

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to assert a proper dilution claim. Opposer filed an amended notice on March 9, 2006. Accordingly, as indicated in the Board's order, applicant has until thirty days from the date of service of opposer's amended notice of opposition within which to file its answer in Opposition No. 91165901.

Opposition Nos. 91165876 and 91165899

In Opposition Nos. 91165876 and 91165899, applicant's alternative motions to dismiss and for summary judgment are pending. In both oppositions, the facts, issues, and arguments of the parties are essentially the same as they were in Opposition No. 91165901 and the evidence submitted in all three cases appears to be identical.³ We will not therefore reiterate that information herein.

With respect to the motions to dismiss, opposer has sufficiently pleaded its standing through its claimed ownership, in both oppositions, of the mark IN BLUES WE TRUST and registrations therefor.⁴ See *Ritchie v. Simpson*,

³ In each case, applicant has submitted the declaration of its counsel, Chad Iida, Esq., with exhibits that include a copy of a page from a website explaining the history of the term "In God We Trust" and copies of third-party registrations from the TESS ("Trademark Electronic Search System") database. Opposer has submitted the declaration of its counsel, John Tang, Esq., with exhibits that include copies of other third-party registrations from the TESS database.

⁴ In both Opposition Nos. 91165876 and 91165899, opposer pleaded ownership of Reg. No. 2050935 for the mark IN BLUES WE TRUST for "restaurant and bar services," registered July 2, 2003, Section 8 and 15 affidavits accepted and acknowledged; and Reg. No. 1981453 for the mark IN BLUES WE TRUST for "clothing, namely, shirts, hats, jackets," registered April 17, 2002; Section 8 and 15 affidavits accepted and acknowledged.

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170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999). Also, opposer has alleged sufficient facts to support a claim of likelihood of confusion in each case. However, the notices of opposition fail to state a proper dilution claim because there is no allegation that opposer's mark became famous prior to the filing date of each subject application. See *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164 (TTAB 2001).

In view thereof, applicant's motions to dismiss are granted only to the extent that **opposer is allowed until twenty days from the mailing date shown on this order to file amended pleadings in Opposition Nos. 91165876 and 91165899 that state, provided opposer is able to do so in good faith in each case, a proper claim of dilution, failing which the claim of dilution will be dismissed.** For each case, if opposer files an amended pleading, applicant is allowed until THIRTY DAYS after being served with a copy of the amended notice of opposition to file its answer thereto.

The motions to dismiss are otherwise denied.

Turning to those portions of applicant's motions that seek summary judgment, we note that as the party moving for summary judgment, applicant bears the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See Fed. R. Civ. P. 56(c); and *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). After reviewing the

arguments and supporting papers of the parties, we find that applicant has not met its burden of establishing that no genuine issue of material fact exists as to opposer's claim of likelihood of confusion.⁵ At a minimum, genuine issues of material fact exist as to the similarity or dissimilarity of the connotations and commercial impressions of the marks at issue and the relationship of the goods identified in the involved application and the pleaded registration.⁶

In view thereof, applicant's motion for summary judgment is denied.⁷

Proceedings are otherwise herein suspended pending receipt of opposer's amended notice of opposition (and applicant's answer thereto), if any. Upon resumption of proceedings, discovery and trial dates will be reset.

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⁵ Because opposer has not pleaded a proper dilution claim, we have not addressed applicant's motions for summary judgment on dilution grounds.

⁶ The fact that we have identified only a few genuine issues of material fact as sufficient bases for denying the motion for summary judgment should not be construed as a finding that these are necessarily the only issues which remain for trial.

⁷ The parties should note that the evidence submitted in connection with their 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 *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).