

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

GCP/JK

Mailed: June 27, 2007

CONSOLIDATED PROCEEDINGS

Opposition No. 91169819

Opposition No. 91171936

BUY.COM INC. AND BUYMUSIC  
INC.

v.

MINTBUY.COM

Before Hairston, Drost and Wellington,  
Administrative Trademark Judges.

By the Board:

Mintbuy.com ("applicant") seeks to register the mark  
MINTBUY COM (in stylized format with a design and claiming  
color as a feature of the mark) for:

"marketing goods of others from around the world  
through the internet; online retail and wholesale  
store services featuring men, women and children  
clothing; men, women and children shoes and, other  
clothing accessories; watches and other jewelry;  
computer equipment and, other electronics; toys and  
games; gift baskets and flowers; home and office  
furnishing; kitchen and bathroom supplies and  
products; office equipment and supplies; house wares  
and appliances; paintings, drawings, pottery,  
embroidery, woodwork and sculptures; home and garden  
tools; power and mechanical tools; sporting goods and

Opposition No. 91169819

Opposition No. 91171936

memorabilia; videos, DVDs, tapes; CDs, cassettes and records; musical instruments and accessories; antiques and collectibles; beauty and health products and accessories; books and magazines; motorcycles, automobiles and boats, along with parts and accessories for same"<sup>1</sup> in International Class 35.

On February 21, 2006, Buy.Com Inc. and BuyMusic Inc. ("opposers") filed a notice of opposition to registration of applicant's MINTBUY COM mark on the ground of priority of use and likelihood of confusion with respect to opposer's pleaded registrations for the following marks:

(1) B BUY.COM (stylized), for "electronic retailing services via computer featuring general merchandise, namely, computers, books, videos, software, games, music and related merchandise" in International Class 35,<sup>2</sup>

(2) BUY.COM for "online retail and wholesale store services featuring a full line of consumer goods, namely, computers, books, videos, software, games, audio cassettes, compact discs, other audio-media related merchandise, toys, office and school supplies, household appliances, surplus goods, sports equipment, and electronics; online ordering services featuring a full line of consumer goods, namely, computers, books, videos, software, games, audio cassettes,

---

<sup>1</sup>Application Serial No. 78455434, filed on July 23, 2004, based on a bona fide intent to use the mark in commerce.

<sup>2</sup> Registration 2376895, issued on August 15, 2000, alleging August 25, 1998 as the date of first use anywhere and November 15, 1998 as the date of first use in commerce.

Opposition No. 91169819

Opposition No. 91171936

compact discs, other audio-media related merchandise, toys, office and school supplies, household appliances, surplus goods, sports equipment, and electronics; online distributorship services featuring a full line of consumer goods, namely, computers, books, videos, software, games, audio cassettes, compact discs, other audio-media related merchandise, toys, office and school supplies, household appliances, surplus goods, sports equipment, and electronics; providing an online searchable computer database in the field of consumer merchandise; and dissemination of advertising for others via an on-line electronic communications network" in International Class 35,<sup>3</sup>

(3) BUY MAGAZINE for "promoting the goods and services of others by preparing and placing advertisements in an electronic magazine accessed through wired and wireless networks" in International Class 35 and "providing an online magazine on the subjects of general interest, entertainment, movies, books, music, games, sports, travel,

---

<sup>3</sup> Registration 2670844, issued on January 7, 2003, alleging November 15, 1998 as the date of first use anywhere and in commerce.

Opposition No. 91169819  
Opposition No. 91171936

telephony, electronics, computers, and software" in International Class 41,<sup>4</sup>

(4) BUYMUSIC for "providing data bases containing musical and audiovisual recordings; providing databases and information pertaining to music and entertainment; providing links to websites of others featuring music and entertainment; all via the Internet and other electronic communications networks" in International Class 41,<sup>5</sup> and

(5) BUYMUSIC for "electronic retailing services via computer namely via the internet and other electronic communications networks, featuring music and related merchandise, and featuring audiovisual works, software and players for playing music and audiovisual works, and related merchandise" in International Class 35.<sup>6</sup>

This case now comes up for consideration of applicant's motion for summary judgment (filed October 3, 2006) in Opposition No. 91169819 on opposers' claim of likelihood of confusion. The motion is fully briefed.

For purposes of this order, we presume the parties' familiarity with the pleadings, the history of the

---

<sup>4</sup> Registration 2877749, issued on August 24, 2004, alleging September 12, 2003 as the date of first use anywhere and in commerce.

<sup>5</sup> Registration 2945085, issued April 26, 2005, alleging July 22, 2003 as the date of first use anywhere and in commerce.

<sup>6</sup> Registration 2990358, issued August 30, 2005, alleging April 30, 1999 as the date of first use anywhere and in commerce.

Opposition No. 91169819  
Opposition No. 91171936

proceeding and the arguments and evidence submitted with respect to applicant's motion for summary judgment.

Summary judgment is an appropriate method of disposing of cases that present no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See 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. *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

Here, applicant, as the moving party, has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

After reviewing the arguments and supporting evidence, and drawing all inferences with respect to the motion in favor of opposer as the nonmoving party, we find that applicant has failed to meet its burden of establishing that there are no genuine issues of material fact for trial.

Opposition No. 91169819

Opposition No. 91171936

At issue in this proceeding is whether there is a likelihood of confusion between applicant's mark and opposers' pleaded registered marks. At a minimum, the record reveals that genuine issues of material fact exist as to the similarity between the marks that preclude disposition of this case by way of summary judgment. Specifically, a genuine issue exists as to whether, and if so to what extent, the marks are within or belong to a crowded field of similar marks for similar services. This issue is relevant, in part, to the scope of protection that can reasonably be afforded to opposers' pleaded registered marks. Additionally, a genuine issue exists regarding the similarity or dissimilarity in the commercial impressions the marks create with respect to the services in connection with which they are used.

Opposition No. 91169819  
Opposition No. 91171936

In view thereof, applicant's motion for summary judgment is hereby denied.<sup>7</sup>

It has come to the Board's attention that Opposition Nos. 91169819 and 91171936<sup>8</sup> involve the same parties and common questions of law and fact. It would therefore be appropriate to consolidate these proceedings pursuant to Fed. R. Civ. P. 42(a).

The Board may, in its discretion, order consolidation upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. See TBMP §511 (2d ed. rev. 2004).

---

<sup>7</sup> The fact that we have identified certain genuine issues of material fact as a sufficient basis for denying applicant's motion for summary judgment should not be construed as a finding that such issues necessarily are the only issues that remain for trial. Also, the parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of the motion. 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).

<sup>8</sup> Buy.Com Inc. and BuyMusic Inc. oppose registration of the mark MINTBUY COM, in standard character format, in Application Serial No. 78443048, filed on June 29, 2004, based on a bona fide intent to use the mark in commerce, and claiming the same services as those identified in Application Serial No. 78455434.

Opposition No. 91169819  
Opposition No. 91171936

Accordingly, the above-noted opposition proceedings are hereby consolidated and may be presented on the same record and briefs.

The Board file will be maintained in Opposition No. 91169819 as the "parent case," and Opposition No. 91171936 is now the "child case." The parties should no longer file separate papers in connection with each proceeding. Only a single copy of each paper should be filed by the parties and each paper should bear the case caption as set forth above.

As a final matter, we note that, although the caption to and opening paragraph of each notice of opposition identify two opposers, Office records indicate that only one opposition filing fee of \$300 was debited for Opposition No. 91169819. Each opposition, however, must be accompanied by the required fee for each party joined as opposer for each class in the application for which registration is opposed. See 37 C.F.R. § 2.101(d)(1). Accordingly, pursuant to instructions opposers provided on page 7 of their notice of opposition, this Office has debited the referenced deposit account an additional \$300 for the second filing fee due in Opposition No. 91169819.

Proceedings herein are resumed. With respect to consolidated proceedings, it is generally the Board's

Opposition No. 91169819  
Opposition No. 91171936

practice to reset discovery and trial dates so as to conform to the status of the most recently filed proceeding, which is the child case herein. The Board notes, however, that discovery and opposers' testimony period have already closed with respect to the child case, and that proceedings were suspended in the parent case as of October 3, 2006, the date on which applicant filed its motion for summary judgment therein. In light of the Board's ruling on the motion for summary judgment, and in order to allow both proceedings to move forward in an orderly fashion, the Board, in its discretion, affords the parties a limited five-day time period for discovery in both proceedings.

Additionally, trial dates for the now consolidated proceedings are reset as follows:

|  |                    |
|--|--------------------|
| DISCOVERY TO OPEN:   | July 9, 2007       |
| DISCOVERY TO CLOSE:  | July 13, 2007      |
| Thirty-day testimony period<br>for plaintiff to close:           | September 28, 2007 |
| Thirty-day testimony period<br>for defendant to close:           | November 27, 2007  |
| Fifteen-day rebuttal testimony<br>period for plaintiff to close: | January 11, 2008   |

Opposition No. 91169819

Opposition No. 91171936

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.