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

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| Proceeding | 91172981 |
| Party | Plaintiff<br>J.L. Pennington |
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re:

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| Applicant's Mark: | GITZIT |
| Serial No.: | 78/703,563 |
| Filed: | March 6, 2000 |
| Published: | In the Official Gazette on May 16, 2006 |

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| J.L. Pennington,<br>Opposer,<br>v.<br>GITZIT, INC.,<br>Applicant. | Opposition No. 91172981<br><br>**OPPOSER'S TRIAL BRIEF** |

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## STATEMENT OF THE CASE

Opposer, J.L. Pennington ("Opposer" or "Pennington"), is the owner of the famous and well-known trademark GITZIT which is used in connection with fishing lures. Pennington (or his predecessor in interest Canyon Plastics and its owner Gary Garland) have continuously used the GITZIT trademark in connection with fishing lures since at least as early as the fall of 1990. The sales of GITZIT fishing lures by Pennington have been made throughout the United States as well as internationally. Pennington has spent significant time, effort and money in advertising and promoting his fishing lures sold under the GITZIT mark and in trade publications and magazines of general circulation as well as the internet. As a result, the GITZIT trademark is internationally recognized as identifying fishing lures made by Pennington.

Applicant Gitzit, Inc. ("Applicant") filed a use-based application on August 30, 2005 seeking to register the GITZIT trademark for use in connection with "fishing lures" in International Class 28. Pennington opposed Applicant's application on the basis that the Applicant's GITZIT mark is identical to Opposer's GITZIT trademark and the parties goods are identical.

The present opposition should be sustained because Applicant's use and registration of the identical GITZIT mark for identical goods is likely to cause confusion, mistake or deception in violation of Section 2(d) of the Lanham Act and Pennington is likely to be damaged if Applicant's GITZIT application is permitted to mature into a registration.

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## DESCRIPTION OF THE RECORD

In addition to the file history for the GITZIT trademark, Application No. 78/03563, which is automatically of record pursuant to 37 CFR Section 2.122(b)(1), the following evidence is also of record:

### I. OPPOSER'S RECORD

Opposer's record consist of the following:

Testimony Deposition of Gary Garland, taken October 24, 2008, including Opposer's Exhibits 1-10.

### II. APPLICANT'S RECORD

None. Applicant has filed no Notice of Reliance and has taken no testimony.

## STATEMENT OF ISSUES

Whether Applicant's use of the identical mark on the identical goods results in a likelihood that confusion, mistake or deception will occur.

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## STATEMENT OF FACTS

### I. OPPOSER'S MARK

In 1975, Gary Garland founded a business named Canyon Lures. This business made tube lures and jig heads for fishermen. In the 1980 timeframe, the business was renamed Canyon Plastics. (Testimonial Deposition of Gary Garland ("Garland Depo."), 6:10-21). On or about the fall of 1990, Canyon Plastics, then owned by Gary Garland, started selling GITZIT branded lures to fishermen throughout the United States and internationally. (Garland Depo., 9:8-16).

On June 1, 2005, Gary Garland sold all of the assets of the Canyon Plastics business to Opposer J.L. Pennington. The sale of assets to Pennington included the GITZIT trademark and all of the goodwill of Canyon Plastics. Opposer continued to operate the business and still does operate the business under the name Canyon Plastics. (Garland Depo, 9:22-11:4 and Opposer's Exhibit 4).

Canyon Plastics continuously made sales of GITZIT lures from the fall of 1990 through 2005 when the business was sold to Pennington. Thereafter, Pennington, doing business as Canyon Plastics, continued to use the GITZIT mark on fishing lures from 2005 through the present. (Garland Depo, 11:5-19).

Opposer and Opposer's predecessor in interest have continuously utilized the GITZIT trademark by applying the mark to product packaging and in promotional materials and price lists. (Garland Depo, 11:25-13:8 and Opposer's Exhibits 5 & 6).

The GITZIT mark was also used on invoices for fishing lures, both in the header portion of the invoice and in the description of the goods. (Garland Depo, 13:14-15:8 and Opposer's Exhibits 7 and 8).

Over the years, Canyon Plastics (initially Canyon Lures), Gary Garland and the GITZIT lures have been recognized in industry publications like the March 1991 edition of Outdoor Life and the August – September 2006 edition of FLW Outdoors. (Garland Depo, 15:10-12 and Opposer's Exhibits 9 and 10).

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## II. APPLICANT'S MARK

The only potential evidence in the record of any use of the GITZIT trademark by the Applicant is Applicant's United States Trademark Application, Serial No. 78/703,563. The '563 application included a declaration by the Applicant's attorney of record, Matthew F. Johnson dated August 30, 2005. In that declaration, Applicant's attorney asserted that the Applicant first used the GITZIT mark in connection with fishing lures on May 7, 1992. The record does not include any allegation of use prior to May 7, 1992. Moreover, there is no evidence in the record of any actual use in commerce whatsoever, much less continuous use. There is also no evidence in the record of sales by Applicant of fishing lures bearing the GITZIT trademark.

# ARGUMENT

## I. OPPOSER HAS STANDING

Opposer has standing to oppose the registration of Applicant's GITZIT mark because Opposer has (1) a "real interest" in the proceedings; and (2) a reasonable basis for the belief that Opposer will suffer damage if registration of the GITZIT mark is allowed. *Ritchie v. Simpson*, 50 U.S.P.Q.2d 1023, 1025-26 (Fed. Cir. 1999). Opposer has presented uncontroverted evidence of his (and his predecessor in interest's) use of the GITZIT trademark in connection with fishing lures from 1990 to the present. Given that the respective trademarks are identical and the respective goods are identical, Opposer has a reasonable basis for claiming that there is a likelihood of confusion. Opposer's real interest for opposing the registration of the GITZIT mark is to prevent damage to Opposer's GITZIT mark, goodwill and reputation.

## II. OPPOSER HAS PRIORITY OF USE

Opposer has established through the testimony of Gary Garland and corroborating documentation that Opposer and his predecessor in interest have continuously used the GITZIT trademark from the fall of 1990 through the present. There is no evidence in the record contradicting Mr. Garland's testimony or the corroborating documentation. Moreover, there is

nothing in the record leading one to question the accuracy of Mr. Garland's testimony or the validity of the corroborating documentation.

The only allegation of any use of the GITZIT trademark by the Applicant is found in U.S. Trademark Application, Serial No. 78/703,563. The allegation is the claimed first date of use in combination with the declaration of the attorney representing Applicant. The alleged first date of use is May 7, 1992. There is no evidence in the record of even a single sale by the Applicant of a single fishing lure bearing the GITZIT trademark. In fact, there is no evidence in the record of any use in commerce, much less continuous use of the GITZIT mark by the Applicant.

The uncontroverted evidence establishes that Opposer (and his predecessor in interest) continuously used the GITZIT trademark from 1990 to the present. This use began nearly two years prior to the alleged, but unproven, first use of the GITZIT trademark by Applicant. As such, Opposer has conclusively established priority of use.

## III. THE OPPOSITION SHOULD BE SUSTAINED BECAUSE REGISTRATION OF APPLICANT'S MARK CREATES A LIKELIHOOD OF CONFUSION.

### A. An Analysis of the Applicable Likelihood of Confusion Factors Weighs In Favor of Opposer.

The Lanham Act provides that a mark which "consists of or comprises a mark which so resembles ... a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the Applicant, to cause confusion, or to cause mistake, or to deceive" shall not be registered. 15 U.S.C. Section 1052(d).

To determine whether the registration of the opposed mark will give rise to confusion, mistake or deception, the Trademark Trial and Appeal board ("Board") should analyze the applicable factors set forth in *In re DuPont de Nemours & Co.*, 177 U.S.P.Q. 563 (CCPA 1973), focusing on "whether the purchasing public would mistakenly assume that the Applicant's goods originate from the same source as, or are associated with," Opposer's goods. *In re Majestic Distilling Co.*, 65 U.S.PQ.2d 1201, 1203 (Fed. Cir. 2003).

The record conclusively establishes that Applicant's GITZIT mark is likely to cause confusion, mistake or deception with Opposer's GITZIT mark, when used in connection with the identical goods, namely, fishing lures. *Wet Seal Inc. v. FD Mgmt. Inc.*, 82 U.S.P.Q.2d 1629, 1638 (TTAB 2007) (similarity of goods and services in marks are "key considerations") citing to *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 U.S.P.Q. 24 (CCPA 1976).

**1. Confusion Is Likely Because The Parties' Marks Are Identical.**

The Board's examination of "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression," must compare the marks as they would be viewed by the average purchaser. *Palm Bay Imports, Inc. v. Veuv Clicquot Ponsardin Maison Fondee En*, 73 U.S.P.Q.2d 1691 (Fed. Cir. 2005) quoting *DuPont*, 177 U.S.P.Q. at 567.

Opposer's and Applicant's marks are identical. Both Opposer's mark and Applicant's mark consist of the single term "gitzit." The marks are absolutely identical as to appearance, sound, connotation and commercial impression. Accordingly, this factor weighs heavily in favor of a likelihood of confusion.

**2. Confusion Is Likely Because The Parties' Goods Are Identical.**

Opposer (and his predecessor in interest) have used the GITZIT trademark in connection with fishing lures since 1990. The goods set forth in the identification of goods in Applicant's trademark application is "fishing lures." Accordingly, the goods for which registration is sought are identical to the goods on which Opposer has used the identical mark. The uncontroverted fact that the goods of the Opposer and the applied for goods are identical weighs heavily in favor of a finding of likelihood of confusion.

**3. Confusion Is Likely Because The Parties' Trade Channels Are Identical.**

Confusion is likely because Applicant's GITZIT mark is used on fishing lures that travel through the same trade channels as Opposer's fishing lures. Applicant and Opposer's goods are

identical. Moreover, Applicant's application does not contain any limitations pertaining to the channels of trade. Accordingly, Opposer is entitled to a presumption that the respective goods travel through identical trade channels. *Hewlett-Packard Co. v. Packard Press, Inc.*, 62 U.S.P.Q.2d 1001 at 1005 (Fed. Cir. 2002) ("absent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers"); *Genesco Inc. v. Martz*, 66 U.S.P.Q.2d 1260, 1268 (TTAB 2003) ("given the in-part identical and in-part related nature of the parties' goods and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same class of purchasers through the same channels of trade").

The record contains no evidence to rebut this presumption. Thus, the Board should find that Applicant's and Opposer's fishing lures travel in the same channels of trade, and that this factor weighs heavily in favor of a likelihood of confusion.

### B. <u>Any Doubt Regarding Likelihood of Confusion Should Be Resolved in Opposer's Favor</u>.

It is well-settled that all doubt as to the likelihood of confusion, mistake, or deception should be resolved in favor of the senior user. *PBC Corp. v. Holsa Inc.*, 44 U.S.P.Q.2d 1315, 1318 (Fed. Cir. 1997); *Century 21 Real Estate Corp. v. Century Life of America*, 23 U.S.P.Q.2d 1698, 1701 (Fed. Cir. 1992). In any event, since the foregoing evidence and analysis overwhelmingly renders confusion likely and Opposer has established that it is the senior user of the GITZIT trademark, any doubt should be resolved in Opposer's favor.

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## IV. CONCLUSION

Opposer has dedicated substantial time, money and effort into building a successful business around the GITZIT trademark. As a result, the GITZIT trademark enjoys widespread market recognition and extremely strong goodwill. Opposer has established standing, priority of use and a likelihood of confusion. Accordingly, Opposer respectfully requests that the Board sustain the Notice of Opposition on all grounds and refuse registration of Applicant's GITZIT trademark.

Dated: April 10, 2009

Respectfully submitted,

By: _____

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## CERTIFICATE OF SERVICE

I, California Lopez, declare under penalty of perjury that I am over the age of eighteen years, and that I am not a party to the above-referenced action. My business address is 600 West Broadway, Suite 2600, San Diego, California 92101.

I hereby certify that a true and correct copy of the:

**OPPOSER J.L. PENNINGTON'S TRIAL BRIEF**

was sent via First Class U.S. Mail to:

Chris Hendershot
667 Red Rock Road
St. George, Utah 84770

I declare under penalty of perjury under the laws of the State of California that the foregoing is true and correct. Executed in San Diego, California on the 10th day of April, 2009.

California Lopez

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