

**United States Court of Appeals  
For The Federal Circuit**

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Honda Motor Company, LTD

Plaintiff

vs.

Case No.

Michael Dalton

Defendant

**Notice of Appeal**

Opposition No. 91173105

**Notice of Appeal**

Now comes defendant, Michael Dalton, and presents his Notice of Appeal from the U.S. Patent and Trademark Office before the Trademark Trial and Appeal Board in Opposition No. 91173105.

Defendant, Dalton, appeals the board's decision sustaining the opposition entered 08/06/2010.

Respectfully submitted:



Michael E. Dalton

PO Box 18137

Cincinnati, Ohio 45218-0137

(513) 557-2901

DALTONME@hotmail.com

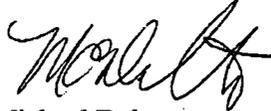
**Certificate of Service**

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I hereby certify that a copy of this notice of appeal has been served on the General Counsel, U.S. Patent and Trademark Office, PO Box 15667, Arlington, VA 22215; Clerk of Court, U.S. Court of Appeals for the Federal Circuit, 717 Madison Place, N. W., Room 401, Washington, D.C. 20439; and counsel for plaintiff Honda Motor Co. LTD., Dyan Finguerra-DuCharme, Wilmer Cutler Pickering Hale and Dorr LLP, 399 Park Avenue, New York, New York, 10022 by U.S. mail this 5<sup>th</sup> day of Oct. 2010.



Michael Dalton, pro se

**THIS OPINION IS NOT A  
PRECEDENT OF  
THE T.T.A.B.**

Mailed: August 6, 2010

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

Honda Motor Co., Ltd.

v.

Michael Dalton

Opposition No. 91173105  
to application Serial No. 78339571

Dyan Finguerra-DuCharme of White & Case LLP for Honda Motor  
Co., Ltd.<sup>1</sup>

Michael Dalton, pro se.

Before Bucher, Cataldo and Taylor,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Michael Dalton, seeks to register in  
standard characters on the Principal Register the mark  
DEALERDASHBOARD for the following services:

providing automotive dealerships managerial  
information concerning their Sales, Service, and  
Parts departments key financial indicators of how

<sup>1</sup> Opposer's July 1, 2010 revocation of previous power of attorney  
and appointment of new attorney is noted and will be made of  
record in due course. Inasmuch as opposer's decision to  
substitute its counsel does not affect applicant in this matter,  
applicant's objections thereto, filed July 2, 2010, and the  
parties' briefing thereof, will be given no consideration.

their dealership is performing via the Internet; and providing a web site featuring information about automobile dealerships, automobiles, automotive parts and accessories, at which users can link to the retail or wholesale web sites of others

in International Class 35.<sup>2</sup>

Opposer, Honda Motor Co., Ltd., has opposed registration of applicant's involved mark. As grounds therefor, opposer alleges as follows:

Opposer manufactures, markets and sells automobiles, motorcycles, motor scooters and all-terrain vehicles in the United States and throughout the world;

opposer uses the terms DEALER DASHBOARD and DASHBOARD on its internal company computer network, accessible only by opposer's authorized dealers;

Dashboard is a common term of art in the Internet industry, denoting a user interface for organizing and displaying key information. Honda uses and/or has used the terms DEALER DASHBOARD and DASHBOARD to describe a tool that presents information to its authorized dealers about their sales, service and parts departments;<sup>3</sup>

the terms comprising the involved alleged mark are generic for the services identified thereby;

<sup>2</sup> Application Serial No. 78339571 was filed on December 11, 2003, based upon applicant's assertion of his bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act. During prosecution of the application, applicant amended his filing basis to assert October 5, 1999 as the date of first use of the mark anywhere and in commerce under Section 1(a) of the Trademark Act.

<sup>3</sup> Notice of Opposition, para. 5.

the terms comprising the involved alleged mark are merely descriptive of the services identified thereby;

on information and belief, Applicant has also failed to use the mark DEALERDASHBOARD on all of the goods or services for which he seeks registration. Specifically, on information and belief, Applicant is not using the mark DEALERDASHBOARD in connection with "providing automotive dealerships managerial information concerning their Sales, Service, and Parts departments key financial indicators of how their dealership is performing via the Internet" as he has claimed in his application. Because Applicant's identification of goods and services for registration contains false statements, Registration should be refused;<sup>4</sup>

and, opposer has a real commercial interest in using the terms comprising applicant's mark to identify goods similar to applicant's services, and would be damaged by registration of applicant's asserted mark.

In his answer, applicant denied the salient allegations of the notice of opposition.<sup>5</sup>

<sup>4</sup> Id., para. 9.

<sup>5</sup> Applicant further asserted certain affirmative defenses, but did not pursue them by motion or at trial. Accordingly, they are deemed waived. The remainder of applicant's asserted affirmative defenses are more in the nature of amplifications of his denial of the salient allegations of the notice of opposition and have been so construed.

In addition, applicant attached exhibits to his answer to the notice of opposition. Certain exhibits form part of the proceeding file of the involved application and, as such, are automatically of record. See Trademark Rule 2.122. The remainder of the exhibits includes printouts from various third-party Internet websites. Except in limited circumstances, which are not present here, an exhibit to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony. Trademark Rule 2.122(c); and TBMP §317 (2d ed. rev. 2004). Accordingly, these Internet printouts are not part of the record.

### Evidentiary Objections

Opposer has objected to certain evidence introduced by applicant. Specifically, opposer objects to Exhibits 43, 46, 47, 49, 51-54, 56, 58, 59, 61, 64-69, and 89-92 to applicant's trial testimony deposition as well as Exhibits BB-LL to applicant's notice of reliance on the ground that these exhibits were the subject of opposer's written discovery requests but were not produced in response thereto. Opposer asserts that it timely served interrogatories and requests for production upon applicant requesting, *inter alia*, documents of the type that are the subject of opposer's above objections.<sup>6</sup> In an interlocutory order issued on February 29, 2008, the Board ordered applicant to respond without objection to opposer's written discovery requests.<sup>7</sup> Opposer timely objected to the above-numbered exhibits during applicant's trial testimony deposition<sup>8</sup> and argues in its brief that the above-numbered and lettered documents were not part of applicant's discovery responses. Applicant, for its part, did not file a trial brief or otherwise respond to the evidentiary objections raised by opposer in its brief.

Opposer's objection is sustained. It is well-settled that a party may not rely at trial upon documents that were

<sup>6</sup> Opposer's February 28, 2007 motion to compel, Exhibit 1.

<sup>7</sup> Board's February 29, 2008 order, p. 3.

<sup>8</sup> Dalton Testimony, p. 22-91.

not produced in response to written discovery requests.

See, for example, *Super Valu Stores Inc. v. Exxon Corp.*, 11 USPQ2d 1539, 1543 (TTAB 1989); *National Aeronautics and Space Administration v. Bully Hill Vineyards Inc.*, 3 USPQ2d 1671, 1672 n.3 (TTAB 1987); and *Shoe Factory Supplies Co. v. Thermal Engineering Co.*, 207 USPQ 517, 519 n.1 (TTAB 1980). Accordingly, these documents are stricken and will be given no consideration.

Further, we note that applicant's trial testimony with regard to the stricken exhibits must be accorded minimal probative value inasmuch as it is unsupported by any evidence of record.<sup>9</sup>

Opposer's further objections to: Exhibit BB on the ground of lack of probative value; Exhibits 54, 56, 58, 59, 61, 64-66 on the ground of hearsay; Exhibits GG-KK on the ground that such documents are not printed publications; and all of the above documents produced by applicant that were obtained by means of the Internet "Way Back Machine" on the ground that such are neither official documents nor self-authenticating, are moot in light of our above determination excluding those documents from consideration herein.

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<sup>9</sup> We hasten to add that even if these documents and testimony had been considered in our determination herein, the outcome would be the same.

### The Record

The record consists of the pleadings and the file of the involved application. In addition, opposer submitted the trial testimony, with related exhibits, of Cynthia Mangham, Manager of the Interactive Network Marketing and Rollout for applicant's wholly-owned subsidiary, American Honda Motor Co., Ltd. Opposer further submitted by notice of reliance the discovery deposition, with exhibits, of applicant; applicant's answers to opposer's first set of interrogatories and requests for admission; and copies of printed publications available to the general public.

Applicant, in light of the above objections, submitted his testimony deposition with related exhibits not otherwise excluded. Applicant's evidence submitted by notice of reliance has been excluded based upon the objections discussed above.

As noted above, only opposer filed a brief on the merits of the case.<sup>10</sup>

### Opposer's Standing

Opposer must prove its standing as a threshold matter in order to be heard on its substantive claims. See, e.g., *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). The purpose of the standing

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<sup>10</sup> As last reset by the Board's January 20, 2010 order, applicant's brief on the case was due no later than January 30, 2010.

requirement is to prevent mere intermeddlers from initiating proceedings. Thus, the Federal Circuit has enunciated a liberal threshold for determining standing, namely, whether a plaintiff's belief in damage has a reasonable basis in fact and reflects a real interest in the case. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d, 1023 (Fed. Cir. 1999). See also *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988).

In this case, opposer has established that it makes use of the term "dealer dashboard" to describe a program on its internal computer network for use by its dealers.<sup>11</sup> Opposer uses the term "dealer dashboard" to describe this program so that its users can easily find and access it on opposer's computer network.<sup>12</sup> Furthermore, applicant sent opposer a cease and desist letter demanding that opposer cease use of "dealer dashboard" on its internal computer network.<sup>13</sup>

We find that because opposer seeks to make descriptive use of the term "dealer dashboard" for a computer-based tool available to its dealers, and applicant has demanded that opposer cease such use, opposer has established its standing to oppose applicant's mark. See, e.g., *Lipton Industries, supra*, (One basis for standing includes "descriptive use of term in registered mark"); and *Ferro Corp. v. SCM Corp.*, 219

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<sup>11</sup> Mangham Testimony at 16-18.

<sup>12</sup> *Id.*

<sup>13</sup> Answer, para. 4; Dalton Discovery Deposition at 203.

USPQ 346, 352 (TTAB 1983) (Opposer "has a real interest sufficient to give it standing. The rationale is that a competitor should be free from harassment based on the presumed exclusive right which registration of a generic term would erroneously accord") (citation omitted). Based upon the foregoing, we find that opposer has demonstrated such an interest.

#### Claim of Mere Descriptiveness

We turn now to opposer's claim that DEALERDASHBOARD is merely descriptive of the services recited in the involved application. A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973). It further is settled that "[t]he question is not whether

someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods and services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002).

In this case, opposer has introduced dictionary definitions of the term DEALER. According to these definitions, DEALER is defined, inter alia, as "one engaged in buying and selling."<sup>14</sup> In addition, opposer has introduced by deposition and notice of reliance evidence of use by third parties of the term DEALER DASHBOARD or DASHBOARD to describe Internet-based goods or services that provide managerial and other information to businesses. The following examples are illustrative:

The Dealer Dashboard appears in your home page when you login to Autogate Pro. It provides a real time snapshot of the performance of your business. The dashboard gauges are clearly marked, with green indicating the ideal range. Using Autogate, you can ensure your dealership operates in the green, maximizing your return on investment.<sup>15</sup>

An auto dealership sales management dashboard  
<<The Dashboard Spy>>  
So what or who is The Dashboard Spy? As his about page states, The Dashboard Spy is just a guy interested in the design of business dashboards. He could not find any executive dashboard design source books and so set about creating his own. Finally convinced to post his extensive collection of dashboard screenshots online, he was amazed to

<sup>14</sup> The American Heritage College Dictionary, 3<sup>rd</sup> ed. (1993).

<sup>15</sup> Dalton Discovery Deposition, Exhibit 23 ([www.datamotive.com](http://www.datamotive.com)).

find how popular it has become.<sup>16</sup>

What is a Dashboard?

Known by many names (enterprise dashboard, executive dashboard, digital dashboard, business dashboard, business intelligence dashboard, performance dashboard, balanced scorecard, kpi summary, data visualization, and so on...), it's basically a way for business users to get an at-a-glance understanding of metrics of importance to them. In addition to acting as a summarization device, the dashboard also serves to highlight specific data and allows the user to drill down and inspect specific items. ...<sup>17</sup>

Using Siebel Dealer Dashboards (Dealer)

Siebel Dealer provides dealer employees with dashboards that allow them to view the most important information that they need for their work on one screen. The following dashboards are available:

Sales Consultant Dashboard. Includes actual and goal unit sales, today's activities, my calendar, current opportunities, and my promotions.

Sales Manager Dashboard. Includes actual and goal unit sales for team, today's activities, my calendar, current opportunities, team's promotion, and team's calendar.

Service Employee Dashboard. Includes today's activities, my calendar, my promotions, and current service requests.

Service Management Dashboard. Includes today's activities, my calendar, store promotions, and current service request for team.

Store Dashboard. Includes actual and goal unit sales for store, today's activities, my calendar, current opportunities, team's promotions, and teams calendar. To be used by the store general manager.<sup>18</sup>

Dashboard

From a simple excel dashboard to a fully

<sup>16</sup> Dalton Discovery Deposition, Exhibit 25 ([www.dashboardspy.com](http://www.dashboardspy.com)).

<sup>17</sup> Id.

<sup>18</sup> Id, Exhibit 27 (<http://download.oracle.com>).

integrated enterprise reporting suite, the Business Dashboard is being quickly adopted as the new face of Business Intelligence. An enterprise dashboard allows at-a-glance visualization of company health and monitoring of key performance indicators. Simple to understand and high in ROI, these executive dashboards are becoming "must-haves" for all enterprises. ...<sup>19</sup>

#### Dealer Dashboard

Dealer Dashboard Key Performance Indicators (KPI's) provide the dealer and service manager with visibility to the crucial numbers that drive the performance of the service department. You have the ability to set target goals for the average labor dollars per repair order, one line work order percentages and average hours per repair order and see the results by year, month, week or day. By comparing it to the prior year's results, you have visibility to improvements in your department and more importantly areas of concern.<sup>20</sup>

#### Denon Dealer Dashboard

The Dealer Dashboard is the easiest way for Denon dealers to get the latest information on Denon products, events, company information and more. As a Denon dealer, the Dashboard provides you with all kinds of product related items such as downloads, images, sell sheets, and more.<sup>21</sup>

In addition ADP Lightspeed provides a New Dealer Dashboard that will allow a user to customize their view of performance factors and track what is important to them and their department. For instance sales managers can pick out the specific performance indicator views as critical in managing their people and departments and easily view them at any time. The charts and graphs are real time and reflect actual transactions as they happen. The Dashboard makes it easy to know what is happening in the dealership right now, when

<sup>19</sup> Id., Exhibit 28 ([www.enterprise-dashboard.com](http://www.enterprise-dashboard.com)).

<sup>20</sup> Id., Exhibit 29 ([www.goallinesolutions.com](http://www.goallinesolutions.com)).

<sup>21</sup> Id., Exhibit 30 (<http://ca.denon.com>).

it's most important.<sup>22</sup>

Excel 2007 Dashboards & Reports For Dummies  
Full-color inserts show dashboard reports you can  
create.

Excel 2007 offers some new conditional formatting  
rules that allow you to add icons to your  
dashboards. With icons, you can represent and  
distinguish values from one another by using  
different shapes and colors. ...<sup>23</sup>

The evidence of record, of which the above is a sample,  
supports a finding that DASHBOARD possesses a recognized  
meaning in the field of Internet-based business information  
tracking and presentation. Specifically, a DASHBOARD is a  
real-time graphical presentation of business information  
regarding sales, service, parts or inventory, and costs,  
displayed as the gauges, lights and numbers on an automobile  
dashboard. A DEALER DASHBOARD is the graphical display of  
sales, service and other information relating to businesses  
engaged in buying and selling goods, particularly  
automobiles. As such, DEALERDASHBOARD merely describes,  
without conjecture or speculation, a significant  
characteristic or feature of applicant's services, namely,  
that they provide Internet-based information regarding  
sales, service, and inventory or parts to automobile  
dealerships. The evidence of record demonstrates that the

<sup>22</sup> Dalton Discovery Deposition, Exhibit 21 ([www.boating-industry.com](http://www.boating-industry.com)).

<sup>23</sup> Mangan Testimony, Exhibit 21 (Excel 2007 Dashboards & Reports for Dummies, Wiley Publishing, Inc. (2008)).

term DEALERDASHBOARD is recognized and used by numerous third parties to describe Internet-based goods and services that are used to provide such information. We find, therefore, that DEALERDASHBOARD merely describes the services identified thereby within the meaning of Trademark Act § 2(e)(1); 15 U.S.C. § 1052(e)(1).

#### Claim of Genericness

As discussed above, the evidence of record establishes that DEALERDASHBOARD merely describes a function, feature or use of the recited services. However, we find the evidence of record is not sufficient to support a finding that DEALERDASHBOARD is a generic designation for such services.

A mark is a generic name if it refers to the class, genus or category of goods and/or services on or in connection with which it is used. See *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), citing *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). The test for determining whether a mark is generic is its primary significance to the relevant public. See Section 14(3) of the Act. See also *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551 (Fed. Cir. 1991); and *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, *supra*.

Opposer correctly states that we analyze the primary significance of the designation in question to the relevant public by determining

[f]irst, what is the category or class of the goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?

*H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 228 USPQ at 530 (Fed. Cir. 1986). In this case, we agree with opposer that the category or class of the services at issue is Internet-based information provided to automobile dealerships regarding sales, services and parts. However, the evidence of record falls short of establishing that the relevant consuming public recognizes DEALERDASHBOARD primarily to refer to that genus of services. As a result, we are constrained to find on the record before us that opposer has failed to meet its burden of establishing that DEALERDASHBOARD is a generic term as applied to the recited services.

#### **Acquired Distinctiveness**

We note that applicant applied for the mark DEALERDASHBOARD on the Principal Register without a claim of acquired distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f). We further note that applicant did not plead acquired distinctiveness in his answer to the notice of opposition. Applicant's assertion of "exclusive

and continuous use of the source identifier and organizational servicemark DealerDashboard beginning October 5, 1999,"<sup>24</sup> even if construed as a claim of acquired distinctiveness, is not supported by declaration, affidavit, or evidence. It is settled that applicant has the burden to establish a prima facie case of acquired distinctiveness. See *Yamaha International Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988).

Accordingly, we find that applicant has failed to assert a claim of acquired distinctiveness; and to the extent that applicant's statements in his answer to the notice of opposition may be construed as asserting such a claim, there is no evidentiary support therefor in the record.

#### Opposer's Remaining Claims

Having found that applicant's mark is merely descriptive, we do not reach the issue of whether applicant failed to use the DEALERDASHBOARD mark in connection with all of the services recited in the involved application. In addition, opposer's unpleaded claim of fraud, asserted for the first time in its brief on the case, will be given no consideration.

DECISION: Opposer's opposition to the registration of application Serial No. 78339571 is sustained on the ground

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<sup>24</sup> Answer, para 1.

of mere descriptiveness.