

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

In the matter of Application Serial No. 78/751,105
Published for Opposition in the OFFICIAL GAZETTE on December 12, 2006

UMG RECORDINGS, INC.

Opposition No.: 91176791

Opposer

v.

MATTEL, INC.,

Applicant

APPENDIX OF CASES TO OPPOSER UMG RECORDINGS, INC.'S
REPLY IN SUPPORT OF TRIAL BRIEF AND OPPOSITION
TO TRIAL BRIEF OF MATTEL, INC.,
PURSUANT TO OFFICIAL GAZETTE NOTICE OF 23 JANUARY 2007

Pursuant to Official Gazette Notice No. 11 published January 23, 2007, Opposer UMG Recordings, Inc. hereby submits true and correct copies of the following decisions in connection with its Trial Brief in support of its Notice of Opposition.

- (1) In re Friends in the West, No. 74584732 (TTAB 1997).
- (2) In re Stephens Media Intellectual Property, LLC, 2003 WL 21030264 (TTAB 2003).
- (3) Kipling Apparel Corp. v. Michael Rich, 2007 WL 1207190 (TTAB 2007).
- (4) The Pep Boys Manny, Moe & Jack v. Hanharutaivan, 2004 WL 2368468 (TTAB 2007).

Dated: March 15, 2010

Respectfully submitted,



Alexa L. Lewis, Esq.
Mitchell Silberberg & Knupp LLP
11377 West Olympic Boulevard
Los Angeles, CA 90064
(310) 312-3100
Attorneys for Opposer

CERTIFICATE OF MAILING

Date of Deposit: March 15, 2010

“Express Mail” mailing label number: EB519288551US

I hereby certify that this paper or fee, **APPENDIX OF CASES TO OPPOSER UMG RECORDINGS, INC.’S REPLY IN SUPPORT OF TRIAL BRIEF AND OPPOSITION TO TRIAL BRIEF OF MATTEL, INC., PURSUANT TO OFFICIAL GAZETTE NOTICE OF 23 JANUARY 2007**, is being deposited with the United States Postal Service “Express Mail Post Office to Addressee” on the date indicated above and is addressed to: UNITED STATES PATENT AND TRADEMARK OFFICE, Trademark Trial and Appeal Board , P.O. Box 1451, Alexandria, Virginia 22313-1451.


Kimberly Stewart

PROOF OF SERVICE

STATE OF CALIFORNIA, COUNTY OF LOS ANGELES

I am employed in the county of Los Angeles, State of California. I am over the age of 18 and not a party to the within action. My business address is Mitchell Silberberg & Knupp LLP, 11377 West Olympic Boulevard, Los Angeles, California 90064-1683 .

On March 15, 2010, I served a copy of the foregoing document(s) described as **APPENDIX OF CASES TO OPPOSER UMG RECORDINGS, INC.'S REPLY IN SUPPORT OF TRIAL BRIEF AND OPPOSITION TO TRIAL BRIEF OF MATTEL, INC., PURSUANT TO OFFICIAL GAZETTE NOTICE OF 23 JANUARY 2007** on the interested parties in this action at their last known address as set forth below by taking the action described below:

Lawrence Y. Iser (liser@kwikalaw.com)

Direct (310) 566-9801

Direct Fax (310) 566-9861

Counsel for Applicant,
MATTEL, INC.

Patricia A. Millett (pmillet@kwikalaw.com)

Direct (310) 566-9821

Direct Fax (310) 566-9870

Chad R. Fitzgerald (CFitzgerald@kwikalaw.com)

Direct 310.566.9802

Direct Fax 310.566.9882

Kinsella, Weitzman, Iser, Kump & Aldisert LLP

808 Wilshire Boulevard, 3rd Floor

Santa Monica, CA 90401

(310) 566-9800

Fax: (310) 566-9850

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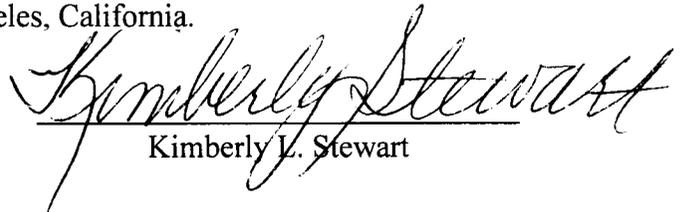
am readily familiar with the firm's practice for collection and processing of correspondence for mailing with the United States Postal Service. Under that practice it would be deposited with the U.S. Postal Service on that same day with postage thereon fully prepaid at 11377 West Olympic Boulevard, Los Angeles, California 90064-1683 in the ordinary course of business.

- BY ELECTRONIC MAIL:** I served the above-mentioned document electronically at ___:___ .m. on the parties listed at the email addresses above and, to the best of my knowledge, the transmission was complete and without error in that I did not receive an electronic notification to the contrary.
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I declare that I am employed in the office of a member of the State Bar of California and various federal bars, at whose direction such service was made.

I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

Executed on March 15, 2010, at Los Angeles, California.



Kimberly L. Stewart

APPENDIX CASE 1

APPENDIX CASE 1

THIS DISPOSITION IS NOT CITABLE AS
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JULY 21, 97

Paper No. 9
GDH/TAF

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Friends in the West

Serial No. 74/584,732

Clark A. Puntigam of Jensen & Puntigam, P.S. for Friends in the West.

Darren B. Cohen, Trademark Examining Attorney, Law Office 101
(Christopher Wells, Managing Attorney).

Before Hanak, Hohein, and Hairston, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Friends in the West has filed an application to register the designation "AFRICAN CHILDREN'S CHOIR" for "charitable fund raising services, featuring a choir".¹

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis

¹ Ser. No. 74/584,732, filed on October 12, 1994, which alleges dates of first use of January 1985.

that, when used in connection with applicant's services, the phrase "AFRICAN CHILDREN'S CHOIR" is merely descriptive of them.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

It is well settled that a designation or term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a designation or term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the designation or term describes a significant attribute or idea about them. Moreover, whether a designation or term is merely descriptive is determined not in the abstract but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the designation or term would have to the average purchaser of the goods or services because of the manner of its use. See *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Consequently, "[w]hether consumers could guess what the product [or service] is from consideration of the

mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

Applicant, referring to the brochures which it submitted as specimens, points out that, as indicated therein, the funds which it raises "are not primarily used to support a children's choir from Africa". Instead, applicant notes, "[t]he funds are used to provide food, shelter and education for needy children in Africa," irrespective of whether the children "sing in choirs or even sing at all." Thus, according to applicant, "[t]he children who sing in the choir are only a small portion of the large number of children receiving the benefits of the funds" which applicant raises and, hence, the designation "AFRICAN CHILDREN'S CHOIR" is not merely descriptive of a characteristic or feature of its services.

Applicant, although conceding that "a choir is in fact used to assist in the rendering of the services," further argues that:

There is no common or typical association in the mind of the consumer between a choir and fund raising services. While the identification of services does use the phrase "featuring a choir," the inclusion of that phrase should not be the basis of a [mere] descriptiveness refusal, since, as indicated above, that aspect (the use of a choir) of the services is ancillary and tangential to the basic thrust of the services, i.e. fund raising services for humanitarian purposes. The participation of a choir in the rendering of such services is not a conventional aspect of such services, nor is it a common characteristic of such services. In this case, when the average customer thinks of fund raising

Ser. No. 74/584,732

services and normal characteristics or features thereof, the participation of a choir does not ordinarily come to mind.

In addition, applicant urges that since its mark as a whole must

be merely descriptive of the services identified in its application, "the mark 'African Children's Choir' does not convey an immediate idea of the stated services because, even though such services are set forth as "charitable fund raising services, featuring a choir," the designation "AFRICAN CHILDREN'S CHOIR" "suggests absolutely nothing about fund raising services". Applicant consequently maintains that in the absence of "a descriptive connection between African Children's Choir as a whole and fund raising services," such designation is not merely descriptive of its services.

We agree with the Examining Attorney, however, that the designation "AFRICAN CHILDREN'S CHOIR" immediately describes, without conjecture or speculation, a significant aspect or feature of applicant's fund raising services, namely, the African children's choir which, as the Examining Attorney accurately observes, "serves as the focal point of the fund raising activities" provided by applicant. As the Examining Attorney correctly points out, it is not necessary that a designation or term describe every characteristic, feature, purpose, function ingredient, quality or other aspect of the services in order for it to be merely descriptive. It is sufficient, instead, if the designation or term simply describes one significant attribute of the services. See, e.g., In re Aid Laboratories, Inc., 223 USPQ 357, 358-59 (TTAB 1984); In re H.U.D.D.L.E, 216 USPQ 358, 359 (TTAB 1982); and In re MBAssociates, 180 USPQ 338, 339 (TTAB 1973).

Here, that a choir of children from Africa serves as a significant element of applicant's services, rather than simply a ancillary and tangential aspect thereof, is evidenced not only by the fact that the services are specifically identified as "charitable fund raising services, featuring a choir," but by the fact that the specimens of record prominently and repeatedly feature references to applicant's African children's choir as the focal point of applicant's fund raising activities. Admittedly, as pointed out by applicant, its brochures state that applicant "cares for more than 700 needy, homeless African children in family-like homes" by providing "food, shelter and education to children with no other chance of survival" and that it also provides "literacy schools for many other children who don't live in our homes." However, applicant's brochures also indicate that a significant feature of its charitable fund raising services revolves around and is centered upon the performances presented by its African children's choir.

In this regard, we observe that, in addition to listing a telephone number which a person may call "[f]or more information, or to find out about having the African Children's Choir perform for your church or organization," the brochures state that applicant is "the choir's parent organization"; that "[t]he purpose of the African Children's Choir is to help create new leadership for tomorrow's Africa"; that "[c]hoir members have the additional benefit of international travel with the choir which exposes them to a wide variety of people, places and perspectives"; that contributors can "[v]olunteer to help with

the African Children's Choir"; that donors can "[c]ommit a monthly amount as a 'Friend of the Children' choir sponsor"² to "provide the choir children with clothing, food and educational materials, as well as help with the choir's travel and medical expenses"; and that audiences "can see joy in every performance of the African Children's Choir!"

Clearly, as shown by the specimen brochures, the African children's choir which applicant sponsors constitutes a significant, if not *the* significant, feature of its fund raising services since the choir functions as an integral part of such services, acting both as a draw for and a recipient of the charitable contributions raised by applicant. The asserted fact that applicant's services are unconventional, in the sense that the participation of a choir is used in the rendering of its services, is not only unsupported by any evidence that appearances by a choir are unusual in connection with fund raising activities, but even if such is the case, such a fact is not dispositive where, as here, the designation "AFRICAN CHILDREN'S CHOIR" unequivocally projects a merely descriptive connotation. See *In re MBAssociates, supra*. As the Examining Attorney persuasively points out: "[T]he featured characteristic of the services, and, indeed, the unique quality of these charitable services, is that a choir, specifically, a children's choir from Africa, serves as the focus of the fund raising."

² Besides inviting donors to "become a CHILD SPONSOR by giving \$25 per month per child," the brochures separately set forth an invitation for donors to "become a FRIENDS OF THE CHILDREN month choir sponsor."

Ser. No. 74/584,732

Accordingly, because the designation "AFRICAN CHILDREN'S CHOIR" conveys forthwith a significant feature of applicant's charitable fund raising services, namely, the African children's choir featured in conjunction therewith, such term is merely descriptive within the meaning of the statute.

Decision: The refusal under Section 2(e)(1) is affirmed.

E. W. Hanak

G. D. Hohein

P. T. Hairston
Administrative Trademark Judges,
Trademark Trial and Appeal Board

APPENDIX CASE 2

APPENDIX CASE 2

Westlaw.

2003 WL 21030264 (Trademark Tr. & App. Bd.)

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2003 WL 21030264 (Trademark Tr. & App. Bd.)

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board
Patent and Trademark Office (P.T.O.)

IN RE STEPHENS MEDIA INTELLECTUAL PROPERTY, LLC

Serial Nos. 75/712,211; 712,212; 712,213

May 5, 2003
Hearing: November 12, 2002

Steven A. Gibson of Santoro, Driggs, Walch, Kearney, Johnson & Thompson for Stephens Media Intellectual Property, LLC

Michael W. Baird, Trademark Examining Attorney
Law Office 109
(Ronald R. Sussman, Managing Attorney)

Before Cissel, Walters and Bottorff
Administrative Trademark Judges
Opinion by Cissel
Administrative Trademark Judge:

The above-referenced applications were filed on May 24, 1999 by DR Partners, a partnership organized and existing under Nevada law. All three applications were subsequently assigned to Stephens Media Intellectual Properties, LLC, prior to the filing of the Notice of Appeal. The marks in these use-based applications (in ascending file-number order) are as follows:

lasvegas.com
one city. one site.

LASVEGAS.COM
ONE CITY. ONE SITE.
and
LASVEGAS.COM

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Exhibit 2
Page 11

As amended, the recitations of services are all as follows: "providing online websites featuring information such as that generally found in daily newspapers, as well as information in the fields of news, politics, public policy, and technology." All three applications are before the Board on appeals from final refusals based on the Examining Attorney's holding that the terminology "LASVEGAS.COM" is merely descriptive in connection with the recited services. In the first two applications, the Examining Attorney required disclaimers of this terminology under Section 6 of the Lanham Act, and in the other application, seeking registration of the term by itself, he refused registration under Section 2(e)(1) of the Act on the ground of descriptiveness.

The records and the issues are essentially identical in each of these applications, so after the appeals were instituted, they were consolidated. The briefs submitted by applicant and the Examining Attorney dealt with all three applications, and at the oral hearing before the Board, all three appeals were argued. This opinion explains our reasoning with respect to all three. Applicant does not dispute the fact that if we find the term to be merely descriptive in connection with the services recited in these applications, the refusal to register in the application for the term by itself must be affirmed and the requirements for disclaimers in the other two applications also must also be affirmed.

The sole issue in these appeals is therefore whether "LASVEGAS.COM" is merely descriptive of the services set forth in the amended applications. Based on careful consideration of the records in the applications, the arguments of applicant and the Examining Attorney and the relevant legal precedents, we hold that it is, and therefore that the refusals to register must be affirmed.

*2 The records include evidence submitted by both applicant and the Examining Attorney. The specimens of use submitted with the application as filed are copies of the page from applicant's website. The main headings include "Visit Las Vegas," "Living in Las Vegas" and "Move to Las Vegas." A line at the bottom of this page shows that the website is "brought to you by the Las Vegas Review-Journal."

Responsive to the first Office actions, applicant submitted several advertisements from its website which are not related to Las Vegas. On each page where such an advertisement appears, however, there is other information directly related to Las Vegas, e.g., promotion of the "Las Vegas Senior Classic" golf tournament; a horse jumping competition which is "headed to Las Vegas, the Entertainment Capitol of the World"; and ski areas which are "a short drive from Las Vegas and are frequented by Las Vegas visitors and locals."

Responsive to the second Office Actions, applicant conceded that "... it is true that the website that is associated with the mark depicts content contextual to Las Vegas," but applicant maintained that its services are not limited to providing information about Las Vegas. Along with the responses, applicant listed ten third-party registered marks for services which applicant argued are similar to the services specified in the instant applications. Each mark included an arguably geographic designation combined with computer terminology such as "Web," or "Internet." Responsive to applicant's responses, the Examining Attorney submitted a dictionary definition showing that Las Vegas is a well-known city in Nevada and a computer glossary establishing that ".com" is a top-level domain indicator used to signify a commercial enterprise. Applicant countered with copies of the ten third-party registrations it had listed in response to the first Office Actions, as well as with several links from its website that do not appear to relate to the city of Las Vegas. Interestingly, this evidence also makes it clear that applicant's website also provides information that is directly related to living and or visiting Las Vegas.

Submitted in conjunction with applicant's brief on appeal were copies of several third-party registrations which had previously been made of record. Also submitted, however, were copies of six additional third-party registra-

tions which had not been made of record prior to the appeal.^[FN1] In his brief, the Examining Attorney properly objected to the Board's consideration of this untimely-submitted evidence. His objection is sustained under Trademark Rule 2.142(d). The record should be complete prior to filing a Notice of Appeal. Accordingly, we have not considered those registrations or the copies submitted with applicant's reply brief. Moreover, even if we had, as discussed below, our resolution of these appeals would not have been different.

*3 Turning to the merits of this controversy, we note that the tests for mere descriptiveness and the propriety of requiring a disclaimer are well settled. Section 2(e)(1) of the Act precludes registration of the term which is merely descriptive in connection with the services for which it is sought to be registered. The term is merely descriptive under the Act if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). Section 6(a) of the Act requires an applicant to disclaim a descriptive component of an otherwise registrable mark.

The evidence submitted by the Examining Attorney establishes that Las Vegas is a well-known city in Nevada. The elimination of the space between "LAS" and "VEGAS" in the mark as presented in the drawing does not change the significance of the term, which is still recognizable as the name of the city. The Examining Attorney also made of record evidence showing that the designation ".COM" is a top-level domain indicator which would be recognized as part of an Internet address for a business. As such, the suffix has no source-indicating significance because it merely indicates that the business which operates at that address is a commercial entity.

Plainly, when the geographic designation is combined with the domain indicator, the primary significance of the term is that of a website relating to Las Vegas. There is no question that "LASVEGAS.COM" is merely descriptive of the service of providing an online website featuring information about Las Vegas. The mark describes the subject matter of the services and the fact that they are rendered by means of the website. These are significant characteristics of the service of providing an online website featuring information about Las Vegas. Applicant does not appear to disagree with this proposition.

The heart of the dispute before us, however, centers on the fact that the recitation of services in these three applications does not mention provision of information about the city of Las Vegas, but instead only refers in general terms to "information such as that generally found in daily newspapers, as well as information in the fields of news, politics, public policy, and technology." Applicant predicates its argument in favor of registration on the well-established principle that in order for a refusal under Section 2(e)(1) of the Act to be appropriate, the mark must be merely descriptive in connection with the services as they are identified in the application, rather than in connection with other activities which applicant may or may not render, but in connection with which registration is not being sought. Applicant argues that unless the recitation in these applications specifically mentions services related to Las Vegas, the term sought to be registered cannot be held to be merely descriptive of the services under the law.

*4 Applicant's analysis is flawed, however. Applicant does not dispute the fact that the evidence of record shows that applicant does render services relating to Las Vegas. As noted above, although there is information which is apparently unrelated to Las Vegas available on applicant's website, a substantial amount of the information applicant provides on its website is in fact related to that city.

The key here is that although the recitation of services does not specify services relating to Las Vegas, such services are encompassed within the recitation as it stands. Any reasonable reading of the broad language in the re-

citation, "providing online websites featuring information such as that generally found in daily newspapers," necessarily includes providing online information about Las Vegas because the term "daily newspapers" includes Las Vegas daily newspapers and such information would be expected to be found in a Las Vegas newspaper, which is exactly what the Las Vegas Review-Journal is. (As we noted above, on applicant's website there is a statement that the Las Vegas Review-Journal is the entity which brings applicant's services to visitors to the website.)

Because providing an online website featuring information about Las Vegas such as that which can be found in a daily Las Vegas newspaper is encompassed within the broad recitation of services common to these applications, the mark applicant seeks to register is merely descriptive of the services within the meaning of the act. The mark conveys significant information about the nature of the services, namely that they include online information about Las Vegas.

Applicant also argues that refusing registration of the marks in these applications is contrary to the past practice of the Patent and Trademark Office, pointing in support of this contention to the third-party registrations of record for what it argues are similar marks registered for similar services. The Examining Attorney argues that the Patent and Trademark Office policy with regard to this area of trademark law was specifically addressed by clarifications and changes made by Examination Guide No. 2-99, issued in September of 1999, and that since then, no registrations have been issued in situations analogous to the one presented by the instant applications. Both applicant and the Examining Attorney present arguments on whether or not the third-party registrations applicant made of record were or were not issued in accordance with the examination procedures in effect at the times of their issuance, but this is really not persuasive of either the result urged by the Examining Attorney or the one asserted by applicant. The fact is that whether or not the operative guidelines were adhered to when these registrations issued is not a factor in our decision-making process. We are no more bound by the administrative practice guidelines which have been provided to Examining Attorneys to assist in the examination of applications than we are bound by examination errors committed in attempting to comply with such guidelines. Put another way, even if the third-party registrations issued erroneously, we are not bound to repeat such mistakes. Neither applicant nor the Examining Attorney has identified any legal precedent by which this Board is bound which is on all fours with the fact scenario with which we are presented in the instant appeals.

*5 In summary, the term "LASVEGAS.COM" is merely descriptive of the services broadly recited in these three applications because it conveys significant information about their nature, namely that they include online provision of information about Las Vegas. That "Las Vegas" has been compressed by elimination of the space between the two words does not alter the significance of the term any more than combining it with the top-level domain indicator does.

DECISION: The refusal to register the term by itself is affirmed under Section 2(e)(1) of the Act, as are the requirements under Section 6(a) for disclaimers of the descriptive term in the other two applications. This decision will be set aside with respect to application S.N.s 75/712,211 and 75/712,212 if applicant, within thirty days of the mailing of this decision, submits an appropriate disclaimer in each of the two applications. See Trademark Rule 2.142(g). A properly worded disclaimer would read: "No claim is made to the exclusive right to use LASVEGAS.COM apart from the mark as shown."

FN1. Registration Nos. 2,477,319; 2,419,696; 2,317,982; 2,249,377; 2,312,431 and 2,432,007.

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WL

21030264

(Trademark Tr. & App. Bd.)
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Exhibit 2
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APPENDIX CASE 3

APPENDIX CASE 3

Westlaw.

2007 WL 1207190 (Trademark Tr. & App. Bd.)

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2007 WL 1207190 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board
Patent and Trademark Office (P.T.O.)

KIPLING APPAREL CORP.

v.

MICHAEL RICH

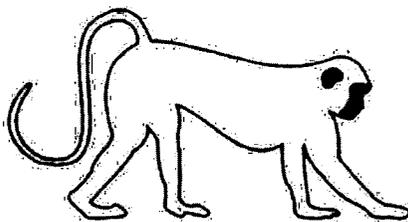
OPPOSITION 91170389

April 16, 2007

Before Walters, Bucher and Cataldo
Administrative Trademark Judges

By the Board:

Applicant seeks to register the mark



M O N O R I C O

for "clothing, namely, pants, shorts, sweatpants, overalls, shirts, tee-shirts, sweatshirts, dresses, skirts, blouses, jackets, vests, coats, rainwear, lingerie, sleepwear, underwear, loungewear, beachwear, swimwear, infantwear, gloves, socks hoisery, belts." [FN1] The application was filed based on use under Trademark Act §1(a). The following statement preceded the identification of goods:

The applicant, or the applicant's related company or licensee, is using the mark in commerce, and lists below the dates of use by the applicant, ..., of the mark on or in connection with the identified goods

The following statement followed the identification of goods:

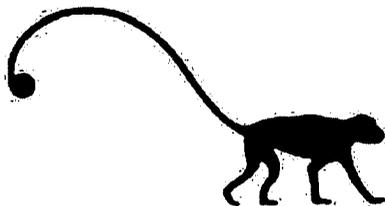
In International Class 025: the mark was first used at least as early as March 7, 2005, and first used in commerce at least as early as March 7, 2005, and now is in use in such commerce.

The application was accompanied by a signed declaration attesting to the truth of the statements made in the application.

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Exhibit 3
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As grounds for the opposition, opposer alleges 1) likelihood of confusion with its previously registered marks consisting in whole or in part of the following long tailed monkey design:^[FN2]



and 2) fraud on the United States Patent and Trademark Office (USPTO) because applicant was not using his mark on all the goods identified in the application at the time he filed his use-based application yet he included a verified statement of use for all goods listed. Opposer alleges further that applicant knew "or believed" that the statement was false and made such statement with the intent of inducing the USPTO to rely thereon and allow the application to publish.

In his answer, applicant admits filing his application with a statement that he was using his mark in commerce on all of the identified goods and that the application contained a declaration.^[FN3] Applicant admits that he made a mistake and should have separated the goods that were currently in use, "namely, shirts and hats," from "the remainder of the goods that were to be used in commerce."^[FN4] Applicant further admits opposer's ownership of its pleaded marks "associated with the Registrations listed..."^[FN5] Applicant otherwise denies the essential allegations of the notice of opposition. Applicant's denials of the remaining fraud allegations are qualified with explanations. Applicant admits a mistake was made in the application process whereby he inadvertently selected to file his application completely under Trademark Act §1(a), use in commerce, instead of under Trademark Act §1(b), intent to use, at least in part. Applicant alleges that he was unaware at the time of filing that he was doing so incorrectly and submits an affidavit in support thereof with his answer.

*2 This case now comes up on opposer's motion, filed October 12, 2006, for summary judgment in its favor on its claim of fraud. The motion is fully briefed.

In support of its motion, opposer argues that applicant has committed fraud in attempting to procure a registration for his involved mark, thus making the involved application void ab initio. More specifically, opposer argues that applicant has admitted in his answer and affidavit accompanying his answer that, at the time of the filing date of the application, he was only using his mark on "shirts and hats" and not on all of the remaining identified goods.^[FN6] Opposer contends that applicant's misstatement of fact is material to the application and of the type that applicant knew or should have known was false.

Opposer relies on the admissions in applicant's answer and applicant's statements in his accompanying affidavit.

In response, applicant, also relying on his affidavit, notes that he was not represented by counsel and argues that he filed the application in good faith and believed at the time he signed the declaration supporting the application that he did so correctly. Applicant states that he did not realize he made a mistake until the Notice of Opposition was filed and he requests an opportunity to correct the application. Applicant also argues that he is the owner of Registration No. 3089320 for the mark MONORICO for essentially the same goods for which he now seeks to register his MONORICO and long tailed monkey design mark. Applicant argues that he did not have a

willful intent to deceive the USPTO but believed he was entitled to a registration because the word portion of the subject mark is the same as his registered mark and both involve the same goods.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue 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 USPQ 1542 (Fed. Cir. 1992).

Fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes false, material representations of fact in connection with an application to register. *See Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986). Statements regarding the use of the mark on goods and services are certainly material to issuance of a registration covering such goods and services. *See First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628 (TTAB 1988). *See also Hachette Filipacchi Presse v. Elle Belle, LLC*, ___ USPQ2d ___ (TTAB April 9, 2007);^[FN7] *Hurley International LLC v. Paul and Joanne Volta*, ___ USPQ2d ___ (TTAB January 23, 2007);^[FN8] *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917 (TTAB 2006); and *Medinol Ltd. v. Neuro Vasx, Inc.*, 67 USPQ2d 1205 (TTAB 2003).

*3 In this case, opposer has established the absence of genuine issues of material fact for trial with regard to its claim of fraud and that it is entitled to summary judgment in its favor on this ground.

There is no dispute, and applicant has admitted, that applicant had not used his mark in connection with most of the goods identified in his application at the time he filed his use-based application. His application included a declaration attesting to the truth of all the statements made in the application. The subject application, filed under Section 1(a) of the Trademark Act, would have been refused registration but for applicant's misrepresentation regarding his use of the mark. Prior to publication, applicant had an opportunity to remedy the matter because a misstatement in an application as to the goods or services on which a mark has been used does not rise to the level of fraud where an applicant amends the application prior to publication. *See Universal Overall Co. v. Stonecutter Mills Corp.*, 154 USPQ 104 (CCPA 1967). However, applicant cannot now correct the false statement in the involved application. Rather, his remedy lies with filing a new application relying on an appropriate and correct basis.

In inter partes proceedings, "... fraud occurs when an applicant or registrant makes a false material representation that the applicant or registrant knew or should have known was false." *See General Car and Truck Leasing Systems, Inc. v. General Rent-A-Car, Inc.*, 17 USPQ2d 1398, 1400 (D.C. S.Fla. 1990). The fact that applicant misunderstood a clear and unambiguous requirement for a use-based application and was not represented by legal counsel does not shield applicant from our finding that he knew or should have known that the representation of fact in his application was false. Nor does such circumstance otherwise preclude our finding of fraud. *See Hurly, supra*. Even if applicant did not act willfully or in bad faith, it was not reasonable for applicant to state use dates in a use-based application for goods upon which he had no use. Applicant was under an obligation to investigate thoroughly the validity of his belief before signing the declaration in support of the application. *Id.* Further, this representation is clearly material to the application.

We find that there are no genuine issues of material fact that applicant's misrepresentation was material and,

thus, fraudulent, thus making the application void ab initio. Accordingly, opposer's motion for summary judgment is granted on its fraud claim only and the opposition is sustained.

In view of our finding of fraud, and because opposer did not move for summary judgment on its likelihood of confusion claim, we need not reach the issue of likelihood of confusion.

FN1. Application Serial No. 76643592, filed July 25, 2005.

FN2. Registration No. 2806067 consists solely of the design. Registration No. 1952995 is for the mark KIP-LING and design. Registration No. 1511776 is for the mark KIPLING BACK TO THE BAG and design.

FN3. Paragraph Nos. 16-18 of the notice of opposition and answer, respectively.

FN4. Paragraph Nos. 19 and 20 of the answer.

FN5. Paragraph No. 9 of the notice of opposition and answer, respectively.

FN6. Paragraph no. 20 of applicant's answer; paragraph no. 6 of applicant's affidavit.

FN7. Cancellation No. 92042991.

FN8. Opposition No. 91158304.

2IED4AE5D1F42A4E779F54135407FEE4BDimage/png20421px501.0701.03001.401ID0CDE6FFAD404A960
0ECF1D2BC58B15Eimage/png9424px390.0683.03001.4022007 WL 1207190 (Trademark Tr. & App. Bd.)
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APPENDIX CASE 4

APPENDIX CASE 4

Westlaw.

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Page 1

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2004 WL 2368468 (Trademark Tr. & App. Bd.)

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board
Patent and Trademark Office (P.T.O.)

THE PEP BOYS MANNY, MOE & JACK OF CALIFORNIA

v.

TEERA
HANHARUTAIVAN
AND KRIENG WONGTANGJAI

Opposition No. 91105133 against Application Serial No. 74519445

September 29, 2004

Marsha G. Gentner and Matthew J. Cuccias of Jacobson Holman, PLLC for The Pep Boys Manny, Moe & Jack of California

Jon Michaelson, Christine Redfield and Kristin Ring, of Coudert Brothers LLP for Teera **Hanharutaivan** and Krieng Wongtangjai

Before Simms, Quinn and Bucher
Administrative Trademark Judges
Opinion by Bucher
Administrative Trademark Judge:

Teera **Hanharutaivan** and Krieng Wongtangjai seek registration on the Principal Register of the mark shown below:



for goods identified in the application, as amended, as follows:

“truck accessories, namely front and rear bumper, vehicle seats, camper shell, gear shift lock, wheel house liner, anti-theft door security lock, anti-sway bar, finished safety glass windows for vehicles and side bumper,” in International Class 12, and

“fit floor tray, namely floor mats for vehicles,” in International Class 27.^[FN1]

On February 12, 1997, registration was opposed by MMJ Corporation, a predecessor in interest to The Pep Boys Manny,

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Moe & Jack Of California, on the grounds of likelihood of confusion, dilution and that the application is void *ab initio*. During the prosecution of this opposition, opposer alleged and tried a fourth ground, namely, fraud on the United States Patent and Trademark Office.

The first ground for the current opposition, under Section 2(d) of the Trademark Act, is based on the allegation that applicants' mark, when applied to applicants' goods, so resembles opposer's previously used and registered marks as to be likely to cause confusion, to cause mistake or to deceive as to source or sponsorship. Opposer has pleaded ownership of the following registered marks:



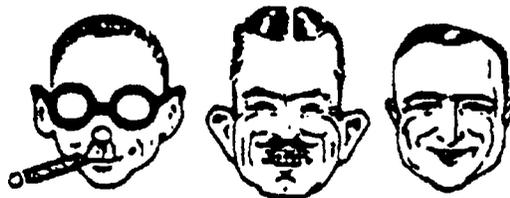
"high pressure lubricants, motor lubricating oils, transmission and differential lubricants," in International Class 4^[FN2]

PEP BOYS

"retail store services in the field of automotive accessories," in International Class 42^[FN3]

THE THREE BEST FRIENDS YOUR CAR EVER HAD

"retail store services in the field of automotive accessories," in International Class 42^[FN4]



"retail store services in the field of automotive accessories," in International Class 42^[FN5]

MANNY MOE & JACK

"retail store services in the field of automotive accessories," in International Class 42^[FN6]

PEP BOYS

"oil additive, transmission fluids, and power steering fluids," in International Class 1;

*2 "hand soap cleaners," in International Class 3; and

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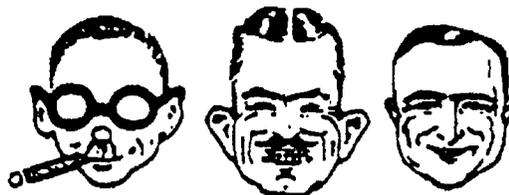
“batteries for land vehicles,” in International Class 9^(FN7)

MANNY, MOE & JACK

“vehicle servicing, repair and maintenance services and installation of vehicle parts,” in International Class 37^(FN8)

PEP BOYS

A “vehicle servicing, repair and maintenance services and installation of vehicle parts,” in International Class 37^(FN9)



“vehicle servicing, repair and maintenance services and installation of vehicle parts,” in International Class 37

PEP BOYS

“vehicle maintenance and repair services,” in International Class 37;

“retail automotive store services,” in International Class 42^(FN10)

1-800-PEPBOYS

“telephone counseling, namely, offering advice regarding motor vehicle maintenance and repair; motor vehicle maintenance and repair services,” in International Class 37^(FN11)

The Pep Boys
MANNY, MOE & JACK

“watches” in International Class 14;

“mugs” in International Class 21; and

“clothing, namely T-shirts, sweatshirts, denim jackets, tank tops, nightshirts.” In International Class 25^(FN12)

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PEP BOYS

“metal key rings, metal money clips,” in International Class 6;

“cigarette lighters made of precious metal, watches,” in International Class 14;

“correspondence holders, pens, playing cards, pen and pencil sets,” in International Class 16;

“tote bags, non-leather duffle bags, golf umbrellas, nylon backpacks,” in International Class 18;

“drinking glasses, mugs, portable beverage coolers; beverage insulators sold together as a unit with sport bottles sold empty, in International Class 21;

“caps, visors, clothing, namely, sweaters, polo shirts, golf shirts, jackets, pullovers, T-shirts, sweatshirts, denim jackets, cotton jackets, baseball jackets, tank tops, nightshirts,” in International Class 25^[FN13]

PEP BOYS

“metal key rings, metal money clips,” in International Class 6;

“cigarette lighters made of precious metal, watches,” in International Class 14;

“correspondence holders, pens, playing cards, pen and pencil sets,” in International Class 16;

“tote bags, non-leather duffle bags, golf umbrellas, nylon backpacks,” in International Class 18;

“drinking glasses, mugs, portable beverage coolers; beverage insulators sold together as a unit with sport bottles sold empty,” in International Class 21;

“beach towels” in International Class 24;

“caps, visors, clothing, namely, sweaters, polo shirts, golf shirts, jackets, pullovers, T-shirts, sweatshirts, denim jackets, cotton jackets, baseball jackets, tank tops, nightshirts,” in International Class 25; and

*3 “tossing disc toys, footballs, golf balls, teddy bears,” in International Class 28^[FN14]



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“watches” in International Class 14;

“mugs” in International Class 23; and

“clothing, namely, T-shirts, sweatshirts, denim jackets, tank tops, nightshirts,” in International Class 25^[FN15]

PEP BOYS EXPRESS

“retail stores featuring automotive parts and accessories,” in International Class 35^[FN16]



“retail stores featuring automotive parts and accessories” in International Class 35^[FN17]

PEP BOYS. LOS AUTOS NOS QUIEREN. LA GENTE NOS ADORA.

“retail stores featuring vehicle parts and related accessories,” in International Class 35; and

“vehicle repair and maintenance,” in International Class 37^[FN18]

PEPBOYS.COM

“providing information about automotive vehicles, automotive parts and accessories, and automotive maintenance and repair via a global computer network,” in International Class 42^[FN19]

Opposer also alleges that its PEP BOYS marks are distinctive and became famous long before the earliest date on which applicants can rely and that applicants' mark dilutes opposer's marks.

Thirdly, opposer claims that applicants' mark was not in use in commerce prior to the filing date of the application and, thus, the application is void *ab initio*.

Finally, opposer alleges that applicants have on more than one occasion made false, material representations to the Office that applicants knew were false.

Applicants, in their answer, denied the salient allegations of the opposition.

The record consists of the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by opposer of Frederick A. Stampone, opposer's senior vice president and chief administrative officer, Bernard Keith McElroy, vice president/chief accounting officer and treasurer, and William Vincent Furtkevic, director of marketing communications; status and title copies of opposer's pleaded registrations introduced by way of opposer's notice of reliance; applicants' responses to certain of opposer's written discovery requests, made of record in opposer's notice of reliance; trial testimony, with related exhibits, taken by applicants, of Yee Tantiyavarong, applicants' business partner in Truck Style, Inc., and of Lawrence J. Ireland, an investigator hired by applicants' attorney; the discovery deposition of Mr. Stampone, introduced by way of applicants' notice of reliance; as well as opposer's responses to certain of applicants' written discovery requests, made of record in applicants' notice of reliance. Both opposer and applicants filed main briefs on the case,

and opposer filed a short reply brief. The parties did not request an oral hearing before the Board.

Objections to Evidence

Opposer has made a series of objections to the testimony of Mr. Ireland based upon the fact that his statements are allegedly hearsay. Essentially, Mr. Ireland's testimony is limited to a review of his survey of half-a-dozen PEP BOYS stores in Southern California undertaken at the request of applicants' counsel. After visiting all six PEP BOYS locations, he issued a brief report of his observations. After his direct testimony, he was then fully cross-examined by opposer's counsel. To the extent Mr. Ireland testified to statements made by Pep Boys' employees, and applicants intended to offer these statements for the truth thereof, they comprise inadmissible hearsay and we have not considered them in reaching our decision herein. However, much of Mr. Ireland's testimony simply relates details of his store visits, what he observed, and he then offers for the record the catalogues he purchased at each stop as well as his written report. Hence, we regard most of Mr. Ireland's testimony as being admissible, although we find that it is of little probative value in deciding the issue of likelihood of confusion. Indeed, we find, *infra*, contrary to the thrust of Mr. Ireland's testimony, that applicants' goods herein are either identical to opposer's goods, or are closely related to opposer's goods and services.

*4 Opposer has also objected to the fact that Mr. Ireland talked to opposer's employees without going through opposer's appointed attorneys. However, on this issue, we also agree with applicants that Mr. Ireland's incidental contact with sales personnel at several Pep Boys stores, e.g., to find out if certain items were available at that location, and if so, where these items were displayed within the store, does not constitute impermissible contact with opposer.

As to opposer's various objections to Mr. Tantiyavarong's testimony on the ground that the questions posed by applicants' counsel were leading or that the witness's answers were nonresponsive, it is quite clear in reading this testimony that English is not Mr. Tantiyavarong's first language, and that applicants' counsel and the witness were doing their best to deal with this fact. Indeed, the transcript of the exchanges that opposer's counsel had with Mr. Tantiyavarong reflects this same challenge. Accordingly, we find this testimony admissible as taken.

Opposer also objected to a number of questions put to Messrs. Furtkevic and Stampone by applicants' attorney on the basis of attorney-client privilege, lack of personal knowledge, calling for legal conclusions, vagueness, etc. However, these objections were either dealt with at the time of the testimony, e.g., at the point of counsel's objection, the witness was not pressed to answer the question posed, or the witness demonstrated with his answer that he understood an allegedly confusing query. Moreover, on substantially all of the likelihood of confusion factors to which the relevant testimony of Messrs. Furtkevic and Stampone was directed, we have found in opposer's favor, *infra*.

Finally, opposer continues to object to applicants' claims of attorney-client privilege based on interaction with prior counsel. In an interlocutory order in this case dated August 28, 2002, the Board reviewed in detail how the underlying purpose of the attorney-client privilege supported its application in the instant case, that no waiver of a privilege had occurred when applicants and their agent submitted their declarations in opposition to opposer's first motion for summary judgment, disclosing information regarding their misunderstanding of the phrase "use in commerce," and hence the Board denied opposer's motion to compel production of privileged information. While we see no reason to reverse our earlier decision on this matter, we are sympathetic to opposer's arguments about the unfairness of applicants' use of this privilege in the context of litigating the question of fraud on the United States Patent and Trademark Office, and we will discuss this matter further, *infra*, at pp. 40 - 43.

Likelihood of Confusion

THERE IS NO ISSUE AS TO PRIORITY

Opposer has introduced into the record by way of its notice of reliance certified copies of its pleaded registrations, which show that they are valid, subsisting and owned by opposer. Thus, this proof removes the issue of priority from this case. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

LIKELIHOOD OF CONFUSION FACTORS

*5 Accordingly, as to the claim of priority of use and likelihood of confusion, the focus of our determination is on the issue of whether applicants' CARRY BOY and design mark, when used in connection with the goods set forth in their application, so resembles one or more of opposer's PEP BOYS marks, including those composite marks having its banner, images of Manny, Moe and Jack, etc., for its various goods and services as to be likely to cause confusion, to cause mistake or to deceive as to source or sponsorship.

The record demonstrates that opposer is a national retailer of replacement vehicle parts, supplies, accessories and tires as well as a provider of vehicle repair and maintenance services. Opposer renders such services through a chain of stores owned and managed by opposer. According to Mr. Furtkevic's testimony, opposer was operating 630 stores in thirty-six states and Puerto Rico, an increase from the 313 stores that it operated in seventeen states as of 1990. (Furtkevic Trial Deposition, pp. 11-13; Opposer's Exhibit #11A).

Opposer was founded in 1921 by industrious young Philadelphians Emanuel "Manny" Rosenfeld, Maurice L. "Moe" Strauss and W. Graham "Jack" Jackson when they opened an auto supply store at 63rd and Market Streets. According to the testimony of Mr. Stampono, Manny and Moe were sitting on a box of Pep valve grinding compound in the back room of one of their first stores in Philadelphia and decided "Pep" would be a great name for a company given the way it conjured up images of motion, action or hustle. Hence, opposer was originally known as "Pep Auto Supplies." When Manny and Moe learned how they were widely and affectionately known as "the boys," they changed the company name to "Pep Boys" sometime in the early 1920's. Shortly after that, when Moe noticed a dress store in Hollywood, California, trading under the name "Minnie, Maude and Mabel's," he thought it would be an interesting twist to add the "Manny, Moe and Jack" reference to the name of the growing company. (Stampono Trial Deposition, pp. 24 - 26; Opposer's Exhibit #8).

Opposer uses the PEP BOYS name as a service mark on the building façade of all of its retail outlets, in all of its print advertising and electronic promotions. Furtkevic Trial Deposition, pp. 18-26. Opposer's national television advertising appears on sports programs seen on the following networks: "ABC; NBC; CBS; Fox; ESPN; ESPN2; PBS." *Id.* at 26. In recent years, it sponsored sports shows such as the Daytona 500, the Pennsylvania 500, the Indy 500 and other NASCAR events, Motorweek on PBS, NCAA Basketball, Major League Baseball, the Indy Racing League, the XFL, NOPI Nationals, etc. *Id.* at pp. 27-28. Opposer has maintained a website at www.pepboys.com since 1994. *Id.* at 39 - 40.

Opposer has for years also promoted its goods and services through the distribution or sale of licensed merchandise - including T-shirts, baseball caps, notepads, bobble heads, sports bottles, coffee mugs, travel mugs, golf balls, key chains, and key fobs - all bearing its PEP BOYS marks. *Id.* at 46 - 48.

*6 Opposer has garnered publicity over the years for a variety of public-service activities. For example, opposer set up a job-training partnership program with the Urban League in Los Angeles, and established the Pep Boys Los Angeles Arts Program to paint the exterior of public schools in the Los Angeles Unified School District. *Id.* at 48 - 52.

In addition to press clippings reflecting decades of free publicity (*Id.* at 56 - 57), the record contains examples of radio and television exposure ranging from local radio to national television broadcasts. These include appearances of the Manny, Moe and Jack characters on "The Today Show" and "The Early Show," "Jeopardy," "Who Wants to be a Millionaire," "The Weakest Link," "The Rosie Show," Jay Leno's "The Tonight Show" broadcasts as well as David Letterman's "The Late Show" programs. References in feature films stretch from "Auntie Mame" (1959) to "The American

President" (1995) and "Striptease" (1996). *Id.* at 46, 52 - 55.

When asked about the value of the Pep Boys marks, Mr. Stampone testified as follows:

... The Pep Boys name, Manny, Moe & Jack, are such a rich part of this company and are such a recognizable name in American folklore, the names are icons of American culture. They're often times used in unsuspecting ways.

You may be watching television and could be watching Jay Leno, and he could mention Pep Boys either in a joke, or, you know, by reference to his experience. You know, he's an avid motorist.

You could be watching a movie and seeing a Pep Boys store or a Pep Boys battery sitting in a front seat. I recall in some movie. Certainly, you cannot drive down the street for very long without seeing a Pep Boys store.

For 81 years, hundreds of millions, probably billions of people have been exposed to the Pep Boys name through our various advertising campaigns. We spend tens of millions of dollars a year promoting the Pep Boys Manny, Moe & Jack name. So the value that I would place on Pep Boys Manny, Moe & Jack would be somewhat like the Visa Commercial, it's priceless; it would be hard to place a value on it, it's so valuable.

Stampone Trial Deposition, pp. 32 - 33.

The record reflects opposer's year-by-year financial records for the years 1985 through 2002. In the following table, "merchandise sales" consist of "the sale of [opposer's] product or inventory items ... sold through Pep Boys stores either to [opposer's] retail customers or to a commercial customer." McElroy Trial Deposition, pp. 8-9. "Service revenue" is the annual total of "the mechanic's labor that [opposer] would charge to [its] customers." *Id.* at p. 8. "Total Net Sales" "is the combination of these two, merchandise sales and service, added together." *Id.* at pp. 8 - 9. Finally, "gross media" reflects opposer's expenditures on advertising and marketing its goods and services. *Id.* at p. 10.

Year	Merchandise Sales	Service Revenue	Total Net Sales	Gross Media
1985	366,707,000	22,207,000	388,914,000	11,936,000
1986	452,650,000	33,249,000	485,899,000	18,601,000
1987	505,583,000	48,181,000	553,764,000	21,470,000
1988	586,162,000	69,806,000	655,968,000	27,312,000
1989	703,487,000	95,204,000	798,691,000	33,512,000
1990	774,502,000	110,172,000	884,674,000	39,154,000
1991	873,381,000	128,127,000	1,001,508,000	41,758,000
1992	1,008,191,000	147,403,000	1,155,594,000	40,346,000
1993	1,076,543,000	164,590,000	1,241,133,000	40,293,000
1994	1,211,536,000	195,449,000	1,406,985,000	40,825,000
1995	1,355,008,000	239,332,000	1,594,340,000	36,614,000
1996	1,554,757,000	273,782,000	1,828,539,000	41,069,000
1997	1,720,670,000	335,850,000	2,056,520,000	41,430,000
1998	1,991,340,000	407,368,000	2,398,708,000	53,189,000
1999	1,954,010,000	440,523,000	2,394,533,000	52,334,000
2000	1,957,480,000	460,988,000	2,418,468,000	51,153,000
2001	1,765,314,000	418,401,000	2,183,715,000	46,166,000

2002 ^[FNal]	1,073,534,000	246,532,000	1,320,065,000	41,083,000
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FNal. Through August 2002*7 Opposer's exhibit #7.

This places opposer within the top five automotive after-market providers in the nation as well as ranking it in the top several repair/maintenance service providers. Stampone Trial Deposition, pp. 29 - 32.

Most of opposer's 630 retail locations are large format stores often referred to as "super centers," where opposer "does everything in automotive except internal engine work and body and collision crash repair." Stampone Trial Deposition, p. 7. As to automotive parts, accessories, tires, chemicals, oils, etc., opposer offers "around 30,000 different items" in the typical super center location. Stampone Trial Deposition, p. 8.

As to the specific listing of goods for which applicants seek registration of their mark, namely, "truck accessories, namely front and rear bumper, vehicle seats, camper shell, gear shift lock, wheel house linear, anti-theft door security lock, anti-sway bar, finished safety glass windows for vehicles and side bumper," and "fit floor tray, namely floor mats for vehicles," Messrs. Stampone and Furtkevic testified on direct examination that opposer sells floor mats, tonneau covers, custom-fit running boards, truck bed mats and truck bed liners, rooftop carriers, seat covers, truck bumpers, tailgate covers and sliding rear windows for pickup trucks. *Id.* at 11 - 14; Furtkevic Trial Deposition, pp. 10 - 11; Exhibit #9, pp. 303, 344 - 346, 348-355, 358 - 359, 360 - 361, 363.

Applicants have indicated that they have used their CARRYBOY and design mark in the United States in connection with their fiberglass canopies or camper shells, slider windows, rear truck bed seat kits, fit floor trays and door security locks since late 1994 and early 1995 (applicants' supplemental response to interrogatory #1); that the record does not show whether applicants were even aware of opposer when this mark was adopted in Thailand in 1983; that opposer does not sell applicants' flagship product (camper shells); that the related truck accessory products sold by opposer are not sold under the PEP BOYS marks; that applicants' goods will never be sold in opposer's retail stores; and that opposer uses its PEP BOYS marks at retail while applicants use their mark exclusively at the wholesale level.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

After applying the *du Pont* factors to the factual record herein, we find that opposer has not shown that applicants' CARRYBOY and design mark, when used in connection with its automotive accessories, so resembles one or more of opposer's PEP BOYS marks, which opposer uses in connection with its various goods and services as to be likely to cause confusion, to cause mistake or to deceive as to the source or sponsorship of applicants' goods.

*8 Turning first to the *du Pont* factor focusing on the relatedness of the goods and/or services and the similarity of established, likely-to-continue trade channels, we agree with opposer that applicants' goods are related to opposer's goods and services. Opposer's and applicants' products are both sold in the automotive after-market. Goods bearing applicants' CARRYBOY and design mark will eventually be purchased by truck owners through, *inter alia*, retail store locations featuring the sale of vehicle parts and accessories not unlike opposer's retail outlets. Moreover, the record shows that a portion of opposer's sales occur through independent repair shops. Accordingly, it is possible that some consumers would be able to purchase PEP BOYS branded products through channels of trade other than opposer's own retail outlets.

On the other hand, while opposer argues that under opposer's customer-friendly service policies, opposer could be faced with a special order request for a CARRYBOY product, we agree with applicants that nothing in the record demonstrates that applicants' goods would ever be sold under its CARRYBOY and design mark in opposer's retail automotive parts

and service centers.

In any case, it is well settled that the registrability of applicants' mark must be evaluated on the basis of the identification of goods as set forth in the involved application and that compared with the identification of the goods and/or recital of services contained in the pleaded registrations of record. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990) and *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Additionally, it is settled that absent any specific limitations in applicants' identification of goods and in the identification of goods and recital of services contained within the opposer's registrations, the issue of likelihood of confusion must be determined by looking at all the usual channels of trade and methods of distribution for the respective goods and services. See *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

Here, neither applicants' identified goods nor opposer's automotive goods contain any restrictions as to the channels of trade or classes of purchasers. Accordingly, the respective goods must be presumed to be available through third-party retailers of automotive after-market parts including retailers who offer vehicle maintenance and repair services as does opposer. Furthermore, even if opposer's goods and services are regarded as being marketed exclusively through its own retail stores, consumers shopping for after-market automotive parts and customers of vehicle repair services will likely seek out desired goods and/or services from a variety of different retailers.

*9 We agree with applicants that tonneau covers for trucks are not inter-changeable items with camper shells, and that the various aftermarket accessories that opposer sells for use in the bed of a truck carry third-party trademarks. While opposer does not list a variety of camper shells in its catalogues, the closest items opposer does list are a number of Bestop brand hardtops for a number of vehicles such as the Jeep Wrangler, Suzuki Sidekick and Geo Tracker. Opposer's exhibit #9, p. 496. Moreover, it is clear from the record that owners of all kinds of regular trucks are accustomed to seeking out opposer to purchase a wide variety of aftermarket accessories for the beds of their pickup trucks - if not all from the retail locations, at least through opposer's extensive catalogue (e.g., Opposer's Exhibit #9). In addition, the record contains testimony that opposer offers a wide variety of vehicle repair, maintenance and parts installation services. Accordingly, on this record, it is clear that the respective goods and services at issue herein, and the established, likely-to-continue channels of trade therefor, are so similar or closely related in a commercial sense that, if such goods and services are sold or advertised under the same or substantially similar marks, confusion as to the origin or affiliation thereof would be likely to result.

Applicants also argue that their "gear shift locks" are not sold in opposer's stores or retail catalogues. While it is true there is no indication that opposer has any gearshift locks, it does market a wide variety of shifters, shift kits and transmission accessories. These goods are not identical but must be deemed to be related.

Accordingly, we agree with opposer that some of applicants' listed goods are identical to some of opposer's goods and are otherwise closely related to opposer's goods and services. Moreover, it is certainly not necessary that a likelihood of confusion be found as to each item included within applicants' identification of goods. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); and *Alabama Board of Trustees v. BAMA-Werke Curt Baumann*, 231 USQP 408, footnote 7 (TTAB 1986).

As to the *du Pont* factor focusing on the conditions under which and buyers to whom sales are made, we also agree with opposer that most of applicants' identified items are inexpensive and would be "purchased by diverse buyers without exercising much care." *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992); *cert. denied*, 506 U.S. 862, 113 S.Ct. 181 (1992). While applicants' camper shells cannot be dismissed as im-

pulse items, neither do we assume, given their retail price, that purchasers of these goods would necessarily qualify as "sophisticated."

*10 Opposer contends that a key *du Pont* factor in its favor is the fame of its PEP BOYS marks. We agree with opposer that, at least as it relates to the issue of likelihood of confusion, the record clearly demonstrates such fame. The PEP BOYS term is either the entirety of opposer's claimed marks, or makes up a dominant and distinguishing portion of its registered marks. Opposer has proven to our satisfaction that this term is famous in the after-market for automotive (including truck) parts and accessories, with respect to retail store services featuring such merchandise and with respect to vehicle repair and maintenance services.

The record shows use of the PEP BOYS designation for more than eighty years. Currently, opposer's large retail stores comprise one of the largest retail automotive parts and accessories store chains in the nation. The sales and advertising figures shown *supra* are most impressive, placing opposer among the nation's leaders, whether measured in terms of its gross sales of parts and accessories or in terms of the number of service bays in its stores.

Additionally, opposer has shown through testimony and other evidence of record that the PEP BOYS name has appeared as a service mark on the building façade of all of its retail outlets, in its print advertising and promotional materials, on in-store point-of-purchase displays, and in connection with television, radio and Internet advertising. Opposer has promoted the PEP BOYS name in connection with its sponsorship of a variety of auto racing events including several popular NASCAR venues. Opposer promotes its name by selling or giving away a variety of licensed logo-bearing merchandise. Opposer's several witnesses testified to opposer's involvement with various civic activities, resulting in free publicity. In addition to free publicity growing out of public service ventures, opposer has granted licensees permission to use the PEP BOYS marks in feature films and other popular entertainment programming. Accordingly, we agree with opposer's witnesses, that after more than eighty years of promotion involving hundreds of millions of dollars of national and local advertising, the PEP BOYS name is famous indeed.

While our principal reviewing court has repeatedly stressed the importance of the *du Pont* factor focusing on the fame of the prior mark, e.g., *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, *supra*; *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000), famous marks still do not create rights in gross. That is, even when the tribunal finds that the prior mark is famous, this does not preclude the registration to another of the same or similar mark for any and all goods and services.

Accordingly, opposer's reliance upon the fame of its PEP BOYS marks, along with the relatedness of the goods and the similarity of the channels of trade, etc., is not sufficient to support a finding of likelihood of confusion when, for example, the dissimilarity of the marks at issue weighs strongly in applicants' favor.

*11 Opposer argues that applicants' CARRYBOY and design mark is confusingly similar to opposer's PEP BOYS marks in sight, sound and meaning. Opposer contends that the term "Boy" is completely arbitrary as applied to applicants' goods and opposer's goods and/or services; that the word "Carry" is not distinctive for applicants' goods, which are designed for use with truck beds, or "carriers of cargo"; and that the word "Carry" in applicants' mark has a similar connotation to the word "Pep" in opposer's marks.

However, we concur with applicants, that their CARRYBOY and design mark is so different in sound, appearance and connotation from opposer's PEP BOYS marks as to preclude any likelihood of confusion. When the respective marks are considered in their entireties, the primary similarity - the presence of the word "Boy" or "Boys" as the second portion of the literal elements of the respective marks - is outweighed by the prominent differences.

The initial term in applicants' mark, CARRY, does not sound or look at all like the term PEP in opposer's marks. As to connotation, while applicants did state that "in Thailand the word CARRYBOY refers to a helper, servant or carrier of cargo," (opposer's exhibits 90 and 91, response # 8), it does not follow that the term "Carry" "connotes hustle, action and motion." Opposer's brief, p. 30. While "carry" has the connotation of the movement of physical things, it does not have the connotations of vitality, hustle or vim of the word "pep." This difference in connotation between the words "carry" and "pep" is not diminished when the respective words are paired with the words "Boy" and "Boys.

Based on the record before us, we see the likelihood of confusion claim asserted by The Pep Boys Manny, Moe & Jack Of California as amounting to only a speculative, theoretical possibility. Language by our primary reviewing court is helpful in resolving the likelihood of confusion controversy in this case:

We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal.

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), citing *Witco Chemical Co. v. Whitfield Chemical Co., Inc.*, 418 F.2d 1403, 1405, 164 USPQ 43, 44-45 (CCPA 1969), *aff'g* 153 USPQ 412 (TTAB 1967).

Accordingly, notwithstanding the *du Pont* factors favoring the position taken by opposer herein, including the critical factor of the fame of its marks, we find that there is no likelihood of confusion from the contemporaneous use by applicants of their CARRYBOY and design mark in connection with their identified truck accessories, and the use by opposer of its PEP BOYS marks for its goods and services, inasmuch as these factors favoring opposer are outweighed by the differences in the overall commercial impressions of the respective marks.

Dilution

*12 Dilution became available as a ground for opposition with the enactment of the Trademark Amendments Act of 1999 ("1999 Act") on August 5, 1999.^[FN20] The 1999 Act permits retroactive application so as to allow oppositions, brought against applications filed on or after January 16, 1996, to be amended to include dilution claims, assuming no prejudice to the defendant. See *Boral Ltd. v. FMC Corp.*, 59 USPQ2d 1701 (TTAB 2000). In the case before us, inasmuch as the involved application was filed on April 22, 1994, there is a statutory bar to any assertion of dilution as a ground for opposition. See *Boral v. FMC, supra*; and *Polaris Industries, Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2001).

Application allegedly void *ab initio*

Opposer also alleged in its notice of opposition that the record demonstrates that applicants' mark was not in use in commerce prior to the April 22, 1994 filing date of the instant application. Inasmuch as the involved application is based upon use in commerce, if this were shown to be true, this opposition could be sustained on the basis that applicants' application would be void *ab initio*. See *Intermed Communications, Inc. v. Chaney*, 197 USPQ 501 (TTAB 1977) [where the INTERMED mark had never been used in the USA on or prior to the filing date in association with the services described in the application, the application was void].

The parties hereto are not disputing the actual facts as much as disagreeing over their legal implications. Hence, we will review first what the record shows about applicants' relevant activities during the period of 1993 and 1994, before turning to a discussion of whether this is sufficient to meet the statutory requirements of the Lanham Act for "use in commerce" prior to April 22, 1994.

In September 1993, T.K.D. Fiber Co. Ltd. (TKD), a manufacturer in Bangkok, Thailand jointly owned by the applicants, transported a variety of goods bearing the CARRYBOY and design trademark, including front and rear bumper, vehicle

seat kit, camper shell, gear shift lock, license plate frame, wheel house liner, door security lock, anti-sway bar, side ski, safety glass windows and fit floor tray, from Thailand to San Francisco, California. These goods were received by Running Wild, a proprietorship owned by the wife of applicants' U.S. agent and business partner, Mr. Yee Tantiyavarong. Most of these items were then shipped to Las Vegas, Nevada, for the Specialty Equipment Market Association (SEMA) show of November 2 - 5, 1993. At the SEMA show, TKD was listed as the exhibitor. After the SEMA show, these goods were shipped back to San Francisco, where Mr. Tantiyavarong continued to display these goods on his pickup truck. Mr. Tantiyavarong assisted the applicants in forming Truck Style, Inc. in December 1993, and continued to work to promote TKD products in the USA. This promotional activity included telephone calls and visits to prospective dealerships throughout California, sending out letters and promotional brochures, and securing a location for offices and a showroom for the newly-incorporated Truck Style, Inc. entity. It was also during this period that Mr. Tantiyavarong provided at no cost a camper shell to a prospective customer (e.g., a retail distributor of truck caps). The first documentation of an actual sale of CARRYBOY products took place on October 24, 1994, more than six months after the filing date of the involved application.

*13 Under the standards established by the Trademark Law Revision Act of 1988, applicants and their U.S. licensee must demonstrate *bona fide* use of the mark in the ordinary course of trade, and not made merely to reserve a right in the mark. As seen in the timeline summarized above, goods bearing the CARRYBOY mark were transported from Thailand to San Francisco, California, and then transported to Las Vegas, Nevada for display at the SEMA show. Over the following year, this led to further product displays and other continuing promotional activities by applicants and Mr. Tantiyavarong, eventually resulting in the first sale on October 24, 1994.

While opposer consistently points to the fact that there was no technical trademark use prior to the April 22, 1994 filing date of the opposed application, applicants have taken the position that the entire series of activities from September 1993 up to and beyond the initial sale of October 1994 clearly satisfies the statutory requirement of Section 45 of the Lanham Act as amended by the Trademark Law Revision Act. Applicants clarify that they are not relying on the single act of this shipment from Thailand to California to establish their "use in commerce," but rather, conceive of this shipment *coupled with* a long series of applicants' later activities to demonstrate a "concentrated and concerted effort" to place their products in the marketplace on a commercial scale.

We agree with opposer on this point, and find that applicants failed to show any technical trademark usage of the mark in commerce prior to the April 22, 1994 filing date of the involved application. The shipment of product in the fall of 1993 from TKD in Thailand for further shipment to TKD's SEMA booth in Las Vegas essentially comprised internal transactions. The promotional activities at the SEMA trade show, which involved no sales but merely the display of product, did not constitute "Use in Commerce."

In defining "Use in Commerce," Section 45 of the Act, 15 U.S.C. Section 1127, requires that "the goods are sold or transported in commerce." Clearly, if applicants had been able to show a pattern of sales of the goods with the mark affixed thereto prior to April 1994, this issue would not be before us.

It is the definition of "use in commerce" as amended by The Trademark Law Revision Act that governs this case. Applicants' use, as revealed by the undisputed facts herein, simply does not rise to the level of "*bona fide* use of a mark in the ordinary course of trade." For example, even if we determined that applicants' display and promotional activities might be judged as sufficiently public uses to identify the marked goods to an appropriate segment of the public mind, thereby providing rights superior to those of a subsequent user (i.e., use analogous to trademark use), the statutory requirement for use on or in connection with the sale of goods in commerce has still not been met. The mere fact that a product is transported across jurisdictional lines is not legally significant unless it comprises a *bona fide* commercial transaction,

e.g., shipment pursuant to a sale or other conveyance to the ultimate customer. See *Hydro-Dynamics Inc. v. George Putnam & Company Inc.*, 811 F.2d 1470, 1 USPQ2d 1772 (Fed. Cir. 1987). Hence, we sustain the opposition on the grounds that the involved application was void *ab initio*.

Allegations of Fraud on the United States Patent and Trademark Office (USPTO)

*14 Again, the parties seem to be in agreement on the legal standards to be applied in judging this ground for opposition. In order for opposer to prevail on a claim of fraud in procuring a trademark registration, opposer must plead and prove that applicants knowingly made "false, material representations of fact in connection with their application." *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986), and *Duffy-Mott Company v. Cumberland Packing Company*, 424 F.2d 1095, 1098-1100, 165 USPQ 422 (CCPA 1970). That is, to constitute fraud on the United States Patent and Trademark Office, a statement must be (1) false, (2) made knowingly, and (3) a material representation. Moreover, the charge of fraud upon the Office must be established by clear and convincing evidence. See *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955 (TTAB 1986). Needless to say, the parties strongly disagree on the question of whether opposer has proven this allegation.

Opposer is vehement in its claims that applicants have committed fraud on the Office. According to opposer, applicants first made false representations when they declared in the opposed application as filed that the opposed mark was in use in commerce in connection with the goods set forth in the involved application as of March 1994. Then in response to an Office action, in a declaration signed by applicants, they stated that, "Goods have been shipped in interstate commerce between Thailand and the U.S. beginning March 1994 by the distributor, Truck Style Inc., a California corporation established December, 1993."

However, opposer points out that neither Truck Style, Inc. nor anyone else associated with applicants either shipped or sold any products identified in this application "beginning" in "March 1994" "between Thailand and the U.S." Opposer charges that applicants were fully aware that as of March and April of 1994, applicants had no product available for shipment to, or sale in, the U.S. by Truck Style, Inc. Apart from any of the legal implications surrounding "use in commerce," opposer charges that the applicants knew when they made their declaration that these facts were untrue. Hence, opposer alleges that applicants knowingly made false representations in this declaration.

Opposer also argues that inasmuch as these representations regarding use of the mark in commerce were fundamental to the registrability of applicants' application, they were certainly "material." See *Western Farmers Assn. v. Loblaw, Inc.*, 180 USPQ 345, 347 (TTAB 1973) [false statement in trademark application that mark had been used on specific goods constituted fraud on the US PTO]; *First International Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628 (TTAB 1988) [fraud found in applicant's filing of application with statement that the mark was in use on a range of personal care products when applicant knew it was used only on shampoo and hair setting lotion]; *Torres v. Cantine Torresella S.r.l.*, *supra* at 49 [fraud found in registrant's submission of renewal application alleging mark was used on wine, vermouth and champagne when registrant knew it was in use only on wine].

*15 Nevertheless, applicants argue that fraud must be proved by clear and convincing evidence, citing to *Metro Traffic Control, Inc. v. Shadow Network, Inc.*, 104 F.3d 336, 340, 41 USPQ2d 1369 (Fed. Cir. 1997); *Smith International v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981), and applicants argue that opposer has failed to meet this heavy burden.

Pointing out that innocently-made, inaccurate statements do not constitute fraud, applicants have sought to explain these misstatements on the basis of "language difficulties" between themselves and trademark counsel - and that it was merely confusion as to the meaning of "use in commerce" under United States trademark law.

Opposer points out this claim is not about legal interpretations of Lanham Act language. Moreover, opposer charges that applicants cannot avoid their duty of knowing what they were representing factually to the Office under penalty of perjury by simply relying upon an asserted unfamiliarity with the English language. Clearly, opposer disagrees with applicants' assertions that their misstatements comprised a reasonable and honest belief of facts that rebuts opposer's charges of fraud. Opposer argues as follows:

To allow Applicants to rely on asserted ignorance of the very claims they are asserting under penalty of criminal prosecution would render meaningless the requirement of the Act and regulations that such statements of use in commerce be verified. 15 U.S.C. §1051(a)(1)(A). It goes, in fact, to the very heart of the application process. If the verification cannot be relied upon for the proposition that the applicant has read, has knowledge of, and understands, at least at the most basic level, the "facts" which the applicant declares under penalty of perjury "are true," such verifications are, in effect, worthless; a procedural requirement with no substance. To represent that one has knowledge, as a matter of fact, of something which the declarant, in fact, does not have knowledge, in itself is a fraud and material misrepresentation. Applicants, therefore, should - and must - have known exactly which goods their mark was used in connection with at the time they made Declarations in this regard. Therefore, their statements were not merely in error, they were false and fraudulent. *Torres, supra* and *Duffy-Mott, supra*.

Opposer's brief, p. 47.

Recognizing that a charge of fraud must be proved by clear and convincing evidence, we find, based upon the entirety of this voluminous record, that applicants, in the declaration executed in response to an Office action, knowingly made false, material representations of fact. When they made this declaration, applicants knew, or should have known, that no one associated with applicants had shipped or sold products between Thailand and the U.S. beginning in March 1994. See *Torres, supra*. The statements were clearly false, and in the context of the prosecution of this application, were definitely material. It is indefensible to suggest that applicants did not know that their declaration statements were false, and so we agree with opposer that the false statements contained in the declaration were made knowingly. This Board will not tolerate a situation where applicants knowingly provide false, material information to counsel for the preparation of a declaration so critical to the application process.

*16 In addition to being troubled by applicants' attempts to save this application with knowingly false statements, we share opposer's concerns about the unfairness in the way applicants have used their claims of attorney-client privilege with their former counsel to defend this fraud claim. Applicants argue as follows:

Although Applicants' fraud is established in the record, Opposer continues to object to Applicants' asserted reliance on communications with counsel to defend the fraud claim, while at the same time refusing to disclose these communications. Applicants have refused to produce these purported communications or documents relating or referring to their "error" and refused to have their witness testify to it, seeking to shield these documents and information by the attorney-client privilege and/or attorney work product doctrine. It is well established that a party cannot rely on purported communications and discussions with counsel, while at the same time refusing to provide, or selectively providing, those communications. See e.g., *Afro-Lecon v. United States*, 820 F.2d 1198, 1204 (Fed. Cir. 1987); *Greater Newberryport Clamshell Alliance v. Public Serv. Co. of New Hampshire*, 838 F.2d 13, 22 (1st Cir. 1988); *United States v. Bilzerian*, 926 F.2d 1285, 1292 (2nd Cir. 1991); *Conkling v. Turner*, 883 F.2d 431, 434 (5th Cir. 1989); *Sedco Int'l v. Cory*, 683 F.2d 1201, 1206 (8th Cir. 1982); *GAB Business Servs. v. Syndicate*, 627, 809 F.2d 755 (11th Cir. 1987); and *United States v. Carr*, 437 F.2d 662, 663 (D.C. Cir. 1970).

The standard here is fairness - fairness to the privilege holder, to the rationale and policy underlying the privilege, and to the opposing party. In *Gorzegno v. Maguire*, 62 F.R.D. 617 (S.D.N.Y. 1973), for example, the defendant claimed that the plaintiff made a fraudulent claim of inventorship before the PTO. In support of this claim, the defendants offered a documentary admission that one of the plaintiffs, Gorzegno, had made in an application that he

had filed when he was an employee of the defendant. The defendant, however, resisted production of communications between Gorzegno and defendant's counsel on the issue being proven by the statement in the application - Gorzegno's knowledge. The defendants argued that they could introduce a document as evidentiary proof of an admission without losing privilege protection for background communications that bore directly on the substance of what was allegedly to be indirectly proven in that document. The court found this argument unpersuasive, stating that "[f]undamental precepts of fairness dictate the opposite conclusion. It would be manifestly unjust to allow the application to be introduced in a vacuum, totally immunized from contextual analysis." *Id.* at 621.

*17 The exact same circumstance is presented here. For Applicants to rely on communications with counsel to defend a charge that their false statements to the PTO were made with fraudulent intent, "while simultaneously foreclosing any further amplification of its underlying validity unduly prejudices [Opposer's] position." *Id.* "Defendants cannot have it both ways; they cannot seek refuge in consultation with counsel as evidence of their good faith yet prevent [opposer] from discovering the contents of the communication." *Dorr-Oliver v. Fluid-Quip*, 834 F.Supp. 1008, 1012, 29 USPQ2d 1732 (N.D. Ill. 1993). Thus, public policy prohibits "the use of an asserted privilege as both sword and a shield," *Gorzegno*, 62 F.R.D. at 621.

Opposer's brief, pp. 47 - 48.

Accordingly, while we continue to uphold applicants' claims of attorney-client privilege, we conclude that it would be most unfair to opposer to permit applicants successfully to defend themselves against a strong showing of fraud on the Office by providing them complete refuge in their consultations with counsel. See *Dorr-Oliver, supra*.

Furthermore, while applicants claim that their former attorney has refused to provide applicants or their current attorneys with documents responsive to several of opposer's litigation requests, applicants' witness, Yee Tantiyavarong, testified that although he was the sole conduit of communications between applicants and their former counsel, he had not made a single request to this former attorney to provide documents and information. This testimony belies earlier statements contained in applicants' discovery responses as well as in statements made before this Board when applicants were opposing opposer's renewed summary judgment motion and opposer's motion to compel. This pattern of conduct is further proof of applicants' fraud, and supports opposer's claims that this opposition should be sustained.

Decision: We dismiss the opposition based upon the claims of likelihood of confusion and dilution. However, we sustain the opposition based upon the claim that the application is void *ab initio* and based upon the claim of fraud on the United States Patent and Trademark Office in procuring a trademark registration, and as a result, registration to applicants is refused.

FN1. Application Serial No. 74519445 was filed on April 22, 1994 based upon applicants' allegation of use in commerce between Thailand and the United States at least as early as March 1994.

FN2. Reg. No. 0310199 issued on February 13, 1934; fourth renewal.

FN3. Reg. No. 1288346 issued on July 31, 1984; renewed.

FN4. Reg. No. 1363854 issued on October 1, 1985; section 8 affidavit accepted and section 15 affidavit acknowledged.

FN5. Reg. No. 1395353 issued on May 27, 1986; section 8 affidavit accepted and section 15 affidavit acknowledged.

FN6. Reg. No. 1420631 issued on December 9, 1986; section 8 affidavit accepted and section 15 affidavit acknowledged.

FN7. Reg. No. 1472747 issued on January 19, 1988; section 8 affidavit accepted and section 15 affidavit acknowledged.

FN8. Reg. No. 1562597 issued on October 24, 1989; section 8 affidavit accepted and section 15 affidavit acknowledged.

FN9. Reg. No. 1562598 issued on October 24, 1989; section 8 affidavit accepted and section 15 affidavit acknowledged.

FN10. Reg. No. 1883212 issued on March 14, 1995; section 8 affidavit accepted and section 15 affidavit acknowledged.

FN11. Reg. No. 1997613 issued on August 27, 1997; section 8 affidavit accepted and section 15 affidavit acknowledged.

FN12. Reg. No. 2001610 issued on September 17, 1996; section 8 affidavit accepted and section 15 affidavit acknowledged.

FN13. Reg. No. 2026793 issued on December 31, 1996; section 8 affidavit accepted and section 15 affidavit acknowledged.

FN14. Reg. No. 2036750 issued on February 11, 1997; section 8 affidavit accepted and section 15 affidavit acknowledged.

FN15. Reg. No. 2130799 issued on January 20, 1998; section 8 affidavit accepted and section 15 affidavit acknowledged.

FN16. Reg. No. 2226116 issued on February 23, 1999.

FN17. Reg. No. 2228755 issued on March 2, 1999. The mark is lined for the colors red and blue.

FN18. Reg. No. 2345076 issued on April 25, 2000. The English translation of the mark is: "PEP BOYS. CARS LIKE US. PEOPLE LOVE US."

FN19. Reg. No. 2408968 issued on November 28, 2000.

FN20. Section 13(a) of the Trademark Act, as amended, reads in pertinent part: "Any person who believes that he would be damaged by the registration of a mark upon the principal register, including as a result of dilution under section 43(c), may ... file an opposition..."

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