

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

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

Mailed: July 15, 2008

Opposition No. 91176901

Bodyonics, Ltd.

v.

Jeffrey Lee Kaplan and
Ilie Iconcescu

Before Quinn, Hohein and Kuhlke, Administrative Trademark
Judges.

Kuhlke, Administrative Trademark Judge:

This opposition now comes before the Board for
consideration of the parties' cross motions for summary
judgment on the claims of mere descriptiveness, genericness
and likelihood of confusion under Sections 2(e)(1) and 2(d)
of the Trademark Act. In addition, opposer has filed a
motion to amend its pleading to add the claims of mere
descriptiveness and genericness. The motions have been
fully briefed.¹

¹ The parties have filed various other motions which we address
throughout this order. Applicants' motion, filed on September
24, 2007, to suspend this proceeding pending decision on
applicants' petition to cancel opposer's registration is moot
inasmuch as the petition was dismissed with prejudice on June 12,
2008, and will be given no further consideration. See
Cancellation No. 92048221.

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Opposer brought this proceeding opposing registration by applicants of the mark ENERGY POPPERS in standard character format for use in connection with "energy boosting nasal spray preparations" in International Class 5, filed on April 15, 2006, alleging a bona fide intention to use the mark in commerce under Section 1(b) of the Trademark Act. Opposer's initial pleading alleges, inter alia, that: since 1999 it has used the mark POPPERS in connection with dietary and nutritional supplements; it is the owner of Registration No. 2447342 for POPPERS and Application Serial No. 78775704 for the mark MUSCLE POPPERS; applicants' goods are closely related to opposer's goods; applicants' mark is "virtually identical" to opposer's mark "with the exception that the word 'ENERGY' is disclaimed as descriptive"; and a "likelihood of confusion in the marketplace exists between opposer's trademark when applied to the goods of the respective parties, and applicants' trademark." Notice of Opposition ¶¶ 4-7. In their answer, applicants have denied the salient allegations of the notice of opposition and asserted the affirmative defenses of laches, acquiescence and "nominative fair use."

Opposer's initial motion for summary judgment has been brought on the unpleaded ground of mere descriptiveness and/or genericness; thus, we must first consider opposer's motion to amend its notice of opposition to include these

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claims. See Fed. R. Civ. P. 56(a) and 56(b); S. Industries Inc. v. Lamb-Weston Inc., 45 USPQ2d 1293, 1297 (TTAB 1997).

In support of its motion to amend, opposer states:

This ground was not raised in the Notice of Opposition and is made based upon responses of the Applicant to discovery served by Opposer...Based upon the evidence adduced in discovery, the Applicant admitted that its mark is merely descriptive and/or generic and Opposer seeks leave to Amend the Notice of Opposition to add this additional ground for Opposition.

Br. p. 1.

Opposer's proposed amendment reads as follows:

8. Applicant's mark ENERGY POPPERS is merely descriptive and/or generic and is, therefore, incapable of functioning as a trademark and cannot be registered on either the Supplemental or Principal Register.

Amended Notice of Opposition ¶ 8.

Under Fed. R. Civ. P. 15(a), the Board liberally grants leave to amend pleadings at any stage of the proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party. See *Polaris Industries v. DC Comics*, 59 USPQ2d 1789 (TTAB 2001). Timing plays a large role in the Board's determination of whether an adverse party would be prejudiced by allowance of an amendment and as a result, long, unexplained delays may render the amendment untimely. See *M. Aron Corp. v. Remington Products, Inc.*, 222 USPQ 93, 96 (TTAB 1984).

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Here, the Board finds that opposer was not fully aware of all the facts it needed in order to include such claims at the time the notice of opposition was filed and it did not become fully aware of them until after applicants served their discovery responses on opposer. Moreover, while applicants objected to the motion for summary judgment in the response brief on the ground that it was based on an unpleaded issue, applicants also argued against the motion for summary judgment on the merits.

In view thereof and in the interest of justice and judicial economy, the Board grants the motion to amend, and will consider the amended pleading as the operative pleading. Opposer's motion for summary judgment is now based on pleaded grounds, and we will rule on the merits of opposer's motion for summary judgment at this time. In deciding the motion for summary judgment, the Board assumes that applicants maintain all denials in their answer to the notice of opposition and that applicants deny opposer's newly asserted claims as alleged in the amended notice of opposition.

We begin by denying opposer's motion, filed on August 13, 2007, to treat its motion for summary judgment on the grounds of descriptiveness and/or genericness as uncontested. Opposer's motion for summary judgment on these initially unpleaded grounds was filed on July 2, 2007. On

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July 13, 2007 applicants, representing themselves pro se, filed a paper titled "Applicant's Motion for Summary Judgment; Memorandum and Declaration of Jeff Kaplan in Support." While this filing contains a motion for summary judgment on opposer's claim of likelihood of confusion, it also includes the following passage:

In Opposer's Notice of Opposition a likelihood of confusion issue was raised as the reason for the filing but now that issue has been withdrawn by the Opposer...In Opposer's Motion for Summary Judgment, the Opposer is attempting to twist the Interrogatory Answers submitted by the Applicant. Applicant stated that the word "POPPERS" by itself is generic for inhalation but Applicant's statement was referencing the inhalation of "illegal chemicals known as Alkyl Nitrates:" Documents supporting this answer were submitted to the Opposer under Exhibit B in the First Set of Request For Production of Documents. Applicant's mark is for "energy boosting nasal spray preparations" which are legal and healthy for the user...Opposer's Notice of Opposition does not contain any claims that Applicant's mark is not a trademark due to its containing a disclaimer for a descriptive word. Therefore all references to this argument should not be allowed.

Br. pp. 3-4.

These statements make clear that this paper is a combined response to opposer's motion for summary judgment on the claims of descriptiveness and genericness and a motion for summary judgment on the claim of likelihood of confusion. Thus, applicants have timely responded to opposer's motion for summary judgment.

Subsequent to applicants' combined response and motion, opposer filed a cross motion for summary judgment on the

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claim of likelihood of confusion. Applicants then filed a supplemental motion for summary judgment on the claim of likelihood of confusion and opposer moved to strike applicants' notice of reliance submitted in support of applicants' motion for summary judgment and to strike applicants' supplemental motion.

Thus, we first consider opposer's objection and motion to strike applicants' notice of reliance. Opposer in its response to applicants' motion for summary judgment on the claim of likelihood of confusion noted that the internet documents applicants submitted had no evidentiary value inasmuch as they were not authenticated. Thereafter, applicants filed concurrently with their response to opposer's cross-motion and their supplemental motion for summary judgment, a notice of reliance on the same documents including the internet documents and, separately, a declaration together with the same documents. Opposer moves to strike this notice of reliance arguing that internet publications cannot be the subject of a notice of reliance, citing the chapter in the Board's Manual of Procedure (TBMP) that covers trial evidence.

First, applicants' evidence was submitted on summary judgment and evidence with respect thereto need not be submitted under a notice of reliance. However, documents, including internet printouts, that are not self-

authenticating must be submitted under a declaration or affidavit for consideration on summary judgment.² *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1371 (TTAB 1998). In view thereof, opposer's motion to strike the notice of reliance is granted.

However, we find that the declaration submitted by applicants is sufficient to allow us to consider these documents to the extent they serve to raise a genuine issue.³ With regard to opposer's motion to strike applicants' supplemental brief, opposer has also filed a supplemental motion for summary judgment and in the interest of judicial economy we will consider all of the summary judgment motions currently before us. In view thereof, the motion to strike applicants' supplemental brief is denied.

SUMMARY JUDGMENT MOTIONS

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material fact, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's

² Of course, at trial, these documents may only come in under testimony absent any stipulations between the parties.

³ Applicants are advised to review Trademark Rule 2.20 for the appropriate declaration to be used in Board proceedings. We note that opposer also submitted internet evidence under the declaration of opposer's counsel.

favor. *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

Finally, where both parties have moved for summary judgment, the mere fact that they have done so does not necessarily mean that there are no genuine issues of material fact, or authorize the resolution of such issues, or dictate that judgment should be entered in favor of one of them.

University Book Store v. University of Wisconsin Board of Regents, 33 USPQ2d 1385, 1389 (TTAB 1994).

Descriptiveness/Genericness

In support of its motion for summary judgment, opposer argues that "[s]ince the goods are intended for boosting energy the term 'energy' was obviously merely descriptive and the Applicants disclaimed the term as descriptive apart from the mark as shown." Br. p. 3. Further, opposer argues:

In light of Applicants' disclaimer of "energy" as descriptive of the goods in the subject application and discovery Admissions that the word "poppers" is generic for the goods, the term "energy poppers" under 15 U.S.C. 1052 is not a trademark and therefore not eligible for registration on the Principal Register.

Br. p. 4.

In support of its position, opposer relies on applicants' responses to the following interrogatories and admissions:

Interrogatory No. 33: State in detail the facts that you claim support your third affirmative

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defense [nominative fair use] set forth in Paragraph 11 of your answer to the Notice of Opposition.

Applicants' Response: POPPERS as utilized in "inhalation" is a generic term therefore Opposer cannot prevent fair use of the word.

Admission Request No. 1: Do you admit that the goods on which you intend to use the mark ENERGY POPPERS is intended to be inhaled by the user?

Applicant's Response: We admit that the goods on which we intend to use the mark ENERGY POPPERS is intended to be inhaled by the user.

Admission Request No. 2: Do you admit that the goods on which you intend to use the mark ENERGY POPPERS are intended for inhalation?

Applicants' Response: We admit that the goods on which we intend to use the mark ENERGY POPPERS is intended for inhalation.

As shown in the excerpt of applicants' response, *infra*, applicants clarified that their discovery responses referred to the use of "poppers" in conjunction with specific illegal substances and their goods do not contain these substances. Further, applicants essentially argue that the compound mark ENERGY POPPERS is unique and distinctive. In support of their position applicants submitted, *inter alia*, documents they produced in response to opposer's request for documents which include the following excerpts from web pages on the internet:

Poppers is a term used for a group of chemicals known as Alkyl Nitrites, these include Butyl Nitrite, Amyl Nitrite and Isobuty street...Poppers come as coloured liquid in bottles or tubes. Poppers are taken by inhaling the vapour through the mouth or nose.

www.drugs-info.co.uk;⁴

Poppers is the street term for various alkyl nitrites taken for recreational purposes through direct inhalation, particularly amyl nitrite, butyl nitrite and isobutyl nitrite.

en.wikipedia.org/wiki/Poppers.

Based on the evidence of record, it is reasonable to infer that applicants' response to Interrogatory No. 33 was referencing the "recreational" drug "poppers" and not every drug or substance consumed by inhalation. Further, we may infer that the pro se applicants' general use of the term "generic" was such that they believe they should have fair use of a generic word for certain goods when they use it in connection with different goods to suggest perhaps to potential consumers the effect of their product. In view thereof, a genuine issue remains as to the descriptiveness or genericness of the term POPPERS in relation to applicants' goods and the descriptiveness or genericness of the mark ENERGY POPPERS in its entirety.

Likelihood of Confusion

In support of its motion on the claim of likelihood of confusion applicants essentially argue that opposer has not submitted any evidence in support of its claim and rather

⁴ Although this is a foreign website it still has some evidentiary value. In re Remacle, 66 USPQ2d 1222, 1224 n. 5 (reasonable to consider relevant website in English if information is of interest worldwide regardless of its country of origin).

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has pursued different claims, namely, descriptiveness and genericness. Applicants appear to misunderstand the summary judgment procedure. Opposer may move for summary judgment on one claim while preserving any other claims for trial; opposer was under no obligation to prove its likelihood of confusion claim prior to trial. Thus, applicants have not met their burden to establish the absence of a genuine issue of material fact and their motion for summary judgment on the claim of likelihood of confusion is denied.

Turning to opposer's motion on the claim of likelihood of confusion, upon careful consideration of the arguments and evidence presented by opposer, and making all inferences in favor of applicants on the likelihood of confusion factors, we find that opposer has not demonstrated the absence of genuine issues of material fact. We find that there are genuine issues of fact, at a minimum, with respect to the relatedness of the goods,⁵ similarity of the marks, and the strength of the marks and the scope of protection to

⁵ The third-party registrations and examples of use are not particularly probative on the issue of the relatedness of the goods. The fact that the word ENERGY is respectively registered or used in connection with nutritional supplements by different entities does not support the position that nasal spray preparations and nutritional supplements are sold by the same entity under the same mark. If anything, this evidence merely highlights the weak nature of the term ENERGY for nutritional supplements. While there is one example of an energy enhancing product that is inhaled, it is in the form of a ring and there is no evidence that the same source sells nutritional supplements under the same mark. Thus, the question remains whether nasal sprays and nutritional supplements are related.

be accorded them.⁶ We further note that, although opposer has alleged a prior registration, opposer did not submit evidence to prove that the registration is subsisting and owned by opposer, and thus priority remains in issue. Accordingly, opposer's motion for summary judgment on the claim of likelihood of confusion is denied.⁷

Affirmative Defenses

Applicants' motion for summary judgment also addresses their affirmative defense of acquiescence. Applicants have not established the required elements for this defense and their motion is denied. Finally, in their motion for summary judgment applicants argue that opposer has abandoned use of the mark POPPERS. Inasmuch as opposer has pleaded a registration for the mark POPPERS, these allegations of abandonment constitute an impermissible collateral attack absent a counterclaim.⁸

⁶ While the term ENERGY has been disclaimed, the evidence with regard to the term POPPERS is ambiguous. It is simply not clear from the record the extent to which this term is used in the field or is even descriptive or generic.

⁷ The Board reminds the parties that any evidence submitted in support of or opposition to a summary judgment motion is only considered of record for the purposes of that motion. See TBMP § 528.05(a). If the case goes to trial, the summary judgment evidence does not form part of the evidentiary record and will not be considered at final hearing unless it is properly introduced in evidence, during the appropriate trial period.

⁸ We note that applicants' petition to cancel was in essence a counterclaim against opposer's pleaded registration and that petition was dismissed based on the Board's determination that it was untimely.

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Proceedings herein are resumed and applicants are allowed **twenty days** from the mailing date of this order to file an answer to the amended notice of opposition. Discovery and trial dates are reset as indicated below. We note, furthermore, the lack of merit to many of the motions that the Board has had to address and this proceeding has been substantially delayed as result. In view thereof, the Board will not entertain any further motions for summary judgment.

DISCOVERY PERIOD TO CLOSE:	November 20, 2008
Testimony period for party in position of plaintiff to close:	February 18, 2009
Testimony period for party in position of defendant to close:	April 19, 2009
Rebuttal testimony period to close:	June 3, 2009

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