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

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re: *Application Ser. Nos. 79/023,935 and 79/023,934*

Published: August 7, 2007, in the Official Gazette

Applicant: Kobelco Construction Machinery Co., Ltd.

Mark: **GEOSPEC and ACERA GEOSPEC (and design)**

PLASTI-FAB LTD.,

Opposer,

vs.

KOBELCO CONSTRUCTION  
MACHINERY CO., LTD.,

Applicant.

Consolidated Opposition Nos. 91179480  
(parent) and 91179482

**OPPOSER'S REPLY IN SUPPORT  
OF ITS MOTION FOR SUMMARY  
JUDGMENT**

December 22, 2010

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## **I. INTRODUCTION**

Opposer Plasti-Fab Ltd. (“Opposer”) submits this Reply in support of its motion seeking summary judgment (“Motion”) against Applicant Kobelco Construction Machinery Co., Ltd. (“Applicant”). Summary judgment is appropriate where no genuine issue of material fact exists. *Levi Strauss & Co. v. Genesco, Inc.*, 742 F.2d 1401, 1403 (Fed. Cir. 1984). There is no material fact at issue in this case as to the existence of a likelihood of confusion between Opposer’s Mark and Applicant’s Marks, and Applicant’s Response to Opposer’s Motion (“Response”) failed to raise any such issue. Further, according to the Order of the Trademark Trial and Appeal Board (the “Board”) dated June 3, 2010, Applicant is precluded from introducing or relying on evidence that was not produced in response to Opposer’s discovery requests. Motion, Exhibit O. Accordingly, Opposer respectfully requests an order granting summary judgment in favor of Opposer and denying registration of Application Serial Nos. 79/023,935 and 79/023,934.

## **II. ARGUMENT**

### **A. Applicant Failed to Refute the Fact That There Is No Genuine Issue of Material Fact Regarding the *duPont* Factors Discussed in Opposer’s Motion.**

#### **1. *duPont* Factor 1 – There is No Genuine Issue of Material Fact Regarding the Confusing Similarity Between Opposer’s Mark and Applicant’s Marks.**

The first *duPont* factor – similarity of appearance, sound, connotation and commercial impression between two competing marks – is a paramount consideration in a likelihood of confusion analysis. In fact, the Federal Circuit repeatedly has held that it “may focus its analysis on *dispositive factors*, such as similarity of the marks...” *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336 (Fed. Cir. 2001) (emphasis added).

#### **i. GEOSPEC**

Applicant cannot reasonably argue that its “GEOSPEC” mark is dissimilar from Opposer’s “GEOSPEC” mark. Indeed, as demonstrated in Applicant’s Response, Applicant is grasping at straws in arguing that the two marks are dissimilar.

Applicant first argues that Opposer’s “GEOSPEC” mark is descriptive and weak because the elements “GEO” and “SPEC” have common meanings.<sup>1</sup> Response at 4. However, a mark is not weak simply because it is in the dictionary or is commonly used. *See In re Energy Telecomms. & Elec. Ass’n*, 222 USPQ 350, 351 (TTAB 1983) (“Appellant’s other point, that the registered mark... is inherently weak because it is derived from a dictionary term, is not well taken. Many famous marks consist of or are derived from words taken out of the dictionary (e.g. ‘IVORY,’ ‘TIME,’ ‘GULF’).”).

Applicant also argues that Opposer’s capitalization of the letter “S” in its mark renders the marks different. Response at 5. This argument has no merit. First, a consumer likely would not even perceive this minute difference. “[A] district court must ask not whether differences are easily discernable on simultaneous viewing, but whether they are likely to be memorable enough to dispel confusion on serial viewing.” *Malletier v. Burlington Coat Factory Warehouse Corp.*, 426 F.3d 532, 538 (2d. Cir. 2005). Second, it is well settled that minor stylization differences do not significantly differentiate two marks, especially something as minor as capitalizing one letter in otherwise identical marks. “Potential purchasers are unlikely to view the differences between

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<sup>1</sup>Even assuming *arguendo* that Opposer’s mark is weak, which it is not, “it is well established that even the owner of a weak mark is entitled to be protected from a likelihood of confusion with another’s use of the same or confusingly similar mark.” *In re Land O Sky, LLC*, 2010 TTAB LEXIS 2, \*19 (TTAB Jan. 4, 2010).

upper or lower case letters... to the extent that they would notice and remember these differences.” *I.B.E. Inc. v. Janet Seed Balekjian*, 2004 TTAB LEXIS 709, \*13 (TTAB Nov. 22, 2004), citing *CBS, Inc. v. Morrow*, 708 F.2d 1579 (Fed. Cir. 1983); see also *China Healthways Inst., Inc. v. Wang*, 491 F.3d 1337, 1341 (Fed. Cir. 2007) (“The fact that in Wang’s mark only the first letter, ‘C,’ is a capital letter, whereas in the Institute’s mark all of the letters are shown as capitals, is unlikely to suggest different sources of the product.”).

Finally, Applicant claims that Opposer lacks evidence concerning actual pronunciation of the parties’ marks. Response at 5. As Applicant admits, there is no “correct” pronunciation of a trademark because it is impossible to predict how the public will pronounce a particular mark, and it is impossible for a trademark owner to control how purchasers will vocalize the mark. See *Centraz Industries Inc. v. Spartan Chemical Co., Inc.*, 77 USPQ2d 1698, 1701 (TTAB 2006). Thus, two identical marks – such as Applicant’s “GEOSPEC” mark and Opposer’s “GEOSPEC” mark – inevitably will be pronounced by consumers in the same way. A supposed difference in pronunciation between the marks is unfounded and does not provide justification for a finding of no likelihood of confusion. Opposer’s Mark and Applicant’s Mark – both “GEOSPEC” – are identical. There is no genuine issue of material fact as to the similarity of the marks.

**ii. ACERA GEOSPEC**

Applicant claims that its “ACERA GEOSPEC” mark is dissimilar from Opposer’s “GEOSPEC” mark for three reasons: (1) the design aspect of the mark, (2) the addition of the word “ACERA,” and (3) the fact that the mark is used on allegedly different goods from those covered by Opposer’s Mark. As explained below, none of Applicant’s arguments have merit,

and it is clear that Applicant's "ACERA GEOSPEC" mark is confusingly similar to Opposer's "GEOSPEC" mark.

First, Applicant argues that the stylization of its "ACERA GEOSPEC" mark renders it distinct from Opposer's Mark. However, a "design element in the mark... is insufficient to create a genuine issue of material fact as to the similarities of the marks." *Fram Trak Industries, Inc. v. WireTracks LLC*, 2006 TTAB LEXIS 21, \*19 (TTAB Jan. 23, 2006); *see also Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165 (Fed. Cir. 2002) (words are dominant portion of mark); *Ceccato v. Manifatura Lane Gaetano Marzetto & Figli S.p.A.*, 32 USPQ2d 1192 (TTAB 1994) (literal portion of mark makes greater and long lasting impression). In addition, as pointed out in Opposer's Motion, the "GEOSPEC" aspect of the "ACERA GEOSPEC" mark literally dominates the mark, based on its relative size and location within the mark. Motion at 6-7.

Second, Applicant alleges that the addition of "ACERA" before "GEOSPEC" differentiates Applicant's "ACERA GEOSPEC" mark from Opposer's Mark. On the contrary, as stated above, "GEOSPEC" is the dominant portion of the mark. Greater weight is given to the dominant portion of a mark in a likelihood of confusion analysis because the dominant portion is what consumers see and remember. *See Twin Lakes Telephone Cooperative, Inc. v. Twin Lakes Internet Service, Inc.*, 2005 TTAB LEXIS 440, \*19 (TTAB Sept. 30, 2005) ("While marks must be compared in their entirety, one feature of a mark may be recognized as more significant in creating a commercial impression. For that reason, in determining whether there is likelihood of confusion, it is appropriate for us to give greater weight to the wording that is the dominant feature in the parties' marks.") (internal citations omitted). Not only is "GEOSPEC" the

dominant portion of Applicant's Mark, it constitutes the *entirety* of Opposer's Mark. Likelihood of confusion often is found where the entirety of one mark is incorporated within another. *See In re Land O Sky, LLC*, 2010 TTAB LEXIS 2, \*11 (TTAB Jan. 4, 2010) ("Because the name HARVEST FARMS is the dominant portion of applicant's marks and the entirety of the registered mark, we find that the marks are similar in appearance, sound, meaning, and commercial impression."). The addition of "ACERA" does nothing to eliminate the likelihood of confusion between the two marks.<sup>2</sup>

Finally, Applicant argues that the goods covered by Applicant's Marks and Opposer's Mark are not related, and therefore conjure different connotations and commercial impressions. This, simply, is untrue. As discussed below, Opposer's goods and Applicant's goods are related and confusingly similar.

The similarity of Applicant's Marks and Opposer's Mark here should be seen as a dispositive factor in a likelihood of confusion analysis, and weighs heavily in favor of granting Opposer's motion for summary judgment.

**2. *duPont* Factor 2 – There is No Genuine Issue of Material Fact Regarding the Confusing Similarity Between Opposer's Goods and Applicant's Goods.**

Applicant admits that its goods and Opposer's good are both used in construction. Response at 8. Yet in the very next breath, Applicant attempts to deny the fact that its goods and

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<sup>2</sup> Applicant claims that because "ACERA" appears before "GEOSPEC" in its mark, the "ACERA" is more likely to create a consumer impression. Response at 5. However, all of Applicant's supporting authority for this claim comes from cases in which the common element of two competing marks is identical, and therefore are inapposite.

Opposer's goods are related. *Id.* However, Opposer does not argue that its goods and Applicant's goods are identical, and it is not required to prove as much.

[G]oods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that the goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would likely be seen by the same persons under circumstances which would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services.

*In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991). Applicant's goods and Opposer's goods are closely related because they would appeal to the same market. Even the case cited by Applicant in asserting that its goods are markedly different from Opposer's goods uses the market comparison test, described above. *See Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399 (TTAB Apr. 14, 2010) ("In determining whether products are identical or similar, the inquiry should be whether they appeal to the same market...") (internal citation omitted).

Applicant additionally asserts that the Board must determine the issue of likelihood of confusion based solely on the goods identified in the description of goods, and therefore, Opposer's introduction of evidence from Applicant's website is improper. Response at 7. Where, as here, applicant's description of goods is unclear, or technical in nature, it is appropriate to use extrinsic evidence showing that the description of goods has a specific meaning to members of the trade.

*See In re Trackmobile, Inc.*, 15 USPQ2d 1152, 1154 (TTAB 1990) (allowing use of extrinsic evidence to define the term "light railway motor tractors"). Thus, Opposer's introduction of evidence from Applicant's website is entirely appropriate to define Applicant's goods. There is

no genuine issue of material fact that Applicant's goods and Opposer's goods are related as a matter of law.

**3. *duPont* Factor 3 – There is No Genuine Issue of Material Fact Regarding the Overlap Between Opposer's and Applicant's Trade Channels and Customers.**

Similarly, Applicant asserts that Opposer has no evidence that customers of Applicant's goods and Opposer's goods will overlap, arguing that it is "illogical to assume that purchasers of Applicant's [goods] will be the same as purchasers of Opposer's goods..." Response at 9.

However, this is exactly what is dictated by the Board in applying its well-established presumption regarding trade channels and consumers of goods:

[W]here the goods in a cited registration are broadly described and there are no limitations in the identification of goods as to their nature, type, channels of trade or classes of purchasers, it is presumed that the scope of the registration encompasses all goods of the nature and type described, that the identified goods move in *all channels of trade* that would be normal for such goods, and that the goods would be purchased by *all potential customers*.

*In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (emphasis added). Accordingly, it is rightfully presumed that Applicant's goods are offered to all potential customers, and there will be overlap with Opposer's customers. Applicant is precluded from introducing or relying on evidence regarding its potential or actual customers and the trade channels in which its goods are sold.

Opposer's Request for Production of Documents No. 27 sought "[d]ocuments sufficient to show or describe the potential or actual customers or end-users of Applicant's Goods and Services.

Motion, Ex. A, Attachment F. Opposer's Request for Production of Documents No. 60 sought "[d]ocuments concerning Applicant's present market and channels of trade and intended markets and channels of trade." *Id.* at Attachment H. Applicant did not provide any documents responsive to these requests. In compliance with the Board's Order of June, 3, 2010, Applicant

is now precluded from relying on evidence regarding these requests. This factor weighs in favor of Opposer.

**4. *duPont* Factor 6 – Third Party Registrations of Elements of Opposer’s Mark Do Not Create Genuine Issue of Material Fact as to the Likelihood of Confusion Between Opposer’s Mark and Applicant’s Marks.**

Applicant provides a list of United States trademark registrations for marks containing “GEO” and “SPEC,” claiming that these weaken Opposer’s “GEOSPEC” mark. There are a number of problems with Applicant’s argument.

First, the registrations offered by Applicant fail to demonstrate that the third-party marks are actually being used. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison*, 396 F.3d 1369, 1373 (Fed. Cir. 2005). The mere existence of third-party marks including the fragments “GEO” and “SPEC” does nothing to show that consumers have become accustomed to seeing various “GEO” or “SPEC” marks, or that they have learned to distinguish between them. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973) (absent evidence of the extent of use of third-party marks, they provide no basis for saying that such marks have any bearing on finding no likelihood of confusion).

Second, Applicant notably did not include any third-party registrations in which “GEO” and “SPEC” are combined into a single mark, nor can it. Motion, Ex. A, Attachment I. This proves Opposer’s point that its “GEOSPEC” mark is not weak, and is deserving of protection from marks like Applicant’s that are confusingly similar. *See In re Land O Sky, LLC*, 2010 TTAB LEXIS 2 at \*18. (“Considering that only one other registrant has adopted the term HARVEST FARMS, the third-party registration evidence does not support applicant’s argument that HARVEST FARMS is a weak mark.”).

Finally, according to the Board, Applicant is precluded from introducing or relying on evidence responsive to Opposer's discovery requests that was not produced. Opposer's Request for Production of Documents No. 22 sought "[d]ocuments sufficient to show any third-party use, application or registration of a trade name, trademark or service mark incorporating 'GEOSPEC' or a term similar thereto for the time period from May 6, 2004, the present." Motion, Ex. A, Attachment F. Applicant provided no responsive documents to this request. Motion, Exhibit N. However, in direct contradiction of the Board's Order, on page 10 and in Exhibit B of its Response, Applicant attempts to introduce third-party marks that, according to Applicant, resemble Opposer's "GEOSPEC" mark. This evidence violates the Board's order, and should be disregarded.

There is no genuine issue of material fact regarding the lack of third-party use of "GEOSPEC." This factor weighs heavily in Opposer's favor.

**5. *duPont* Factor 12 – There is No Genuine Issue of Material Fact Regarding the Potential for Likelihood of Confusion Between Opposer's Mark and Applicant's Marks**

The potential for consumer confusion between Opposer's Mark and Applicant's Marks is considerable. And because "the test under § 1052(d) is likelihood of confusion, not actual confusion," Opposer is not obligated to prove as much. *Herbko Int'l Inc. v. Kappa Books, Inc.*, 308 F.3d at 1165. Taking all of the relevant factors discussed above, it is apparent that the potential for likelihood of confusion between Opposer's Mark and Applicant's Marks is substantial. Thus, in order to avoid potential consumer confusion due to the undeniable similarity between Opposer's Mark and Applicant's Marks, this factor weighs in favor of granting summary judgment to Opposer.

**B. Applicant Failed to Raise Any Genuine Issue of Material Fact of Likelihood of Confusion By Introducing Any Additional *duPont* Factors.**

**1. *duPont* Factor 4 – There is No Genuine Issue of Material Fact Regarding the Conditions of Sale of Opposer’s Goods and Applicant’s Goods.**

Applicant claims that the machines sold under its marks are inherently expensive and therefore, not likely to be confused with Opposer’s goods. Even if Applicant is correct that its machines sold, or rented, under its marks are expensive, this fact alone is not “highly probative of a lack of likelihood of confusion,” as alleged by Applicant. Response at 11. “Human memories even of discriminating purchasers... are not infallible.” *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 1406, 58 CCPA 751, 168 USPQ 110, 112 (CCPA 1970)). As is the case here, when there is strong similarity between competing marks, even careful purchasers are not immune from confusion on related goods. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 948-949 (Fed. Cir. 2000) (“The alleged sophistication of [consumers of the product] is outweighed by the Board’s finding of strong similarity of marks and identity of goods...”). Moreover, Applicant has not provided any evidence describing the identity of its current or prospective customers, and is precluded from doing so by the Board. Opposer’s Request for Production of Documents No. 27 sought “[d]ocuments sufficient to show or describe the potential or actual customers or end-users of Applicant’s Goods and Services. Motion, Ex. A, Attachment F. Applicant did not produce documents in response to this request, and is precluded from introducing or relying on such evidence now. The Board cannot make a conclusion as to the sophistication – or lack thereof – of Applicant’s customers based on its unsupported allegations. Therefore, this factor weighs in favor of Opposer.

**2. *duPont* Factor 5 – Applicant Raised No Genuine Issue of Material Fact Regarding the Fame of Opposer’s Mark.**

Applicant argues that Opposer’s “GEOSPEC” mark lacks fame, and therefore is entitled to little or no protection. In assessing fame of a mark, the proper inquiry is the extent to which customers and potential customers of a product are aware of the prior mark. *Palm Bay Imports Inc.*, 396 F.3d at 1375. To this end, Opposer has advertised and marketed its products to customers and potential customers at geotechnical conferences and trade shows, has earned hundreds of thousands of dollars in revenue, and has used its product on large scale products such as Interstate I-94 at Rotunda. Motion, Exhibit B. Notwithstanding these facts, Opposer need not prove the fame of its own federally registered mark. All registered marks are entitled to be protected from a likelihood of confusion with confusingly similar marks. *In re Land O Sky, LLC*, 2010 TTAB LEXIS 2, \*19.

**C. According to the Board’s Order, Applicant Is Precluded From Relying On Any Information Responsive to the Discovery Requests That Was Not Produced.**

Applicant attempts to evade the Order already handed down by the Board as a result of Applicant’s repeated failure to provide the requested discovery in the current proceedings. The Board ordered that “any objections still remain[ing] following applicant’s supplemental responses... will be disregarded and the requests to which they pertain will be construed against applicant.” Motion, Exhibit O. Applicant’s objection to Interrogatory No. 43 violates the Board’s Order, and as a result, this Interrogatory should be construed against it. It is nonsensical for Applicant to assume that the Board’s order prohibiting Applicant from objecting to Opposer’s discovery requests applies only to its supplemental responses, especially in light of the

fact that the Board's sanction is a direct result of "applicant's failure to comply with the Board's orders requiring applicant to respond without objection." *Id.*

Opposer also points to Interrogatory No. 29, a part of Applicant's supplemental discovery responses, which Applicant admits is subject to the Board's order prohibiting Applicant's objections to Opposer's discovery requests. Interrogatory No. 29 requests facts supporting Applicant's contention that there is no likelihood of confusion between Opposer's Mark and Applicant's Mark. Applicant objected to Interrogatory No. 29 in contravention of the Board's Order, and therefore, the interrogatory must be construed against it. This, in combination with all of the deficient discovery responses mentioned above, shows that Applicant cannot show a genuine issue of material fact as to any of the relevant *duPont* factors.

### III. CONCLUSION

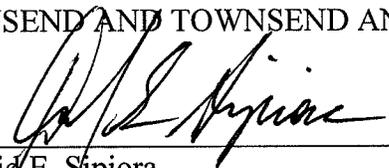
For the foregoing reasons, Opposer respectfully requests that the Board find that there is no genuine issue of material fact as to the likelihood of confusion between Opposer's Mark and Applicant's Marks, and grant Opposer's motion for summary judgment.

Dated: December 22, 2010

Respectfully submitted,

TOWNSEND AND TOWNSEND AND CREW LLP

By

  
\_\_\_\_\_  
David E. Sipiora  
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Attorneys for Opposer

**CERTIFICATE OF SERVICE**

I hereby certify that on December 22, 2010, I served the foregoing **OPPOSER'S**  
**REPLY IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT** on counsel for  
Applicant by depositing a true and correct copy of the same with the United States Postal  
Service, first class mail, postage prepaid, in an envelope addressed to:

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Kara Fielder