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

Proceeding	91181448
Party	Defendant Patriot Guard Riders, Inc.
Correspondence Address	James R. Foley Trexler, Bushnell, Giangiorgi, Blackston 36th Floor 105 West Adams St. Chicago, IL 60603 UNITED STATES dmarr@trexlaw.com, ptodocket@trexlaw.com
Submission	Opposition/Response to Motion
Filer's Name	David J. Marr
Filer's e-mail	ptodocket@trexlaw.com, dmarr@trexlaw.com, jomalley@trexlaw.com
Signature	/David J. Marr/
Date	03/18/2009
Attachments	Applicant'sResponseMotionStrike.pdf (5 pages)(137027 bytes) DeclStrikeJamesAO'Malley.pdf (4 pages)(98431 bytes) Exhibit28.pdf (21 pages)(608439 bytes) Exhibit29.pdf (6 pages)(94320 bytes) Exhibit30.pdf (12 pages)(275519 bytes) Exhibit31.pdf (8 pages)(324322 bytes) Exhibit32.pdf (5 pages)(200163 bytes) Exhibit33.pdf (8 pages)(362756 bytes) Exhibit34.pdf (5 pages)(161053 bytes) Exhibit35.pdf (6 pages)(271446 bytes) Exhibit36.pdf (5 pages)(200920 bytes) Exhibit37.pdf (11 pages)(488395 bytes) Exhibit38.pdf (5 pages)(197174 bytes) Exhibit39.pdf (7 pages)(282879 bytes) Exhibit40.pdf (5 pages)(195246 bytes) Exhibit41.pdf (5 pages)(215521 bytes) CertServiceStrike.pdf (1 page)(22136 bytes)

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

JEFF BROWN,)	
)	
Opposer,)	
)	Opposition No. 91181448
v.)	
)	Application No. 77/040,379
PATRIOT GUARD RIDERS, INC.,)	
)	
Applicant.)	

**APPLICANT’S RESPONSE TO OPPOSER’S MOTION TO STRIKE CERTAIN EXHIBITS
ATTACHED TO APPLICANT’S MEMORANDUM IN SUPPORT OF
ITS MOTION FOR SUMMARY JUDGMENT**

Applicant Patriot Guard Riders, Inc. (“Applicant” or “PGR”) submits its Response to Opposer’s Motion to Strike Certain Exhibits attached to Applicant’s Memorandum in Support of its Motion for Summary Judgment (“PGR’s Memorandum”).

Brown has moved to strike Exhibits 7, 16, 17 and 18 which were attached to PGR’s Memorandum on the basis that these exhibits were not authenticated. PGR respectfully requests that the Trademark Trial and Appeal Board (“TTAB”) deny Brown’s Motion to Strike.

I. EXHIBITS 7, 16 & 17

PGR notes that 37 CFR §2.127(e)(2) states:

For purposes of summary judgment only, the Board will consider any of the following, if a copy is provided with the party’s brief on the summary judgment motion: written disclosures or disclosed documents, a discovery deposition or any part thereof with any exhibit to the part that is filed, an interrogatory and answer thereto with any exhibit made part of the answer, a request for production and the documents or things produced in response thereto, or a request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto). (Emphasis added).

As such, for purposes of summary judgment only, the TTAB will consider all documents identified in 37 CFR §2.127(e)(2), *without authentication*, so long as the documents are provided with the party's summary judgment brief.

A. May 11, 2006 E-mail of Exhibit 17

The May 11, 2006 e-mail included in Exhibit 17 of PGR's Memorandum (which identifies Brown as the composer thereof) was produced by Brown as it displays "BROWN007994" at the bottom right-hand corner thereof. In Exhibit 4 of PGR's Memorandum, paragraphs 13-15 identified the attached documents thereto as Brown's Responses to PGR's Document Production Requests and that the documents produced in accordance therewith were identified by BATES stamping "BROWN #####". As such, in accordance with 37 CFR 2.127(e)(2), this e-mail was properly submitted in PGR's Memorandum because the Board *will consider* a request for production and the documents or things produced in response thereto if a copy is provided with the party's brief on the summary judgment motion. Furthermore, documents produced during discovery shall be deemed authentic when offered by a party opponent. *E.g., Wells v. Xpedx*, No. 8:05-CV-2193-T-EAJ, 2007 WL 2696566, at *4 (M.D. Fla. Sept. 11, 2007).

Thus, PGR respectfully requests that Brown's Motion to Strike the May 11, 2006 e-mail of Exhibit 17 be denied and that this e-mail be considered by the TTAB in connection with PGR's Memorandum.

B. Exhibits 7, 16 & February 24, 2006 and June 15, 2006 E-mails of Exhibit 17

PGR produced the May 15, 2006 e-mail of Exhibit 7 (BATES stamped as PGR002236-PGR002237), the Internet printout from October 6, 2006 of Exhibit 16 (BATES stamped as PGR001831-PGR001833), the February 24, 2006 e-mail of Exhibit 17 (BATES stamped as PGR002232), and the June

15, 2006 e-mail of Exhibit 17 (BATES stamped as PGR002238),¹ to Brown in response to his Document Production Requests. In Exhibit 4 of PGR's Memorandum, paragraph 16 identified the attached documents thereto as PGR's Responses to Brown's Document Production Requests and that the documents produced in accordance therewith were identified by BATES stamping "PGR #####". As such, in accordance with 37 CFR 2.127(e)(2), these documents were properly submitted in PGR's Memorandum because the Board *will consider* disclosed documents if a copy is provided with the party's brief on the summary judgment motion.² PGR further notes that Brown did not dispute the allegations set forth in the second sentence of Section VIII of PGR's Memorandum, which explicitly relies on Exhibit 16 for support.

Thus, PGR respectfully requests that Brown's Motion to Strike Exhibits 7, 16 and the February 24, 2006 and June 15, 2006 e-mails of Exhibit 17 be denied and that these documents be considered by the TTAB in connection with PGR's Memorandum.

II. EXHIBIT 18

Exhibit 18 is an Internet printout from www.merriam-webster.com which identifies the definition of the word "association" as "an organization of persons having a common interest". The TTAB may take judicial notice of dictionary definitions. *E.g., Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372 (Fed. Cir. 1983). The TTAB may also take judicial notice of dictionary definitions included in online dictionaries that exist in printed

¹PGR notes that each of these e-mails, as well as the content of the Internet posting, identifies Brown as the composer thereof.

²PGR notes that it did not attach PGR's Responses to Brown's Document Production Requests to its Memorandum as PGR's understanding of 37 CFR §2.127(e)(2) did not require it to do so because these were "disclosed documents". In the event that the TTAB might require PGR's Responses to Brown's Document Production Requests, PGR has attached them hereto as PGR's Exhibits 28-30 and PGR states that Brown would not be unfairly prejudiced by same as he is aware that PGR disclosed these documents to him pursuant to his Document Production Requests.

format or have regular fixed editions. *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1717 at n.4 (TTAB 2007). In this case, PGR identified a definition from www.merriam-webster.com, which the TTAB has repeatedly identified as an online dictionary that exists in printed format and/or that has regular fixed editions such that judicial notice can be taken therefrom.³ PGR also notes that the word “association” is a common word in the English language such that the TTAB could likely take judicial notice of this word’s definition, even without the use of a dictionary, as being an organization of two or more persons having a common interest.

Thus, PGR respectfully requests that Brown’s Motion to Strike Exhibit 18 be denied and that the TTAB take judicial notice of the definition of the word “association”, such that the Internet printout of Exhibit 18 be considered by the TTAB in connection with PGR’s Memorandum.

³See, e.g., *W. Sizzlin Corp. v. Hi Mountain Jerky, Inc.*, Opposition No. 91165983, 2008 WL 96114, at *5, n.3 (TTAB Jan. 3, 2008) (non-precedential) (PGR Ex. 31); *Ermenegildo Zegna Corp. v. Bekele*, Opposition No. 91170493, 2008 WL 902838, at *4, n.4 (TTAB Feb. 27, 2008) (non-precedential) (PGR Ex. 32); *Meier’s Wine Cellars, Inc. v. Meyer Intellectual Props. Ltd.*, Cancellation No. 92044883, 2008 WL 902837, at *7, n.10 (TTAB Mar. 4, 2008) (non-precedential) (PGR Ex. 33); *In re Dan-Foam APS*, Serial No. 78723624, 2008 WL 2515096, at *2 (TTAB June 13, 2008) (non-precedential) (PGR Ex. 34); *In re CompressorWorks, Inc.*, Serial No. 78855392, 2008 WL 2619535, at *4, n. 8 (TTAB June 20, 2008) (non-precedential) (PGR Ex. 35); *In re Am. Blanching Co.*, Serial No. 76443653, 2008 WL 2817085, at *2 (TTAB July 10, 2008); *In re Intuitive Surgical, Inc.*, Serial No. 76654345, 2008 WL 3244031, at *1 (TTAB July 25, 2008) (non-precedential) (PGR Ex. 36); *In re The Naples Group*, Serial No. 78767372, 2008 WL 4235321, at *1, n.6 (TTAB Sept. 4, 2008) (non-precedential) (PGR Ex. 37); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1590, n.8 (TTAB 2008); *In re S.A. Establecimientos Vitivinícolas Escorihuela*, Serial No. 78967315, 2008 WL 4354166, at *3 (TTAB Sept. 19, 2008) (non-precedential) (PGR Ex. 38); *In re Unigene Labs., Inc.*, Serial Nos. 78679380, 78679390, 7869397, 2008 WL 4674579, at *2, n.6 (TTAB Sept. 30, 2008) (non-precedential) (PGR Ex. 39); *In re Leonhardt*, Serial No. 78666879, 2008 WL 4922486, at *2, n.2 (TTAB Nov. 13, 2008); *Big O Tires, Inc. v. 67 and Latham, LLC*, Opposition Nos. 91178685, 91178688, 2008 WL 5078738, at *3 (TTAB Nov. 18, 2008) (non-precedential) (PGR Ex. 40); and *Addict, Ltd. v. GS & G, Inc. USA*, Cancellation No. 92046699, 2009 WL 30133, at *3 (TTAB Jan. 2, 2009) (non-precedential) (PGR Ex. 41).

III. CONCLUSION

In view of the foregoing, PGR respectfully requests that the TTAB deny Brown's Motion to Strike Exhibits 7, 16, 17 and 18 and that the TTAB consider each of Exhibits 7, 16, 17 and 18 in connection with PGR's Memorandum.

Dated: 3/18/09

Respectfully submitted,

By: 

One of Applicant's Attorneys
David J. Marr
James R. Foley
James A. O'Malley
TREXLER, BUSHNELL, GIANGIORGI,
BLACKSTONE & MARR, LTD.
105 W. Adams Street, Suite 3600
Chicago, Illinois 60603-6210
(312) 704-1890

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

JEFF BROWN,)	
)	
Opposer,)	
)	Opposition No. 91181448
v.)	
)	Application No. 77/040,379
PATRIOT GUARD RIDERS, INC.,)	
)	
Applicant.)	

**DECLARATION OF JAMES A. O'MALLEY IN SUPPORT OF
APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO STRIKE CERTAIN EXHIBITS
ATTACHED TO APPLICANT'S MEMORANDUM IN SUPPORT OF
ITS MOTION FOR SUMMARY JUDGMENT**

I, James A. O'Malley, declare and state as follows:

1. I am an attorney with the law firm of Trexler, Bushnell, Giangiorgi, Blackstone & Marr, Ltd., counsel for Applicant Patriot Guard Riders, Inc. in the above-captioned proceeding. As such, I have personal knowledge of the facts set forth below. If called upon and sworn as a witness, I could and would competently testify to the facts set forth below.
2. Applicant originally submitted Exhibits 1-18 in connection with "Applicant's Memorandum in Support of its Motion for Summary Judgment" which was filed with the Trademark Trial and Appeal Board on January 22, 2009.
3. Applicant submitted Exhibits 19-27 in connection with "Applicant's Reply to Opposer's Response in Opposition to Applicant's Motion for Summary Judgment" which was filed with the Trademark Trial and Appeal Board today, March 18, 2009.
4. Exhibit 28 is submitted in support of "Applicant's Response to Opposer's Motion to Strike Certain Exhibits Attached to Applicant's Memorandum in Support of its Motion for Summary Judgment" and is a true and correct copy of "Applicant's Response to Opposer's First Requests for Production of Documents", which were served on Opposer on May 27, 2008.

5. Exhibit 29 is submitted in support of “Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to Applicant’s Memorandum in Support of its Motion for Summary Judgment” and is a true and correct copy of “Applicant’s Amended/Supplemental Response to Certain Requests for Production of Documents”, which were served on Opposer on December 19, 2008.

6. Exhibit 30 is submitted in support of “Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to Applicant’s Memorandum in Support of its Motion for Summary Judgment” and is a true and correct copy of “Applicant’s Response to Opposer’s Second Requests for Production of Documents”, which were served on Applicant on December 1, 2008.

7. Exhibit 31 is submitted in support of “Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to Applicant’s Memorandum in Support of its Motion for Summary Judgment” and is a true and correct copy of *Western Sizzlin Corporation v. Hi Mountain Jerky, Inc.*, Opposition No. 91165983, 2008 WL 96114 (TTAB Jan. 3, 2008) (non-precedential).

8. Exhibit 32 is submitted in support of “Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to Applicant’s Memorandum in Support of its Motion for Summary Judgment” and is a true and correct copy of *Ermenegildo Zegna Corporation v. Bekele*, Opposition No. 91170493, 2008 WL 902838 (TTAB Feb. 27, 2008) (non-precedential).

9. Exhibit 33 is submitted in support of “Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to Applicant’s Memorandum in Support of its Motion for Summary Judgment” and is a true and correct copy of *Meier’s Wine Cellars, Inc. v. Meyer Intellectual Properties Limited*, Cancellation No. 92044883, 2008 WL 902837 (TTAB Mar. 4, 2008) (non-precedential).

10. Exhibit 34 is submitted in support of “Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to Applicant’s Memorandum in Support of its Motion for Summary Judgment” and is a true and correct copy of *In re Dan-Foam APS*, Serial No. 78723624, 2008 WL 2515096 (TTAB June 13, 2008) (non-precedential).

11. Exhibit 35 is submitted in support of “Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to Applicant’s Memorandum in Support of its Motion for Summary Judgment” and is a true and correct copy of *In re CompressorWorks, Inc.*, Serial No. 78855392, 2008 WL 2619535 (TTAB June 20, 2008) (non-precedential).

12. Exhibit 36 is submitted in support of “Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to Applicant’s Memorandum in Support of its Motion for Summary Judgment” and is a true and correct copy of *In re Intuitive Surgical, Inc.*, Serial No. 76654345, 2008 WL 3244031 (TTAB July 25, 2008) (non-precedential).

13. Exhibit 37 is submitted in support of “Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to Applicant’s Memorandum in Support of its Motion for Summary Judgment” and is a true and correct copy of *In re The Naples Group*, Serial No. 78767372, 2008 WL 4235321 (TTAB Sept. 4, 2008) (non-precedential).

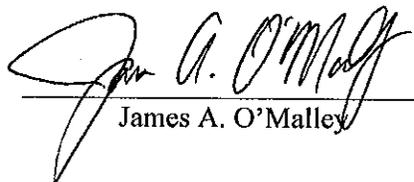
14. Exhibit 38 is submitted in support of “Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to Applicant’s Memorandum in Support of its Motion for Summary Judgment” and is a true and correct copy of *In re S.A. Establecimientos Vitivinícolas Escorihuela*, Serial No. 78967315, 2008 WL 4354166 (TTAB Sept. 19, 2008) (non-precedential).

15. Exhibit 39 is submitted in support of “Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to Applicant’s Memorandum in Support of its Motion for Summary Judgment” and is a true and correct copy of *In re Unigene Laboratories, Inc.*, Serial Nos. 78679380, 78679390 and 78679397, 2008 WL 4674579 (TTAB Sept. 30, 2008) (non-precedential).

16. Exhibit 40 is submitted in support of “Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to Applicant’s Memorandum in Support of its Motion for Summary Judgment” and is a true and correct copy of *Big O Tires, Inc. v. 67 and Latham, LLC*, Opposition Nos. 91178685 and 91178688, 2008 WL 5078738 (TTAB Nov. 18, 2008) (non-precedential).

17. Exhibit 41 is submitted in support of “Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to Applicant’s Memorandum in Support of its Motion for Summary Judgment” and is a true and correct copy of *Addict, Ltd. v. GS & G, Inc. USA*, Cancellation No. 92046699, 2009 WL 30133 (TTAB Jan. 2, 2009) (non-precedential).

Executed on: March 18, 2009



James A. O'Malley

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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JEFF BROWN,)	
)	
Opposer,)	
)	Opposition No. 91181448
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)	Application No. 77/040,379
PATRIOT GUARD RIDERS, INC.,)	
)	
Applicant.)	

EXHIBIT 28

of

**“Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to
Applicant’s Memorandum in Support of its Motion for Summary Judgment”**

**IN THE UNITED STATES PATENT & TRADEMARK OFFICE
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JEFF BROWN,)	
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PATRIOT GUARD RIDERS, INC.,)	
)	
Applicant.)	

**APPLICANT'S RESPONSE TO
OPPOSER'S FIRST REQUESTS FOR PRODUCTION OF DOCUMENTS**

Applicant, Patriot Guard Riders, Inc., hereby responds to "*Petitioner's First Requests for Production of Documents*" as follows:

GENERAL OBJECTIONS AND CONDITIONS

1. Applicant objects to these requests to the extent that they seek documents or things which are neither relevant to the issues raised in this Opposition, nor reasonably calculated to lead to the discovery of admissible evidence.
2. Applicant objects to these requests to the extent they seek information which is protected from disclosure under the attorney-client privilege or work product immunity doctrine.
3. Applicant objects to these requests as being unduly broad and burdensome to the extent they seek the production of "*all*" documents or things. Unless otherwise indicated, Applicant will produce relevant responsive documents or things which it was able to locate as a result of a comprehensive search of documents and things that were within Applicant's possession, custody or control.
4. Applicant objects to producing documents and things which are readily available to Opposer from public sources on the ground that the burden of obtaining such documents or things is the same for Applicant as it would be for Opposer.

5. To the extent that Applicant responds to a request for documents or things, it should not be construed as a representation or admission that the documents or things will be admissible as evidence.

6. A response that indicates that documents or things will be produced is subject to the foregoing general objections, which are deemed to be incorporated into each of Applicant's responses. Documents or things which are free of such objections shall be referred to below as "producible documents or things".

REQUEST FOR PRODUCTION NO. 1

Produce all documents that refer or relate to the corporate status of the Applicant, including, but not limited to, articles of incorporation, bylaws, and shareholder agreements.

RESPONSE TO REQUEST FOR PRODUCTION NO. 1

Applicant has already provided "producible documents or things" to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Subject to the foregoing general objections, to the extent Applicant has any further "producible documents or things" within its possession, custody or control, Applicant will make these further "producible documents or things" available for inspection and/or copying at Applicant's attorneys' offices at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further "producible documents or things" and will forward them to Opposer's counsel.

REQUEST FOR PRODUCTION NO. 2

Produce all documents that refer or relate to the date of first use by the Applicant or its licensees of the alleged marks PATRIOT GUARD RIDERS or PATRIOT GUARD RIDERS RIDING WITH RESPECT.

RESPONSE TO REQUEST FOR PRODUCTION NO. 2

Applicant has already provided “producible documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Subject to the foregoing general objections, to the extent Applicant has any further “producible documents or things” within its possession, custody or control, Applicant will make these further “producible documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further “producible documents or things” and will forward them to Opposer’s counsel.

REQUEST FOR PRODUCTION NO. 3

Produce all documents that refer or relate to any representative specimens, including, but not limited to any invoices or other documentation that support any claimed first use.

RESPONSE TO REQUEST FOR PRODUCTION NO. 3

Applicant has already provided “producible documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Subject to the foregoing general objections, to the extent Applicant has any further “producible documents or things” within its possession custody or control, Applicant will make these further “producible documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further “producible documents or things” and will forward them to Opposer’s counsel.

Upon information and belief, Opposer has such “producible documents and things” but has refused to provide same to Applicant as generally discussed in *“Applicant’s Response to Opposer’s First Set of Interrogatories”* – see *“Response to Interrogatory No. 6”*, *“Response to Interrogatory No. 11”*, *“Response to Interrogatory No. 18”* and *“Response to Interrogatory No.*

21". Applicant again requests that Opposer provide Applicant with these "producible documents and things".

REQUEST FOR PRODUCTION NO. 4

Produce all documents that refer or relate to any considered or used alternative marks or alternative forms of the alleged marks PATRIOT GUARD RIDERS or PATRIOT GUARD RIDERS RIDING WITH RESPECT.

RESPONSE TO REQUEST FOR PRODUCTION NO. 4

Applicant has already provided "producible documents or things" to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Subject to the foregoing general objections, to the extent Applicant has any further "producible documents or things" within its possession custody or control, Applicant will make these further "producible documents or things" available for inspection and/or copying at Applicant's attorneys' office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further "producible documents or things" and will forward them to Opposer's counsel.

REQUEST FOR PRODUCTION NO. 5

Produce all documents that refer or relate to any publicity surrounding the use of the alleged marks PATRIOT GUARD RIDERS or PATRIOT GUARD RIDERS RIDING WITH RESPECT, as well as any publicity surrounding the use of any considered or used alternative marks or alternative forms of the alleged marks PATRIOT GUARD RIDER or PATRIOT GUARD RIDERS RIDING WITH RESPECT.

RESPONSE TO REQUEST FOR PRODUCTION NO. 5

Applicant has already provided “producible documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Applicant objects to this Request because the term “publicity” is not defined.

Subject to the foregoing objections, to the extent Applicant has any further “producible documents or things” within its possession custody or control, Applicant will make these further “producible documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further “producible documents or things” and will forward them to Opposer’s counsel.

REQUEST FOR PRODUCTION NO. 6

Produce all document that refer or relate to the ultimate selection of the alleged marks PATRIOT GUARD RIDERS or PATRIOT GUARD RIDERS RIDING WITH RESPECT.

RESPONSE TO REQUEST FOR PRODUCTION NO. 6

Applicant has already provided “producible documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Subject to the foregoing general objections, to the extent Applicant has any further “producible documents or things” within its possession, custody or control, Applicant will make these further “producible documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further “producible documents or things” and will forward them to Opposer’s counsel.

REQUEST FOR PRODUCTION NO. 7

Produce all documents that refer or relate in any way to the adoption of the alleged marks PATRIOT GUARD RIDERS or PATRIOT GUARD RIDERS RIDING WITH RESPECT and design by Applicant.

RESPONSE TO REQUEST FOR PRODUCTION NO. 7

Applicant has already provided “producible documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Subject to the foregoing general objections, to the extent Applicant has any further “producible documents or things” within its possession, custody or control, Applicant will make these further “producible documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further “producible documents or things” and will forward them to Opposer’s counsel.

REQUEST FOR PRODUCTION NO. 8

Produce all documents that refer or relate to sales of products bearing the PATRIOT GUARD RIDER or PATRIOT GUARD RIDERS RIDING WITH RESPECT marks.

RESPONSE TO REQUEST FOR PRODUCTION NO. 8

Applicant has already provided “producible documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Subject to the foregoing general objections, to the extent Applicant has any further “producible documents or things” within its possession, custody or control, Applicant will make these further “producible documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further

“producing documents or things” and will forward them to Opposer’s counsel.

Upon information and belief, Opposer also has such “producing documents and things” but has refused to provide same to Applicant as generally discussed in “Applicant’s Response to Opposer’s First Set of Interrogatories” – see “Response to Interrogatory No. 6”, “Response to Interrogatory No. 11”, “Response to Interrogatory No. 18” and “Response to Interrogatory No. 21”. Applicant again requests that Opposer provide Applicant with these “producing documents and things”.

REQUEST FOR PRODUCTION NO. 9

Produce all documents that refer or relate to any advertising or marketing by the Applicant using the marks PATRIOT GUARD RIDER or PATRIOT GUARD RIDERS RIDING WITH RESPECT marks.

RESPONSE TO REQUEST FOR PRODUCTION NO. 9

See Applicant’s “Response to Interrogatory No. 25”.

Applicant has already provided “producing documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Subject to the foregoing general objections, to the extent Applicant has any further “producing documents or things” within its possession, custody or control, Applicant will make these further “producing documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further “producing documents or things” and will forward them to Opposer’s counsel.

REQUEST FOR PRODUCTION NO. 10

Produce all documents that refer or relate to the class of purchasers for the PATRIOT GUARD RIDER or PATRIOT GUARD RIDERS RIDING WITH RESPECT marks.

RESPONSE TO REQUEST FOR PRODUCTION NO. 10

Applicant has already provided “producible documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Applicant objects to this Request as it seeks information and documents which are neither relevant to the issues in the present Opposition, nor which are reasonably calculated to lead to the discovery of admissible evidence.

Subject to the foregoing objections, to the extent Applicant has any further “producible documents or things” within its possession, custody or control, Applicant will make these further “producible documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further “producible documents or things” and will forward them to Opposer’s counsel.

REQUEST FOR PRODUCTION NO. 11

Produce all documents that refer or relate to the geographical areas in which products bearing the PATRIOT GUARD RIDER or PATRIOT GUARD RIDERS RIDING WITH RESPECT marks are sold and/or otherwise used.

RESPONSE TO REQUEST FOR PRODUCTION NO. 11

Applicant has already provided “producible documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Applicant objects to this Request as it seeks information and documents which are neither relevant to the issues in the present Opposition, nor which are reasonably calculated to lead to the discovery of admissible evidence.

Subject to the foregoing objections, to the extent Applicant has any further “producible documents or things” within its possession, custody or control, Applicant will make these further “producible documents or things” available for inspection and/or copying at Applicant’s

attorneys' office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further "producible documents or things" and will forward them to Opposer's counsel.

REQUEST FOR PRODUCTION NO. 12

Produce all documents that refer or relate to the net profits to Applicant derived from the sale and or distribution of products bearing the PATRIOT GUARD RIDER or PATRIOT GUARD RIDERS RIDING WITH RESPECT marks.

RESPONSE TO REQUEST FOR PRODUCTION NO. 12

Applicant has already provided "producible documents or things" to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Subject to the foregoing general objections, to the extent Applicant has any further "producible documents or things" within its possession, custody or control, Applicant will make these further "producible documents or things" available for inspection and/or copying at Applicant's attorneys' office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further "producible documents or things" and will forward them to Opposer's counsel.

Upon information and belief, Opposer also has such "producible documents and things" but has refused to provide same to Applicant as generally discussed in "*Applicant's Response to Opposer's First Set of Interrogatories*" – see "*Response to Interrogatory No. 6*", "*Response to Interrogatory No. 11*", "*Response to Interrogatory No. 18*" and "*Response to Interrogatory No. 21*". Applicant again requests that Opposer provide Applicant with these "producible documents and things".

REQUEST FOR PRODUCTION NO. 13

Produce all documents that refer or relate to the use of the PATRIOT GUARD RIDER or PATRIOT GUARD RIDERS RIDING WITH RESPECT marks on services sold, distributed or marketed by third parties.

RESPONSE TO REQUEST FOR PRODUCTION NO. 13

Applicant has already provided “producible documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Subject to the foregoing general objections, to the extent Applicant has any further “producible documents or things” within its possession, custody or control, Applicant will make these further “producible documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further “producible documents or things” and will forward them to Opposer’s counsel.

REQUEST FOR PRODUCTION NO. 14

Produce all documents that refer or relate to the licensing, transfer or sale of the PATRIOT GUARD RIDER or PATRIOT GUARD RIDERS RIDING WITH RESPECT marks to any third parties.

RESPONSE TO REQUEST FOR PRODUCTION NO. 14

Applicant has already provided “producible documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Subject to the foregoing general objections, to the extent Applicant has any further “producible documents or things” within its possession, custody or control, Applicant will make these further “producible documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel.

Alternatively, upon arrangement with counsel, Applicant will make copies of these further “producible documents or things” and will forward them to Opposer’s counsel.

REQUEST FOR PRODUCTION NO. 15

Produce all documents that refer or relate to any trademark search reports with respect to the alleged marks PATRIOT GUARD RIDER or PATRIOT GUARD RIDERS RIDING WITH RESPECT conducted at any time.

RESPONSE TO REQUEST FOR PRODUCTION NO. 15

Applicant states that no such producible documents or things exist, other than those available to Opposer in the records of the United States Patent and Trademark Office.

REQUEST FOR PRODUCTION NO. 16

Produce all documents that refer or relate to Petitioner’s registration of the marks PATRIOT GUARD RIDER or PATRIOT GUARD RIDERS RIDING WITH RESPECT.

RESPONSE TO REQUEST FOR PRODUCTION NO. 16

Applicant has already provided “producible documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Applicant objects to this Request in part because, based upon Applicant’s knowledge and belief, Opposer has to registered, nor attempted to register, the mark PATRIOT GUARD RIDERS RIDING WITH RESPECT.

Subject to the foregoing general objections, to the extent Applicant has any further “producible documents or things” within its possession, custody or control relating to Opposer’s attempted registration of the mark PATRIOT GUARD RIDER, which are not available to Opposer in the records of the United States Patent and Trademark Office, Applicant will make these further “producible documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel.

Alternatively, upon arrangement with counsel, Applicant will make copies of these further “producible documents or things” and will forward them to Opposer’s counsel.

REQUEST FOR PRODUCTION NO. 17

Produce all documents that refer or relate to any investigation or objection into Petition’s registration or use of the marks PATRIOT GUARD RIDER.

RESPONSE TO REQUEST FOR PRODUCTION NO. 17

Applicant has already provided “producible documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Subject to the foregoing general objections, to the extent Applicant has any further “producible documents or things” within its possession, custody or control, Applicant will make these further “producible documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further “producible documents or things” and will forward them to Opposer’s counsel.

REQUEST FOR PRODUCTION NO. 18

Produce all documents that refer or relate to the sale or distribution by third parties of products similar to Applicant’s products.

RESPONSE TO REQUEST FOR PRODUCTION NO. 18

Applicant has already provided “producible documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Subject to the foregoing general objections, to the extent Applicant has any further “producible documents or things” within its possession, custody or control, Applicant will make these further “producible documents or things” available for inspection and/or copying at

Applicant's attorneys' office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further "producible documents or things" and will forward them to Opposer's counsel.

REQUEST FOR PRODUCTION NO. 19

Produce all documents that refer or relate to Applicant's knowledge of Petitioner's use of the marks PATRIOT GUARD RIDER.

RESPONSE TO REQUEST FOR PRODUCTION NO. 19

Applicant has already provided "producible documents or things" to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Subject to the foregoing general objections, to the extent Applicant has any further "producible documents or things" within its possession, custody or control, Applicant will make these further "producible documents or things" available for inspection and/or copying at Applicant's attorneys' office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further "producible documents or things" and will forward them to Opposer's counsel.

REQUEST FOR PRODUCTION NO. 20

Produce all documents, including but not limited to website posts, online comments, emails, and minutes, that refer or relate to Applicant's application or Petitioner's opposition.

RESPONSE TO REQUEST FOR PRODUCTION NO. 20

Applicant has already provided "producible documents or things" to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Subject to the foregoing general objections, to the extent Applicant has any further "producible documents or things" within its possession, custody or control, Applicant will make

these further “producible documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further “producible documents or things” and will forward them to Opposer’s counsel.

REQUEST FOR PRODUCTION NO. 21

Produce all documents, including but not limited to website posts, online comments, emails, and minutes, that refer or relate to any direction, suggestion or implication that products or other items should not be purchased from Petitioner.

RESPONSE TO REQUEST FOR PRODUCTION NO. 21

Applicant has already provided “producible documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Applicant objects to this Request as it seeks documents which are neither relevant to the issues raised in this Opposition, nor which are reasonably calculated to lead to the discovery of admissible evidence.

Subject to the foregoing general objections, to the extent Applicant has any further “producible documents or things” within its possession, custody or control, Applicant will make these further “producible documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further “producible documents or things” and will forward them to Opposer’s counsel.

REQUEST FOR PRODUCTION NO. 22

Produce all documents, including but not limited to website posts, online comments, emails, and minutes, that refer or relate to any direction, suggestion or implication that communications with Petitioner should cease.

RESPONSE TO REQUEST FOR PRODUCTION NO. 22

Applicant has already provided “producible documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Applicant objects to this Request as it seeks documents which are neither relevant to the issues raised in this Opposition, nor which are reasonably calculated to lead to the discovery of admissible evidence.

Subject to the foregoing general objections, to the extent Applicant has any further “producible documents or things” within its possession, custody or control, Applicant will make these further “producible documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further “producible documents or things” and will forward them to Opposer’s counsel.

REQUEST FOR PRODUCTION NO. 23

Produce all documents that refer or relate to any contracts or agreements with any vendor or other third party that Applicant has either formally or informally authorized or allowed to use the marks PATRIOT GUARD RIDER or PATRIOT GUARD RIDERS RIDING WITH RESPECT in any manner.

RESPONSE TO REQUEST FOR PRODUCTION NO. 23

Applicant has already provided “producible documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Applicant objects to this Request as it seeks documents which are neither relevant to the issues raised in this Opposition, nor which are reasonably calculated to lead to the discovery of admissible evidence.

Subject to the foregoing general objections, to the extent Applicant has any further “producible documents or things” within its possession, custody or control, Applicant will make

these further “producible documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further “producible documents or things” and will forward them to Opposer’s counsel.

REQUEST FOR PRODUCTION NO. 24

Produce all documents, including but not limited to website posts, online comments, emails, and minutes, that refer or relate to Petitioner.

RESPONSE TO REQUEST FOR PRODUCTION NO. 24

Applicant has already provided “producible documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Subject to the foregoing general objections, to the extent Applicant has any further “producible documents or things” within its possession, custody or control, Applicant will make these further “producible documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further “producible documents or things” and will forward them to Opposer’s counsel.

REQUEST FOR PRODUCTION NO. 25

Produce all documents, including but not limited to website posts, online comments, emails, and minutes, that refer or relate to any investigation, action, evaluation, discipline, or report regarding Jason Wallin.

RESPONSE TO REQUEST FOR PRODUCTION NO. 25

Applicant has already provided “producible documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Applicant objects to this Request as it seeks documents which are neither relevant to the issues raised in this Opposition, nor which are reasonably calculated to lead to the discovery of admissible evidence.

Subject to the foregoing general objections, to the extent Applicant has any further “producidle documents or things” within its possession, custody or control, Applicant will make these further “producidle documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further “producidle documents or things” and will forward them to Opposer’s counsel.

REQUEST FOR PRODUCTION NO. 26

Produce all documents that you intend to enter as evidence in this matter.

RESPONSE TO REQUEST FOR PRODUCTION NO. 26

Applicant objects to this Request as being premature, as the Opposition proceeding currently only in the early stages of the discovery phase.

Applicant has already provided “producidle documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Subject to the foregoing general objections, to the extent Applicant has any further “producidle documents or things” within its possession, custody or control, Applicant will make these further “producidle documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further “producidle documents or things” and will forward them to Opposer’s counsel.

REQUEST FOR PRODUCTION NO. 27

Produce all documents that support or refute your application in this matter.

RESPONSE TO REQUEST FOR PRODUCTION NO. 27

Applicant objects to this Request as being premature, as the Opposition proceeding currently only in the early stages of the discovery phase.

Applicant has already provided “producible documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Subject to the foregoing general objections, to the extent Applicant has any further “producible documents or things” within its possession, custody or control, Applicant will make these further “producible documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further “producible documents or things” and will forward them to Opposer’s counsel.

REQUEST FOR PRODUCTION NO. 28

Produce all documents that support or refute Petitioner’s claims in this matter.

RESPONSE TO REQUEST FOR PRODUCTION NO. 28

Applicant objects to this Request as being premature, as the Opposition proceeding currently only in the early stages of the discovery phase.

Applicant has already provided “producible documents or things” to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Subject to the foregoing general objections, to the extent Applicant has any further “producible documents or things” within its possession, custody or control, Applicant will make these further “producible documents or things” available for inspection and/or copying at Applicant’s attorneys’ office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further “producible documents or things” and will forward them to Opposer’s counsel.

REQUEST FOR PRODUCTION NO. 29

Produce all documents provided to any expert, advisor or consultant.

RESPONSE TO REQUEST FOR PRODUCTION NO. 29

Applicant has already provided "producible documents or things" to Opposer through its Initial Disclosures (documents PGR 000001 - PGR 000886) which may be responsive to this request.

Subject to the foregoing general objections, to the extent Applicant has any further "producible documents or things" within its possession, custody or control, Applicant will make these further "producible documents or things" available for inspection and/or copying at Applicant's attorneys' office at a mutually agreeable time and date to be arranged by counsel. Alternatively, upon arrangement with counsel, Applicant will make copies of these further "producible documents or things" and will forward them to Opposer's counsel.

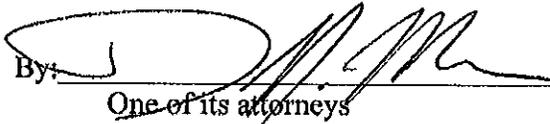
Respectfully submitted,

PATRIOT GUARD RIDERS, INC.

Date: _____

5/29/08

By: _____



One of its attorneys

David J. Marr
James R. Foley
James A. O'Malley
TREXLER, BUSHNELL, GIANGIORGI,
BLACKSTONE & MARR, LTD.
105 West Adams Street, 36th Floor
Chicago, Illinois 60603
Tel: (312) 704-1890
Fax: (312) 704-8023

Attorneys for the Applicant

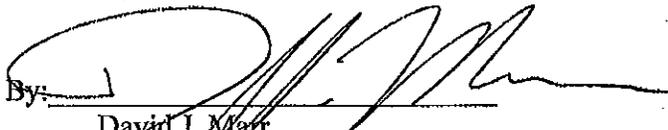
9Z5833

CERTIFICATE OF SERVICE

I certify that a copy of the foregoing **APPLICANT'S RESPONSE TO OPPOSER'S FIRST REQUESTS FOR PRODUCTION OF DOCUMENTS** has been served on the following counsel, by United States mail, on May 27, 2008.

Tom Q. Ferguson
Rachel Blue
Doerner, Saunders, Daniel & Anderson, L.L.P.
320 South Boston Avenue, Suite 500
Tulsa, Oklahoma 74103-3725
Facsimile: (918) 591-5360

Date: May 27, 2008

By: 
David J. Mair
One of Applicant's attorneys

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

JEFF BROWN,)	
)	
Opposer,)	
)	Opposition No. 91181448
v.)	
)	Application No. 77/040,379
PATRIOT GUARD RIDERS, INC.,)	
)	
Applicant.)	

EXHIBIT 29

of

**“Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to
Applicant’s Memorandum in Support of its Motion for Summary Judgment”**

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

JEFF BROWN,)	
)	
Opposer,)	
)	Opposition No. 91181448
v.)	
)	Serial No. 77/040,379
PATRIOT GUARD RIDERS, INC.,)	
)	
Applicant.)	

**APPLICANT'S AMENDED/SUPPLEMENTAL RESPONSE TO CERTAIN
REQUESTS FOR PRODUCTION OF DOCUMENTS**

Applicant, Patriot Guard Riders, Inc., hereby submits its amended/supplemental responses to Requests for Production Nos. 26, 27 and 28 as follows:

GENERAL OBJECTIONS AND CONDITIONS

1. Applicant objects to these requests to the extent that they seek documents or things which are neither relevant to the issues raised in this Opposition, nor reasonably calculated to lead to the discovery of admissible evidence.
2. Applicant objects to these requests to the extent they seek information which is protected from disclosure under the attorney-client privilege or work product immunity doctrine.
3. Applicant objects to these requests as being unduly broad and burdensome to the extent they seek the production of "all" documents or things. Unless otherwise indicated, Applicant will produce relevant responsive documents or things which it was able to locate as a result of a comprehensive search of documents and things that were within Applicant's possession, custody or control.
4. Applicant objects to producing documents and things which are readily available to Opposer from public sources on the ground that the burden of obtaining such documents or things is the same for Applicant as it would be for Opposer.

5. To the extent that Applicant responds to a request for documents or things, it should not be construed as a representation or admission that the documents or things will be admissible as evidence.

6. A response that indicates that documents or things will be produced is subject to the foregoing general objections, which are deemed to be incorporated into each of Applicant's responses. Documents or things which are free of such objections shall be referred to below as "producible documents or things".

REQUEST FOR PRODUCTION NO. 26

Produce all documents that you intend to enter as evidence in this matter.

AMENDED/SUPPLEMENTAL RESPONSE TO REQUEST FOR PRODUCTION NO. 26

All documents that Applicant presently intends to enter as evidence in this matter have been produced by one or both of the parties. Applicant has acted in a good faith manner and to the best of its ability to produce all responsive, non-privileged documents in response to this Request for Production.

REQUEST FOR PRODUCTION NO. 27

Produce all documents that support or refute your application in this matter.

AMENDED/SUPPLEMENTAL RESPONSE TO REQUEST FOR PRODUCTION NO. 27

As presently advised, all documents that support or refute Applicant's application in this matter, namely United States Trademark Application No. 77/040,379 for the mark "PATRIOT GUARD RIDERS RIDING WITH RESPECT", have been produced by one or both of the parties. Applicant has acted in a good faith manner and to the best of its ability to produce all responsive, non-privileged documents in response to this Request for Production.

REQUEST FOR PRODUCTION NO. 28

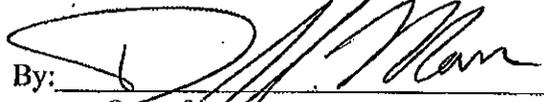
Produce all documents that support or refute Petitioner's claims in this matter.

AMENDED/SUPPLEMENTAL RESPONSE TO REQUEST FOR PRODUCTION NO. 28

As presently advised, all documents that support or refute Petitioner's claims in this matter have been produced by one or both of the parties. Applicant has acted in a good faith manner and to the best of its ability to produce all responsive, non-privileged documents in response to this Request for Production.

Respectfully submitted,

PATRIOT GUARD RIDERS, INC.

By: 
One of its attorneys

Date: 12/19/08

David J. Marr
James R. Foley
James A. O'Malley
TREXLER, BUSHNELL, GIANGIORGI,
BLACKSTONE & MARR, LTD.
105 West Adams Street, 36th Floor
Chicago, Illinois 60603
Tel: (312) 704-1890
Fax: (312) 704-8023

Attorneys for the Applicant

A79211

CERTIFICATE OF SERVICE

I certify that a copy of the foregoing *APPLICANT'S AMENDED/SUPPLEMENTAL RESPONSE TO CERTAIN REQUESTS FOR PRODUCTION OF DOCUMENTS* has been served on the following counsel, by United States mail, on December 19, 2008.

Tom Q. Ferguson
Rachel Blue
Courtney Bru
Doerner, Saunders, Daniel & Anderson, L.L.P.
320 South Boston Avenue, Suite 500
Tulsa, Oklahoma 74103-3725
Facsimile: (918) 591-5360

Date: December 19, 2008

By: 
David J. Marr
One of Applicant's attorneys

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

JEFF BROWN,)	
)	
Opposer,)	
)	Opposition No. 91181448
v.)	
)	Application No. 77/040,379
PATRIOT GUARD RIDERS, INC.,)	
)	
Applicant.)	

EXHIBIT 30

of

**“Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to
Applicant’s Memorandum in Support of its Motion for Summary Judgment”**

5. To the extent that Applicant responds to a request for documents or things, it should not be construed as a representation or admission that the documents or things will be admissible as evidence.

6. A response that indicates that documents or things will be produced is subject to the foregoing general objections, which are deemed to be incorporated into each of Applicant's responses. Documents or things which are free of such objections shall be referred to below as "producible documents or things".

REQUEST FOR PRODUCTION NO. 31

Produce all posts to forums regarding any store selling merchandise affixed with the Disputed PGR Mark that were posted between the period of November 1, 2005 to December 31, 2005.

RESPONSE TO REQUEST FOR PRODUCTION NO. 31

Subject to the foregoing objections, to the extent Applicant has any of the requested producible documents or things in its possession, custody or control, Applicant will produce same to the best of its ability. Applicant states that some of the documents previously produced by Applicant and/or Opposer may include or make reference to the requested documents or things.

REQUEST FOR PRODUCTION NO. 32

Produce all current and archived forum posts stored in the Captains Forums relating to Jeff Brown.

RESPONSE TO REQUEST FOR PRODUCTION NO. 32

Applicant objects to this Request for Production as being overly broad and overly burdensome. Applicant states that there are approximately one thousand current and archived forum topics or threads that are stored in the Captains Forums, and this number continues to grow daily. Within these current and archived forum topics or threads, there are well over eighteen thousand individual forum posts; again this number continues to grow daily. Of these current and archived forum posts, a significant portion arguably "relate" to Jeff Brown, but a large number are undoubtedly not in any way relevant to the issues properly pleaded in this Opposition by Opposer, namely which party has prior/superior rights in the mark at issue and whether Applicant's trademark application was fraudulently filed, and, as such, the vast majority of these current and archived forum posts that "relate" to Jeff Brown are not reasonably calculated to lead to the discovery of admissible evidence.

Subject to the foregoing objections, however, Applicant will produce to the best of its

ability the requested producible documents and things that are, in any way, relevant to the issues that were properly pleaded in this Opposition by the Opposer, to the extent Applicant has any of the requested producible documents or things in its possession, custody or control. Applicant states that some of the documents previously produced by Applicant and/or Opposer may include or make reference to the requested producible documents or things.

REQUEST FOR PRODUCTION NO. 33

Produce all versions of the PGR mission statement drafted, enacted and/or amended since the founding of the PGR organization to the present, including, without limitation, all drafts, edits, revisions, etc.

RESPONSE TO REQUEST FOR PRODUCTION NO. 33

Subject to the foregoing objections, to the best of Applicant's present knowledge, the requested producible documents or things have already been produced by the parties.

REQUEST FOR PRODUCTION NO. 34

Produce all versions of the PGR conflict of interest and/or ethics statement drafted, enacted and/or amended since the founding of the PGR organization to the present, including, without limitation, all drafts, edits, revisions, etc.

RESPONSE TO REQUEST FOR PRODUCTION NO. 34

Applicant objects to this Request for Production on the basis that it is not relevant to the issues properly pleaded in this Opposition by Opposer, namely which party has prior/superior rights in the mark at issue and whether Applicant's trademark application was fraudulently filed, and on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence.

Subject to the foregoing objections, Applicant will produce the present version of the requested producible documents or things.

REQUEST FOR PRODUCTION NO. 35

Produce all versions of PGR bylaws drafted, enacted and/or amended since the founding of the PGR organization to present, including, without limitation, all drafts, edits, revisions, etc.

RESPONSE TO REQUEST FOR PRODUCTION NO. 35

Applicant objects to this Request for Production on the basis that it is not relevant to the issues properly pleaded in this Opposition by Opposer, namely which party has prior/superior rights in the mark at issue and whether Applicant's trademark application was fraudulently filed, and on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence.

Subject to the foregoing objections, to the best of Applicant's present knowledge, the requested producible documents or things have already been produced by the parties.

REQUEST FOR PRODUCTION NO. 36

Produce all versions of all policies governing or applicable to PGR website or forum moderators and/or administrators drafted, enacted and/or amended since the founding of the PGR organization to the present, including, without limitation, any and all guidelines and non-disclosure agreements.

RESPONSE TO REQUEST FOR PRODUCTION NO. 36

Applicant objects to this Request for Production on the basis that it is not relevant to the issues properly pleaded in this Opposition by Opposer, namely which party has prior/superior rights in the mark at issue and whether Applicant's trademark application was fraudulently filed, and on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence.

Subject to the foregoing objections, to the extent Applicant has any of the requested producible documents or things in its possession, custody or control, Applicant will produce same to the best of its ability. Applicant states that some of the documents previously produced by Applicant and/or Opposer may include or make reference to the requested producible

documents or things.

REQUEST FOR PRODUCTION NO. 37

Produce all versions of all policies governing use of the website www.patriotguard.org by visitors and/or registered users of that website drafted, enacted and/or amended since the founding of the PGR organization to the present, including, without limitation, all terms of use, suspension policies, and forum guidelines.

RESPONSE TO REQUEST FOR PRODUCTION NO. 37

Applicant objects to this Request for Production on the basis that it is not relevant to the issues properly pleaded in this Opposition by Opposer, namely which party has prior/superior rights in the mark at issue and whether Applicant's trademark application was fraudulently filed, and on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence.

Subject to the foregoing objections, to the extent Applicant has any of the requested producible documents or things in its possession, custody or control, Applicant will produce same to the best of its ability. Applicant states that some of the documents previously produced by Applicant and/or Opposer may include or make reference to the requested producible documents or things.

REQUEST FOR PRODUCTION NO. 38

Provide all written communications, including electronic communications (i.e., emails) between any current or former PGR Board of Director member and Jason Wallin sent or received after the resignation of Jason Wallin from the PGR Board of Directors.

RESPONSE TO REQUEST FOR PRODUCTION NO. 38

Applicant objects to this Request for Production on the basis that it is not relevant to the issues properly pleaded in this Opposition by Opposer, namely which party has prior/superior rights in the mark at issue and whether Applicant's trademark application was fraudulently filed, and on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence.

Applicant further objects to this Request for Production as being overly burdensome as this Request is not limited in scope to any particular issues or topics and, therefore, may potentially include hundreds, if not thousands, of documents.

REQUEST FOR PRODUCTION NO. 39

Produce all documents, including, without limitation, correspondence, agreements, contracts and invoices relating to CDM.

RESPONSE TO REQUEST FOR PRODUCTION NO. 39

Applicant objects to this Request for Production on the basis that it is not relevant to the issues properly pleaded in this Opposition by Opposer, namely which party has prior/superior rights in the mark at issue and whether Applicant's trademark application was fraudulently filed, and on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 40

Produce all books of account and/or financial records kept by or on behalf of PGR from the founding of the PGR organization to the present, including, without limitation, all such materials kept by Jason Wallin.

RESPONSE TO REQUEST FOR PRODUCTION NO. 40

Applicant objects to this Request for Production on the basis that it is not relevant to the issues properly pleaded in this Opposition by Opposer, namely which party has prior/superior rights in the mark at issue and whether Applicant's trademark application was fraudulently filed, and on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 41

Produce all documents reflecting the amount of funds raised through PGR's legal defense fund.

RESPONSE TO REQUEST FOR PRODUCTION NO. 41

Applicant objects to this Request for Production on the basis that it is not relevant to the issues properly pleaded in this Opposition by Opposer, namely which party has prior/superior rights in the mark at issue and whether Applicant's trademark application was fraudulently filed, and on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 42

Produce all documents reflecting the amount of funds donated to PGR through the sale of patches displaying the letters "FJB," available for sale at www.freedomjusticebrotherhood.com.

RESPONSE TO REQUEST FOR PRODUCTION NO. 42

Applicant objects to this Request for Production on the basis that it is not relevant to the issues properly pleaded in this Opposition by Opposer, namely which party has prior/superior rights in the mark at issue and whether Applicant's trademark application was fraudulently filed, and on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence.

REQUEST FOR PRODUCTION NO. 43

Produce all contracts, bills of sale, invoices, receipts, etc. reflecting orders and/or purchases of merchandise by or on behalf of PGR and containing the slogan "Patriot Guard Riders Riding With Respect" or "Patriot Guard Riders Standing With Those Who Stood For Us."

RESPONSE TO REQUEST FOR PRODUCTION NO. 43

Applicant objects to this Request for Production on the basis that it is not relevant to the issues properly pleaded in this Opposition by Opposer, namely which party has prior/superior rights in the mark at issue and whether Applicant's trademark application was fraudulently filed, and on the basis that it is not reasonably calculated to lead to the discovery of admissible evidence.

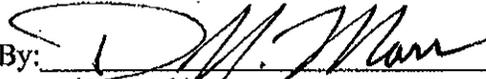
Subject to the foregoing objections, with regard to the slogan "Patriot Guard Riders Riding With Respect", Applicant states that, to the best of Applicant's present knowledge, for all requested producible documents or things from prior to November 9, 2006, that Opposer has in his possession, custody or control, the requested producible documents or things that were made by him on behalf of PGR in order to further PGR's cause.

Subject to the foregoing objections, with regard to the slogan "Patriot Guard Riders Standing With Those Who Stood For Us", Applicant states that it has no responsive documents which reflect orders and/or purchases of merchandise by or on behalf of PGR that contain the slogan "Patriot Guard Riders Standing With Those Who Stood For Us" in its possession, custody or control. Applicant notes that, along with the slogan "Patriot Guard Riders Riding With Respect", it currently uses the slogan "Patriot Guard Riders Standing For Those Who Stood For Us".

Respectfully submitted,

PATRIOT GUARD RIDERS, INC.

Date: 12/1/08

By: 
One of its attorneys

David J. Marr
James R. Foley
James A. O'Malley
Trexler, Bushnell, Giangiorgi,
Blackstone & Marr, Ltd.
105 West Adams Street, 36th Floor
Chicago, Illinois 60603
Tel: (312) 704-1890
Fax: (312) 704-8023

Attorneys for the Applicant

A67682

CERTIFICATE OF SERVICE

I certify that a copy of the foregoing **APPLICANT'S RESPONSE TO OPPOSER'S SECOND REQUESTS FOR PRODUCTION OF DOCUMENTS** has been served on the following counsel, by United States mail, on December 1, 2008.

Tom Q. Ferguson
Rachel Blue
Courtney Bru
Doerner, Saunders, Daniel & Anderson, L.L.P.
320 South Boston Avenue, Suite 500
Tulsa, Oklahoma 74103-3725
Facsimile: (918) 591-5360

Date: December 1, 2008

By: 
David J. Marr
One of Applicant's attorneys

H
2008 WL 96114 (Trademark Tr. & App. Bd.)

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

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

Western Sizzlin Corporation
v.
Hi Mountain Jerky, Inc.

OPPOSITION 91165983 TO APPLICATION SERIAL 76399174 FILED ON APRIL 23, 2002

January 3, 2008

Samuel D. Littlepage and Jeffrey S. Molinoff of Dickinson Wright PLLC for Western Sizzlin Corporation

Ramon L. Pizarro, Esq. for Hi Mountain Jerky, Inc.

Before Hohein, Zervas and Cataldo
Administrative Trademark Judges
Opinion by Zervas
Administrative Trademark Judge:

On April 23, 2002, Hi Mountain Jerky, Inc. filed an application for registration of the following mark on the Principal Register for "spices and seasonings" in International Class 30:



Applicant has claimed dates of first use anywhere and first use in commerce of April 20, 1992; has described its mark as consisting of "the words 'WESTERN SIZZLE' imbedded in a frame with a highly decorative Western motif"; and has disclaimed the term WESTERN.

Western Sizzlin Corporation has opposed registration of applicant's mark. In its amended notice of opposition, opposer pleaded ownership of the following eight registrations for various WESTERN SIZZLIN marks:

- Registration No. 1362691, issued on September 24, 1985 and twice renewed, for the mark WESTERN SIZZLIN (in typed or standard character form) for "restaurant services" in International Class 42;
- Registration No. 1360991, issued on September 17, 1985 and twice renewed, for the mark WESTERN SIZZLIN STEAK

HOUSE (in typed or standard character form) for "restaurant services" in International Class 42, with a disclaimer of STEAK HOUSE;

Registration No. 1362680, issued on September 24, 1985 and twice renewed, for the mark



for "restaurant services" in International Class 42 with a disclaimer of STEAK HOUSE; Registration No. 1126269, issued on October 23, 1979 and twice renewed for the mark



for "restaurant services" in International Class 42 with a disclaimer of STEAK HOUSE; Registration No. 1584119, issued on February 20, 1990 and once renewed for the mark



for "restaurant services" in International Class 42 with a disclaimer of STEAK & MORE and RESTAURANT; Registration No. 2621596, issued on September 17, 2002 for the mark WESTERN SIZZLIN WOOD GRILL (in typed or standard character form) for "restaurant services" in International Class 42 with a disclaimer of WOOD GRILL; Registration No. 2355500, issued on June 6, 2000 for the mark WESTERN SIZZLIN WOOD GRILL BUFFET (in typed or standard character form) for "restaurant services" with a disclaimer of WOOD GRILL BUFFET; and Registration No. 1977804, issued on June 4, 1996 and once renewed for the mark WESTERN SIZZLIN COUNTY FAIR BUFFET AND BAKERY (in typed or standard character form) for "restaurant services" in International Class 42 with a disclaimer of BUFFET AND BAKERY.

*2 Opposer alleges that applicant's mark so closely resembles opposer's WESTERN SIZZLIN marks as to be likely to cause confusion, mistake or deception in violation of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

Applicant has answered the amended notice of opposition by denying the salient allegations thereof and asserting various affirmative defenses.

The record consists of the pleadings; the file of the involved application; and, pursuant to opposer's two notices of reliance, a certified copy of each of opposer's pleaded registrations showing that the registration is subsisting and owned by opposer, an admission against interest made in applicant's response to opposer's summary judgment motion in this proceeding, a redacted copy of applicant's response to opposer's first set of interrogatories, and a redacted copy of applicant's responses to opposer's requests for admissions nos. 22 and 24 in which applicant has admitted the authenticity of copies of applicant's labels and one of applicant's advertising brochures. Additionally, opposer has submitted the testimonial deposition with exhibits of Michelle DiCarlo, a paralegal with opposer's law firm.

Applicant did not submit any trial testimony or other evidence during its testimony period.

Both parties have filed briefs.

Preliminary Matters

Applicant has objected to Ms. DiCarlo's testimony because the "USPTO's TTABVUE internet posting for this case [did] not show that the transcript of Ms. DiCarlo's deposition was filed ..." at the time applicant filed its brief on July 12, 2007. Brief at fn. 2, p. 3. In its reply, opposer maintains that it did file the deposition transcript with the Board on July 11, 2007, and opposer served applicant's copy of the deposition transcript on applicant on or about December 26, 2006. Trademark Rule 2.123(h), 37 C.F.R. § 2.123(h), the rule regarding filing depositions with the Board, does not specify a filing date for depositions. Also, applicant has not contended that it has suffered any prejudice by the filing of the transcript with the Board just prior to the filing of applicant's brief and has not contended that it has not received a copy of Ms. DiCarlo's deposition transcript prior to preparing its brief. In view thereof, applicant's objection is overruled.

Additionally, applicant contends that even if Ms. DiCarlo's testimony is part of the trial record, the exhibits she introduced are "types of Internet printouts ... specifically prohibited as being inherently unreliable unauthenticated records and inadmissible hearsay," relying on TBMP § 704.08 and Trademark Rule 2.122(e), 37 C.F.R. 2.122(e). Applicant's contention is not correct; Ms. DiCarlo was the individual who downloaded the printouts from the Internet and by her testimony has authenticated these materials. Moreover, opposer is not using them for the truth of the statements contained therein, and we have not used the printouts for this purpose. Further, the authority applicant cites to concerns notices of reliance, and opposer has not introduced the printouts pursuant to a notice of reliance. Thus, applicant's objection to the printouts is overruled.

*3 Applicant's objection to the TESS printouts from one of the U.S. Patent and Trademark Office's electronic databases introduced by Ms. DiCarlo is without merit and therefore is also overruled. Ms. DiCarlo testified that she obtained these printouts from the Office's database on a particular date. DiCarlo dep. at pp. 5 - 8.

Opposer, in its reply brief, has cited instances where applicant has made representations not supported by evidence. Opposer's objections are noted. See TBMP §801.01 (2d ed. rev. 2004), which states in relevant part that "the facts and arguments presented in the brief must be based on the evidence offered at trial"; and TBMP §704.06(b) (2d ed. rev. 2004), which sets forth in pertinent part that: "[f]actual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial."

Standing/Priority

Because opposer has properly made its pleaded registrations of record, opposer has established its standing. Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Also, because opposer's pleaded registrations are of record, priority is not an issue in this case. King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the 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). See also, In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We first consider the similarity and dissimilarity of the marks, determining whether the marks are similar in sound, appearance, meaning, and commercial impression. Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). While we must consider the marks in their entireties, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In view thereof, and because purchasers will use the literal portions of the marks to refer to applicant's and opposer's goods and services, we accord greater weight to the literal portions of applicant's mark and those of opposer's marks which have both word and design components, such as opposer's WESTERN SIZZLIN STEAK HOUSE and design mark. See Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983); In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). Additionally, the Federal Circuit, our primary reviewing court, has recognized that descriptive matter may have less significance in likelihood of confusion determinations. See Cunningham v. Laser Golf Corp., 55 USPQ2d at 1846, quoting, In re National Data Corp., 24 USPQ2d at 752 ("Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion"). See also In re Code Consultants, Inc., 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often "less significant in creating the mark's commercial impression"). Accordingly, in those of opposer's asserted marks having disclaimed terms, e.g., WOOD GRILL in Registration No. 2621596, we accord more weight to the WESTERN SIZZLIN portion of those marks, which has not been disclaimed. The descriptive wording is unlikely to be used to distinguish the marks.

*4 In applying the above principles to the marks before us, we find that (i) WESTERN SIZZLIN is the dominant term in opposer's marks containing WESTERN SIZZLIN and other wording, and dominates over the design components in opposer's WESTERN SIZZLIN and design marks, and (ii) that WESTERN SIZZLE is the dominant term in applicant's mark.

In considering the dominant terms of the marks, as well as opposer's WESTERN SIZZLIN mark per se, we find that the marks are highly similar in sound, slightly differing only by the last syllable in SIZZLIN and SIZZLE. Additionally, the marks are highly similar in meaning, with the second word in applicant's mark being the verb SIZZLE and the second word in opposer's marks being a form of the same verb.^[FN1] These minor differences between opposer's marks and applicant's mark are not likely to be recalled by purchasers seeing the marks at separate times. The recollection of the average purchaser is normally a general rather than a specific impression of the many trademarks encountered, and the purchaser's fallibility of memory over a period of time must also be kept in mind. See Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); In re Mucky Duck Mustard Co., Inc., 6 USPQ2d 1467 (TTAB 1988); Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation, 206 USPQ 255, 259 (TTAB 1980). With regards to the commercial impressions of the respective marks, they are highly similar because both applicant's and opposer's marks evoke Western cooking, and specifically the sizzling noise made by food when cooking on a grill. See brochure submitted as Exhibit E to opposer's notice of reliance, which refers to grilling; "I don't even think about starting up the grill without my Western Sizzle Seasonings. I have the complete selection, so I always have the perfect seasoning no mater what I am grilling."

Thus, with respect to applicant's mark and opposer's marks which do not have design components, i.e., the marks of Registration Nos. 1362691, 1360991, 2355500, 1977804 and 2621596, we find them to be similar. With respect to those of opposer's marks that have design components, i.e., Registration Nos. 1362680, 1126269 and 1584119, we find applicant's mark to be similar to such marks even though the design components differ, due to the similarity between the wording WESTERN SIZZLIN and WESTERN SIZZLING. Any differences in appearance of the parties' marks are outweighed by the significant similarities in the sound, meaning and commercial impressions of the marks due to the highly similar wording in the marks. Thus, we resolve the *du Pont* factor regarding the similarity of the marks in opposer's favor.

*5 We next consider the goods identified in the application and the services identified in opposer's registrations. It is well settled that the question of likelihood of confusion must be determined based on an analysis of the goods recited in an applicant's application vis-à-vis the services recited in an opposer's registration. Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992); The Chicago Corp. v. North American Chicago Corp., 20 USPQ 2d 1715

(TTAB 1991). Further, it is a general rule that goods 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 be likely to be seen by the same persons under circumstances which would give rise, because of the marks used therewith, 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 party's goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and the cases cited therein.

Opposer's evidence establishes that restaurants offer spices and seasonings under the same mark used for restaurant services. Ms. DiCarlo, in her deposition, testified that she located in an Internet search numerous websites in which restaurants offer spices and seasonings under the same mark. See, e.g.:

BIG BUBBA'S BAD BBQ	seasonings and restaurant services
RED HOT & BLUE	seasonings and restaurant services
LA MADELEINE	"chicken spice" and restaurant services
FAMOUS DAVE'S	spices and restaurant services
Ms. DiCarlo also introduced into evidence photographs of containers for spices, seasonings and sauces purchased on-line or in a supermarket. According to Ms. DiCarlo, the owner of the mark also provides restaurant services. ^[FN2] See, e.g.:	
BIG BOB GIBSON	barbecue sauce ^[FN3] and restaurant services
SHULA'S	steak sauce and restaurant services
RED HOT & BLUE	dry rub seasonings and restaurant services
BIG BUBBA'S BAD BBQ	barbecue sauce and restaurant services
MEMPHIS BARBECUE	magic dust all-purpose seasoning and restaurant services
TACO BELL TACO SAUCE	taco sauce and restaurant services ^[FN4]

*6 In addition, through Ms. DiCarlo's deposition, opposer has introduced copies of third-party registrations. Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. *In re Albert Trostel & Sons Co.*, 29

USPO2d 1783 (TTAB 1993). See, e.g.:

Registration No. 3020149 for the mark THINK OUTSIDE THE BUN for, inter alia, taco seasoning mix, taco sauce, seasoning mix, and restaurant services;

Registration No. 3016077 for the mark MAMA DP'S KITCHEN for, inter alia, barbecue sauce and restaurant services;

Registration No. 2983920 for the mark STOP AND SMELL THE BREADSTICKS for, inter alia, spices, sauces and restaurants;

Registration No. 2777983 for the mark FAT WILLY'S for, inter alia, spices, sauces and restaurant services;

Registration No. 2978028 for the mark TARA STEAK AND LOBSTER HOUSE for, inter alia, steak sauce and restaurant services;

Registration No. 2959167 for the mark MALIA for, inter alia, herb mixes, spices and restaurant services;

Registration No. 2934344 for the mark BOTEJYU and design for, inter alia, Worcestershire sauce, and restaurant services; and

Registration No. 2830511 for the mark SIOUX CITY STEAKHOUSE and design for, inter alia, steak sauce, barbecue sauce and restaurant services.

This evidence establishes that the same source may provide both goods and services and hence that prospective purchasers would be likely to regard such goods and services as being commercially related to each other. This evidence also satisfies the requirement set forth in Jacobs v. International Multifoods Corp., 668 F.2d 1234, 212 USPO 641, 642 (CCPA 1982) that "a party ... show something more than that similar or even identical marks are used for food products and for restaurant services" to establish likelihood of confusion. Hence, we conclude that opposer has established prima facie that opposer's restaurant services are related to applicant's spices and seasonings and resolve this *du Pont* factor in opposer's favor.

We now consider the similarity or dissimilarity of the parties' trade channels. Inasmuch as there are no restrictions with respect to trade channels in either the application or the pleaded registrations, we must assume that the goods and services travel in all the normal channels of trade for such goods and services. See Schieffelin & Co. v. Molson Companies Ltd., 9 USPO2d 2069 (TTAB 1989). Ms. DiCarlo has testified that she purchased certain seasonings on restaurant websites and in a retail grocery store, and that the seasonings bear the names of restaurants. DiCarlo dep. at pp. 16 - 17. We thus conclude that it is not uncommon for restaurants to also sell spices and seasonings under the same mark, at least on restaurant websites and at grocery stores and supermarkets, and thus purchasers are accustomed to viewing such goods and services as related in that they share overlapping or similar channels of trade. We therefore conclude that the trade channels of the parties' goods and services overlap and resolve the *du Pont* factor regarding the trade channels in opposer's favor.

*7 We add too that the nature of the goods and services involved here are such that they may be purchased upon impulse by members of the general public, with little or no deliberation in their purchasing decisions.

Applicant has noted at p. 8 of its brief that it knows of no instances of actual confusion. Because the record does not include information such as the volume of applicant's or opposer's sales of their respective goods and services under the marks in issue, or whether both parties are doing business in the same geographic areas, it is not apparent that the conditions were such that confusion could occur. The *du Pont* factor regarding actual confusion is therefore not applicable.

Thus, in view of the similarities between the marks, the relationship between the goods and services, and the overlapping trade channels, we conclude that applicant's mark, when used in connection with seasonings and spices, is likely to cause confusion with opposer's pleaded marks as used in connection with restaurant services.

DECISION: The opposition is sustained and registration to applicant is refused.

FN1. Applicant maintains that because "sizzle" or "sizzling" "includes the hissing sound made while frying ..., the variants of the word "sizzle" are particularly weak when used with services that involve cooking, such as restaurant services." Brief at p. 2. We disagree. The term does not merely describe a feature of restaurant services.

FN2. DiCarlo Dep. at p., 17.

FN3. We accept that a sauce such as barbeque sauce or taco sauce is a “seasoning” in view of the following definition of “seasoning” taken from *Merriam-Webster's Online Dictionary* (from bartleby.com), of which we take judicial notice; “something that serves to season, *especially*: an ingredient (as a condiment, spice, or herb) added to food primarily for the savor that it imparts.” The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002). See also *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

FN4. DiCarlo Dep. Exhibits E - K.

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

JEFF BROWN,)	
)	
Opposer,)	
)	Opposition No. 91181448
v.)	
)	Application No. 77/040,379
PATRIOT GUARD RIDERS, INC.,)	
)	
Applicant.)	

EXHIBIT 32

of

**“Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to
Applicant’s Memorandum in Support of its Motion for Summary Judgment”**



2008 WL 902838 (Trademark Tr. & App. Bd.)

Page 1

2008 WL 902838 (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.)

Ermenegildo Zegna Corporation
v.
Samson G. Bekele

OPPOSITION 91170493 TO APPLICATION SERIAL 78666031 FILED ON JULY 7, 2005

February 27, 2008

John M. Cone of Hitchcock Evert LLP for Ermenegildo Zegna Corporation

Thomas J. Tighe of Tighe & Associates for Samson G. Bekele

Before Grendel, Walsh and Wellington
Administrative Trademark Judges
Opinion by Wellington
Administrative Trademark Judge:

Applicant, Samson G. Bekele, seeks registration of the mark JEGNA (in standard character form) for goods identified as "clothing namely, belts, night caps, hats, socks, athletic uniforms, night gowns, pajamas, night shirts, swimming wear, swimming caps, sports shirts, sweaters, jumpers, rain coats, coats, jackets, men's suits, pants, shirts, boots, jerseys, vests, polo shirts, foot wear, dresses, scarves, blouses, head wear, and bandanas" in International Class 25.^[FN1]

Opposer, Ermenegildo Zegna Corporation, has opposed registration of applicant's mark on the ground that, as applied to applicant's goods, the mark so resembles opposer's previously used and registered marks ZEGNA and EREMENGILDO ZEGNA for "clothing and accessories", and in connection with retail stores, that it is likely to "cause confusion or to cause mistake or to deceive, and to thereby cause damage to opposer."^[FN2] Opposer pleaded ownership of twenty-three registrations for the marks ZEGNA and ERMENGILDO ZEGNA covering various articles of clothing and apparel accessories, as well as retail store services featuring men's clothing, footwear and accessories.

Applicant filed an answer wherein he denied the salient allegations.

Before we discuss the evidence of record, we note that both parties apparently acted in accordance with the original trial schedule set forth in the Board's April 20, 2006 institution order. However, the Board rescheduled the discovery deadline and trial dates on October 17, 2006. Specifically, opposer filed status and title copies of its registrations under a notice of reliance on February 2, 2007, a date falling within its originally-scheduled testimony period, but before its rescheduled testimony period. Likewise, applicant filed a communication with exhibits on April 3, 2007, a

date falling within his originally-scheduled testimony period, but before his rescheduled testimony period. Moreover, opposer filed a trial brief on July 17, 2007, also apparently based on the original trial schedule and in conjunction with Trademark Rule 2.128 (allowing plaintiff sixty days from the end of the rebuttal testimony period to file its trial brief). Nothing further was filed by the parties.

Because the issue of the aforementioned submissions being prematurely filed has not been raised by either party, any timeliness objections are waived. See TBMP § 707.04 (2d ed. rev. 2004) and authorities cited therein. Accordingly, we consider the submissions timely-filed.

*2 Although we consider applicant's April 3, 2007 (untitled) submission to be timely-filed, opposer's motion (contained on p. 2 of its trial brief) to strike the submission with exhibits on other grounds is granted, in part, as well-taken and conceded. Trademark Rule 2.127. In particular, we agree with opposer that the communication is not a notice of reliance and, in any event, the exhibits attached thereto (copies of printouts from various internet websites) are not self-authenticating and have not otherwise been authenticated. Trademark Rule 2.122(e); see also TBMP § 704.07 (2d ed. rev. 2004) [regarding the introduction into evidence of internet materials]. Accordingly, opposer's motion is granted to the extent that the exhibits attached to applicant's submission are stricken and the Board will not give consideration to any factual averments or arguments based on the exhibits. However, to the extent that the submission contains arguments not based on the exhibits, the Board construes the submission as a trial brief and, like opposer's trial brief, we will give consideration to the brief in spite of it being filed prematurely.

In view of the above, the only evidence of record on submission are the status and title copies of opposer's seventeen registrations, filed under opposer's notice of reliance.^[FN3] And, by rule, the record includes the pleadings and the file of the opposed application.

We focus our likelihood of confusion analysis on the following two registrations, which are in full force and effect, owned by opposer:

Registration No. 1258643, for the mark ZEGNA (in typeset form) for "Shoes, Belts, Hats, Ties, Scarves, Robes, Suits, Sports Jackets, Topcoats, Overcoats, Raincoats, Leather Coats and Jackets, Car Coats, Slacks, Vests, Knit and Woven Shirts, Formal and Sport Shirts, Bathing Suits, Short Pants, Sweaters, Socks, Quilted Jackets and Coats, Long Pants, [Long and Short Woven and Knit Underwear,] Athletic Shorts, Sleeveless and Sleeved Knit and Woven Shirts, [Boxer Shorts, Waistbands,] Gloves, Balaklava, [Jumpsuits, Skirts and Blouses]" in International Class 25, issued on November 22, 1983, renewed (for ten years) in 2004; and
Registration No. 2640485, for the mark ZEGNA (in typeset form) for "retail stores and departments in retail stores featuring men's clothing, footwear and accessories" in International Class 35, issued on October 22, 2002, claiming dates of first use anywhere and in commerce on March 1, 2001;

Because opposer has made the two registrations summarized above properly of record, opposer has established its standing to oppose registration of applicant's mark and its priority is not in issue. See King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPO 108 (CCPA 1974). We thus turn to the issue of likelihood of confusion between these two registered marks and applicant's mark.

*3 Our likelihood of confusion determination under Trademark Act Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in In re E. I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPO 563 (CCPA 1973). See also, In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPO2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPO 24 (CCPA 1976). See also, In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPO2d 1531 (Fed. Cir. 1997).

We turn first to the similarity of the parties' goods and services. Here, the parties' identifications of goods list many

of the same articles of clothing and accessories. For example, both Registration No. 1258643 and the subject application identify shirts, coats, swimwear, jackets, belts, hats, socks, athletic apparel, pants, and suits. Also, opposer's retail store services featuring men's clothing are closely related to applicant's goods inasmuch as, based on the record before us, we must assume that it is possible for applicant's clothing to be sold in opposer's stores.

Applicant argues that the parties' goods are sold to different classes of customers and through different trade channels. Brief, p. 1. However, neither opposer's nor applicant's identifications of goods are restricted as to their trade channels or classes of purchasers. And, we must make our findings based on the goods as they are recited in the application and registrations, respectively. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992); *In re Elbaum*, 211 USPQ 639 (TTAB 1981). We must presume that the parties' goods are marketed in all of the normal trade channels for such goods, and that the goods are bought by the usual classes of purchasers. Accordingly, given that the parties' goods are, in part, identical and without restrictions, it is presumed that they move in the same trade channels to the same classes of purchasers.

In view of the nature of the parties' goods, i.e., fairly basic articles of clothing, the purchasers of the goods would include ordinary consumers, who would be expected to exercise the ordinary amount of care in their purchasing decisions. Further, several of the goods, which are common to both parties' identifications, are relatively inexpensive, e.g., belts, socks, and are capable of being purchased on impulse.

*4 The du Pont factors of the similarity of the goods and trade channels, as well as the conditions under which and buyers to whom sales are made, weigh in favor of a finding of likelihood of confusion.

We now turn our attention to the parties' marks. In considering the marks, we initially note that when they are used in connection with identical goods and/or services, as they are here, "the degree of similarity [between the marks] necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Under this du Pont factor, we look to the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their overall commercial impressions that confusion as to the source of the goods/ services offered under the respective marks is likely to result. The focus is on the perception and recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. See *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

We find the marks at issue, ZEGNA and JEGNA, to be nearly identical in appearance -- the obvious, single difference being the first letter of the marks. There is also no evidence in the record as to whether there is a proper pronunciation for either mark. Thus, when a consumer encounters the marks, after pronouncing the first letter, the rest of the mark will sound the same depending on how the consumer chooses to pronounce "-EGNA." Consequently, the marks are not only visually very similar, but will also sound alike.

As to any connotations created by the respective marks, applicant argues that its mark is the transliteration of an Amharic (a language spoken in Ethiopia) word and "there is no limit on how many ways JEGNA can be translated. Warrior, teacher, influencer are just a few...." Brief, p. 4. However, there is no evidence in the record for us to draw the same conclusion. Likewise, there is no evidence that opposer's ZEGNA mark has any particular meaning. The Board has verified that neither term has a defined meaning in English.^[FN4]

In view of the above, and with emphasis on the fact that the only distinguishing features of the marks are their initial letters, we conclude that the marks are highly similar in their appearance and sound. And there is nothing in the re-

cord for us to conclude that either mark creates a commercial impression or connotes a meaning to help distinguish them. Accordingly, as to similarity of the marks, this du Pont factor strongly favors opposer.

*5 In sum, the marks are very similar, there is no evidence establishing that opposer's mark is weak or for any reason entitled to a narrow scope of protection, the involved goods are in part the same and otherwise closely related, and the goods must be presumed to be marketed to the same classes of end consumers. On the record, we find that confusion among consumers is likely.

Decision: The opposition is sustained.

FN1. Serial No. 78666031, filed July 7, 2005, alleging a bona fide intention to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. §1051(b). The application contains a statement that the mark translates into English as hero, warrior or soldier.

FN2. Opposer pleaded two other grounds for opposition, i.e., dilution and that applicant did not have a bona fide intent to use its mark in commerce at the time of filing of the application. However, in opposer's brief, it states that it is only pursuing the likelihood of confusion ground. Brief, p. 1. Accordingly, opposer has waived any pleaded claims other than likelihood of confusion.

FN3. As noted, opposer pleaded ownership of twenty-three registrations. Of the seventeen registrations for which opposer filed status and title copies, twelve were pleaded by opposer, i.e., opposer did not plead ownership for five of the registrations for which it submitted status and title copies. As explained in this decision, we have focused our likelihood of confusion analysis with respect to two of opposer's registrations, namely, Registrations Nos. 2640485 and 1258643. Opposer pleaded these two registrations and provided status and title copies therefor.

FN4. The Board may take judicial notice of dictionary definitions. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). In searching for definitions of "Jegna" and "Zegna", the Board referenced The Merriam-Webster Online Dictionary which is based on the print version of *Merriam-Webster's Collegiate® Dictionary, Eleventh Edition*.

2008 WL 902838 (Trademark Tr. & App. Bd.)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

JEFF BROWN,)	
)	
Opposer,)	
)	Opposition No. 91181448
v.)	
)	Application No. 77/040,379
PATRIOT GUARD RIDERS, INC.,)	
)	
Applicant.)	

EXHIBIT 33

of

**“Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to
Applicant’s Memorandum in Support of its Motion for Summary Judgment”**



2008 WL 902837 (Trademark Tr. & App. Bd.)

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

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

Meier's Wine Cellars, Inc.
v.
Meyer Intellectual Properties Limited

CANCELLATION 92044883

March 4, 2008

Before Hairston, Kuhlke and Bergsman
Administrative Trademark Judges

By the Board:

Meier's Wine Cellars, Inc. ("petitioner") seeks to cancel the registration of Meyer Intellectual Properties Limited ("respondent") for the mark MEYER VINEYARD for "wine."^[FN1] As grounds for cancellation, petitioner claims ownership and priority of use of the mark MEIER'S and likelihood of confusion. In support of its claims, petitioner alleges common law use of the mark MEIER'S in connection with sparkling fruit juices and wines since as early as 1895 and 1935, respectively; that registration of its mark for use with certain goods in International Classes 32 and 33^[FN2] has been refused by the Trademark Examining Operation under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion with respondent's mark; and that continued existence of respondent's registration will be a source of damage and injury to petitioner in that it will be unable to obtain a registration for its mark.

Respondent, in its amended answer, has denied the essential allegations of the amended petition to cancel.^[FN3]

This case now comes up on petitioner's fully briefed motion (filed May 9, 2006) for summary judgment in its favor on its claims of priority and likelihood of confusion.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. *See Fed. R. Civ. P. 56(c)*. The purpose of summary judgment is one of judicial economy, that is, to save the time and expense of a useless trial where no genuine issue of material fact remains and more evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result. *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741, 743 (Fed. Cir. 1984).

A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. *Fed. R. Civ. P. 56(c)*; and *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986). Additionally, the evidence must be viewed in a light favorable to the non-movant,

and all justifiable inferences are to be drawn in the non-movant's favor. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993).

*2 Petitioner first argues that there is no genuine issue of fact as to whether it used the MEIER'S mark "previously" in the United States. In support of its claim of priority, petitioner has introduced the declaration of its chairman, Robert A. Manchick, who avers that petitioner "has used the MEIER'S mark continuously on wine and juice for more than 100 years and continues to use the mark on wine and juice to the present day."^[FN4] Mr. Manchick states further that labels such as those currently in use have been used since "well prior to 2002," which is the date of first use claimed by respondent.^[FN5] Specifically, attached to the Manchick declaration is an exhibit containing photocopies of representative wine labels used on the date on which the motion for summary judgment was filed (Manchick declaration, Exhibit A); and numerous other exhibits showing wine labels bearing the mark MEIER'S and the approvals of those wine labels by the relevant Federal agency between 1945 and 2003 (Manchick declaration, Exhibits B through O).^[FN6] Also attached to said declaration are exhibits comprising printouts of various advertising materials dating from the 1960's through 1992 for MEIER'S wines, some of which show pictures of labeled wine bottles bearing the mark MEIER'S (Manchick declaration, Exhibits P, Q, R, and S). Further, Mr. Manchick also attests that petitioner's website has been used for promoting wines sold under the mark MEIER'S since the late 1990s and that it is still used for that purpose, and has submitted undated printouts from petitioner's website, which show information on various wines sold in connection with the MEIER'S mark (Manchick declaration, Exhibit T). To further support its use of the MEIER'S mark on its website, petitioner has also provided, by way of the declaration of Diane M. Jacquinet (an employee of petitioner's counsel), a printout dated April 6, 2006 from petitioner's website (attached as Exhibit JA thereto).

Petitioner also contends "there is no genuine issue of fact that ... [t]here is a likelihood of confusion between the MEIER'S mark and the MEYER VINEYARD trademarks [*sic*]." In particular, petitioner argues that the parties' goods are identical and move in the same trade channels to the same classes of purchasers; the degree of similarity required to find likelihood of confusion between the marks is less than in situations where the goods are dissimilar and non-competing; and, therefore, the Board should enter judgment in its favor because the marks are "strikingly similar with respect to appearance and sound." Petitioner also argues, in essence, that the term "vineyard" in respondent's mark does not distinguish the marks because the term merely describes the source of the grapes from which the wines are made. For evidentiary support that the trade channels of the parties' goods are identical, petitioner has provided printouts from the Internet, which show that both MEIER'S wines and MEYER VINEYARD wines can be viewed and/or purchased on-line (Jacquinet declaration, Exhibits JA and JB).

*3 Petitioner also argues that other factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) weigh in its favor for finding likelihood of confusion as a matter of law. Specifically, petitioner contends that in recent years wine purchasers have become less careful and considered, and might easily mistake petitioner's goods sold in connection with the mark MEIER'S for a MEYER VINEYARD brand of wine (Jacquinet declaration, Exhibits JC and JD). Additionally, petitioner argues that its trademark should be considered to be famous, based on its many years of use and "prominent advertising in publications" such as *The Wine Spectator*, *Gourmet* and *Vegetarian Times* magazines (Manchick declaration, Exhibits V, S, and AF).

In opposition to the motion, respondent contends that petitioner does not have priority over the MEYER VINEYARD mark because petitioner has never used the mark MEYER VINEYARD (respondent's mark), nor claimed any ownership of it.^[FN7] This argument is not persuasive. The issue of priority is not determined by whether petitioner has ever used respondent's mark; rather, the issue is whether petitioner acquired rights in its mark prior to the date on which respondent acquired rights in its own mark. Further, because both MEIER'S and MEYER are surnames, the determination of priority must be based not on when each party first used its respective term, but when it acquired trademark rights in the term. See *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1136 (TTAB 1992) (because neither party's mark is inherently distinctive, the issue of priority turns on the priority of acquisition of acquired distinctiveness). As noted previously, respondent's mark MEYER VINEYARD is registered on the Supplemental Register (with "vineyard" disclaimed), an acknowledgement that MEYER VINEYARD is not

inherently distinctive and also an acknowledgement that the mark had not acquired distinctiveness as of the filing date of the underlying application.^[FN8] Because petitioner is relying on its common law rights, we must first determine whether there is a genuine issue as to whether petitioner acquired rights in MEIER'S *as a trademark* prior to respondent's acquiring trademark rights in MEYER VINEYARD. See *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). We find that petitioner has established, through the Manchick declaration and evidence attached thereto, use of the MEIER'S mark in connection with wines from at least 1945 to present. Petitioner has also established that it has advertised its mark since at least 1992. In view of this long use and advertising, we find that petitioner has established that it acquired trademark rights in the mark MEIER'S prior to 2002. See TMEP 1212.05(a) (for most surnames, a statement of five years use is sufficient to establish acquired distinctiveness). Respondent has not submitted any evidence of its use, and therefore, even if we treat the September 30, 2002 filing date of respondent's underlying application as evidencing respondent's acquisition of trademark rights, there is no genuine issue that petitioner has made earlier trademark use. As a matter of law, petitioner has established priority.

*4 As to whether there is a material issue of fact regarding petitioner's claim of likelihood of confusion, respondent primarily argues that the mark actually used by petitioner on its labels is MEIER'S WINE CELLARS. Based on that assertion, respondent contends that when comparing MEYER VINEYARD with MEIER'S WINE CELLARS, the marks are not confusingly similar because they sound different and evoke different commercial impressions. Consequently, because the marks are allegedly significantly different, respondent contends that petitioner's famous mark argument is "negated." Additionally, respondent argues that it adopted its mark in good faith and, in support thereof, has provided the declaration of Dean Krause, Vice President and General Counsel for respondent, who attests that the MEYER VINEYARD mark was derived from the name of a corporate affiliate, which has used the name MEYER for housewares since the 1950's. Respondent also relies heavily on a shopping mall intercept survey and expert opinion thereon to argue that there is no likelihood confusion between the parties' marks.

Respondent also argues that it is an admission against interest and disingenuous for petitioner to now argue that there exists a likelihood of confusion when it argued before the Examining Attorney that there is no likelihood of confusion with respondent's registration that, as noted previously, had been cited against petitioner's application.

Respondent's Survey

In connection with whether there exists a material fact in issue as to petitioner's claim of likelihood of confusion, we first address the probative value of respondent's shopping mall intercept survey. For the reasons set forth below, we consider the survey, which allegedly shows that there is no likelihood of confusion between the two marks, to be so seriously flawed that it fails to raise a genuine issue with respect to the likelihood of confusion between the parties' marks.

The survey was conducted in four geographically disparate cities by independent marketing research firms under the direction of Craig M. Joseph, PhD, a director at FTI Consulting, Inc., a forensic and litigation consulting and research firm. The survey questions and Dr. Joseph's expert report (and exhibits thereto) regarding the survey results were introduced by way of the declaration of Dr. Joseph.

We will not burden this opinion with an exhaustive discussion of all the flaws we have found in the methodology of the survey, but will limit our discussion to a few examples. First, there is a problem with the stimulus, in that the survey respondents were shown respondent's entire wine bottle, including the full label, rather than just the mark. The Board has held that surveys, such as respondent's, which embellish the stimulus with features that are not directly involved in the determination of likelihood of confusion, have limited probative value. See, e.g., *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125, 1132 n.19 (TTAB 1995); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1334 (TTAB 1992); and *Miles Laboratories, Inc. v. Naturally Vitamin Supplements, Inc.*, 1 USPQ2d 1445, 1459 (TTAB 1986) ("a labeled ... multivitamin tablets jar would have introduced irrelevant matter, thereby destroying any probative value of the survey for our purposes").

*5 The interviewees were instructed to look at the “bottle” and were then shown a bottle of respondent's wine bearing the information “Meyer Vineyard 2003 Napa Valley Cabernet Sauvignon” on the label (Expert Report, page 7; Exhibit 2 to Joseph declaration). After the bottle was removed from view, the survey respondents were informed that the interviewer would ask questions “*about the bottle* you just looked at.” (Consumer Survey, page 2; Exhibit 3 to Joseph declaration; emphasis added) As a result, the majority of the survey respondents focused on features of the bottle apart from the mark, *i.e.* the trade dress comprising the color and shape of the bottle and label, and other data on the bottle such as the geographic origin of the product (*i.e.* Napa Valley). For instance, in response to the question, “First, can you describe what you saw,” 68.2 percent of the survey respondents mentioned the black or dark color of the bottle, 39.1 percent referred to the gold lettering or writing on the bottle label, and 5 percent remarked that the bottle was “heavy.”

Another obvious flaw in the survey is the fact that the label presented to the interviewees included the wording “Napa Valley.” Because the bottle label referred to the geographic region “Napa Valley,” and because petitioner's wine is made in Ohio, survey respondents may have ruled out petitioner as the source of the wine.^[FN9] Additionally, in response to the question, “who do you think puts out the wine you just saw,” fewer than half of the survey respondents, *i.e.* 48.2 percent stated “MEYER”; 30% percent answered “don't know”; and 11.8% answered “Napa Valley.” Thus, over half of the survey respondents may not have even noticed respondent's trademark.

The survey also failed to account for the highly similar spelling of the parties' marks. Specifically, even though the survey respondents were asked to spell all proper names in their answers, the survey did not include a control question to distinguish whether the survey respondents remembered the correct spelling of petitioner's mark and, therefore, whether they believed that the mark on the label was in fact petitioner's mark. Thus, even when spelling the answer “MEYER”, a survey respondent could have been referring to petitioner.

As a result of the lack of a control feature and of “probing questions,” we cannot ascertain from the survey responses whether the interviewees saw respondent's mark as being separate from petitioner or, instead, as being petitioner's mark. For example, the survey did not include probing questions such as, “What makes you think so?” *See, e.g., Starbucks U.S. Brands LLC and Starbucks Corporation d.b.a. Starbucks Coffee Company v. Marshall S. Ruben*, 78 USPQ2d 1741 (TTAB 2006); and *Union Carbide Corporation v. Ever-Ready Inc.*, 531 F.2d 366, 188 USPQ 623, 641 (7th Cir. 1976), *cert. denied*, 429 U.S. 830, 191 USPQ 416 (1976). Such questions could have shed light on why the survey respondents answered as they did. In *Ava Enterprises, Inc. v. Audio Boss USA, Inc.*, 77 USPQ2d 1783 (TTAB 2006), the survey included a question related to whether the separately viewed marks came from the same or different companies. After responding to that question, survey respondents were asked, “Why do you feel that way?” The majority of reasons given for confusion related to the similarity in the appearance of the parties' marks. *Audio Boss*, 77 USPQ2d at 1787. Here, in contrast, there exists no such clarifying information.

*6 In view of the numerous flaws in the design of the survey, we find the survey to be without probative value for purposes of determining likelihood of confusion between the parties' marks. Accordingly, the survey does not raise a genuine issue of fact that would preclude entering summary judgment.

Considering the evidentiary factors set forth in *du Pont supra*, we find that there are no genuine issues of material fact relating to the issue of likelihood of confusion. First, there is no genuine issue that petitioner uses the mark on wine. Because respondent's identification of goods is for wine, the goods are legally identical. *See In re Elbaum*, 211 USPO 639, 640 (TTAB 1981). In view thereof, there is no genuine issue that they travel in the same channels of trade and would be sold to the same classes of consumers. *Id.*

We now consider whether there is a genuine issue of material fact as to the similarity or dissimilarity of the parties' marks in their entireties as to appearance, sound, connotation and commercial impression. In comparing the marks, we are mindful that the test is not whether the marks can be distinguished when subjected to a side-by-side compari-

son, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See Dassler KG v. Roller Derby Skate Corporation, 206 USPO 255 (TTAB 1980); and Sealed Air Corp. v. Scott Paper Co., 190 USPO 106 (TTAB 1975).

Petitioner's mark, MEIER'S, and the dominant portion of respondent's mark, MEYER, are virtually phonetically identical and, because of their similar spelling, are very similar in appearance. See, e.g., Kabushiki Kaisha Hattori Tokeiten v. Scuto, 228 USPO 461 (TTAB 1985) (SEYCOS and design for watches held likely to be confused with SEIKO for watches and clocks); and In re Mack, 197 USPO 755, 757-758 (TTAB 1977). The marks comprise highly similar surnames and thus evoke highly similar connotations and commercial impressions. Further, the additional element "VINEYARD" in respondent's mark does not serve to distinguish the marks; the term, which respondent has disclaimed, merely indicates the location from which wine comes and, based on respondent's disclaimer, is generic for the goods. See footnote 8. Descriptive terms are properly accorded less weight in the likelihood of confusion analysis; generic terms have no source-identifying significance. See In re National Data Corp., 753 F.2d 1056, 224 USPO 749, 751 (Fed. Cir. 1985).

*7 Accordingly, although there are minor differences in the marks, these differences are not sufficient to raise a genuine issue about the similarity of the marks.

Respondent has also argued that petitioner's mark should be treated as "MEIER'S WINE CELLARS" as opposed to MEIER'S *per se*. We disagree. The majority of petitioner's wine labels in evidence show MEIER'S either to be the only mark on those wine labels or to convey a commercial impression separate from "Wine Cellars." Further, the labels that show "MEIER'S" and the wording "Wine Cellars" are frequently used in conjunction with a smaller second label that shows the MEIER'S mark alone. In any event, even if we were to treat petitioner's mark as "MEIER'S WINE CELLARS," "wine cellars" is highly descriptive of wine, and therefore is entitled to less weight in the likelihood of confusion analysis.^[FN10] See In re National Data Corp., *supra*. When MEIER'S WINE CELLARS and MEYER VINEYARD are compared in their entireties, the words WINE CELLARS do not serve to distinguish the marks. For the same reasons we have discussed in our analysis of MEIER'S and MEYER VINEYARD, we find that there is no genuine issue that MEIER'S WINE CELLARS and MEYER VINEYARD are very similar.

We find that there is no genuine issue that the goods, the channels of trade and classes of customers are legally identical, and that the consumers would include ordinary purchasers who might purchase wine on impulse and without great care. In re Bercut-Vandervoort & Co., 229 USPO 763, 765 (TTAB 1986) (average ordinary wine consumer must be looked at in considering source confusion).

We also find that there is no genuine issue that the marks are very similar. Based on these findings, we conclude that petitioner has demonstrated, as a matter of law, that it is entitled to summary judgment on the issue of likelihood of confusion.

In reaching this conclusion, we have not treated petitioner's mark as famous, and therefore the evidence on this factor does not raise a genuine issue of material fact. See Kellogg Co. v. Pack'em Enterprises Inc., 951 F.2d 330, 21 USPO2d 1142 (Fed. Cir. 1991).

Respondent has asserted that it adopted its mark in good faith. We have accepted this assertion in reaching our conclusion, and therefore it does not raise a genuine issue of fact. However, because it is not necessary for a petitioner to show bad faith adoption in order to demonstrate likelihood of confusion, respondent's assertion of its good faith does not preclude our granting summary judgment in petitioner's favor.

Finally, respondent has pointed to statements made by petitioner to the effect that there is no likelihood of confusion

between its mark and the respondent's. These statements were made during the prosecution of petitioner's application, as part of its efforts to overcome the refusal of registration based on respondent's registration. Respondent claims that these statements are admissions against interest. They are not. Statements made by an applicant in the context of prosecution may be viewed as "illuminative of shade and tone in the total picture confronting the decision maker." *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 154 (CCPA 1978). Here, the statements by petitioner are in the nature of inconsistent pleadings, with petitioner trying to avoid the need for a cancellation action if it could overcome the Examining Attorney's refusal of registration. They do not raise a genuine of fact.

*8 In sum, there is no issue of fact as to petitioner's claims of priority and likelihood of confusion. Petitioner is entitled to judgment as a matter of law.

Accordingly, judgment is hereby entered against respondent, the petition to cancel is **GRANTED**, and Registration No. 2799507 will be cancelled in due course.

FN1. Registration No. 2799507 issued on December 23, 2003 on the Supplemental Register, with the term "vineyard" disclaimed.

FN2. Application Serial No. 76465378, filed November 7, 2002.

FN3. Respondent has also asserted six affirmative defenses, which, apart from a bald assertion of laches, are essentially amplifications of respondent's denials of the allegations in the petition to cancel. Respondent has not made any reference to laches in its response to petitioner's motion for summary judgment.

FN4. We note that the first amended petition to cancel alleges use of MEIER'S as a trademark for wines "since at least as early as 1935"; and we further note that petitioner asserts "1934" as its date of first use anywhere and in commerce in its pending application Serial No. 76465378.

FN5. The date of first use anywhere and in commerce set forth in the subject registration is August 1, 2002. In its answers to petitioner's first set of interrogatories, respondent states, "the earliest date for the mark MEYER VINEYARD on wine was November 2002."

FN6. Exhibits B through O show approved wine labels by either the Department of the Treasury - Alcohol and Tobacco Tax and Trade Bureau, the Department of the Treasury - Bureau of Alcohol, Tobacco and Firearms, or the U.S. Treasury Department - Internal Revenue Service.

FN7. We note, however, that respondent conceded petitioner's prior use in commerce of its trade name, MEIER'S, in ¶2 of respondent's motion (filed June 9, 2006) under Fed. R. Civ. P. 56(f).

FN8. At the time applicant amended its application to the Supplemental Register (by Examiner's Amendment), applicant also disclaimed the word "vineyard." Because the registration is on the Supplemental Register, the word "vineyard" would have been considered generic. Respondent's disclaimer of "vineyard" is a concession that it is a generic term when used in connection with wine. See *In re Volvo White Truck Corp.* 16 USPQ2d 1417, 1420 (1990).

FN9. We note that many of petitioner's wine labels of record state that the wine is made in Ohio. Further, in response to the survey questions addressing association confusion, one survey respondent stated, "thought it might be confused with another company that is Ohio based but spell [sic] it [Meijer's]" (Expert Report, page 15; Exhibit 2 to Joseph declaration).

FN10. We take judicial notice of the wording “wine cellar,” namely, “a stock of wines” from Merriam-Webster's Online Dictionary, at www.merriam-webster.com, © 2007-2008 Merriam-Webster, Incorporated. See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPO 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPO 505 (Fed. Cir. 1983).

2008 WL 902837 (Trademark Tr. & App. Bd.)
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EXHIBIT 34

of

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Applicant’s Memorandum in Support of its Motion for Summary Judgment”**



2008 WL 2515096 (Bd.Pat.App. & Interf.)

Page 1

2008 WL 2515096 (Bd.Pat.App. & Interf.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

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

In re Dan-Foam APS

Serial No. 78723624

June 13, 2008

Ariana G. Voigt of Michael Best & Friedrich for Dan-Foam APS

D. Beryl Gardner, Trademark Examining Attorney
Law Office 112

Angela Wilson, Managing Attorney

Before Walters, Drost and Mermelstein
Administrative Trademark Judges
Opinion by Walters
Administrative Trademark Judge:

Dan-Foam APS has filed an application to register on the Principal Register the standard character mark THE DELUXEBED BY TEMPUR-PEDIC for "Lmattresses,"R in International Class 20.^[FN1]

The examining attorney has issued a final refusal to register, under Section 6 of the Trademark Act, 15 U.S.C. §1056, on the ground that applicant's mark contains the merely descriptive term DELUXEBED which must be disclaimed apart from the mark as a whole.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

The examining attorney contends that the term DELUXEBED consists of the laudatory term DELUXE and the merely descriptive term BED; that the merger of the two terms into a single word adds no incongruity or other meaning; and that DELUXEBED merely describes the quality and purpose of the identified goods, mattresses.^[FN2]

Applicant contends that the examining attorney has not met the burden of establishing that DELUXEBED is merely descriptive in connection with mattresses; that its mark is a unitary mark with "La unified commercial impression that is suggestive, though the separate parts may be descriptive"R (response of February 20, 2007); that DELUXEBED is at most suggestive and any doubt should be resolved in applicant's favor; and that its co-pending application for the mark THE DELUXE BY TEMPUR-PEDIC^[FN3] was published without a disclaimer of DELUXE

and, thus, the mark herein should also be approved without a disclaimer.

Both applicant and the examining attorney submitted numerous third-party registrations for marks including the term DELUXE for a wide variety of goods unrelated to mattresses. Those submitted by applicant do not have disclaimers of DELUXE; those submitted by the examining attorney have disclaimers of DELUXE or the marks are registered with a showing of acquired distinctiveness or on the Supplemental Register. Of all the third-party registrations submitted, only two are for mattresses or beds. The third-party registration containing a disclaimer of DELUXE (Registration No. 2700921) is for the mark SELECTAIR DELUXE for "Ltherapeutic bed systems comprised of mattresses, pumps, and controls therefore."R The third-party registration without a disclaimer of DELUXE (Registration No. 2349616) is for the mark REPLAMATTDELUXE for "Lmattresses for medical purposes."R^[FN4]

*2 The examining attorney submitted excerpts from twelve third-party Internet websites,^[FN5] of which the following are several examples:

- www.isoform.com indicates that Isoform provides a Deluxe Bed made of thick foam.
- www.electricbeds.info advertises "LGolden Tech Deluxe Beds,"R noting that the 3000 Series is the standard bed and the 5000 Series is the deluxe bed.
- <http://adroncanton.craigslist.org> is a posting from Craigslist by an individual who is offering for sale his King Size Deluxe Bed and attaches to the posting the label for a Serta® Perfect Sleeper.
- www.americanmedicalwholesale.com indicates that, as an alternative to the standard mattress, consumers can order an adjustable bed with a Full, Queen or King size Deluxe mattress.
- www.healthback.com includes the statement "LThe Tempur- Pedic® Deluxe mattress has all of the attributes of the original Tempur-Pedic® mattress but it is thicker and more luxurious.... The Deluxe Tempur-Pedic® mattress retains ... the luxurious look and feel of a plush mattress."R^[FN6]
- www.blbeds.co.uk indicates that Sealy® provides a Deluxe mattress that is made for any type of bedstead or fashion bed and includes a mattress with a luxury damask cover.

Additionally, we take judicial notice of the definitions from *Merriam-Webster's Online Dictionary* (which is the online version of a print dictionary), submitted with the examining attorney's brief, of "Ldeluxe"R as "Lnotably luxurious, elegant, or expensive"R; of "Lbed"R as "La piece of furniture on or in which to lie and sleep,"R "La place for sleeping,"R and "La mattress filled with soft material"R; and of "Lmattress"R as "La fabric case filled with resilient material (as cotton, hair, feathers, foam rubber, or an arrangement of coiled springs) used either alone as a bed or on a bedstead."R

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Further, it is well established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. *In re Recovery*, 196 USPQ 830 (TTAB 1977).

*3 The evidence clearly establishes that "Ldeluxe"R is a word used regularly in connection with beds and mattresses to indicate a level of quality and comfort beyond that of a "Lstandard"R bed or mattress; and that the terms "Lbed"R and "Lmattress"R are somewhat interchangeable as a bed may consist of only a mattress or both a mattress and a bedstead. Thus, the individual words, "Ldeluxe"R and "Lbed,"R are each merely descriptive in connection with mattresses. Furthermore, the phrase "Ldeluxe bed"R is equally merely descriptive in connection with mattresses because its connotation of a high quality and/or luxurious bed/mattress. The elimination of the space between the two words DELUXE and BED to create a single term does not change the connotation of the individual words and

the resulting term has the same connotation as the individual words together.

When applied to applicant's goods, the term DELUXEBED immediately describes, without conjecture or speculation, a significant feature or function of applicant's goods, namely, that its mattresses are of superior quality and comfort. Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for purchasers of and prospective customers for applicant's services to readily perceive the merely descriptive significance of the term DELUXEBED as it pertains to applicant's goods.

Therefore, we conclude that the examining attorney correctly required a disclaimer of the merely descriptive term DELUXEBED. We do not find applicant's arguments to the contrary to be persuasive. In particular, we are not bound by the decision of the examining attorney in applicant's co pending application for the mark THE DELUXE BY TEMPUR-PEDIC, nor is that application before us herein. See *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001); *In re First Draft Inc.*, 76 USPQ2d 1183 (TTAB 2005); and *In re Sunmarks Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994).

Decision: The refusal under Section 6 of the Act is affirmed.

This affirmance of the Section 6 refusal will be set aside and the mark forwarded for publication for opposition if applicant, no later than thirty days from the mailing date of this decision, submits an appropriate disclaimer of DELUXEBED. See, 15 U.S.C. §1056 and Trademark Rule 2.142(g), 37 C.F.R. 2.142(g).

FN1. Serial No. 78723624, filed September 29, 2005, based on an allegation of a bona fide intention to use the mark in commerce.

FN2. The examining attorney characterizes applicant's argument that DELUXEBED is not merely descriptive as "Lmoot,"R stating that because the examining attorney has the discretion to require a disclaimer, the examining attorney does not have the burden of establishing that the term to be disclaimed is merely descriptive. This convoluted argument is incorrect. Indeed, in order to justify the disclaimer requirement, the examining attorney *does* have the burden of establishing that DELUXEBED is merely descriptive in connection with the identified goods and that the mark as a whole is not unitary such that a disclaimer would be inappropriate.

FN3. Serial no. 78723625 was filed on September 9, 2005 and published for opposition on January 23, 2007. It is currently awaiting the filing of a statement of use.

FN4. Applicant also submitted numerous third-party registrations for marks including the term LUXURY, arguing that LUXURY is essentially synonymous with DELUXE and that these registrations do not contain disclaimers of LUXURY. We do not find this evidence regarding an entirely different word to be probative.

FN5. Applicant objects to the probative value of the websites from the United Kingdom and Australia. The examining attorney submitted excerpts from twelve websites, of which seven clearly originate in the United States. The foreign websites are in English and, while U.S. consumers are unlikely to purchase beds or mattresses from these foreign sites, they are likely to view these sites as part of any Internet search for mattresses or beds. Therefore, we have considered these websites to be probative in this case as they support the connotation of the term DELUXE as it appears on the U.S. websites. See *In re King Koil Licensing Co., Inc.*, 79 USPQ2d 1048, 1050 (TTAB 2006), wherein the Board stated that general consumers in the United States "L... may visit foreign web sites for information purposes, even if they are more likely to focus on internet retailers that can easily ship items or make items available for pick up in a store in a location convenient to the purchaser"

FN6. Applicant notes that this is a third-party website.

2008 WL 2515096 (Bd.Pat.App. & Interf.)
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2008 WL 2619535 (Trademark Tr. & App. Bd.)

THIS OPTION IS NOT A PRECEDENT OF THE TTAB

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

In re CompressorWorks, Inc.

Serial No. 78855392

June 20, 2008

Linda M. Novak and J. Kevin Gray of Fish & Richardson P.C. for CompressorWorks, Inc.

Tarah Hardy Ludlow, Trademark Examining Attorney
Law Office 110
(Chris A.F. Pedersen, Managing Attorney)

Before Bucher, Kuhlke and Taylor
Administrative Trademark Judges
Opinion by Taylor
Administrative Trademark Judge:

CompressorWorks, Inc. has filed an application to register on the Principal Register the mark COOLFLO (in standard character format) for “land vehicle parts, namely, fan clutches” in International Class 12.^[FN1]

Registration has been refused on the ground that applicant's mark is confusingly similar to the registered mark KOOL FLOW (in typed form) for “automotive parts, namely air filters for land vehicles” in International Class 7^[FN2] under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

When the refusal was made final, applicant appealed.^[FN3] Both applicant and the examining attorney filed briefs. For the reasons discussed below, we affirm the refusal to register.

As a preliminary matter, the examining attorney, citing in part to 37 C.F.R. § 2.142(d), has objected to Exhibits A-I^[FN4] attached to applicant's appeal brief, arguing that the exhibits include new evidence. 37 C.F.R. § 2.142(d) provides, in part, that “[t]he record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed.” Accordingly, Exhibits A-I have not been considered in our decision herein, except to the extent that the submissions were submitted previously during the prosecution of the application.^[FN5]

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence that are relevant to the factors set forth in In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir.

2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

*2 We consider first the goods based on a comparison of the identifications in the application and the cited registration. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1690 at n. 4 (Fed. Cir. 1993). As a general rule the goods 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 be likely to be seen by the same persons under circumstances which would give rise, because of the marks used therewith, 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 (TTAB 1991), and the cases cited therein.

Applicant's goods are "land vehicle parts, namely, fan clutches" and the goods in the cited registration are "automotive parts, namely air filters for land vehicles." Although applicant acknowledges that both its goods and registrant's goods are automotive engine parts, applicant argues that the goods are different because they "belong in different places in an automotive engine, operate in completely different ways, and serve different purposes." (Brief at 7).

Applicant also contends that there does not appear to be an "appreciable commonality" of purchasers and channels of trade. Specifically, applicant argues that while both its goods and registrant's goods will be sold to and in auto parts stores, its goods will be "behind the counter" products not available for pick-up and purchase on the sales floor whereas registrant's goods are sold in the main shopping floor of retail stores.

The examining attorney conversely maintains that although the goods are not identical, they are related and are likely to be encountered by the same group of consumers, being products that are sold along side one another. To support her position, the examining attorney made of record with her final office action copies of third-party registrations to show that applicant's type of fan clutches and registrant's type of air filters are parts for automobiles commonly sold under the same mark. These third-party registrations may serve to suggest that the types of goods involved herein are related goods. See In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1470 n.6 (TTAB 1988) (Although third-party registrations are "not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, [they] may nonetheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source"). See also In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993).

*3 These registrations include:^[FN6]

Registration No. 2929913 for, *inter alia*, "components of automotive air conditioning systems, namely ... fan clutches" and "air filters";

Registration No. 2986790 for, *inter alia*, "replacement parts for automotive air conditioners, namely, ... air filters" and "replacement parts for automotive air conditioners, namely, ... clutches"; and

Registration No. 3015016 for, *inter alia*, "automotive parts, namely, ... air filters" and "air conditioner parts for automobiles, namely, ... fan clutches."

Based on the identifications of record, which contain no limitations as to product placement, use or purpose, save that both applicant's and registrant's goods are for use with land vehicles, we find that the third-party registrations are sufficient to demonstrate that applicant's fan clutches and registrant's air filters are related automotive engine parts.

Further, and contrary to applicant's contention, in the absence of any limitations in the identifications of goods in either the application or the cited registration as to channels of trade or classes of purchasers, we must presume that both applicant's and registrant's automotive parts will be offered in the normal channels of trade for such goods, such as automotive supply stores, automobile dealers and automotive repair shops and will be offered to all normal pur-

chasers of such goods. *See In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Moreover, there is nothing in the record to substantiate applicant's claim that the normal sales practices for the parties' goods differ, i.e., applicant's goods being "behind the counter" products selected with aid as opposed to registrant's goods being "shopping floor" items.

In view thereof, the *du Pont* factors of the similarity of the goods, channels of trade and classes of purchasers strongly favor a finding of likelihood of confusion as to the cited registration.

We now consider the marks. In determining the similarity or dissimilarity of the marks, we must compare the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods offered under the respective marks is likely to result. Applicant's mark is COOLFLO and the cited mark is KOOL FLOW. Both marks are depicted without any stylization or design. The marks are similar because, as the examining attorney points out, they are essentially phonetic equivalents which will be pronounced identically. *See RE/MAX of America, Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980) (similarity in sound alone may be sufficient to support a finding of likelihood of confusion). *See also, for example, Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469 (TTAB 1975); and *In re Cresco Mfg. Co.*, 138 USPQ 401 (TTAB 1963). Contrary to applicant's position, we find that neither the fanciful spelling of the term "cool" in registrant's mark nor the fanciful spelling of the term "flow" and the deletion of the space between the terms "cool" and "flo[w]" in applicant's mark are sufficient to distinguish the marks as to appearance. In addition, due to the similarity in sound and appearance, we find the marks similar in meaning and commercial impression.

*4 Applicant, however, in urging that the refusal be reversed, argues that the marks are different in meaning and commercial impression because one cannot assume that "KOOL" means the same thing as "COOL." Applicant relies on the following definitions of "kool" and "cool":

"Kool" means "cooler than cool" as in "hip," "awesome," "sweet" and the like.^[FN7]

"Cool" means "moderately cold; Lacking in warmth."^[FN8]

The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. *See In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789 (TTAB 2002). *See also University of Notre Dame du Lac v. J. C. Gourmet Foot Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). However, inasmuch as it appears that the *Urban Dictionary* is solely an online publication, we will not further consider the definition of "kool." Rather, we consider applicant's position regarding the definition of "kool" unsubstantiated argument only.^[FN9] The use of "kool" (as opposed to "cool") in the cited mark, applicant contends, "suggests something more than moderately cold — the spelling is a slang spelling and alludes to being 'hip,' 'with it,' or the like" while "cool" in applicant's mark means moderately cold. Applicant further contends that by ending the "flo" portion of its mark with an "O," "applicant alludes to the open clutch which permits air to flow through the carburetor. Applicant combines two terms to mimic the smooth continuous flow of air." (Brief at 11.) Applicant thus maintains that its mark creates a separate and distinct commercial impression that is different than that of the cited mark.

We do not find this argument persuasive. While some consumers may perceive slight differences in meaning, there is nothing in the record to suggest that consumers upon seeing the registered mark used on or in connection with air filters would immediately think "something hip" as opposed to something that "mimic[s] the smooth continuous flow of [moderately cold] air." (Applicant's brief at 11). Indeed, the advertising/informational copy of record for registrant's air filters states:

Remember to allow for the cold air feed flexible tube that is connected to the front of the filter. This must be directed toward a cold air source, such as below the radiator or through the fender well. This cold air source does not need to be a ram air effect.

(Applicant's response to Office Action No. 1 at Exhibit F-2). We thus find the meaning and commercial of the marks

similar.

Put simply, when viewing the marks in their entireties, we find that the similarity of the marks, due to their phonetic equivalence, and the similarity in meaning and commercial impression outweigh the slight differences in spelling and appearance. This factor thus favors a finding of likelihood of confusion.

*5 Applicant also argues that the cited “KOOL FLOW” mark is weak and should therefore be given limited protection. In support of its position that the mark is weak, applicant made of record copies from the TESS and TARR databases of the U.S. Patent and Trademark Office (USPTO) of four third-party applications and seven third-party registrations for marks containing the terms “C(K)OOL”, and/or “FLO(W)” for a variety of goods. We find these examples of limited probative value. First, as regards the applications, they show only that the applications have been filed. See Interpayment Services Ltd. v. Docters & Thiede, 66 USPQ2d 1463 (TTAB 2003). As regards the third-party registrations, while they may be used to demonstrate that a portion of a mark is suggestive or descriptive, they are not evidence that the marks shown therein are in use or that the public is aware of them. See AMF Incorporated v. American Leisure Products, Inc., 177 USPQ 268, 269 (CCPA 1973) [“little weight is to be given such registrations in evaluating whether there is likelihood of confusion.”]. Moreover, our review of such registrations reveals that of the seven registrations, only five of the marks in those registrations (i.e., COOLFLO, COOL FLOW, COOLFLOW, KOOL-FLO and KOOL FLOW) contain both the terms “c(k)ool and “flo(w).”^[FN10] However, they cover very different goods (i.e., sporting goods, water purifying fountains for pets, infusion pumps used in electrophysiology procedures, plastic containers for trees and water distribution and return control systems, respectively).

Nonetheless, we note that even if “KOOL FLOW” was considered to be weak due to an asserted degree of common usage, even weak marks are entitled to protection where confusion is likely. See Matsushita Electric Company v. National Steel Co., 442 F.2d 1383, 170 USPQ 98, 99 (CCPA 1971) [“Even though a mark may be ‘weak’ in the sense of being a common word in common use as a trademark, it is entitled to be protected sufficiently to prevent confusion from source arising”]. Here, notwithstanding any alleged weakness in the registered mark, it is still similar in sound, appearance, connotation and commercial impression to applicant's mark. We accordingly find this *du Pont* factor is neutral.

Two final arguments made by applicant require comment. First, with respect to the conditions of sale, applicant argues that:

Applicant's mark is unlikely to be confused with the Cited Mark because consumers buying the respective goods are sophisticated consumers. ... Both parties sell specific parts used *inside* the engine of land vehicles. Only people sophisticated about the mechanics and operation of motors of land vehicles attempt to replace or repair such parts.

*6 ***

Distributors, repair shops, parts houses, and automotive parts stores have sophisticated purchasing agents who are trained to know about auto parts, their manufacturers, and their uses. Because the goods of Applicant and Registrant are highly specialized, these consumers are expected to, and will, exercise great care in the selection and purchase of their respective goods. Accordingly, these consumers will likely exercise great care when viewing Registrant's Mark versus Applicant's mark — such consumers will know that Applicant only sells fan clutches under the COOLFLO mark and will be able to distinguish Applicant's fan clutches from Registrant's air filters sold under the KOOL FLOW mark.

(Brief at 7-8). We find these arguments unavailing. Even assuming that purchasers of applicant's fan clutches and registrant's air filters may need to exercise a degree of care or thought in choosing such goods, even careful purchasers of goods can be confused as to source under circumstances where substantially similar marks are used on substantially related goods. See In re Research 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, 168 USPQ 110, 112 (CCPA 1970) (“Human memories even of discriminating purchasers ... are not infallible.”).

Last, applicant argues that the Trademark Trial and Appeal Board, and various Federal and state courts, have many

times ruled that similarly situated marks have not been confusingly similar. However, as often noted by the Board and the Courts, each case must be decided on its own merits. The determination of registrability of a mark in another case cannot control the merits in the case now before us. See In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). See also, In re Kent-Gamebore Corp., 59 USPQ2d 1373 (TTAB 2001); and In re Wilson, 57 USPQ2d 1863 (TTAB 2001).

In view of the foregoing, we conclude that prospective purchasers familiar with the registered mark KOOL FLOW for automotive parts, namely air filters for land vehicles would be likely to believe, upon encountering applicant's substantially similar mark COOLFLO for land vehicle parts, namely, fan clutches, that such goods emanate from, or are sponsored by or affiliated with the same source.

Decision: The refusal to register is affirmed.

FN1. Serial No. 78855392, filed April 6, 2006, and alleging a bona fide intention to use the mark in commerce.

FN2. Registration No. 2776725, issued October 21, 2003.

FN3. Applicant also filed a "request for reconsideration." The request for reconsideration did not purport to contain any additional evidence or argument, but rather, was merely a notification that applicant was seeking a consent agreement from the owner of the cited registration. Applicant neither filed a consent agreement nor requested that the appeal be suspended while applicant attempted to obtain one. Instead, applicant continued with the appeal. For that reason, on February 5, 2008, the Board issued an order stating that no further consideration would be given to the request for reconsideration.

FN4. Exhibits A-I appear to be results from a search of the Google® Internet search engine in which either the terms "C(K)OOL" and "FLO(W)" were used in connection with automotive products.

FN5. We add, however, that even if we had considered this evidence, our decision would be the same. Particularly, of the third-party uses, all but one were for marks that did not include both the terms "C(K)OOL" AND "FLO(W)."

FN6. We note that while Registration Nos. 2873519, 2578733, 2869160, 3044874 and 3210128 cover both "air filters" and "clutches," it is unclear whether the clutches listed therein are engine parts. Accordingly, those registrations have little probative value.

FN7. Urban Dictionary at www.urbandictionary.com/define.php?term=kool.

FN8. Merriam-Webster Online Dictionary at www.m-w.com.

FN9. Doing so, however, does not affect the outcome of this decision.

FN10. The other two registrations are for the marks KOOL FLOSS and THE FLORIDA COOL RING.

2008 WL 2619535 (Trademark Tr. & App. Bd.)
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THIS OPINION IS NOT A PRECEDENT OF THE T.T.A.B.

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

In re Intuitive Surgical, Inc.

Serial No. 76654345

July 25, 2008

Michelle D. Kahn and Michelle J. Hirth of Sheppard, Mullin, Richter & Hampton LLP for Intuitive Surgical, Inc.

Bernice Middleton, Trademark Examining Attorney
Law Office 106

Mary I. Sparrow, Managing Attorney

Before Quinn, Zervas and Cataldo
Administrative Trademark Judges
Opinion by Zervas
Administrative Trademark Judge:

Intuitive Surgical, Inc. has appealed from the final refusal of the examining attorney to register on the Principal Register the term CARDIOVAC (in standard character form) as a trademark for the following goods: "medical devices, namely, suction apparatus for use during urologic, gynecologic, pediatric, cardiac and general surgical procedures" in International Class 10.^[FN1]

The examining attorney has finally refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that, when used on applicant's goods, the mark CARDIOVAC would be merely descriptive of such goods.

After the examining attorney issued a final action, applicant filed an appeal and a request for reconsideration. The examining attorney denied the request for reconsideration, and subsequently both applicant and the examining attorney filed briefs. We affirm the refusal to register.

The examining attorney maintains that applicant's mark is a combination of the terms "cardio" and "vac," and that both terms have significance in connection with applicant's goods. She has entered a definition of "cardio" from dictionary.cambridge.org into the record, which provides that "cardio" is a prefix meaning "of the heart," and she states that the term "will immediately convey to consumers that applicant's goods are to be used in cardiac or cardiovascular procedures." Brief at unnumbered p. 3. "Vac" is identified as an abbreviation for "vacuum" in *Merriam-Webster's Online Dictionary* located at merriamwebster.com.^[FN2] As an adjective, the record shows that "vacuum"

is defined in part in bartleby.com as “operating by means of suction or by maintaining a partial vacuum.”^[FN3] According to the examining attorney,

The mark is descriptive because it immediately conveys that the goods provide suctioning in procedures affecting the heart and/or blood vessels. Applicant's goods, a suction apparatus[,] would clearly utilize suction. Therefore applicant's use of the word ‘vac’ is descriptive for a suction apparatus and/or goods operating by suction.

Id. at unnumbered p. 3.

Applicant responds that its goods “have nothing whatsoever to do with the heart and blood vessels” and that they “are used in a wide variety of surgical procedures to remove or evacuate fluids that accumulate during those procedures ... and do not affect the heart or blood vessels themselves.” Brief at pp. 5 - 6. It adds that even if it were to implicate the heart and blood vessels, “cardio” suggests “the importance of maintaining a clear surgical field while operating and that such maintenance is central or at the ‘heart’ of any successful surgical procedure.” *Id.* at p. 7.

*2 With respect to the term “vac,” applicant makes three arguments. First, applicant distinguishes a vacuum from the suction caused by applicant's goods. Referring to definitions of “vacuum” and “suction,” applicant argues that suction “is the process of producing a pressure differential that attracts substances to a region of lower pressure”; that “[w]hile a vacuum is often created to achieve suction and often one is related to the other, a vacuum and suction are two different things”; and that “[t]he ‘vac’ portion of Applicant's mark is suggestive of the suction that is used by a vacuum cleaner or the suction created by a vacuum but is not descriptive of it.” *Id.* at pp. 8 - 9.

Second, applicant maintains that applicant's apparatus “does not itself create the suction used to remove fluids, and instead simply transmits the suction effect through its tubing.” Applicant quotes from a submission by applicant to the Food and Drug Administration, made of record by the examining attorney with her final Office action, and states that “the goods offered under CARDIOVAC transmit the suction, they do not themselves create the vacuum from which the suction results.” *Id.* at p. 9.

Third, applicant argues that “vac” has a suggestive connotation because “evacuate” is commonly used to refer to the removal of fluids from the body; that an “evacuator” is a medical device for removing fluid or small particles from a body cavity;^[FN4] and that “[s]urgeons and health care professionals, the consumers of Applicant's goods, commonly use the term evacuate and are highly likely to interpret the term ‘vac’ when used in connection with Applicant's goods ... to be suggestive of fluid removal or evacuation.” Reply at p. 8.

As to the term CARDIOVAC as a whole, applicant argues that it is suggestive rather than merely descriptive of applicant's goods. According to applicant, neither “cardio” nor “vac” is merely descriptive of applicant's goods; the combination creates an incongruity because “the concept of using a vacuum in a medical procedure, whether involving the heart or not, seems strange and does not comport with the common understanding of vacuuming.” *Id.* at p. 10.

Applicant has also introduced into the record several third-party registrations for marks with either the term CARDIO or the term VAC that have registered without disclaimers. In particular, we note the following registered marks containing VAC; SAF-T-VAC for suction devices for removing by-products of electrocautery medical procedures; MEDI-VAC for medical suction collection containers; and PLAK-VAC for “aspirating oral hygiene instrument for use in conjunction with a separate suction system.” Applicant points out that the lack of a disclaimer of “vac” indicates the term is suggestive. Further, applicant has introduced into the record the registration for the mark CARDIOVAD for “blood pumps,” arguing that a “vad” is a common abbreviation for “ventricular assist device” or a heart pump. In view of these registrations without any disclaimers, applicant maintains that its mark is suggestive.

*3 A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development*

Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982); and In re MBAssociates, 180 USPQ 338 (TTAB 1973).

Both the examining attorney and applicant have considered the mark as having two components, CARDIO and VAC, and so do we. We consider each component and then consider the mark as a whole.

The examining attorney has established that "cardio" is a prefix meaning "of the heart." Because applicant's identification of goods specifies that applicant's goods are to be used, inter alia, in cardiac or cardiovascular procedures, we find that the term CARDIO in applicant's mark immediately informs the purchaser of a use of applicant's goods. We are not persuaded by applicant's argument that the goods "have nothing whatsoever to do with the heart and blood vessels." Brief at p. 5. Applicant's identification of goods provides that applicant's suction apparatus is for cardiac procedures. Further, even if applicant's goods can be used in other non-cardiac surgical procedures, the term may be deemed merely descriptive. As mentioned above, a term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. *Id.* We also find little merit in applicant's argument that "cardio" "suggests the importance of maintaining a clear surgical field while operating and that such maintenance is central to or at the 'heart' of any successful surgical procedure." Brief at p. 7. The connotation suggested by applicant is not one that purchasers are likely to give to the term "cardio" in applicant's mark in the context of cardiac procedures in which applicant's goods may be used.

Turning then to the term VAC, the examining attorney has established that "vac" is an abbreviation for "vacuum," defined as "operating by means of suction or by maintaining a partial vacuum," and that applicant's "suction apparatus" operates through the use of a vacuum. The term "vac" in applicant's mark hence informs the purchaser that applicant's goods operate in conjunction with a vacuum and hence too informs the purchaser of a feature of applicant's goods.

*4 Applicant's argument that the goods "transmit the suction, they do not themselves create the vacuum from which the suction results," and its reliance on statements made in its submission to the Food and Drug Administration, are not persuasive. Applicant has chosen to describe its goods as "suction apparatus" and not the "sterilized tubing assemblies" described in the Food & Drug Administration submission. The Board considers the issue of mere descriptiveness based on the identification of goods; other goods on which applicant may use its mark are not relevant to our analysis.^[FN5] Further, applicant's "suction apparatus" is sufficiently general to be construed as including an element that provides the suction, or a vacuum. And, even if "suction apparatus" is the equivalent of "sterilized tubing assemblies," "vac" indicates that the tubing assemblies are specifically suited for use in a vacuum environment. See material regarding "Medi-Vac Suction Tubing" submitted by applicant with its request for reconsideration, emphasizing that "[t]hick tubing walls offer safety and collapse resistance at high vacuum pressures."

Applicant has also argued that the word "evacuate" and "evacuator" are commonly used by health care professionals in connection with the removal of fluids from the body, citing to dictionary definitions of "evacuate" and "evacuator," and concludes that "consumers of Applicant's goods are highly likely to interpret and understand Applicant's mark as having this suggestive connotation." Brief at p. 10. The dictionary definitions do not persuade us that consumers of applicant's goods would consider "vac" as a reference to "evacuate" or "evacuator" rather than as a reference to "vacuum." We consider it more likely that health care professionals would give "vac" its dictionary definition rather than the "suggestive" meaning applicant advocates.

We are also not persuaded by the evidence of thirdparty registrations of marks containing CARDIO or VAC. These registrations may not contain disclaimers of the terms CARDIO and VAC because the examining attorneys may have considered the marks as unitary and hence not requiring a disclaimer. Further, as the examining attorney pointed out, third-party registrations are not conclusive as to the question of descriptiveness and each case must be

analyzed based on the facts pertinent to that case. See In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001).

Thus, we find that CARDIO is merely descriptive of a use of applicant's goods, i.e., that they are used in connection with cardiac procedures. VAC also is merely descriptive of the vacuum component of applicant's goods. Combining the two terms into CARDIOVAC does not negate the mere descriptiveness of these terms; the composite is as merely descriptive of the goods as the two terms are when considered separately - a separate non-descriptive meaning is not created by combining the two terms. Applicant is not entitled to appropriate for itself (via Federal registration) the exclusive right to use the term CARDIOVAC in connection with suction apparatus for use during urologic, gynecologic, pediatric, cardiac and general surgical procedures.

***5 Decision:** The refusal to register is affirmed.

FN1. Application Serial No. 76654345 was filed on January 31, 2006, based on applicant's assertion of its bona fide intention to use the mark in commerce.

FN2. We take judicial notice of this dictionary definition of "vac." The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. See In re CyberFinancial.Net Inc., 65 USPQ2d 1789 (TTAB 2002). See also University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

FN3. As a noun, "vacuum" is defined in part as "a vacuum cleaner."

FN4. The definition of record of "evacuate" from www2.merriamwebster.com is "2: to discharge (as urine or feces) from the body as waste)." The definition of record of "evacuator" from medical-dictionary.com is "a mechanical evacuant; an instrument for the removal of fluid or small particles from a body cavity" The definition of "evacuator" from medicaldictionary.thefreedictionary.com is "an instrument for removal of material from a body cavity."

FN5. Also, the present application is an intent-to-use application.

2008 WL 3244031 (Bd.Pat.App. & Interf.)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

JEFF BROWN,)	
)	
Opposer,)	
)	Opposition No. 91181448
v.)	
)	Application No. 77/040,379
PATRIOT GUARD RIDERS, INC.,)	
)	
Applicant.)	

EXHIBIT 37

of

**“Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to
Applicant’s Memorandum in Support of its Motion for Summary Judgment”**

2008 WL 4235321 (Trademark Tr. & App. Bd.)

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

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

In re The Naples Group

Serial No. 78767372

September 4, 2008

Craig Johnson and Jennifer F. Wisniewski of Kutak Rock for The Naples Group

Sara N. Thomas, Trademark Examining Attorney
Law Office 110
(Chris A.F. Pedersen, Managing Attorney)

Before Quinn, Grendel and Cataldo
Administrative Trademark Judges
Opinion by Cataldo
Administrative Trademark Judge:

The Naples Group has filed an application on the Principal Register for the mark shown below for “restaurant services” in International Class 43.^[FN1]



Registration has been finally refused pursuant to Trademark Act §2(d), 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark displayed below in Registration No. 2799650,^[FN2] issued to Woman's Club Reception Facility, Inc., for “food services, namely catering business meetings, banquets and wedding receptions” in International Class 42;



and the mark

SORELLA CAFFE (standard characters) in Registration No. 2813426,^[FN3] issued to John Molloy for “restaurant services” in International Class 43, as to be likely, if used on or in connection with the identified services, to cause confusion, to cause mistake, or to deceive. Applicant and the examining attorney have filed main briefs on the issue under appeal. In addition, applicant filed a reply brief.

Evidentiary Matters

With its main brief, applicant submitted for the first time an exhibit consisting of a specimen of use from the application underlying cited Registration No. 2799650. In addition, with its reply brief, applicant submitted for the first time exhibits consisting of search summaries from the Google Internet search engine as well as printouts from various Internet websites. Applicant also submitted with its reply brief dictionary definitions of “cater,” “company,” “mussel” and “pizza” from an unspecified edition of Webster's Dictionary. Applicant requests that the above evidence be entered into the record and that we take judicial notice of the referenced dictionary definitions.

As has often been stated, the record in the application should be complete prior to the filing of an appeal. *See Trademark Rule 2.142(d)*. The exhibits attached to applicant's main brief and reply brief were not made of record during examination. Accordingly, their submission therewith is untimely, and we have not considered this evidence in reaching our decision. *See Trademark Rule 2.142(d)* and TBMP §1203.02(e) (2d ed. rev. 2004) and the authorities cited therein.

Further, inasmuch as we have not relied upon the proffered dictionary definitions of “pizza,” “company” or “mussel” in our determination herein, we decline to take judicial notice thereof.^[FN4] However, we will exercise our discretion to take judicial notice of the following definition of “cater” submitted by applicant: “to provide food and service, as for parties.”^[FN5] In addition, we hereby take judicial notice of the following definition of “restaurant” submitted by the examining attorney with her brief: “a business establishment where meals or refreshments may be purchased.”^[FN6] The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. *See In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002). *See also University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

*2 Finally, during examination of the application at issue, applicant submitted copies of third-party registrations and listings of additional third-party registrations obtained from the United States Patent and Trademark Office's (USPTO) Trademark Electronic Search System (TESS) database. We note that the examining attorney did not advise applicant that such listing was insufficient to make the additional third-party registrations of record at a point when applicant could have corrected the error. Accordingly, applicant's request that we deem the list of additional registrations to have been stipulated into the record is granted. *See TBMP §1208.03* (2d ed. rev. 2004) and the authorities cited therein. However, we will only consider the information that applicant has provided in the list of additional third-party registrations for such probative value as it may possess. *See Id.*

Likelihood of Confusion

Our determination under Trademark Act §2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re E.I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPO 563 (CCPA 1973). See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPO2d 1689 (Fed. Cir. 2005); In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPO2d 1201 (Fed. Cir. 2003); and In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPO2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.” Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPO 24, 29 (CCPA 1976); and In re Azteca Restaurant Enterprises, Inc., 50 USPO2d 1209 (TTAB 1999), and cases cited therein.

We review the relevant *du Pont* factors as they apply to this case.

The Services

Turning to our consideration of the recited services, we must determine whether consumers are likely to mistakenly believe that they emanate from a common source. It is not necessary that the services at issue be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient instead that the respective services are related in some manner, and/or that the conditions and activities surrounding the marketing of the services are such that they would or could be encountered by the same persons under circumstances that could, as a result of similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

*3 In this case, applicant’s “restaurant services” are identical to the services recited in Registration No. 2939414.

The services recited in Registration No. 2799650 are “food services, namely, catering business meetings, banquets and wedding receptions.” As noted above, “cater” is defined as “to provide food and service, as for parties.” “Restaurant” is defined above as “a business establishment where meals or refreshments may be purchased.” Thus, as identified, applicant’s services are related to those recited in Registration No. 2799650 in that both concern the provision of food or meals to customers.

In addition, the examining attorney has made of record twenty-four use-based third-party registrations which show that various entities have adopted a single mark for services that are identified in both applicant’s application and cited Registration No. 2799650. See, for example:

Registration No. 3041484 for “restaurant, bar and catering services;”

Registration No. 3288710 for “restaurant services and catering services;”

Registration No. 3283685 for “catering, restaurant services;”

Registration No. 3287988 for “restaurant and catering services” and

Registration No. 3222887 for “restaurant services, carry-out and delivery restaurant services, catering services, food preparation services.”

Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source.

See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1786 (TTAB 1993). In this case, the evidence of record supports a finding that the same marks are used to identify both applicant's services and those recited by registrant in Registration No. 2799650.

Applicant's reliance upon *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059 (Fed. Cir. 2003) and *Jacobs v. International Multifoods Corp.*, 668 F.2d 1234, 212 USPQ 641 (CCPA 1982) in support of its contention that restaurant services are unrelated to catering services is misplaced. Both *Coors* and *Jacobs* involved the relationship between restaurant services on the one hand and beverage products, respectively, beer and tea, on the other. Neither case addresses the relationship between restaurants and catering services. Nor does applicant cite to any authority that the analysis or evidentiary showings relevant to those cases applies to a determination regarding the relationship between restaurants and catering services.

Thus, based upon the recitations thereof and the evidence of record, applicant's services are identical to and closely related to the respective services in the cited registrations, and this *du Pont* factor favors a finding of likelihood of confusion.

Channels of Trade

*4 Neither applicant's services nor those of registrant recites any restrictions as to the channels of trade in which they are distributed or the class of purchasers to whom they are marketed. It is settled that in making our determination regarding the channels of trade, we must look to the services as identified in the involved application and cited registrations. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); and *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Because there are no restrictions recited either in the involved application or cited registrations as to channels of trade, both applicant's and registrant's services are presumed to move in all normal channels of trade therefor and be available to all normal classes of potential consumers. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Because applicant's services are identical to the restaurant services in Registration No. 2939414, and have been found to be related to the catering services in Registration No. 2799650, the services must be deemed to move in the same channels of trade and encountered by the same classes of purchasers. Accordingly, this *du Pont* factor further favors a finding of likelihood of confusion.

Conditions of Sale

Applicant contends that purchasers of the catering services recited in Registration No. 2799650 are sophisticated. Even assuming *arguendo* that purchases of such services would involve a deliberate decision, this does not mean that the purchasers are immune from confusion as to the origin of the respective services, especially when, as we view the present case, the similarity of the marks and the relatedness of the services outweigh any sophisticated purchasing decision. See *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990) [similarities of goods and marks outweigh sophisticated purchasers, careful purchasing decision, and expensive goods]. See also *In re Research 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, 168 USPQ 110, 112 (CCPA 1970) ["Human memories even of discriminating purchasers...are not infallible."]. As a result, we find this *du Pont* factor to neutral or to slightly favor a finding of likelihood of confusion.

Actual Confusion

Another *du Pont* factor discussed by applicant and the examining attorney is that of the lack of instances of actual confusion. We do not accord significant weight to applicant's contention, unsupported by any evidence, that there have been no instances of actual confusion despite contemporaneous use of the respective marks for the past three years. The Federal Circuit has addressed the question of the weight to be given to an assertion of no actual confusion by an applicant in an *ex parte* proceeding:

*5 With regard to the seventh DuPont factor, we agree with the Board that Majestic's uncorroborated statements of no known instances of actual confusion are of little evidentiary value. See *In re Bissett-Berman Corp.*, 476

F.2d 640, 642, 177 USPQ 528, 529 (CCPA 1973) (stating that self-serving testimony of appellant's corporate president's unawareness of instances of actual confusion was not conclusive that actual confusion did not exist or that there was no likelihood of confusion). A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, [citation omitted], especially in an ex parte context.

In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003).

Accordingly, while examples of actual confusion may point toward a finding of a likelihood of confusion, an absence of such evidence is not as compelling in support of a finding of no likelihood of confusion. Thus, we cannot conclude from the lack of instances of actual confusion that confusion is not likely to occur.

Moreover, the test under Section 2(d) is not actual confusion but likelihood of confusion. See *In re Majestic Distilling Co. supra*. See also *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984); and *In re General Motors Corp.*, 23 USPQ2d 1465 (TTAB 1992). As a result, we find this *du Pont* factor, to the extent that it is applicable in this case, to be neutral.

Strength of the Cited Marks

Applicant contends that the term SISTERS is common in the food and restaurant industry and that, as a result, consumers are accustomed to distinguish between marks containing SISTERS in connection with restaurant and food services. In support of its contention, applicant has made of record twelve third-party registrations for SISTERS-formative and SORELLA marks for restaurants as well as food-related goods and services.^[FN7] The following examples are illustrative:

Registration No. 2682979 for the mark shown below for "restaurant services;"



Registration No. 2892958 for the mark THE COURT OF TWO SISTERS for "restaurant services;"

Registration No. 2963240 for the mark WINE SISTERS USA for "providing classes and seminars in the filed [sic] of wine and food tasting, organizing and conducting wine tasting events;"

Registration No. 2683435 for the mark 3 SISTERS' for "candy;"

Registration No. 2991974 for the mark SORELLA (translated into English as "sister") for "wines"; and

Registration No. 2791894 for the mark SORELLA (translated into English as "sister") for "cheese and edible oils."

*6 However, applicant's evidence of third-party registrations is entitled to limited probative value. The registrations are not evidence of use of the marks shown therein. Thus, they are not proof that consumers are familiar with such marks so as to be accustomed to the existence of the same or similar marks in the marketplace. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982). Moreover, the probative value of many of the third-party registrations is diminished by virtue of the fact that the trademarks cover a wide variety of goods (candy, wine, cheese and edible oils), which are not as closely related to the services identified in the cited registrations as applicant's services. See *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1740 (TTAB 1991), *aff'd unpub.*, (Appeal No. 92-1086, Fed. Cir., June 5, 1992). In any event, even if we were to find, based on applicant's evidence, that registrants' marks are weak and entitled to a narrow scope of protection, the scope is still broad enough to prevent the registration of a highly similar mark for identical or closely related services. See *In re Farah Manufacturing Co., Inc.*, 435 F.2d 594, 168 USPQ 277, 278 (CCPA 1971).

In addition, applicant submitted Internet evidence of fourteen third-party uses of SISTERS-formative marks for restaurants. The following examples are illustrative:

THREE SISTERS CAFÉ, a restaurant located in Oakhurst, California (www.threesisterscafe.com);
SWEET SISTERS CAFÉ, a restaurant located in Pleasant Hill, California (www.sweetsisterscafe.com);
SISTER'S HOMESTYLE CAFÉ, a restaurant located in Phoenix, Arizona (www.azcentral.com);
TWO SISTERS CAFÉ, a restaurant located in Babb, Montana (www.visitmt.com);
MY SISTER'S CATERING AND CAFÉ, a restaurant and caterer located in Kenosha, Wisconsin (www.mysisterscateringandcafe.com); and
SISTERS' CAFÉ, a restaurant located in Honolulu, Hawaii (www.thehawaiiichannel.com).

Similarly, the probative value of this evidence is very limited because applicant presented no evidence concerning the extent to which these third-party designations are used in commerce. *See Palm Bay Imports, supra.* Moreover, unlike other cases in which the Board has found a term to be weak as a result of applicant's submission of evidence that, for example, "hundreds of restaurants and eating establishments" (brief, p. 22) use a particular term, applicant in this case has introduced only fourteen examples of use by third-parties of designations that include some form of the term SISTERS. *Cf. In re Broadway Chicken, Inc., 38 USPQ2d 1559 (TTAB 1996).* Thus, applicant's evidence does not establish that there is widespread use of similar marks on restaurants and catering services such that registrants' marks are weak and entitled to only a narrow scope of protection. This factor, therefore, also favors a finding of likelihood of confusion.

The Marks

*7 We now turn to the similarities or dissimilarities between applicant's mark and those in the cited registrations. In coming to our determination, we must compare the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports, supra.* The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the goods offered under the respective marks is likely to result.

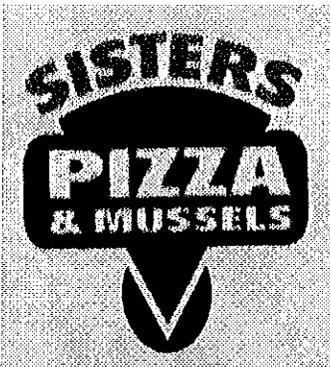
We further note that while we must base our determination on a comparison of the marks in their entireties, we are guided, equally, by the well established principle that, in articulating reasons for reaching a conclusion on the issue of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp., 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).*

Registration No. 2799650

Turning first to Registration No. 2799650 for the mark

Established 1976
SISTERS'
catering company

we find that such mark is similar to applicant's mark



in that both contain the word SISTERS as the most prominent feature thereof. SISTERS, as it appears in both marks, is identical in sound and meaning, and similar in appearance. We do not find that the presence of the apostrophe in registrant's mark results in a significant difference between SISTERS' therein and SISTERS as it appears in applicant's mark. Moreover, SISTERS appears to have the connotation in applicant's mark of a food establishment operated by sisters, and there is nothing in registrant's mark that suggests a different connotation.

The word SISTERS in applicant's mark is clearly the dominant element. It is displayed at the top of the mark and thus is the first word encountered therein. In addition, it is the only distinctive word in applicant's mark, PIZZA & MUSSELS being disclaimed and obviously descriptive of food products. Disclaimed wording typically is less significant in determining the similarity between marks. See *In re National Data Corp.*, *supra*. Further, the simple and rather abstract pizza slice and mussel shell design acts primarily as a carrier for the disclaimed wording in applicant's mark and makes less of a visual impression than SISTERS. It is settled that if a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987).

Thus, SISTERS is the portion of applicant's mark to which the viewer is drawn, the portion that the viewer is most likely to remember, and the portion by which consumers will refer to or request the identified services. See *In re Appetito Provisions Co.*, *supra*. For these reasons, we consider SISTERS to be the dominant feature of the applied-for mark.

*8 With regard to the mark in the cited registration, the word SISTERS' is also the dominant element. It is visually most prominent, and it is likely to be most noted and remembered inasmuch as it is the sole distinctive term in the mark. The disclaimed wording CATERING COMPANY appears in relatively smaller script below the word SISTERS' and is generic as applied to registrant's services and thus has little, if any, source identifying significance. Similarly, the disclaimed wording ESTABLISHED 1976 appears in very small script compared to the rest of the wording in the mark, and also has little, if any, source identifying significance. Accordingly, it is by the word SISTERS' that customers would recognize and request the identified services. See *In re Appetito Provisions*, *supra*.

We noted above that SISTERS, the word which the marks share in common, and the only distinctive word element in either mark, is also the first word in the marks. It is "a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered." *Presto Products, Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 USPQ2d at 1692 ("The presence of this strong distinctive term as the first word in both parties' marks renders the marks similar, especially in light of the largely laudatory (and hence non-source identifying) significance of ROYALE."). For the reasons articulated above, the disclaimed wording in both marks and the design elements in that of applicant are far less prominent than the word SISTERS. Consumers are likely to regard these elements of the marks as less important, and thus will refer to both marks as SISTERS, instead of pronouncing the remaining wording. See *Big M, Inc. v. United States Shoe Corp.*, 228 USPQ 614, 616 (TTAB 1985)("[W]e cannot ignore the propensity of consumers to often shorten trademarks.")

Viewing the marks in the involved application and cited registration as a whole, we find that the identity of the dominant feature, namely, the word SISTERS, in sound, meaning and connotation results in the marks' conveying similar overall commercial impressions. We note that the test under the first *du Pont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Accordingly, this *du Pont* factor favors a finding of likelihood of confusion as to the mark in Registration No. 2799650.

Registration No. 2939414

*9 Next we turn to the mark SORELLA CAFFE in Registration No. 2939414, bearing in mind that where, as here, the services identified in the involved application are identical to those identified in an existing registration, "the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine similarity of connotation with English word marks. See *Palm Bay Imports, supra*. The doctrine is applied when it is likely that "the ordinary American purchaser would 'stop and translate [the term] into its English equivalent.'" *Id.* at 1696, quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976).

The "ordinary American purchaser" in this context refers to the ordinary American purchaser who is knowledgeable in the foreign language. See *J.T. McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION*, §23:36 (4th ed. 2006). In this case, such a purchaser would be knowledgeable in Italian. In addition, in *In re Ithaca Industries, Inc.*, 230 USPQ 702, 703 (TTAB 1986), we found that "it does not require any authority to conclude that Italian is a common, major language in the world and is spoken by many people in the United States" in our determination that the doctrine of foreign equivalents is applicable where the foreign word is in Italian.

As noted above, the cited registration includes a translation of the mark SORELLA CAFFE as SISTER CAFÉ or SISTER COFFEE. In addition, the examining attorney submitted a translation from an Internet-based dictionary which agrees with the translation of SORELLA provided by registrant. Based upon the above evidence and authorities, we find that Italian is a modern language which is not obscure. We further find that every translation made of record agrees that SORELLA means SISTER. We find, in view of the foregoing, not only that the Italian term SORELLA is the exact translation of "SISTER," but further that the mark would be translated by those who are familiar with the Italian language. This situation, thus, differs from those cases in which it was found that the mark would not be translated because of the inherent nature of the mark. Cf. *In re Tia Maria, Inc.*, 188 USPQ 524 (TTAB 1984); and *Le Continental Nut Co. v. Le Cordon Bleu S.A.R.L.*, 494 F.2d 1395, 181 USPQ 646 (CCPA 1974) (finding that CORDON BLEU, while literally translated as BLUE RIBBON, would not be translated by the American public because the two terms create different commercial impressions, CORDON BLEU having been adopted into the English language and acquiring a different meaning from BLUE RIBBON).

*10 Accordingly, we find that the doctrine of foreign equivalents applies, and that the word SORELLA, while differing somewhat from the word SISTERS in sound and appearance, is identical in meaning conveys a highly similar, if not identical, commercial impression. We further find that the disclaimed word CAFFE in registrant's mark appears at best to be highly descriptive as applied to its services and thus possesses little, if any, source identifying significance. Thus, in accordance with the above discussion, the dominant portion of applicant's mark, namely, SISTERS, is identical to the dominant portion of registrant's mark, namely, SORELLA, in meaning and nearly so in commercial impression. The fact that the marks have same meaning, resulting in a highly similar overall commercial

impression, is sufficient for us to conclude that confusion is likely, despite the differences in their appearance and sound. See *In re American Safety Razor Co.*, 2 USPQ2d 1459 (TTAB 1987). This is particularly the case given that the marks both are used to identify legally identical restaurant services. See *Century 21 Real Estate Corp. v. Century Life of Am.*, *supra*.

Finally, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrants. See *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 165, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: Based upon the foregoing, and in particular, considering the similarities between applicant's mark and the marks in the cited registrations, as well as the identity and close relationship between the services recited therein, the refusal to register under Trademark Act § 2(d) is affirmed both as to the mark in Registration No. 2799650 and as to the mark in Registration No. 2939414.

FN1. Application Serial No. 78767372 was filed on December 6, 2005, based upon applicant's assertion of November 21, 2005 as a date of first use of the mark in commerce. Applicant disclaimed "PIZZA & MUSSELS." Applicant further submitted the following description of the mark: "The mark consists of the words 'SISTERS PIZZA & MUSSELS' inside a stylized slice of pizza facing downward into an open mussel shell. The word 'SISTERS' is gold, the pizza slice is red, the mussel is black, the rectangle is green and the wording 'PIZZA & MUSSELS' is white."

FN2. Issued on December 30, 2003, with a disclaimer of "ESTABLISHED 1976" and "CATERING COMPANY."

FN3. Issued on April 12, 2005 with a disclaimer of "CAFFE." The registration includes the following translation: "The English translation of SORELLA CAFFE is SISTER CAFÉ or SISTER COFFEE."

FN4. We hasten to add that even if we considered this evidence in our determination herein, the result would be the same.

FN5. Webster's Dictionary, p. 73 (unspecified Ed.).

FN6. Merriam-Webster Online, www.merriam-webster.com.

FN7. Applicant further made of record several registrations based upon Section 44 of the Trademark Act. Because these registrations are not based on use in commerce they have no probative value in showing the relatedness of the services, and they have not been considered. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). Applicant has also included several marks that have not registered. These applications are irrelevant. *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002) ("While applicant also submitted a copy of a third-party application ..., such has no probative value other than as evidence that the application was filed").

In addition, and as noted above, applicant submitted listings of third-party applications and registrations. Such listings of registrations have almost no probative value because there is no indication of whether the marks identified thereby are based on use in commerce; or which goods or services are identified thereby. In accordance with the above authority, listings of pending applications are without probative value.

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

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

In re S.A. Establecimientos Vitivinícolas Escorihuela

Serial No. 78967315

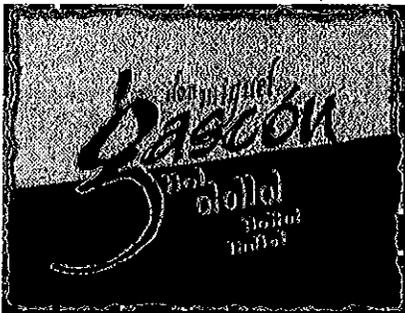
September 19, 2008

Julie B. Seyler of Abelman, Frayne & Schwab for S.A. Establecimientos Vitivinícolas Escorihuela

Michael Litzau, Trademark Examining Attorney
Law Office 104
(Chris Doninger, Managing Attorney)

Before Rogers, Zervas and Ritchie de Larena
Administrative Trademark Judges
Opinion by Zervas
Administrative Trademark Judge:

On September 5, 2006, S.A. Establecimientos Vitivinícolas Escorihuela (“applicant”) filed an application under Trademark Act §§ 1(a) and 44(e), 15 U.S.C. §§ 1051(a) and 1126(e), to register the mark



on the Principal Register for “wine” in International Class 33. Applicant has claimed first use anywhere and first use in commerce on July 1, 2007 and has entered the following description of the mark: “The mark consists of the stylized words ‘Don Miguel Gascon’ with an accent mark above the ‘O’ in GASCON, and below GASCON the design elements of circles and slashes in four horizontal rows.”

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the previously registered mark HACIENDA DE DON MIGUEL (in standard character form) for “wines” in International Class 33.^[FN1] The registration includes the following statement: “HACIENDA can be translated as ‘estate.’

Thus a translation of the mark is 'Don Miguel Estate.'" Registrant has entered a disclaimer of the term HACIENDA.

Additionally, the examining attorney has required (i) that a true copy, photocopy, certification or certified copy of the foreign registration on which applicant relies under Section 44(e) of the Trademark Act be submitted in order to satisfy the requirements of Section 44(e); and (ii) that applicant submit a specimen of use supported by a statement, verified with an affidavit or signed declaration under Trademark Rule 2.20, 37 C.F.R. § 2.20, supporting the specimen. The application does not now contain either a specimen of use or copy of the foreign registration on which applicant relies.

Applicant has appealed the final refusal and the requirements of the examining attorney. Both applicant and the examining attorney have filed briefs.^[FN2] As discussed below, the refusal to register is affirmed.

We first address one preliminary matter. Applicant sought to introduce into the record evidence with its attorney's brief, to which the examining attorney has objected. The examining attorney's objection is sustained. As stated in Trademark Rule 2.142(d), 37 C.F.R. 2.142(d), in countless Board decisions, in TMEP § 710.01(c) and in TBMP § 1207.01 (2d. ed. rev. 2004), the record should be complete prior to the filing of an appeal. Applicant could have easily entered the evidence it seeks to enter through its brief earlier in this proceeding; the issues which are discussed in applicant's brief are the same as those discussed in applicant's responses to the examining attorney's Office actions.^[FN3] We therefore do not further consider any of applicant's evidence submitted with its brief, which is the only evidence submitted in connection with its application.

*2 Turning next to the merits of the Section 2(d) refusal, our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPO 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPO2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPO2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPO2d 1531 (Fed. Cir. 1997). Because applicant and the examining attorney have focused their arguments on the similarity and dissimilarity of the goods and marks, we also focus on these two *du Pont* factors.

Applicant's and registrant's goods are identical. The *du Pont* factor regarding the similarity of the goods therefore weighs heavily in favor of finding a likelihood of confusion.

We next consider the *du Pont* factor regarding the similarity or dissimilarity of the marks when viewed in their entirety in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imports, Inc., supra*. The test, under this *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPO 106 (TTAB 1975). Finally, in cases such as this, where the goods are identical, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPO2d 1698 (Fed. Cir. 1992).

Applicant, who points out that "the marks are to be compared in their entirety and not dissected in to [sic] their individual components," and who accuses the examining attorney of "ignoring the basic precept that marks are to be compared in their entirety," nonetheless contends that that "a consumer is much more likely to remember the GASCON element rather than the [D]on [M]iguel element when recalling the goods," and that "the primary source-identifier of Applicant's mark is GASCON." Brief at p. 7. Applicant also relies on *Giant Food, Inc. v. Nation's Foodservice, Inc.* 218 USPO 390 (CAFC 1983) for the proposition that "one feature of a mark may be more signifi-

cant than other features” and “it is proper to give greater force and effect to that dominant feature,” i.e., GASCON.

*3 The Federal Circuit has stated that there is nothing improper in giving more weight, for rational reasons, to a particular portion or feature of a mark. See *In re National Data Corp.*, 753 F.2d 1056 USPQ 749 (Fed. Cir. 1985). Turning first to registrant's mark, we find that the term DON MIGUEL is the dominant part of that mark. The disclaimed term HACIENDA, translated as “estate,” serves little in indicating the source of the goods because it is a descriptive term that identifies a place where the goods are produced. Rather, it is the DON MIGUEL portion of the mark, translated as DON MIGUEL's ESTATE or ESTATE OF DON MIGUEL, which largely serves as the source indicator of the mark, and is entitled to more weight in our analysis than the remaining terms in registrant's mark.

The wording DON MIGUEL also appears in applicant's mark. Applicant has placed DON MIGUEL in lettering smaller than the term GASCON, but by including DON MIGUEL in the manner it has, applicant's mark still suggests an association with or sponsorship by registrant. Those familiar with registrant's mark would likely believe that a connection exists between applicant's and registrant's identical goods.^[FN4]

Applicant has also included design elements in its mark. These design elements do not distance the mark from registrant's mark. Because of their simple shapes, the design elements would be viewed merely as background for the wording in applicant's mark. Additionally, if a mark comprises both a word and a design, the word portion is normally accorded greater weight because it would be used by prospective consumers to order the services or be spoken through word of mouth. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli, Spa.*, 32 USPQ2d 1192 (TTAB 1994).

Thus, when we consider the marks as a whole, we find that applicant's mark is similar in sound and appearance to registrant's mark in view of applicant's inclusion of the dominant portion of registrant's mark, DON MIGUEL, in its mark. We also find that the marks are similar in meaning; *Merriam-Webster's Online Dictionary* located at merriam-webster.com defines “don” as “a Spanish nobleman or gentleman — used as a title prefixed to the Christian name,” and, of course, “Miguel” is a name. The meaning of DON MIGUEL, i.e., a Spanish nobleman or gentleman named Miguel, is the same in both marks; the addition of GASCON and the design elements in applicant's mark do not change the meaning of DON MIGUEL.^[FN5] As for the commercial impression of the marks, the commercial impression is also similar because DON MIGUEL is in both marks and has the same meaning in both marks. The inclusion of GASCON in applicant's mark would not distinguish the marks because registrant's mark would be viewed as merely omitting the surname of DON MIGUEL, while applicant's mark would be viewed as providing it. The *du Pont* factor regarding the marks is resolved against applicant.

*4 Applicant maintains that there have been no instances of actual confusion between the marks. However, there is nothing in the record to show that there has been a meaningful opportunity for such confusion to have occurred. More importantly, in the context of an ex parte proceeding, “the lack of evidence of actual confusion carries little weight.” *Majestic Distilling, supra*, 65 USPQ2d at 1205. Applicant's argument regarding actual confusion therefore is unpersuasive, and the seventh *du Pont* factor is neutral.

Another point applicant makes is that applicant has alleged a date of use earlier than registrant's filing date. However, this is not relevant since we do not determine priority in an ex parte proceeding. *In re Calgon Corp.*, 435 F.2d 596, 168 USPQ 278, 280 (CCPA 1971) (“As the board correctly pointed out, ‘the question of priority of use is not germane to applicant's right to register’ in this ex parte proceeding”). See also *In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001).

In short, we find that the marks are similar, and that the goods are identical. Based on these findings under the relevant *du Pont* factors, we conclude that a likelihood of confusion exists. Applicant's arguments to the contrary are not persuasive.

As for the examining attorney's requirements regarding applicant's foreign registration and specimen of use, which the examining attorney has not addressed in its briefs, they too are affirmed.

Decision: The refusal to register under Section 2(d) is affirmed. The refusal to register for applicant's failure to comply with requirements to submit a specimen of use and the relevant foreign registration also is affirmed.

FN1. Registration No. 3098323, issued May 3, 2006.

FN2. Applicant's reply filed late because applicant did not receive the examining attorney's brief, is accepted.

FN3. At fn. 5 of its brief, applicant has offered another argument in support of allowing its late-filed evidence into the record. It maintains that "the third party registrations constitute official records and therefore should be admitted as evidence." Applicant provides no support for its argument, but ostensibly is relying on Trademark Rule 2.122(e), 37 C.F.R. § 2.122(e), which concerns the admission of official records at trial during an inter partes proceeding pursuant to the notice of reliance procedure. That rule has no applicability in this ex parte proceeding.

FN4. Applicant, referring to the term "don" at p. 9 of its brief, argues that it is a "title of respect [and it] cannot be viewed as particularly strong." Applicant's argument is not persuasive because the common portion of the marks is DON MIGUEL, not DON.

FN5. We take judicial notice of this definition; the Board may take judicial notice of dictionary definitions including online dictionaries which exist in printed format. See In re CyberFinancial.Net Inc., 65 USPQ2d 1789 (TTAB 2002); University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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2008 WL 4674579 (Trademark Tr. & App. Bd.)

Page 1

2008 WL 4674579 (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.)

In re Unigene Laboratories, Inc.

Serial Nos. 78679380; 78679390; 78679397

September 30, 2008

Charles P. LaPolla, Esq. of Ostrolenk, Faber, Gerb & Soffen, LLP for Unigene Laboratories, Inc.

Dominic Fathy, Trademark Examining Attorney
Law Office 108

Andrew Lawrence, Managing Attorney

Before Quinn, Grendel and Wellington
Administrative Trademark Judges
Opinion by Wellington
Administrative Trademark Judge:

On July 27, 2005, Unigene Laboratories, Inc. filed applications to register the following marks:

SECRAPEP (in standard character format) for:

Biochemical preparations in the nature of biotechnology based preparations for medical and veterinary purposes in International Class 5;^[FN1] and

ENTERIPEP (in standard character format) for:

Bio-technology based delivery agents that facilitate the delivery of pharmaceuticals for medical and veterinary purposes in International Class 5;^[FN2] and

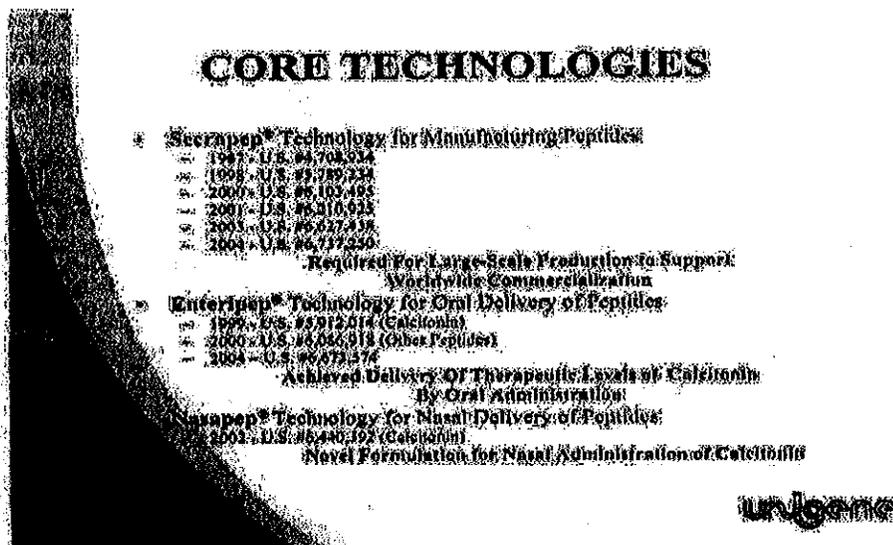
NASAPEP (in standard character format) for:

Bio-technology based delivery agents that facilitate the delivery of pharmaceuticals for medical and veterinary purposes in International Class 5.^[FN3]

The applications were based upon applicant's allegation of a *bona fide* intention to use the mark in commerce. The applications were published for opposition and a notice of allowance subsequently issued with respect to each application.

Applicant filed a statement of use for each application; in doing so, applicant attached the same specimen of use and alleged the same date (September 12, 2006) of first use anywhere and first use in commerce. The specimen appears

as follows:



In each application, the trademark examining attorney issued a refusal on the ground that the specimen submitted was not acceptable to show use of the mark in connection with the identified goods. Specifically, he stated that the specimen “comprises what appears to be an advertisement for the applicant’s goods” and, as such, is not acceptable.

Applicant filed responses wherein it argued against the refusal. Specifically, in each case, applicant essentially argued that the specimen “constitutes an appropriate display associated with the goods at their point-of-sale”; that the display “has been projected on a wall at a trade show booth where perspective purchasers were in a position to place orders for the goods”; and therefore “the specimen...constitutes a point-of-sale presentation in the same manner as a banner, shelf talker window display, menu or similar device as permitted under TMEP 904.06.”^[FN4] Moreover, applicant argued that because of “the nature of the goods,...[i]t has to be anticipated that point-of-purchase displays would be the natural form of specimen for such goods in view of the microscopic and intangible nature of such biotechnology based goods.”^[FN5]

*2 The examining attorney, however, was not persuaded by applicant’s arguments and issued a final refusal to register for each application.

Applicant filed notices of appeal and requests for reconsideration. The examining attorney denied the requests for reconsideration and maintained the refusal to register the three marks based on the ground that specimen was not acceptable for the identified goods. Applicant and the examining attorney thereafter filed briefs.

Applicant’s appeals in the three referenced applications are hereby consolidated and shall be decided in this single opinion.

As a preliminary matter, we address the examining attorney’s objection to evidence applicant submitted for the first time with its appeal brief.^[FN6] Specifically, applicant submitted printouts from the Wikipedia online encyclopedia website concerning “peptide.” The Examining Attorney objects to this evidence as untimely and, “as it is a Wikipedia article, that the examining attorney has not had the opportunity to rebut.” Examining Attorney’s Brief, (unnumbered) p. 4. The Examining Attorney’s objection is well taken. The record must be complete prior to appeal, subject to certain exceptions not relevant here. See 37 C.F.R. § 2.142(d). Applicant’s submission here is clearly late. Furthermore, as the examining attorney alluded to, we will not take judicial notice of evidence from Wikipedia or other sources which are available only online. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB

2002). See also *In re IP Carrier Consulting Group*, 84 USPQ2d 1028 (TTAB 2007) (Wikipedia evidence only admissible when there is an opportunity to verify its accuracy). Accordingly, we have not considered the Wikipedia evidence. Nonetheless, we note that, even if we had considered it, we would not decide the case differently.

We turn then to the merits of the appeal. The sole issue for consideration is whether the specimen submitted by applicant with its statements of use is acceptable to show use of the mark in connection with the identified goods. Narrowing the issue further, in its brief, applicant states “[t]he sole issue presented by this appeal is whether the specimen submitted...may be construed as a point-of-sale display associated with the goods.” Brief, p. 2. In this regard, we note that Trademark Rule 2.56(b)(1) provides:

A trademark specimen is a label, tag, or container for the goods, or a display associated with the goods. The Office may accept another document related to the goods or the sale of the goods when it is not possible to place the mark on the goods or packaging for the goods.

Trademark Rule 2.88(b)(2), applicable to this application because applicant filed its specimen with its Statement of Use, requires a specimen of the mark as actually used in commerce, and specifically refers to Rule 2.56 for the requirements for specimens.

- *3 Further, Section 45 of the Trademark Act states, in pertinent part, that a mark is deemed to be in use in commerce (1) on goods when —
- (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with goods or their sale, ...

Applicant argues that the specimen is a display associated with the goods; applicant notes that it has repeatedly advised the examining attorney that “the display [of the specimen] was projected on a wall at trade shows where prospective purchasers were in a position to place orders for the goods.” Brief, p. 1. Applicant states that “[w]ith sales representatives in close proximity to the projection, it is *inevitable* that the projection is designed to act as a banner intended to stimulate sales.” Brief, p. 3 (emphasis in original). Applicant asserts that the latter statements regarding use of the specimen at trade shows is supported by a declaration (signed by applicant's counsel) at the end of its request for reconsideration.

The examining attorney, on the other hand, contends that the specimen fails to meet the criteria (previously set forth in case law) to be considered displays associated with the goods. She argues specifically that the specimen, in all three applications, does not show an appropriate relationship with the goods and notes there is no information relating to the sale of goods, such as price, ordering information, or a picture of the goods. She also disputes applicant's contention that there are sales representatives nearby or otherwise call attention to purchasers that a product is available for sale.

The TMEP sets out factors to consider when determining whether a specimen is a display associated with the goods.

A display must be associated directly with the goods offered for sale. It must bear the trademark prominently. However, it is not necessary that the display be in close proximity to the goods. See *In re Marriott Corp.*, 459 F.2d 525, 173 USPQ 799 (C.C.P.A. 1972); *Lands' End Inc. v. Manbeck*, 797 F. Supp. 511, 24 USPQ2d 1314 (E.D. Va. 1992).

Displays associated with the goods essentially comprise point-of-sale material, such as banners, shelf-talkers, window displays, menus and similar devices.

These items must be designed to catch the attention of purchasers and prospective purchasers as an inducement to make a sale. Further, the display must prominently display the trademark in question and associate it with, or relate it to, the goods. *In re Osterberg*, 83 USPQ2d 1220 (TTAB 2007); *In re Morganroth*, 208 USPQ 284 (TTAB 1980) (purported mark was so obfuscated on the specimen that it was not likely to make any impression on the reader). The display must be related to the sale of the goods such that an association of the two is inevitable.

*4 TMEP § 904.03(g) (5th ed. rev. September 2007).

Applicant also cites to, and relies heavily on, the Board's decision in *In re Shipley Co.*, 230 USPQ at 694 (TTAB 1985). The Board, reversing the examining attorney's refusal in that case, found that applicant's use of its mark at a trade show booth amounted to a point of sale display and demonstrated use of applicant's mark on the identified goods. In that case, the applicant not only submitted pictures showing applicant's mark being used on its trade show booth, but also submitted a declaration from applicant's marketing communications director averring that:

[A]t all trade shows where [applicant] has such a booth, [applicant's] sales personnel are at the booth at all times during the show promoting and selling [applicant's] products, and though products are not always in close proximity to the booth, point of sale materials such as product literature, banners, displays, etc., are at the booths and ... the display of the identified trademark at the booth is intended to catch the attention of purchasers and prospective purchasers as an inducement to consummate the sale of chemicals for use in the fabrication of printed circuit boards.

In *Shipley*, the Board made absolutely clear that decisions regarding this type of specimen to show use for goods were to be made on a case-by-case basis and depended heavily on the evidence submitted. "In holding this use to be a display associated with the goods, we do not intend to establish a broad rule that any and all signs bearing a mark establish use in commerce for any and all goods...Here, the proof, that is, the circumstances of use shown in the specimens and explained in the declaration supporting them, convince us that applicant's use is a 'display associated' with the goods." 230 USPQ at 694.

The present record differs significantly from that in *Shipley* and we are not able conclude, on this record, that applicant's specimen amounts to a point of purchase display. For each application, applicant only submitted the specimen above which its *counsel* states, albeit under signature of a declaration, is projected on a wall at trade shows. There is no evidence showing the manner in which the specimen is used. Specifically, there is no photograph of the actual trade show exhibit or projection of the specimen or a declaration by someone with personal knowledge attesting to the manner in which the specimen was used. As to the "declaration" of applicant's counsel, this has no probative value because there is nothing in the declaration, or elsewhere in the record, to suggest that applicant's counsel has personal knowledge of how the specimen was being projected or that sales representatives were present at the trade show booths.

*5 The specimen, on its face, falls short of amounting to a point of purchase display. As the examining attorney correctly notes, there is no association of applicant's marks with the identified goods. Moreover, applicant's marks are followed immediately by "technology for nasal delivery of peptides," or "technology for manufacturing peptides," or "technology for oral delivery of peptides." The use of the term "technology" certainly obfuscates whether the mark is even identifying goods. Indeed, we find it very likely that this language may lead one to believe that the mark is identifying a process, method or procedure. Also, noticeably absent in the specimen is any inducement for the consumer to purchase any goods; there is no information regarding price or how one may even begin to purchase applicant's identified goods, not even a telephone number or an address.

Applicant alternatively argues that, in view of the nature of the identified goods, the specimen should be considered acceptable as "another document related to the goods or the sale of the goods," citing to TMEP § 904.03(k) (5th ed. rev. September 2007). Applicant explains that its goods are a "bio-technology based preparation, microscopic and intangible in nature, and submits that they are akin to natural gas or chemicals that are transported in tankers, both of which are also intangible in nature." Brief, p. 5.^[FN7]

The TMEP section cited by applicant specifically states that the examining attorney may accept another document related to the goods "when it is not possible to place the mark on the goods, packaging, or *displays associated with the goods.*" (emphasis added). Any reliance by applicant on this section must therefore be based on an assumption that the specimen is not a point of purchase display. See *In re Genitope Corporation*, 78 USPQ2d 1819, 1822 (TTAB 2006) ("If applicant is asserting that the nature of its product precludes it from creating a display associated

with the goods that satisfies the requirements of the Trademark Act, as it has been interpreted by case law, then applicant may not be able to rely on a display associated with the goods as its evidence of trademark use, but rather would have to submit evidence of a different manner of use.”).

Although we have found that applicant's specimen is not a point of purchase display, we are not able to conclude, as applicant requests in its alternative argument, that such use is impractical. Indeed, the record in the *Shiple* case demonstrated that an applicant may use point of purchase displays to show use of a mark on goods highly similar in nature to those of applicant herein.^[FN8] In any event, applicant here has not demonstrated that its goods are of such a nature that traditional trademark use is not practical. The record is unclear as to how applicant actually transports or delivers its goods to its consumers. If they are delivered in laboratory containers, then it is likely that these containers could be labeled or affixed somehow with applicant's marks. Although applicant has submitted a definition of “peptide” and argues that peptides are “not pills...do not take a shape or form...” applicant's goods are not peptides. Applicant's goods, as applicant describes them, are biochemical preparations and delivery agents to be used either with or in the manufacturing of peptides. Without any further evidence, we are not able to accept applicant's contention that its goods are of such a nature that traditional trademark use is not practical. *In re Settec, Inc.*, 80 USPQ2d 1185 (TTAB 2006) (A mere assertion of impracticability does not suffice to establish that traditional trademark use is impracticable).

*6 In summary, we conclude that the specimen submitted by applicant with its statements of use is not acceptable to show use of the mark in connection with the identified goods in all three applications. Contrary to applicant's contention, we find that the specimen is not a display associated with the goods. Moreover, applicant has not demonstrated that its goods are of such a type that it is not possible for applicant to make trademark use by placing the mark packaging or displays associated with the goods.

Decision: The refusal of registration in all three applications is affirmed.

FN1. Application Serial No. 78679380. Notice of Allowance was mailed on May 30, 2006.

FN2. Application Serial No. 78679397 (filed on July 27, 2005). Notice of Allowance was mailed on April 4, 2006.

FN3. Application Serial No. 78679380 (filed on July 27, 2005). Notice of Allowance was mailed on April 4, 2006.

FN4. These arguments were made in applicant's June 20, 2007 response for application Serial No. 78649380, but nearly identical arguments were made in its responses in the other two applications.

FN5. *Id.*

FN6. In its reply brief, applicant notes the examining attorney's objection. Applicant does not withdraw its submission of the evidence, but requests that we take judicial notice of the definition of “peptide” from the *Merriam-Webster Online Dictionary* (2008). It is well settled that the Board may take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 n.7 (TTAB 1981). This includes online reference works which exist in printed format or have regular fixed editions. See *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006). Accordingly, the “peptide” definition has been considered.

FN7. Brief filed in Serial No. 78679380. Same essential argument, if not verbatim, was made in applicant's reply briefs filed with respect to the other two applications.

FN8. In Shipley, applicant's goods were identified as "biopharmaceutical preparations used to treat cancer in humans, namely, individualized cancer treatments prepared specifically for each individual patient from whom tumor tissue has been received."

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2008 WL 5078738 (Trademark Tr. & App. Bd.)

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

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

Big O Tires, Inc.
v.
67 and Latham, LLC

Opposition Nos. 91178685; 91178688

November 18, 2008

Before Bucher, Zervas and Wellington
Administrative Trademark Judges

By the Board:

Opposer, Big O Tires, Inc. has filed an opposition against registration of the marks A BIG RIG RESORT and DANNY'S A BIG RIG RESORT, filed by 67 and Latham, LLC, both for "retail store services featuring convenience store items and gasoline."^[FN1] Opposer asserts that the marks so resemble opposer's "BIG O" and "BIGFOOT" marks, which opposer alleges to have previously used or registered for goods and services related to vehicle tires, parts and accessories, as to be likely, when applied to applicant's services, to cause confusion among prospective purchasers.^[FN2] Applicant filed an answer denying the salient allegations in the notice of opposition.

This case now comes before the Board for consideration of applicant's "Motion To Dismiss Or In The Alternative, For Summary Judgment" (filed November 30, 2007 and renewed January 4, 2008). The motion has been fully briefed.^[FN3]

The parties briefed this case as a motion for summary judgment and they have submitted matters outside the pleadings that have not been excluded by the Board. Accordingly, the motion has been treated as a motion for summary judgment under Fed. R. Civ. P. 56. See TBMP § 503.04 (2d ed. rev. 2004).

A motion for summary judgment is a pretrial device, intended to save the time and expense of a full trial when a party is able to demonstrate, prior to trial, that there is no genuine issue of material fact, and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c); TBMP § 528.01 (2d ed. rev. 2004). To prevail on its motion, applicant must establish that there is no genuine issue of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Celotex Corp. v. Catrett, 477 U.S. 317 (1986); Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and Sweats Fashions Inc. v. Pannill Knitting Co. Inc., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). Applicant may discharge its burden "by 'showing' - that is, pointing out to the [Board] - that there is an absence of evidence to support the nonmoving party's case." Celotex Corp., 477 U.S. at 325.

Applicant's motion for summary judgment is brought on opposer's pleaded likelihood of confusion claim under Section 2(d) of the Trademark Act. Our determination under Section 2(d) is based on an analysis of all of the 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). See also, In re Majestic Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

*2 As set forth in *E.I. du Pont, supra*, "[t]he evidentiary elements are not listed ... in order of merit" inasmuch as "[e]ach may from case to case play a dominant role." *E.I. du Pont*, 177 USPQ at 562. Our primary reviewing court has made it clear that in appropriate cases, one *du Pont* factor can outweigh all of the other factors. See Kellogg Co. v. Pack'em Enterprises Inc., 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991). That one factor can outweigh all others is "especially [true] when that single factor is the dissimilarity of the marks." Champagne Louis Roederer v. Delicato Vineyard, 148 F.3d 1173, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998).

Applicant contends that the first *du Pont* factor, the similarity or dissimilarity of the marks, outweighs all other factors in this case because its marks, when compared with opposer's, are so dissimilar in appearance, meaning, sound, and overall commercial impression that opposer could not prove at trial that a likelihood of confusion exists.

For purposes of its motion, applicant has conceded that the other *du Pont* factors weigh in opposer's favor, with the exception of the factor regarding actual confusion.^[FN4] The two most important of these "conceded factors" are the factors regarding the similarity of the goods and services and the fame of opposer's marks.

As to applicant's concession of the fame of opposer's marks for purposes of this motion, we consider such fame to cover not only the goods recited in opposer's registrations but also to extend to the services identified in applicant's applications. We keep in mind too that the fame of a prior mark "plays a dominant role in cases featuring a famous or strong mark." Century 21 Real Estate Corp. v. Century Life of America, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), quoting Kenner Parker Toys v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

This brings us to the *du Pont* factor regarding the similarity or dissimilarity of the marks. We consider opposer's BIG O and BIGFOOT (or BIG FOOT) marks of Registration Nos. 0994466, 0993415, 1904955 and 3233881, as they are the most similar to applicant's marks.^[FN5] We examine the marks in their entireties as to appearance, sound, connotation and commercial impression. See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005).

*3 In appearance, the marks BIG O and BIGFOOT (or BIG FOOT) clearly differ from the marks A BIG RIG RESORT and DANNY'S A BIG RIG RESORT. The only common element is the descriptive term "big," prominently located as the first word in opposer's marks but relegated to the middle of applicant's marks. The marks also differ in their aural qualities. Applicant's marks contain alliteration ("rig" and "resort"), and rhyming elements ("big" and "rig"). Opposer's BIG O mark, on the other hand, contains a "pure sound" element, the letter "O." Neither of opposer's marks rhyme or contain alliteration.

The main difference between the marks, however, lies in their connotations. The word "big" is defined, *inter alia*, as "large or great in dimensions, bulk, or extent <a big house>; also large or great in quantity, number, or amount <a big fleet>." Merriam-Webster Online Dictionary, 2008.^[FN6] There is nothing in the record to suggest any particular meaning of either of opposer's marks in the context of tires. The only meanings we can attribute to opposer's BIG O mark is a large letter "O" or a big tire (the letter suggesting the tire's shape). The marks BIGFOOT and BIG FOOT connote a large foot, good traction of the tire on the road, or "bigfoot," otherwise known as Sasquatch.^[FN7] On the other hand, the phrase "big rig" has a distinct meaning as a term separate and apart from the two individual words

“big” and “rig” that make up the phrase.

Applicant submitted a copy of a print-out from the website “dictionary.com” which, citing to *Webster's New Millennium Dictionary of English*, Preview Edition (v. 0.9.7 2008), defines the phrase “big rig” as “a tractor-trailer truck.”^[FN8] Thus, applicant's marks A BIG RIG RESORT and DANNY'S A BIG RIG RESORT connote a place of relaxation for drivers of “big rigs”; in other words, a truck stop where drivers of tractor-trailer trucks may take a break or purchase convenience items and gasoline. The marks also play on the meaning of the word “resort” as an upscale vacation spot, “a place frequented by people for relaxation or recreation: a *ski resort*.”^[FN9] The juxtaposition of such connotation to an establishment that sells fuel and convenience items to drivers of tractor-trailer trucks creates an irony that is not found in opposer's marks.

Considering the overall commercial impressions of the marks, again we find that opposer's marks identify an object, suggesting in their overall commercial impression a big foot or print as could be made by a large tire, or Sasquatch (“Bigfoot”), or a big tire itself (the “O” being the shape of a tire). Applicant's marks create an entirely different overall commercial impression. They suggest leisure, a place for long-haul truck drivers to stop and rest, a “resort for big rigs.”

In view of the above, we conclude that the marks are dissimilar in sound, connotation, appearance and commercial impression. Further, we find that actual confusion was not conceded or established by the evidence.^[FN10]

*4 Despite applicant's concession regarding the remaining *du Pont* factors, including that the goods and services are related and of the fame of opposer's marks, we find the dissimilarities of the marks so great as to outweigh the other *du Pont* factors. See *Kellogg Co. v. Pack'em, supra* [no likelihood of confusion between mark “FROOTIE ICE” and elephant design for packages of flavored liquid frozen into bars and mark “FROOT LOOPS” for, *inter alia*, cereal breakfast foods and fruit-flavored frozen confections because -- while such goods are very closely related, move through the same channels of trade to the same classes of purchasers, are purchased casually rather than with care, and despite the fact that the mark “FROOT LOOPS” is a very strong, well known and, indeed, famous, mark -- the respective marks differ so substantially in appearance, sound, connotation and commercial impression that likelihood of confusion did not exist as a matter of law]. Applicant has shown an absence of evidence supporting opposer's claim that confusion as to the source of applicant's services in view of opposer's pleaded marks is likely.

Accordingly, no genuine issues of material fact remain for trial, and applicant is entitled to judgment as a matter of law. Applicant's motion for summary judgment is granted and the opposition is dismissed.

FN1. Serial Nos. 78815618 and 78811121.

FN2. Opposer pleaded ownership of 18 registrations. Eleven of the registrations are for marks that include the words BIG O or BIGFOOT. These marks are BIG O, BIG-O, BIG FOOT 60, BIG FOOT 70, BIG O TIRES and Design, BIG FOOT, COST U LESS BIG O TIRES and Design, BIG O TIRES, WWW.BIGOTIRES.COM and Design, BIG O TIRES LUBE CENTER, and BIGFOOT. Opposer also pleaded ownership of registrations for six marks consisting of a design only. Opposer also pleaded ownership of a registration for the mark BIG LIFT; because that registration has been cancelled under Section 8 of the Trademark Act, we give no further consideration to the BIG LIFT mark.

FN3. On June 17, 2008, applicant filed a contested motion, later withdrawn, to exclude opposer's response to applicant's summary judgment motion as untimely. As it has been withdrawn, we have not considered the motion. Applicant also filed a contested motion to extend its time to file a reply brief. Inasmuch as applicant timely filed its reply brief within fifteen days after the service date of opposer's response, the motion is denied.

FN4. Opposer was permitted limited discovery on the *du Pont* factors relating to actual confusion on grant of op-

poser's motion for discovery under Fed. R. Civ. P. 56(f). In briefing this motion, opposer presented no evidence showing actual confusion. We have therefore treated this factor as neutral in our likelihood of confusion analysis.

FN5. With respect to opposer's other word marks, while they contain additional elements, the additional elements do not add significantly to the marks in their overall impressions. The additional elements are either descriptive (as in "tires," "tires lube center," "tires cost u less," and "www.--.com") or model or grade designations (as in "60" and "70").

FN6. Retrieved November 5, 2008, from <http://www.merriam-webster.com/dictionary/big>. The Board may take judicial notice of standard reference works, including online reference works which exist in printed format. *In re Spirits International N.V.*, 86 USPQ2d 1078, 1081 n.5 (TTAB 2008).

FN7. Merriam-Webster Online Dictionary, 2008, defines "Bigfoot" as "[from the size of the footprints ascribed to it]: Sasquatch," and further defines Sasquatch as "a hairy creature like a human being reported to exist in the northwestern United States and western Canada and said to be a primate between 6 and 15 feet (1.8 and 4.6 meters) tall —called also *bigfoot*."

FN8. Opposer's objection to this dictionary entry on the ground of authentication is overruled; applicant authenticated the dictionary entry with its attorney's declaration, filed with applicant's reply brief.

FN9. *The American Heritage Dictionary of the English Language*: Fourth Edition 2000.

FN10. Moreover, the relevant test under Section 2(d) is likelihood of confusion, not actual confusion. *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990), and TMEP § 1207.01(c)(iii).

2008 WL 5078738 (Trademark Tr. & App. Bd.)
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

JEFF BROWN,)	
)	
Opposer,)	
)	Opposition No. 91181448
v.)	
)	Application No. 77/040,379
PATRIOT GUARD RIDERS, INC.,)	
)	
Applicant.)	

EXHIBIT 41

of

**“Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to
Applicant’s Memorandum in Support of its Motion for Summary Judgment”**



2009 WL 30133 (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.)

Addict, Ltd.
v.
GS & G, Inc. USA

Cancellation No. 92046699

January 2, 2009

John R. Sommer, Esq. for Addict, Ltd.

Richard S. Ross, Esq. for GS & G, Inc. USA

Before Zervas, Bergsman and Ritchie
Administrative Trademark Judges
Opinion by Zervas
Administrative Trademark Judge:

On January 10, 2006, Registration No. 3039758 (“the ‘758 registration”) for the mark ADDICT (in standard character form) issued on the Principal Register to GS & G, Inc. USA (“respondent” or “Defendant”) for “retail store services featuring clothing” in International Class 35, based on an application filed on January 4, 2005. The ‘758 registration recites dates of first use anywhere and first use in commerce on August 12, 2004.

Addict, Ltd. (“petitioner” or “Addict”) has filed a petition to cancel the ‘758 registration, alleging that petitioner owns a trademark application (Serial No. 78852067) for ADDICT for various clothing items in International Class 25, which the Office refused registration in view of respondent’s registration. Petitioner further alleges that prior to respondent’s claimed first use date, petitioner has been and is now (i) engaged in the business of manufacturing, promoting, distributing, and selling clothing worldwide and in the United States under the ADDICT and ADDICTWEAR marks; and (ii) providing retail store services featuring clothing under the ADDICT mark. Additionally, petitioner claims that it owns Registration No. 2310612 (the ‘612 registration) for the mark ADDICTWEAR (in standard character form) for “sportswear clothing, namely, shirts, shorts, hats, pants, jackets and socks” in International Class 25. According to petitioner, “[i]n the event there is any conflict between the Addict’s rights and marks and Defendant’s right and marks, Addict clearly has priority over Defendant as to clothing under the ADDICT and ADDICTWEAR marks and as to retail store services under the ADDICT mark.”

Respondent has filed an answer to the petition to cancel in which it denied petitioner’s salient allegations.

The record consists of (i) the pleadings; (ii) the file of the involved registration; (iii) petitioner’s notice of reliance in which it made of record, among other items, a certified copy of the ‘612 registration showing the status and title of

this registration,^[FN1] a copy of “part or all” of the file history of petitioner's pending application Serial No. 78852067 (including an Office action in which the assigned examining attorney has refused registration of petitioner's mark in view of the '758 registration), and respondent's responses to various discovery requests propounded by petitioner; and (iv) the trial testimony of (a) Merwin Andrade, the owner of a clothing store named Memes in New York City, and exhibits, (b) David Jefferies, petitioner's Director of Sales, and exhibits, and (c) Piers Kannangara, petitioner's Managing Director, and exhibits. In addition, the parties filed a stipulation on May 19, 2008 providing that petitioner “stipulates that Respondent GS & G, Inc. USA, has made continuous United States interstate commerce use of its ADDICT mark for the services set forth in U.S. Reg. No. 3,039,758 since at least as early as August 12, 2004.”

*2 Petitioner has filed a main brief; respondent has not filed any evidence or a main brief.

Preliminary Issue

Petitioner has not specifically asserted a likelihood of confusion or referenced Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in its pleading. However, the parties have proceeded as though likelihood of confusion is an issue at trial, with respondent's attorney participating in the testimonial depositions of Messrs. Jeffries, Kannangara and Andrade, during which petitioner elicited testimony regarding matters pertaining to likelihood of confusion, without objection from respondent. Indeed, at one point in Mr. Jeffries testimonial deposition respondent's attorney stated, “[I]f it would help, I think the client is willing to stipulate to the issue of confusion.” Jeffries dep. at 71. We therefore consider respondent to have been fairly apprised that petitioner was offering evidence in support of the likelihood of confusion issue and find that the likelihood of confusion issue was tried by the consent of the parties. See TBMP § 507.03(b) (2d ed. rev. 2004) and cases cited therein.

Standing

Petitioner has submitted proof that it is the owner of the '612 registration, and that the registration is valid and subsisting. Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPO2d 1842 (Fed. Cir. 2000); and Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPO 185 (CCPA 1982). Additionally, petitioner has submitted proof, that it is the owner of application Serial No. 78852067 for ADDICT which has been refused registration in view of respondent's '758 registration. In view of such evidence, petitioner has established its standing. See Great Seats, Ltd. v. Great Seats, Inc., 84 USPO2d 1235 (TTAB 2007).

Priority

Because this is a cancellation proceeding, petitioner does not necessarily have priority simply because it owns a registration. Brewski Beer Co. v. Brewski Brothers, Inc., 47 USPO2d 1281, 1284 (TTAB 1998) (the “Board has taken the position, in essence, that the registrations of each party offset each other; that petitioner as a plaintiff must, in the first instance, establish prior rights in the same or similar mark ...”). In this case, the parties have stipulated that respondent “has made continuous United States interstate commerce use of its mark ADDICT for the services set forth in U.S. Reg. No. 3,039,758 since at least as early as August 12, 2004.” This date is earlier than the January 4, 2005 filing date of the underlying application for respondent's '758 registration, on which respondent may also rely. See Intersat Corp. v. International Telecommunications Satellite Organization, 226 USPO 154, 156 n. 5 (TTAB 1985) (“The earliest date of first use upon which Intelsat can rely in the absence of testimony or evidence is the filing date of its application.”). Inasmuch as petitioner's use-based application that matured into petitioner's pleaded '612 registration was filed on April 15, 1998, a date earlier than the stipulated date of August 12, 2004 for “retail store services featuring clothing,” petitioner has priority in connection with the goods set forth in the '612 registration, “sportwear clothing, namely, shirts, shorts, hats, pants, jackets and socks.”^[FN2] We hence award priority to petitioner.

Likelihood of Confusion

*3 Our determination under Section 2(d) is based on an analysis of all of the 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). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that “[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We consider first the similarity or dissimilarity of petitioner's and respondent's marks. We determine whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

Petitioner's ADDICTWEAR mark consists of two components, ADDICT and WEAR. “Wear” is defined in *Merriam-Webster's Online Dictionary*, located at merriam-webster.com, as: “2 a: clothing or an article of clothing usually of a particular kind; *especially* : clothing worn for a special occasion or popular during a specific period b: FASHION, VOGUE.”^[FN3] Because WEAR merely describes a feature of the goods, i.e., clothing, ADDICT is the dominant term in petitioner's mark. The Federal Circuit has recognized that there is nothing improper in giving more weight, for rational reasons, to a particular portion or feature of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). According to the court, “the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’” *Cunningham*, 55 USPQ2d at 1846, quoting, *National Data Corp.*, 224 USPQ at 752.

The dominant term in petitioner's mark is identical to respondent's mark. Because the additional term WEAR does not significantly change the meaning of petitioner's mark, we find that the marks are similar in meaning and commercial impression. They are also similar in sound and appearance in view of the shared term ADDICT, with ADDICT being the first term in petitioner's mark. See, e.g., *In re Dixie Restaurants*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997) (likelihood of confusion with addition of the words “The” and “Café” and a diamond-shaped design to registrant's DELTA mark); and *In re Denisi*, 225 USPQ 624, 624 (TTAB 1985) (if “the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences.”) Any differences in the marks due to petitioner's inclusion of the term WEAR are outweighed by the similarity due to the shared term ADDICT. The *du Pont* factor regarding the similarity of the marks is therefore resolved in favor of finding a likelihood of confusion.

*4 Next, we consider the *du Pont* factor regarding the similarity or dissimilarity and nature of the goods and/or services. Such goods and services are similar if they are related in some manner. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

The record reflects that clothing companies use the same mark on both their clothing and clothing stores. See Kanganara dep. at 50; Jefferies dep. at 44, 66 and 74; and third party registrations submitted with petitioner's notice of reliance, from petitioner's application Serial No. 78852067.^[FN4] This evidence suggests that consumers would consider the source of clothing and retail sales of clothing to be the same when sold or provided under similar marks. Additionally, the Board has found in the past that clothing and retail sales of clothing are related for purposes of the likelihood of confusion analysis. See *In re Peebles, Inc.*, 23 USPQ2d 1795 (TTAB 1992) (MOUNTAINHIGH for clothing, namely coats sold in applicant's store is likely to cause confusion with MOUNTAIN HIGH for retail outlet store services for camping and mountain climbing equipment); and *In re Gerhard Horn Investments, Ltd.*, 217 USPQ 1181 (TTAB 1983) (MARIPOSA for retail women's clothing store services is likely to cause confusion with MARIPOSA for woven and knit fabrics of cotton, acrylic and polyester). Because there is a relationship between clothing and retail clothing store services, we resolve the *du Pont* factor regarding the goods and services in petitioner's favor.

Petitioner has said little in its brief about the *du Pont* factor concerning the similarity or dissimilarity of trade channels. We point out that our determination of the likelihood of confusion issue is based on the identification of goods and services as recited in the registrations. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987). Because there are no restrictions as to channels of trade or classes of purchasers in either petitioner's identification of goods or respondent's identification of services, we presume that petitioner's items of clothing travel in all channels of trade normal for such goods, and that they are available in retail stores, such as respondent's retail stores, and sold to the general public. We find, therefore, that the trade channels for petitioner's clothing and respondent's retail store services featuring clothing are the same and that petitioner's clothing and respondent's services are offered to the same class of purchasers.

*5 We turn next to the *du Pont* factor regarding actual confusion. Petitioner maintains that “[v]arious friends of Mr. Jefferies who have traveled to Miami have asked him about the GS&G shop because even though it is called ‘Addict’ it carries no ADDICT products.” Brief at p. 22, citing to Jefferies dep. at 71 - 72. Because there is no indication in the record that Mr. Jefferies' friends are purchasers or even potential purchasers of petitioner's goods, we give Mr. Jefferies testimony in this regard limited weight. The *du Pont* factor regarding actual confusion is neutral in our analysis.

Considering and evaluating all of the evidence as it pertains to the relevant *du Pont* factors discussed above, we conclude that a likelihood of confusion exists.^[FN5] Respondent's mark is sufficiently similar to petitioner's registered mark that use of respondent's mark on respondent's services related to petitioner's goods is likely to lead to confusion as to source, sponsorship or affiliation.

DECISION: The petition to cancel Registration No. 3039758 is granted.

FN1. The '612 registration was filed on April 15, 1998, claims first use anywhere and first use in commerce in March 1996 and issued on January 25, 2000. Section 8 accepted and Section 15 acknowledged. Also, Mr. Kannangara has testified that petitioner uses the ADDICTWEAR mark on clothing in the United States. Kannangara dep. p. 47.

FN2. We need not consider petitioner's allegation of priority based on common law use of ADDICT in light of our disposition of this case based on petitioner's pleaded registration.

FN3. The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002). See also *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). We take judicial notice of this definition of “wear.”

FN4. The third-party registrations serve to suggest that the goods and services are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

FN5. Petitioner contends that it has used its mark on a wide variety of goods, but has not submitted proof of which of such uses was in the United States. Petitioner's contention therefore is not persuasive.

2009 WL 30133 (Trademark Tr. & App. Bd.)
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on March 18, 2009, true and correct copies of the following documents:

1. *“Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to Applicant’s Memorandum in Support of its Motion for Summary Judgment”*,
2. *“Declaration of James A. O’Malley in Support of Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to Applicant’s Memorandum in Support of its Motion for Summary Judgment”*, and
3. Exhibits 28-41 in support of *“Applicant’s Response to Opposer’s Motion to Strike Certain Exhibits Attached to Applicant’s Memorandum in Support of its Motion for Summary Judgment”*.

were sent via electronic delivery and mailed, with proper postage thereon, to:

Tom Q. Ferguson (tferguson@dsga.com)
Courtney Bru (cbru@dsga.com)
DOERNER, SAUNDERS, DANIEL
& ANDERSON, L.L.P.
320 South Boston Avenue, Suite 500
Tulsa, Oklahoma 74103-3725

and

Rachel Blue (rachel.blue@mcafeetaft.com)
MCAFEE & TAFT
500 Oneok Plaza
100 W. 5th Street
Tulsa, Oklahoma 74103



One of Applicant’s Attorneys