

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
October 7, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

HyLoft, Inc. and KE Investments, Inc.
v.
Rapid Rack Industries, Inc.

Opposition No. 91187636
to application Serial No. 77415502
filed on March 6, 2008

Dana B. Robinson for HyLoft, Inc. and KE Investments, Inc.

David A. Dillard of Christie, Parker & Hale, LLC for Rapid
Rack Industries, Inc.

Before Quinn, Taylor and Bergsman,
Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Rapid Rack Industries, Inc. ("applicant") filed an
intent-to-use application for the mark GORILLA LOFT, in
standard character form, for "storage racks and shelving,"
in Class 20.

HyLoft, Inc. and KE Investments, Inc. ("opposers")
filed a notice of opposition against the registration of
applicant's mark on the ground of priority of use and
likelihood of confusion pursuant to Section 2(d) of the

Trademark Act of 1946, 15 U.S.C. §1052(d). Specifically, opposers alleged that prior to the filing of the application at issue, they have used the mark HYLOFT for storage systems, that opposers own the federally-registered mark HYLOFT, in typed drawing form, for shelves, namely, suspended shelves for storage purposes, in Class 20,¹ and that applicant's mark is likely to cause confusion with opposers' mark. In addition, opposers pleaded ownership of two applications for the mark HYLOFT, in standard character form, Serial No. 77348201 for *inter alia* shelving and storage racks, in Class 20, and Serial No. 77392304 for retail store services featuring *inter alia* shelving and storage racks, in Class 35. During the course of this proceeding, registrations for the applications issued: Registration Nos. 3617076 and 3617110 respectively.²

Despite the fact that opposers did not plead a dilution claim or seek leave to amend their notice of opposition to include a dilution claim, opposers argued in their brief that the registration of applicant's mark will dilute opposers' mark. Applicant did not object to opposers' assertion of a dilution claim and, in fact, addressed the merits of that claim in its brief. Accordingly, we construe

¹ Registration No. 2585032, issued June 25, 2002; affidavits under Sections 8 and 15 accepted and acknowledged.

² These registrations are now of record. See the discussion *infra*.

opposers' dilution claim as having been tried by implied consent and we deem the notice of opposition to be amended to conform to the evidence. Fed. R. Civ. P. 15(b)(2).

Applicant admitted that opposers own Registration No. 2585032 and the two applications referenced above and that the registration has become incontestable. Applicant denied the remaining salient allegations in the notice of opposition.

Evidentiary Issues

A. Michael Mikich Deposition.

Opposers took the testimony deposition of Michael Mikich, the president of HyLoft, Inc., on January 11, 2010, two weeks prior to the opening of their rebuttal testimony period.³ In its brief, applicant objected to the deposition of Mr. Mikich on the ground that it constitutes improper rebuttal. Applicant argued that the testimony "attempts to establish fame of the HyLoft mark, awards won by HyLoft and that the HyLoft brand was a driving force for sales at certain retail chains" and "did not respond to or rebut anything raised in Applicant's testimony period."⁴ In response, opposers argue that the testimony is proper

³ Applicant mistakenly thought that the Mikich deposition was taken during the rebuttal testimony period. Applicant's Brief, p. 23 ("The trial testimony identified by Opposers occurred during Opposers' rebuttal period, not during its time for taking testimony").

⁴ Applicant's Brief, p. 23.

because it "proves that the mark is famous, and at a minimum is appropriate to show that the mark (and the term 'loft') is distinctive or at a minimum has acquired distinctiveness."⁵

We agree with applicant that the testimony of Mr. Mikich constitutes improper rebuttal. Evidence which should constitute part of a plaintiff's case in chief, but which is made of record during the rebuttal period, is not considered when the applicant objects.

Applicant is entitled to an opportunity to rebut, during its testimony period, any testimony and evidence proffered in support of the allegations in the notice of opposition. This opportunity is foreclosed if opposer withholds the evidence until its rebuttal testimony period, **which is intended to be limited to denials, refutations or explanations of applicant's testimony and evidence.** (Emphasis added).

General Electric Company v. Graham Magnetics Incorporated,
197 U.S.P.Q. 690, 692 n.5 (TTAB 1977).

We note that opposers do not contend that the testimony of Mr. Mikich is intended to deny, explain or discredit applicant's testimony and evidence; rather, opposers assert that the testimony is proffered to prove fame and distinctiveness which are factors considered in determining likelihood of confusion. In this regard, in their main brief, opposers argued that their HYLOFT mark was famous and

⁵ Opposers' Rebuttal Brief, p. 12 n.2.

that the word "loft" is not descriptive when used in connection with storage systems. Thus, opposers recognized that the fame and distinctiveness of their mark are part of their *prima facie* case.

Furthermore, our review of the testimony confirms that it covers topics appropriate as part of opposers' case in chief (e.g., channels of trade, competitive products, first use of the HYLOFT trademark, registrations for the HYLOFT mark, media coverage of the product, etc.). Accordingly, applicant's objection is sustained and the testimony deposition of Mr. Mikich submitted by opposers prior to their rebuttal testimony period has not been considered.⁶

B. Declaration of Michael Mikich.

In a notice of reliance filed on January 8, 2010, more than two weeks prior to the opening of the their rebuttal testimony period, opposers filed the declaration of Michael Mikich and the declaration of counsel as testimony. Applicant objected to the declaration of Michael Mikich on the ground that there was no agreement between the parties that testimony could be introduced by declaration.⁷

⁶ In the alternative, the deposition could have been stricken on the ground that it was taken outside of the rebuttal period. See Trademark Rule 2.121(a) ("No testimony shall be taken except during the times assigned, unless by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board").

⁷ Applicant's Brief, pp. 22-23.

Opposers did not respond to applicant's objection in their reply brief.

Trademark Rule 2.123(b) provides that upon "written agreement of the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses." Because applicant asserted that there was no stipulation to submit testimony via an affidavit or declaration, because opposers did not file the written agreement between the parties authorizing testimony by declaration or affidavit, and because opposers did not contest applicant's objection, applicant's objection to the declaration of Michael Mikich, as well as the declaration of counsel, is sustained and those declarations have not been considered.⁸

C. Applicant's trial testimony.

On December 28, 2009, applicant took the testimony depositions of Bruce Meredith, applicant's Vice President of sales and marketing, Patricia Anne Martin, a paralegal in applicant's counsel's law firm, and David Dillard, applicant's counsel.

⁸ In the alternative, the declarations could have been stricken as having been filed outside the rebuttal period. See Trademark Rule 2.121(a).

On March 25, 2010, opposers served their brief on the case and objected to consideration of applicant's depositions because they had not been served or filed.⁹

Rapid Rack did not submit its trial testimony, nor serve it on the Opposer, and therefore should not be entitled to rely on any part of it. TBMP 703.01(k). Opposer has not received a signed and corrected version of the trial testimony of Mr. Dillard; (sic) Mr. Meredith or Ms. Martin. TBMP 703.01(j). Opposer should have been served the trial testimony within 30 days of the taking of the testimony, and been forwarded to the Board promptly.¹⁰

However, opposers must have had unsigned copies of the depositions at the time they prepared their brief because opposers referenced the depositions throughout their brief.¹¹

On April 2, 2010, applicant filed the deposition transcripts with the Board and served copies of the transcripts on opposers' counsel.

If a copy of a deposition transcript is not served on the adverse party within thirty days,

[A]ny adverse party which was not served may have remedy by way of a motion to the Trademark Trial and Appeal Board to reset such adverse party's testimony and/or briefing periods, as may be appropriate. If the deposing party fails to serve a copy of the transcript with exhibits on an adverse party after having been ordered to do so by the

⁹ Opposers' Brief, p. 10.

¹⁰ *Id.*

¹¹ Opposers' Brief, pp. 16, 17, 19-23, 26, 27, 33, 38, and 41.

Board, the Board, in its discretion, may strike the deposition, or enter judgment as by default against the deposing party, or take such other action as may be deemed appropriate.

Trademark Rule 2.125(a).

Opposers' remedy was to file a motion for an extension of time to file its brief. Moreover, opposers were not prejudiced by applicant's delay in filing and serving certified copies of the depositions and did not need an extension of time to file their brief because they had unsigned copies of the depositions. Furthermore, applicant did not refuse to serve certified copies of the depositions on opposers or fail to serve copies of the transcripts on opposers after having been ordered to do so by the Board. In fact, applicant eventually filed and served copies of the depositions.

In view of the foregoing, opposers' objection to the depositions of Mr. Meredith, Mr. Dillard and Ms. Chou is overruled. Nevertheless, we hasten to add that applicant's delay in filing and serving the certified copies of the deposition transcripts is not the best practice. Certified copies of the transcripts should be served as soon as practicable. In fact, Trademark Rule 2.125(a) provides that a copy of the transcript shall be served on each adverse party within thirty days after completion of the taking of that testimony.

D. Miscellaneous objections.

With respect to the numerous miscellaneous objections lodged by both parties to evidence deemed to be hearsay, irrelevant, etc., we have reviewed all of those and given them such consideration and weight, if any, as we considered to be warranted, noting that in no case would the inclusion or exclusion of such testimony or evidence be critical to our conclusions in this opposition.

The Record

By rule, the record includes applicant's application file and the pleadings. Trademark Rule 2.122(b), 37 CFR §2.122(b). The record also includes the following testimony and evidence:

A. Opposers' Evidence.

1. Notice of reliance on the following items:¹²
 - a. Applicant's responses to requests for admission (Exhibit C);

¹² Copies of opposers' pleaded registration(s) (Exhibit A) were not properly made of record pursuant to Trademark Rule 2.122(d). Opposers' advertising brochure (Exhibit B) is not properly made of record through a notice of reliance. Trademark Rule 2.122(e). Applicant's advertising brochure obtained through applicant's response to a request for production of documents is not properly made of record through a notice of reliance (Exhibit D). Trademark Rule 2.120(j)(3)(ii) ("A party that has obtained documents from another party ... under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of §2.122(e)"). Accordingly, these documents were not given any consideration unless they were properly made of record in some other manner.

- b. Articles from printed publications (Exhibits F-H, M-CC); and
- c. Excerpts from websites (Exhibits I-L, DD-FF);¹³

2. Second notice of reliance on the following items:¹⁴

- a. Excerpts from websites; and
- b. "USPTO search results of trademarks containing the word 'loft' for ('overhead storage'), 'loft,' 'rack 'shelves' (sic)."

3. Third notice of reliance on applicant's responses to interrogatories.

4. Testimony deposition of Wei Fong Jennifer Chou, a former law clerk for opposers' counsel, authenticating documents she found on the Internet regarding the HYLOFT trademark.

B. Applicant's evidence.

1. Testimony deposition of Bruce Arthur Meredith, applicant's Vice President of sales and marketing, with attached exhibits.

¹³ *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010) ("if a document obtained from the Internet identifies its date of publication or date that it was accessed and printed, and its source (e.g., the URL), it may be admitted into evidence pursuant to a notice of reliance in the same manner as a printed publication in general circulation in accordance with Trademark Rule 2.122(e)"). (Emphasis in the original).

¹⁴ We are not listing documents that were submitted in the first notice of reliance.

2. Testimony deposition of applicant's counsel authenticating documents attached to the deposition.

3. Testimony deposition of Patricia Anne Martin, a paralegal administrator and library administrator for applicant's counsel's law firm, authenticating documents attached to the deposition.¹⁵

4. Notice of reliance on the following items:¹⁶

- a. An excerpt from opposers' website (Exhibit 2);

¹⁵ As part of her testimony, Ms. Martin authenticated the search results from a TrademarkScan database search "that had loft somewhere in the mark and would have storage or shelf or rack someplace in the description of goods or services." (Martin Dep., p. 5; Exhibit 24). A trademark search report is not credible evidence of the existence of the registrations listed in the report. *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1231 (TTAB 1992); *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1215 n.3 (TTAB 1990). A party wishing to make of record third-party registrations referenced in a search report must file with a notice of reliance copies of the registrations or the electronic equivalent of them from the USPTO database. *Weyerhaeuser Co. v. Katz*, 24 USPQ2d at 1231; *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1549 (TTAB 1990) ("the trademark search report submitted by applicant is not credible evidence of the existence of third-party registrations; soft copies of the registrations themselves are required for this purpose"), *aff'd*. 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). Accordingly, we have not considered the TrademarkScan search reports authenticated by Ms. Martin or introduced through applicant's notice of reliance.

¹⁶ Opposers' catalog (Exhibit 1) purportedly downloaded from opposers' website did not display the URL or date it was printed and, therefore, it was not properly made of record through a notice of reliance. *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d at 1039. Copies of applicant's GORILLA registrations (Exhibit 22) were not properly made of record because they do not show their current status and title. Trademark Rule 2.122(d)(2). See also *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1928 (TTAB 2009) (permitting printout of information from the electronic database records of the USPTO). Applicant's advertising literature (Exhibits 26-27) is not admissible through a notice of reliance. Trademark Rule 2.122(e). In view of the foregoing, these documents were not given any consideration.

- b. Copies of opposers' registrations (Exhibit 3);
- c. Results from searches from the Google search engine (Exhibits 4-7);
- d. Excerpts from third-party websites (Exhibits 8-19);
- e. Dictionary definitions for the word "loft" (Exhibits 20-21); and
- f. Excerpts from newspaper and magazine articles retrieved through the LexisNexis database (Exhibit 23).¹⁷

Likelihood of Confusion

A. Opposer's Standing and Priority

Because applicant admitted that opposers are owners of Registration No. 2585032 and that the registration has become incontestable, we find that opposers pleaded registration is of record and, therefore, opposers have established their standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). In addition, because opposers' pleaded registration is of record, Section 2(d) priority is not an issue in this case as to the mark and the

¹⁷ Because there was no testimony regarding the extent to which Americans encountered the foreign sources, we have only considered the excerpts from American sources.

goods covered by the registration. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Applicant also admitted that opposers are owners of their pleaded applications and that the applications were published for opposition. As indicated above, applicant introduced copies of opposers' registrations through a notice of reliance. Because those registrations issued during the course of this proceeding, we consider those registrations to have been made of record. *UMG Recordings, Inc. v. Charles O'Rourke*, 92 USPQ2d 1042, 1045 n.12 (TTAB 2009) (if a party pleads a pending application in the notice of opposition, it may make the resulting registration of record at trial without having to amend its pleading to assert reliance on the registration).

B. Likelihood of confusion analysis.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

Applicant concedes that the goods of the parties and the channels of trade in which those goods move are the same.

It is also uncontested that Opposer and Applicant both use their respective marks in connection with ceiling mounted storage shelves and sell those products through similar channels of trade.¹⁸

Accordingly, the issues in this proceeding are the strength of opposers' mark and the similarity or dissimilarity of the marks GORILLA LOFT and HYLOFT.

1. The fame of opposers' HYLOFT mark.

This *du Pont* factor requires us to consider the fame of opposers' mark. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, "by the length of time those indicia of commercial awareness have been evident,"

¹⁸ Applicant's Brief, p. 5.

widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305-1306 and 1309. Although raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or services). *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1309.

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

The only admissible evidence regarding the fame of opposers' HYLOFT mark is media references.

Searches for press conducted by Ms. Chou were extensive, and resulted in about 20 unique instances of press reports about HyLoft or the HyLoft product(s). Chou Testimony Exhibits 19A-19S. A search on Google of the HYLOFT mark reveals numerous press articles referring to Opposer and its products. See, Chou

Testimony Dep., Exhibit 19S (sic) 19U,
(sic) 19V.¹⁹

We found the following media references noteworthy:

a. An excerpt from the Amazon.com website "Amazon Announces Top-Selling Holiday Products" (November 26, 2004) listing HYLOFT in the "tools & hardware" category;²⁰

b. An excerpt from an article printed in *Do It Yourself Retailing* (January 2005) identifying HYLOFT as an award winning storage product;²¹

c. Excerpts from *Home Improvement Executive* identifying HYLOFT as a "2008 HIE Innovation Award Winner";²² and

d. Excerpts from *Home Improvement Executive* identifying HYLOFT as a brand that merchants "perceive as driving your business" in connection with garage storage (2003-2009).²³

The media references are effective to show that HYLOFT storage systems have been advertised, sold, and reviewed by industry analysts and that the product has been reported to be effective. We cannot, however, infer that the mark is famous or enjoys public renown because there is no evidence

¹⁹ Applicant's Brief, p. 33.

²⁰ Chou Dep., Exhibit 19A; notice of reliance Exhibit M.

²¹ Chou Dep., Exhibit 19G; notice of reliance Exhibit R2. The award, the source of the award, and the year the award was granted were not identified.

²² Notice of reliance Exhibit G.

²³ Notice of reliance Exhibit H.

regarding the circulation of the media sources. For example, *Home Improvement Executive* appears to be a publication of limited circulation (*i.e.*, in the home improvement industry) as opposed to being a publication in general circulation available to the general public who purchase storage systems. Likewise, *Do It Yourself Retailing* appears to be a publication of limited circulation to retailers.

Furthermore, opposers failed to introduce any testimony or evidence regarding their sales figures in either dollar, units sold or market share, and they did not introduce any testimony or evidence regarding its advertising. Thus, in terms of sales and advertising there is no evidence to warrant an inference of extensive consumer awareness. On this record, we have no basis to find that consumers have been widely exposed to the HYLOFT mark, or that the mark has otherwise become widely known. In view thereof, we find that opposers have failed to prove that their HYLOFT mark is famous.

2. The similarity of the marks in their entirety in terms of appearance, sound, meaning, and connotation.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont*

de Nemours & Co., 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In addition, 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 comparison, 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. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). In this case, the average customer is any person who may have the need for shelving and storage racks.

The only similarity between the marks is that they share the word "loft." While opposers contend that "[t]he word 'loft' does not have any meaning as a description of a

ceiling mounted storage devices,"²⁴ they did concede that "[t]he word 'loft' has meaning for attic living and built-in storage spaces."²⁵ In fact, one of the definitions of the word "loft" is "a room, storage area, or the like within a sloping roof; attic; garret."²⁶ Another definition is "to store in a loft."²⁷

Third parties use the term "storage loft," "garage loft" and "loft" to describe suspended storage systems.

A. *SpotlessGarage.com*²⁸

Storage Loft

Any garage can use a loft to keep large items out of the way. ... Why keep your ladder in the way when a SpotlessGarage.com storage loft can keep it out of the way?

²⁴ Opposers' Brief, p. 16. We note that applicant's description of goods is not limited to "ceiling mounted storage devices." Applicant's description of goods is simply "storage racks and shelving." Likewise, while Registration No. 2585032 is for "suspended shelves," Registration No. 3617076 is not restricted; the description of goods includes "shelves" and "storage racks." "The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed." *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); see also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). In this case, there was no admissible testimony regarding opposers' actual use of their mark and, therefore, we are limited to the description of goods in the registrations.

²⁵ Opposers' Brief, p. 17.

²⁶ Random House Unabridged Dictionary (1997) (applicant's notice of reliance Exhibit 20).

²⁷ *Id.*

²⁸ Applicant's notice of reliance Exhibit 19.

* * *

SpotlessGarage.com storage lofts are the perfect solution for a homeowner who has lots of large items that aren't used very often. ... A loft, even a small one, can increase the amount of space in your garage substantially.

Our ceiling-mounted storage lofts allow you to place large, heavy items on top while allowing you access them via a ladder or step stool. ...

Using a storage loft might be the easiest way to start organizing your garage.

B. *GarageStorageLoftBuilders.com*²⁹

C. *Garageloftstorage.com*³⁰

²⁹ Applicant's notice of reliance Exhibit 18.

³⁰ Applicant's notice of reliance Exhibit 16.

D. *Garagedooropenerguide.com*³¹

Garage Loft Storage

Transform your garage with loft style shelving.

Suncast ALS17 Loft Shelf



- Overhead loft shelf designed for Suncast storage buildings
- Holds 30 evenly-distributed pounds
- Measures 50 inches wide, 17 inches deep and 12 inches tall
- For use with Suncast storage buildings (not for use with GS8000, GS9000, or GS9500A)
- Durable power-coated finish

May require a couple 2X4's to adapt this unit for use in your garage loft.



Ceiling Mounted Shelving Hardware-For 4'x8' Shelf

Your garage will be transformed when you install loft style shelving.

This ceiling mounted shelving unit enables you to conveniently store heavy and bulky items.

All you need to add is a 4' x 8' plywood board!

Once assembled, this 4' x 8' garage shelf will hold up to 300 lbs. and provide up to 85 cubic feet of space.

Thanks to the adjustable rod system, the distance between ceiling and shelf can adjust from 17" to 30".

Now you can easily store patio furniture, pool supplies, canoes, camping gear and many other seasonal items.

All mounting brackets are made of heavy carbon steel and are electrostatic painted.

Maximize your garage storage potential now with this garage ceiling storage system. The adjusting hanging rods are zinc plated and have a life long warranty.

All mounting hardware and instructions are included. (plywood not included)

³¹ Applicant's notice of reliance Exhibits 12 and 15. In addition to the "loft style shelving" advertised by Suncast Corporation and Artkan International, Inc., *Garagedooropenerguide.com* advertises opposers' HYLOFT storage system. Exhibit 14 is an excerpt from the *Onewayfurniture.com* website featuring an advertisement for the Suncast Corporation "Shed Storage Loft Shelf Shelving Kit." Exhibit 8 is an excerpt from *Target.com* advertising the Suncast Corporation "Loft Shelf for Storage Buildings."

E. *Thestoragebuilding.com*³²

The screenshot shows the website for 'Loft It Up Garage Storage & More'. The header features the company name and tagline 'Offering A Creative Storage Solution'. Contact information includes a phone number (615) 512-7454, a fax number (615) 773-9075, and an email address info@thestoragebuilding.com. A navigation menu on the left lists: Home, Garage Grids, Garage Cabinets, Garage Lofts, Garage Accessories, and Know Your Product. A central image shows a garage with a loft structure. Below the image is the text: '8' X 20' Overhead Garage Loft With Finished Drywall, Trim, Primed & Painted'. A link 'Click Here for Garage Accessories' is positioned above the image.

F. *Masstransitmag.com*³³

The screenshot displays a product page for 'COMPOSITE LOFT OVERHEAD RACK' from Transmatic Group. The page includes a 'Bookmark' and 'Print' link. A list of features is provided: 'Made of composite materials', 'High flexural and bearing strength while reducing total weight', 'Open design of the rack makes it easy to see if objects remain in the loft', and 'Available in numerous color options'. A photograph shows the rack installed in a garage, with various items stored on the shelves.

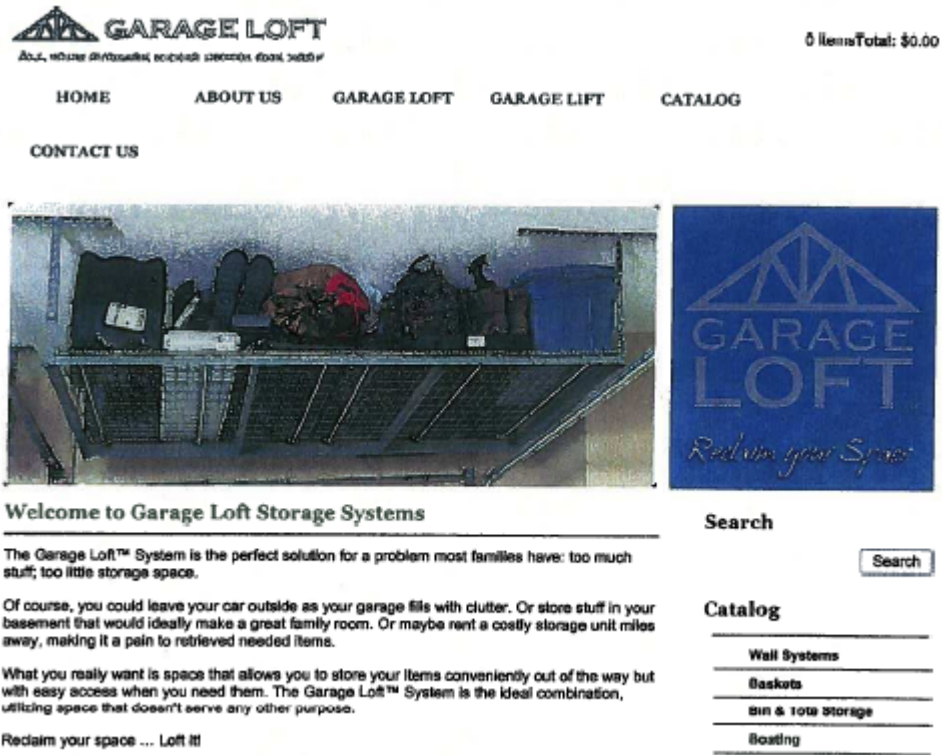
G. *Distinctivegarage.com*³⁴ identifies "Loft-Shelves" as a type of storage product for use in garages.

³² Applicant's notice of reliance Exhibit 13.

³³ Applicant's notice of reliance Exhibit 11.

³⁴ Applicant's notice of reliance Exhibit 10

H. *Thegarageloft.com*³⁵



News articles submitted by applicant show use of the word "loft" in connection with storage systems.

A. *Pensacola News Journal* (August 1, 2007)³⁶

Your garage: Its' not just a place to
hide clutter

To tuck things into an unutilized
space, you can always hang a rack. You
can hang a high loft of metal racks
along the ceiling about the garage
door.

³⁵ Applicant's notice of reliance Exhibit 9.

³⁶ Applicant's notice of reliance Exhibit 23.

B. United Press International (August 31, 1987)³⁷

Brief Looks at home care

The booklet offers suggestions on how to overcome lack of floor space by building storage units using shelves, cabinets, hooks, brackets and lofts. Included are diagrams of different types of shelving and hanging systems, overhead platforms and workbench and cabinet design.

C. *Intelligencer Journal* (June 16, 2000)³⁸

Shedding new light on storage

Ahl designed her sheds to be functional and charming. Whether well-lit by skylights or true, divided light windows, all the sheds are sold with practical features like potting shelves, tool racks and storage lofts.

We find that the word "loft" when used in connection with storage systems is suggestive, if not descriptive. As indicated above, the only similarity between the marks is the word "loft." The suggestive nature of the word loft would be readily apparent to purchasers of shelving and storage racks and, therefore, the use of that word alone is not sufficient to support a finding that the marks GORILLA LOFT and HYLOFT are similar. Accordingly, we find that applicant's GORILLA LOFT mark is readily distinguishable from opposers' HYLOFT mark.

³⁷ *Id.*

³⁸ *Id.*

3. Balancing the factors.

Despite the identity of the goods and channels of trade, we find that the differences between the marks warrant a finding that there is no likelihood of confusion. Simply put, we find that the dissimilarity of the marks simply outweighs the other relevant factors. *Kellogg Co. v. Pack'em Enterprises, Inc.*, 14 USPQ2d at 1550. In reaching this conclusion, we have carefully considered all of the evidence pertaining to the relevant *du Pont* factors, as well as all of the parties' arguments with respect thereto (including any evidence and arguments not specifically discussed in this opinion).

Dilution

In addition to its Section 2(d) claim, opposers have asserted a dilution claim. The Trademark Act provides for a cause of action for the dilution of famous marks. Sections 13 and 43(c) of the Trademark Act of 1946, 15 U.S.C. §§1063 and 1125(c).

The Trademark Act provides as follows:

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of

actual or likely confusion, of competition, or of actual economic injury.

Opposers contend that applicant's marks will "blur" the distinctiveness of opposers' HYLOFT mark. The Trademark Act defines dilution by blurring as follows:

"dilution by blurring" is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.³⁹

Our dilution analysis requires consideration of the following issues:

1. Whether opposers' HYLOFT mark is famous;
2. Whether opposers' HYLOFT mark became famous prior to applicant's use of its GORILLA LOFT mark; and
3. Whether applicant's GORILLA LOFT mark is likely to cause dilution by blurring the distinctiveness of opposers' HYLOFT mark.

A. The fame of opposers' mark.

Fame for likelihood of confusion and dilution is not the same. Fame for dilution requires a more stringent showing. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005); *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001). Because opposers were unable to prove that their mark was famous for purposes of likelihood of confusion, they are unable to prove that the mark is famous

³⁹ Section 43(c)(2)(B) of the Trademark Act of 1946, 15 U.S.C. §1125(c)(2)(B).

for purposes of dilution. Likewise, we are unable to determine when opposers' mark would have become famous.

On this record, opposers cannot prevail on their dilution claim because we have found that opposers have not met their burden of proving that their HYLOFT mark is famous for purposes of dilution or that their HYLOFT mark became famous prior to the filing date of applicant's application. Nevertheless, for purposes of completeness, we discuss dilution by blurring.

B. Dilution by blurring.

"Dilution diminishes the 'selling power that a distinctive mark or name with favorable associations has engendered for a product in the mind of the consuming public.'" *Toro Co. v. ToroHead Inc.*, 61 USPQ2d at 1182, quoting *Sally Gee, Inc. v. Myra Hogan, Inc.*, 699 F.2d 621, 624-25, 217 USPQ 658, 661 (2nd Cir. 1983). Dilution by blurring occurs when a substantial percentage of consumers, upon seeing the junior party's use of a mark on its goods [in this case GORILLA LOFT used in connection with shelving and storage racks], are immediately reminded of the famous mark [in this case HYLOFT] and associate the junior party's use with the owner of the famous mark, even if they do not believe that the goods come from the famous mark's owner. *Toro Co. v. ToroHead Inc.*, 61 USPQ2d at 1183.

The Board may look to all relevant facts in determining whether applicant's GORILLA LOFT mark will blur the distinctiveness of opposers' HYLOFT mark. The Trademark Act provides the following guidance:

In determining whether a mark or trade name is likely to cause dilution by blurring, the court may consider all relevant factors, including the following:

(i) The degree of similarity between the mark or trade name and the famous mark.

(ii) The degree of inherent or acquired distinctiveness of the famous mark.

(iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.

(iv) The degree of recognition of the famous mark.

(v) Whether the user of the mark or trade name intended to create an association with the famous mark.

(vi) Any actual association between the mark or trade name and the famous mark.

1. The degree of similarity between the mark or trade name and the famous mark.

For purposes of dilution, a party must prove more than confusing similarity; it must show that the marks are "identical or very substantially similar." *Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d at 1514, quoting *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d at 1183; see also *Citigroup, Inc. v. Capital City Bank Group, Inc.*, 94 USPQ2d 1645, 1666 (TTAB 2010). As the

Board explained in *Toro Co. v. ToroHead, Inc.*:

The test for blurring is not the same as for determining whether two marks are confusingly similar for likelihood of confusion purposes. "To support an action for dilution by blurring, 'the marks must be similar enough that a significant segment of the target group sees the two marks as essentially the same.'" *Luigino's, Inc.*, 170 F.3d at 832, 50 USPQ2d at 1051⁴⁰ (quoting 2 McCarthy on Trademarks and Unfair Competition, §24:90.1 (4th ed. 1998)). Therefore, differences between the marks are often significant. Mead Data (LEXUS for cars did not dilute LEXIS for database services).⁴¹

Toro Co. v. ToroHead, Inc., 61 USPQ2d at 1183 (TORO and ToroMR and Design are not substantially similar for dilution purposes).

In discussing likelihood of confusion, we found that the marks of the parties were not similar. Given that finding, we must also find that the marks are not substantially similar in the context of dilution. In fact, the dissimilarity of the marks outweighs all the other factors. *Cf. Kellogg Co. v. Pack'em Enterprises, Inc.*, 14 USPQ2d at 1550.

Based on the record before us, opposers have not demonstrated that the registration of applicant's GORILLA LOFT mark will dilute their HYLOFT mark by blurring.

⁴⁰ *Luigino's, Inc. v. Stouffer Corp.*, 170 F.3d 827, 50 USPQ2d 1047 (8th Cir. 1999).

⁴¹ *Mead Data Central, Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1065, 10 USPQ2d 1961 (2nd Cir. 1989).

Opposition No. 91187636

Decision: The opposition is dismissed with prejudice.