

**THIS OPINION IS NOT
A PRECEDENT OF
THE TTAB**

Hearing: May 30, 2013

Mailed: August 12, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Great Seats, Inc.

v.

Great Seats, Ltd.

Opposition No. 91189540
to application Serial No. 75733290

P. Jay Hines of Cantor Colburn LLP for Great Seats, Inc.

Adam M. Cohen and Sarah B. Yousuf of Kane Kessler PC for
Great Seats, Ltd.

Before Cataldo, Wolfson and Adlin,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Opposer, Great Seats, Inc., opposes registration of application Serial No. 75733290 for the mark GREAT SEATS (standard characters, "SEATS" disclaimed). Applicant, Great Seat, Ltd., filed the application on June 21, 1999 on the Principal Register, based upon its assertion of August 1, 1992 as a date of first use of the mark anywhere and in commerce, and with a claim of acquired distinctiveness under Trademark Act Section 2(f). The services are identified

therein as "arranging for ticket reservations for shows and other entertainment events," in International Class 41.

In its notice of opposition, opposer alleges that it has made prior use analogous to trademark use of GREAT SEATS, as well as common-law use of GREAT SEATS as a mark, in connection with ticket agency services for concerts, theatrical performances and sporting events; that its mark acquired distinctiveness prior to applicant's; and that as a result of the similarity between the parties' marks as applied to their respective services, confusion is likely among consumers as to the source of those services. In addition, opposer alleges that applicant's mark is highly descriptive of the recited services, and that its showing of acquired distinctiveness under Section 2(f) is insufficient.

In its answer, applicant denied the salient allegations of the notice of opposition.¹

Evidentiary Issue

On September 21, 2011, the Board issued an order finding that opposer's failure to supplement its response to applicant's interrogatory number 1 to disclose twenty-six potential witnesses was neither harmless nor substantially justified, and imposed an estoppel sanction against opposer

¹ Applicant also asserted numerous affirmative defenses. Certain defenses were stricken by a Board order issued on June 25, 2009. Applicant did not pursue the remainder at trial. Accordingly, they are deemed waived.

to the extent that opposer was not permitted to take the testimony of these witnesses.² *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323 (TTAB 2011). On April 5, 2012, opposer submitted the rebuttal testimony deposition of its owner/shareholder Enrique D. (hereinafter "Danny") Matta, introducing as evidence written statements from twenty-three of the same twenty-six individuals whose testimony was excluded in the Board's September 21, 2011 order, as well as four additional individuals not included in opposer's initial or pretrial disclosures.

On June 18, 2012, applicant filed a motion to strike the written statements, as well as Mr. Matta's rebuttal testimony to the extent that it pertains to those statements, on the grounds that by introducing written statements from twenty-three of the individuals whose testimony was precluded by the Board's order, opposer seeks to circumvent the Board's ruling therein. In addition, applicant seeks to strike the statements of the four additional individuals because they were never disclosed to applicant. Further, applicant argues that the entirety of opposer's testimony constitutes improper rebuttal, inasmuch as applicant's own testimony and evidence, including statements from third parties introduced by applicant, all

² That decision also provided, inter alia, that opposer may rely upon the testimony of an additional witness, Michael Kelly.

Opposition No. 91189540

are directed toward applicant's own use of its GREAT SEATS mark and opposer's rebuttal evidence is unrelated thereto.

Opposer, for its part, argues that applicant has known since the parties briefed their cross-motions for summary judgment that opposer would be relying upon such third-party statements. Opposer argues in addition that the Board's September 21, 2011 order quashed the testimony deposition of the twenty-six witnesses in question not for failure to name them in initial disclosures, but for failure to supplement written discovery; that, as a result (opposition to motion to strike, p. 2) "23 of the 26 individuals that provided written statements were properly disclosed to Applicant" inasmuch as opposer disclosed these individuals in its amended and supplemental pretrial disclosures. Opposer further argues (id.) that

Although generally in the context of limitations to discovery, the Board has a Goose-Gander Rule. A party will not be heard to contend what it does is proper when propounded by the party itself but improper when propounded by its adversary. TBMP § 402.01 and Note 9 thereto. Thus, in all fairness, Opposer should not be estopped from doing on a key issue virtually what Applicant has done.

Under the circumstances herein, where the case of Opposer is based on use analogous to trademark use, and oral evidence being the only means of demonstrating that use, Opposer maintains that the estoppel sanction as to the third party statements would be patently too strict and do a grave injustice to Opposer.

With regard to applicant's contention that the proffered testimony and evidence is improper rebuttal, opposer argues

(id.) that "Applicant relies on the scripted statements of 35 individuals first presented in response to Opposer's Motion for Summary Judgment" and that (id. at 3) "Opposer's introduction of 27 third party statements directly rebuts Applicant's claim that its mark acquired distinctiveness prior to that of Opposer" and thus is proper rebuttal. Finally, opposer argues that to the extent applicant relies in its trial brief upon the third-party statement of Mr. Glen Melcher, submitted with the rebuttal testimony of Mr. Matta, applicant has waived its right to object to the introduction of these statements.

In reply, applicant argues that the third-party statements upon which it relies were submitted by stipulation of the parties, whereas the statements submitted by opposer with its rebuttal testimony were precluded as an estoppel sanction issued by the Board. As a result, applicant argues (reply in support of motion, p. 2) "the Board's general 'Goose-Gander Rule' cannot serve as a basis for disregarding a specific ruling of the Board imposing a sanction on Opposer." Applicant argues in addition that because opposer is required to prove priority, including the prior acquired distinctiveness of GREAT SEATS in connection with its services, the third-party statements submitted with Mr. Matta's rebuttal testimony go to opposer's case in chief, and not to rebut applicant's evidence of acquired

distinctiveness. Finally, applicant argues that it relies in its brief not on the statement of Mr. Melcher, which is part of the evidence it seeks to strike, but rather its own cross-examination of Mr. Matta.

We note initially that in our September 21, 2011 order, we declined

to quash the notice of testimony deposition of Mr. Kelly or the twenty-six other new potential witnesses named in opposer's pretrial disclosures and exclude their testimony based on opposer's failure to name them in initial disclosures.

Great Seats Inc. v. Great Seats Ltd., 100 USPQ at 1326.

Rather, we found that

Opposer's failure to name Mr. Kelly until service of its original pretrial disclosures more than a month after the close of discovery and failure to name the twenty-six additional potential witnesses until service of opposer's amended and supplemental pretrial disclosures more than seven months after the close of discovery was neither harmless nor substantially justified. In view thereof, the Board finds that it is appropriate to apply the estoppel sanction. Applicant's motion to quash and to exclude testimony is granted to the extent that opposer may not take testimony of the twenty-six potential witnesses that were first disclosed in opposer's February 2011 amended and supplemental pretrial disclosures. However, opposer may rely on the testimony of Michael Kelly, who was first disclosed in opposer's initial pretrial disclosures on August 9, 2010, provided that applicant has an opportunity to take Mr. Kelly's discovery deposition prior to his appearance for a testimony deposition.

Id. at 1328. Thus, while the prohibition against the testimony of the twenty-six individuals named in its amended and supplemental pretrial disclosures resulted from its

"failure to supplement discovery," we nonetheless found that the estoppel sanction was justified due to opposer's "correspondingly late disclosures of these witnesses." *Id.* As a result, we disagree with opposer's position that the witnesses were properly or timely disclosed to applicant. However, regardless of the precise reason for the exclusion of the testimony of these witnesses, the September 21, 2011 order unequivocally estops opposer from taking their testimony.

Opposer argues (brief, p. 18) that

these third parties have not testified. They have provided third party statements very similar to the ones relied upon by the Applicant, albeit in their words and Mr. Matta has verified how and when he knew these people and their first-hand knowledge of him and his business.

In other words, despite being estopped by the Board's September 21, 2011 order from taking their *oral* testimony, opposer has attempted to introduce the *written* statements of twenty-three of the same individuals, on the same subject matter that would have been encompassed by their oral testimony, namely, use by Mr. Matta and others of the term "Great Seats" to identify him and his activities.³

³ Applicant's Interrogatory No. 1 reads as follows: Identify each person having firsthand knowledge of Matta being known as "GREAT SEATS" at any time during the period from January 1, 1978 to January 1, 1993, and for each person identified, describe his/her relationship to Matta, both currently and over said time period.

In its response, opposer interposed objections and identified "Mr. Tim Lee, a long time acquaintance" and "Mr. Donald Phillips, a long time acquaintance."

Opposition No. 91189540

Opposer's introduction of these statements, from witnesses whose testimony clearly was prohibited, and Mr. Matta's testimony with regard thereto, exalts form over substance and violates the Board's September 21, 2011 order. Whether written or oral, the substance of these witnesses' statements remains the same. In addition, the introduction of the statements of the additional four individuals not disclosed by opposer clearly is not permitted.

We are not persuaded by opposer's argument that its submission of these statements is proper because applicant was on notice that opposer would be relying on such statements and that the individuals in question were eventually disclosed to applicant. Even if true, the testimony of these individuals, and their equivalent written statements, is prohibited by opposer's conduct as discussed in the Board's September 21, 2011 order. As a result, applicant's knowledge of these individuals does not compel a different result. We further are unpersuaded by opposer's

In its initial disclosures, opposer indicates that only Mr. Matta "may testify regarding the history of Great Seats, Inc., the nature of it's business, the history and use of the GREAT SEATS mark, website screen shots and information regarding the GREATSEATS.COM website, channels of trade, early use of the designation GREAT SEATS by the public, early advertising on the part of Mr. Matta's business, and his decision to adopt the designation as his business name."

In its amended pretrial disclosures, opposer indicates with regard to the originally disclosed and additional witnesses that "The foregoing witnesses may testify regarding their first hand knowledge of the appellation GREAT SEATS in connection with the sales of tickets to entertainment and sports events by Mr. Matta

assertion of the Board's so-called "Goose-Gander Rule" as applied to discovery matters and discussed in TBMP § 402.01 (2013), and authorities cited in fn. 9. Opposer is correct in observing that a party generally will not be heard to complain that discovery is excessive when propounded by its opponent, but not by itself. See *id.* However, in this case, applicant introduced into evidence a number of third-party statements by stipulation of the parties to this proceeding. Such evidentiary submission by applicant does not, by itself or viewed in the totality of the circumstances of this case, justify opposer's submission of evidence substantially identical to testimony that was prohibited by Board order.

Finally, we note opposer's argument that preclusion of this evidence is too strict a result and works a grave injustice upon opposer. Nonetheless, we are not persuaded that this panel should disturb the September 21, 2001 order or interpret it in such a way as to allow the evidentiary submission in question. Almost by definition, any application of the estoppel sanction resulting in the exclusion of potentially outcome-determinative evidence could be said to work a "grave injustice" to the estopped party, but if that was a ground for ignoring or overruling a Board sanctions order, the Board's discovery and pretrial

and the level of recognition on the part of the public of Mr.

Opposition No. 91189540

Rules would become ineffective at best, with a corresponding negative impact on the fairness, predictability and cost of Board proceedings.

We further agree with applicant that the twenty-seven third-party statements and Mr. Matta's rebuttal testimony with regard thereto constitute improper rebuttal. As plaintiff in this proceeding, opposer must demonstrate that it has made prior use analogous to trademark use and/or common law trademark use of the designation GREAT SEATS. The third-party statements and Mr. Matta's rebuttal testimony regarding such statements go to opposer's assertions regarding its prior use of such designation, rather than to rebut applicant's showing. Again, we are not persuaded that simply because applicant submitted third-party statements about applicant and its use of the designation GREAT SEATS as a mark, opposer's submission of statements regarding opposer's use thereof somehow rebuts them rather than proving opposer's case in chief on issues in dispute in this proceeding.

In view thereof, we find that opposer's submission of twenty-seven third-party statements, and Mr. Matta's rebuttal testimony concerning such statements, both violates the Board's September 21, 2011 order and constitutes improper rebuttal. As a result, such statements, and Mr.

Matta as GREAT SEATS."

Matta's corresponding testimony, have been given no consideration. Any discussion in either party's brief regarding such statements and testimony similarly has been given no consideration.

The Record

By rule, the record in this case consists of the pleadings and the file of applicant's involved application. In addition, pursuant to Trademark Rule 2.123(b) the parties stipulated to the use in this proceeding of materials from prior Cancellation No. 92032534, involving the parties herein. The parties further stipulated that evidence submitted by opposer in connection with its notice of reliance, exhibits A - J, shall be deemed admissible for trial and of record; exhibits and evidence submitted in connection with applicant's response to opposer's motion for summary judgment and cross-motion for summary judgment, exhibits 1 - 25, shall be deemed admissible for trial and of record, and that all documents produced by the parties in discovery in the cancellation and all evidence submitted as exhibits to opposer's notice of reliance and applicant's summary judgment brief shall be deemed authentic.⁴

Pursuant to the parties' stipulation, during its assigned testimony and rebuttal testimony periods, opposer

⁴ The Board commends the parties for utilizing such evidentiary stipulations and ACR type efficiencies. See TBMP § 705 (2013) and authorities cited therein.

Opposition No. 91189540

submitted from the prior cancellation proceeding:
applicant's answers to written discovery; opposer's answers to written discovery; portions of the discovery deposition and testimony of its shareholder Danny Matta and corporate counsel Steven H. Oram; the 1999, 2005 and 2009 declarations of Danny Matta; and excerpts from the application file history for opposer's prior, cancelled, Registration No. 2339519. Opposer further submitted a notice of reliance upon the discovery deposition of applicant's principal, Mr. Gary Shapiro; printouts from the internet home pages of the parties' websites; the statements of third parties Mr. Tim Lee and Mr. Donald Phillips; the first pages of opposer's 1990 and 1991 S Corporation income tax returns; advertisements from New York magazine; the testimony of Tim Lee and Donald Phillips; and the rebuttal testimony of Mr. Matta, except as the portions thereof excluded above.

Applicant, for its part, submitted from the prior cancellation proceeding: various exhibits from both party's notices of reliance; the Board's decision in that case, cancelling opposer's registration; and the discovery depositions of Danny Matta and Steven H. Oram. Applicant further submitted the testimony of Gary Shapiro, Danny Matta, Tim Lee and Donald Philips; printed advertisements and promotional materials of both parties.

Opposer and applicant filed main briefs and opposer filed a reply brief. In addition, counsel for the parties presented arguments at an oral hearing before this tribunal on May 30, 2013.

Opposer's Standing

Opposer, through its testimony and related exhibits, has established that it uses the mark GREAT SEATS in connection with ticket agency services for concerts, theatrical performances and sporting events. Opposer has asserted a likelihood of confusion claim directed toward applicant's use of an identical mark for services that are essentially identical, namely, "arranging for ticket reservations for shows and other entertainment events." Thus, opposer has demonstrated it possesses a real interest in this proceeding beyond that of a mere intermeddler, and a reasonable basis for its belief of damage. *See Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d 1023 (Fed. Cir. 1999). *See also Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). We find, therefore, that opposer has proven its standing.

We note in addition that applicant does not dispute opposer's standing.

Likelihood of Confusion

As discussed above, the parties are using identical marks to identify essentially identical services. Opposer

asserts (brief, p. 1) that "the parties agree that there is a likelihood of confusion between their identical marks for identical services." Applicant, for its part, asserts (brief, p. 3) that "in this proceeding involving parties offering identical services, there is no dispute that there is a likelihood of confusion between their identical GREAT SEATS marks."

We agree. There is no question that a likelihood of confusion exists between the parties' use of identical marks for services that the parties acknowledge are identical. There is no evidence of record that any of the *du Pont* factors favor a finding of no likelihood of confusion under these circumstances. We turn then to the issue of priority.

Priority of Use

Priority is the key issue in this case. We begin by addressing applicant's position that opposer must prove priority by clear and convincing evidence. In a case involving common law rights, the Federal Circuit has held that "the decision as to priority is made in accordance with the preponderance of the evidence." *Hydro-Dynamics Inc. v. George Putnam & Company Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987). See also *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1929 (TTAB 2006) ("In order to establish priority based on common law rights, opposer's burden is to demonstrate by a

Opposition No. 91189540

preponderance of the evidence proprietary rights in TUNDRA and TUNDRA SPORT for clothing prior to June 1, 1998, the filing date of applicant's intent-to-use application").

Opposer is not asserting ownership of a pending application, and thus is not seeking to allege an earlier date of use than the one set forth in such an application. *Hydro-Dynamics*, 1 USPQ2d at 1774 ("Where an applicant seeks to prove a date earlier than the date alleged in its application, a heavier burden has been imposed on the applicant than the common law burden of preponderance of the evidence"). "When a party seeks to carry the date of first use back to a date prior to that stated in the application, the proof of an earlier date must be by clear and convincing evidence." *American Hygienic Laboratories Inc. v. Tiffany & Co.*, 12 USPQ2d 1979, 1984 (TTAB 1989). This is because of the change of position from one "considered to have been made against interest at the time of filing of the application." *Hydro-Dynamics*, 1 USPQ2d at 1773. In this case, opposer is relying only upon common-law use of the designation GREAT SEATS as a mark as well as use analogous to trademark use thereof. Therefore, the question is whether opposer has shown that it has established its priority in the mark GREAT SEATS in the United States before applicant by a preponderance of the evidence.

Opposition No. 91189540

A party opposing registration of another's mark on the basis of likelihood of confusion with its own unregistered mark must establish that the unregistered mark is distinctive of its goods or services either inherently or through the acquisition of secondary meaning. See *Towers v. Advent Software, Inc.*, 913 F.2d 942, 945, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990); and *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43-45 (CCPA 1981).

As discussed above, both parties use the designation GREAT SEATS for arranging ticket reservations or ticket agency services. As further noted above, applicant seeks registration of the involved application with a claim of acquired distinctiveness under Section 2(f) and a disclaimer of "SEATS." "Where an applicant seeks registration on the basis of Section 2(f), the mark's descriptiveness is a nonissue; an applicant's reliance on Section 2(f) during prosecution presumes that the mark is descriptive." *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009). Opposer's prior, cancelled, Registration No. 2339519 for the mark GREAT SEATS INC. and design also was registered with a claim of acquired distinctiveness under Section 2(f) with a disclaimer of "INC." In addition, both parties acknowledge in their briefs that the term GREAT SEATS is not inherently distinctive of their services. Therefore, we find the

Opposition No. 91189540

designation GREAT SEATS not to be inherently distinctive, but rather to convey information about the nature of opposer's and, for that matter, applicant's services, namely, that they provide great seats at concerts, shows and sporting events. Thus, GREAT SEATS is merely descriptive of the parties' services under Section 2(e)(1).

Under the rule of *Otto Roth*, having determined that GREAT SEATS is not inherently distinctive of opposer's ticket agency services, we must review the record to determine whether or not opposer has demonstrated that such term has acquired distinctiveness as a source-indicator for its services and, if so, when. In this regard, we note that the degree of acquired distinctiveness that must be shown varies directly with the degree of descriptiveness of the mark. *In re Bongrain International (American) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727, 1728 (Fed. Cir. 1990); and *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988). *See also* *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759 (2d Cir. 1976). Based on the record in this case, we find that GREAT SEATS, while acknowledged by the parties to be merely descriptive of the services, is not so highly descriptive thereof that opposer must meet a heightened showing of acquired distinctiveness.

We turn then to the evidence of record to determine opposer's priority date. Testimony and documentary evidence establishes that opposer used GREAT SEATS as a service mark in association with common-law ticket agency services as early as 1995.⁵ Applicant does not dispute this date.

However, opposer also argues that the evidence of record establishes that it has made prior use analogous to trademark use. Specifically, opposer argues (brief, p. 4) that it

has now made of record testimony and third party statements establishing not only that a significant segment of the purchasing public in the Baltimore/Washington area knew Mr. Matta as "Great Seats" long before Applicant's alleged date of first use of August 1, 1992, but that Mr. Matta himself answered to the nickname, used the nickname and referred to himself and his business as such from approximately 1980 forward.

Opposer further argues (brief, p. 16) that its

corroborated testimony confirms that the appellation GREAT SEATS acquired distinctiveness and secondary meaning referring to Mr. Matta, the founding principal of Opposer, and his ticket broker business at least as early as 1980.

In support of this argument, opposer made of record the testimony depositions and declarations of Mr. Matta, and the testimony depositions of Mr. Lee and Mr. Phillips. The following excerpts are illustrative:

Q. How did you come to adopt the name Great Seats?

⁵ Matta testimony at 36; Applicant's Notice of Reliance, Exhibits F, G.

A. I was always called Great Seats. When I started in this business in 1978, '79, there was a lot of selling out in front of the buildings. And back then the computer programs used to do a test run, because computers were new in '78, '79, as Ticket Master was. And I always had the first couple of spots. I would tie them down at the Capital Center, which was our local arena which is gone now, and I always had the first five rows. So, people, I remember people coming, I used to sell out in front of the building a lot. I remember people yelling across the lot, hey, Great Seats, Great Seats. It was almost what I was known as was Great Seats. I didn't start in sports. I started completely in concerts, now it is everything. But, when you started in concerts everything was about having the first few rows. And I was always know [sic] for all the shows.

Q. So, you were known as Great Seats even before you started advertising as Great Seats.

A Oh, yes. I never thought of it, you know, but, yes.

Q. Even before the first refrigerator magnet distribution?

A. Even before I had Wholesale Tickets. I date back, people used to call me Great Seats.

Q. And Wholesale Tickets was the late '80's.

A. The paperwork says '90, and I thought it was '89. But the paperwork says '90.

Q. So, even though at that time you were incorporated as Wholesale Tickets, people knew you as Great Seats?

A. I carried a nickname of Great Seats I never thought of naming the company Great Seats, or I would have done it right from the beginning, because it doesn't sound like a company name. It didn't at first, when I first went Wholesale Tickets, and it just didn't sound like a company

name or I would have called myself Great Seats from the very beginning.⁶

A. I was called "Great Seats" before 1990.

Q. What do you mean by that?

A. I've always been known as "Great Seats."

Q. Could you explain that, please?

A. "Great Seats" has been a term that's been affiliated with me since I first started in 1978 because I always had great seats, and everybody knew that. ...

Q. Why did you pick the Great Seats mark?

A. It's me.

Q. It's you. And you've indicated, it tells members of the public that they can get "great seats"?

A. Well, it tells members of the public that it's me.

Q. That it's you?

A. That - and they know they can trust where to get great seats

I've always had the title, being called "Great Seats." Since I first camped out for concerts in 1978, I've been called "Great Seats."⁷

⁶ Opposer's Notice of Reliance, Exhibit H, 2004 Deposition of Danny Matta, p. 293-5.

⁷ Opposer's Notice of Reliance, Exhibit H, 2006 Matta Testimony, p. 30-31, 54.

Q. Do you recall when you first heard the term Great Seats in connection with Danny Matta?

A. Not an exact date, but it was back in the day. It would have been in the late seventies, going to concerts and selling tickets out front.

Q. What are the circumstances of how that came up?

A. Danny would sit there. He'd always get the, I don't know how he did it, but he always got the seats up front, and we'd be out in the street doing a Statue of Liberty play hollering, "Great seats. Who needs great seats?" And then it kind of evolved that occasionally, he would be over one entrance and I'd be at another entrance and some of the customers would come up and say, "Where's Great Seats?" And I'd say, "He's over at Stars and Stripes." Because I'd be over like at the Capital entrance, and he'd be over at Stars and Stripes.

Q. What is Stars and Stripes?

A. I'm sorry. That's -- there was four entrances at the old Capital Centre. Stars and Stripes was where the main box office was.

Q. These were not people that you knew that came up to you, these were strangers looking for tickets?

A. Yeah. Because Danny had done the street a lot more than I had at that point and had more regular customers than I did.

Q. I would like to show you the one exhibit I have today and see if you remember this document.

A. Yes. It's an e-mail I wrote for Danny, a letter to him.

Q. Is that dated? Is there any date?

A Yeah. Monday, January 18th, 2010.

Q. Would you mind reading it out for us? Take your time, but just read the statement.

A. I have known Danny Matta for 31 years. In 1979 I went to the Capital Centre in Landover, Maryland

to wait in line for tickets to a Boston concert that was going on sale there. Danny was already there and first in line. Over the next few years, I camped out for many concerts there and got to know him very well. He was always there and one of the first three people in line. The first two rows were always held back and sold at the arena. Danny was known as Great Seats by everyone because he always had the seats up front at every show. He has been Great Seats for as long as I have known him.

Q. Do you still stand by that statement today?

A. Yes, I do.⁸

Q. When did you first hear the term Great Seats in connection with Danny Matta?

A. Somewhere around 1979, 1980, because he always had great seats. We knew where to go to get great seats, and we were going to help him camp and get great seats

Q. How widespread would you say was this association of the phrase Great Seats with Danny?

A. I would say it was fairly widespread. I mean, it was a term we associated with him, friends, and then people, when we were out places, going to shows, you heard it.

Q. Did the phrase become a nickname for Danny Matta?

MR. COHEN: Objection. Leading question.

THE WITNESS: Yeah. I would say it, you know, when I think about it, yeah, I think about Great Seats and Danny. They're almost synonymous, if that's the right word, but they sound together.

FURTHER EXAMINATION BY COUNSEL FOR OPPOSER BY MR. HINES:

⁸ Lee Testimony, p. 7-9; Exhibit 1.

Q. Mr. Phillips, I just have a couple. Would you say that an appreciable number of your high school classmates knew Danny Matta as Great Seats?

A. Yes.

Q. With respect to your firsthand personal observations as a concert goer in the 1980s in the D.C. region, would you say that an appreciable number of concert goers knew Dan Matta as Great Seats?

A. Yes.⁹

It is settled that a party may establish prior rights in a mark through use analogous to trademark use, such as trade name use, which creates a public awareness that the designation serves as a trademark and identifies the party as a source. *TAB Sys. v. PacTel Teletrack*, 37 USPQ2d 1879, 1882 (Fed. Cir. 1996), *vacating Pac Tel Teletrack v. TAB Sys.*, 32 USPQ2d 1668 (TTAB 1994) (such use must be "sufficiently clear, widespread and repetitive to create the required association in the minds of potential purchasers between the mark as an indicator of a particular source and the service to become available later."); and *American Stock Exchange, Inc. v. American Express Company*, 207 USPQ 356, 364 (TTAB 1980) ("use of a mark in a manner analogous to trademark use, such as use in advertising, use as a grade mark, use as the salient or distinguishing feature of a trade name, use of an acronym or of the initial letters of a corporate name, etc., may be considered in computing the

length of use for determining ownership of a mark."). To establish trade name identification, an "organization need only to have used a name or acronym in a manner that identifies the company by that name or acronym to the public ... no particular formality of adoption or display is necessary to establish trade name identification." *Martahus v. Video Duplication Servs., Inc.*, 27 USPQ2d 1850 (Fed. Cir. 1993).

In this case, however, there is no documentary evidence that opposer or Mr. Matta used the designation GREAT SEATS prior to 1995.

Q: Now, isn't it a fact that in neither the cancellation proceeding or this proceeding, you produced a single piece of paper that was created before 1995 to show that you were known as Great Seats.
Correct?

A: Correct.¹⁰

Simply put, the testimony and evidence adduced by opposer fails to support a finding that a clear or widespread association exists between "Great Seats" and opposer or Mr. Matta in the minds of the purchasing or potential purchasing public prior to opposer's first use of GREAT SEATS as a trademark in 1995.

Nonetheless, this tribunal has held that in certain limited circumstances a nickname or a trade name for a

⁹ Phillips Testimony, p. 6-8, 17.

¹⁰ Matta Deposition, p. 36.

Opposition No. 91189540

product or service may acquire trademark significance when the public has come to know and use it as such "even if the company itself has made no use of the term." *American Stock Exchange*, 207 USPQ at 364 ("AM EX CO" protectable abbreviation for American Express Company). See also *Big Blue Products, Inc. v. International Business Machines Corp.*, 19 USPQ2d 1072 (TTAB 1991) ("Big Blue" could be protectable nickname for IBM); *VolkswagenwerkAG v. Advance Welding & Mfg. Corp.*, 193 USPQ 673 (TTAB 1976) (petitioner acquired a proprietary right and hence a protectable right in BUG as an associative term for its vehicles notwithstanding that it never used BUG alone in a trademark sense); and *Peiper v. Playboy Enterprises, Inc.*, 179 USPQ 318 (TTAB 1973) ("Bunny Club" protectable nickname for Playboy's clubs).

In this case, opposer's evidence of public use of the designation GREAT SEATS as a nickname for Mr. Matta to designate his services falls short for several reasons. First, it is not at all clear from opposer's testimony and evidence whether the appellation "Great Seats" was applied to Mr. Danny Matta as a nickname, or simply described him as someone "to go to get great seats," or merely described the seats he obtained for resale to concerts. Second, and more importantly, there is insufficient evidence that a sufficient level of public awareness was created such that

Opposition No. 91189540

the nickname operated as a source identifier for the services rendered by Mr. Matta. Specifically, while the testimony and evidence suggests that Mr. Matta was known as someone who had tickets for "great seats" for resale at concerts and was, on occasion, referred to by concert goers as "Great Seats" as a result of his possession of such tickets, the record is unclear whether the public called him "Great Seats" in a manner that created more than a de minimus public association of the term with the services offered by Mr. Matta. *Cf. Pieper*, 197 USPQ at 320 (BUNNY CLUB being used in newspaper articles synonymously with PLAYBOY CLUB and such use "was not a de minimis use but, as the record shows, quite extensive.").

In the *Volkswagenwerk AG* case relied upon by opposer, the plaintiff therein "consistently used the terms 'BUG' and 'BEETLE' in [promotional] material as terms of reference for its vehicles." 193 USPQ at 675. That is to say, the record in that case clearly supported a finding that the term "BUG" identified certain of plaintiff's vehicles "as a result of [plaintiff's] long and extensive use in its advertising and material and many years use in a similar manner in the trade and by the news media, ... notwithstanding that [plaintiff], insofar as this record shows, has never used "BUG" alone in a trademark sense." *Id.*

Finally, opposer observes (brief, p. 3-4) that

Opposition No. 91189540

In prior Cancellation Proceeding No. 92032524 the Board made a finding that Mr. Matta "eventually acquired the nickname 'Great Seats' due to his ability to obtain and sell 'great seats' to entertainment events." *Great Seats*, 84 USPQ2d at 1237. In its decision of May 10, 2010 in the instant proceeding on the cross-motions for summary judgment, the Board noted that Opposer had not established when its president acquired the nickname "Great Seats" or to what extent the public was aware of the nickname.

However, our earlier findings did not indicate that Mr. Matta's acquisition of the nickname "Great Seats" amounted to use of GREAT SEATS in a manner analogous to trademark use, or establish when the acquisition of rights in GREAT SEATS as a mark due to its public use as a nickname occurred. For the reasons discussed above, we find that even if we accept that Mr. Matta acquired the nickname "Great Seats" and that his acquisition thereof inures to the benefit of opposer, opposer's evidence is insufficient to show that opposer acquired such proprietary right prior to applicant, or that GREAT SEATS acquired distinctiveness before applicant's priority date.

Opposer urges that we should not consider its evidence piecemeal, but "should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use." *West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994). In this case, viewing the evidence as a

Opposition No. 91189540

whole, we find that the earliest date of use upon which opposer may rely for the purposes of priority is 1995.

Now that we have determined opposer's priority date, we turn to applicant's date of actual or constructive first use. Applicant filed its involved application on June 21, 1999. Thus, it is entitled to rely on the filing date of this application as its constructive use date. *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991) ("[T]here can be no doubt but that the right to rely upon the constructive use date comes into existence with the filing of the intent-to-use application and that an intent-to-use applicant can rely upon this date in an opposition brought by a third party asserting common law rights").

In addition, applicant has asserted a date of first use in commerce of August 1, 1992, and submitted testimony and evidence that shows that applicant used its mark as early as 1992 and acquired distinctiveness as early as 1993 or 1994. Applicant's evidence includes the following:

Applicant announced its formation and services in weekly display ads appearing in Women's Wear Daily beginning the Wednesday after applicant was formed and continuing for the following consecutive six weeks.¹¹

¹¹ Shapiro Testimony. P. 9, 13; Ex. A2.

Opposition No. 91189540

Applicant's principal threw a party in the Hamptons to announce applicant's formation, and distributed at that party a business card, which was made to look like a ticket.¹² The ticket-shaped business card has been in use consistently from 1992 to the present.¹³

Beginning in November 1992, applicant began advertising on a regular basis in New York Magazine. In applicant's advertisement which appeared in the November 30, 1992 and December 21-28, 1992 issues of New York Magazine, "Great Seats Ltd." is set out as the lead line in prominent type.¹⁴

Applicant's advertisements in this same format appeared in subsequent issues of New York Magazine in 1993.¹⁵

Applicant continued to advertise its services under its GREAT SEATS mark in 15 to 20 issues of New York Magazine per year from 1992 through 2002.¹⁶

Applicant also has advertised in other publications including The Wall Street Journal, The Washington Post, and Hamptons Magazine.¹⁷

Beginning in 1992-1993, applicant also began sending monthly brochures to all of its customers.¹⁸

¹² *Id.* at 9-10; Exs. A12, A13.

¹³ *Id.* at 19-20.

¹⁴ Applicant's Notice of Reliance at Ex. A3.

¹⁵ *Id.*

¹⁶ Shapiro Testimony, p. 15-16; Applicant's Notice of Reliance at Exs. A3 and A4.

¹⁷ Shapiro Testimony, p. 14, 18-20, Applicant's Notice of Reliance Exs. A5 and A6.

Opposition No. 91189540

Applicant's annual ticket sales under its GREAT SEATS mark, and its annual advertising and promotional expenses, have been substantial, increasing from over \$1 million in sales in 1993 to over \$9 million in 2008, and from \$66 thousand in advertising and promotions in 1997 (the first year for which such figures are available) to \$104 thousand in 2008.¹⁹

Thirty-six individuals signed form statements indicating that they have been customers of applicant since 1992 and recognized GREAT SEATS as identifying applicant's applied-for services.²⁰

Based upon the foregoing testimony and documentary evidence, we find that applicant commenced use of its GREAT SEAT mark in 1992. We further find that as a result of evidence of its promotional and advertising efforts and customer recognition, applicant's GREAT SEATS mark acquired distinctiveness as a source identifier for applicant's services as early as 1993 or, at the latest, 1994.

As discussed above, the earliest date opposer made use of GREAT SEATS as a mark is 1995, and opposer has not proven an earlier priority date through application of the analogous or nickname use doctrines. Opposer's first use of

¹⁸ Shapiro Testimony, p. 21, Applicant's Notice of Reliance Exs. A7, A8 and A9.

¹⁹ Notice of Reliance at Ex. A17.

²⁰ Shapiro Testimony, p. 25, 30-31, Exs. A10, A16.

Opposition No. 91189540

GREAT SEATS as a common-law mark is subsequent to applicant's date of first use as well as the date on which GREAT SEATS acquired distinctiveness as a mark identifying applicant as the source of its recited services. As a result, opposer has failed to prove priority of use of GREAT SEATS and cannot prevail on its opposition to the applied-for mark on the ground of priority and likelihood of confusion.

Applicant's Showing of Acquired Distinctiveness

Finally, opposer argues that applicant made an insufficient showing of acquired distinctiveness under Trademark Act Section 2(f) during prosecution of its involved application. Opposer's arguments (brief, p. 19) are reproduced below:

Applicant claims that its mark acquired distinctiveness based on five year's use immediately preceding October 24, 2008, the date of amendment to enter a Section 2(f) claim. See the Request for Reconsideration after Final Action refusing registration pursuant to Section 2(e)(1) of the Trademark Act. In the course of registering its Word & Design mark, the subject of Cancellation No. 92032524 and part of the record herein by stipulation, Opposer was required to put on actual evidence of acquired distinctiveness for that specific mark from the claimed use date of March 1, 1997 to the submission date of November 1, 2000. A key component of that submission was Mr. Matta's Declaration, signed on March 23, 1999, showing rapid escalation of sales and advertising expenditures over a period of time and putting on other evidence of acquired distinctiveness. Opposer's Notice of Reliance, 1999 Declaration of Danny Matta, Exhibit I. Opposer maintains that, due to the nature of the mark, Applicant should also have likewise been required to submit actual

evidence of acquired distinctiveness rather than merely relying on the Section 2(f) presumption based on five years in commerce alone.

These allegations address an ex parte examination issue, namely, whether the examining attorney should have required additional evidence of acquired distinctiveness in support of applicant's amendment to seek registration under Section 2(f), and fail to state a proper ground for relief in an inter partes proceeding. See *Phonak Holding AG v. ReSound GmbH*, 56 USPQ2d 1057 (TTAB 2000) (failure to enforce requirement of filing of foreign registration is examination error and not a ground for opposition); and *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989) (the issue of the adequacy of the specimens is solely a matter of ex parte examination).

Fairness dictates that the ex parte question of the sufficiency of the Section 2(f) showing during examination not be a ground for opposition or cancellation. Opposer does not allege that applicant failed to comply with any examination requirements. Had the Examining Attorney rejected the Section 2(f) showing during examination, applicant would have had an opportunity to submit evidence in support thereof similar to the evidence submitted herein. See *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355 (TTAB 1989). "It would be manifestly unfair to penalize applicant for non-compliance with a requirement

Opposition No. 91189540

that was never made by the Examining Attorney." *Saint-Gobain Abrasives, Inc. v. Unova Industrial Automation Systems, Inc.*, 66 USPQ2d 1355, 1358 (TTAB 2003). In any event, and as discussed above, applicant has submitted evidence of acquired distinctiveness in the instant proceeding, and opposer does not argue that such evidence is insufficient.

DECISION: Based upon our findings above, the notice of opposition on the ground of priority and likelihood of confusion, and the sufficiency of applicant's Section 2(f) showing, is dismissed.