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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: January 18, 2012

Opposition No. 91195961

ELVH, Inc.

v.

Kelly Van Halen

Before Quinn, Zervas, and Cataldo,
Administrative Trademark Judges

By the Board:

Kelly Van Halen ("applicant") seeks to register the mark KELLYVANHALEN in standard character form for "armoires; chairs; dining tables; end tables; entertainment centers; pillows; sofas; tables; upholstered furniture" in International Class 20; "bed blankets; blanket throws; children's blankets; lap blankets" in International Class 24; "bathing suits; blouses; coats; coverups; dresses; hats; jackets; jeans; leggings; lounge pants; pajamas; pants; ponchos; robes; scarves; shirts; sweaters; vests" in International Class 25; "building construction; construction management; construction of environmentally responsible residential real property; custom construction and building renovation; housing services, namely, repair, improvement, and construction of residential real property; installation and maintenance of solar thermal installations; residential

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and building construction consulting" in International Class 37; and "design of specialty interior and exterior environment settings; interior design services; interior design services including space planning, furniture selection, material and surface selection" in International Class 42.¹

In an amended notice of opposition, ELVH, Inc. ("opposer") opposes registration of applicant's mark on ground of priority and likelihood of confusion with its previous registered VAN HALEN marks for a variety of goods and services in International Classes 9, 15, 16, 25, and 41, including VAN HALEN in typed form for "clothing namely, shorts; caps; hats; jerseys; blouses; shirts; tank-tops; T-shirts, namely long sleeve and short sleeve T-shirts; polo shirts; woven and knit shirts; thermal shirts; sweaters; jogging and warm-up suits; sweat shirts; sweat pants; sweat bands; headbands; bandanas; jeans; pants; ties; jackets; gloves; scarves; neckwear" in International Class 25.² In

¹ The goods in International Classes 20, 24, and 25 are the subject of application Serial No. 77919644, and the services in International Classes 37 and 42 are the subject of application Serial No. 77919645. Both applications were filed on January 25, 2010, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b).

² Such mark is the subject of Registration No. 2866540, issued July 27, 2004, Section 8 affidavit accepted, Section 15 affidavit acknowledged. Opposer's three remaining pleaded registrations are:

Registration No. 2853393 for the mark VAN HALEN in typed form for "printed matter for publicity and promotional material,

the amended notice of opposition, opposer also includes a dilution claim and a claim that applicant did not have a bona fide intent to use her marks in commerce when she filed her involved intent-to-use applications. Applicant, in her answer, denies the salient allegations of the amended notice of opposition.

namely, posters; fold-out poster books; postcards; mounted and unmounted photographs and photographic prints; newsletters; stickers; calendars; decals and temporary tattoos; printed concert tickets; printed backstage passes; trading cards; books, trivia books, tour books, encyclopedias, comic books, picture books, magazines, all in the field of music and entertainment; tablature books; sheet music books; book covers" in International Class 16, issued June 15, 2004, Section 8 affidavit accepted, Section 15 affidavit acknowledged;

Registration No. 2868311 for the mark VAN HALEN in typed form for "Entertainment services, namely live performances and appearances, and live performances and appearances featuring prerecorded music by a vocal and instrumental group; fan club services; providing a website featuring entertainment information, namely reviews, articles, interviews, music videos, music charts, personal biographies, diaries, information on music instruments, tour dates, games, trivia, access to memorabilia, photographs, video clips, and audio clips, all available via a global computer network" in International Class 41, issued August 3, 2004, Section 8 affidavit accepted, Section 15 affidavit acknowledged; and

Registration No. 3701926 for the mark VH VAN HALEN and design in the following form,



for "musical sound recordings, [and] musical video recordings" in International Class 9; "musical instruments, musical instruments accessories, namely, guitar picks" in International Class 15; stickers; tablature books; sheet music books" in International Class 16; "clothing, namely, caps; hats; T-shirts" in International Class 25; and "entertainment services, namely, live performances and appearances by a vocal and instrumental group, and live performances and appearances featuring prerecorded music by a vocal and instrumental group; fan club services; providing a website featuring entertainment information, namely, reviews, articles, interviews, music videos, music charts, personal biographies, diaries, information on music instruments, tour dates, games, trivia, access to memorabilia, photographs, video

This case now comes up for consideration of the following motions: (1) opposer's motion (filed April 13, 2011) for partial summary judgment on the ground of likelihood of confusion between opposer's VAN HALEN mark as used on opposer's identified goods in International Class 25 in its pleaded Registration Nos. 2866540 and 3701926 and applicant's involved KELLYVANHALEN mark on her identified goods in International Classes 24 and 25; and (2) applicant's cross-motion (filed May 12, 2011) for partial summary judgment in her favor on the ground of likelihood of confusion between opposer's registered marks on the goods and services identified in its pleaded registrations and applicant's mark as used on her identified goods in International Class 20 and her recited services in International Classes 37 and 42. Opposer's motion for partial summary judgment has been fully briefed; opposer filed a brief in response to applicant's cross-motion for partial summary judgment.

As an initial matter, applicant contends in her combined brief in response to the motion for partial summary judgment and cross-motion for partial summary judgment that until she "has an opportunity to conduct discovery to gather information from [individuals identified in opposer's initial disclosures] and other parties, the facts relevant

clips, and audio clips, all available via a global computer

to this proceeding remain in dispute, and partial summary judgment in favor of Opposer [in International Classes 24 and 25] would be inappropriate." However, applicant did not expressly ask for leave to take discovery under Fed. R. Civ. P. 56(d) prior to responding to opposer's motion for partial summary judgment. See TBMP Section 528.06 (3d ed. 2011).

A request for Rule 56(d) discovery should be clearly made and should not be "buried" in a brief in response to a motion for summary judgment. TBMP Section 528.06(a) (3d ed. 2011). When a party incorporates a motion for Rule 56(d) discovery into a brief in response to a motion for summary judgment on the merits, the Board ordinarily will deem the Rule 56(d) discovery request moot and will decide the summary judgment motion on the merits. See *id.* Because applicant has responded on the merits to the motion for summary judgment, her request for Rule 56(d) discovery is moot.

We will now consider the parties' cross-motions for partial summary judgment. Summary judgment is an appropriate method of disposing of a case in which there are no genuine disputes as to any material fact, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The Board may not resolve disputes of material fact; it may only ascertain whether such disputes

network" in International Class 41.

are present. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993). A dispute as to a material fact is genuine only if a reasonable fact finder viewing the entire record could resolve the dispute in favor of the nonmoving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). In deciding a motion for summary judgment, the Board must view the evidence in the light most favorable to the nonmovant, and must draw all reasonable inferences from underlying facts in favor of the nonmovant. *Id.* A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

We turn first to opposer's motion for partial summary judgment. As evidence in support of that motion, opposer submitted copies of applicant's responses to opposer's first set of interrogatories. See brief in support, Exhibit 2. Although those responses are marked "CONFIDENTIAL" on every page thereof, opposer did not file those responses under seal and did not submit a redacted copy of those responses for public inspection. See TBMP Section 412.04 (3d ed. 2011). However, instead of objecting to opposer's failure

to file her confidential interrogatory responses under seal, applicant submitted her own copy of those confidential interrogatory responses as Exhibit 2 to her combined brief in response to opposer's motion for partial summary judgment and in support of her cross-motion for partial summary judgment, and also did not file those responses under seal. Accordingly, applicant has waived any claim of confidentiality of the responses and the the information contained in the responses. *See Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1633 (TTAB 2007). With respect to other confidential information, if any, involved in this case, the parties are reminded that the Board's standard protective agreement is operative herein and that they are obligated to handle such confidential information in accordance therewith. *See Trademark Rule 2.116(g)*.

After reviewing the parties' arguments and evidence we find that opposer has not met its initial burden of demonstrating the absence of any genuine dispute of material fact, and that opposer's motion for partial summary judgment must therefore be denied. Notwithstanding the parties' use or intended use of their respective marks on overlapping goods in International Class 25,³ there are, at minimum,

³ Regarding applicant's assertions that opposer's use of its marks relates entirely to the rock band Van Halen, we are required to decide the cross-motions for summary judgment based on the goods and services as they are identified in opposer's pleaded registrations. We therefore cannot consider applicant's

genuine disputes of material fact as to the similarity or dissimilarity of the parties' marks in their entireties, as to the inherent strength of opposer's marks, and as to whether applicant's identified goods in International Class 24 are related to opposer's pleaded goods in International Class 25 in a manner that would give rise to source confusion. Accordingly, opposer's motion for partial summary judgment is denied.

Regarding applicant's cross-motion for partial summary judgment on opposer's likelihood of confusion claim against her applications in International Classes 20, 37, and 42, we note that applicant, in her combined brief in response to opposer's motion for partial summary judgment and in support of her cross-motion for partial summary judgment, relied entirely upon arguments in support of her cross-motion. In particular, applicant contends that her goods in International Class 20 and services in International Classes 37 and 42 are unrelated to the goods and services in opposer's pleaded registrations because there is no overlap

arguments based on actual use or common law use. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

Opposer relies largely upon third-party registrations showing use of the same mark on the types of applicant's identified goods in International Class 24 and opposer's pleaded goods in International Class 25. However, "[t]hird-party registrations have little probative value by themselves because they tell us nothing about whether or not the marks are actually being used or the manner of any such use." *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1028 (TTAB 2011), citing *Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600, 1614 (TTAB 2010).

between the respective goods and services. Applicant further contends that opposer opposed registration of applicant's mark in International Classes 20, 37, and 42 "merely as a procedural tactic to create an additional burden on Applicant." Applicant's brief at 11. We find that applicant has not met her initial burden of demonstrating the absence of any genuine dispute of material fact. At minimum, there are genuine disputes of material fact as to the similarity or dissimilarity of the parties' marks in their entirety, as to the inherent strength of opposer's marks,⁴ and as to whether opposer's pleaded goods and services and applicant's goods in International Class 20 and services in International Classes 37 and 42 are not related in a manner that would give rise to source confusion.⁵ Accordingly, applicant's cross-motion for partial summary judgment is denied.⁶

⁴ Opposer notes in its brief in opposition to the cross-motion that applicant's two involved applications are the only applications or registrations for marks that include the wording VAN HALEN other than those of opposer's in the USPTO records.

⁵ Even if we assume, as applicant argues, that there is no overlap between opposer's pleaded goods and services and applicant's goods in International Class 20 and services in International Classes 37 and 42, the goods and/or services at issue do not have to be identical or even competitive to find that there is a likelihood of confusion. See *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); *In re G.B.I. Tile & Stone, Inc.*, 92 USPQ2d 1366, 1368 (TTAB 2009); TMEP Section 1207.01(a)(1) (8th ed. 2011). It is sufficient that the goods and/or services of the parties are related in some manner or that the conditions surrounding their marketing are such that they are likely to be encountered by the same persons under circumstances that, because of the marks used in connection therewith, would

In view of our denials of the parties' cross-motions for summary judgment, the Board, in exercising its inherent authority to control the scheduling of cases on its docket and in the interest of judicial economy, will not consider any further motions for summary judgment in this case. See TBMP Section 510.01 (3d ed. 2011).

Proceedings herein are resumed. The parties are allowed until thirty days from the mailing date set forth in this order to serve responses to any outstanding discovery requests. Remaining dates are reset as follows.

Expert Disclosures Due	5/2/12
Discovery Closes	6/1/12
Plaintiff's Pretrial Disclosures Due	7/16/12
Plaintiff's 30-day Trial Period Ends	8/30/12
Defendant's Pretrial Disclosures Due	9/14/12
Defendant's 30-day Trial Period Ends	10/29/12
Plaintiff's Rebuttal Disclosures Due	11/13/12
Plaintiff's 15-day Rebuttal Period Ends	12/13/12

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after

lead to the mistaken belief that they originate from the same source. See, e.g., *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).

⁶ The parties should note that the evidence submitted in connection with the motion and cross motion for summary judgment is of record only for consideration of those motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *Am. Meat Inst. v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

In addition, the parties should not infer that the issues that we have identified as genuine disputes of material fact are the only such issues remaining for trial.

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completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.