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

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

In the Trademark Opposition of:

DILLE FAMILY TRUST,
Opposer,

vs.

NOWLAN FAMILY TRUST,
Applicant

Opposition No.: 91200643

OPPOSER'S REBUTTAL BRIEF

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INTRODUCTION

Throughout its Final Brief, Applicant repeatedly fails to address relevant facts and evidence that Opposer has raised. Further, Applicant misstates the various evidentiary rules and legal burdens which govern this proceeding. Applicant's baseless conclusory statements and failure to acknowledge or respond to Opposer's valid assertions are consistent with the hollow claims and lack of substantive arguments that Applicant has demonstrated throughout these proceedings.

It is clear that Applicant has filed this application as a calculated attempt to undermine the rights of Opposer in this famous mark and to force Opposer into frivolous administrative proceedings and litigation in order to protect these longstanding rights.

ARGUMENT

I. ADDRESSING APPLICANT'S EVIDENTIARY OBJECTION TO GEER DEPOSITION EXHIBITS

Opposer addresses first Applicant's objection to nearly all of the Geer Deposition Exhibits. Applicant suggests that any document proffered by current Trustee, Louise Geer, that was made prior to July 1, 2011 (the date Ms. Geer became Trustee) is inadmissible because Ms. Geer lacks personal knowledge prior to that date, and as such those documents are hearsay. However, Applicant fails to acknowledge that there is a long-standing hearsay exception -- the business record exception under Federal Rule of Evidence 803(6). Under this rule, a party may admit any records of a business (1) that were made in the regular course of business; (2) that the business has a regular practice to make such records; (3) that were made at or near the time of the recorded event; and (4) that contain information transmitted by a person with knowledge of the information within the document. Fed. R. Evid. 803(6).

To suggest this exception does not apply, would limit any trustee, chief executive officer, or custodian of records from testifying about those matters of the trust or business prior to their appointment. Extensive case precedent has illuminated the various circumstances under which the aforementioned exception applies. *See* United States v. Komassa, 767 F.3d 151 (2d Cir. 2014) (To lay a proper foundation for a business record, a custodian must testify that the document was kept in the course of a regularly conducted business activity. The custodian need not have personal knowledge of the actual creation of the document); and Capital Marine Supply, Inc. v. M/V Roland Thomas II, 719 F.2d 104, 106 (5th Cir.1983) (Person testifying is custodian of record and able to explain the record keeping procedures and information).

During Ms. Geer's deposition, she clearly authenticated and laid the proper foundation for all documents introduced as exhibits. Ms. Geer indicated that she could identify each document and subsequently described the content of each. She further detailed the history of each document and indicated that each was a fair and accurate representation of what it purported to convey.

Ms. Geer made it abundantly clear that these documents were made in the ordinary course of the Trust's business, and given to Ms. Geer upon becoming trustee. Moreover, Ms. Geer indicates she was briefed by the former trustee Arthur Martin on the documents upon receiving them and becoming trustee (*see* Geer Deposition at p.6-8). The Geer Deposition Exhibits clearly fall under the Rule 803(6) exception and are therefore admissible.

Applicant objects to use of pinpoint citations by Opposer in this reply brief (see Applicant's Brief at Footnote 11). However, the case law cited by Applicant in Footnote 11 is puzzling: Kohler Cp. v. Baldwin Hardware Corp., 82 USPQ2d 1100, 1004 (TTAB 2007) --

Opposer is unclear how citing specific portions of the Geer deposition equates to waiting until its reply to renew an objection. Additionally, Life Zone Inc. v. Middlemen Group, Inc. 87 USPQ2d 1953 (TTAB 2008) (citing Wet Seal Inc. v. FD Mgmt. Inc. 82 USPQ2d 1629 (TTAB 2007) deal with rebuttal testimony during the testimony period -- *not* the Opposer's rebuttal brief. Additionally, both Life Zone Inc. and Wet Seal Inc. state that rebuttal evidence/testimony may be submitted for the purpose of "denying, explaining or discrediting applicant's case." *See* Life Zone Inc. at 1953 (*citing* Wet Seal Inc. at 1629); *see also* The Ritz Hotel Limited v. Ritz Closet Seat Corp., 17 USPQ2d 1466 (TTAB 1990).

II. APPLICANT'S ASSERTION THAT OPPOSER HAS NO STANDING IS UNFOUNDED

"Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefore." Lanham Act § 13.

Applicant states that the Opposer has failed to meet initial element of proving grounds for standing. (Applicant's Brief at 7). However, the law is clear that a person's reasonable belief that they will be harmed by the registration of a mark is sufficient to establish standing. Here, Opposer has established, through myriad evidence, continuous use of the BUCK ROGERS mark in commerce since as early as 1929. Opposer undoubtedly has a reasonable belief that it will be harmed by registration of an identical mark and thus has standing to bring this proceeding. Applicant's arguments to the contrary should be summarily dismissed.

Applicant, in one of its many contradictory statements, states that it "fails to see the relevance" of Opposer noting Applicant has alleged it is the successor in interest and creator of

the BUCK ROGERS mark (*see* Applicant's Brief at Footnote 7). However, Applicant raises this very point in its Answer -- once in its responses and once as an affirmative defense (*see* Docket No. 4 at Paragraph 14 and Affirmative Defense Paragraph 7). Applicant is disingenuous in its attempt to raise issue with the contents of Opposer's pleadings, while ignoring statements made in its own pleadings.

III. OPPOSER HAS SUFFICIENTLY PROVEN PRIORITY

Trademark rights can arise through federal registration or under common law; the test in either instance is "conditioned upon use [of the mark] in commerce." Gen. Healthcare Ltd. v. Qashat, 364 F. 3d 332, 335 (1st Cir. 2004) (citing United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90, 97 (1918)).

Applicant claims that Opposer's claim to priority is "based on broad, unsupported allegations that "Opposer has used and continues to use the Buck Rogers mark in commerce." (Applicant's Brief at 15). In making this statement, Applicant ignores the multitude of evidence presented by Opposer outlining Opposer's continued use of the BUCK ROGERS mark in commerce, dating back to 1929. (*see* Geer deposition exhibits 6, 13, 14, 19, 34, 36, 37, 39, 40, 42, 43, 51, 53, and 57).

It is clear that Opposer has submitted substantial evidence, in the form of print advertising, covers of comic books, licensing agreements, foreign trademark registrations and trial testimony, attesting to the efforts Opposer has made to establish and maintain the BUCK ROGERS mark in the marketplace, as well as the degree of recognition and fame the BUCK ROGERS mark has achieved due to Opposer's efforts.

One of the more significant showings of Opposer's consistent use can be seen in Geer deposition exhibit 19, which depicts dozens of examples of the BUCK ROGERS mark used on published books. These images show not only the presence of the mark on multiple commercial items, but the publication dates and prices of these commercial items. Opposer cannot fathom a more striking example of commercial use than the abundance of evidence presented in Geer deposition exhibit 19, as well as in Geer deposition exhibits 6, 13, 14, 34, 36, 37, 39, 40, 42, 43, 51, 53, and 57.

Instead of introducing arguments to rebut this strong evidence presented by Opposer, Applicant summarily dismisses it and thus cannot overcome Opposer's valid assertion of priority.

IV. OPPOSER HAS NOT ABANDONED ITS RIGHTS IN THE MARK

Opposer asserts that it has never abandoned the Mark. However, assuming *arguendo*, that Applicant's claim that Opposer has abandoned the Mark has any merit, Opposer has presented ample evidence in its primary brief to rebut any presumption of abandonment. Applicant admits that a presumption of abandonment is rebuttable (*see* Applicant's Brief at page 28; *see also* 15 U.S.C. § 1127). Efforts to license the mark are, in fact, sufficient to rebut the presumption of abandonment. *See Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 956 (7th Cir.1992). Taking actions of a normal businessman intending to use the mark in commerce can also be used as evidence to rebut the presumption of abandonment. *See Rivard v. Linville*, 133 F.3d 1446, 1449-50 (Fed.Cir.1998). Efforts to sell products featuring the mark, the mark's associated goodwill and exploit the value of the mark are all evidence in support of use and against abandonment. *See Silverman v. CBS, Inc.*, 870 F.2d 40, 47 (2d Cir.1989).

Opposer has presented substantial evidence demonstrating its efforts to license the Mark, sell the associated good will, as well as other business actions relating to promotion of the Mark, all of which clearly rebut any presumption of abandonment. *See* Geer Deposition Exhibits 6, 13, 14, 19, 34, 36, 37, 39, 40, 42, 43, 51, 53, and 57. Applicant suggests none of the licenses attached as Geer Deposition Exhibits evidence use of the Mark prior to Applicant's priority date of January 15, 2009 (Applicant's Brief at 29). However, in the preceding sentence, Applicant admits the licenses range from 2008-2013 (Applicant's Brief at 29) – clearly, 2008 predates Applicant's priority date.

Additionally, dates of first publication of works containing the mark listed in Geer Deposition Exhibit 19 long predate Applicant's filing date. These publications clearly evidence Opposer's continuous use of the mark from at least 1964 through 2013. *See* Geer Deposition Exhibit 19.

Although the burden shifts to Opposer to rebut a presumption of abandonment, the burden is always on the party alleging abandonment to prove by a preponderance of the evidence that the mark has been abandoned without intent to use the mark again in commerce. *See Rivard* at 1449. Applicant has failed to meet its burden of proof by a preponderance of the evidence. As such, if Applicant's argument of abandonment is considered by the Board, it must be disregarded as Opposer has rebutted any presumption of abandonment.

V. APPLICANT DID NOT HAVE A BONA FIDE INTENT TO USE THE MARK

Applicant objects to Opposer's argument that Applicant did not have a bona fide intent to use the mark. When Opposer filed the instant opposition, it was informed that Applicant "has commenced use of the mark or intends imminently to do so" (Docket No. 1 at Paragraph 7). It

was only after Applicant submitted no evidence during its testimony period that Opposer could prove that Applicant has never used the Mark in commerce, and in fact at the time of its application, did not have a bona fide intent to use the Mark. A motion to amend Opposer's opposition pleading at the time it discovered Applicant was not using, nor had the intent to use the mark in commerce (upon the close of Applicant's testimony period) would have been untimely. Opposer reaffirms its argument from its primary brief that "the absence of evidence alone is sufficient to prove that applicant lacked a bona fide intention to use." See Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha, 26 U.S.P.Q.2d 1503, 1507 (TTAB 1993); and L.C. Licensing, Inc. v. Cary Berman, 86 U.S.P.Q.2d 1883 (TTAB 2008).

VI. THE *du Pont* FACTORS WEIGH IN FAVOR OF FINDING A LIKELIHOOD OF CONFUSION

Opposer now addresses the relevant *du Pont* factors raised by Applicant in Applicant's trial brief.

2. Similarity of the Goods

Applicant admits that "to the extent there is overlap among the goods and services and they are identical, likelihood of confusion could apply if Opposer could establish common law rights and priority of use of the mark for those goods and services." (Applicant's Brief at 32). As detailed above, Opposer does have priority with respect to this mark. Opposer has extensively and consistently used the mark in commerce since 1929 (*see* Geer Deposition Exhibits 6, 13, 14, 19, 31, 34, 36, 37, 39, 40, 42, 43, 51, 53 and 57).

There are many identical products and goods between Opposer's and Applicant's applications, including but not limited to: motion picture films featuring science fiction and

adventure, audio-visual recordings featuring science fiction and adventure, sound recordings featuring musical soundtracks, a series of books featuring a collection of comic strips, toy action figures. Opposer has demonstrated common law rights by using the BUCK ROGERS mark in commerce for decades (*see* Geer Deposition Exhibits 6, 13, 14, 19, 31, 34, 36, 37, 39, 40, 42, 43, 51, 53 and 57).

3. Channels of Trade

With respect to this factor, Applicant again concedes a similarity in the channels of trade with respect to the goods and services “actually at issue in the opposition.” Applicant fails to acknowledge the overwhelming evidence of Opposer’s continuous and lengthy use in the above-referenced classifications. Just as there is substantial similarity between the goods and services of the Applicant and the Opposer, there is equal overlap with respect to the channels of trade.

5. Fame of the Prior Mark

With respect to this factor, The Board and the courts have cautioned that “there is ‘no excuse for even approaching the well-known trademark of a competitor . . . that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous’” Planter’s Nut & Chocolate Co. v. Crown Nut Co., Inc., 305 F.2d 916.

Opposer has submitted a multitude of evidence detailing the high level of fame of the BUCK ROGERS mark¹. However, Applicant once again erroneously states that Opposer has failed to submit any evidence of use of the mark. (Applicant’s Brief at 34).

¹ *See*: http://en.wikipedia.org/wiki/Buck_Rogers

On the contrary, Opposer has submitted substantial evidence, in the form of print advertising, covers of comic books, licensing agreements, foreign trademark registrations and trial testimony, attesting to the efforts Opposer has made to establish, and keep established the BUCK ROGERS mark in the marketplace, as well as the degree of recognition the BUCK ROGERS mark has achieved in light of Opposer's efforts (*see generally* Geer Deposition; *see also* Geer Deposition Exhibits 6, 13, 14, 19, 31, 34, 36, 37, 39, 40, 42, 43, 51, 53,57, 60, 61 and 62).

By contrast, Applicant has submitted no evidence to demonstrate that it has ever used, or even intends to use, the mark in commerce.

11. Extent of Potential Confusion

In the trial brief, Applicant makes the following perplexing statement regarding this factor: "Other than making conclusory statements, Applicant has not established the extent of any potential consumer confusion." (Applicant's Brief at 36). Assuming *arguendo* that Applicant means to say "*Opposer* has not established..." Applicant still makes no effort to present arguments to counter Opposer's valid assertion that due to Opposer's well-established use of the mark, any use by Applicant would cause substantial confusion among consumers. (*see* Geer Deposition Exhibits 6, 13, 14, 19, 31, 34, 36, 37, 39, 40, 42, 43, 51, 53,57, 60, 61 and 62). It is clear that the use of a mark that is identical to the mark that Opposer has used extensively in commerce since 1929 will cause Opposer significant damage.

CONCLUSION

For the foregoing reasons, Opposer maintains the position that Opposer would suffer clear damage as a result of the registration of Applicant's mark. Therefore, Opposer respectfully

requests that Application Serial No. 77/650082 be rejected, and that registration of Applicant's mark for the classes and goods specified in its application be refused.

Dated: Buffalo, New York
April 14, 2015

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Opposition No.: 91200643

CERTIFICATE OF SERVICE

I, Vincent G. LoTempio, hereby certify that I caused a copy of the foregoing Opposer's Rebuttal Brief to be served upon counsel of record for Applicant by causing the same to be sent via regular first-class mail, postage prepaid on this 14th day of April 2015, addressed as follows:

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