

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

Baxley

Mailed: May 31, 2013

Opposition No. **91202862**

Technology Advancement Group,
Inc.

v.

LVMH Swiss Manufactures SA

Before Bucher, Taylor and Mermelstein,
Administrative Trademark Judges

By the Board:

LVMH Swiss Manufactures SA ("applicant") seeks to register the mark TAGLINK in standard character form for "handheld mobile digital electronic devices for the sending and receiving of telephone calls, for use as a digital audio player, and for use as a camera; accessories for the foregoing, namely, fitted cases, protective covers, carrying holsters, headsets, headphones and earphones" in International Class 9.¹

Technology Advancement Group, Inc. ("opposer") filed a notice of opposition to registration of applicant's mark on the ground of likelihood of confusion with its previously

¹ Application Serial No. 85282081, filed March 31, 2011, 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).

used and registered marks which are comprised in whole or in part of the word TAG.² Applicant, in its answer, denied

² The nine pleaded registrations include the following:

Registration No. 2106170 for the mark **TAG** in typed form for "computers, computer peripherals and computer software for use in scientific and engineering applications, and for use in office and business management applications" in International Class 9, issued October 21, 1997, renewed;

Registration No. 3113307 for the mark **TAG** in standard character form for "computer system services, namely computer system consulting, computer software programming, testing and development, and computer system integration, development and design" in International Class 42, issued July 11, 2006, Section 8 affidavit accepted, Section 15 affidavit acknowledged;

Registration No. 3286202 for the mark **TAG** in standard character form for "Computers; laptop computers; computer hardware; computer hardware for telecommunications; computer networking hardware; communications servers used as computer hardware; network access server hardware; computer software for application and database integration; computer network hubs, switches and routers; LAN (local area network) access points for connecting network computer users; computer storage devices, namely, hard drives, disc drives, flash drives, and RAIDS; flat panel displays; liquid crystal displays; computer monitors; computer keyboards; computer carrying cases; ruggedized computer carrying cases" in International Class 9, issued August 28, 2007; and

Registration No. 3888425 for the mark **TAG** in standard character form for "Database management, namely, database administration; business management consulting services in the fields of transformation and integration strategy and advisory services; business management consulting services in the fields of transformation and integration strategy and advisory services as to national security including arms control and disarmament, weapon systems, treaties, military operations lessons learned and Federal Aviation Administration data requirements for development and support" in International Class 35, "Archive management services, namely, storage services for archiving databases, images and other electronic data; storage services for archiving electronic data, namely, extensible markup language tagging, XML tagging, and electronic tagging of military and intelligence data; and electronic data and image storage services" in International Class 39, "Data identification and collection, namely, collection of information for training purposes in the field of military tactics, training and procedures, TTPs; data reporting, namely, reporting of information for military training; military operational analysis training services regarding combat lessons learned, military performance in

the salient allegations of the notice of opposition and asserted affirmative defenses, which are discussed in detail *infra*.

disaster relief and humanitarian operations, force-on-force modeling and simulation, force development, acquisition support, cyber security, chemical, biological, radiological and nuclear issues, international treaties compliance, nuclear counter-and non-proliferation and biometrics analysis" in International class 41, "Web portal development for others; computer software development; architecture analysis; military operation analysis services in the area of cyber security, namely, computer security consulting; information tagging and retrieval services, namely, application service provider featuring application programming interface software for allowing data retrieval, upload, access and management of extensible markup language tagging, XML tagging, and electronic tagging of military and intelligence data" in International Class 42, "Providing information in the field of the military, military tactics and strategies, namely, military and policy decision support, military and policy decision planning, military action analysis, military data exploitation, military operations modeling and simulation, military operations research, military force assessments, counter-terrorism analysis and unmanned ground combat vehicle route assessment and planning; military science services, namely, analyzing war strategies, namely, wargaming; military and national security information management and knowledge discovery services, namely, the registration, collection, transcription, compilation and systemization of written communications and data, namely, data collection and exploitation; data identification and collection, namely, collection of information for military purpose operations in the field of military tactics and strategies; data reporting, namely, reporting of information for military operations in the field of military tactics and strategies; military operational analysis services, namely, providing information in the field of military tactics and strategies regarding military performance in disaster relief and humanitarian operations, force-on-force modeling and simulation, force development, acquisition support, cyber security, chemical, biological, radiological and nuclear issues, international treaties compliance, nuclear counter-and non-proliferation and biometrics analysis; military operation analysis services in the area of cyber security, namely, information security governance, information assurance and identity management" International Class 45, issued December 14, 2010.

On September 21, 2012, applicant filed a motion to extend by sixty days its time to serve discovery responses and the close of the discovery period. In response, opposer stated that it did not object to such motion. The Board granted that motion in a March 25, 2013, order.

This case now comes up for consideration of applicant's combined motion (filed November 20, 2012) (a) to amend the identification of goods in its involved application, and (b) for summary judgment. The combined motion has been fully briefed.³

As an initial matter, we note that applicant's nine-page reply brief includes, as Exhibit X, a five-page chart which sets forth a list of allegedly undisputed facts and opposer's response thereto. Because the chart is prepared by applicant as part of the legal argument set forth in the reply brief, it is not proper matter for an exhibit and should have been incorporated into the body of the reply brief. Accordingly, the five (5) pages are included in the page count for applicant's reply brief. See Trademark Rule 2.127(a); *Saint-Gobain Corp. v. Minnesota Mining and Manufacturing Co.*, 66 USPQ2d 1220 (TTAB 2003). Because the

³ Opposer, on November 26, 2012, filed a motion for entry of discovery sanctions, or, in the alternative, to compel discovery. However, the parties, on December 17, 2012, filed a stipulation to, among other things, withdraw that motion.

reply brief and Exhibit X, taken together, exceed the ten-page limit for reply briefs in support of motions, the reply brief has received no consideration in our decision.⁴ *Id.*

By the motion to amend, applicant seeks to add the following wording at the conclusion of the identification of goods of the involved application: "all of the above intended for individual use and sold at high end jewelry and watch stores and mobile telephone stores and not intended for military, computer, scientific, engineering or business management applications." With such language added to the identification, the identification would read in its entirety as "handheld mobile digital electronic devices for the sending and receiving of telephone calls, for use as a digital audio player, and for use as a camera; accessories for the foregoing, namely, fitted cases, protective covers, carrying holsters, headsets, headphones and earphones; all of the above intended for individual use and sold at high end jewelry and watch stores and mobile telephone stores and not intended for military, computer,

⁴ We hasten to add that, unlike a complaint, a recital of allegedly undisputed facts in a motion for summary judgment does not require a paragraph-by-paragraph answer by the nonmovant. Opposer's brief in response indicates that it believes that there are similarities in the marks, the goods and services at issue, and trade channels as well as other factors that do not favor entry of summary judgment in this case.

scientific, engineering or business management applications."

Applicant contends that, based on the application as amended, there is no genuine dispute as to any material fact and that it is entitled to entry of judgment in its favor as a matter of law in view of the following: (1) applicant manufactures and markets TAG HEUER watches and mobile telephones and owns eight registrations for marks which include the wording TAG HEUER;⁵ (2) applicant has moved to limit the trade channels of its goods in the application; (3) the marks, the goods and services at issue and their trade channels are different; (4) the parties'

⁵ Such registrations include:

Registration No. 2407950 for the mark **TAG HEUER LINK** in typed form for "Horological instruments and chronometrical instruments, namely watches, wrist-watches, straps for wrist-watches and watch cases, travel clocks, clocks, chronographs for use as watches, chronometers-- powder compacts and jewel cases in precious metals or coated with precious metals; jewelry made of precious metals or coated with precious metals" in International Class 14, issued November 28, 2000, renewed;

Registration No. 2484514 for the mark **TAG HEUER** and design in



the following form, , for "telephone and parts thereof, optical goods, namely spectacles, sunglasses, spectacle frames, spectacles cases" in International Class 9 and "organization of exhibitions for cultural or educational purposes" in International Class 41, issued September 4, 2001, renewed; and

Registration No. 3894358 for the mark **TAG HEUER MERIDIIST** in standard character form for "handheld mobile digital electronic devices for the sending and receiving of telephone calls, for use as a digital audio player, and for use as a camera; accessories for the foregoing, namely, fitted cases, protective covers, carrying holsters, headsets, headphones and earphones" in International Class 9, issued December 21, 2010.

goods are purchased "with care;" (5) there is no evidence of confusion between the parties' marks; and (6) an unrelated third party, Stilwell & Associates of the USA, Inc. ("Stilwell"), owns Registration No. 2023588 for the mark TAGLINK for "computer software for use in tagout/lockout procedures, required to ensure a safe environment for maintenance of hazardous industrial equipment" in International Class 9. Applicant's evidence in support of its registration includes: (1) copies of its registrations which include the wording TAG HEUER; (2) a printout of an excerpt from Stilwell's website, showing Stilwell's use of the TAGLINK mark; and (3) a copy of Registration No. 2023588.

In response to the motion to amend, opposer contends that applicant's motion to amend is improper because: (1) opposer does not consent to it, and (2) applicant has not consented to entry of judgment with regard to unrestricted identification of goods; that applicant's goods are smart phones and are marketed accordingly; that smart phones, by definition, contain computer functions; that, notwithstanding the proposed limit in the identification, "there is nothing to prevent any individual user from using the device for its full capabilities, including for military, computer, scientific, engineering, or business

management applications;" and that the expressed "intention not to use the smart phone for computer applications is contrary to the very idea of a smart phone."

With regard to the motion for summary judgment, opposer contends that there are genuine disputes of material fact with regard to the similarities of the marks and the goods and services at issue; that, even with the proposed limitation on trade channels, the goods are sold in overlapping trade channels because "mobile telephone stores" includes such stores as Best Buy and Radio Shack, which typically sell other electronics, including computers and related peripherals.

We elect to exercise our discretion and consider the motion to amend at this time. See TBMP Section 514.03. Although the proposed amendment limits applicant's identification of goods, applicant has not consented to entry of judgment on the question of likelihood of confusion as to the broader identification. See *Drive Trademark Holdings LLC v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007). Further, the proposed amendment seeks to delete a core function of the identified goods. Although applicant seeks to add the language "not intended for ... computer ... applications," applicant concedes in its brief in support of the combined motion that its "smart phones

... will include computer-like features." Brief at 14. Applicant cannot have it both ways. The computer encyclopedia entry provided by opposer defines a "smartphone" as "[a] cellular telephone with built-in applications and Internet access. ... In addition to their built-in functions, smartphones run myriad free and paid applications, turning the once single-minded cellphone into a mobile personal computer."

www.pcmag.com/encyclopedia. Because use with computer applications is one of the essential functions of goods of the type, we agree with opposer that the proposed amendment is akin to "a kitchen knife not intended for cutting" or "a carpenter's hammer not intended for driving nails." Based on the foregoing, the motion to amend is hereby denied.

We will now consider applicant's motion for summary judgment. Such motions are an appropriate method of disposing of cases 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 party moving for summary judgment has the initial burden of demonstrating that there is no genuine dispute regarding any material fact remaining for trial and that it is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1987); *Sweats Fashions Inc.*

v. Pannill Knitting Co. Inc., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). The Board may not resolve disputes of material fact; it may only ascertain whether such disputes are present. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA, Inc. v. Great American Music Show, Inc.*, 23 USPQ2d at 1476; *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

After reviewing the parties' arguments and evidence, we find that applicant has failed to meet its initial burden of showing that there is no genuine dispute as to any material fact and that it is entry of judgment in its favor as a matter of law. At a minimum, we find that there are genuine disputes as to the similarity of the marks,⁶ as

⁶ Likelihood of confusion is determined on the basis of the marks as presented in the drawings of the pleaded registrations and the involved application. See *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172 (TTAB 1987). Thus, even if we assume that TAG is

to the scope of protection to which opposer's registered marks are entitled, as to whether the goods and services at issue are related in a manner that is likely to give rise to source confusion, and as to the trade channels of the goods and services at issue.⁷

Even if applicant were to restrict the trade channels of its identified goods in the manner proposed in its motion to amend, opposer's pleaded registrations are not similarly restricted. Thus, we must presume that opposer's goods and services move through all reasonable trade channels for such goods to all usual classes of consumers for such goods. See *Schieffelin & Co. v. Molson Companies Ltd.*, 9 USPQ2d 2069, 2073 (TTAB 1989); *Morton-Norwich Products, Inc. v. N. Siperstein, Inc.*, 222 USPQ 735, 736 (TTAB 1984). As a result, a question still remains for trial as to whether the parties' consumers and channels of trade overlap.

Regarding the third-party registration cited by applicant in support of its motion for summary judgment, the significance of third-party trademarks depends entirely

used as an acronym for opposer's corporate name, such use has no bearing upon this case.

⁷ The parties should not assume that these are the only genuine disputes remaining for trial.

upon their use. See *Scarves by Vera, Inc. v. Todo Imports, Ltd.*, 544 F.2d 1167, 1173, 192 USPQ 289 (2d Cir. 1976).

Because the Stilwell registration is for "computer software" used in connection with "hazardous industrial equipment," whereas the goods at issue herein are general consumer goods, Stilwell's use of TAGLINK has no bearing upon this case.

Although applicant contends that there is no evidence of confusion between the parties' marks, applicant's involved application was filed based on an assertion of a *bona fide* intent to use the mark in commerce. There is no evidence in the record to show that applicant's mark has been used or advertised to such an extent that there has been an opportunity for confusion to occur if it were likely to occur. Thus, we can give no weight to this factor. Likewise, despite the parties' arguments, there is no specific evidence in the record regarding the degree of care involved in purchasing the goods and services at issue. In view of the foregoing, the motion for summary judgment is denied.

In the interest of narrowing the issues for trial, the Board has reviewed the parties' pleadings. In so reviewing, we note that all of applicant's pleaded affirmative defenses are insufficient or redundant.

As applicant's first affirmative defense, applicant states that the involved mark is not likely to cause confusion with any of opposer's pleaded marks. This defense adds nothing to applicant's denials of the salient allegations of the notice of opposition and is therefore *sua sponte* stricken. See *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995); Fed. R. Civ. P. 12(f); TBMP Section 506.01.

Applicant's second affirmative defense is that the term "tag" is not exclusively associated with opposer. However, even if applicant were to establish that the term TAG is not exclusively associated with opposer, so establishing would not defeat opposer's pleaded Section 2(d) claim. Rather, Section 2(d) precludes the registration of a mark which

[c]onsists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive....

See also *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974). Accordingly, the second affirmative defense is insufficient and stricken on

that basis. See Fed. R. Civ. P. 12(f); TBMP Section 506.01.

As applicant's third affirmative defense, it asserts that opposer will not be damaged by issuance of the registration sought because applicant owns "a number of registrations that include the word TAG for a variety of goods and services." However, for applicant to plead a defense based on prior registrations, its registered marks must be substantially identical, i.e., literally identical or legally equivalent, to the applied-for mark, and must be for goods/services that are identical, substantially the same, or so related to those in its prior registration as to represent in law a distinction without a difference. See *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969); *Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701 (TTAB 2010). Indeed, none of the registrations cited by applicant in its combined motion would provide a basis for such a defense. Because applicant's third affirmative defense does not allege that applicant owns a prior uncontested registration for the TAGLINK mark for substantially the same goods as in its involved application, that defense is insufficient and therefore stricken. See Fed. R. Civ. P. 12(f); TBMP Section 506.01.

As applicant's fourth and fifth affirmative defenses, it asserts that the opposition is barred, in whole or in part, by the doctrines of laches, waiver, acquiescence, estoppel and unclean hands. However, because applicant has pleaded no facts which form the basis for any of these defenses, those defenses are insufficiently pleaded and are therefore stricken. See *IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); TBMP Sections 311.02(b) and 506.01.

Proceedings herein are resumed.⁸ Pursuant to the parties' December 17, 2012 stipulation, applicant is allowed until **thirty days** from the mailing date set forth in this order to serve responses to opposer's August 17, 2012 discovery requests "without objection other than privilege and pursuant to the parties' agreement regarding interpretation of Document Request Nos. 7 and 8." Dates herein are reset as follows.⁹

Expert Disclosures Due	6/22/2013
Discovery Closes	7/22/2013
Plaintiff's Pretrial Disclosures Due	9/5/2013
Plaintiff's 30-day Trial Period Ends	10/20/2013
Defendant's Pretrial Disclosures Due	11/4/2013

⁸ The parties' evidence submitted in connection with applicant's combined motion is of record for purposes of that combined motion only. To be made properly of record at trial, the propounding party must make that evidence of record during its testimony period.

⁹ The Board's March 25, 2013, order stated that the parties would be allowed a fifty-two day discovery period, if applicant's combined motion was denied.

Defendant's 30-day Trial Period Ends	12/19/2013
Plaintiff's Rebuttal Disclosures Due	1/3/2014
Plaintiff's 15-day Rebuttal Period Ends	2/2/2014

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 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.

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.