

THIS DECISION IS
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OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

WINTER

Mailed: December 17, 2014

Opposition No. 91204404
Cancellation No. 92055541

David M. Holder

v.

*Vincent Motors LLC and
Eicher Motors Ltd., joined as
party defendants*¹

**Before Seeherman, Taylor, and Greenbaum,
Administrative Trademark Judges.**

By the Board:

These consolidated cases now come up for consideration of the motion (filed June 25, 2014) to substitute submitted by Applicants/Respondents, Vincent Motors, LLC and Eicher Motors Ltd. (hereafter collectively referred to as “Vincent”); Opposer/Petitioner David M. Holder’s (hereafter “Holder”) motion (filed June 27, 2014) for summary judgment on the ground of likelihood of confusion; and Vincent’s motion (filed August 21, 2014) to strike.

¹ As discussed *infra*, we have joined Eicher Motors Ltd. (“Eicher”) as a party defendant in response to Vincent Motors LLC’s motion to substitute.

Background

Regarding the opposition, Vincent seeks to register the mark VINCENT in standard characters for “protective helmets, namely, motorcycle helmets” in Class 9 and for “motorcycles and structural parts therefor” in Class 12.² Holder opposes registration, and asserts as grounds therefor likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), and dilution under Trademark Act Section 43(c), 15 U.S.C. § 1125(c). In connection with his likelihood of confusion claim, Holder alleges prior use of the mark VINCENT in the United States since long prior to August 13, 2011, the filing date of the opposed application. As regards his dilution claim, Holder alleges that the VINCENT mark is “internationally famous” and that Vincent’s use and registration of the VINCENT mark will dilute the strength and quality of Holder’s trademark rights.³ Applicant has denied the salient allegations in the notice of opposition.⁴

² Application Serial No. 85397317, filed August 13, 2011, based on Section 1(b) of the Trademark Act (intent to use the mark in commerce).

³ We note that Holder has failed to adequately plead the ground of dilution because he did not allege that his mark became famous in the United States prior to the constructive first use date of Vincent’s marks. *See The Toro Co. v. Torohead, Inc.*, 61 USPQ2d 1164, 1174 n.9 (TTAB 2001). As more fully discussed *infra*, we allow Holder time to re-plead this ground in the opposition insofar as it pertains to the goods identified in Class 9.

⁴ Vincent has also asserted the affirmative defenses of unclean hands, laches, estoppel, and/or waiver, and further alleges that Holder lacks standing and has abandoned any rights established in the United States. Vincent’s other “affirmative defenses” are amplifications of its denials of Holder’s claims of likelihood of confusion and dilution.

With respect to the cancellation, Holder seeks to cancel two registrations owned by Vincent for the marks VINCENT⁵ and VINCENT HRD,⁶ both for “caps; jackets; shirts; t-shirts” in Class 25. As with the opposition, Holder asserts the grounds of likelihood of confusion and dilution. In connection with his likelihood of confusion claim, Holder alleges prior use of the marks VINCENT and VINCENT HRD on or in connection with motorcycles, motorcycle parts and accessories, parts catalogs and other printed matter, clothing, and other products since long prior to October 31, 2003, the date of first use set forth in the involved registrations. As regards his dilution claim, Holder once again alleges that the VINCENT mark is “internationally famous” and that Vincent’s use and registration of the involved marks will dilute the strength and quality of Holder’s trademark rights.⁷ Vincent has denied the salient allegations in the petition for cancellation.⁸

Motion to Substitute

Eicher requests that the Board substitute it as the party defendant in these proceedings, stating that on May 21, 2014, Vincent Motors LLC assigned to it all rights, title, and interest in and to the opposed application

⁵ U.S. Reg. No. 4128589, issued April 17, 2012.

⁶ U.S. Reg. No. 4128588, issued April 17, 2012.

⁷ Similar to the pleading in the opposition, Holder did not adequately plead his dilution claim.

⁸ As with its answer to the notice of opposition, Vincent has also asserted the affirmative defenses of unclean hands, laches, estoppel, and/or waiver, and further alleges that Holder lacks standing and has abandoned any rights established in the

and the registrations sought to be cancelled. Eicher has included a copy of the assignment with its motion, which indicates that said assignment is recorded with the USPTO Assignment Recordation Branch at Reel/Frame 5307/0871. In further support of its motion, Eicher contends that substitution is proper because discovery has been completed. Holder opposes the motion to substitute, asserting that Eicher should be joined as a party defendant rather than substituted.

If the mark in an application or registration which is the subject matter of an *inter partes* proceeding before the Board is assigned, together with the application or registration, the assignee may be joined as a party upon the filing with the Board of a copy of the assignment. *See* TBMP § 512.01 (2014). The assignee will be joined, rather than substituted, when the assignment occurs after the commencement of the proceeding, to facilitate the taking of discovery and the introduction of evidence. *See Id.*; *cf. William & Scott Co. v. Earl's Restaurants Ltd.*, 30 USPQ2d 1870 (TTAB 1994) (substitution of opposer appropriate where assignment occurred prior to commencement). Here, the assignment occurred after the institution of these proceedings and prior to trial. In view thereof, Eicher's motion to substitute is **denied** and Eicher is hereby **joined** as a party defendant.

United States. Vincent's other "affirmative defenses" are amplifications of its denials of Holder's claims of likelihood of confusion and dilution.

Motion to Strike

Inasmuch as the motion to strike relates to the evidence we may consider in reviewing Holder's summary judgment motion, we turn next to Vincent's motion to strike.

Vincent requests that the Board strike the declarations of John Healy and Patrick Godet and the exhibits attached to those declarations, which were submitted by Holder with his reply brief to the summary judgment motion. Vincent argues that the evidence is untimely and should have been submitted with Holder's motion, rather than with his reply; and that during discovery Holder withheld evidence regarding the information contained in the declarations and should be precluded from using the evidence in support of the summary judgment motion. In particular, Vincent contends that Holder refused to provide information during discovery about an asserted agreement with Mr. Godet (or his company, Godet Motorcycles, S.A.R.L.) and information concerning the terms of the asserted oral license agreement with Coventry Spares, Ltd. ("Coventry Spares"), which is owned and managed by John Healy. Attached to Vincent's motion is a copy of Holder's responses to certain of Vincent's interrogatories regarding the licensing arrangements.

In opposition, Holder contends that the declarations supplement and corroborate Holder's declaration submitted with his motion in which Holder discussed his dealers/distributors for his products sold in the United States under the VINCENT mark. Holder also asserts that insofar as he discussed Coventry Spares and Mr. Godet in his deposition, Vincent had an opportunity

to conduct discovery on the licensing arrangements. In support of his arguments, Holder submitted a copy of portions of his deposition.

As to the timeliness of Holder's evidence, we find that Holder's submission of the Healy and Godet declarations (and accompanying exhibits) does not constitute improper rebuttal. Specifically, the materials accompanying Holder's reply brief corroborate and elaborate on Holder's discussion in his motion, *viz.* (i) how he has sold motorcycle parts, clothing, and previously-owned and reconditioned motorcycles, through his U.S. distributors and dealers (motion at 5-6; Holder dec. ¶¶8, 10), and (ii) that certain dealers build replica Vincent motorcycles from parts made by Holder (motion at 3, 5; Holder dec. ¶17). The materials accompanying Holder's reply also are responsive to Vincent's argument that Holder has submitted no corroborating evidence regarding distributors for his parts and clothing or his alleged licensing agreements with them (response at 13, 15). In view thereof, Holder's submission of the Healy and Godet declarations (and accompanying exhibits) with his reply was proper rebuttal.

With respect to Vincent's requested estoppel sanction, a party that fails to provide information requested during discovery may, upon motion or objection by its adversary, be precluded from using that information upon motion for summary judgment, unless the failure was substantially justified or is harmless. Fed. R. Civ. P. 37(c)(1); *Vignette Corp. v. Marino*, 77 USPQ2d 1408 (TTAB 2005), *citing Presto Products, Inc. v. Nice Pak Products, Inc.*, 9

USPQ2d 1895 (TTAB 1988). On review of the parties' submissions, we find for the following reasons that Holder should not be precluded from using the Healy declaration, but that the Godet declaration must be excluded.

As regards the Healy declaration, we find that Holder did not improperly withhold evidence from Vincent regarding the licensing agreement with Coventry Spares. Specifically, in response to Vincent's interrogatory no. 16, in which Vincent requested that Holder "identify and describe the facts concerning any agreements between [Holder] and any person referring to or relating to ... use of the VINCENT Marks, or any variation thereof, including without limitation, all licenses ...," Holder identified Coventry Spares as his main licensee. Holder also specifically discussed his licensing arrangement with Coventry Spares in his deposition (see Holder dep. at 67:2-72:19). Further, although Vincent claims that Holder did not provide information during his discovery deposition about the specific terms of the licensing agreement, there is no evidence that Vincent asked any questions regarding the nature of the arrangement with Coventry Spares, nor is there any evidence that Vincent inquired as to when the licensing arrangement had commenced. *See Milliken & Co. v. Image Industries Inc.*, 39 USPQ2d 1192 (TTAB 1996) (motion to exclude "new evidence" relied on in reply brief denied; the asserted failure to identify a witness was not supported by the identification of a discovery request requiring such identification). In view of

the foregoing, as to the Healy declaration, Vincent's motion to strike is **denied**.

However, with respect to the Godet declaration, we note that Holder failed to disclose Godet or his company in his response to interrogatory no. 16, although this information clearly is responsive to the interrogatory. Additionally, during his deposition, Holder did not identify Mr. Godet or his company as a licensee. Thus, as regards the Godet declaration, Vincent's motion to strike is **granted**. *See Presto Products*, 9 USPQ2d at 1897 n.5.

Motion for Summary Judgment on the Likelihood of Confusion Ground

Holder asserts that it "is uncontested that the marks VINCENT and VINCENT HRD of the parties are the same and the marks are used (or will be used, in the case of the opposed ITU application) on the same goods sold to the same classes of customers" (motion at 2-3). Thus, Holder's motion focuses on the issue of priority.

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute with respect to any material fact, thus leaving the case to be resolved as a matter of law. *See Fed. R. Civ. P. 56(c)(1)*. A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute as to a material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the

evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). Additionally, the evidence of record and all justifiable inferences that may be drawn from the undisputed facts must be viewed in the light most favorable to the non-moving party. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and *Opryland USA*, 23 USPQ2d at 1472.

Further, when a moving party's motion for summary judgment is supported by evidence sufficient to indicate that there is no genuine dispute as to any material fact and the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of a genuine dispute regarding at least one material fact which requires resolution at trial. The nonmoving party, however, may not rest on the mere allegations of its pleadings and assertions, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine dispute as to a material fact for trial. Consequently, factual assertions, without evidentiary support, are insufficient to defend against a motion for summary judgment. See *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1739 (TTAB 2001) ("applicant has produced no evidence, or raised any expectation that at trial it could produce

evidence.”); and *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1225 n.9 (TTAB 1987).

Cancellation No. 92055541

- *Standing*

We must first consider the question of whether Holder has demonstrated his standing to bring the cancellation, since standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). The purpose of the standing requirement, which is directed solely to the interest of the plaintiff, is to prevent litigation when there is no real controversy between the parties. *Id.* at 189.

In the petition for cancellation, Holder relies on his common law rights, alleging use of the trademarks VINCENT and VINCENT HRD. Holder avers in his declaration that his company, Velocette Vincent HRD Company, Ltd. (“Velocette Vincent”), which is owned by him and his wife, manufactures and sells in the United States motorcycle parts and accessories, literature or publications, and clothing under the marks VINCENT and VINCENT HRD (Holder dec., ¶¶ 1, 3, 4, and 6). Holder’s testimony is sufficient to show Holder’s standing, *see Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (common-law use sufficient to establish standing), and Vincent has not submitted any evidence that would raise a genuine dispute.

Accordingly, we find that there is no genuine dispute and that Holder has standing to bring the cancellation.

- *Priority*

Holder submitted with his motion his declaration and exhibits attached thereto, including photographs of motorcycle parts bearing the marks VINCENT and VINCENT HRD (Holder dec., Exh. 2) and a photograph of clothing bearing the mark VINCENT (*see id.*). Holder, in his declaration, attests that he, through Velocette Vincent, manufactures and has sold motorcycle parts and accessories and clothing in the United States since long prior to 1990 under the marks VINCENT and VINCENT HRD (Holder dec., ¶¶ 3, 6 and Exh. 2). In addition, Holder submitted the declaration of John Healy, the owner and chief manager of Coventry Spares, who attests that Coventry Spares operates under an oral license from Holder by which it sells motorcycle parts and accessories, clothing, and parts lists and other literature such as instruction manuals, under the trademarks VINCENT and VINCENT HRD; that it has operated under that license since approximately 1978; that his company has sold those products in the United States under those trademarks essentially continually from 1978 to August 7, 2014, the date of his declaration; and that the license was originally granted by Holder's father and was continued with Holder when he took over the business in the 1980s (Healy dec. ¶¶ 2, 4 and 5). Attached as exhibits to Mr.

Healy's declaration, *inter alia*, are photographs of the motorcycle parts and the caps and t-shirts bearing the VINCENT and VINCENT HRD marks.

The foregoing evidence shows that Holder, through his licensee Coventry Spares, has used the marks VINCENT and VINCENT HRD in the United States in connection with motorcycle parts and accessories and clothing, namely, caps and t-shirts, since at least as early as 1978. *See* Trademark Act Section 5, 15 U.S.C. § 1055 ("Where a ... mark sought to be registered is or may be used legitimately by related companies, such use shall inure to the benefit of the ... applicant for registration."). *See General Motors Corp. v. Aristide & Co.*, 87 USPQ2d 1179 (TTAB 2008) ("A trademark owner can rely on the use of a licensee for its priority.").

Nevertheless, Vincent asserts that a genuine dispute exists as to whether Holder owns any rights in the marks VINCENT and VINCENT HRD. Vincent contends that Holder has not presented any evidence that he is the successor-in-interest to the original Vincent HRD Company or that he inherited any rights to the marks from either of his parents. Further, Vincent argues that a genuine dispute exists as to whether consumers in the United States who encounter Holder's VINCENT or VINCENT HRD marks would attribute those marks to Holder, contending that Holder has not presented any evidence of use of the marks VINCENT or VINCENT HRD in the United States that consumers connect with him. As for the materials Holder provided purporting to show use of VINCENT or VINCENT HRD by related

parties, Vincent claims that Holder has not produced any corroborating evidence of license agreements, specific sales, or advertising in the United States with or by the alleged licensed dealers/distributors that show such use was on behalf of Holder. Moreover, with respect to the clothing sold by Coventry Spares for Holder, Vincent contends that because Holder admitted that he does not receive royalties from Coventry Spares for the sale of the clothing, and because Coventry Spares now “sells its own VINCENT clothing,” (response at 17) there is a genuine dispute as to whether Coventry Spares’ use of the VINCENT and VINCENT HRD marks is on Holder’s behalf. Finally, Vincent “suggests that Holder has lost any rights he had” because he took no action against Vincent’s predecessor-in-interest, Vincent Motors USA (owned by Bernard Li) and against Coventry Spares, whose website contains information regarding “Vincent parts” made by Maughan & Sons, a manufacturer unrelated to Holder or his licensees (response at 18).

Vincent has not demonstrated that there is a genuine dispute as to Holder’s priority. First, as to whether Holder owns trademark rights in the marks VINCENT and VINCENT HRD, Holder’s testimony establishes that Holder’s father purchased the original “Vincent HRD business” and “the [VINCENT] trademark” and “all intellectual property” from Harper Engines (which had purchased the original Vincent HRD business from Mr. E.C. Bailey) (Holder dep. at 17:12-24:17), and that Holder inherited the manufacturing company and marks from his mother who owned the company after his father’s death (Holder dec., ¶1). Second, as noted, Mr. Healy

testified that there has been an oral license between Holder and Coventry Spares since 1978 in connection with motorcycle parts and accessories, clothing, and parts lists (Healy dec., ¶2). Further, Holder testified that he reviews Coventry Spares' clothing items before Coventry Spares creates them and that Healy obtains Holder's approval before selling the clothing (Holder dep. at 70:18-72:19), testimony which is corroborated by Mr. Healy (Healy dec., ¶4). Third, Vincent's argument that "[t]he label does not identify either Holder or Velocette as the manufacturer or seller of the part" (response at 14) is unavailing. It is well-settled that trademarks may identify an anonymous source. Trademark Act Section 45, 15 U.S.C. § 1127. *See In re Polar Music Int'l AB*, 714 F.2d 1567, 221 USPQ 315, 317 (Fed. Cir. 1983) ("the public need not know the name of the owner of the mark"); and 1 McCarthy on Trademarks and Unfair Competition § 3.9 (4th ed. 2014). Furthermore, as noted *supra*, a trademark owner may rely on its licensee's use of the mark.

Finally, we are not persuaded by Vincent's argument that Holder's asserted "inaction" toward Vincent's predecessor-in-interest or Coventry Spares raises a genuine dispute for trial. First, in support of its contention that Holder has allowed Coventry Spares to sell parts not manufactured by Holder under the VINCENT mark, Vincent points to printouts from the Coventry Spares' website and from the www.sumpmagazine.com website to show that Maughan & Sons sells VINCENT parts. However, the printouts do not show that the goods sold by Maughan & Sons bear the trademark

VINCENT. Rather, the printouts show that Maughan & Sons sells parts for VINCENT motorcycles. Further, Mr. Healy's declaration corroborates that Coventry Spares identifies all manufacturers that make parts for Vincent motorcycles other than Vincent Velocette, and that those parts do not bear the VINCENT trademark (Healy dec., ¶¶10-11).

With respect to the claimed inaction towards Vincent's predecessor, to the extent Vincent is attempting to assert a laches defense, the parties' marks are identical and some of the goods, *i.e.*, caps and t-shirts, are identical. In such circumstances, likelihood of confusion is inevitable. *See Reflange Inc. v. R-Con Int'l*, 17 USPQ2d 1125, 1131 (TTAB 1990) (confusion is inevitable where the marks of the parties are identical and the goods are the same or essentially the same). If there is an inevitability of confusion, laches is not applicable. *See Ultra-White Co., Inc. v. Johnson Chemical Industries, Inc.*, 465 F.2d 891, 175 USPQ 166, 167 (CCPA 1972); *Turner v. Hops Grill & Bar Inc.*, 52 USPQ2d 1310 (TTAB 1999).

Accordingly, we find that Vincent has failed to raise a genuine dispute that Holder has abandoned his trademark through inaction.

In view of the foregoing, we find that there is no genuine dispute that Holder's date of first use in the United States of the marks VINCENT and VINCENT HRD for motorcycle parts and accessories and for clothing, specifically, t-shirts and caps, is 1978. As for Vincent's dates of first use, Vincent submitted, *inter alia*, a portion of the deposition of David Green,

owner of Vincent Motors LLC, in which Mr. Green discussed how the first use date of October 2003 asserted in the applications underlying its registrations was derived. Specifically, Mr. Green explained that “the information and records I had available to me [from his predecessor in interest when the applications were filed in August 2011] went back to 2003 ... so that’s what we were comfortable with ...” (Green dep., 44:3-44:21; Vincent’s response, Exh. 2). Mr. Green also testified that a colleague (Russ Pangborne) had a VINCENT HRD shirt dating from 1994 or 1995, and that he had found print advertising of Vincent’s predecessor, Vincent Motors USA, dating from “’94, ’95” (Green dep., 45:13-46:4). Vincent did not submit any other evidence to show an earlier date of first use through its predecessor. Even accepting these dates as the operative dates of first use, there is no genuine dispute that Holder’s date of first use, 1978, is earlier. In view thereof, there is no genuine dispute that Holder has priority with respect to the VINCENT and VINCENT HRD marks for motorcycle parts and accessories and clothing.

- *Likelihood of Confusion*

Turning to the issue of likelihood of confusion, first, as stated, there is no genuine dispute that Holder’s marks VINCENT and VINCENT HRD are identical to the registered marks VINCENT (U.S. Reg. No. 4128589) and VINCENT HRD (U.S. Reg. No. 4128588). Second, as to both registrations, there is no dispute that Holder’s clothing items for which it has demonstrated priority of use of the marks VINCENT and VINCENT HRD, *i.e.*, caps and

t-shirts, are legally identical to two of the goods identified in each registration.⁹ Thus, there is no genuine dispute that the marks are identical and the goods are, in part, identical. In view of the foregoing, and having drawn all justifiable inferences in a light most favorable to Vincent as the non-moving party, we find that there is no genuine dispute as to the material facts relating to the issue of likelihood of confusion, and that Holder has established as a matter of law that Vincent's marks VINCENT and VINCENT HRD for Vincent's identified goods, "caps, jackets, shirts, t-shirts" are likely to cause confusion with Holder's marks VINCENT and VINCENT HRD for Holder's caps and t-shirts. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application).

In summary, because there is no genuine dispute that Holder has standing and has made prior use in the United States of the VINCENT and VINCENT HRD marks for, *inter alia*, clothing; and there is no genuine dispute that Vincent's use of identical marks and identical goods is likely to cause confusion with Holder's marks and goods, Holder is entitled to summary judgment on the ground of likelihood of confusion.

⁹ The other identified goods are shirts and jackets.

Accordingly, Holder's motion for summary judgment on the ground of likelihood of confusion is **granted**. The petition to cancel is granted, and Registration Nos. 4128588 and 4128589 will be cancelled in due course.¹⁰

Opposition No. 91204404

- *Standing*

Holder relies in the notice of opposition only on his common law rights to the mark VINCENT. For the same reasons discussed above in connection with Holder's standing to maintain the cancellation, we find the evidence of record sufficient to show that there is no genuine dispute that Holder has standing to maintain the opposition.

- *Priority*

We have already determined that there is no genuine dispute that Holder's date of first use in the United States of the mark VINCENT for motorcycle parts and accessories and clothing, namely, caps and t-shirts, is 1978. As regards the opposed application, because it is based on Vincent's intent to use the mark VINCENT under Trademark Act Section 1(b), and because Vincent has not submitted any evidence of actual use of the mark VINCENT for the goods identified in the application, namely, motorcycle helmets and motorcycles and structural parts therefor, Vincent may only rely on the filing date of the application, *i.e.*, August 13, 2011, as its constructive date of first use. *See Syngenta Crop Protection Inc.*, 90 USPQ2d 1112, 1119

¹⁰ In view of our decision, we do not reach Holder's dilution claim.

(TTAB 2009); *Zirco Corp.*, 21 USPQ2d at 1544. In view thereof, there is no genuine dispute that Holder has priority with respect to the VINCENT mark for motorcycle parts and accessories and for clothing, namely caps and t-shirts.¹¹

- *Likelihood of Confusion*

There is no genuine dispute that Holder's mark VINCENT is identical to the applied-for mark VINCENT. Second, there is no dispute that certain of Holder's goods, *i.e.*, motorcycle parts, are identical to the structural parts for motorcycles identified in International Class 12 of Vincent's application. We note, in particular, the exhibits submitted with the Healy declaration which show and/or refer to structural parts of motorcycles, e.g., "rear mudguard hinges," "flexable [*sic*] drive" and "multi-plate clutches." In view of the foregoing, and having drawn all justifiable inferences in a light most favorable to Vincent as the non-moving party, we find that there is no genuine dispute that Vincent's mark VINCENT for "structural parts for motorcycles" listed in the Class 12 goods identified in the application is likely to cause confusion with Holder's mark VINCENT for motorcycle parts.¹²

¹¹ Vincent did not specifically indicate which of its arguments pertained to the opposition and which to the cancellation proceeding. To the extent that its claim of laches was intended to apply to the opposition, we note that laches does not begin to run until an application is published for opposition. *See National Cable Television Ass'n Inc. v. Am. Cinema Editors Inc.*, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991).

¹² In view thereof, there is no need for Holder to demonstrate likelihood of confusion in connection with the remaining goods in Vincent's application, namely, motorcycles. *See Tuxedo Monopoly, Inc.*, 209 USPQ at 288.

Accordingly, we grant Holder's motion for summary judgment on the ground of likelihood of confusion with respect to the application in Class 12, and the opposition with respect to this class is **sustained**.

As for the application in Class 9, Holder did not submit any evidence showing that he has used the mark VINCENT with the identified goods *i.e.*, motorcycle helmets. Nor has Holder submitted evidence to show that there is no genuine dispute as to the relatedness of motorcycle helmets and any of the goods for which Holder has shown use of his mark. Consequently, Holder has not met his burden of establishing that there is no genuine dispute as to material facts and that he is entitled to judgment as a matter of law on the ground of likelihood of confusion as to the goods identified in Class 9. Accordingly, Holder's motion for summary judgment with respect to the application in Class 9 is **denied**.

Summary

In summary, Eicher is joined as a party defendant, the petition for cancellation is granted as to each registration, and the opposition is sustained as to the goods identified in Class 12 only. The opposition will proceed and trial dates shall be reset only as to the goods identified in Class 9.

Holder's Dilution Claim in the Opposition

As noted *supra*, Holder has failed to properly assert in his dilution claim that his marks became famous in the United States prior to the constructive

first use date of Vincent's marks. Holder is allowed until **THIRTY DAYS** from the mailing date of this order to file an amended notice of opposition addressing this insufficiency, failing which paragraph 7 in the notice of opposition will be stricken. *See* Fed. R. Civ. P. 12(f).

Opposition Resumed and Trial Dates Reset for Class 9 Only

On June 25, 2014, prior to the submission of the summary judgment motion, the parties submitted a joint motion requesting that the dates in the proceedings be extended for two months in order to provide the parties time to review documents relating to the change to the party defendant. Although said motion is moot with respect to the cancellation and for Class 12 in the opposition, it is **granted** with respect to Class 9 in the opposition to the extent shown in the following schedule. *See* Trademark Rule 2.127(a).

The opposition proceeding is resumed solely with respect to Class 9 of the application. Trial dates are reset as follows:

Plaintiff's 30-day Trial Period Ends	3/17/2015
Defendant's Pretrial Disclosures Due	4/1/2015
Defendant's 30-day Trial Period Ends	5/16/2015
Plaintiff's Rebuttal Disclosures Due	5/31/2015
Plaintiff's 15-day Rebuttal Period Ends	6/30/2015

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. *See* Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

