

ESTTA Tracking number: **ESTTA554833**

Filing date: **08/19/2013**

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

Proceeding	91204861
Party	Defendant Jean Pierre Biane
Correspondence Address	Paulo A. de Almeida Patel & Almeida, P.C. 16830 VENTURA BLVD SUITE 360 ENCINO, CA 91436 UNITED STATES Paulo@PatelAlmeida.com
Submission	Opposition/Response to Motion
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Date	08/19/2013
Attachments	Applicant's Brief in Response to Opposer's Request for Discovery _8_19_13.pdf(3425777 bytes)

needed to obtain the information necessary to enable the party to respond to the motion for summary judgment. *Id.* The motion must also be supported by an affidavit showing that the nonmoving party cannot, for reasons stated therein, present facts essential to justify its opposition to the motion. *Id.*

It is not sufficient that a nonmoving party simply state in an affidavit supporting its motion under Fed. R. Civ. P. 56(d) that it needs discovery in order to respond to the motion for summary judgment; rather, the party must state therein the reasons why it is unable, without discovery, to present facts sufficient to show the existence of a genuine dispute of material fact for trial. *Id.* More precisely, the nonmoving party must demonstrate a specific need for specific facts and explain how the facts sought are reasonably expected to create a genuine issue of material fact. *See Strang Corp. v. The Stouffer Corp.*, 16 USPQ2d 1309, 1311 n.6 (TTAB 1990) (affidavit stating that "petitioner will seek to elicit information and obtain documents relevant to the issue of likelihood of confusion, including items relevant to consumer recognition, use, prior knowledge, channels of trade, consumer sophistication, and other Dupont factors" is considered to be no more than the "discovery for discovery's sake" that was condemned by the Court in *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989)); *see also Burlington Coat Factory Warehouse Corp. v. Esprit De Corp.*, 769 F.2d 919, 926 (2d Cir. 1985) (must show what facts are sought and how they are reasonably expected to create a genuine issue of material fact); *SEC v. Spence & Green Chem. Co.*, 612 F.2d 896, 901 (5th Cir. 1980) ("must conclusively justify entitlement to shelter of Rule 56(f) by presenting specific facts explaining inability to make substantive response required by Rule 56(e)"; "non movant may not simply rely on vague assertions that discovery will produce needed, but unspecified, facts"). Last, a factor to be

considered in whether to grant or deny the motion is "whether the information sought is largely within the control of the party moving for summary judgment." *Id.*

Here, the Board should first deny Opposer's Motion because Opposer has already demonstrated an ability to respond to the MSJ by essentially arguing its opposition to the MSJ as part of its Motion requesting discovery. Second, Opposer can easily obtain information about the single *DuPont* factor of the "similarity or dissimilarity of the marks" -- the *sole* issue raised in the MSJ -- by conducting its own research on facts which are not largely in control of the Applicant (i.e., whether Opposer's own mark in fact contains "rectangles" or "trapezoids" and a "circle"). Last, Opposer cannot possibly meet its burden of demonstrating that discovery is "necessary" because the affidavit of Opposer's counsel, Leah Z. Halpert, is completely devoid of any explanation as to how deposing Applicant regarding his personal opinion on "the similarity or dissimilarity of the marks" could even *possibly* be expected to create a genuine issue of material fact. This is "discovery for discovery's sake" and should not be permitted. Simply put, Opposer is perfectly capable of arguing, and the Board is perfectly capable of determining the sole issue of the "similarity or dissimilarity of the marks" *without* the need for deposing Applicant.

Opposer Has Already Demonstrated an Ability to Respond to the MSJ Without Discovery

Opposer is perfectly capable of responding to the MSJ without discovery, and in fact has already argued its opposition to the MSJ (at least in part) *within* the instant Motion requesting discovery. For example, Opposer forcefully argues three times in its Motion that "Applicant concedes that every other relevant factor for a likelihood of confusion analysis weighs in favor of Opposer"; *Motion* at 2, 4, 8. This is *precisely* what Opposer will argue in response to the MSJ -- i.e., that most or all of the *DuPont* factors weigh in favor of Opposer, and therefore that "confusion is likely" (a conclusion with which Applicant strongly disagrees). By reiterating this point *three*

times in its Motion, Opposer has demonstrated its ability to respond to the MSJ without any discovery.

Next, Opposer has demonstrated its ability to substantively respond to the MSJ without discovery by forcefully attacking the sufficiency of the evidence presented in support of the MSJ. Specifically, Opposer argues that the Declaration of Jean P. Biane is "the *only* evidence presented in support of the Motion"; *id.* at 2; that Applicant presents *only* "two conclusory statements that that [sic] Applicant's Mark is not similar to Opposer's Mark"; *id.*; and that "Applicant does not provide any evidence to support these legal conclusions" *Id.* Essentially, Opposer has devoted an entire *eight pages* to attacking the sufficiency of Applicant's Declaration in support of the MSJ.

By forcefully attacking the sufficiency of the Declaration and *repeatedly* arguing that "every other relevant [DuPont] factor" weighs in Opposer's favor, Opposer has clearly demonstrated its ability to oppose Applicant's MSJ without the need for discovery. In fact, Opposer will continue to emphasize the exact same arguments in its forthcoming opposition to the MSJ. All that is missing from the Motion is a statement of Opposer's subjective (and incorrect) belief that the marks are "similar" and "likely to cause confusion". Accordingly, Opposer has already demonstrated an ability to substantively respond to the MSJ without the need for a deposition.

Opposer's Affidavit in Support of its Motion Fails to Explain Why Discovery is Necessary

Next, the Declaration of Leah Z. Halpert in support of Opposer's Motion is completely devoid of any explanation as to what *specific facts* Opposer expects to uncover through a deposition or *how* the information is reasonably expected to create a genuine issue of material fact. *See Burlington Coat Factory*, 769 F.2d at 926 (must show what facts are sought and how they are

reasonably expected to create a genuine issue of material fact); *SEC v. Spence & Green*, 612 F.2d at 901 (5th Cir. 1980) ("must conclusively justify entitlement to shelter of Rule 56(f) by presenting specific facts explaining inability to make substantive response required by Rule 56(e)"; "non movant may not simply rely on vague assertions that discovery will produce needed, but unspecified, facts").

Specifically, the Declaration of Leah Z. Halpert merely states that Opposer "needs" to depose Applicant regarding his "opinion" that "the marks are dissimilar and therefore, confusion is not likely". *Motion* at 4. However, Applicant's beliefs regarding "likelihood of confusion" are not merely statements of opinion; they are legal conclusions and the ultimate facts of this case. Opposer has offered no explanation as to how deposing Applicant regarding his belief that the marks are "dissimilar" and "confusion is not likely" could possibly uncover a genuine issue of material fact. Instead, Opposer's suggestion that it "needs" to conduct discovery on legal conclusions and ultimate facts is precisely the "discovery for discovery's sake" which the Board has strictly prohibited in the past. *See Strang Corp. v. The Stouffer Corp.*, 16 USPQ2d 1309, 1311 n.6 (TTAB 1990) (affidavit stating that "petitioner will seek to elicit information and obtain documents relevant to the issue of likelihood of confusion, including items relevant to consumer recognition, use, prior knowledge, channels of trade, consumer sophistication, and other Dupont factors" is considered to be no more than the "discovery for discovery's sake" that was condemned by the Court in *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989)). Accordingly, Opposer's Motion falls far short of the requirement that Opposer demonstrate a specific need for specific facts and explain how the facts sought are reasonably expected to create a genuine issue of material fact. *See* TMEP § 528.06.

The Information Sought by Opposer is Not Within Applicant's Control

As explained above, the Declaration of Leah Z. Halpert is completely devoid of any explanation as to *what* exactly Opposer expects to learn from Applicant during a deposition. Nor does the Declaration explain *how* a deposition on the sole issue of the "similarity or dissimilarity of the marks" -- during which Applicant would simply recite aloud his belief that "the marks are not similar and thus confusion is not likely" -- could even possibly create a material dispute of fact.

Even assuming, however, that Opposer *could possibly* discover more "information" about Applicant's "opinions" regarding the "dissimilarity" of the marks by deposing him, such a deposition would be wholly unnecessary because that information is not "largely within the Applicant's control". TMEP § 528.06. Rather, the dissimilarities between the marks (which Opposer has the onerous burden to materially dispute) are self-evident and can be determined through a simple visual comparison of the marks side-by-side. In fact, it is clear that the opinions set forth in Applicant's Declaration are *wholly* based on Applicant's visual comparison of the marks side-by-side -- not on any other information which Opposer claims to "need". For example, Applicant's Declaration sets forth specific, objective facts supporting *why* the marks are "dissimilar" in appearance, including describing the "trapezoids" and "circle" in Opposer's mark and the "rectangles" in Applicant's mark. See Declaration of Jean Pierre Biane at ¶ 4. The Board should note that Opposer does not specify, as it is required to do under Fed. R. Civ. Pro. 56(d), that there is some *other* basis for Applicant's opinion (aside from a visual comparison of the marks) which Opposer *cannot* now determine and which *requires* additional discovery. Accordingly, because Applicant's Declaration is based on objective facts easily ascertainable through a side-by-side comparison of the marks, the information sought is not "largely within the Applicant's control" and additional discovery on the subject is unnecessary.

Opposer then inexplicably argues that a deposition is *necessary* to ascertain facts concerning whether Opposer's mark contains "trapezoids of alternating shades and a small circle placed directly in the center of the design" and whether Applicant's mark contains "rectangles of alternating shades and no circle directly in the center of the mark", both of which, when asserted by Applicant, are somehow "purely his opinion". *Motion* at 3. Opposer is incorrect because the facts asserted are objective in nature and are not subject to reasonable dispute. Being objective facts, they are not "largely within Applicant's control". *See* TMEP § 528.06. To the extent Opposer intends to dispute the objective meaning of the words "trapezoid", "rectangle" and "circle" as used by Applicant, Opposer is free to do so in its forthcoming opposition to the MSJ. Even assuming, *arguendo*, that the meanings of the words "trapezoid", "rectangle" and "circle" are unclear and their application to the marks at issue somehow raises *genuine* issues of material fact, Opposer is free to research the definitions for "trapezoid", "rectangle" and "circle" on its own, and a deposition of Applicant regarding his understanding of basic shapes is therefore totally inappropriate.

To remove any doubt that objective facts about basic shapes is not "largely within Applicant's control", Applicant submits herewith as *Exhibit A* copies of dictionary definitions of "trapezoid", "rectangle" and "circle" of which the Board may take judicial notice. FRE 201; see also *Lee v. City of Los Angeles* (9th Cir. 2001) 250 F3d 668, 688–690. Opposer is now free to consult *Exhibit A* to understand the well-accepted definitions of "trapezoid", "rectangle" and "circle" as used by Applicant in his declaration. Accordingly, information about the "dissimilarity of the marks" is not "largely within Applicant's control", and thus discovery is not necessary for Opposer to respond to the MSJ. *See* TMEP § 528.06.

The Board Has Denied Other Motions for Additional Discovery Under Similar Circumstances

The circumstances here are similar to those presented in *Cytosport, Inc. v.*

Comercializadora de Lacteos y Derivados, S.A. de C.V., 2011 TTAB LEXIS 325

(non-precedential), in which the Board denied the opposer's motion for additional discovery pursuant to Fed. R. Civ. Pro 56(d). The opposer argued that it could not respond to the applicant's MSJ without first conducting additional discovery on, among other things, the possible English translations of the Spanish word "leche" which was part of the applicant's mark NUTRI LECHE.

The Board summarily denied the opposer's motion:

We note that applicant's motion for summary judgment only concerns whether the marks at issue are sufficiently similar and/or dissimilar for likelihood of confusion purposes and that for purposes of the motion, applicant has effectively conceded that all of the other likelihood of confusion factors favor finding that there is a likelihood of confusion. We further note that opposer has been able to respond substantively to this limited issue without the need for the requested additional discovery.

With regard to opposer's alleged need to obtain discovery from applicant regarding all English translations of applicant's NUTRI LECHE mark, we note that applicant has already made of record a dictionary definition of the term "LECHE" and, to the extent there are other definitions of said term, opposer can obtain such definitions by conducting its own research. Accordingly, opposer's motion for continued discovery under Fed. R. Civ. P. 56(d) is denied.

Cytosport, Inc. v. Comercializadora de Lacteos, 2011 TTAB LEXIS 325 at 10-11.

Like *Nutri Leche*, Opposer here has already presented its opposition to Applicant's MSJ (at least in part) by attacking the sufficiency of Applicant's Declaration and repeatedly arguing that Applicant has conceded "every other *DuPont* factor". See *Motion* at 2, 4, 8. Moreover, Opposer is also free to argue that the marks are "similar" in "appearance, sound, meaning, and commercial impression" (although Applicant strongly disagrees) in its forthcoming opposition to MSJ by presenting its own arguments and evidence based on information already in Opposer's control (i.e., by looking at the marks and comparing them in its opposition brief). Like *Nutri Leche*, Opposer

here is also free to conduct its own additional research on why the marks at issue are "similar or dissimilar", including whether the marks in fact contain "trapezoids", "rectangles", or "circles". Again like *Nutri Leche*, Applicant here has already made of record dictionary definitions of the terms "trapezoid", "rectangle" and "circle" used by Applicant to describe the marks. *See Exhibit A*. Opposer is now in possession of everything it needs to provide a substantive response to the MSJ. Accordingly, Opposer's Motion falls far short of what is necessary, under Fed. R. Civ. Pro 56(a), to show that additional discovery is necessary to respond to the MSJ.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the Board deny Opposer's Motion in its entirety.

Date: August 19, 2013

Respectfully submitted,

/Paulo A. de Almeida/
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PROOF OF SERVICE

I hereby certify that a true and complete copy of the foregoing **BRIEF IN RESPONSE TO OPPOSER'S REQUEST FOR DISCOVERY TO RESPOND TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT** has been served on Martin R. Greenstein, counsel for Opposer, on August 19, 2013, via First Class U.S. Mail, postage prepaid to:

Martin R. Greenstein
TechMark a Law Corporation
4820 Harwood Road, 2nd Floor
San Jose, CA 95124-5273

By: /Paulo A. de Almeida/
Paulo A. de Almeida

EXHIBIT A



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trapezoid

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2 ENTRIES FOUND:

- trapezoid
- isosceles trapezoid

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trap·e·zoid noun \ˈtrā-pē-zoid\

Definition of TRAPEZOID

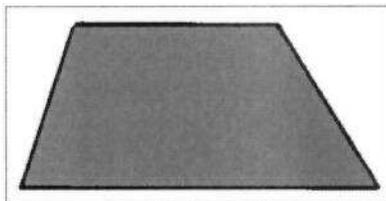
Like

- a** *British* : TRAPEZIUM 1a
b : a quadrilateral having only two sides parallel
- : a bone in the wrist at the base of the metacarpal of the index finger

— trap·e·zoi·dal *adjective*

- ☑ See trapezoid defined for English-language learners »
- See trapezoid defined for kids »

Illustration of TRAPEZOID



Origin of TRAPEZOID

New Latin *trapezoides*, from Greek *trapezoidēs* trapezium-shaped, from *trapeza* table

First Known Use: circa 1706

Rhymes with TRAPEZOID

adenoid alkaloid amoeboid aneroid anthropoid arachnoid asteroid Australoid carcinoid Caucasoid celluloid crystalloid echinoid...

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trap·e·zoid *noun* \ˈtrap-ə-ˈzɔɪd/ (Medical
Dictionary)

Medical Definition of TRAPEZOID

??????

: a bone in the distal row of the carpus at the base of
the index finger—called also *lesser multangular*, *trapezoid
bone*, *trapezoideum*

Illustration of TRAPEZOID



Learn More About TRAPEZOID

Spanish Central: Spanish translation of "trapezoid"

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rectangle

rectangle

Popularity

2 ENTRIES FOUND:

- rectangle
- golden rectangle

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rect·an·gle *noun* ˈrɛk-tən-jəl

Definition of RECTANGLE

: a parallelogram all of whose angles are right angles; *especially* : one with adjacent sides of unequal length

- See rectangle defined for English-language learners »
- See rectangle defined for kids »

Origin of RECTANGLE

Medieval Latin *rectangulus* having a right angle, from Latin *rectus* right + *angulus* angle — more at RIGHT, ANGLE

First Known Use: 1571

Rhymes with RECTANGLE

embrangle entangle face angle pentangle quadrangle right angle round angle straight angle triangle untangle wide-angle

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- Spanish Central: Spanish translation of "rectangle"
- Britannica.com: Encyclopedia article about "rectangle"

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circle

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86 ENTRIES FOUND:

- circle
- circle brick
- circle dance

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¹cir·cle *noun, often attributive* \sər-'kəl

Definition of CIRCLE

Like

- 1 a :** RING, HALO
 - b :** a closed plane curve every point of which is equidistant from a fixed point within the curve
 - c :** the plane surface bounded by such a curve
- 2 archaic :** the orbit of a celestial body
- 3 :** something in the form of a circle or section of a circle: as
 - a :** DIADEM
 - b :** an instrument of astronomical observation the graduated limb of which consists of an entire circle
 - c :** a balcony or tier of seats in a theater
 - d :** a circle formed on the surface of a sphere by the intersection of a plane that passes through it <circle of latitude>
 - e :** ROTARY 2
- 4 :** an area of action or influence : REALM
- 5 a :** CYCLE, ROUND <the wheel has come full circle>
 - b :** fallacious reasoning in which something to be demonstrated is covertly assumed
- 6 :** a group of persons sharing a common interest or revolving about a common center <the sewing circle of her church> <family circle> <the gossip of court circles>
- 7 :** a territorial or administrative division or district
- 8 :** a curving side street

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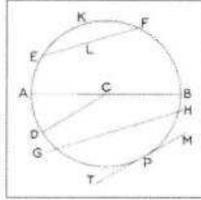
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Examples of **CIRCLE**

- She drew a *circle* around the correct answer.
- We formed a *circle* around the campfire.
- He looked old and tired, with dark *circles* under his eyes.
- She has a large *circle* of friends.
- She is well-known in banking *circles*.

Illustration of **CIRCLE**



Origin of **CIRCLE**

Middle English *cercle*, from Anglo-French, from Latin *circulus*, diminutive of *circus* circle, circus, from or akin to Greek *krikos*, *kirkos* ring; akin to Old English *hring* ring — more at [RING](#)

First Known Use: 14th century

Related to **CIRCLE**

Synonyms

cirque ring round roundel

Related Words

circlet ringlet ellipse loop oval ball globe orb sphere

Near Antonyms

loner individualist

more

²circle *verb*

cir-cled **cir-cling**

Definition of **CIRCLE**

transitive verb

- 1** : to enclose in or as if in a circle
- 2** : to move or revolve around <satellites *circling* the earth>

intransitive verb

- 1 a** : to move in or as if in a circle
- b** : [CIRCULATE](#)
- 2** : to describe or extend in a circle

— **cir-cler** *noun*

🔍 See [circle](#) defined for English-language learners »

Examples of **CIRCLE**

- He *circled* his arms around his wife's waist.
- His arms *circled* around his wife's waist.



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She *circled* the correct answer.

The pilot *circled* the airport before landing.

The halfback *circled* to the left.

First Known Use of CIRCLE

14th century

Related to CIRCLE

Synonyms

surround compass embrace encircle enclose *also*
inclose encompass environ gird girdle ring wreath

Related Words

circumscribe close in cordon (off) fence (in) hem (in)
wall beset besiege entrench *also* intrench invest
swarm

more

circle *noun* \sər-kəl/ (*Medical Dictionary*)

Medical Definition of CIRCLE

??????

- a** : a closed plane curve every point of which is equidistant from a fixed point within the curve
b : the plane surface bounded by such a curve
- 2** : something (as an anatomical part) in the form of a circle or section of a circle <an arterial *circle*>—see CIRCLE OF WILLIS

circle *noun* (Concise Encyclopedia)

Geometrical curve, one of the CONIC SECTIONS, consisting of the set of all points the same distance (the radius) from a given point (the centre). A line connecting any two points on a circle is called a chord, and a chord passing through the centre is called a diameter. The distance around a circle (the circumference) equals the length of a diameter multiplied by π (see P_1). The area of a circle is the square of the radius multiplied by π . An arc consists of any part of a circle encompassed by an angle with its vertex at the centre (central angle). Its length is in the same proportion to the circumference as the central angle is to a full revolution.

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EXHIBIT B



1 of 1 DOCUMENT

Cytosport, Inc. v. Comercializadora de Lacteos y Derivados, S.A. de C.V.

Opposition No. 91194995

Trademark Trial and Appeal Board

2011 TTAB LEXIS 325

September 26, 2011, Decided

JUDGES: [*1]

Before Bucher, Zervas, and Bergsman, Administrative Trademark Judges.

OPINION:

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

By the Board:

Comercializadora de Lacteos y Derivados, S.A. de C.V. ("applicant") seeks to register the mark NUTRI LECHE in standard character format for "milk-based beverages containing milk concentrates, vegetable oil and added nutrients" in International Class 29. n1 Applicant has provided the English translation of the Spanish term "LECHE" to mean "milk." Applicant has also disclaimed the term "LECHE."

n1 Application Serial No. 77502817, filed on June 19, 2008 pursuant to Trademark Act Section 44(e).

Cytosport Inc. ("opposer") has filed a notice of opposition to registration of applicant's NUTRI LECHE mark. As grounds for opposition, opposer alleges priority of use and that applicant's mark, when used on the identified goods, so resembles opposer's previously used and registered family of "MILK" marks, as identified below, as to be likely to cause confusion, mistake [*2] or to deceive under Section 2(d) of the Trademark Act.

Opposer's pleaded marks are as follows:

MUSCLE MILK for "powdered nutritional supplement containing milk derived ingredients for adding to food or drink" in International Class 5; n2

n2 Registration No. 2714802, issued on May 13, 2003, claiming June 1, 1998 as both the date of first use

anywhere and date of first use in commerce. Section 8 and 15 affidavits accepted and acknowledged on December 17, 2008.

MUSCLE MILK for "nutritional supplements" in International Class 5; n3

n3 Registration No. 2809666, issued on February 4, 2003, claiming October 8, 1999 as both the date of first use anywhere and the date of first use in commerce. The term "MUSLCE" is disclaimed. Section 8 and 15 affidavits accepted and acknowledged on April 14, 2009.

MUSLCE MILK for "meal replacement [*3] drinks; meal replacement and dietary supplement drink mixes; protein based, nutrient-dense meal replacement bars; and pre-mixed nutritionally fortified beverages" in International Class 5 and "protein based, nutrient-dense snack bars" in International Class 29; n4

n4 Registration No. 2973352, issued on July 19, 2007, claiming October 1, 2001, as both the date of first use anywhere and date of first use in commerce. Section 8 affidavit accepted on May 7, 2011.

MUSCLE MILK LIGHT for "dietary and nutritional supplements" in International Class 5; n5

n5 Registration No. 3333886, issued on November 13, 2007, claiming January 31, 2007 as both the date of first use anywhere and date of first use in commerce. The term "LIGHT" is disclaimed.

MUSCLE MILK N' OATS for "dietary and nutritional supplements" in International Class 5 and [*4] "fortified food, namely, protein based, nutrient-dense oatmeal" in International Class 30; n6

n6 Registration No. 3311489, issued on October 16, 2007, claiming January 31, 2006 as both date of first use anywhere and date of first use in commerce for both classes. The term "OATS" is disclaimed.

MUSCLE MILK PUDDING for "dietary and nutritional supplements" in International Class 5 and "fortified food, namely, protein based, nutrient-dense oatmeal" in International Class 30; n7

n7 Registration No. 3311490 issued on October 16, 2007, claiming January 31, 2007 as both date of first use anywhere and date of first use in commerce for both classes. The term "PUDDING" is disclaimed.

MIGHTY MILK for "dietary and nutritional supplements" in International Class 5; n8 and

n8 Registration No. 3132139, issued on August 22, 2006, claiming December 31, 2004 as the date of first use anywhere and July 31, 2005 as the date of first use in commerce.

[*5]

MIGHTY MILK BAR for "dietary and nutritional supplement" in International Class 5 and "fortified food, namely, protein based, nutrient-dense oatmeal" in International Class 30. n9

n9 Registration No. 3886569, issued on December 7, 2010, claiming October 14, 2010 as both the date of first use anywhere and date of first use in commerce for both classes. The term "BAR" is disclaimed.

Opposer has also pleaded ownership of two applications; one for the mark MIGHTY MILK N' OATS n10 and the other for the mark MIGHTY MILK PUDDING. n11 Both applications recite "dietary and nutritional supplement" in International Class 5 and "fortified food, namely, protein based, nutrient-dense oatmeal" in International Class 30.

n10 Application Serial No. 77103659, filed on February 9, 2007, based upon an allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

n11 Application Serial No. 77103668, filed on February 9, 2007, based upon an allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act. The Board notes that this application has been abandoned for failure to file a timely Statement of Use.

[*6]

Applicant, in its answer, has denied the salient allegations of the notice of opposition.

Applicant's Motion for Summary Judgment

This case now comes before the Board for consideration of applicant's motion for summary judgment on opposer's asserted claim of likelihood of confusion. The motion is fully briefed.

In support of its motion, applicant, while conceding for the purpose of its motion that opposer owns valid trademarks and has priority, essentially argues that the differences in appearance, pronunciation and commercial impression between applicant's NUTRI LECHE mark and opposer's pleaded MILK marks are so great that confusion as to source is not likely. Specifically, applicant contends that the dominant element of its mark is the wording NUTRI

which has no meaning, although it may suggest a product that is "nutritious" or contains "nutrients." As such, applicant maintains that the term NUTRI is more likely to be noticed and recalled by potential consumers.

Moreover, applicant argues that while the terms "LECHE" and "MILK" mean the same thing in the abstract, they have different connotations when used in the parties' respective marks. In support of this point, [*7] applicant states that it has agreed to disclaim the term LECHE because it is descriptive of its milk-based beverage products. In contrast, applicant maintains that opposer successfully disputed the Office's requirement to disclaim MILK in opposer's applications for the marks MIGHTY MILK and MUSCLE MILK by arguing that the term MILK, as used in opposer's marks, suggests that opposer's goods replicate mother's milk in that the goods are natural, healthy and nutritious. Further, applicant maintains that confusion is unlikely between marks that share a descriptive or suggestive term, i.e., the term "milk" and the Spanish equivalent thereof, when the dominant elements of the marks are completely different.

As evidence in support of its motion, applicant has submitted the declaration of John M. Murphy, counsel for applicant, which introduces the following exhibits: (i) a printout from the USPTO's TARR database displaying the status of application Serial No. 77103668 for the mark MIGHTY MILK PUDDING; (ii) an excerpt from the *Larousse Gran Diccionario Ingles-Espanol*, with an English translation of the Spanish word "leche"; (iii) copies of an office action dated October 1, 2008, and the [*8] response thereto dated March 23, 2009 regarding application Serial No. 77502817 to register the mark NUTRI LECHE; (iv) a response to an office action dated June 21, 2004 in application Serial No. 7854425 to register the mark MUSCLE MILK; and (v) a response to an office action dated March 20, 2006 in application Serial No. 78574711 to register the mark MIGHTY MILK.

In response, opposer maintains that there are sufficient similarities between the marks such that a reasonable fact finder could find that similarities between the marks, taken together with the relatedness of the respective goods and channels of trade, are sufficient such that a likelihood of confusion does exist between the marks. Specifically, opposer contends that because the term LECHE means "milk," applicant's mark should be interpreted as NUTRI MILK. n12 As such, opposer argues that a fact finder could conclude that consumers are likely to believe that the mark NUTRI LECHE is part of opposer's family of MILK marks, and that the product used in connection with the NUTRI LECHE mark originates from the same source as opposer's products.

n12 We note that this argument is not supported by any declaration or any other evidence of record.

[*9]

Opposer further argues that it is unclear from the record whether the term "LECHE" in applicant's mark is in fact generic, descriptive or suggestive of applicant's identified goods and, therefore, additional discovery is required to make such determination. To the extent such discovery would reveal that the term "LECHE" is suggestive of applicant's identified goods, opposer maintains that there is even a greater probability that a likelihood of confusion exists between applicant's NUTRI LECHE mark and opposer's pleaded MIGHTY MILK and MUSCLE MILK marks. Opposer also argues that even if the word "leche" aka "milk" is determined to be descriptive, it does not mean that the respective marks are not confusingly similar. The fact that a word, which is part of a trademark, is deemed descriptive does not remove the word from the mark and remains visible, audible and meaningful to consumers. In other words, opposer contends that consumers will not discount the word "leche" aka "milk" from NUTRI LECHE mark based on whether the product does or does not contain dairy milk; rather, upon hearing or seeing applicant's NUTRI LECHE mark on beverage products, consumers familiar with opposer's family [*10] of MILK marks would likely believe that the respective marks and products are affiliated.

Finally, opposer argues that summary dismissal is improper where dissimilarity of the marks alone is the basis for concluding that there is no issue of fact as to likelihood of confusion. Opposer contends that, even if the Board were to agree with applicant, and concludes that the respective marks are dissimilar, this factor alone does not obviate the need

to consider other important factors, such as the relatedness of the parties' respective goods and the channels of trade through which they travel, in making a final determination as to whether a likelihood of confusion exists.

As evidence in support of its motion, opposer has submitted the declaration of Roberta White, Vice President of Legal and Regulatory Affairs for opposer, who declares that (1) opposer first used its MUSCLE MILK mark in 1998; (2) opposer's products are sold and marketed at health and nutrition retail outlets, convenience stores, club stores and fitness gyms; (3) opposer markets its goods to both English and Spanish speaking consumers and that opposer has several marketing campaigns directed specifically to Spanish speaking [*11] consumers in the United States; and (4) opposer currently uses a family of MILK marks in connection with some of its dietary and nutritional supplements. The declaration also introduces copies of various federal registrations for MILK marks owned by opposer. Opposer also introduces, *inter alia*, without a supporting declaration, (1) a printout of the prosecution history of applicant's involved application; n13 (2) copies of its pleaded registrations; and (3) a printout of C.F.R. Title 21, Chapter 1, Part 131, Sec. 131.110 which provides a description of milk and its properties as defined by the Food and Drug Administration.

n13 The submission of the file history of applicant's involved application is unnecessary inasmuch as it is already of record. *See* Trademark Rule 2.122(b)(1).

Concurrently with its opposition to applicant's motion for summary judgment, opposer has also filed a motion for continued discovery under Fed. R. Civ. P. 56(d).

In reply, applicant disputes opposer's need for additional [*12] discovery inasmuch as opposer has been able to respond substantively to applicant's motion. Moreover, applicant argues that opposer has not demonstrated ownership of a family of "MILK" marks because opposer has failed to show that its pleaded marks have been used and advertised in such a manner as to create common exposure and recognition of common ownership. Applicant contends that opposer's only support for its contention that it owns a family of MILK marks is the declaration of opposer's in-house counsel which applicant argues is pure assertion, not evidence. Lastly, applicant argues that that dissimilarities of the marks alone is sufficient to find that a likelihood of confusion does not exist.

We first turn to opposer's motion for continued discovery under Fed. R. Civ. P. 56(d). In support of its motion, opposer contends that it needs discovery regarding the following subject matters in order to respond properly to applicant's motion for summary judgment:

1. Information regarding all possible English translations of applicant's NURTI LECHE mark;
2. Information regarding the products with which applicant has used or intends to use the NURTI LECHE mark;
3. Information regarding [*13] applicant's date of first use of the NURTI LECHE mark;
4. Information regarding the consumers to which applicant markets or intends to market its products;
5. Information regarding the channels of trade through which applicant distributes or intends to distribute its products;
6. Information regarding the circumstances under which applicant became aware of opposer's MILK marks;
7. Information regarding the primary ingredients and nutrients found in applicant's product;
8. Information regarding whether applicant's products are "nutritionally fortified;" and
9. Information regarding whether applicant's products identified for use in connection with the NURTI LECHE mark are or contain "milk" as that term is defined by the U.S. Food and Drug Administration in 21 CFR § 131.110.

We note that applicant's motion for summary judgment only concerns whether the marks at issue are sufficiently similar and/or dissimilar for likelihood of confusion purposes and that for purposes of the motion, applicant has

effectively conceded that all of the other likelihood of confusion factors favor finding that there is a likelihood of confusion. We further note that opposer has been able to respond [*14] substantively to this limited issue without the need for the requested additional discovery. *See Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.*, 63 USPQ2d 2009, 2012 n. 8 (TTAB 2002) ("Inasmuch as opposer has submitted a substantive response to applicant's motion for summary judgment, opposer's request for discovery pursuant to Fed. R. Civ. P. 56(f) is denied"). Moreover, we find that the discovery requested by opposer goes beyond the scope of the issues presented in applicant's motion and therefore such discovery is unnecessary for purposes of responding to applicant's motion for summary judgment. With regard to opposer's alleged need to obtain discovery from applicant regarding all English translations of applicant's NUTRI LECHE mark, we note that applicant has already made of record a dictionary definition of the term "LECHE" and, to the extent there are other definitions of said term, opposer can obtain such definitions by conducting its own research. Accordingly, opposer's motion for continued discovery under Fed. R. Civ. P. 56(d) is denied.

We now turn to the merits of applicant's motion for summary judgment. In a motion for summary judgment, the moving [*15] party has the burden of establishing the absence of any genuine dispute of material fact and that it is entitled to judgment as a matter of law. *See Fed. R. Civ. P. 56*. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. *See Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ 1542 (Fed. Cir. 1992).

In the present case, we find that applicant has adequately met its burden of proof of showing that no genuine dispute of material fact exists, and that there is no likelihood of confusion as a matter of law with regard to all of opposer's pleaded marks. We believe that the circumstances here are similar to those in *Kellogg Co. v. Pack'em Enterprises, Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991), [*16] in that the single *DuPont* n14 factor of the dissimilarity of the marks in their entireties substantially outweighs any other relevant factors and is dispositive of the issue of likelihood of confusion.

n14 *See In re E.I. DuPont deNemours & Co.*, 476 F.2d 1357, 177 USPQ 463 (CCPA 1973).

As noted above, in bringing its motion for summary judgment based solely on the dissimilarities of the parties' respective marks, applicant has effectively conceded all other relevant *DuPont* factors in opposer's favor for the purposes of applicant's motion, and the Board has so considered those factors as favoring opposer. Thus, even viewing the other relevant *DuPont* factors in opposer's favor, the dissimilarities of the marks are so great as to avoid likelihood of confusion.

While we acknowledge that the term "LECHE" contained in applicant's involved mark means "milk" in English, we note that applicant seeks to register the mark NUTRI LECHE not NUTRI MILK. As such, we find that applicant's mark creates [*17] a markedly different visual appearance as compared to opposer's pleaded MILK marks. In addition to the visual differences, applicant's NUTRI LECHE mark and opposer's pleaded MILK marks, when considered as a whole, do not sound alike. Further, the marks do not share the same meaning; the first term in applicant's mark, i.e., NUTRI, is not a recognized word but may suggest that applicant's goods are nutritious or contain nutrients. In comparison, the first terms in opposer's pleaded marks are MUSCLE n15 and MIGHTY n16 which do not convey anything about nutrients or nutrition. In view thereof, we find that when wording with completely different connotations is added before LECHE and MILK, i.e., NUTRI on the one hand and MUSCLE and MIGHTY on the other, the ensuing combination of the terms create marks with completely different connotations. The commercial impressions of applicant's mark is different from opposer's marks too because of the differences in connotation, appearance and sound.

n15 **mus.cle** '*noun, verb, -cled, -cling, adjective*

noun

1. a tissue composed of cells or fibers, the contraction of which produces movement in the body.
2. an organ, composed of muscle tissue, that contracts to produce a particular movement.
3. muscular strength; brawn: *It will take a great deal of muscle to move this box.*
4. power or force, especially of a coercive nature: *They put muscle into their policy and sent the marines.*
5. lean meat.

The American Heritage(R) Dictionary of the English Language (4th Ed. 2006).

[*18]

n16 **might.y** *adjective, might.i.er, might.i.est, adverb, noun*

adjective

1. having, characterized by, or showing superior power or strength: *mighty rulers.*
2. of great size; huge: *a mighty oak.*
3. great in amount, extent, degree, or importance; exceptional: *a mighty accomplishment.*

The American Heritage(R) Dictionary of the English Language (4th Ed. 2006).

The Board may take judicial notice of dictionary definitions, including online reference works which exist in print format or have regular fixed editions. See *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1590 (TTAB 2008) (judicial notice taken of definition from the Merriam-Webster Online Dictionary).

We would arrive at the same conclusion even if opposer established that it owns a family of " MILK" marks and purchasers understand that the English translation of "leche" is "milk." The differences in sound, meaning and appearance noted above sufficiently distinguish opposer's pleaded MILK marks from applicant's mark which would not lead [*19] a prospective purchaser to conclude that NUTRI LECHE is part of opposer's alleged family of marks.

In view of the foregoing, we find that applicant's involved NUTRI LECHE mark and opposer's pleaded MILK marks, considered in their entirety, are dissimilar in appearance, sound, and connotation, and create utterly dissimilar commercial impressions. See *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998) (court affirms Board dismissal of opposition based on dissimilarity of the marks CRISTAL and CRYSTAL CREEK); *Kellogg Co. v. Pack'em Enterprises, Inc.*, 21 USPQ2d at 1145 (court affirms Board dismissal of opposition based on dissimilarity of the marks FROOTEE ICE and elephant design and FRUIT LOOPS); *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989)(court affirms Board dismissal of opposition based on dissimilarity of the marks PECAN SANDIES and PECAN SHORTEES). See also *Sears Mortgage Corp. v. Northeast Savings F.A.*, 24 USPQ2d 1227 (TTAB 1992)(dissimilarity between the marks APPROVAL PLUS and APPROVALFIRST dispositive).

Accordingly, applicant's [*20] motion for summary judgment is granted, and the opposition is dismissed with prejudice.

Legal Topics:

For related research and practice materials, see the following legal topics:

Trademark LawLikelihood of ConfusionSimilarityAppearance, Meaning & SoundGeneral OverviewTrademark
LawProtection of RightsAbandonmentGeneral OverviewTrademark LawU.S. Trademark Trial & Appeal Board
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