

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

Mailed: November 6, 2013

Opposition No. 91205896

Beau L. Tardy

v.

Wild Brain Entertainment, Inc.

Andrew P. Baxley, Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties to this proceeding conducted a discovery conference on November 4, 2013, after opposer had requested Board participation through ESTTA on October 16, 2013. Participating in the conference were opposer's attorney Wendy Peterson, applicant's attorney Katherine L. McDaniel, Carrie Dumont (senior vice president for Business and Legal Affairs of DHX Media, Ltd., applicant's parent company), and Board interlocutory attorney Andrew P. Baxley.

As an initial matter, the Board's August 11, 2013 order is modified to reflect that opposer's motion (filed February 1, 2013) for leave to file a second amended notice of opposition is granted as conceded. See Trademark Rule 2.127(a).

The Board is an administrative tribunal that is empowered solely to determine the right to register and which has no authority to determine the right to use a mark or any infringement or unfair competition issues and no injunctive authority. See TBMP Section 102.01 (3d ed. rev. 2012). A Board *inter partes* proceeding, such as this case, is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions, discovery (a party's use of discovery depositions, interrogatories, document requests, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. As the plaintiff, opposer has the burden of establishing his claims at trial by a preponderance of the evidence. See *ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351 (TTAB 2007); *Genesco Inc. v. Martz*, 66 USPQ2d 1260 (TTAB 2003).

The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless

it has been introduced in evidence in accordance with the applicable rules.¹

The Board encourages the parties to discuss settlement. To that end, the Board is generous in granting consented extensions of the schedule and periods of suspension to accommodate any settlement pursuits. The parties indicated that they have engaged in some settlement talks, but they did not request suspension for settlement negotiations.

The Board further reminded the parties that neither the exchange of discovery requests nor the filing of a motion for summary judgment (except on the basis of *res judicata* or lack of Board jurisdiction) could occur until the parties made their initial disclosures as required by Fed. R. Civ. P. 26(f). See Trademark Rules 2.120(a)(3) and 2.127(e)(1).

In addition, the parties may seek mediation, arbitration or some other means for resolving this case. Information concerning the Board's Accelerated Case Resolution (ACR) procedure is available online at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>.²

¹ The parties are advised that, if a document obtained from the Internet identifies its date of publication or date that it was accessed and printed, and its source (e.g., the URL), it may be admitted into evidence by way of a notice of reliance in the same manner as a printed publication in general circulation in accordance with Trademark Rule 2.122(e). See *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031 (TTAB 2010).

² Such procedure is similar to a motion for summary judgment; however, rather than merely determining whether there are genuine issues of material fact, the Board makes findings of fact in an ACR.

If the parties do not settle this case and wish to pursue ACR, they should inform the Board as soon as possible.

There are no other Board proceedings or other litigation between the parties at this time. The parties did not agree to e-mail service under Trademark Rule 2.119(b)(6).

The parties are advised to refer to the Trademark Trial and Appeal Board Manual of Procedure (TBMP) and the Trademark Rules of Practice, both online at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>, and the Federal Rules of Civil Procedure, online at <http://www.law.cornell.edu/rules/frcp/>. Other useful databases include the Electronic System for Trademark Trials and Appeals (ESTTA)³ for filing submissions with the Board, TTABVUE for status and prosecution history, and TTAB Decisions for examples of fully litigated proceedings (that is, from the filing of the complaint to final decision). All of these databases are accessible online at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. The Board expects all parties appearing before it to comply with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure.

³ Use of electronic filing with ESTTA, available through the USPTO website, is strongly encouraged. This electronic file system operates in real time. The filing party is also provided with a confirmation number that the filing has been received once the transaction is completed.

Trademark Rules 2.119(a) and (b) state that every paper filed in this proceeding must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board. Consequently, copies of all submissions that they parties may subsequently file in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made, e.g., by mail. The statement, whether attached to or appearing on the submission when filed, will be accepted as prima facie proof of service.

The standard form protective order is in effect in this proceeding to govern the exchange of confidential information and materials. See Trademark Rule 2.116(f). The standard protective order is online at <http://www.uspto.gov/trademarks/process/appeal/guidelines/stndagmnt.jsp>. The parties may substitute a stipulated protective agreement (signed by both parties and approved by the Board upon motion). However, in view of the existence of the Board's standardized protective order, the Board will not become involved in a dispute over any substitution.

The Board then reviewed the parties' pleadings. In the second amended notice of opposition, opposer has adequately

pleaded his standing (paragraphs 1-3)⁴ and claims of: (1) priority and likelihood of confusion under Section 2(d), 15 U.S.C. Section 1052(d) (paragraphs 4-10, 20-30);⁵ and (2) no bona fide intent to use the involved mark on all of the identified goods, in particular "hand held units for playing electronic games for use with external display screen or monitor" (paragraphs 11-19). Applicant in its answer denied the salient allegations of the second amended notice of opposition and asserted affirmative defenses.

In view of the determination that opposer pleaded his standing and a valid basis for denying the registration sought, the affirmative defense of failure to state a claim

⁴ Opposer's allegations of prior common law use of the DIZZY mark and of a reasonable belief that registration of his application will be refused because of applicant's registration constitute a sufficient pleading of standing. See *L. & J.G. Stickley Inc. v. Cosser*, 81 USPQ2d 1956, 1964 (TTAB 2007); *Hartwell Co. v. Shane*, 17 USPQ2d 1569, 1570 (TTAB 1990); TBMP Section 309.03(b).

⁵ Opposer's allegations of likelihood of confusion based on prior use of an "identical" mark on "identical or highly similar goods" is a sufficient pleading of a claim under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). 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. See ¹*Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981). Although opposer alleges that "[t]he parties' services are identical," applicant's involved application is for goods in International Class 9 only.

In the second amended notice of opposition, opposer alleges priority based on common law use of the pleaded DIZZY mark on his identified goods since at least as early as December 31, 1996. Applicant, in its answer, contends that as an affirmative defense that opposer abandoned the DIZZY mark. If the pleaded mark was abandoned, any resumption of use would be in the nature of a new first use. See *Linville v. Rivard*, 26 USPQ2d 1508 (TTAB 1993).

is *sua sponte* stricken. See *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221 (TTAB 1995); TBMP Section 506.01.

Regarding the pleaded Section 2(d) claim, in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the Court of Customs and Patent Appeals set forth the factors, which when of record, are considered in determining likelihood of confusion:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
 - (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
 - (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
 - (4) The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.
 - (5) The fame of the prior mark (sales, advertising, length of use).
 - (6) The number and nature of similar marks in use on similar goods.
 - (7) The nature and extent of any actual confusion.
 - (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
 - (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark).
 - (10) The market interface between applicant and the owner of a prior mark:
 - (a) a mere "consent" to register or use.
 - (b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.
 - (c) assignment of mark, application, registration and good will of the related business.
 - (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
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- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.
- (12) The extent of potential confusion, i.e., whether de minimis or substantial.
- (13) Any other established fact probative of the effect of use.

Regarding the claim that applicant lacked a bona fide intent to use the mark when it filed the involved intent-to-use application, Trademark Act Section 1(b), 15 U.S.C.

Section 1051(b), states that "a person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce" may apply for registration of the mark. An applicant's bona fide intent to use a mark must reflect an intention that is firm, though it may be contingent on the outcome of an event (that is, market research or product testing) and must reflect an intention to use the mark "in the ordinary course of trade, ... and not ... merely to reserve a right in a mark."

Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503 (TTAB 1993) (quoting Trademark Act Section 45, 15 U.S.C. Section 1127, and citing Senate Judiciary Comm. Rep. on S. 1883, S. Rep. No. 515, 100th Cong., 2d Sess. 24-25 (1988).

In determining the sufficiency of documentary evidence demonstrating bona fide intent, the Board has held that the Trademark Act does not expressly impose "any specific requirement as to the contemporaneousness of an applicant's documentary evidence corroborating its claim of bona fide

intention. Rather, the focus is on the entirety of the circumstances, as revealed by the evidence of record." See *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994).

During the discovery conference, opposer noted that applicant had abandoned two additional intent-to-use applications since the commencement of this proceeding and that he wanted to amend the notice of opposition again to rely upon those applications in support of his no bona fide intent to use claim. Evidence that an applicant filed an excessive number of intent-to-use applications to register marks which ultimately were not actually used may cast doubt upon or disprove an asserted bona fide intent to use a mark in commerce. See *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434 (TTAB 2012); *id.* The Board indicated that opposer need to file a motion for leave to file a third amended notice of opposition to raise those additional applications.

The Board highlighted aspects of the scope of discovery in this case. Although the parties did not agree to any limitations on discovery, they may agree to limit discovery to expedite this case.⁶ The parties are directed to review TBMP Section 414 regarding the discoverability of various

⁶ The parties can also simplify the issues in this case by stipulating to certain facts, to the authenticity of documents produced in discovery, etc. If the parties so stipulate, they should file a notice with the Board which sets forth their stipulation.

categories of information in Board proceedings.⁷ Discovery topics should be focused primarily on opposer's pleaded common law rights in the DIZZY mark, including chain of title in the pleaded mark, and steps undertaken by applicant to bring its involved goods to market.

Opposer requested that he be allowed more than the seventy-five interrogatories allowed by Trademark Rule 2.120(d)(1) in view of the number of items in the identification of goods in the involved application. However, the Board denied that request. See TBMP Section 405.03 regarding the counting of interrogatories in Board proceedings.

Any party filing an unconsented motion to extend or suspend should notify the Board by telephone upon the filing thereof so that such motion can be resolved promptly by telephone conference. See Trademark Rule 2.120(i)(1); TBMP Section 502.06(a). Regarding discovery depositions, pursuant to Fed. R. Civ. P. 30(b)(4), the parties may take

⁷ The Board expects parties and/or their attorneys to cooperate with one another in the discovery process and looks with disfavor on those who do not so cooperate. Each party and/or its attorney has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case. See TBMP Section 408.01. If the parties appear to be uncooperative in discovery, the Board will not hesitate to require a telephone conference prior to the filing of any motion to compel discovery.

The parties are not required to create documents merely to satisfy their adversary's discovery requests. See *Washington v. Garrett* 10 F.3d 1421, 1437-38 (9th Cir. 1993).

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and appear for such depositions by telephone. The parties may also appear in person for such depositions.

Dates remain as last reset in the Board's September 27, 2013 order. The Board thanks the parties for their participation.