

THIS OPINION
IS NOT A PRECEDENT
OF THE TTAB

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

CME

Mailed: March 13, 2014

Opposition No. 91212177 (parent)
Opposition No. 91212483

Teresa H. Earnhardt

v.

Bobby Dale Earnhardt, LLC

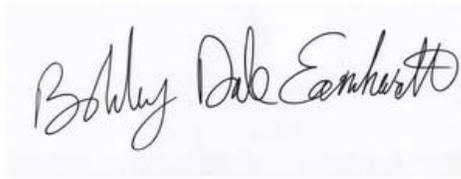
**Before Quinn, Wolfson and Lykos,
Administrative Trademark Judges.**

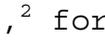
By the Board:

This case now comes up for consideration of opposer's fully-briefed motion for partial summary judgment, filed November 20, 2013, in the above-captioned consolidated opposition proceedings.

By way of background, applicant seeks registration of the mark BOBBY DALE EARNHARDT, in standard characters,¹ and

¹ Application Serial No. 85686394, filed on July 25, 2012, based on applicant's allegation of a *bona fide* intention to use the mark in commerce pursuant to Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

A handwritten signature in black ink that reads "Bobby Dale Earnhardt". The signature is written in a cursive, stylized font. The word "Bobby" is written in a larger, more prominent script, while "Dale Earnhardt" follows in a similar but slightly smaller and more compact script.

in a stylized format, ,² for "Photographic albums; Photographic prints; Stickers" in International Class 16; "Beverage glassware; Thermal insulated bags for food or beverages" in International Class 21; "Hats; Jackets; Pants; Shirts; Shorts; Sweatshirts; Tank-tops; Underwear" in International Class 25, and "Model cars; Model racing car bodies; Play motor cars; Remote control toys, namely, race cars; Toy cars" in International Class 28.³ In her notices of opposition, opposer alleges that applicant's marks are likely to cause confusion with and dilute her previously used and registered mark DALE EARNHARDT⁴ and stylized mark,

² Application Serial No. 85686416, filed on July 25, 2012, based on applicant's allegation of a *bona fide* intention to use the mark in commerce pursuant to Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

³ Application Serial No. 85686416 also covers "Toy model kit cars" in International Class 28.

⁴ Registration No. 1644237, filed on August 28, 1989 and issued on May 14, 1991; Section 8 affidavit accepted, Section 15 affidavit acknowledged, and twice renewed.



,⁵ consisting of the signature of Dale Earnhardt, both for a range of goods and services, including, but not limited to, paper goods, printed materials, clothing, and toys, namely, miniature cars. In its answers, applicant denies the salient allegations in the notices of opposition.

Opposer moves for partial summary judgment on her likelihood of confusion claims, or, "in the alternative" on the issues of (i) standing, (ii) priority (iii) the similarity of the parties' goods, (iv) the overlap in the channels of trade and classes of purchasers of the parties' goods, and (v) the similarity of the parties' marks.

Before addressing opposer's motion, we note as a procedural matter that opposer has not adequately set forth claims for dilution because she has not pleaded that her marks became famous prior to the **filing dates** of the involved intent-to-use applications. See *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1174 (TTAB 2001) ("We hold that in the case of an intent-to-use application, an owner

⁵ Registration No. 2035107, filed September 12, 1995 and issued on February 4, 1997; Section 8 affidavit accepted, Section 15 affidavit acknowledged, and once renewed.

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of an allegedly famous mark must establish that its mark had become famous prior to the filing date of the trademark application..."). Opposer is allowed until **April 2, 2014** to replead her dilution claims by filing separate amended complaints in each of the consolidated cases, failing which, the existing allegations regarding dilution will be stricken and the dilution claims will be given no further consideration. In the event that opposer files amended complaints, applicant is allowed until **April 23, 2014** to file its answers or to otherwise respond to the amended complaints.⁶

With respect to opposer's motion, summary judgment is only appropriate where there are no genuine disputes as to any material facts, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(a). The party seeking summary judgment bears the burden of demonstrating the absence of any genuine dispute of material fact, and that it is entitled to a judgment under the applicable 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

⁶ Complaints and answers, unlike other filings, must be filed in each separate consolidated proceeding.

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reasonable fact finder could resolve the matter in favor of the non-moving party. See *Opryland USA Inc. v. Great Am. 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). Evidence on summary judgment must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472. The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. See *Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1542.

In support of her motion for summary judgment, opposer submits the affidavit⁷ of her attorney in which the attorney states that she has attached current printouts of information concerning opposer's pleaded registrations from the USPTO's Trademark Status and Document Retrieval (TSDR) electronic database and the Trademark Electronic Search Systems (TESS) electronic database. However, the

⁷ Although opposer identifies the exhibit as an affidavit, the document is not an affidavit nor is it a declaration that meets the requirements of Trademark Rule 2.20. See TBMP § 528.05(b) (3d ed. rev.2 2013) (a declaration may be submitted in lieu of an affidavit, but it must include the language set out in Trademark Rule 2.20).

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referenced TSDR and TESS printouts are not attached to the affidavit or the motion for summary judgment, and opposer has not submitted any other evidence in support of her motion. Accordingly, opposer has not satisfied her burden of demonstrating the absence of any genuine disputes of material fact with respect to standing and priority. See Fed. R. Civ. P. 56(c)(1); *see also* TBMP §§ 528.01 and 528.05(a)(1). For this reason, opposer's motion for summary judgment is **DENIED without prejudice to opposer's right to re-file the motion with accompanying evidence.**

Proceedings herein are resumed, and discovery, disclosure, trial and other dates are reset as follows:

Deadline to File Any Amended Complaints	4/2/14
Time to Answer Any Amended Complaints	4/23/14
Deadline for Discovery Conference	5/23/2014
Discovery Opens	5/23/2014
Initial Disclosures Due	6/22/2014
Expert Disclosures Due	10/20/2014
Discovery Closes	11/19/2014
Plaintiff's Pretrial Disclosures	1/3/2015
Plaintiff's 30-day Trial Period Ends	2/17/2015
Defendant's Pretrial Disclosures	3/4/2015

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Defendant's 30-day Trial Period Ends	4/18/2015
Plaintiff's Rebuttal Disclosures	5/3/2015
Plaintiff's 15-day Rebuttal Period Ends	6/2/2015

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. Trademark Rule 2.125.

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