

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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Goodman

**THIS OPINION IS NOT  
A PRECEDENT OF THE TTAB**

Mailed: July 18, 2014

Opposition No. 91212177

Opposition No. 91212483

Ms. Teresa H. Earnhardt

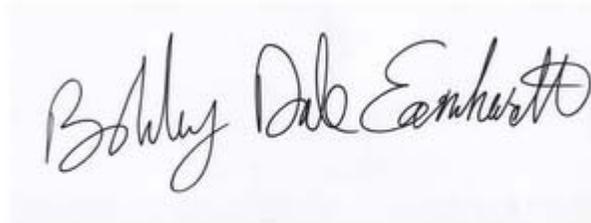
v.

Bobby Dale Earnhardt LLC  
(as consolidated)

Before Quinn, Wolfson and Lykos, Administrative Trademark Judges.

By the Board:

Bobby Dale Earnhardt LLC (“Applicant”), has filed an application to register the mark BOBBY DALE EARNHARDT, in standard character form,

A handwritten signature in black ink that reads "Bobby Dale Earnhardt". The signature is written in a cursive, flowing style.

and the mark  in stylized form,

both for the following goods:

Photographic albums; Photographic prints; Stickers, in Class 16;

Beverage glassware; Thermal insulated bags for food or beverages, in Class 21;

Hats; Jackets; Pants; Shirts; Shorts; Sweatshirts; Tank-tops; Underwear, in Class 25; and

Model cars; Model racing car bodies; Play motor cars; Remote control toys, namely, race cars; Toy cars, in Class 28.<sup>1</sup>

Ms. Teresa H. Earnhardt (“Opposer”) has opposed registration on the grounds of priority and likelihood of confusion and dilution by blurring.<sup>2</sup> Opposer alleges continuous use in the United States of the designation DALE EARNHARDT as a trademark “since at least as early as 1976” in connection with various items, including goods classified in International Classes 16, 21, 25 and 28. Opposer has also pleaded ownership of the following registrations: Registration No. 1644237<sup>3</sup> for the mark DALE EARNHARDT in typed drawing form<sup>4</sup> for the following goods and services:

Metal Key Rings, in Class 6;

Pocket Knives, in Class 8;

Paper goods and printed material, namely posters, bumper stickers, decals, wall calendars, window stickers, and books directed to automobile racing, in Class 16;

Clothing, namely, sweatshirts, warm-up sets, shorts, sport shorts, golf shirts, t-shirts, jackets, caps and socks, in Class 25;

Toys, namely miniature cars, in Class 28; and

Entertainment services in the nature of participating in professional automobile racing related exhibitions, in Class 41.

and Registration No. 2035107<sup>5</sup> for the following mark in stylized form:

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<sup>1</sup> Application Serial Nos. 85686416 and 85686394, respectively, both filed July 25, 2012, under Section 1(b).

<sup>2</sup> The cases were consolidated on September 25, 2013.

<sup>3</sup> Registration issued May 14, 1991; second renewal June 8, 2011.

<sup>4</sup> Effective November 2, 2003, Trademark Rule 2.52, 37 C.F.R. § 2.52, was amended to replace the term “typed” drawing with “standard character” drawing. A mark depicted as a typed drawing is the legal equivalent of a standard character mark.



for the following goods and services:

key rings, metal license plates and metal tag holders, in Class 6;

pocket knives, in Class 8;

jewelry, namely, lapel pins, charms and belt buckles, in Class 14;

paper goods and printed material, namely, posters, bumper stickers, decals, wall calendars, window stickers, card sets, and brochures and books directed to automobile racing, in Class 16;

housewares and glass, namely, drinking glasses, cups, mugs; rubber, plastic or foam insulating beverage holders and water bottles sold empty, in Class 21;

cloth flags, afghans, towels, cloth pennants,

clothing, namely, sweatshirts, warm-up sets, shorts, shirts, sport shirts, golf shirts, T-shirts, jackets, headbands, caps, visors, straw hats, socks and infant sets, in Class 25;

toys, namely, miniature cars and trucks; and radio controlled cars, in Class 28; and

entertainment services in the nature of conducting entertainment services in the nature of participating in professional automobile races and related exhibitions, in Class 41.

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

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<sup>5</sup> Registration issued February 4, 1997, first renewal September 21, 2007 .

This case now comes up on Opposer's renewed motion<sup>6</sup>, filed March 24, 2014, for partial summary judgment on the likelihood of confusion ground. The motion is fully briefed.

A party is entitled to summary judgment when it has demonstrated that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). In reviewing a motion for summary judgment, the evidentiary record and all reasonable inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the nonmoving party. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

In support of her motion, Opposer has submitted copies of electronic TSDR and TESS reports from the USPTO website for Registration Nos. 1644237 and 2035107, confirming her ownership and the current status of these registrations.

Applicant has not submitted any evidence with its response.

To obtain summary judgment in her favor on the Section 2(d) claim in the opposition proceeding, Opposer must establish that there is no genuine dispute that (1) she has standing to maintain this proceeding; (2) that she is the record owner of her pleaded registrations and the prior user of her pleaded marks with respect to any goods not covered by the registrations; and (3) that contemporaneous use of the parties' respective marks on their

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<sup>6</sup> On March 13, 2014, the Board denied Opposer's motion for summary judgment "without prejudice to Opposer's right to re-file the motion with accompanying evidence."

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respective goods would be likely to cause confusion, mistake or to deceive consumers. *See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001).

### Standing

We first determine Opposer's standing to bring this opposition proceeding. 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 (Fed. Cir. 1999). We find that Opposer's standing to bring this opposition proceeding is undisputed by Applicant and is established by the TSDR and TESS printouts for pleaded Registration Nos. 1644237 and 2035107. *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185, 189-190 (C.C.P.A. 1982); *see also Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1408 (TTAB 2010) (pleaded registration made of record establishes standing).

Accordingly, we find no genuine dispute of material fact regarding Opposer's standing.

### Priority

We next determine Opposer's priority. Priority is established by Opposer's submission of electronic TSDR and TESS reports of Opposer's pleaded Registration Nos. 1644237 and 2035107. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Moreover, Applicant does not dispute Opposer's priority.

Accordingly, we find no genuine dispute of material fact regarding Opposer's priority with respect to the marks and goods and services covered by the pleaded registrations made of record.

Likelihood of confusion

As stated *supra*, to obtain summary judgment in her favor on likelihood of confusion, Opposer must establish that there is no genuine dispute of material fact that contemporaneous use of the parties' respective marks on their respective goods would be likely to cause confusion, mistake or to deceive consumers. *Hornblower & Weeks, Inc.*, 60 USPQ2d at 1735. For a likelihood of confusion claim, we focus on "... whether the purchasing public would mistakenly assume that the applicant's goods originate from the same source as, or are associated with," Opposer's goods or services. *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In determining likelihood of confusion, we do not need to consider every *du Pont* factor inasmuch as "we are required only to consider those factors that are relevant." *Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1241, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004), *citing Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001). The only *du Pont* factors raised by Opposer in her motion are similarity or dissimilarity of the marks, similarity or dissimilarity and nature of the goods, and similarity or dissimilarity of established or likely to continue trade channels. *In re E. I. du*

*Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).

Therefore, we turn our focus to these *du Pont* factors.

*Similarity of the Goods*

Consideration of the similarity of the parties' goods is based on the goods recited in Applicant's applications vis-à-vis the goods identified in Opposer's pleaded registrations. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783, 1815 (Fed. Cir. 1992). The respective identification of goods in Applicant's applications and Opposer's registrations may themselves be evidence as to the relatedness of the parties' goods. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). Similarity need not be found as to each and every product listed in the description of goods in each class of the applications and corresponding class in the registrations. It is sufficient for a finding of likelihood of confusion that relatedness is established for any item in each class in the registration encompassed by the description of goods for that class in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007).

Opposer has argued that for each of the four classes of goods covered in the involved applications, Applicant's goods are "identical or at least very

closely related to the goods covered by Opposer's DALE EARNHARDT registrations." Applicant's response does not include any arguments with respect to the relatedness of the parties' goods.

In considering the respective identification of goods in Opposer's pleaded registrations and the involved applications, there is no genuine dispute of material fact that the parties' goods in International Classes 16, 21, 25 and 28 are identical in part, related, or that Opposer's goods are encompassed by Applicant's description of goods.

Specifically, Applicant's description of goods for both involved applications in International Class 16 includes the broad wording stickers, which would encompass bumper stickers and window stickers in Registration No. 1664237 and bumper stickers, window stickers, and decals in Registration No. 2035107. Applicant's description of goods for both applications in International Class 21 includes the broadly identified beverage glassware which would encompass drinking glasses, cups and mugs in Registration No. 2035107. In International Class 25, both the involved applications and Registration Nos. 1664237 and 2035107 identify sweatshirts, shorts, and jackets in the description of goods; both the applications and Registration No. 2035107 also identify shirts. Additionally, Applicant's shirts, shorts and hats identified in the applications encompass sport shorts, golf shirts, and t-shirts in Registration No. 1664237 and straw hats in Registration No. 2035107. Applicant's description of goods in

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International Class 28 for both involved applications identifies remote control toy race cars, and toy cars which would encompass miniature toy cars in Registration Nos. 166423 and 2035107 and radio controlled toy cars in Registration No. 2035107.

Accordingly, we find no genuine dispute of material fact that the parties' goods are similar or, in some cases, identical.

*Similarity or Dissimilarity of the Channels of Trade/Classes of Purchasers*

With respect to the channels of trade and classes of purchasers, Opposer argues that "the parties' goods are practically identical" and "the Board must presume that Applicant's and Opposer's goods will be sold in the same channels of trade and will be bought by the same classes of purchasers."

Applicant, on the other hand, argues that there is a lack of evidence of "overlap in marketing channels" and "Opposer offers nothing more than a conclusory statement that as the goods are similar they must be presumed to travel in the same channels of trade."

In reply, Opposer argues that her "assertion that Opposer's and Applicant's trade channels are presumed to be the same is also grounded in well-recognized legal principles."

When there are no limitations or restrictions as to trade channels or classes of purchasers in the pertinent identifications of the involved applications or pleaded registrations, we presume that those goods are or would be marketed in all normal trade channels for such goods and to all

normal classes of purchasers of such goods. *Octocom Syst. Inc. v. Houston Computers Svcs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011). The Board is entitled to rely on this legal presumption. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, in determining likelihood of confusion, the Board was entitled to rely on the legal presumption that absent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same classes of purchasers).

There are no restrictions in either of Applicant's identifications or the identifications in Opposer's Registration Nos. 1664237 and 2035107. Therefore, it is presumed that the identifications encompass all goods of the type described, that they move in all normal trade channels for such goods, and that they are available to all potential consumers for such goods. *Paula Payne Products Co. v. Johnson Publishing Co.*, 177 USPQ at 77. In addition, because some of the goods in Opposer's registrations and Applicant's involved applications are legally identical, such goods are presumed to travel in similar trade channels and to be purchased by the same classes of consumers. *See Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) (Where goods

in applicant's application were in-part identical to those in registrant's registration, lack of restrictions as to trade channels or purchasers gives rise to presumption that goods "could be offered and sold to the same classes of purchasers through the same channels of trade").

Accordingly, we find there is no genuine dispute of material fact that the parties' goods travel in similar channels of trade and are purchased by the same classes of consumers.

*Similarity of the marks*

We must compare the marks in their entireties as to appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. Furthermore, the focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Opposer argues that the parties' marks are similar in sound and appearance and that "the similarities greatly outweigh the differences . . . in light of use of the marks on identical and closely related goods."

In response, Applicant argues that the marks are not identical and cannot be confusingly similar as a matter of law.

In reply, Opposer argues that she “has supported adequately the conclusion that the marks are similar in appearance, sound connotation and their overall commercial impressions.”

When the goods at issue are identical (or, as here, identical in part), the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than if the goods were not identical. *In re Viterra Inc.*, 101 USPQ2d at 1912, citing *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992). Where the entirety of one mark is incorporated within another, likelihood of confusion is often found. *See e.g., In re Denisi*, 225 USPQ 624, 626 (TTAB 1985) (PERRY’S PIZZA for restaurant services specializing in pizza and PERRY’S for restaurant and bar services); *Aileen, Inc. v. Eileen Togs, Corp.*, 188 USPQ 698 (TTAB 1975) (LOVE EILEEN confusingly similar to AILEEN).

There is no genuine dispute of material fact that Applicant’s BOBBY DALE EARNHARDT marks incorporate Opposer’s DALE EARNHARDT marks in their entirety and that the marks are identical to the extent that they both contain the name DALE EARNHARDT. The incorporation of Opposer’s entire marks in Applicant’s involved marks underscores the

similarity in the sound, appearance and overall commercial impression of the parties' marks.

It is well established that the mere addition of a term to a registered mark, in this case the name BOBBY, generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). *See In re Chatam Int-'l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (CCPA 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967) (THE LILLY and LILLI ANN).

Given the similarities, consumers might well believe that BOBBY DALE EARNHARDT and DALE EARNHARDT refer to the same person. *See Harry Winston, Inc. v. Bruce Winston Gem Corp.*, Opposition No. 91153147, \_\_\_ USPQ2d \_\_\_ (TTAB July 9, 2014) (WINSTON and BRUCE WINSTON; a surname preceded by a given name is a common, highly conventional combination of word elements, and such a mark could well be interpreted as a more specific reference to a person or company that is otherwise identified by the designation); *Modern Shoe Co. v. B.B. Walker Shoe Co.*, 170 USPQ 530, 531 (TTAB 1971) (“WALKER’ and ‘JOHNNIE WALKER’ could be regarded as one and the same individual. These names when used as marks will create the same impression and such impression is greatly enhanced

because they are used on directly competitive goods, even as to price”). With respect to the parties’ stylized marks, the use of script formats does not obviate confusion. *See In re H. J. Seiler Co.*, 289 F.2d 674, 129 USPQ 347 (CCPA 1961) (with both marks consisting of the surname, SEILER’S, in script formats, a likelihood of confusion exists when applied to applicant’s catering services and registrant’s smoked and cured meats).

In view thereof, we find that there is no genuine dispute of material fact that the parties’ marks are similar in sound, appearance, meaning and overall commercial impression.

*Other du Pont factors*

Applicant argues that genuine disputes remain because Opposer failed to address other *du Pont* factors such as sophistication of the purchasers, the marketing of the goods upon which the respective marks are used, as well as the number and nature of other marks used on similar goods.

However, Applicant has not put in any evidence in the record with regard to these factors, but relied only on attorney argument. Argument by counsel is insufficient to raise a genuine dispute. *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed.Cir.2005) (“Attorney argument is no substitute for evidence.”). To the extent there are other relevant *du Pont* factors, in the absence of any evidence, we treat them as neutral. *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d

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1826, 1831 (TTAB 2012) (treating certain *du Pont* factor as neutral when no evidence provided by the parties).

Decision

We find based on the record herein and the applicable law, that there is no genuine dispute of material fact that Opposer has established her standing, as well as priority and likelihood of confusion as a matter of law.

In view thereof, Opposer's motion for summary judgment is granted, Opposition Nos. 91212177 and 91212483 are sustained, and registration to application Serial Nos. 85686416 and 85686394 is refused.<sup>7</sup>

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<sup>7</sup> Insofar as we are sustaining the oppositions on this ground, we need not consider Opposer's remaining dilution claim.