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

Proceeding	91217273
Party	Defendant Three Notch'd Brewing Company, LLC
Correspondence Address	ROBERT C VAN ARNAM WILLIAMS MULLEN 301 FAYETTEVILLE STREET, STE 1700 RALEIGH, NC 27601 UNITED STATES rvanarnam@williamsmullen.com, nmagnuson@williamsmullen.com, tbergert@williamsmullen.com, prenie@williamsmullen.com, mhayes@williamsmullen.com
Submission	Motion for Summary Judgment
Filer's Name	Thomas F. Bergert
Filer's e-mail	tbergert@williamsmullen.com, ip@williamsmullen.com, prenie@williamsmullen.com, rvanarnam@williamsmullen.com, mhayes@williamsmullen.com
Signature	/Thomas F. Bergert/
Date	02/03/2016
Attachments	2424_001.pdf(1090383 bytes)

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

MONSTER ENERGY COMPANY,)	
)	
Opposer,)	
)	Opposition No. 91217273
v.)	
)	Serial No. 85/920,112
THREE NOTCH'D BREWING COMPANY, LLC,)	
)	
Applicant.)	
)	

APPLICANT'S MOTION FOR SUMMARY JUDGMENT

Pursuant to Federal Rule of Civil Procedure 56(c) and Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 528.01, Applicant, Three Notch'd Brewing Company, LLC ("Applicant" or "Three Notch'd"), hereby submits this motion for summary judgment and requests that the Board suspend these proceedings under 37 CFR §2.127(d) pending a decision on this motion.

I. INTRODUCTION

On May 1, 2013, Applicant filed Application Serial No. 85/920,112 for the mark shown below, in connection with "Beer" in International Class 32 ("Applicant's Mark"):



Opposer, Monster Energy Company ("Opposer" or "Monster"), filed a Notice of Opposition on July 9, 2014, opposing registration of Applicant's Mark, and commencing the present proceeding. Opposer has asserted trademark rights based on various U.S. Trademark

Registrations (the “M Claw Icon Registrations”) containing Opposer’s  mark (the “M Claw Icon Mark”), as shown below.

Mark	Registration No. Reg. Date	Goods/Services
	Reg. No. 2903214 Reg. Date: 11/16/2004	Class 32: Drinks, namely, carbonated soft drinks, carbonated drinks enhanced with vitamins, minerals, nutrients, amino acids and/or herbs, carbonated and noncarbonated energy or sports drinks, fruit juice drinks having a juice content of 50% or less by volume that are shelf stable, *but excluding perishable beverage products that contain fruit juice or soy, whether such products are pasteurized or not.*
 The mark consists of the letter "m" in the form of a claw.	Reg. No. 3434821 Reg. Date 05/27/2008	Class 5: Nutritional supplements
 The mark consists of the letter "m" in the form of a claw.	Reg. No. 3434822 Reg. Date 5/27/2008	Class 32: Non-alcoholic beverages, namely, energy drinks, excluding perishable beverage products that contain fruit juice or soy

 <p>Mark: M MONSTER ENERGY</p>	<p>Reg. No. 3134841 Reg. Date 8/29/2006</p>	<p>Class 32: Beverages, namely, carbonated soft drinks, carbonated soft drinks enhanced with vitamins, minerals, nutrients, amino acids and/or herbs, carbonated energy and sports drinks, fruit juice drinks having a juice content of 50% or less by volume that are shelf stable, but excluding perishable beverage products that contain fruit juice or soy, whether such products are pasteurized or not</p>
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In the Notice of Opposition, Opposer alleges that it will be damaged by registration of Applicant's Mark "in that the claw mark" included in Applicant's Mark so resembles Opposer's M Claw Icon Mark as to be likely to cause confusion, to cause mistake, or to deceive within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). Opposer further alleges that it will be damaged by registration of Applicant's Mark because Applicant's Mark will dilute the distinctive qualities of Opposer's M Claw Icon Mark within the meaning of Section 43(c) of the Trademark Act, 15 U.S.C. §1125(c), and will lessen the ability of Opposer's M Claw Icon Mark to distinguish Opposer's goods.

II. ARGUMENT

a. Summary Judgment Standard

Summary judgment is appropriate for disposing of cases where there is no genuine issue of material fact in dispute, and thus the case should be resolved as a matter of law. Fed. R. Civ. P. 56(a). The Federal Rules of Civil Procedure govern summary judgment proceedings before the Board. *Nat'l Cable TV Ass'n Inc. v. Am. Cinema Editors, Inc.*, 937 F.2d 1572 (Fed. Cir.

1991). The purpose of summary judgment is to avoid an unnecessary trial where additional evidence would not reasonably be expected to change the outcome. *See Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); *see also* TBMP § 528.01 and cases cited therein.

The issue of likelihood of confusion is an issue of law in the Federal Circuit, which may properly be resolved on summary judgment. *Sweats Fashions, Inc. v. Pannill Knitting Co., Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797 (Fed. Cir. 1987). The Board may consider thirteen factors set forth in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973), but it need not consider every factor, as certain factors are often more probative than others depending on the case. *Han Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1338 (Fed. Cir. 2001). One factor, particularly dissimilarity between the marks, may outweigh all of the other factors in certain cases. *See, e.g., Odom's Tennessee Pride Sausage, Inc. v. FF Acquisition, L.L.C.*, 600 F.3d 1343, 1347 (Fed. Cir. 2010) (“even if all other relevant DuPont factors were considered in [registrant’s] favor, as the board stated, the dissimilarity of the marks was a sufficient basis to conclude that no confusion was likely”); *Kellogg Co. v. Pack'em Enterprises*, 14 USPQ2d 1545 (TTAB Feb. 2, 1990), *affirmed* 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *duPont* factor may not be dispositive.”); *Anheuser-Busch, Inc. v. Coyote Springs Brewing Co.*, Opp. 106,462, at 6 (TTAB May 12, 2000) (non-precedential) (“We find the circumstances here are similar to those in *Kellogg*...in that the single *DuPont* factor of the similarity or dissimilarity of the marks in their entirety totally outweighs any other relevant factors and is dispositive of the issue of likelihood of confusion.”).

b. Analysis

In this case, there are no genuine factual disputes that would preclude summary judgment, as there are no genuine issues of fact as to confusion or dilution by blurring based on the obvious differences between the respective marks.

i. The Marks are Vastly Different and Thus There is No Likelihood of Confusion

Despite Opposer's allegation that "the claw mark" included in Applicant's Mark so resembles Opposer's M Claw Icon Mark as to be likely to cause confusion, the Board must analyze the marks *in their entirety* as to the "appearance, sound, connotation and commercial impression" of the parties' marks. *DuPont*, 177 USPQ 563. For marks comprised of both wording and a design, greater weight is often given to the wording, because it is the wording that purchasers would use to refer to or request the goods or services. *See, e.g., In re Viterra, Inc.*, 671 F.3d 1358, 1366, 101 USPQ2d 1905, 1911; *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1247 (TTAB 2010); *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987). "Even if an element of a mark is dominant, this does not mean that other elements may simply be ignored in the likelihood of confusion analysis. Although it is permissible to give greater weight to a dominant element, marks must still be compared in their entirety." *In re National Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985).

The words in Applicant's Mark are THREE NOTCH'D BREWING COMPANY CHARLOTTESVILLE, VA. In each of Opposer's pleaded registrations, the subject mark contains no words, the stylized letter "M" and/or the words MONSTER ENERGY. Thus, Opposer's M Claw Icon Registrations do not contain a single common word with, or phonetic equivalent of, any of the words in Applicant's Mark. As such, the visual appearance and sound

of the words of Applicant's Mark and Opposer's M Claw Icon Registrations are entirely dissimilar.

Additionally, the claw in Opposer's M Claw Icon Registrations is described as consisting of the letter "M" in the form of a claw, and the claw has thicker portions at the top extending and narrowing downward to thinner portions at the bottom, with the middle claw mark extending further than the outside claw marks. Opposer has self-described its mark as conveying the commercial impression of "monster-like creatures/supernatural beasts." *See Monster Energy Company v. Li-Wei Chih*, Consolidated Oppositions Nos. 91205893 and 91205924 (February 1, 2016) (non-precedential). By contrast, the design element of Applicant's Mark does not include a claw, but rather has three thick horizontal lines, not larger at any one end than the other, none longer than any of the other two, and a stylized "C" extending to the left end of Applicant's Mark under the three lines. Thus, the graphic elements alone in Applicant's Mark and Opposer's M Claw Icon Registrations are substantially different and distinctive in styling.

Further, Applicant's Mark as a whole conveys a vastly different meaning and overall commercial impression. The three thick lines in Applicant's Mark represent axe notches. Applicant's Mark, including both the three horizontal axe notches and the phrase "Three Notch'd", is a tribute to the historical Three Notch'd Road, a colonial-era route across central Virginia that ran from Richmond, Virginia to the Shenandoah Valley, which was named for the three horizontal axe notches carved into trees along the trail to designate the road. *See Exhibits A-C, OY8* (tree displaying three vertical axe notches), *OY10* (Jack Jouett's ride), *OY11* (historical marker for Three Notch'd Road). The road was made famous by Captain Jack Jouett's midnight ride to Charlottesville, VA in June 1781 to warn Governor Thomas Jefferson that General Cornwallis was secretly sending British Army soldiers to Monticello, Jefferson's

home, to capture the Governor and his state legislators. Jack Jouett's ride to warn Jefferson saved Jefferson from capture and the ride became a legendary part of Virginia's history. Applicant actively markets its brewery and beer names as tributes to various Virginia colonial-era events, including Jack Jouett's ride. *See* Hayes Declaration, Exhibit D.

Given the vast overall differences in appearance, sound, connotation and commercial impression between Applicant's Mark and Opposer's M Claw Icon Mark, there is no likelihood of confusion.

ii. The Marks are Vastly Different and Thus There is No Blurring

With regard to Opposer's dilution allegation, 15 U.S.C. §1125(c)(2)(B) defines dilution by blurring as "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark." The U.S. Court of Appeals for the Federal Circuit has set forth four elements an opposer must prove in a Board proceeding in order to prevail on a claim of dilution by blurring: (1) the plaintiff owns a famous mark that is distinctive; (2) the defendant is using a mark in commerce that allegedly dilutes the plaintiff's famous mark; (3) the defendant's use of its mark began after the plaintiff's mark became famous; and (4) the defendant's use of its mark is likely to cause dilution by blurring or by tarnishment. *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1723-24 (Fed. Cir. 2012).

While Applicant does not concede as much, even if Opposer's M Claw Icon Mark is deemed to be famous and deemed to have achieved fame prior to Applicant's filing date for Applicant's Mark, Applicant submits that there is no likelihood of dilution in the present case. The first of the six non-exhaustive factors in Section 43(c)(2)(B) of the Trademark Act for assessing the fourth *Coach* element is the degree of similarity between the marks at issue. As

noted by the Board, the test for this factor is based simply on a comparison of the marks as to appearance, sound, connotation and commercial impression. *See Rolex Watch U.S.A., Inc. v. AFP Imaging Corporation*, 101 USPQ2d 1188 (TTAB 2011), *vacated* January 29, 2013 (TTAB) (citing *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1023 (TTAB 2011)). Under this test, Applicant's Mark and Opposer's M Claw Icon Mark are so entirely different as noted above that Applicant's Mark will not trigger consumers to conjure up Opposer's M Claw Icon Mark. Accordingly, Applicant's Mark will not create an association with Opposer's M Claw Icon Mark to support Opposer's dilution claim. *See Kellogg*, 951 F.2d 330 (there is "no reason why, in a particular case, a single *duPont* factor may not be dispositive").

iii. The Dissimilarity of the Marks is Dispositive in this Case

The Board and the Federal Circuit have held repeatedly that a single *DuPont* factor, particularly the dissimilarity of the marks, may be dispositive. *See Odom's*, 600 F.3d at 1347 ("even if all other relevant *DuPont* factors were considered in [registrant's] favor, as the board stated, the dissimilarity of the marks was a sufficient basis to conclude that no confusion was likely"); *Missiontrek Ltd. Co. v. Onfolio, Inc.*, 80 USPQ2d 1381 (TTAB 2005); *accord Kellogg*, 951 F.2d 330 (there is "no reason why, in a particular case, a single *duPont* factor may not be dispositive"); *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, 148 F.3d 1373, 1375, 47 USPQ2d 1459, 1461 (Fed. Cir. 1998) ("one *DuPont* factor may be dispositive in a likelihood of confusion analysis, especially when that single factor is the dissimilarity of the marks"); *Truescents LLC v. Ride Skin Care, L.L.C.*, 81 USPQ2d 1334, 1343 (TTAB 2006) ("Simply put, the dissimilarity between the marks is dispositive in this case"). Given the extreme differences between Applicant's Mark and Opposer's pleaded marks, Applicant submits that these

differences are dispositive, and show that there is no genuine issue as to a material fact in the present case.

II. CONCLUSION

Applicant's Mark and Opposer's M Claw Icon Mark do not look alike, do not sound alike, do not convey similar meanings and do not convey similar overall commercial impressions. Even assuming that all other DuPont factors weigh in Opposer's favor, the dissimilarities in the parties' marks, when viewed in their entireties, are so prevalent that there is no likelihood of confusion and no dilution by blurring as alleged. Continuation of the present proceeding would be wasteful of the Board's and the parties' resources. Accordingly, Applicant requests summary judgment in its favor and dismissal of the present opposition with prejudice.

Respectfully submitted,
WILLIAMS MULLEN, PC

Date: February 3, 2016

By: /Thomas F. Bergert/

Thomas F. Bergert, Esquire
Williams Mullen
321 East Main St., Suite 400
Charlottesville, Virginia 22902-3200
Telephone: (434) 951-5700
Facsimile: (434) 817-0977
Email: tbergert@williamsmullen.com

Robert C. Van Arnam, Esquire
Williams Mullen
301 Fayetteville Street, Suite 1700
Raleigh, NC 27601
Telephone: (919) 981-4000
Facsimile: (919) 981-4300
Email: rvanarnam@williamsmullen.com

Martin W. Hayes, Esquire
Williams Mullen
8300 Greensboro Drive, Suite 1100
Tysons Corner, Virginia 22310
Telephone: (703) 760-5245
Facsimile: (703) 748-0244
Email: mhayes@williamsmullen.com

Counsel for Applicant

CERTIFICATE OF SERVICE

I hereby certify that on this 3rd day of February, 2016, the foregoing Motion for Summary Judgment has been served on Opposer, Monster Energy Company, by mailing a true and correct copy of the same by first class mail, postage prepaid, to:

Diane M. Reed
Jason A. Champion
Jonathan A. Menkes
Knobbe, Martens, Olson & Bear, LLP
2040 Main Street, Fourteenth Floor
Irvine, CA 92614

/Thomas F. Bergert/

Thomas F. Bergert, Esquire
Williams Mullen
321 East Main St., Suite 400
Charlottesville, Virginia 22902-3200
Telephone: (434) 951-5700
Facsimile: (434) 817-0977
Email: tbergert@williamsmullen.com

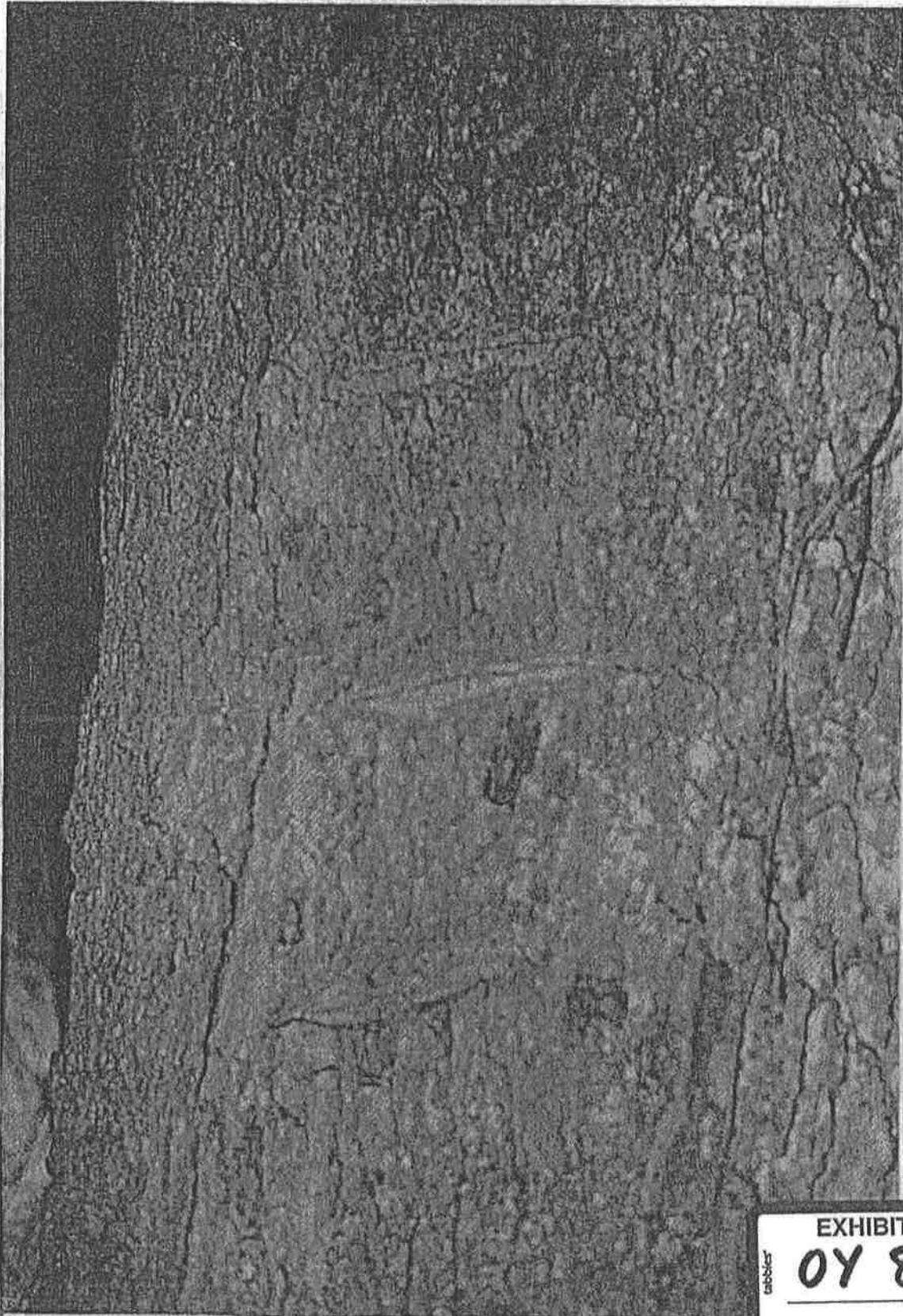
Robert C. Van Arnam, Esquire
Williams Mullen
301 Fayetteville Street, Suite 1700
Raleigh, NC 27601
Telephone: (919) 981-4000
Facsimile: (919) 981-4300
Email: rvanarnam@williamsmullen.com

Martin W. Hayes, Esquire
Williams Mullen
8300 Greensboro Drive, Suite 1100
Tysons Corner, Virginia 22310
Telephone: (703) 760-5245
Facsimile: (703) 748-0244
Email: mhayes@williamsmullen.com

Counsel for Applicant

EXHIBIT A

HIGHLY CONFIDENTIAL



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EXHIBIT
0Y 8

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EXHIBIT B

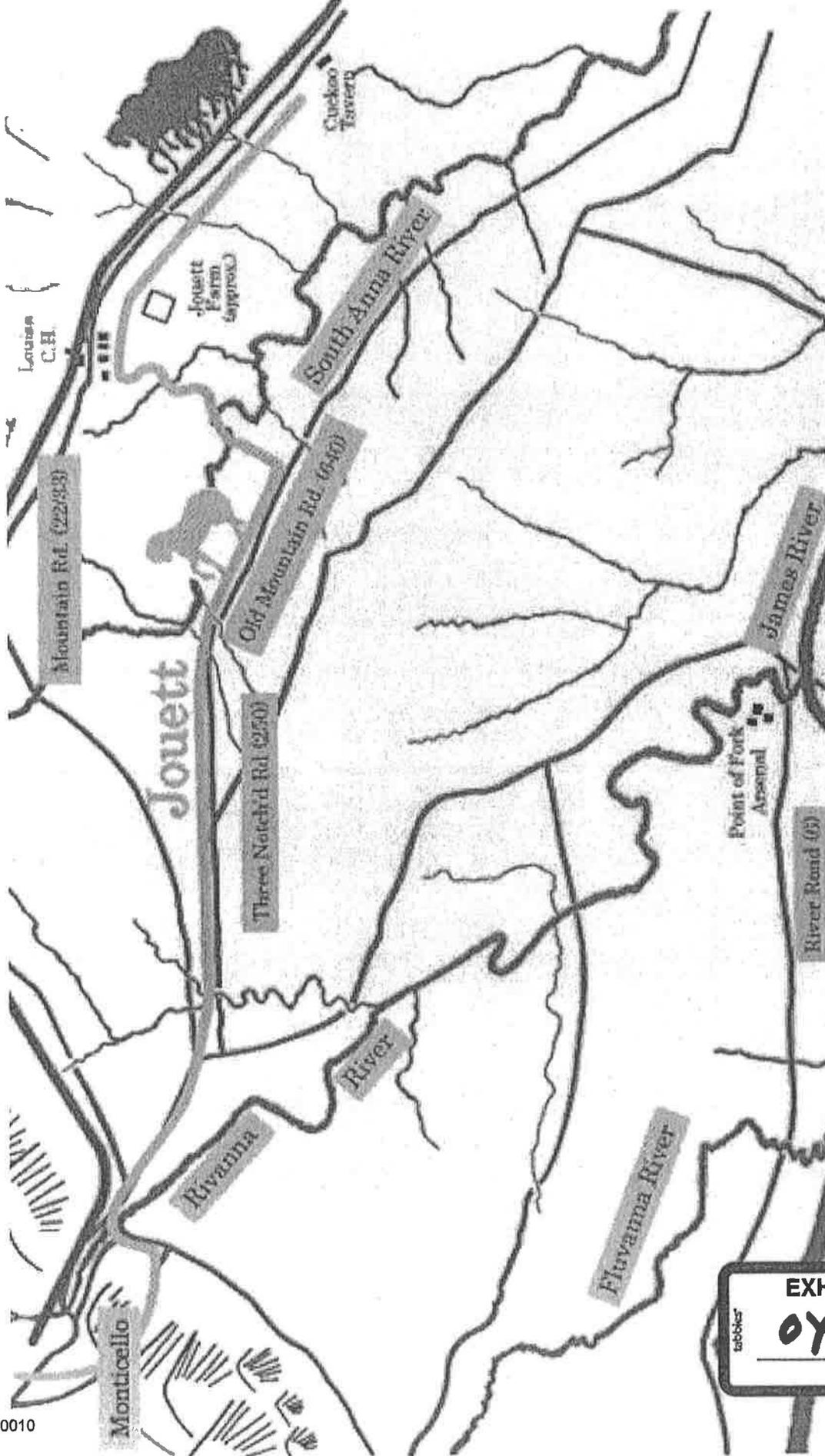


EXHIBIT
0Y 10

EXHIBIT C



Q 21 THREE NOTCH'D ROAD

Also called Three Chopt Road, this colonial route ran from Richmond to the Shenandoah Valley. It likely took its name from three notches cut into trees to blaze the trail. A major east-west route across central Virginia from the 1730s, it was superseded by Route 250 in the 1930s. Part of Jack Jouett's famous ride and the Marquis de Lafayette's efforts to prevent Gen. Charles Cornwallis from obtaining munitions took place along this road. Today West Main Street and part of University Avenue approximate the Three Notch'd Road's original course through present-day Charlottesville.

DEPARTMENT OF HISTORIC RESOURCES 1998

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EXHIBIT
11 10

EXHIBIT D

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THREE NOTCH'D BREWING COMPANY, LLC,)	
)	
Applicant.)	
)	

DECLARATION OF MARTIN W. HAYES

I, Martin W. Hayes, declare pursuant to 28 U.S.C. § 1746 as follows:

1. I am counsel for Three Notch'd Brewing Company, LLC. I make this declaration based on personal knowledge and am competent to testify on the matters stated below.
2. Attached as Exhibit D-1 is a printout from the web page <http://threenotchdbrewing.com/brewery/> as accessed on February 3, 2016.
3. I declare under penalty of perjury under the laws of the United States that the foregoing is true and correct to the best of my knowledge and belief.

Executed on February 3, 2016.

/Martin W. Hayes/
Martin W. Hayes



STAY IN TOUCH Enter Your Email Address



LOGIN

BEER FINDER

HOME ABOUT BEER LOCATIONS CONTACT EVENTS

HARRISONBURG

BREWERY

About the Brewery

Originally, the Three Notch'd Road was a colonial-era thoroughfare running east and west through central Virginia. It is believed to have taken its name from a distinctive marking of three notches burnt or axed into trees to blaze the trail. As legend has it, the road was made famous by Jack Jouett's midnight ride to Charlottesville, VA, in June of 1781. After General Benedict Arnold defected to the British, he sacked Richmond and caused a number of our founding fathers, including then Governor Thomas Jefferson, to seek refuge at Jefferson's home, Monticello, in Charlottesville, VA. Learning of this, General Cornwallis ordered Banastre Tarleton to ride to Charlottesville and capture the group. Captain Jack Jouett of the Virginia Military heard the sound of Tarleton's cavalry from his Louisa County home just 40 miles from Charlottesville. Upon witnessing the cavalry pause for an extended rest, he raced the moon-lit Three Notch'd Road to Monticello to warn the Governor and his state legislators to flee Charlottesville. Recognizing their debt to Jouett, the legislature passed a resolution on June 15, 1781 to honor him, and "Jack Jouett's Ride" became a legendary portion of Virginia's history.

The original trail runs less than a quarter mile from the location of our brewery. It only makes sense that at Three Notch'd Brewing Company it will be our primary goal to align our products with the rich history of Virginia and lead our patrons down the Three Notch'd Road to great beer.

In doing this, we at Three Notch'd Brewing Co. will never be as legendary as some of the most revered characters in Virginia history, but we do aim to leave our humble mark in the world of craft beer. As we evolve from our beginnings, and get to know all of you, we look forward to brewing great beer, while telling the stories of some of the greatest characters in American History - from a very unique Virginian-craft brew perspective. From Jack Jouett, to Thomas Jefferson and Patrick Henry; and from John Brown to Stonewall Jackson and Robert E. Lee, our brewery will develop around bold characters that left their mark on our country's history.

Much like the people mentioned above who left their marks on all of us, our brewery's mission respects the inalienable rights of man, and we want to celebrate these with each and every one of our patrons. We encourage you to learn about our beers, our identities, and also yourselves while you take the trip down Three Notch'd Road and find how you will Leave Your Mark.

Jack left his mark, we're leaving ours, how will you leave yours?

Three Notch'd Brewing Company, LEAVE YOUR MARK.

Read about Three Notch'd In the News





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[Team](#)

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[Tours](#)

Brewery Location

**Charlottesville
Location**

946 Grady Ave
Charlottesville, VA
22903

[Map It](#)

Harrisonburg Location

241 East Market Street,
Harrisonburg, VA 22801

[Map It](#)

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