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

Proceeding	91217273
Party	Plaintiff Monster Energy Company
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Attachments	2016-03-22 OPPOSER'S REPLY ISO MOTION FOR SUMMARY JUDGMENT-HANBEV.2514M.pdf(208568 bytes ) 2016-03-22 JVC DECL ISO OPPOSER'S REPLY RE MOTION FOR SUMMARY JUDGMENT-HANBEV.2514M.pdf(93202 bytes ) JVC MSJ Exhibit 01.pdf(3143124 bytes )

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

MONSTER ENERGY COMPANY,	)	Opposition No.: 91217273
	)	
Opposer,	)	Serial No.: 85/920112
	)	
v.	)	Mark:  <b>Three Notch'd</b> BREWING COMPANY Charlottesville, Va
	)	
THREE NOTCH'D BREWING COMPANY, LLC,	)	
	)	
Applicant.	)	

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**REPLY MEMORANDUM IN SUPPORT OF OPPOSER'S MOTION FOR PARTIAL SUMMARY JUDGMENT**

**I. INTRODUCTION**

Applicant's Response fails to raise genuine issues of material fact with respect to likelihood of confusion. Consideration of the *DuPont* factors, particularly in light of the fame of Opposer's ® mark, overwhelming supports a finding of likelihood of confusion. Accordingly, Opposer has met its burden and is entitled to summary judgment that Applicant's Mark is confusingly similar to Opposer's famous ® mark.

**II. ARGUMENT**

**A. Applicant's Mark is Highly Similar to Opposer's ® Mark**

Applicant's primary argument is that Opposer improperly focuses on the  design in Applicant's Mark and ignores the secondary elements. *See, e.g.*, Applicant's Response at p. 3.<sup>1</sup> However, Opposer specifically acknowledges that the marks should be compared in their entirety, with

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<sup>1</sup> Applicant's Response to Opposer's Motion for Summary Judgment, Docket No. 23.

the added caveat that dominant portions are typically given more weight in the analysis. Opposer's Motion at p. 14.<sup>2</sup> Applicant does not dispute this principle, but instead argues that the wording "THREE NOTCH'D" is the dominant portion of Applicant's Mark and that all references to the individual  design in Opposer's Motion are "wholly irrelevant to this proceeding." Applicant's Response at pp. 4, 8. However, the  design is the dominant portion of Applicant's Mark, and should be given greater weight in assessing likelihood of confusion.<sup>3</sup>

1. **The Wording "THREE NOTCH'D" is Not the Dominant Portion of Applicant's Mark**

Applicant's argument that its composite mark is dominated by the words "THREE NOTCH'D" is not supported by the law. Applicant relies on three cases to rebut Opposer's argument that the  design is the dominant portion of Applicant's Mark: *In re Viterra Inc.*, 101 U.S.P.Q.2d 1905 (Fed. Cir. 2012); *The Board of Trustees of Univ. of Alabama v. Pitts.*, 107 U.S.P.Q.2d 2001 (T.T.A.B. 2013), and *Jansen Enters. v. Rind*, 85 U.S.P.Q.2d 1104 (T.T.A.B. 2007). See Applicant's Response at p. 3. All of these cases are distinguishable on the facts and do not support the argument that the wording "THREE NOTCH'D" is the dominant aspect of Applicant's Mark.

In *In re Viterra*, the Federal Circuit found that the literal portion of the mark  was dominant over the stylized and colored "X" design. See 101 U.S.P.Q.2d at 1911. But the court based its decision on the fact that the design feature was not entirely distinct and separate from the literal portion of the mark, and explained that the stylized "X" design overlapped with and was covered by the other literal parts of the mark. *Id.* Here, unlike the "X" design, Applicant's  design is distinctly separated from the literal portion "THREE NOTCH'D" and does not overlap or cover any part of the wording.

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<sup>2</sup> Opposer's Motion for Summary Judgment, Docket No. 16.

<sup>3</sup> Applicant's emphasis on the  design in its marketing materials and on its products further underscores that it is the dominant portion of Applicant's Mark. See, e.g., Opposer's Motion at pp. 2-10.

Similarly, in *Bd. of Trs. v. Pitts*, the Board found the literal portion of the mark



was dominant over the  background design depicted behind the words

“HOUNDSTOOTH MAFIA.” See 107 U.S.P.Q.2d at 2028. Applicant’s  design in the



mark is not comparable to the  design, which the Board found to play a *secondary*



*role* in applicant’s mark. *Id.* at 2023. Applicant’s  design appears first in the mark and is displayed in a prominent size independent from the other literal elements of Applicant’s Mark such as the words “THREE NOTCH’D.”

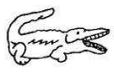
Finally, Applicant’s reliance on *Jansen Enters. v. Rind* is also misplaced. In *Jansen*, the Board

was tasked with comparing opposer’s stylized word mark  against applicant’s composite



mark, which incorporated the term IZZY’S. See 85 U.S.P.Q.2d at 1105-1107. In comparing the marks, the Board focused on the literal portion of applicant’s mark because it included the senior user’s word mark. The Board then considered applicant’s design elements to determine whether they sufficiently distinguished the junior user’s adoption of the senior user’s word mark. See *id.* Unlike in *Jansen*, the focus here is on a senior user’s famous design mark and its incorporation into a junior user’s composite mark. This factual scenario was not addressed by the court in *Jansen* or in any of the other cases cited by Applicant.

2. **The Secondary Elements of Applicant’s Mark Are Insufficient to Avoid a Finding of Likelihood of Confusion Given the Fame of Opposer’s Mark**

The inclusion of “THREE NOTCH’D” and other words in Applicant’s Mark does not avoid a likelihood of confusion with Opposer’s ® mark. The Board has repeatedly found that when a junior user, such as Applicant, incorporates a design element into its mark that is substantially similar to a senior user’s famous design, additional elements such as literary elements or stylistic differences fail to eliminate a likelihood of confusion. For example, in *Lacoste Alligator SA v. Maxoly Inc.*, the Board found Applicant’s  mark was confusingly similar to the opposer Lacoste’s 

mark. 91 U.S.P.Q.2d 1594, 1598, 2009 WL 4079116, at \*6 (T.T.A.B. 2009) (precedential). The Board recognized that “[f]ame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use.” *Id.* at \*6. While the Board considered the stylistic differences between the alligator designs and the added text contained in the applicant’s mark, it ultimately concluded that “[b]ecause of the fame of opposer’s alligator designs, the addition of the words ‘Colba Island’ is not sufficient to distinguish applicant’s mark from opposer’s marks.” *Id.*

This reasoning was also applied by the Board in *Target Brands, Inc. v. Artificer Life Corp.*, Opp. No. 91206421, 2014 WL 2159247 (T.T.A.B. 2014) (non-precedential). There, the Board found that

applicant’s  mark was confusingly similar to Target’s famous  mark. Again, the Board recognized the wide latitude given to famous marks: “Indeed, a strong mark ... casts a long shadow which competitors must avoid.” *Id.* at \*6 (quoting *Kenner Parker Toys v. Rose Art Industries Inc.*, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992)). In determining the proper weight owed to the design portion of the applicant’s mark, the Board noted that the bullseye design “is prominent both in size and placement” and thus is dominant over the literal portion of the applicant’s mark. *Id.* at \*8. The Board also explained that “the addition of ‘artificier’ to the design in applicant’s mark is not sufficient to

create a commercial impression that is separate from that of opposer’s famous mark.” *Id.* As a result, the Board found the marks more similar than dissimilar despite the added words and stylistic differences. *Id.*

Here, the fame of Opposer’s ® mark has been previously recognized by the Board. *See, e.g., Monster Energy Co., v. Zekser*, Opp. No. 91203340, 2015 WL 4779214, at \*4 (T.T.A.B. July 30, 2015) (non-precedential). Applicant also fails to refute the substantial evidence presented by Opposer regarding its widespread promotion and use of the ® mark, which demonstrate the fame of the mark. Accordingly, Opposer’s Mark is owed “extreme deference” and a “wide latitude of legal protection.” *See Lacoste Alligator SA*, 2009 WL 4079116, at \*3. In sum, the Board should rule, as it did in both *Lacoste* and *Target*, that the additional elements in Applicant’s Mark fail to distinguish it from Opposer’s famous ® mark.<sup>4</sup>

**B. Opposer’s Motion Does Not Contradict the Record**

In its brief, Applicant also accuses Opposer of mischaracterizing testimony and manipulating images of Applicant’s Mark. Applicant’s Response at pp. 1, 6-7, and 10-11. Both of those allegations are unfounded.

**1. Opposer’s Representations of Applicant’s Mark Fairly and Accurately Demonstrate its Similarity to Opposer’s Mark**

Applicant accuses Opposer of contorting the appearance of Applicant’s Mark by “careful scale reduction and rotation.” *Id.* at 6. While Opposer’s Motion includes images of Applicant’s Mark shown in different sizes and orientations, Applicant cites to no authority requiring that marks be evaluated using the exact size and orientation shown in the trademark application.

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<sup>4</sup> *See also Nike, Inc. v. Palm Beach Crossfit Inc.*, 116 U.S.P.Q.2d 1025 (T.T.A.B. 2015) (finding Opposer had sufficiently stated a claim for likelihood of confusion between Opposer’s Jumpman design

marks depicting a silhouette of Michael Jordan, including its  mark, and Applicant’s  mark and denying Applicant’s motion to dismiss that claim under Fed. R. Civ. P. Rule 12(b)(6)).

Federal trademark registrations protect marks irrespective of the size and orientation depicted in the applications. Applicants who seek this type of protection should face a similar level of scrutiny at the opposition stage. Here, Applicant is not disclaiming any sizes or orientations of Applicant's Mark in its application. In fact, the specimens submitted by Applicant during prosecution include depictions of the mark used in different sizes. *See* Declaration of Jason Champion #2 (filed herewith) ¶ 2, Ex. 1.

Applicant also does not dispute that it uses Applicant's Mark and the  design in different variations and orientations. Indeed, Applicant admitted in its Response that some of the images displayed in Opposer's Motion reflect Applicant's actual use in the marketplace. *See* Applicant's Response at p. 7 ("Opposer continually points to variations and portions of Applicant's Mark, **some of which are occasionally used in the marketplace...**") (emphasis added).

**2. Opposer Does Not Mischaracterize the Testimony of Applicant's CEO**

Applicant accuses Opposer of mischaracterizing the testimony of Applicant's CEO George Kastendike. Specifically, Applicant takes issue with Opposer's argument that 

 Applicant's Response at p. 10. But Opposer's brief cannot have mischaracterized Mr. Kastendike's testimony because it does not include any citations to his testimony in that section. *See* Opposer's Motion at pp. 23-24. Indeed, the only quote credited to Mr. Kastendike is taken verbatim from an email written by Mr. Kastendike:

Opposer's Motion	Champion Decl. Ex. 17 <sup>5</sup>

Moreover, Applicant's citation to self-serving deposition testimony in response to Opposer's reliance on Mr. Kastendike's email should be disregarded. [REDACTED]

**C. All of Opposer's Evidence Is Properly Introduced**

Applicant argues that the website screenshots submitted by Opposer showing companies selling both alcoholic and non-alcoholic beverages are unsupported by admissible evidence. Applicant's Response at p. 12. Applicant's argument is without merit. All of the screenshots introduced by Opposer contain the necessary date and URL information to be properly authenticated. Moreover, they are also accompanied by the testimony of Opposer's CEO Rodney Sacks and therefore are sufficiently supported by admissible evidence. *See* Sacks Decl. ¶¶ 34-35.<sup>6</sup> Finally, at a minimum, the screenshots are admissible to show that companies are representing the existence and availability of these products on their websites.<sup>7</sup>

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<sup>5</sup> Opposer refers to the Declaration of Jason Champion which was filed in support of Opposer's Motion for Summary Judgment, Docket No. 18.

<sup>6</sup> Opposer refers to the Declaration of Rodney Sacks which was filed in support of Opposer's Motion for Summary Judgment, Docket No. 20.

<sup>7</sup> Applicant also asserts that energy drinks cannot contain alcohol and thus consumers are unlikely to believe that an energy drink manufacturer also sells alcoholic beverages. Applicant's Response at pp. 8-9. However, Applicant ignores that many companies sell both alcoholic and non-alcoholic beverages, and thus consumers are likely to believe a company that sells non-alcoholic beverages also sells beer.

**III. CONCLUSION**

For the foregoing reasons, Opposer respectfully requests the Board grant Opposer's Motion for summary judgment that there is a likelihood of confusion between Opposer's Mark and Applicant's Mark.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: March 22, 2016

By: /Jason A. Champion/

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **REPLY MEMORANDUM IN SUPPORT OF MOTION FOR PARTIAL SUMMARY JUDGMENT** has been served on Robert C. Van Arnam by mailing said copy on March 22, 2016 via First Class Mail, postage prepaid to:

Robert C. Van Arnam  
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Signature: 

Name: Doreen P. Buluran

Date: March 22, 2016

22924790/dpb/031616



I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

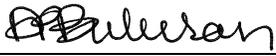
Dated: March 22, 2016

By: /Jason A. Champion/  
Jason A. Champion

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **DECLARATION OF JASON A. CHAMPION IN SUPPORT OF REPLY MEMORANDUM IN SUPPORT OF OPPOSER'S MOTION FOR PARTIAL SUMMARY JUDGMENT** has been served on Robert C. Van Arnam by mailing said copy on March 22, 2016 via First Class Mail, postage prepaid to:

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Signature: 

Name: Doreen P. Buluran

Date: March 22, 2016

22958086/dpb/032216

# EXHIBIT 1





