

THIS OPINION
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OF THE TTAB

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

Mailed: June 16, 2016

Opposition No. 91223512

ABG Collective LLC

v.

Atmos Nation LLC

**Before Cataldo, Taylor, Gorowitz,
Administrative Trademark Judges.**

By the Board:

Atmos Nation LLC (“Applicant”) seeks to register the mark AIRWALK,¹ in standard characters, for “electronic cigarettes; electronic cigars; electronic hookahs; electronic smoking pipes; mechanical electronic cigarettes; smokeless cigarette vaporizer pipe” in International Class 34 (“Applicant’s Mark”).

ABG Collective LLC (“Opposer”) opposed the registration of Applicant’s Mark on the grounds of likelihood of confusion and dilution by blurring and dilution by tarnishment, alleging common law rights and ownership of registrations for AIRWALK and marks which include the term AIRWALK in various classes, in connection with goods and services including “footwear, apparel, sporting goods and equipment, and in connection with sporting events

¹ Application Serial No. 86459048 was filed November 19, 2014 under Trademark Act Section 1(b), 15 U.S.C § 1051(b).

and for retail store services related to the same.” 1 TTABVUE ¶ 3. Applicant denied the salient allegations of the notice of opposition and enumerates a variety of affirmative defenses.

This case now comes up on Applicant’s motion, filed February 10, 2016, for summary judgment on the grounds of likelihood of confusion, dilution by blurring and dilution by tarnishment. In response to the motion for summary judgment, Opposer argues that Applicant’s motion should be denied for lack of evidence² and alternatively, moves for 56(d) discovery.

Motion for 56(d) Discovery

Rather than filing a responsive brief, Opposer seeks discovery pursuant to Fed. R. Civ. P. 56(d) to respond to Applicant’s motion for summary judgment which Applicant opposes. A party that believes that it cannot effectively oppose a motion for summary judgment without first taking discovery may file a request with the Board for time to take the needed discovery. *See* Fed. R. Civ. P. 56(d); TBMP § 528.06 (2015).

In view of the Board’s decision herein on the merits of Applicant’s motion for summary judgment, as discussed *infra*, Opposer’s motion for 56(d) discovery is moot.

Motion for Summary Judgment

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to material facts, thus leaving the case to be

² Opposer did not otherwise address the motion for summary judgment.

resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). In deciding motions for summary judgment, the Board must follow the well-established principles that, in considering the propriety of summary judgment, all evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. The Board may not resolve disputes of material fact; it may only ascertain whether such disputes are present. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The burden is on the party moving for summary judgment to demonstrate the absence of any genuine dispute of material fact, and that it is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(c). The burden of the nonmovant to respond arises only if the summary judgment motion is properly supported. *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 160-161 (1970). If the evidence produced in support of the summary judgment motion does not meet this burden, “summary judgment must be denied even if no opposing evidentiary matter is presented.” *Id.* (quoting Fed. R. Civ. P. 56 advisory committee notes to the 1963 amendments). As the moving party, opposer’s initial burden is greater than the evidentiary burden at trial. *See* TBMP §528.01 and cases cited therein.

Likelihood of Confusion

In determining the issue of likelihood of confusion and, in this case, whether there is any genuine dispute of material fact relating to that ultimate legal question, we must consider the pertinent evidentiary factors listed in *In re E.I. du Pont de Nemours & Co.*³ In its motion for summary judgment, Applicant argues, *inter alia*, that the *du Pont* factors of similarity of marks and goods weigh in favor of a finding of no likelihood of confusion. More specifically, Applicant argues that it “acknowledges the aesthetic similarities in [the parties’] marks,” but that it is irrelevant when considering the overall difference in the parties’ goods, channels of trade, class of customers, lack of actual confusion and Applicant’s intent in adopting Applicant’s Mark. 6 TTABVUE pp. 8-11. Applicant did not submit any evidence or declarations to support its argument.⁴

Given the dearth of evidentiary support, and drawing all possible inferences in favor of Opposer as the non-moving party, we conclude that Applicant did not meet its burden on summary judgment. In particular, Applicant failed to demonstrate that there are no genuine disputes of material fact with respect to the claim of likelihood of confusion. Genuine disputes of material facts exist with respect to the issues of whether the parties’ respective goods are related, are sold to the same class of customers, and are sold in the same channels of trade.

³ 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, our primary reviewing court's predecessor, discussed the factors relevant to a determination of likelihood of confusion.

⁴ The file of the opposed application is automatically of record, *see* Trademark Rule 2.122(b).

Accordingly, Applicant's motion for summary judgment on the ground of likelihood of confusion is **denied**.

Dilution

Dilution under Section 43(c) of the Act, 15 U.S.C. § 1125(c) requires consideration of the following: (1) whether the opposer's mark is famous; (2) whether the opposer's mark became famous prior to the date of the application to register the applicant's intent to use mark; and (3) whether the applicant's mark is likely to cause dilution by blurring or tarnishment of the opposer's famous mark. *See Coach Services Inc. v. Triumph Learning LLC*, 668 F3d 1356, 101 USPQ2d 1713, 1723-24 (Fed. Cir. 2012); *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1295 (TTAB 2016); *Research in Motion Ltd. v. Defining Presences Marketing Group Inc.*, 102 USPQ2d 1187, 1197 (TTAB 2012); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001); *The Toro Company v. Torohead, Inc.*, 61 USPQ2d 1164 (TTAB 2001).

In its motion for summary judgment on the ground of dilution, Applicant argues, *inter alia*, that Opposer's mark is not famous; and that Opposer cannot show that Applicant's mark would impair Opposer's mark or that the parties' marks would be linked such that it would lead to blurring or tarnishment. 6 TTABVUE pp. 12-14. Applicant did not submit any evidence or declarations in support of this claim.

Drawing all possible inferences with respect to Applicant's motion in favor of Opposer as the nonmoving party and the fact that Applicant has not made of record any evidence in support of its arguments, Applicant again has failed to meet its burden on summary judgment with respect to its claim of dilution. There are genuine disputes as to whether or not Opposer's marks are famous and whether Applicant's Mark would dilute the distinctiveness of Opposer's pleaded marks.

Applicant's motion for summary judgment based on dilution is **denied**.⁵

Motion for Sanctions

Opposer seeks sanctions against Applicant under Rule 11 because of Applicant's "utter lack of evidentiary support proffered in support of its motion" which Opposer construes as "calculated in bad faith or to waste the time and resources of [Opposer] and the Board." 8 TTABVUE p. 6. Applicant disputes the allegations of bad faith and harassment.

Under Fed. R. Civ. P. 11, made applicable by Trademark Rule 2.116, the Board has discretion to impose sanctions for, among other things, filings that are presented to the Board "for any improper purpose, such as to harass or to cause unnecessary delay or needless increase in the cost of litigation." *See Carrini Inc. v. Carla Carini, Srl*, 57 USPQ2d 1067, 1071 (TTAB 2000); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 967-68 (TTAB 1986).

⁵ The fact that we have identified certain genuine disputes as to material facts should not be construed as a finding that these are necessarily the only disputes which remain for trial.

Whether the filing of Applicant's motion for summary judgment without evidence was motivated by bad faith or harassment is, at this point in this proceeding, speculative. Based on the record before us, the Board is not persuaded that the imposition of sanctions, at this time, is warranted.⁶ Opposer's motion is **denied**.

Outstanding Discovery

When a party to a Board proceeding files a motion which is potentially dispositive of the proceeding, such as a motion for summary judgment, the Board will suspend that proceeding with respect to all matters not germane to the motion. See Trademark Rule 2.127(d); *Leeds Technologies Ltd. V. Topaz Communications Ltd.*, 65 USPQ2d 1303 (TTAB 2002); *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040, 1044 n.7 (TTAB 1985); TBMP § 510.03(a).

To the extent any discovery was properly served prior to the filing of Applicant's motion for summary judgment, the responding party is allowed **fifteen days** from the date of this order to serve its responses to the serving party's discovery requests.

Proceedings are resumed. Dates are reset as follows:

Expert Disclosures Due	8/5/2016
Discovery Closes	9/4/2016
Plaintiff's Pretrial Disclosures	10/19/2016
Plaintiff's 30-day Trial Period Ends	12/3/2016

⁶ In any event, Opposer has not complied with the "safe harbor" provision of Fed. R. Civ. P. 11(c)(2). This provision delays filing of a motion for sanctions before the Board for twenty-one days after service of the motion and allows the motion to be filed only if the challenged submission is not withdrawn or appropriately corrected within those twenty-one days or within another time that the Board may set. The Board will deny motions for Fed. R. Civ. P. 11 sanctions which fail to comply with this requirement.

Defendant's Pretrial Disclosures	12/18/2016
Defendant's 30-day Trial Period Ends	2/1/2017
Plaintiff's Rebuttal Disclosures	2/16/2017
Plaintiff's 15-day Rebuttal Period Ends	3/18/2017

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. An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.