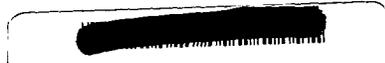


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD



10-23-2002

U.S. Patent & TMO/tm Mail Rcpt Dt. #22

BELL, INCORPORATED,

Petitioner,

vs.

BELL PACKAGING CORPORATION,

Respondent.

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Cancellation No. 31,904

Mark: BELL PACKAGING CORPORATION

Registration No. 2,089,082

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TRADEMARK TRIAL AND APPEAL BOARD

RESPONDENT'S RESPONSE TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT

On October 2, 2002, Petitioner Bell, Incorporated ("Petitioner") filed a Motion for Summary Judgment (hereafter the "Petitioner's Motion") in the above-referenced cancellation proceeding. In response, Respondent Bell Packaging Corporation ("Respondent") submits that Petitioner's Motion is untimely and should be given no consideration by the Trademark Trial and Appeal Board (the "Board"). Furthermore, Respondent submits that, even if Petitioner had timely filed its Motion, Petitioner has failed to meet its burden of proof under Fed. R. Civ. P. 56 to sustain its Motion for Summary Judgment.

RESPONDENT'S BRIEF

I. Petitioner's Motion Should be Denied as Untimely

Petitioner's Motion should be denied as untimely because it was filed during Petitioner's testimony period as reset by the Board in its ruling mailed August 29, 2002. 37 CFR 2.127(e)(1) A motion for summary judgment should be filed prior to the commencement of the first

testimony period, as originally set or as reset. The Board, in its discretion, may deny as untimely any motion for summary judgment filed thereafter. 37 CFR 2.127(e)(1)

Petitioner has presented no reason for filing its Motion late, and Respondent submits that the late filing of Petitioner's Motion is an example of the lack of interest Petitioner has shown in prosecuting its cancellation proceeding. Petitioner has not served discovery in this proceeding, but has answered Respondent's discovery requests. Petitioner requested, and the Board granted, an extension of the testimony periods; however, Petitioner has failed to notice or take depositions in this proceeding. Petitioner's Motion is a mere three pages long and, as discussed below, contains little relevant evidence or legal basis to support the claims alleged in the cancellation. For these reasons, Respondent requests that the Board deny Petitioner's Motion.

II. Petitioner's Motion Should be Denied Because Petitioner has Failed to Meet Its Burden for Summary Judgment

A. Federal Rule of Civil Procedure 56

Pursuant to Trademark Board Manual of Procedure ("TBMP") § 528, Federal Rule of Civil Procedure 56 governs motions for summary judgment filed in *inter partes* proceedings before the Board. It is well-settled that summary judgment is only appropriate when "there is no genuine issue as to any material fact and . . . the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c); *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1116, 227 U.S.P.Q. (BNA) 557, 581 (Fed. Cir. 1985) (*en banc*). "The *movant* bears the burden of demonstrating absence of all genuine issues of material fact." *SRI*, 775 F.2d 1116, 227 U.S.P.Q. (BNA) at 581 (emphasis added); *Armco, Inc. v. Cyclops Corp.*, 791 F.2d 147, 149, 229 U.S.P.Q. (BNA) 721, 722-723 (Fed. Cir. 1986). "The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist; and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party." TBMP § 528, and

cases cited therein. “A fact is material if it may ‘affect the decision, whereby the finding of fact is relevant and necessary to the proceedings.’” *Id.*, citing, *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992).

In the instant cancellation proceeding, Petitioner has failed to show that there are no genuine issues of material fact, or that it is entitled to judgment as a matter of law. Petitioner has alleged but failed to prove that Petitioner adopted and began using its BELL mark (“Petitioner’s Mark”) before Respondent adopted and began using its BELL PACKAGING COMPANY mark (“Respondent’s Mark”). Petitioner has alleged but failed to prove that there is a likelihood of confusion between these two marks. These two issues form the crux of Petitioner’s basis for cancellation and, therefore, constitute issues of material fact. Petitioner states in its Motion that “both parties are using the same distinctive name or mark, BELL, in connection with very similar or identical products or services. Petitioner’s use of BELL commenced long prior to Respondent’s use. These are uncontroverted facts; Petitioner believes they are incontrovertible facts.” Respondent submits that these are not uncontroverted facts; they are two genuine issues of material fact that remain unresolved.

B. Petitioner has Failed to Establish That it has Prior Rights in its Mark or That There is a Likelihood of Confusion between Petitioner’s Mark and Respondent’s Mark.

1. Petitioner’s Evidence

The evidence submitted by Petitioner to support its Motion for Summary Judgment is insufficient to establish that there is no genuine issue as to the parties’ respective dates of first use of their marks or whether there is a likelihood of confusion between the two marks. Petitioner has neither served discovery nor taken testimony in this proceeding. The only evidence presented by Petitioner consists of the following, which was submitted with Petitioner’s Motion: (1) the affidavit of Mark Graham, which states, among other things, that “[c]ontinuously since 1976 (and to the best of my knowledge and belief, long prior thereto) the company has used BELL or BELL PAPER BOX as its trade name. . .” and that “[c]ontinuously since 1976, the company has also used BELL and BELL PAPER BOX as a service mark in connection with

its service of custom designing and producing paperboard containers for specific customer's needs, and as a trademark applied to some of its containers;" (2) copies of income tax returns for Bell Incorporated and Bell Paper Box, Inc. for the years 1992 through 2001; (3) copies of independent auditors' reports for Bell Incorporated and Bell Paper Box, Inc. for the years 1991 through 2001; (4) what appears to be a copy of a brochure promoting Petitioner's products and services; (5) what appear to be copies of Petitioner's products that feature a "W" logo but not the Petitioner's Mark; and (6) copies of documents showing Petitioner's Overhead Budget for the years 1991 through 2002.

2. Petitioner's Evidence Does Not Establish Prior Trademark Use

Other than Petitioner's self-serving affidavit, Petitioner has presented no evidence that Petitioner's Mark was used prior to Respondent's adoption and use of Respondent's Mark. In his affidavit, Mr. Graham appears to have drawn a legal conclusion that may be incorrect with established principles of trademark law. Petitioner's Exhibits 3 and 4 appear to be an advertising brochure and packaging. There is no evidence that the brochure was used in commerce prior to Respondent's use of Respondent's Mark, or that it was ever used in commerce. The packaging in Exhibit 4 does not show use of Petitioner's Mark. In fact, the product packaging shows an entirely different "w" mark and not Petitioner's Mark. There is no evidence concerning when and if the packaging was used in commerce. Thus, Petitioner's evidence does not establish that Petitioner used its mark as a trademark for its products before Respondent used Respondent's Mark in connection with Respondent's goods and services.

3. Petitioner's Evidence Does Not Establish a Likelihood of Confusion

Petitioner has not presented any evidence of a likelihood of confusion between Petitioner's Mark and Respondent's Mark. Likelihood of confusion is a question of law, based on underlying factual determinations. *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 767, 25 U.S.P.Q.2d (BNA) 2027, 2028 (Fed. Cir. 1993). Whether likelihood of confusion exists between two marks is determined on a case-by-case basis, aided by the application of the factors set out in *In re E.I. DuPont De Nemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. (BNA)

563,567 (C.C.P.A. 1973). The DuPont factors are intended to provide an analytical framework, wherein individual factor(s) are considered “when relevant evidence is of record.” DuPont, supra, 476 F.2d at 1361, 177 U.S.P.Q. (BNA) at 567. Indeed, “none of these factors by itself is dispositive of the likelihood of confusion question, and different factors will weigh more heavily from case to case depending on the particular facts and circumstances involved.” International Kennel Club, 846 F.2d 1079, 1087. Therefore, the “weight and totality of the most important factors in each case will ultimately be determinative of the likelihood of confusion, not whether the majority of the factors tilt the scale in favor of one side or the other.” Schwinn Bicycle Co. v. Ross Bicycles, Inc., 870 F.2d 1176, 1187 (7th Cir. 1989).

Petitioner has failed to perform a likelihood of confusion analysis in its Motion. There are a number of material facts that are relevant to the determination of whether a likelihood of confusion exists between Petitioner’s Mark and Respondent’s Mark, such as, (1) whether the parties’ respective marks are used on similar or related goods; (2) whether the parties’ respective goods are advertised and sold in the same channels of trade; (3) whether the parties’ respective goods are advertised and sold to the same class of consumers; (4) the conditions under which and the buyers to whom sales are made; (5) the nature and extent of any actual confusion; (6) the length of time during and the conditions under which there has been concurrent use without evidence of actual confusion; and (7) whether there are other third parties using similar marks.

Petitioner has neither thoroughly addressed whether there is a likelihood of confusion between the marks nor presented evidence concerning these issues. Petitioner has only made conclusory statements that the marks are used in connection with very similar or identical products and that there is a likelihood of confusion between the marks. Thus, the assertions advanced by Petitioner in support of its Motion for Summary Judgment are unsupported by the evidence. Petitioner has failed to take discovery or depositions to obtain evidence in support of its case against Respondent. Accordingly, Petitioner has not adduced sufficient facts as to any of

the DuPont factors, and must instead rely only upon information of record such as the marks themselves, the goods identified for use with the marks in the parties' respective applications, and the self-serving affidavit attached to Petitioner's Motion. Therefore, Petitioner is not in a position to assess the likelihood of confusion. From the limited evidence gathered thus far, it would appear that Respondent's Mark is used in connection with packing supplies and boxes used by third parties to *ship* quantities of their goods for further distribution, while Petitioner produces paper packaging for third parties that contain the third party product and bear the third party trademark. Therefore, Respondent submits that the evidence suggests that the parties' respective goods may be sold to different classes of consumers, through different channels of trade and in a manner that would preclude confusion among the relevant consumers.

The ultimate question is whether relevant consumers, when faced with the marks as they are used in the marketplace, would be confused to believe that the goods and services offered under one of the marks were affiliated with, sponsored by or otherwise connected to the source of the other. Petitioner has not presented evidence sufficient to show that there is no genuine issue of material fact regarding this question. *For this reason*, summary judgment in favor of Respondent is not appropriate at this juncture. Accordingly, Respondent hereby requests that Petitioner's Motion for Summary Judgment be ***denied***.

III. Conclusion

Petitioner's Motion should be denied by the Board because it was not filed in a timely manner. Even if Petitioner's Motion had been filed in a timely manner, Petitioner has failed to meet the standard imposed under Fed. R. Civ. Pro. 56. Petitioner has failed to show that it enjoys senior rights in its mark or that there is a likelihood of confusion between Petitioner's

Mark and Respondent's Mark. Respondent must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist. Respondent respectfully requests Petitioner's Motion for Summary Judgment be denied.

Respectfully submitted,


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ATTORNEYS FOR RESPONDENT

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of this Respondent's Response to Petitioner's Motion for Summary Judgment was served on the attorneys of record for Petitioner via U.S.

Express Mail to the following this the 22nd day of October, 2002:

J.W. Gipple, Esq.
GIPPLE & HALE.
P.O. Box 40513
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Pamela S. Ratliff
Pamela S. Ratliff

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 in an envelope addressed to:
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