

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: January 7, 2005

Opposition No. **91151445**
Cancellation No. **920040955**

ROLLER DERBY SKATE CORPORATION

v.

BAUER NIKE HOCKEY INC.

Before Hairston, Bottorff, and Holtzman,
Administrative Trademark Judges

By the Board:

Bauer Nike Hockey Inc. ("defendant") seeks to register
the following miscellaneous design



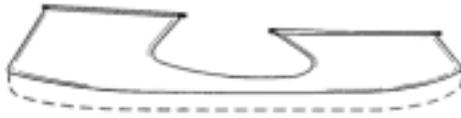
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and has registered the following miscellaneous design

¹ Application Serial No. 75873445, filed December 17, 1999, under Trademark Act Sections 1(a) and 44(e), 15 U.S.C. Section 1051(a) and 1126(e), and alleging 1977 as the date of first use and date of first use in commerce. The application includes a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f), and the following statements:

The mark consists of the design of an ice hockey blade chassis with a oval-shaped opening in the center of the blade chassis and rectangular-shaped indentations along the bottom portion of the oval-shaped opening. The broken line in the drawing shows the skate blade and is not a part of the mark. The lining in the drawing, other than the broken line that shows the actual blade of the ice skate, is for shading purposes only and is not claimed as a part of the mark.

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both for "ice skate blades" in International Class 28.

Roller Derby Skate Corporation ("plaintiff") has opposed registration of the mark in application Serial No. 75873445 and seeks cancellation of Registration No. 2551672. As grounds for opposition and cancellation, plaintiff contends that the marks at issue are unregistrable because they are *de jure* functional; that, while defendant stated, in response to examining attorney's queries regarding whether the marks are the subject of design or utility patents, that it had owned expired Canadian Patent No. 984422, defendant failed to disclose, in contravention of Trademark Rule 2.61(b), that the marks at issue had also been the subject of expired United States utility Patent Nos. 3934892, 4074909, and 4218069 and Canadian Patent Nos. 1072994 and 1113129; and that defendant committed fraud upon

² Registration No. 2551672, issued March 26, 2002, and alleging 1977 as the date of first use and date of first use in commerce. The application includes a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. Section 1052(f), and the following statements:

The mark consists of the design of an ice hockey blade chassis with a oval-shaped opening in the center of the blade chassis. The broken line in the drawing shows the skate blade and is not a part of the mark. The lining in the drawing other than the broken line that shows the actual blade of the ice skate is for shading purposes only.

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the Office during *ex parte* examination of involved application Serial No. 75873445 and of the underlying application that became Registration No. 2551672 by failing to disclose the additional patents. Defendant denied the salient allegations of the notice of opposition and petition to cancel in its answers. The Board consolidated the above-captioned proceedings in a May 22, 2003 order.

This case now comes up for consideration of (1) plaintiff's motion (filed July 15, 2003) for summary judgment on the Rule 2.61(b) and *de jure* functional grounds;³ (2) defendant's consented motion (filed May 11, 2004) to reopen time to respond to the motion for summary judgment; and (3) defendant's consented motion (filed June 4, 2004) to extend time to respond to the motion for summary judgment. The motion for summary judgment has been fully briefed.⁴

As an initial matter, defendant's consented motion to reopen its time to respond to the motion for summary judgment and its motion to extend time to respond to the motion for summary judgment are hereby granted. Accordingly, the brief in opposition to the motion for

³ Defendant filed a motion for leave to take discovery under Fed. R. Civ. P. 56(f) on August 19, 2003. In a February 13, 2004 order, the Board denied that motion and reset defendant's time to respond to the motion for summary judgment.

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summary judgment that defendant filed on July 6, 2004 was timely filed.

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material facts, and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). All evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. See *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992).

With regard to plaintiff's motion for summary judgment on the Rule 2.61(b) ground, that rule does not constitute a basis upon which to oppose or cancel a registration because it involves *ex parte* examination issues only. Cf. *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ 2034 (TTAB 1989). Rule 2.61(b) allows an examining attorney to request from an applicant information and exhibits reasonably necessary for *ex parte* examination of marks, and an examining attorney may refuse registration for failure to comply with such a request. See *In re Babies Beat Inc.*, 13 USPQ2d 1729 (TTAB 1990). However, Rule 2.61(b) does not provide a third party with a basis for opposing or canceling

⁴ We have, in our discretion, considered plaintiff's reply brief because it clarifies the issues before us. See Trademark Rule 2.127(a).

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a registration based on failure to comply fully with an examining attorney's request made thereunder.⁵ Accordingly, plaintiff's motion for summary judgment on the Rule 2.61(b) ground is hereby denied.

Turning to plaintiff's motion for summary judgment on the ground that the marks are *de jure* functional, we have said, "[i]n general terms, that a product feature is functional,' and cannot serve as a trademark, 'if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.'" *Qualitex Co. v. Jacobsen Products Co.*, 514 U.S. 159, 165 (1995) (quoting *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850, n. 10 (1982)). Expanding upon the meaning of this phrase, the Supreme Court has observed that a functional feature is one the "exclusive use of [which] would put competitors at a significant non-reputation-related disadvantage." 514 U.S. at 165. See *Traffix Devices Inc. v. Marketing Displays Inc.*, 523 U.S. 23, 32, 58 USPQ2d 1001, 1006 (2001).

Our reviewing court, the United States Court of Appeals for the Federal Circuit, looks at four factors in considering the issue of functionality: (1) the existence of a utility patent disclosing the utilitarian advantages of

⁵ Rather, the allegations set forth as a Rule 2.61(b) ground are part of plaintiff's fraud ground.

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the design; (2) advertising materials in which the originator of the design touts the design's utilitarian advantages; (3) the availability to competitors of functionally equivalent designs; and (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product. See *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1426 (Fed. Cir. 2002), citing *In re Morton-Norwich Products, Inc.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA 1982).

After reviewing the parties' arguments and materials submitted in support thereof, and drawing all inferences in favor of defendant as the nonmoving party, we find that plaintiff has not met its burden of establishing that it is entitled to summary judgment on the issue of *de jure* functionality. At a minimum, there are genuine issues of material fact as to whether registration of the marks at issue would put defendant's competitors at a significant non-reputation-related disadvantage and as to whether the ice skate blade designs at issue are functionally superior to other available designs.⁶

⁶ The fact that we have identified only two genuine issues of material fact as sufficient bases for denying the motion for summary judgment should not be construed as a finding that these are necessarily the only issues which remains for trial.

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In view thereof, plaintiff's motion for summary judgment is hereby denied.⁷ Proceedings herein are resumed. Discovery remains closed. Trial dates are reset as follows.

Plaintiff's 30-day testimony period to close: **03/11/05**

Defendant's 30-day testimony period to close: **05/10/05**

15-day rebuttal testimony period to close: **06/24/05**

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.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

⁷ The parties should note that the evidence submitted in connection with their motions for summary judgment is of record only for consideration of those motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).