

ESTTA Tracking number: **ESTTA451264**

Filing date: **01/13/2012**

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

Proceeding	92053426
Party	Plaintiff Bachmann Industries, Inc.
Correspondence Address	ROBERTA JACOBS-MEADWAY ECKERT SEAMANS CHERIN & MELLOTT LLC 50 SOUTH 16TH STREET, TWO LIBERTY PLACE 22ND FLOOR PHILADELPHIA, PA 19102 UNITED STATES RJacobsMeadway@eckertseamans.com, MBoesenhofer@eckertseamans.com, JBae@eckertseamans.com
Submission	Opposition/Response to Motion
Filer's Name	Roberta Jacobs-Meadway
Filer's e-mail	rjacobsmeadway@eckertseamans.com, blabutta@eckertseamans.com
Signature	/Roberta Jacobs-Meadway/
Date	01/13/2012
Attachments	PETITIONER'S COMBINED REPLY ISO SUMMARY JUDGMENT (M1007306).PDF (25 pages)(1283530 bytes)

Pursuant to the Board's Order dated December 22, 2011 [Dkt. 23], Petitioner Bachmann Industries, Inc. ("Petitioner" or "Bachmann"), through its undersigned counsel, submits this combined Reply in Support of its Motion for Summary Judgment [Dkt. 13-15] ("motion" or "MSJ") and Opposition to Respondent Scientific Toys, Ltd.'s ("Respondent" or "Scientific") Cross-Motion for Summary Judgment [Dkt. 17-22] ("opposition" or "Opp." or "cross-motion" or "CM").

I. OVERVIEW OF THE PARTIES' RESPECTIVE MOTIONS FOR SUMMARY JUDGMENT

Bachmann moved for summary judgment on the issue of likelihood of confusion between its E-Z TRACK marks (as shown in Reg. Nos. 2,053,073 and 3,222,737) for toy trains and toy train sets, and Scientific's EZTEC mark (as shown in Reg. No. 3,567,168) for toy train sets, *inter alia*. In its motion, Bachmann presented undisputable material facts that establish that it has standing, and priority of use, and that there is a likelihood of confusion between its E-Z TRACK marks and Scientific's EZTEC mark. In its opposition to Bachmann's motion, Scientific failed to meet its burden to present countering evidence sufficient to create a genuine factual dispute. Accordingly, Bachmann's motion for summary judgment should be granted.

Scientific cross-moved for summary judgment on three separate issues, namely, (1) that Bachmann did not have a family of "E-Z" marks at the time Scientific commenced use of its EZTEC mark, (2) there is no likelihood of confusion between Scientific's EZTEC mark and Bachmann's E-Z MATE, E-Z LUBE, E-Z RIDERS, or E-Z COMMAND marks, and (3) there is no likelihood of confusion between Scientific's EZTEC mark and Bachmann's E-Z TRACK marks. In its cross-motion, Scientific failed to meet its burden to present sufficient evidence to establish that there are no issues of material fact in dispute and that Scientific is entitled to

judgment as a matter of law. Accordingly, Scientific's cross-motion for summary judgment should be denied.

II. THERE ARE MATERIAL FACTS IN DISPUTE WITH RESPECT TO SCIENTIFIC'S CROSS-MOTION

Scientific's opposition to Bachmann's motion for summary judgment sets forth a number of irrelevancies and misstatements of fact. Contrary to Scientific's contentions, there are material issues of fact in dispute which preclude grant of its cross-motion for summary judgment. Bachmann had a family of "E-Z" marks at the time Scientific commenced use of its EZTEC mark based on the following facts: Scientific first used the EZTEC mark on toys no earlier than July 20, 1996 (CM, Pg. 3) and on toy train products no earlier than December 31, 1998¹ (CM, Pg. 6; Declaration of Louis Chan ("Chan Dec."), ¶8). In 1994, Bachmann adopted and used a family of E-Z marks for toy train products, including E-Z (as shown in Reg. No. 2,225,724) and E-Z TRACK (as shown in Reg. No. 3,222,737). (MSJ, Sec. II, A, 1; CM, Pg. 19).

There is a likelihood of confusion between Scientific's EZTEC mark and Bachmann's E-Z MATE, E-Z LUBE, E-Z RIDERS, or E-Z COMMAND marks based on the following facts. Bachmann has priority of use for a family of marks. (MSJ, Sec. III, B, 2; and Sec. IV, B, 1, *infra*). The parties' respective marks are confusingly similar on their face: the first and dominant element of each is EZ, while the remaining elements are descriptive (TEC, MATE) or generic (LUBE) or suggestive (RIDERS, COMMAND). (MSJ, Sec. III, B, 3, a; Sec. IV, B, 2, a, *infra*). There is no evidence of third party use of marks comprising the term EZ/EASY such that would diminish Bachmann's own trademarks rights for toy train products. (Sec. IV, A, 2, b, *infra*).

¹ Scientific claims it first used the mark EZTEC in commerce on toy train products in 1998, but does not specify a month or day. Since the date of first use is indefinite, it may be presumed that the effective date is no earlier than December 31, 1998. See TMEP 903.06 ("When only a year is given, the date presumed for purposes of examination is the last day of the year.").

The parties' respective marks are used with toy trains and toy train products. (MSJ, Sec. III, B, 3, b; Opp., Pg. 7). The parties' respective goods travel through overlapping trade channels. (MSJ, Sec. II, A, 3; Opp., Pgs. 5-6). The parties' respective goods are sold to overlapping classes of customers. (MSJ, Sec. III, B, 3, d; Opp., Pg. 17).

All of these issues, however, would be moot upon grant of summary judgment in Bachmann's favor on the grounds that Scientific's EZTEC mark is confusingly similar to Bachmann's E-Z TRACK marks.

III. UNDISPUTED MATERIAL FACTS IN ADDITION TO THOSE SET FORTH IN BACHMANN'S MEMORANDUM IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT THAT WARRANT A DETERMINATION THAT BACHMANN, AND NOT SCIENTIFIC, IS ENTITLED TO SUMMARY JUDGMENT

The undisputed facts about the matters raised by Scientific provide further support for Bachmann's summary judgment motion. Scientific first used the EZTEC mark on toys no earlier than July 20, 1996 (Opp., Pg. 3) and on toy train products no earlier than December 31, 1998 (Opp., Pg. 6; Chan Dec., ¶8). In 1994, Bachmann adopted and used a family of E-Z marks for toy train products, including E-Z (as shown in Reg. No. 2,225,724) and E-Z TRACK (as shown in Reg. No. 3,222,737). (MSJ, Sec. II, A, 1; Opp., Pg. 19). The parties' respective marks are confusingly similar on their face: the first and dominant element of each is EZ, while the remaining elements are descriptive (TEC, TRACK, MATE) or generic (LUBE) or suggestive (RIDERS, COMMAND). (MSJ, Sec. III, B, 3, a; Opp., Pg. 11). There is no evidence of third party use of marks comprising the term EZ/EASY such that would diminish Bachmann's own trademarks rights for toy train products. (MSJ, Sec. III, B, 3, f; Opp., Pg. 13-16). The use of the mark EZTEC on toy train products is not prominent. (Supplemental Declaration of John Metzger ("Supp. Metzger Dec."), ¶5, Ex. A.). The parties' respective marks are used on toy trains and toy train products. (MSJ, Sec. III, B, 3, b; Opp., Pg. 7). The parties' respective goods

travel through overlapping trade channels. (MSJ, Sec. II, A, 3; Opp., Pgs. 5-6). The parties' respective goods are sold to overlapping classes of customers. (MSJ, Sec. III, B, 3, d; Opp., Pg. 17).

IV. STATEMENT OF LAW AND ARGUMENT

A. **THERE ARE NO MATERIAL FACTS IN DISPUTE WITH RESPECT TO BACHMANN'S MOTION FOR SUMMARY JUDGMENT AND BACHMANN IS ENTITLED TO JUDGMENT AS A MATTER OF LAW.**

Bachmann moved for summary judgment on the issue of likelihood of confusion between its E-Z TRACK marks (as shown in Reg. Nos. 2,053,073 and 3,222,737) for toy trains and toy train sets, and Scientific's EZTEC mark (as shown in Reg. No. 3,567,168) for toy train sets, *inter alia*. In its opposition, Scientific argued that Bachmann's motion should be denied because (1) summary judgment cannot be obtained on an issue that has not been pleaded, and (2) the parties' marks are not confusing similar. Neither argument has merit.

1. **Bachmann's References in its Motion for Summary Judgment and Supporting Memorandum to Registrations in Addition to Registration No. 3,222,737 Are Proper.**

Scientific argues that Bachmann can only obtain summary judgment on its claim of likelihood of confusion with respect to Bachmann's E-Z TRACK mark as shown in Reg. No. 3,222,737. (Opp., Pg. 8). Specifically, Scientific argues that Bachmann's marks E-Z TRACK (as shown in Reg. No. 2,053,073), E-Z TRACK (as shown in Reg. No. 2,061,990), and BACHMANN E-Z TRACK SYSTEM (& Design) (as shown in Reg. No. 3,301,198), were not introduced in this proceeding until Bachmann's motion for summary judgment, and therefore, cannot form the basis for Bachmann's motion.

Scientific's argument is unfounded. Bachmann is seeking summary judgment on the issue of likelihood of confusion between the marks E-Z TRACK and EZTEC when used in connection with toy train products. Bachmann is entitled to submit a wide variety of relevant

evidence in support of its motion, including copies of other federal trademark registrations. TBMP 528.05(a)(1) (“In addition, a party may make of record, for purposes of summary judgment, copies of other registrations...”) Bachmann references its various “E-Z TRACK” registrations in order to, *inter alia*, support the point that the E-Z TRACK marks, as used in connection with toy train products, and as registered without objection or challenge, are distinctive, and therefore, strong. Scientific’s continued registration of its EZTEC mark for toy train products is a source of damage to Bachmann based on Bachmann’s prior use and its registration of its E-Z TRACK mark. *See Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1429 (TTAB 1993) (any confusion made likely by a junior user’s mark will support a finding of likelihood of confusion and will be a cause for refusal of a registration).

Scientific’s argument raises no genuine factual dispute that would preclude grant of summary judgment in Bachmann’s favor.

2. Scientific’s EZTEC Mark For Toy Trains and Toy Train Sets is Confusingly Similar to Bachmann’s E-Z TRACK Marks for Toy Trains and Toy Train Sets and Toy Train Track.

In its opposition to Bachmann’s motion, Scientific sets forth three specific points in support of its position that the parties’ marks are not confusingly similar. None of these arguments create a genuine factual dispute that precludes grant of summary judgment in Bachmann’s favor.

a. The Parties’ Marks are Confusingly Similar in Sound, Appearance, Connotation, and Commercial Impression.

What the marks are, how similar they are, is evident without need for discussion. Scientific argues that its EZTEC mark is visually distinguished from Bachmann’s E-Z TRACK

marks since Bachmann's mark is two words, separated by a hyphen. (Opp., Pg. 10). There is no factual dispute. The marks are what they are. The registration for each mark is in standard character format. The presence or absence of a hyphen and the minor differences in the last syllable of the marks are far outweighed by the marks' similarities. (MSJ, Sec. III, B, 3, a).

Scientific has not refuted and cannot refute the fact that the parties' marks, when considered in their entirety, are similar in not only appearance and sound, but also commercial impression. The dominant portion of Scientific's mark EZTEC is **identical** in sound and appearance to the dominant portion of Bachmann's E-Z TRACK marks. (Opp., Pg. 13; MSJ, Sec. III, B, 3, a). "There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Any difference in meaning prompted by the remaining descriptive or generic elements of the respective marks is outweighed by the similarity in the initial and dominant elements, and the overall similarity. *Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.*, Opposition No. 91157248 (TTAB November 21, 2011) (the syntax, commercial impression, and connotation of the marks CLASSIC CANADIAN and CLASSIC AMERICAN BLEND were found to be similar, as used on similar goods).

Scientific argues from no evidence but only bald surmise that consumers will associate the E-Z TRACK mark with train tracks and the EZTEC mark with "something technical." (Opp., Pg. 10). Such a conclusory statement raises no issue of fact, unsupported as it is by consumer surveys or any other evidence of consumer perception. Rather, both marks will be understood to have something to do with toy trains and toy train sets, given that each mark is specifically registered for use in connection with such goods. Moreover, the suffix "tec," which Scientific does not dispute is shorthand for technology (MSJ, Sec. III, B, 3, a), is a term that is

strongly connected to toy train products, as is the term “track.” The toy train products offered by Scientific under its EZTEC mark are remote-controlled and radio-controlled (Opp., Pg. 3), which features can be considered technological, in contrast to non-electronic toy trains; Bachmann also sells remote-controlled and radio-controlled toy trains. (Supplemental Declaration of Douglas Blaine (“Supp. Blaine Dec.”), ¶¶5-6). This overlap in the respective marks’ appearance, sound, and commercial impressions weighs strongly in favor of a finding of likelihood of confusion.

b. The Registration of Other Marks Incorporating EZ/EASY on Other Goods Does Not Weigh in Favor of a Finding of No Likelihood of Confusion.

Scientific argues that the prefix “EZ” is commonly used within the toy industry, and therefore, the inclusion of the “common” element in the parties’ marks is an insufficient basis on which to predicate a holding of confusing similarity. (Opp., Pg. 16). The registration of the term “EZ” by third parties on goods such as toy ovens or puzzles or water toys is simply immaterial.

Scientific bases its argument on the presence of 32 federal trademark registrations for marks comprising the term EZ/EASY. (Opp., Pgs. 14-15). These third party registrations merely show that at some point in time, various third parties owned registrations for marks comprising the term EZ/EASY on various goods in Class 28. *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1700 (TTAB 1987) (“...the only probative value of the third-party registrations introduced by applicant here, absent a showing that the marks subject of the third party registrations are in use, is to show the meaning of a mark...”); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917 (CCPA 1976) (“third-party registrations are entitled to little weight on the question of likelihood of confusion where there is no evidence of actual use”); *Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.*, Opposition No. 91157248 (TTAB November 21, 2011) (“As to the evidence of actual use of the term CLASSIC in third-party marks on tobacco products, this is not accompanied by any other evidence indicating the length of time said marks

have been in use, the degree of exposure, or the popularity of such marks vis-à-vis the relevant purchasing public.”). On their own, these registrations do not provide any information as to whether and how these marks are actually used in connection with the identified goods or what public recognition there is, if any, of any such marks. The registrations, accordingly, cannot be relied upon to contend that the term EZ/EASY is commonly used in connection with any products, let alone any relevant products, and specifically toy train products, in such a way that precludes a determination of likelihood of confusion in the instant case.

Scientific also improperly claims that the field of “same or closely related goods” includes all toys. (Opp., Pg. 16). It provides no basis whatsoever for its contention that the field should be expanded beyond toy train products as sold by Bachmann and Scientific. *Tektronix, Inc.*, 534 F.2d at 917 (third-party registrations may evidence that some third parties considered the common elements to be suggestive of related products); *Red Carpet Corp. v. Johnstown Am. Enters. Inc.*, 7 USPQ2d 1404, 1406 (TTAB 1998) (the inclusion of the common element in the respective marks may be an insufficient basis on which to predicate a holding of confusing similarity when marks containing such a common feature are used on the same or closely related goods); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1490 (TTAB 2007) (“We cannot conclude from these registrations that HOG or HAWG has a particular significance for goods of the nature of opposer’s or applicant’s products.”). Even with the limited context provided by the third party registrations referenced by Scientific, it is obvious that these registrations are directed to unrelated goods and services. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (the nature and scope of a party’s goods or services must be determined on the basis of the goods or services recited in the application or registration). None of the registrations cited by Scientific are directed to toy trains or toy train products, and no evidence was proffered by Scientific to establish that any of

these third party registrations have had any impact on purchasers in the toy train market. *See* Supp. Blaine Dec., ¶7.

The fact that toy and sporting goods are classified in International Class 28 does not make each of them closely related to all the other products in the same class. Classification has long been recognized to be a matter of administrative convenience having no impact on substantive trademark rights. *See Jean Patou, Inc. v. Theon Inc.*, 9 F.3d 971, 975, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993) (The classification of goods and services has no bearing on the question of likelihood of confusion). Therefore, the goods identified in these third party registrations are not related to the goods identified in the E-Z TRACK registrations merely because they might be classified in International Class 28.

Scientific offers no facts and no evidence to dispute Bachmann's facts and evidence that establish that the toy train market is a specific sub-category within the toy industry; that those are the only goods on which Bachmann's mark is used and registered; and that it is the relevant sub-category that should be considered in the likelihood of confusion analysis (MSJ, Sec. II, A, 4). Simply put, none of the third party registrations referenced by Scientific diminish the strength of Bachmann's E-Z TRACK marks. The third party registrations do not establish that these other EZ/EASY marks are used or that they are used in connection with toy train products or closely related goods. Accordingly, the third party registrations raise no issue of fact sufficient to preclude grant of summary judgment to Bachmann.

c. The Length of Time of Concurrent Use of the Parties' Marks Does Not Weigh Against a Finding of Likelihood of Confusion.

Scientific argues that any potential for confusion is obviated because the parties' marks have been used for fifteen years without any known instances of actual confusion. (Opp., Pgs. 17-18).

Scientific has ignored the facts not subject to dispute that render the absence of confusion evidence a neutral factor in this proceeding. The mere fact that the parties are not aware of specific instances of actual confusion means that, in these circumstances, this is a neutral factor. *General Mills, Inc. v. Fage Dairy Processing Industry S.A.*, 100 USPQ2d 1584 (TTAB 2011) (“As to this factor, we find it to be neutral, and to the extent any inference could be made in applicant’s favor, it would not outweigh the other relevant du Pont factors discussed herein.”); *see also Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1490 (TTAB 2007). Scientific has not advanced any other material facts to dispute the position Bachmann set forth in its motion for summary judgment, namely, that use of the EZTEC mark in connection with toy trains has been so inconspicuous and so restricted that there is no reason to conclude that any confusion should have come to light (MSJ, Sec. III, B, 3, g).

Scientific first used the mark EZTEC on some toy products in 1996. (Opp., Pg. 6). It was not until 1998 that it used the mark on toy train products. (Opp., Pg. 6). Scientific proffers a quote from McCarthy on Trademarks and Unfair Competition §2-18 at 23-133, noting that weight is given to a failure to prove instances of actual confusion only in instances where the relevant products have existed in the market for a long period of time. (Opp., Pg. 17). Given that toy train products are the relevant products to this likelihood of confusion analysis, the parties’ marks have co-existed in the market on the same goods for less than fifteen years. What is more important than the length of use is the lack of prominence of the use of the mark by Scientific, the lack of advertising, and the lack of any effort to make the mark EZTEC known in connection with the toy train products (MSJ, Sec. III, B, 3, g; *see also* Declaration of John Metzger, ¶8, Ex. D), while at the same time, Scientific does, in fact, prominently use and promote the mark EZTEC in connection with other products (*Id.*; *see also*, Supp. Metzger Dec., ¶5, Ex. A). In the circumstances, this factor is neutral in the likelihood of confusion analysis.

3. Scientific Has Not Disputed The Material Facts that Weigh in Favor of a Finding of Likelihood of Confusion

Scientific presents insufficient or no countering evidence to dispute the material facts presented by Bachmann that (a) Bachmann has standing to bring this cancellation action (MSJ, Sec. III, B, 1); (b) Bachmann has priority of use for the mark E-Z TRACK (MSJ, Sec. III, B, 2); (c) the toy train products sold by Scientific under its EZTEC mark are essentially identical to the goods sold by Bachmann under its E-Z TRACK marks (MSJ, Sec. III, B, 3, b); (d) the trade channels in which the E-Z TRACK and EZTEC goods travel are overlapping, if not the same (MSJ, Sec. III, B, 3, c); and (e) the conditions under which, and the buyers to whom sales are made, are essentially the same (MSJ, Sec. III, B, 3, d).

With respect to the relatedness of the goods, Scientific cannot dispute that it is selling under its EZTEC mark the same goods that Bachmann is selling under its E-Z TRACK mark, namely, toy train products. (MSJ, Sec. III, B, 3, b; Opp., Pg. 7). Bachmann seeks to cancel Reg. No. 3,567,168 irrespective of the fact that the registration identifies goods in addition to toy train products.² “Likelihood of confusion may be found based on *any* item that comes within the identification of goods...in the involved registrations...”. *Decho Corp. v. Brigitte Mueller*, Opposition. No. 91183001 (TTAB August 12, 2011) (non-precedential) (emphasis in original) *citing Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *see also In re JTMX.LLC*, 2006 TTAB LEXIS 29 (TTAB 2006) (“Inasmuch as it is well settled that a refusal under Section 2(d) is proper if there is a likelihood of confusion involving any of the goods listed in the application and one or more of the goods set forth in the

² Bachmann would not object if Scientific chose to finally resolve this proceeding by voluntarily limiting the goods identified in Reg. No. 3,567,168 to specifically exclude “trains, train sets,” in accordance with 15 U.S.C. §1068.

cited registrations, it is unnecessary to rule with respect to the other goods listed in applicant's application and registrant's registration.").

It is immaterial that Scientific claims its toy trains are "larger-sized" and "more toy-like" (Opp., Pg. 7), when there is no limitation in Scientific's identification of goods as to size or "realism." *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638 (TTAB 2009) ("We have no authority to read any restrictions or limitations into the registrant's description of goods.") Bachmann's registrations also contain no limitations as to the nature or type of toy train products sold under the E-Z TRACK marks.

With respect to the similar trade channels and similar customers, Scientific admits that its EZTEC toy trains are sold through the exact same retailers through which Bachmann sells its E-Z TRACK products, including Target and Toys R Us (MSJ, Sec. II, A, 3; Opp., Pgs. 5-6), and also concedes that the parties sell to many of the same classes of customers (MSJ, Sec. III, B, 3, d; Opp., Pg. 17).

Scientific attempts to distinguish the conditions under which its products are purchased or used, by speculating that customers who purchase EZTEC toy trains typically use the toy trains "as part of a display around a Christmas tree" (Opp., Pg. 7), while inferring that this is unique to Scientific's customers or products. These conclusory statements are immaterial because there is no restriction on the method of use of the toy train products in Scientific's registration. *In re Thor Tech, Inc.*, 90 USPQ2d at 1638. These statements are also demonstrably false. Scientific has produced no advertisements that show its toy trains actually placed around a Christmas tree, and its product packaging does not show a train display around a Christmas tree or otherwise instruct consumers to place the toy trains around a Christmas tree. Declaration of John Metzger, ¶7, Exhibit C. On the other hand, Bachmann's promotional materials do, in fact, show its own sale of Christmas themed sets and its displays of its train products around Christmas trees, and

that Bachmann's trains have in fact been promoted for such use. Supp. Blaine Dec., ¶8, Ex. 1. Even assuming that these facts could somehow be deemed material, they would weigh in favor of a finding likelihood of confusion.

Scientific has failed to raise any genuine dispute with respect to any material fact which would warrant denial of Bachmann's motion for summary judgment. For all of the foregoing reasons, Bachmann's motion for summary judgment should be granted. There are no material issues of fact in dispute and Bachmann is entitled to judgment as a matter of law. Bachmann has standing, and priority of use, and Scientific's EZTEC mark, as used on toy trains, is confusing similar to Bachmann's E-Z TRACK marks, as used on toy trains.

B. SCIENTIFIC'S CROSS-MOTION FOR SUMMARY JUDGMENT SHOULD BE DENIED BECAUSE THE UNDISPUTED MATERIAL FACTS ESTABLISH THAT BACHMANN IS ENTITLED TO JUDGMENT AS A MATTER OF LAW.

Scientific moved for summary judgment on three separate issues, namely, (1) that Bachmann did not have a family of "E-Z" marks at the time Scientific commenced use of its EZTEC mark, (2) there is no likelihood of confusion between Scientific's EZTEC mark and Bachmann's E-Z MATE, E-Z LUBE, E-Z RIDERS, or E-Z COMMAND marks, and (3) there is no likelihood of confusion between Scientific's EZTEC mark and Bachmann's E-Z TRACK mark.

Grant of summary judgment is proper when there is no genuine issue of material fact and the movant is entitled to judgment as a matter of law. *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548 (1986); *see also* F.R.C.P. 56(c); *Hewlett Packard v. Vudu*, Opposition No. 91185393 (TTAB October 26, 2009). Once the moving party provides evidence that there is no issue of material fact, the burden shifts to the nonmoving party "to proffer countering evidence sufficient to create a genuine factual dispute." *Sweats Fashions, Inc. v. Pannill Knitting*

Company, Inc., 833 F.2d 1560, 1562 (Fed. Cir. 1987). “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 528.01.

None of Scientific’s three arguments provides grounds to grant summary judgment in Scientific’s favor. Scientific failed to establish that there are no undisputed material facts that support grant of Scientific’s motion. Accordingly, Scientific’s cross-motion for summary judgment should be denied.

1. Bachmann Has a Family of E-Z Marks, Which Existed at the Time Scientific Commenced Use of Its Own EZTEC Mark on Toy Train Products.

Scientific seeks summary judgment that Bachmann did not have a family of “E-Z” marks at the time Scientific commenced use of its EZTEC mark.

Scientific first used the EZTEC mark on toy trains no earlier than December 31, 1998. (CM, Pg. 6; Chan Dec., ¶8)³. Prior to that date, Bachmann had adopted and used a family of E-Z marks for toy train products, including E-Z (as shown in Reg. No. 2,225,724) and E-Z TRACK (as shown in Reg. No. 3,222,737). (MSJ, Sec. II, A, 1; CM, Pg. 19). Bachmann commenced use of those particular marks at least as early as 1994. Bachmann’s family of marks established prior to Scientific’s first use of its EZTEC mark has expanded since 1994 to include E-Z MATE (first used in commerce on July 8, 1997) and E-Z LUBE (first used in commerce on February 5, 1998). *See Marion Labs, Inc. v. Biochemical/Diagnostics, Inc.*, 6 USPQ2d 1215, 1218-19 (TTAB 1988).

A family of marks is defined as a “group of marks having a recognizable characteristic.” TMEP 1207.01(d)(xi); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1462

³ See Footnote 1, *supra*.

(Fed. Cir. 1991). The use of at least two or more marks may be sufficient to comprise a family, provided that the marks are used and advertised in such a manner as to create common exposure, and thereafter, recognition of common ownership based upon a feature common to each mark. *Id.*; *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1490 (TTAB 2007); *Decho Corp. v. Brigitte Mueller*, Opposition. No. 91183001 (TTAB August 12, 2011) (non-precedential) (finding that the use of just four marks is “of course” sufficient to comprise a family).

In the instant case, Bachmann’s family of marks all share the common feature “E-Z,” a term distinctively used and promoted by Bachmann in connection with toy train products so as to alert the consuming public that Bachmann, specifically, is the source of the toy train products offered under each mark in the family. Bachmann has presented dated advertising, catalogues, and packaging showing the promotion together of the E-Z marks. (MSJ, Sec. II, A, 1-3). Scientific admits that Bachmann has used and marketed its E-Z marks in such a way as to create a family of marks, by correctly noting that the term is repeatedly used by Bachmann in its advertising and promotional materials. (CM, Pgs. 11, 21). Public recognition of the family can properly be inferred from this evidence. *J & J Snack Foods Corp.*, 932 F.2d at 1462-3.

Even if Bachmann’s marks do not constitute a “family,” the fact that Bachmann has used and promoted variations of its E-Z mark by adding suffixes such as –LUBE and –MATE increases the likelihood that the consuming public will mistake Scientific’s later-adopted EZTEC mark when used on toy train products as yet another one of Bachmann’s E-Z marks. *See Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1700 (TTAB 1987) (finding that this point is relevant even where a family of marks has not been proved).

Each party has presented evidence in support of its respective position regarding whether Bachmann had a family of E-Z marks either at the time Scientific commenced use of its EZTEC

mark which is the subject of the registration placed in issue by the instant petition, or at the time of its first use of EZTEC for toy train products. To the extent there are material facts in dispute, this issue cannot now be resolved through summary judgment.

Scientific's federal trademark registration for EZTEC is subject to cancellation based on the likelihood of confusion between the EZTEC mark and Bachmann's E-Z TRACK marks. It is not necessary for Bachmann to prove the existence of a family of EZ marks in order to establish the likelihood of confusion between the EZTEC mark and the E-Z TRACK marks when all are used and registered in connection with toy train products. This family of marks issue would, therefore, be moot upon grant of summary judgment in Bachmann's favor on the grounds that Scientific's EZTEC mark is confusingly similar to Bachmann's E-Z TRACK marks.

2. There is a Likelihood of Confusion Between Scientific's EZTEC Mark and Bachmann's E-Z MATE, E-Z LUBE, E-Z RIDERS and E-Z COMMAND Marks.

Scientific seeks summary judgment there is no likelihood of confusion between Scientific's EZTEC mark and Bachmann's E-Z MATE, E-Z LUBE, E-Z RIDERS, or E-Z COMMAND marks when each is used in connection with toy train products. (CM, Pgs. 22-23).

There are no undisputed material facts that support Scientific's cross-motion for summary judgment on this issue. Bachmann has priority of use for a family of marks comprising the E-Z mark, dating back to 1994. (MSJ, Sec. III, B, 2; and Sec. IV, B, 1, *supra*). The parties' respective marks are confusingly similar on their face: the initial, dominant element of each mark is EZ , while the remaining elements are descriptive (-TEC, -MATE), generic (-LUBE), or suggestive (-RIDERS, -COMMAND), whose differences are far outweighed by the similarities in the initial, dominant elements. (MSJ, Sec. III, B, 3, a; Sec. IV, B, 2, *supra*). There is no evidence of third party use of marks comprising the term EZ/EASY such that would diminish Bachmann's own trademarks rights for toy train products. (Sec. IV, A, 2, b, *supra*). The parties'

respective marks are used with toy trains and toy train products. (MSJ, Sec. III, B, 3, b; CM, Pg. 7). The parties' respective goods travel through overlapping trade channels (MSJ, Sec. II, A, 3; CM, Pgs. 5-6) and to overlapping classes of customers (MSJ, Sec. III, B, 3, d; CM, Pg. 17). These facts not subject to dispute weigh in favor of finding that confusion is likely.

Each party has presented evidence in support of its respective position regarding whether there is a likelihood of confusion between Scientific's EZTEC mark and Bachmann's E-Z MATE, E-Z LUBE, E-Z RIDERS, or E-Z COMMAND marks when each is used in connection with toy train products. To the extent there are material facts in dispute, this issue cannot now be resolved through summary judgment.

Scientific's federal trademark registration for EZTEC is subject to cancellation based on the likelihood of confusion between the EZTEC mark and Bachmann's E-Z TRACK marks. It is not necessary for Bachmann to prove the likelihood of confusion between Scientific's EZTEC mark and any one of Bachmann's E-Z MATE, E-Z LUBE, E-Z RIDERS, or E-Z COMMAND marks to prevail. This particular issue would, therefore, be moot upon grant of summary judgment in Bachmann's favor on the grounds that Scientific's EZTEC mark is confusingly similar to Bachmann's E-Z TRACK marks.

3. There is a Likelihood of Confusion Between Scientific's EZTEC Mark and Bachmann's E-Z TRACK Marks.

Scientific seeks summary judgment there is no likelihood of confusion between Scientific's EZTEC mark and Bachmann's E-Z TRACK marks. Scientific's argument is based solely on the three reasons set forth in its opposition to Bachmann's motion for summary judgment. (CM, Pg. 23). Scientific's cross-motion for summary judgment must be denied as it is Bachmann that has established its own right to summary judgment on this issue.

To establish its own right to summary judgment on this issue, Bachmann has proven that there is no genuine dispute that (1) it has standing to maintain this proceeding, (2) it is the prior user of its pleaded mark, and (3) the contemporaneous use of the parties' respective marks on their respective goods would be likely to cause confusion, mistake or to deceive consumers.

Hornblower v. Weeks, Inc. v. Hornblower & Weeks, Inc., 60 USPQ.2d 1733, 1735 (TTAB 2001).

a. Bachmann Owns a Valid Trademark.

Bachmann owns several federal trademark registrations for its E-Z TRACK mark, including but not limited to Reg. No. 2,053,073 (*incontestable*) and Reg. No. 3,222,737, for toy trains and toy train sets. (MSJ, Sec. II, A, 1 and Sec. III, B, 1). The registrations directed to the E-Z TRACK mark are "prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate." 15 U.S.C. § 1057(b).

Bachmann's E-Z TRACK marks are distinctive and strong when used in connection with toy train products, having been used by Bachmann on toy train products for at least fifteen years. The E-Z TRACK marks are entitled to a broad scope of protection for such products, where Scientific has subsequently adopted a very similar mark for identical goods.⁴

Scientific attempts to undermine the distinctiveness of the E-Z TRACK marks and the validity of Bachmann's federal trademark registrations for the E-Z TRACK marks throughout its opposition to Bachmann's motion for summary judgment. (*See, inter alia*, CM, Pgs. 11, 16, and

⁴ Even a weak mark is entitled to protection against the registration of a similar mark for closely related goods or services. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 1401 182 USPQ 108, 109 (CCPA 1974).

20). Scientific's attempts constitute an impermissible collateral attack. *See* TMEP 1207.01(d)(iv) quoting 15 U.S.C. §1057(b); *Top Tobacco, L.P. v. North Atlantic Operating Co., Inc.*, Opposition No. 91157248 (TTAB November 21, 2011). Scientific has not petitioned to cancel any E-Z TRACK registration, and therefore, the distinctiveness of Bachmann's marks, and the validity of Bachmann's registrations, are not subject to dispute.

b. Bachmann Has Established Priority of Use of the E-Z TRACK Mark on Toy Train Products.

In its Reg. No. 3,567,168 for the mark EZTEC in connection with "toys, namely, remote controlled, radio controlled, and battery operated vehicles, trains, train sets, helicopters, submarines, boats, musical instruments, pinball machines, animals, and insects," Scientific asserted a date of first use in commerce of July 20, 1996. (CM, Pg. 5). It is undisputed that Scientific first used the EZTEC mark on toy train products, specifically, no earlier than 1998. (MSJ, Sec. II, B; CM, Pg. 6; *see also* Footnote 1, *supra*.)

In its Reg. No. 2,053,073 for the mark E-Z TRACK in connection with "toy train sets," Bachmann asserted a date of first use in commerce of at least as early as August of 1994. In its Reg. No. 3,222,737 for the mark E-Z TRACK in connection with "toy train sets; toy train track, and train track with roadbed," Bachmann asserted a date of first use in commerce of at least as early as August of 1994.

Priority with respect to Bachmann's E-Z TRACK marks cannot be disputed in view of Bachmann's ownership of valid and subsisting registrations for these marks. *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1700 (TTAB 1987) ("Applicant's arguments to the contrary notwithstanding, since applicant has not counterclaimed to cancel any of the four registrations relied upon by opposer, priority is not an issue as to any of the registered marks.") *citing King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). The

veracity of the information contained in Bachmann's registrations has been substantiated several times over, including through specimens of use (MSJ, Sec. II, A, 1 *citing* Blaine Dec. ¶11, Ex. B (showing use of E-Z TRACK toy train products in October/November 1994))⁵, and through declarations (MSJ, Sec. II, A, 1 *citing* Blaine Dec. ¶11 ("Bachmann adopted and began using the E-Z TRACK mark for toy train products at least as early as 1994")) and Supp. Blaine Dec., ¶8, Ex. 1 and ¶9.

Scientific's argument that Bachmann was not using the E-Z TRACK mark in 1994 (CM, Pg. 4 and FN 5-6) is unsupported and unsustainable. Scientific's argument is based heavily upon information culled from the discovery deposition of Douglas Blaine, Bachmann's Vice President of Marketing. (CM, Pg. 4 and FN 5-6). Mr. Blaine's deposition statements are the result of misleading, immaterial, and confusing questions posed by counsel for Scientific, which resulted in Mr. Blaine answering with incomplete or inapplicable information. (Supp. Metzger Dec., ¶6, Ex. B, Pg. 27: 15-23; Pg. 34: 4-25; Pg. 103: 16-20; Pg. 104: 13-16; Pg. 128: 6-14, *inter alia*.) Mr. Blaine, on reviewing the transcript, identified the misstatements and took appropriate steps to correct the transcript so that it is accurate (Supp. Blaine Dec., ¶10, Ex. 2), in accordance with Fed.R.Civ.P. 30(e)(1)(b). The corrected transcript is consistent with all the other the evidence of record, including Bachmann's federal trademark registrations, the documents produced, Mr. Blaine's declaration, and the specimens of record.

During the deposition, counsel for Scientific pursued a misleading and immaterial line of questioning regarding Bachmann's use of the term E-Z alone. (Supp. Metzger Dec., ¶6, Ex. B,

⁵ Scientific argues that use of the E-Z TRACK mark in catalogs is "non-trademark use." (Opp., Pg. 4). To the contrary, the catalogs show the mark on product packaging. TMEP 904.03(h). Moreover, for purposes of determining priority of right, technical trademark use is not required. Use analogous to trademark use is sufficient. *See Dyneer Corp. v. Automotive Prods., PLC*, 37 USPQ2d 1251 (TTAB 1995).

Pg. 21: 23-25; Pgs. 25: 14-22; Pg. 29: 9-13; Pg. 67: 6-9; Pg. 71: 16-18, *inter alia*.) Scientific argues that Mr. Blaine stated during his deposition that Bachmann has never used the mark E-Z “alone” on train tracks or packaging for the trains.⁶ (CM, Pg. 4). However, the material issue is not whether or how or when Bachmann used the term E-Z alone, entirely divorced from any other matter, but whether Bachmann used and uses the term E-Z in such a way that the term creates a separate commercial impression that is recognizable to the purchasing public. A portion of a composite mark is entitled to registration if that portion presents a separate, distinct commercial impression which indicates the source of the goods and distinguishes applicant’s goods from those of others. *See Institut National des Appellations D’Origine v. Vintners International Co. Inc.* 958 F.2d 1574, 22 USPQ2d 1190, 1197 (Fed. Cir. 1992). The evidence of record establishes that Bachmann has used the term E-Z in such a way on toy trains and related toy train products since at least as early as 1994, including as part of the mark E-Z TRACK. E-Z as used by Bachmann creates a separate, distinct commercial impression, which invests rights in E-Z as well as in the composite presented. *Id.*

Bachmann’s priority of use with respect to its E-Z TRACK marks is not subject to dispute.

⁶ Scientific also mistakenly argues that Bachmann’s use of the mark E-Z alone on couplers does not constitute trademark use because the mark is inconspicuous. (CM, Pg. 4, FN 5.) There is no particular requirement as to the size of a mark. *In re Elba, Inc.*, Serial No. 77424767 (December 16, 2011) (not precedential) (a small mark can still serve as a source identifier). Moreover, the mark as it appears on the couplers is visible to the purchaser. Couplers are toy train products that are sold attached to train cars and are intended to be removed and replaced in the ordinary course of use and enjoyment of the products. (Blaine Dec., ¶29.) Bachmann’s use of the term E-Z on couplers constitutes appropriate trademark use.

c. Scientific's EZTEC Mark For Toy Trains Products is Confusingly Similar to Bachmann's E-Z TRACK Mark for Toy Train Products.

The factors by which likelihood of confusion is determined are fully discussed in Bachmann's original motion for summary judgment (MSJ, Sec. III, B, 3), and are further supported in this combined reply and opposition (Sec. IV, A and B, *supra*). Those discussions, arguments, and all supporting evidence are incorporated herein by reference, in support of Bachmann's opposition to Scientific's cross-motion for summary judgment.

All the relevant *DuPont* factors weigh in favor of a finding of likelihood of confusion, or are neutral. No factor weighs in favor of Scientific. No other undisputed material facts support Scientific's cross-motion for summary judgment on this issue.

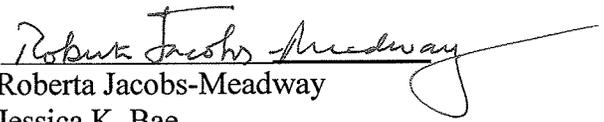
V. CONCLUSION

The material facts not subject to dispute establish that Bachmann has standing, and priority of use, and that there is a likelihood of confusion between Bachmann's E-Z TRACK marks and Scientific's EZTEC mark, as both marks are used in connection with toy train products. Bachmann has met its burden of proof sufficient for grant of summary judgment on the issue of likelihood of confusion between the parties' marks for toy train products. There is no evidence sufficient to create a genuine factual dispute that contemporaneous use of the E-Z TRACK and EZTEC marks on toy trains would be not be likely to cause confusion among the relevant purchasers as to source or sponsorship or affiliation. Scientific has failed to meet its burden in both its opposition to Bachmann's motion for summary judgment and its own cross-motion for summary judgment.

For all these reasons, Bachmann respectfully requests that the Board enter summary judgment in Bachmann's favor and cancel Reg. No. 3,567,168, and terminate these proceedings *with prejudice*.

Date: January 13, 2012

Respectfully submitted,

By: 
Roberta Jacobs-Meadway
Jessica K. Bae
Eckert Seamans Cherin & Mellott, LLC
Two Liberty Place
50 South 16th Street, 22nd Floor
Philadelphia, PA 19102
Phone: 215-851-8522
Fax: 215-851-8383
rjacobsmeadway@eckertseamans.com

ATTORNEYS FOR PETITIONER

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the attached Memorandum in Support of Petitioner's Combined Reply in Support of its Motion for Summary Judgment and Opposition to Respondent's Cross-Motion for Summary Judgment was served on counsel for Scientific Toys, Ltd. on the date listed below via Fed Ex standard next day delivery:

Chester Rothstein, Esq.
Neil M. Zipkin, Esq.
Amster, Rothstein & Ebenstein LLP
90 Park Avenue
New York, New York 10016

Dated: January 13, 2012



John Metzger