

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

Baxley

Mailed: August 14, 2013

Cancellation No. 92053911

Ovation LLC

v.

Ovation, Inc.

Before Bucher, Mermelstein, and Gorowitz,
Administrative Trademark Judges.

By the Board:

Ovation, Inc. (“respondent”) is the record owner of three registrations which consist in whole or in part of the word OVATION. Respondent’s three involved registrations are the following:

Registration No. 3670163, issued August 18, 2009, based on an application that was filed on **December 12, 2007**, for the mark OVATION in standard character form, for “[b]usiness meeting planning, arranging and conducting business conferences and providing facilities for business meetings, providing on-line registrations services for business meetings and for live corporate business events” in International Class 35, “[w]ebcasting of live events and audio, data, graphics, video and multimedia data in connection therewith, video conferencing services, electronic transmission of music, audio, data, graphics and video, satellite broadcasting of live television special events” in International Class 38, “[a]rranging and conducting educational conferences, special event planning consultation services” in International Class 41, and “[d]esign, development and maintenance of websites and web-based applications for others, design and development of multimedia products for use in corporate events, meetings and conferences, lighting design, graphics design, industrial design, visual design services in the

nature of designing visual elements for online, broadcast, print, outdoor and other communication media, and set design services for corporate events” in International Class 42. In such registration, respondent alleges October 9, 2008, as the date of first use anywhere and date of first use in commerce.

Registration Nos. 3755678 and 3755679, both issued March 2, 2010, for the mark OVATION and design in the following form,  . Registration No. 3755678 is for “[w]ebcasting of live events and audio, data, graphics, video and multimedia data in connection therewith, video conferencing services, electronic transmission of music, audio, data, graphics and video, satellite broadcasting of live television special events” in International Class 38. Registration No. 3755679 is for “[d]esign, development and maintenance of websites and web-based applications for others, design and development of multimedia products for use in corporate events, meetings and conferences, lighting design, graphics design, industrial design, visual design services in the nature of designing visual elements for online, broadcast, print, outdoor and other communication media, and set design services for corporate events” in International Class 42. Both registrations matured from applications that were filed on October 9, 2008, based on an assertion of a *bona fide* intent to use the mark under Trademark Act Section 1(b).

On April 19, 2011, Ovation, LLC (“petitioner”), commenced the above-captioned proceeding by filing three separate petitions to cancel respondent’s registrations.¹ As a ground for cancellation, petitioner alleges likelihood of confusion with its previously-used word mark OVATION for “television broadcasting services, the development and production of television programs

¹ The petitions were filed as one; however, separate pleadings were filed. The Board prefers that each *inter partes* proceeding have only one operative set of pleadings, e.g., a complaint and an answer. *See generally* TBMP Sections 309 and 507.02 (3d ed. rev. 2 2013). *Compare* TBMP Section 511 (“Each proceeding retains its separate character and requires the filing of separate pleadings and entry of a separate judgment.”). Petitioner should have filed either (1) one petition to cancel in which it sought cancellation of all three registrations (the preferable solution), or (2) three separate petitions in separate proceeding files. If petitioner elected to file three separate petitions, it could have requested consolidation of those proceedings. *See* TBMP Section 511.

and motion picture films to be broadcast over a variety of platforms, television programming, a website, and other services” and the mark OVATION TV and design in the following form, , for “[c]able television broadcasting services” and “[d]evelopment and production of television programs to be broadcast over television, iptv, Internet, cable and satellite; production of motion picture films to be broadcast over television, cable and satellite; cable television programming.”²

Respondent, in its answers, denied the salient allegations of the petitions to cancel and set forth affirmative defenses.

This case now comes up for consideration of the following motions: (1) petitioner’s motion (filed December 10, 2012) for summary judgment; and (2) respondent’s motion (filed December 14, 2012) to extend time to respond to the motion for summary judgment.

Respondent’s motion to extend time to respond to the motion for summary judgment is granted as conceded. *See* Trademark Rule 2.127(a). The brief in response to the motion for summary judgment that respondent filed on January 30, 2013, is accepted as timely filed.

We now turn to the motion for summary judgment. Contrary to respondent’s assertion, petitioner is not seeking summary judgment on the

² Petitioner also pleads dilution in each of the petitions to cancel, but those claims are insufficiently pleaded. In particular, petitioner alleges prior use and fame of its OVATION marks, but does not expressly allege that those marks became famous prior to any date upon which respondent can rely in support of the involved registrations. *See Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540 (TTAB 2001).

ground that respondent's registrations are overly broad. Rather, petitioner is seeking entry of summary judgment on its pleaded Section 2(d) claim based on the broad recitation of services in respondent's involved registrations. It is not petitioner's contention that respondent's registrations are broader than they should be; rather, petitioner contends that the breadth of respondent's registrations brings them into conflict with petitioner's prior rights.

A motion for summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to any material facts, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating that there is no genuine dispute as to any material fact remaining for trial and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1987); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine disputes 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. *See Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F. 2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine dispute of material fact, and that the

moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial. The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine dispute of material fact for trial. In general, to establish the existence of disputed facts requiring trial, the nonmoving party “must point to an evidentiary conflict created on the record at least by a counterstatement of facts set forth in detail in an affidavit by a knowledgeable affiant.” *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990).

As a party moving for summary judgment in its favor on its Section 2(d) claim, petitioner must establish that there is no genuine dispute that (1) it has standing to maintain this proceeding; (2) that it has prior proprietary rights in its pleaded mark; and (3) that contemporaneous use of the parties’ respective marks on their respective goods and/or services would be likely to cause confusion, mistake or to deceive consumers. *See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001). If the nonmoving party then fails to raise a genuine dispute as to any material fact regarding any essential element of the movant’s case with respect to which it would have the burden of proof at trial, judgment as a matter of law may be

entered in favor of the moving party. *See* Fed. R. Civ. P. 56(c); *Celotex Corp. v. Catrett*, 477 U.S. at 322-23.

With regard to whether petitioner has standing to maintain this proceeding, we find that there is no genuine dispute that petitioner has standing based at least on (1) petitioner's evidence of common law use of the OVATION word mark in connection with a broadcast television network featuring fine arts (*see* declaration of petitioner's chief operating officer Chad Gutstein and exhibits D1-14) and (2) petitioner's submission of copies of USPTO Office Actions in which its pleaded application Serial Nos. 77894130, 77943004 and 77943009 were refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on respondent's involved registrations (*see* declaration of petitioner's attorney Wendy M. Mantell, exhibit C4-5). *See ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009). No genuine dispute as to any material fact exists on this issue.

We turn next to the issue of whether there is a genuine dispute of material fact regarding petitioner's asserted priority of use. To establish priority on a likelihood of confusion ground brought under Trademark Act Section 2(d), a party must prove that, vis-a-vis the other party, it owns either a registration or "a mark or trade name previously used in the United States ... and not abandoned..." Trademark Act Section 2, 15 U.S.C. § 1052. A plaintiff may establish its own prior proprietary rights in a mark through

actual use or through use analogous to trademark use, such as use in advertising brochures, trade publications, catalogues, newspaper advertisements and Internet websites which creates a public awareness of the designation as a trademark identifying the party as a source. *See* Trademark Act Sections 2(d) and 45, 15 U.S.C. §§ 1052(d) and 1127; *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), vacating *PacTel Teletrac v. T.A.B. Systems*, 32 USPQ2d 1668 (TTAB 1994).

Petitioner has established that there is no genuine dispute that it used the OVATION word mark in connection with its broadcast television network featuring fine arts and Internet website promoting that network and featuring streaming videos and other electronic transmissions of music, audio, data and graphics long prior to December 12, 2007, the earliest date upon which respondent can rely in support of any of its pleaded registrations.³ With regard to the parties' respective uses of their marks, petitioner has established, through the declaration of Mr. Gutstein and exhibits thereto; that it was founded in 1992; that it first rendered television broadcasting services featuring fine arts under the OVATION word mark since at least as early as October 1996 and was "re-launch[ed]" in 2006 after a change of ownership; that it has rendered webcasting services featuring

³ Respondent does not attempt to establish any use of its marks prior to December 12, 2007.

fine arts under the OVATION word mark since May 2000; and that it has been subject of a dedicated channel on YouTube.com since October 23, 2007.⁴

Although the record also shows petitioner using other marks, such as OVATION – THE ARTS NETWORK and OVATION TV, the record clearly indicates that petitioner and media outlets regularly use OVATION standing alone to refer to petitioner. Thus, contrary to respondent’s assertions, petitioner is not relying, and need not rely, upon tacking of its prior use of the marks OVATION THE ARTS NETWORK and OVATION TV to establish priority herein. The record clearly indicates prior use of the OVATION word mark in promotional materials for petitioner’s broadcast television network that precedes the filing dates of the intent-to-use applications for respondent’s registrations. Even if we assume that petitioner uses other marks, such as OVATION THE ARTS NETWORK and OVATION TV, more

⁴ Through Mr. Gutstein’s declaration, petitioner introduces excerpts from petitioner’s website ovationtv.com obtained from the Wayback Machine of Archive.org, which show prior use of the OVATION word mark.

For example, a February 13, 1997, excerpt includes the headline “What is OVATION?,” followed by text that commences with “OVATION is the only television network devoted exclusively to the arts...” (Exhibit D3).

A June 26, 1998, excerpt which states that “OVATION is developing an online feature on the 100 Best Museums in the World.” The bottom of the excerpt includes a directive to “Check here if you do NOT want to receive periodic email from OVATION regarding this website or network information.” (Exhibit D6).

A May 27, 2000, excerpt directs customers to “Click here to search for **Arthur C. Clarke: The Man Who Saw the Future** on Ovation’s schedules” (emphasis in original) and provides links to “OVATION Info,” “OVATION Shop”, and “Get OVATION NOW!” (Exhibit D4).

An August 15, 2002, excerpt directs customers to “Search for **Big Bangs** on Ovation’s TV schedule” (emphasis in original) (Exhibit D4).

A May 15, 2006, excerpt directs customers to “Click here to search for Wallace and Gromit Go To Hollywood! on OVATION’s schedule.” (Exhibit D4).

A December 10, 2006, excerpt directs customers to “Click here to search for Stuart Sutcliffe – The Lost Beatle on OVATION’s schedule.” (Exhibit D4).

prominently, such use of other marks does not create a genuine dispute as to petitioner's priority.

Turning to the likelihood of confusion issue, two key factors are the degree of similarity of the parties' marks and the degree of similarity of their respective goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). As to the word marks at issue, the parties' standard-character OVATION marks are identical, and petitioner's OVATION word mark is identical to the word component of the OVATION and design mark in respondent's involved Registration Nos. 3755678 and 3755679. Although petitioner uses a building block design in the mark in involved Registration Nos. 3755678 and 3755679, we find it does not significantly change the sight, sound, connotation or commercial impression of the mark as a whole, and that design element in the mark is insufficient to create a genuine dispute of material fact as to the similarities of the marks. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012), citing *CBS v. Morrow*, 708 F.2d. 1579; 218 USPQ 198 (Fed. Cir. 1983) ("the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed").

With regard to the similarity of the services at issue, respondent argues at length that the parties' core businesses are different in that petitioner is a television network, whereas it is involved in business conference and event planning consulting. However, the question of likelihood of confusion must be

determined based on an analysis of the services recited in respondent's registrations vis-à-vis the services shown to be in use by petitioner, rather than what respondent's goods are asserted or shown to be in current use. *See, e.g., Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). The services in International Class 38 recited in respondent's involved Registration Nos. 3670163 and 3755678, i.e., "[w]ebcasting of live events and audio, data, graphics, video and multimedia data in connection therewith, ... electronic transmission of music, audio, data, graphics and video, satellite broadcasting of live television special events" overlap petitioner's services. In particular, the evidence of record shows that petitioner's services include a television network which broadcasts profiles, interviews, documentaries, and prerecorded live performances in connection with classical music, jazz, blues, dance, painting, drama, literature, architecture and the like and a website through which petitioner streams video previews promoting those broadcasts. Respondent's services in International Class 38 are presumed to include webcasting and satellite broadcasting of all types of "live" television special events, including musical and dance performances, and are presumed to move in all normal channels of trade for services of these types, including DIRECTV and Dish Network, and would be purchased by the same class of customers. *See id.*

Based on the foregoing, we find that petitioner has met its burden by supporting its motion with the Gutstein and Mantell declarations and evidence introduced thereby which establishes its right to judgment on its pleaded Section 2(d) claim with regard to Registration No. 3670163 in International Class 38 only and Registration No. 3755678. Accordingly, the burden shifts to respondent to proffer countering evidence which establishes that there is a genuine factual dispute for trial. However, the evidence that respondent submitted in response to petitioner's motion is insufficient to show that there is a genuine dispute of material fact for trial.

Respondent argues that petitioner does not render many of the services recited in respondent's involved registrations. However, likelihood of confusion must be found with regard to an entire international class if there is likely to be confusion with respect to any item within the identification of goods in that class. *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Further, contrary to respondent's assertion, the fact that petitioner pleaded use of the OVATION word mark since 1995, but asserts use of the mark since 1992 in the motion for summary judgment, does not create an unpleaded issue upon which petitioner is seeking entry of summary judgment.⁵ That is, petitioner is seeking entry of summary judgment on its Section 2(d) claim based on use of the OVATION mark that precedes by more

⁵ Moreover, we note that the record herein indicates that petitioner did not actually render the broadcasting services in question until 1996.

than a decade any use upon which respondent can rely in support of its involved registrations. To prevail thereon, petitioner need only establish likelihood of confusion with its “mark or trade name previously used in the United States ... and not abandoned.” Use must be established by competent evidence. Cf. Trademark Rule 2.122(b)(2) (dates of use in an application or registration are not evidence of use). Because petitioner is relying upon common-law rights in the OVATION mark, a determination of when petitioner first used that mark is based on the evidence of record.

Respondent contends that petitioner is prohibited from complaining about respondent’s mark because petitioner’s rebranding efforts have brought petitioner’s pleaded marks closer to respondent’s involved marks. However, there is no genuine dispute that petitioner adopted the OVATION word mark more than a decade prior to any date upon which respondent can rely in support of any of its registrations.

Moreover, respondent argues that respondent’s chairman and CEO had never heard of petitioner prior to respondent’s adoption of the involved marks and that respondent conducted trademark searches prior to filing its applications for the involved marks. However, good faith adoption of a mark is not a defense to a claim of likelihood of confusion. *See Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1516 (TTAB 2009).

Respondent further contends that there has been no actual confusion between the parties’ marks. However, it is unnecessary to show actual

confusion to establish likelihood of confusion. *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); TMEP Section 1207.01(d)(ii) (April 2013).

Respondent contends in addition that petitioner's customers are sophisticated and educated, and that respondent's customers are "procurement officers," who are also sophisticated. However, even if we assume that the parties' customers are sophisticated, sophisticated purchasers are not immune from source confusion, especially in cases, such as the instant one involving highly similar marks and overlapping services. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000).

Respondent also argues that petitioner's pleaded marks are not famous. However, even if we assume that petitioner's pleaded marks are not famous, the Board has entered summary judgment for a plaintiff on a Section 2(d) claim where there is no genuine dispute as to the plaintiff's prior common law use of a highly similar mark on overlapping services. *See Fram Trak Industries Inc. v. WireTracks LLC*, 77 USPQ2d 2000 (TTAB 2006).

Respondent also contends that, notwithstanding petitioner's alleged prior use, petitioner did not seek to register its pleaded marks until it filed its pleaded applications in 2009. Although the USPTO encourages parties to register their marks, petitioner can rely on its common-law rights in support

of its Section 2(d) claim. *See* Trademark Act Section 2(d); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

In summary, considering the identical and extremely similar marks and the parties' legally overlapping services in International Class 38, we find that there is no genuine dispute that confusion is likely to result with regard to the OVATION word mark in Registration No. 3670163 in International Class 38 only and the OVATION and design mark in Registration No. 3755678. In view thereof, petitioner's motion for summary judgment is granted in part. The petition to cancel is granted with regard to petitioner's standing and priority and on petitioner's Section 2(d) claim with regard to Registration No. 3670163 in International Class 38 only and Registration No. 3755678. Registration No. 3670163 will be cancelled in International Class 38 only and Registration No. 3755678 will be cancelled in its entirety in due course.

With regard to Registration No. 3755679 and the remaining classes in Registration No. 3670163, we find that disposition of this proceeding by summary judgment is inappropriate.⁶ At a minimum, we find that there is a

⁶ Petitioner alleges prior use of its pleaded OVATION mark in connection with design, development and maintenance of websites and web-based applications services, design and development of multimedia products, lighting design, graphics design, industrial design, visual design services in the nature of designing visual elements for online, broadcast, print, and other communication media, and set design services. However, this prior use is not clearly pleaded in the petition to cancel and thus may not be relied upon in support of the motion for summary judgment. *See* TBMP Sections 314 and 528.07. In any event, a service must be (1) a real activity; (2) performed to the order of, or for the benefit of, someone other than petitioner; and (3) the activity performed must be qualitatively different from

genuine dispute as to whether the services at issue are related in a manner that would give rise to source confusion.⁷ Accordingly, the motion for summary judgment is otherwise denied.

This proceeding will go forward on the issue on likelihood of confusion factors other than similarity of the marks with regard to Registration No. 3670163 in International Classes 35, 41, and 42 and Registration No. 3755679.⁸ See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In view of the foregoing, we treat petitioner's standing and its priority as established.

Proceedings herein are resumed.⁹ Remaining dates are reset as follows.

Plaintiff's Pretrial Disclosures Due	09/3/2013
Plaintiff's 30-day Trial Period Ends	10/18/2013
Defendant's Pretrial Disclosures Due	11/2/2013
Defendant's 30-day Trial Period Ends	12/17/2013
Plaintiff's Rebuttal Disclosures Due	1/1/2014
Plaintiff's 15-day Rebuttal Period Ends	01/31/2014

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within

anything necessarily done in connection with the performance of petitioner's other services. See *In re Husqvarna AG*, 91 USPQ2d 1436 (TTAB 2009).

⁷ The parties should not presume that these are the only issues remaining for trial.

⁸ All evidence submitted in support of the motion for summary judgment is of record for purposes of that motion only. All trial evidence must be properly made of record during the appropriate testimony period. See TBMP Section 528.05(a).

⁹ The parties are reminded that our decision granting partial summary judgment is interlocutory in nature and may not be appealed until a final decision is rendered in the proceeding. See *Copeland's Enterprises Inc. v. CNV Inc.*, 887 F.2d 1065, 12 USPQ2d 1562 (Fed. Cir. 1989).

thirty days after completion of the taking of testimony. Trademark Rule 2.125.

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

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.