

ESTTA Tracking number: **ESTTA484717**

Filing date: **07/20/2012**

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

Proceeding	92054629
Party	Defendant Wohali Outdoors, LLC
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Date	07/20/2012
Attachments	07-20-12 - Wohali's MSJ - Final Submitted.pdf (11 pages)(37032 bytes) 001x.pdf (1 page)(504080 bytes) 002x.pdf (61 pages)(3052095 bytes) 013x.pdf (5 pages)(696838 bytes) 014x.pdf (34 pages)(3548365 bytes) 015x.pdf (14 pages)(1013477 bytes) 016x.pdf (8 pages)(969824 bytes) 017x.pdf (3 pages)(935459 bytes) 018x.pdf (4 pages)(947003 bytes) 019x.pdf (9 pages)(1928499 bytes) 020x.pdf (6 pages)(1093484 bytes) 021x.pdf (2 pages)(968109 bytes) 022x.pdf (17 pages)(1203793 bytes) 023x.pdf (2 pages)(467765 bytes) 024x.pdf (9 pages)(1059331 bytes)

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

In re Registration No. 3,904,929)	
)	
SHELTERED WINGS, INC.)	
)	
Petitioner,)	Cancellation No. 92054629
)	
v.)	
)	
WOHALI OUTDOORS, LLC)	
)	
Respondent.)	

RESPONDENT’S MOTION FOR SUMMARY JUDGMENT AND BRIEF IN SUPPORT

COMES NOW the Respondent, Wohali Outdoors, LLC (“Wohali” or “Respondent”), and pursuant to and in accordance with TTAB Rule 528 and Fed. R. Civ. P. 56, hereby moves the Court to grant summary judgment in Wohali’s favor, dismissing with prejudice all of Petitioner’s claims.

In support, Wohali submits the following.

I. STATEMENT OF FACTS FOR WHICH NO GENUINE ISSUE EXISTS (HEREIN REFERRED TO AS “SOF”)

1. Wohali is a limited liability company organized under the laws of the State of Oklahoma, with its principal place of business in Claremore, Oklahoma. (Ex. 21, Declaration of Griffin at para. 2.)

2. On March 12, 2009, Wohali filed its application for the mark “STEEL EAGLE” in International Class 9, for magnifying optical equipment, namely, rifle scopes and binoculars. (Ex. 1, Certificate of Registration for STEEL EAGLE, Registration No. 3,904,929.)

3. Wohali’s first use and first use in commerce of the mark “STEEL EAGLE” was

October 21, 2009. (Ex. 21, Declaration of Griffin at para. 3; See also Ex. 1.)

4. On June 5, 2009, the USPTO Examining Attorney, Ronald McMorrow, concluded that after a search, there were no marks that conflicted with or would preclude the registration of Wohali's STEEL EAGLE mark. Mr. McMorrow stated:

“Search Results

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d).” (underlining added)

(Ex. 14, Office Action dated June 5, 2009, at p. 2.)

5. On January 11, 2011, the mark “STEEL EAGLE” was registered and assigned Registration No. 3,904,929. (Ex. 1.)

6. When Wohali filed its application for STEEL EAGLE and at the time its mark was registered, Wohali was not aware of any of Petitioner's marks (i.e. the 5 marks identified on page 2 of the Petition for Cancellation). (Ex. 21, Declaration of Griffin at para. 4.)

7. On or around April 12, 2011, the USPTO refused Petitioner's application to register the mark “EAGLE” because the mark, when used in connection with the identified goods, so resembled Wohali's STEEL EAGLE mark as to be likely to cause confusion, or to cause mistake, or to deceive. (Ex. 2, Trademark Application File, at p. 3.)

8. Petitioner alleged it was unaware of Wohali's STEEL EAGLE mark until its application to register EAGLE was denied. (Ex. 18, Doc. 11, Order at p. 1, last sentence.)¹

9. There is no evidence of actual confusion concerning the source of Wohali's STEEL EAGLE mark. (Ex. 21, Declaration of Griffin at para. 5.)

¹ All references to “Doc.” mean the Document # assigned by the U.S. District Court for the Western District of Wisconsin, in Civil Case No. 11-CV-300.

10. On April 25, 2011, Petitioner filed a Complaint in the U.S. District Court for the Western District of Wisconsin seeking (among other things) damages, injunctive relief and the cancellation of Wohali's STEEL EAGLE mark. (Ex. 15, Doc. 1, Complaint at p. 12-14.)

11. On May 23, 2011, Wohali filed its Answer and Affirmative Defenses, and within same informed the Court that Petitioner's application to register the mark EAGLE was refused because Petitioner's applied for mark when used in connection with the identified goods resembled Wohali's STEEL EAGLE mark as to be likely to cause confusion, or to cause mistake, or to deceive. (Ex. 16, Doc. 4, Answer and Affirmative Defenses of Wohali Outdoors, LLC at p. 7-8, para. 12.)

12. On June 6, 2011 (14 days after Wohali asserted this defense), Petitioner filed a motion to dismiss its case without prejudice. (Ex. 17, Doc. 5, Plaintiff's Motion for Voluntary Dismissal Without Prejudice.)

13. Petitioner admitted there are many registered EAGLE marks on optical goods, and that the mark EAGLE in respect to optical goods, is weak.

“. . . Clearly, the old saw about 'eagle eyes' has informed the use of 'Eagle' in each of these marks. The eagle is regarded as exemplifying excellent distance vision. This lends itself to use of the term 'eagle' in many different marks pertaining to optical products. As such, the term 'Eagle' is a relatively weak mark for optical products." (underlining added)

(Ex. 13, Petitioner's Response to Official Action dated August 26, 2002, at p. 2, last paragraph.)

"Finally, the extent of confusion is de minimus. The existence of many registered EAGLE marks on various types of optical goods leads to a determination that the mark EAGLE is weak in respect to the goods and the extent of potential confusion is de minimus rather than substantial." (underlining added)

(Ex. 13 at p. 4.)

14. The only similarity between Wohali's mark (STEEL EAGLE) and any of

Petitioner's marks (GOLDEN EAGLE, STRIKE EAGLE or any of the EAGLE OPTICS marks set forth on page 2 of Petitioner's Petition for Cancellation filed October 10, 2011) is that each includes the term "EAGLE". (Ex. 21, Declaration of Griffin at para. 6.)

15. The purchase of optics is a careful, thought out process. Rifle scopes and binoculars are expensive items, generally costing at least one hundred dollars, and often times are much more expensive. It is not an impulse purchase. (Ex. 21, Declaration of Griffin at para. 7; See also Ex. 13 at p. 4, 3rd para. from bottom of page.)

16. On November 4, 2002 (approximately 10 years ago), after having its application to register EAGLE OPTICS denied, Petitioner requested this Court to cancel Nikon, Inc.'s mark, EAGLEVIEW.

"Petitioner has applied to register EAGLE OPTICS, U.S. Trademark application no. 78/029,311 filed October 5, 2000 for binoculars, telescopes and spotting scopes. Petitioner's application for registration has been refused registration under Section 2(d) of the Trademark Act based on the Examiner's conclusion that the Petitioner's mark EAGLE OPTICS is likely to be confused with Registrant's mark EAGLEVIEW." (underlining added)

(Ex. 19, Petition for Cancellation at p. 2, para. 5.)

17. Thereafter, Petitioner entered into a Consent Agreement with Nikon, Inc. (owner of the EAGLEVIEW mark), and "requested that the refusal of registration be withdrawn and that the present application [application for EAGLE OPTICS] be approved for publication." (Ex. 20, Petitioner's Response to Official Action dated January 15, 2004, specifically at p. 2.)

II. STANDARD FOR GRANTING SUMMARY JUDGMENT

The requirements for granting summary judgment in a trademark cancellation proceeding are the same as in any other case. *Loglan Institute, Inc. v. Logical Language Group, Inc.*, 22 U.S.P.Q.2d 1531; 962 F.2d 1038, 1040 (Fed. Cir. 1992). Summary judgment is proper where the

undisputed material facts establish that a party is entitled to judgment as a matter of law. Fed.R.Civ.P. 56(c); *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). A material fact is one which may affect the outcome of the suit under the governing law. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-48 (1986). To dispute a material fact, the non-moving party must offer more than a “mere scintilla” of evidence; the evidence must be such that “a reasonable jury could return a verdict” for it. *Id.* “[T]he requirement that a dispute be ‘genuine’ means simply that there must be more than ‘some metaphysical doubt as to the material facts.’” *Scott v. Harris*, 550 U.S. 372, 380 (2007) (quoting *Matsushita Electric Industrial Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586 (1986)). If a party's version of the facts is “blatantly contradicted by the record, so that no reasonable jury could believe it, a court should not adopt that version of the facts for purposes of ruling on a motion for summary judgment.” *Scott*, 550 U.S. at 380.

III. THERE IS NO EVIDENCE SUPPORTING PETITIONER'S CLAIM

The registration of Wohali's STEEL EAGLE mark is prima facie evidence that Wohali has the exclusive right to use the mark in commerce and in connection with the goods specified in its registration. 15 U.S.C. § 1115. By registering Wohali's STEEL EAGLE mark, the USPTO previously determined there was no likelihood of confusion between Wohali's STEEL EAGLE mark and all other marks (including Petitioner's marks). (SOF Nos. 2-5.) Petitioner has failed to submit any evidence supporting its claim and therefore, Petitioner's claim should be dismissed with prejudice.

Wohali is not required to produce evidence negating the existence of a material fact on which Petitioner has the burden of proof, but may submit a bare motion for summary judgment pointing out the absence of evidence supporting Petitioner's claim. *Saunders v. Michelin Tire*

Corporation, 942 F.2d 299 (5th Cir. 1991), citing *Latimer v. Smithkline & French Laboratories*, 919 F.2d 301 (5th Cir. 1990) as well as *Celotex Corporation v. Catrett*, 477 U.S. 317 (1986).

IV. THERE IS NO LIKELIHOOD OF CONFUSION CONCERNING WOHALI'S STEEL EAGLE MARK

Petitioner's own admissions prove its claim has no merit and must be dismissed.

A. Petitioner Cannot Monopolize All Marks That Contain The Term "Eagle"

Petitioner seeks to create a monopoly on any mark containing the word "EAGLE". Similar attempts have been rejected by the Courts. See *Freedom Card, Inc. v. JP Morgan Chase Co.*, 432 F.3d 463, 475-476 (3rd Cir. 2005) (The mark "CHASE FREEDOM" on a credit card did not preclude Chase's mark, "FREEDOM CARD".)² See also *Continental Distilling Corp. v. Norman Williams*, 170 U.S.P.Q. 132; 443 F.2d 392, 1302-1303 (Ct. Custom Appeals 1971) (The mark Dixie Belle for distilled spirits did not preclude applicant's marks for Cumberland Belle, River Belle, Heather Belle and/or Canadian Belle, which were also for distilled spirits.)³

Approximately ten years ago, Petitioner applied for the mark EAGLE OPTICS. When the USPTO refused registration based on Nikon's EAGLEVIEW mark, Petitioner filed a cancellation proceeding seeking to cancel Nikon's mark. Petitioner conceded the term "EAGLE" was a very common term used in connection with optics. (SOF No. 13.) Admitting Petitioner cannot monopolize all marks containing the term "EAGLE", Petitioner entered into a Consent Agreement with Nikon. (SOF Nos. 16-17.)

² Exhibit 22 is a copy of *Freedom Card, Inc. v. JP Morgan Chase Co.*, 432 F.3d 463 (3rd Cir. 2005).

³ Exhibit 23 is a copy of *Continental Distilling Corp. v. Norman Williams*, 170 U.S.P.Q. 132; 443 F.2d 392 (Ct. Custom Appeals 1971).

Now ten years later, after having its application for EAGLE rejected based on Wohali's mark, Petitioner has again attempted to cause the mark identified by the USPTO examiner to be cancelled.

Concerning its attacks on Wohali's mark, Petitioner first filed suit in Federal District Court in Wisconsin seeking relief, including but not limited to, damages, injunctive relief and the cancellation of Wohali's mark. Almost immediately after Wohali filed its Answer to the Complaint, informing the Court that the USPTO had previously denied Petitioner's EAGLE mark because it so resembled Wohali's mark as to likely cause confusion, Petitioner moved to dismiss its own Federal action. (SOF Nos. 10-12.)

B. Petitioner's Admissions Prove Its Claim Must Be Dismissed. Petitioner Has Admitted The Term "EAGLE" Is Used In Many Marks Pertaining To Optics And That The Term "EAGLE" Is Weak In Respect To Optics

In *Application of E.I. DuPont DeNemours & Co.*, 177 U.S.P.Q. 563; 476 F.2d 1357, 1361 (Ct. Custom Appeals 1973), the Court set forth the test/factors when determining likelihood of confusion under 15 U.S.C. § 1052(d).⁴ Not all factors are applicable to all cases and the facts of each case determine which factors are most important. *DuPont*, 476 F.2d at 1361-1362.

⁴ "(1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use. (3) The similarity or dissimilarity of established, likely-to-continue trade channels. (4) The conditions under which and buyers to whom sales are made, i. e. "impulse" vs. careful, sophisticated purchasing. (5) The fame of the prior mark (sales, advertising, length of use). (6) The number and nature of similar marks in use on similar goods. (7) The nature and extent of any actual confusion. (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion. (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark). (10) The market interface between applicant and the owner of a prior mark: (a) a mere "consent" to register or use. (b) agreement provisions designed to preclude confusion, i. e. limitations on continued use of the marks by each party. (c) assignment of mark, application, registration and good will of the related business. (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion. (11) The extent to which applicant has a right to exclude others from use of its

Based on (i) Petitioner's admissions made before the USPTO, which are binding on Petitioner⁵ and (ii) the registration of Wohali's STEEL EAGLE mark, there is no likelihood of confusion. Applying the relevant *DuPont* factors to the facts of this case:

(a) Factors 1, 2, 6 and 10-12 (see footnote 2 at pages 7-8 herein for descriptions):

After the USPTO examiner refused to register Petitioner's mark EAGLE OPTICS because of Nikon's EAGLEVIEW mark, Petitioner advised the USPTO that the term EAGLE is weak as it is used in many different marks pertaining to optical products and that the potential for confusion is *de minimus* rather than substantial. Petitioner stated:

“. . . Clearly, the old saw about 'eagle eyes' has informed the use of 'Eagle' in each of these marks. The eagle is regarded as exemplifying excellent distance vision. This lends itself to use of the term 'eagle' in many different marks pertaining to optical products. As such, the term 'Eagle' is a relatively weak mark for optical products." (underlining added)

(SOF No. 13.)

"Finally, the extent of confusion is *de minimus*. The existence of many registered EAGLE marks on various types of optical goods leads to a determination that the mark EAGLE is weak in respect to the goods and the extent of potential confusion is *de minimus* rather than substantial." (underlining added)

(SOF No. 13.)

Petitioner then entered into a Consent Agreement with Nikon, Inc. (SOF No. 16-17.)

mark on its goods. (12) The extent of potential confusion, i. e., whether *de minimis* or substantial. (13) Any other established fact probative of the effect of use."

DuPont, 476 F.2d at 1361. Exhibit 24 is a copy of the case.

⁵ "Factual assertions in pleadings are judicial admissions conclusively binding on the party that made them." *Davis v. A.G. Edwards & Sons, Inc.*, 823 F.2d 105 (5th Cir.1987) (quoting *White v. Arco/Polymers, Inc.*, 720 F.2d 1391 (5th Cir.1983)). *Morales v. Department of Army* 947 F.2d 766, 769 (C.A.5 (Tex.),1991).

Thus, Petitioner admitted (1) there are many marks concerning optics that contain the term “EAGLE”; (2) the term EAGLE with respect to optics is a weak mark; and (3) the potential for confusion is *de minimus* as the only similarity between Wohali’s mark (STEEL EAGLE) and Petitioner’s marks (GOLDEN EAGLE, STRIKE EAGLE AND EAGLE OPTICS), is the use of the term “EAGLE”.

This precise scenario was addressed in *Freedom Card, Inc. v. JP Morgan Chase Co.*, 432 F.3d 463 (3rd Cir. 2005). In *Freedom*, the Petitioner (UTN) challenged Chase’s CHASE FREEDOM CARD mark based on UTN’s mark, FREEDOM CARD.

Like here, UTN’s application for its FREEDOM CARD mark was rejected based on the existing mark, FUEL FREEDOM CARD. Like here (so the USPTO would register its FREEDOM CARD mark), UTN represented that the term “freedom” was in wide-spread commercial use, and that no one had the exclusive right to use the term FREEDOM alone. Then, UTN entered into a Consent Agreement with Parker Oil (owner of the FUEL FREEDOM CARD mark), and agreed there was no likelihood of confusion between the marks. *Freedom*, 432 F.3d at 475-476.

When UTN later challenged Chase’s CHASE FREEDOM CARD mark, the Third Circuit held that UTN’s admissions showed there was no likelihood of confusion. (Here Petitioner’s admissions must be similarly interpreted):

“The district court viewed UTN's representations to the USPTO through the lens of judicial estoppel.^{FN20} [Chase, 333 F.Supp.2d at 246](#). Whether we view the district court's treatment of UTN's prior representations about the commercial availability of marks containing the word “freedom” as judicial estoppel, an admission, waiver, or simply hoisting UTN by its own petard, we agree with the district court's conclusion about the commercial impact of “freedom” in the two marks at issue here. Thus, UTN's own statements and actions, together with Chase's undisputed evidence of the widespread and common use of “freedom,” undermine

UTN's belated attempt to establish likelihood of confusion from the juxtaposition of "FREEDOM" and Chase's housemark. See *SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 1043 (Fed.Cir.1983)." (underlining added)

Freedom, 432 F.3d at 476.

(b) Factor 7 (nature and extent of actual confusion):

There is no evidence of actual confusion as to the source of Wohali's STEEL EAGLE mark. (SOF No. 9.)

(c) Factor 4 (impulse v. careful, sophisticated purchasing):

The purchase of optics is a careful, thought out process due to the expense to obtain the goods. It is the opposite of an impulse purchase. (SOF No. 15.)

(d) Factor 5 (fame of prior mark):

Petitioner's marks have no fame. Each of Petitioner's marks contain the term "EAGLE", a term used in many marks for optics. (SOF No. 13.) Petitioner's willingness to enter into a Consent Agreement with Nikon, Inc. is further evidence of this. (SOF No. 16-17.) Wohali was not aware of any of Petitioner's marks at the time it applied for and/or received the registration for its STEEL EAGLE mark. (SOF No. 6.) There is no evidence of any actual confusion concerning the source of Wohali's mark. (SOF No. 9.)

V. CONCLUSION/PRAYER

There is no genuine issue concerning any of the facts set forth herein. As the USPTO previously concluded, there is no likelihood of confusion between Wohali's STEEL EAGLE mark and any other marks. The only reason these parties are before this Court, is because the examiner identified Wohali's mark as the basis for denying Petitioner's application.

Wohali prays the Court (1) grant summary judgment in favor of Wohali and against Petitioner; (2) dismiss Petitioner's claim with prejudice; (3) award attorneys' fees and costs in

favor of Wohali and against Petitioner; and (4) award any other relief Wohali proves it is entitled to or for which the Court deems just and equitable.

Respectfully Submitted,

DOYLE HARRIS DAVIS & HAUGHEY

/S. Max Harris/

Steven M. Harris, OBA #3913

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Attorneys for Respondent, Wohali Outdoors, LLC

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of Respondent's Motion for Summary Judgment and Brief in Support was sent by U.S. First Class Mail, postage prepaid, this 20th day of July, 2012, to:

James D. Peterson
Jennifer L. Gregor
GODFREY & KAHN, S.C.
One East Main Street, Suite 500
Madison, Wisconsin 53701-2719

I further certify that a copy of same was also sent via electronic mail, this 20th day of July, 2012, to:

James D. Peterson jpeterson@gklaw.com
Jennifer L. Gregor jgregor@gklaw.com

/s/ S. Max Harris/

S. Max Harris

United States of America

United States Patent and Trademark Office

STEEL EAGLE

Reg. No. 3,904,929

WOHALL OUTDOORS, LLC (OKLAHOMA LIMITED LIABILITY COMPANY)
1300 N. INDUSTRIAL BLVD.
CLAREMORE, OK 74017

Int. Cl.: 9

FOR: MAGNIFYING OPTICAL EQUIPMENT, NAMELY, RIFLE SCOPES AND BINOCULARS,
IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

TRADEMARK

FIRST USE 10-21-2009; IN COMMERCE 10-21-2009.

PRINCIPAL REGISTER

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PAR-
TICULAR FONT, STYLE, SIZE, OR COLOR.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "STEEL", APART FROM THE
MARK AS SHOWN.

SN 77-689,308, FILED 3-12-2009.

RONALD MCMORROW, EXAMINING ATTORNEY



David S. K. [Signature]

Director of the United States Patent and Trademark Office

To: Sheltered Wings, Inc. (trademark@langlotz.com)

Subject: U.S. TRADEMARK APPLICATION NO. 85095903 - EAGLE - VX-T67

Sent: 4/12/2011 10:22:24 AM

Sent As: ECOM108@USPTO.GOV

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85095903

MARK: EAGLE

85095903

CORRESPONDENT ADDRESS:

ANGELA V. LANGLOTZ
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WORKS, INC.
PO BOX 9650337585
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CLICK HERE TO RESPOND TO THIS LETTER:

http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Sheltered Wings, Inc.

**CORRESPONDENT'S REFERENCE/DOCKET
NO:**

VX-T67

CORRESPONDENT E-MAIL ADDRESS:

trademark@langlotz.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 4/12/2011

Action on this application had been suspended pending the disposition of Application Serial No. 77-689308. That application has matured into a registration. Accordingly, the examining attorney determines as follows.

Mark is Likely to Cause Confusion

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration No. 3904929 as to be likely to cause confusion, or to cause mistake, or to deceive. TMEP section 1207. See the enclosed registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. See 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). See TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); see *In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

Analysis of Applicant's Mark and Registered Mark

First, a comparison of the respective marks show that they are comprised either in whole or significant part of the term "EAGLE." The mere deletion of wording from a registered mark is not sufficient to overcome a likelihood of confusion under Section 2(d). See *In re Optical Int'l*, 196 USPQ 775 (TTAB 1977) (where applicant filed to register the mark OPTIQUE for optical wear, deletion of the term BOUTIQUE is insufficient to distinguish the mark, *per se*, from the registered mark OPTIQUE BOUTIQUE when used in connection with competing optical wear). Accordingly, the applicant's mark, "EAGLE," is similar in sound, appearance, connotation and commercial impression to Registration No. 3904929's mark "STEEL EAGLE." Similarity in any one of these elements alone is sufficient to find a likelihood of confusion. *In re Mack*, 197 USPQ 755 (TTAB 1977).

It is well settled that in some circumstances, it is appropriate to recognize that one component of a particular mark may, for some reason, have more significance than other components in determining the commercial impression which is generated by the mark. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Although the determination of whether or not confusion is likely must be based on a comparison of the marks in their entireties, the dominance of such a significant element must be taken into account in resolving this issue. *Ceccato v. Manifattura Lane Gaetano Morzotto Figli S.p.A.*, 32 USPQ 1192 (TTAB 1994). Disclaimed matter is typically less significant or less dominant.

The registrant's mark is "STEEL EAGLE." In the comparison above, the mark was viewed and considered as a whole. "STEEL," however, is descriptive of the feature of the goods and is of less trademark significance than "EAGLE."

Analysis of Goods and Services

Second, the relationship of the goods is evident because both marks are for goods including rifle scopes and binoculars. The overlapping identifications evidence the relationship.

As to the registrant's other goods, it should be noted that third party registrations that do not cover a wide variety of goods might have some probative value in establishing a relationship between the goods. *In re Parfums Schiaparelli Inc.*, 37 USPQ2d 1864 (TTAB 1995). A search of Office records reveals a number of registrations for spotting scopes or binoculars and telescopes as goods being utilized under the same mark (See attached for random examples).

The examining attorney must also consider any goods or services in the registrant's normal fields of expansion to determine whether the registrant's goods or services are related to the applicant's identified goods or services under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977). Accordingly, the mark is likely to cause consumer confusion as to source.

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. §2.23(a)(1). For a complete list of these documents, see TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of \$50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

If the applicant has any questions or needs assistance in responding to this office action, please telephone the assigned examining attorney.

/Jason F. Turner/
Examining Attorney
Law Office 108
(571) 272-9353
(571) 273-9108 (Fax for Official Responses)
jason.turner@uspto.gov (Inqui

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

DESIGN MARK

Serial Number

77689308

Status

REGISTERED

Word Mark

STEEL EAGLE

Standard Character Mark

Yes

Registration Number

3904929

Date Registered

2011/01/11

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Wohali Outdoors, LLC LIMITED LIABILITY COMPANY OKLAHOMA 1300 N.
Industrial Blvd. Claremore OKLAHOMA 74017

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Magnifying optical equipment, namely, rifle scopes and binoculars.
First Use: 2009/10/21. First Use In Commerce: 2009/10/21.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "STEEL" APART FROM THE
MARK AS SHOWN.

Filing Date

2009/03/12

Examining Attorney

MCMORROW, RONALD

Attorney of Record

Frank J. Catalano

STEEL EAGLE

DESIGN MARK

Serial Number

78515580

Status

REGISTERED

Word Mark

XTR

Standard Character Mark

Yes

Registration Number

3127957

Date Registered

2006/08/08

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

BUSHNELL INC. CORPORATION DELAWARE 9200 CODY OVERLAND PARK KANSAS
66214

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Lens coatings sold as a component of sports optics products, namely,
binoculars, riflescopes, spotting scopes, rangefinders, bore-sighters,
telescopes, and telescopic gun sights for pistols, rifles and
shotguns. First Use: 2005/01/00. First Use In Commerce: 2005/02/00.

Filing Date

2004/11/11

Examining Attorney

PAPPAS, MATTHEW

Attorney of Record

Michael Elbein

XTR

DESIGN MARK

Serial Number

78552204

Status

REGISTERED

Word Mark

PAUL BUNYAN

Standard Character Mark

Yes

Registration Number

3089724

Date Registered

2006/05/09

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

PRESS HOLDING'S INTERNATIONAL, INC. CORPORATION 116 West 23rd Street, Suite 500 c/o Sherman & Blank Inc. New York NEW YORK 10011

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S: binoculars; carpenter's levels; children's educational software; children's video tapes; directional compasses; computer game software; decorative magnets; electric switch plates; gloves for protection against accidents; goggles for sports; photographic slide transparencies; sound recordings featuring adventure, environmental sciences, and folklore; spectacle cases; sports eyewear; sunglasses; survival suits; telescopes; video recordings featuring adventure, environmental sciences, and folklore; walkie-talkies. First Use: 1975/02/12. First Use In Commerce: 1975/02/12.

Prior Registration(s)

2025161;2049274;2071723;AND OTHERS

Name/Portrait Statement

The name(s), portrait(s), and/or signature(s) shown in the mark does not identify a particular living individual.

Print: Apr 12, 2011

78552204

Filing Date

2005/01/22

Examining Attorney

HOLTZ, ALLISON

Paul Bunyan

DESIGN MARK

Serial Number

78552207

Status

REGISTERED

Word Mark

DANIEL BOONE

Standard Character Mark

Yes

Registration Number

3050501

Date Registered

2006/01/24

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

PRESS HOLDING'S INTERNATIONAL, INC. CORPORATION 116 West 23, Suite 500
c/o Sherman & Blank Inc. Millwood NEW YORK 10011

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Binoculars; carpenter's levels; children's educational software;
children's video tapes; compasses; computer game software; decorative
magnets; electric switch plates; gaming machines; gloves for
protection against accidents; goggles for use in fishing, hunting, and
snow sports; photographic slide transparencies; sound recordings
featuring adventure, exploration, and history; spectacle cases; sports
eyewear; sunglasses; survival suits; telescopes; video game
cartridges; video recordings featuring adventure, exploration, and
history; walkie-talkies. First Use: 1975/11/18. First Use In
Commerce: 1975/11/18.

Prior Registration(s)

1856781;1996967;2108572;AND OTHERS

Name/Portrait Statement

The name(s), portrait(s), and/or signature(s) shown in the mark does

Print: Apr 12, 2011

78552207

not identify a particular living individual.

Filing Date

2005/01/22

Examining Attorney

HARDY, TARA H

Daniel Boone

DESIGN MARK

Serial Number

78552262

Status

REGISTERED

Word Mark

PECOS BILL

Standard Character Mark

Yes

Registration Number

3116381

Date Registered

2006/07/18

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

PRESS HOLDING'S INTERNATIONAL, INC. CORPORATION PANAMA 116 West 23rd Street, Suite 500 c/o Sherman & Blank Inc. New York NEW YORK 10011

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S: binoculars; children's educational software; children's video tapes; decorative magnets; electric switch plates; goggles for sports; photographic slide transparencies; sound recordings featuring adventure and folklore; spectacle cases; sports eyewear; sunglasses; telescopes; video recordings featuring adventure and folklore; walkie-talkies. First Use: 1978/01/10. First Use In Commerce: 1978/01/10.

Prior Registration(s)

1872555;1886929;1896123;AND OTHERS

Name/Portrait Statement

The name(s), portrait(s), and/or signature(s) shown in the mark does not identify a particular living individual.

Filing Date

Print: Apr 12, 2011

78552262

2005/01/23

Examining Attorney
SINGH, TEJBIR

Pecos Bill

DESIGN MARK

Serial Number

78552588

Status

REGISTERED

Word Mark

MUELLER

Standard Character Mark

No

Registration Number

3063003

Date Registered

2006/02/28

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

Mueller Optics LLC LIMITED LIABILITY COMPANY MICHIGAN 6544 Finnegan Rd. Johannesburg MICHIGAN 49751

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S: Optical lens sights for firearms, binoculars, spotting scopes. First Use: 2003/08/01. First Use In Commerce: 2003/08/01.

Filing Date

2005/01/24

Examining Attorney

LORENZO, GEORGE

Attorney of Record

Christopher J. Day



DESIGN MARK

Serial Number

78556531

Status

REGISTERED

Word Mark

LEGENDS OF THE WEST

Standard Character Mark

Yes

Registration Number

3054547

Date Registered

2006/01/31

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Geronimo Productions, Inc. CORPORATION DELAWARE 116 West 23rd Street,
Suite 500 c/o Sherman & Blank Inc. New York NEW YORK 10011

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Binoculars; children's educational software; children's video tapes;
computer game software; decorative magnets; electric switch plates;
downloadable electronic publications, namely, books featuring
adventure, folklore, and history; electronic publications, namely,
books featuring adventure, folklore, and history recorded on computer
media; gaming machines; goggles for sports; photographic slide
transparencies; sound recordings featuring adventure, folklore, and
history; spectacle cases; sports eyewear; sunglasses; telescopes;
video game cartridges; video recordings featuring adventure, folklore,
and history; walkie-talkies. First Use: 1979/06/02. First Use In
Commerce: 1979/06/02.

Prior Registration(s)

1923801;1945695;2036906;AND OTHERS

Filing Date

Print: Apr 12, 2011

78556531

2005/01/31

Examining Attorney
MCCAULEY, BRENDAN

Legends of the West

Print: Apr 12, 2011

78593915

DESIGN MARK

Serial Number

78593915

Status

REGISTERED

Word Mark

MULTIZERO

Standard Character Mark

Yes

Registration Number

3129032

Date Registered

2006/08/15

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Kahles, GmbH CORPORATION AUSTRIA Zeillergasse 20-22 Vienna AUSTRIA
1170

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Optical apparatus and instruments, namely, telescopes, telescopic
sights, binoculars, and telescopic sights for firearms. First Use:
2005/03/11. First Use In Commerce: 2005/03/11.

Foreign Country Name

AUSTRIA

Foreign Priority

FOREIGN PRIORITY CLAIMED

Foreign Application Number

AM65672004

Foreign Filing Date

2004/09/24

-1-

Print: Apr 12, 2011

78593915

Foreign Registration Number

222273

Foreign Registration Date

2004/12/30

Foreign Expiration Date

2014/12/30

Filing Date

2005/03/24

Examining Attorney

MCDOWELL, MATTHEW

Attorney of Record

Anton P. Ness

MULTIZERO

DESIGN MARK

Serial Number

78596617

Status

REGISTERED

Word Mark

INDEX MATCHED LENS SYSTEM

Standard Character Mark

Yes

Registration Number

3125115

Date Registered

2006/08/01

Type of Mark

TRADEMARK

Register

SUPPLEMENTAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Leupold & Stevens, Inc. CORPORATION OREGON PO Box 688 Beaverton OREGON 970750688

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S: Optical lens sights for firearms; telescopic sights; rifle scopes; telescopes; handgun scopes; optical lens scopes; spotting scopes; binoculars. First Use: 2006/01/03. First Use In Commerce: 2006/01/03.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "SYSTEM" APART FROM THE MARK AS SHOWN.

Filing Date

2005/03/28

Amended Register Date

2006/05/12

Examining Attorney

Print: Apr 12, 2011

78596617

SWAIN, MICHELE

Attorney of Record

Jere M. Webb

INDEX MATCHED LENS SYSTEM

DESIGN MARK

Serial Number

78603419

Status

REGISTERED

Word Mark

NEPTUNE

Standard Character Mark

No

Registration Number

3144658

Date Registered

2006/09/19

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

CANDO ENTERPRISES, INC. CORPORATION CALIFORNIA 14642 Central Avenue
Chino CALIFORNIA 91710

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
telescopes and binoculars. First Use: 2003/12/17. First Use In
Commerce: 2003/12/17.

Description of Mark

The mark consists, in part, of a design of three curved or arched
overlapping bands with a four-pointed star in the center. The mark
also consists of the term NEPTUNE in stylized form below the curved
band and star design. The middle dash of each letter E in the term
NEPTUNE is formed by a four-pointed star.

Filing Date

2005/04/27

Examining Attorney

DELANEY, ZHALEH

Print: Apr 12, 2011

78603419

Attorney of Record
Alfred H. Chan



DESIGN MARK

Serial Number

78616900

Status

REGISTERED

Word Mark

CANASCOPE

Standard Character Mark

Yes

Registration Number

3220669

Date Registered

2007/03/20

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Events Marketing LLC LIMITED LIABILITY CORPORATION NEVADA Suite 239
3315 Russell Road Las Vegas NEVADA 89120

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Telescopes and binoculars. First Use: 1999/08/00. First Use In
Commerce: 2000/08/00.

Filing Date

2005/04/26

Examining Attorney

CARRUTHERS, ALICE SUE

Canascope

DESIGN MARK

Serial Number

78651640

Status

REGISTERED

Word Mark

WOLLENSAK

Standard Character Mark

Yes

Registration Number

3123173

Date Registered

2006/08/01

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

VIRGINVILLE LENS COMPANY CORPORATION PENNSYLVANIA 1050 Maidencreek Road Fleetwood PENNSYLVANIA 19522

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S: Filters for optical devices; Optical glasses; Optical inspection apparatus for industrial use; Optical lens sights; Optical lenses; Optical or telescopic lens sights; Optical readers; Optical reflectors; Optical shutters; Scientific and technical apparatus, namely, optical mirrors; Prisms for scientific purposes; Prisms for telescopes; Reflectors for telescopes, Telescopes, Body-tubes for telescopes namely lens-barrels; Eyeglass lenses, Magnifying lenses, Ophthalmic lenses; Binoculars; Hunting binoculars; Laboratory equipment namely, spectrosopes; Adapter rings for attaching objectives on cameras; Camera cases; Camera filters; Cameras; Cameras shutters; Motion picture cameras; Photographic cameras; Range finders for cameras; Shutters for cameras; Viewfinders for cameras; Microscopes and parts thereof; Microscope condensers; Prisms for microscopes; Reflectors for microscopes; Microscopes. First Use: 1900/00/00. First Use In Commerce: 1900/00/00.

Print: Apr 12, 2011

78651640

Section 2f Statement
2(F) ENTIRE MARK

Filing Date
2005/06/15

Examining Attorney
DAHLING, KRISTIN

WOLLENSAK

DESIGN MARK

Serial Number

78661493

Status

REGISTERED

Word Mark

STARSEEKER

Standard Character Mark

Yes

Registration Number

3148049

Date Registered

2006/09/26

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Imaginova Corp. CORPORATION DELAWARE 470 Park Avenue South 9th Floor
New York NEW YORK 10016

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Optical goods, namely, telescopes, binoculars, lenses, and telescope
parts, namely lenses, lens filters, body tubes, eye pieces, prisms,
reflectors, mounts, computerized mounts, computerized hand controllers
used to control the movement of the telescope and astro-camera,
astro-cameras used to take pictures of images that are seen through
the telescope and tripods. First Use: 2003/09/00. First Use In
Commerce: 2003/09/00.

Filing Date

2005/06/30

Examining Attorney

LEWIS, MICHAEL

Attorney of Record

Lara A. Holzman, Esq.

STARSEEKER

DESIGN MARK

Serial Number

78766074

Status

REGISTERED

Word Mark

WYATT EARP

Standard Character Mark

Yes

Registration Number

3293671

Date Registered

2007/09/18

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Geronimo Productions, Inc. CORPORATION DELAWARE 116 West 23rd Street,
Suite 500 c/o Sherman & Blank Inc. New York NEW YORK 10011

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Binoculars; Cases for mobile phones; Cases for spectacles and
sunglasses; Chains for spectacles; Compasses; Decorative switch plate
covers; Electric switch plates; Goggles for sports; Sports eyewear;
Sunglasses; Telescopes; Telescopic sights. First Use: 1997/12/31.
First Use In Commerce: 1997/12/31.

Prior Registration(s)

1822807;1822817;1981170;AND OTHERS

Name/Portrait Statement

The name(s), portrait(s), and/or signature(s) shown in the mark does
not identify a particular living individual.

Filing Date

2005/12/03

Print: Apr 12, 2011

78766074

Examining Attorney
MCCAULEY, BRENDAN

Wyatt Earp

DESIGN MARK

Serial Number

78807217

Status

REGISTERED

Word Mark

GARRETT OPTICAL

Standard Character Mark

Yes

Registration Number

3222054

Date Registered

2007/03/27

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Garrett Optical LLC LIMITED LIABILITY COMPANY OKLAHOMA 11601 S. Lynn Lane Broken Arrow OKLAHOMA 740114022

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S: Binoculars; Golf scopes; Gun scopes; Hunting binoculars; Optical or telescopic lens sights; Rifle scopes; Spotting scopes; Telescopes; Tripods. First Use: 2005/04/01. First Use In Commerce: 2005/10/01.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "OPTICAL" APART FROM THE MARK AS SHOWN.

Filing Date

2006/02/03

Examining Attorney

STRUCK, ROBERT

Garrett Optical

DESIGN MARK

Serial Number

78831844

Status

REGISTERED

Word Mark

KOWA

Standard Character Mark

No

Registration Number

3229361

Date Registered

2007/04/17

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

KOWA COMPANY, LTD. CORPORATION JAPAN 6-29, Nishiki 3-chome, Naka-ku Nagoya JAPAN

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S: Photographic machines and apparatus, and their parts and fittings, namely, digital cameras with zoom functions, optical lenses; optical apparatus and instruments, and their parts and fittings, namely, telescopes and binoculars, optical lenses. First Use: 2001/05/00. First Use In Commerce: 2001/05/00.

Description of Mark

The mark consists of Kowa in an oval.

Filing Date

2006/03/08

Examining Attorney

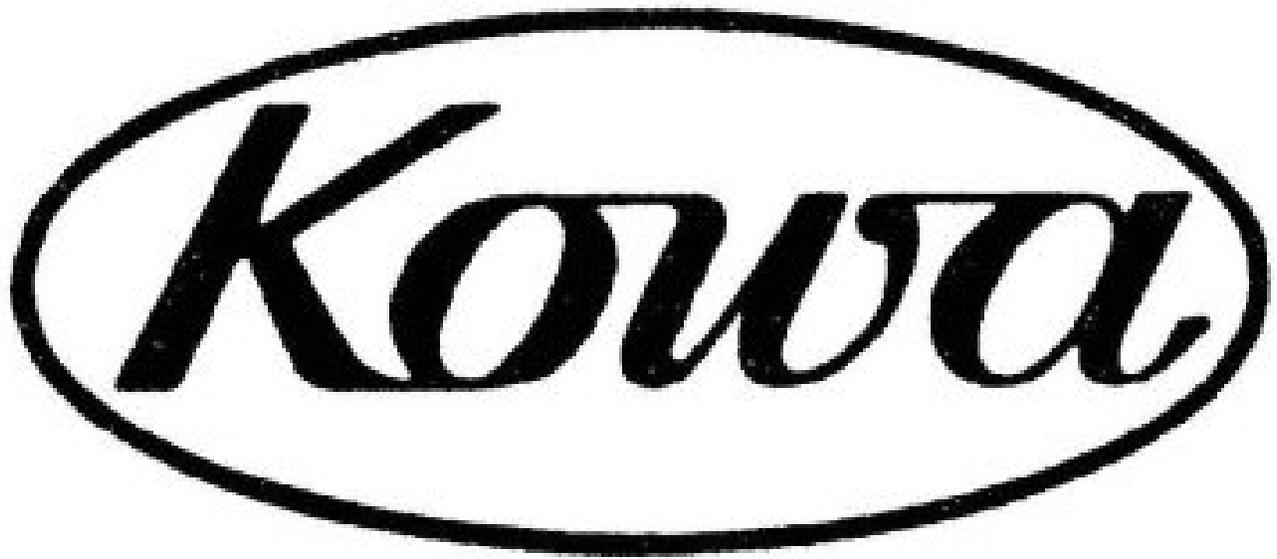
BENMAMAN, ALICE

Attorney of Record

Print: Apr 12, 2011

78831844

Thomas J. Moore



DESIGN MARK

Serial Number

78865804

Status

REGISTERED

Word Mark

STAR · INNOVATIONS

Standard Character Mark

No

Registration Number

3206242

Date Registered

2007/02/06

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

Imagine Nation Books Ltd CORPORATION COLORADO 4601 Nautilus Court
South Boulder COLORADO 80301

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
35mm cameras; Binoculars; Camera tripods; Cameras; Telescopes. First
Use: 2005/12/14. First Use In Commerce: 2006/02/15.

Description of Mark

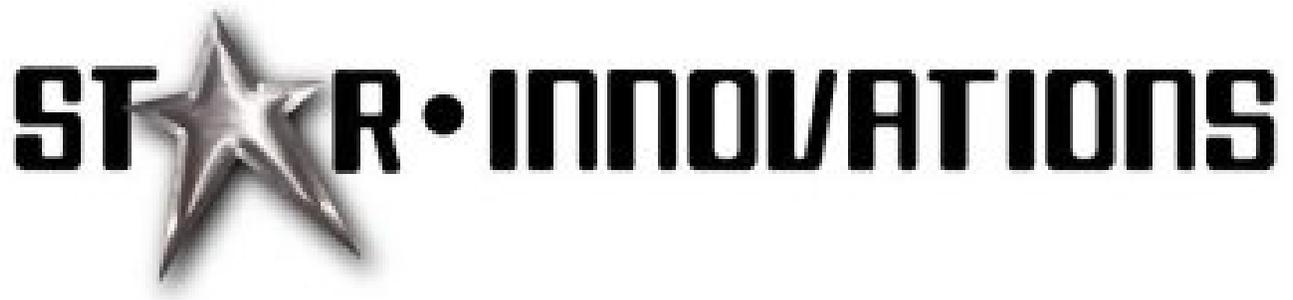
The mark consists of the wording "STAR INNOVATIONS" with a raised
period between the words "star" and "innovations" in which the letter
"A" is formed by a star.

Filing Date

2006/04/20

Examining Attorney

RITTNER, HANNO



DESIGN MARK

Serial Number

78895986

Status

REGISTERED

Word Mark

FAMOUS TRAILS

Standard Character Mark

Yes

Registration Number

3202203

Date Registered

2007/01/23

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Famous Trails CORPORATION CALIFORNIA 1580 N. Harmony Circle Anaheim CALIFORNIA 92807

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S: night vision goggles, binoculars, metal detectors, parabolic microphones, binocameras, telescopes and microscopes. First Use: 1999/12/01. First Use In Commerce: 1999/12/01.

Goods/Services

Class Status -- ACTIVE. IC 014. US 002 027 028 050. G & S: sport watches, watches containing heart rate monitors, watches containing remote control devices, watches containing digital cameras. First Use: 2003/08/01. First Use In Commerce: 2003/08/01.

Filing Date

2006/05/30

Examining Attorney

DEFORD, JEFF

Print: Apr 12, 2011

78895986

Attorney of Record

Lisa A. Sanderson, Esq.

Famous Trails

DESIGN MARK

Serial Number

78910322

Status

REGISTERED

Word Mark

XOTIC

Standard Character Mark

No

Registration Number

3233198

Date Registered

2007/04/24

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

Southwestern Firearms, Inc. CORPORATION TEXAS 420 Century Way, #100
Red Oak TEXAS 75154

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Binoculars; Rifle scopes; Spotting scopes. First Use: 2005/01/01.
First Use In Commerce: 2005/01/01.

Description of Mark

The mark consists in part of a rifle scope reticle formed in the "O"
of XOTIC.

Filing Date

2006/06/16

Examining Attorney

BELENKER, ESTHER

Attorney of Record

Eric Karich

XOTIC

DESIGN MARK

Serial Number

78955641

Status

REGISTERED

Word Mark

TRIGGER STICK

Standard Character Mark

Yes

Registration Number

3671097

Date Registered

2009/08/18

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Primos, Inc. CORPORATION MISSISSIPPI 604 First Street Flora
MISSISSIPPI 39071

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Tripods, bipods, and monopods for binoculars, cameras, and telescopes
used in outdoor recreation. First Use: 2008/12/22. First Use In
Commerce: 2008/12/22.

Goods/Services

Class Status -- ACTIVE. IC 013. US 002 009. G & S: Tripods,
bipods, and monopods for firearms used in hunting. First Use:
2008/12/22. First Use In Commerce: 2008/12/22.

Filing Date

2006/08/18

Examining Attorney

HETZEL, DANNEAN

Attorney of Record

Print: Apr 12, 2011

78955641

L. Grant Foster

TRIGGER STICK

DESIGN MARK

Serial Number

78961804

Status

REGISTERED

Word Mark

CRYSTAL CLEAR OPTICS

Standard Character Mark

No

Registration Number

3905824

Date Registered

2011/01/11

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Owner

Kowa Company, Ltd. CORPORATION JAPAN 6-29, Nishiki 3-chome, Naka-ku
Nagoya JAPAN

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Photographic machines and apparatus, namely, digital cameras with zoom
functions, lenses and parts thereof; optical apparatus and
instruments, namely, telescopes, binoculars, lenses and parts thereof.
First Use: 2010/08/31. First Use In Commerce: 2010/08/31.

Goods/Services

Class Status -- ACTIVE. IC 010. US 026 039 044. G & S: Diagnostic
instruments, namely, tonometers, fundus cameras and slit-lamps for use
in ophthalmology. First Use: 2010/08/31. First Use In Commerce:
2010/08/31.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "OPTICS" APART FROM THE
MARK AS SHOWN.

Colors Claimed

Print: Apr 12, 2011

78961804

Color is not claimed as a feature of the mark.

Filing Date

2006/08/28

Examining Attorney

CHISOLM, KEVON

Attorney of Record

Thomas J. Moore

Crystal Clear Optics

To: Sheltered Wings, Inc. (trademark@langlotz.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85095903 - EAGLE - VX-T67
Sent: 4/12/2011 10:22:30 AM
Sent As: ECOM108@USPTO.GOV
Attachments:

**IMPORTANT NOTICE REGARDING YOUR
U.S. TRADEMARK APPLICATION**

**USPTO OFFICE ACTION HAS ISSUED ON 4/12/2011 FOR
SERIAL NO. 85095903**

Please follow the instructions below to continue the prosecution of your application:

TO READ OFFICE ACTION: Click on this [link](#) or go to <http://portal.uspto.gov/external/portal/tow> and enter the application serial number to [access](#) the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this e-mail notification.

RESPONSE IS REQUIRED: You should carefully review the Office action to determine (1) how to respond; and (2) the applicable [response time period](#). Your response deadline will be calculated from **4/12/2011** (or sooner if specified in the office action).

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System [Response Form](#).

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

Failure to file the required response by the applicable deadline will result in the [ABANDONMENT](#) of your application.

3A

TRADEMARK
03584-T0001A SPM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	Sheltered Wings, Inc.
Serial No. 78/029,311	Filing Date: October 5, 2000
Trademark	EAGLE OPTICS
Law Office: 102	Trademark Attorney: April Lueders Rademacher

BOX RESPONSES – NO FEE
Assistant Commissioner for Trademarks
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Arlington, VA 22202-3513

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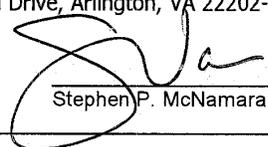
Response to Official Action

Dear Sir:

In response to the Office Action mailed on April 11, 2002, please enter the following Remarks.

Certificate of Mailing: I hereby certify that this correspondence is today being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

August 26, 2002



Stephen P. McNamara

Sheltered Wings, Inc. v. Wohali Outdoors, LLC, Cancellation No. 92054629
Wohali's Exhibit 13 Page 1 of 5



Sheltered Wings, Inc. v. Wohali Outdoors, LLC, Cancellation No. 92054629
Wohali's Exhibit 6 Page 67 of 127

Remarks

The Examining Attorney has refused registration of Applicant's mark EAGLE OPTICS on the basis of Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the Examining Attorney believes that Applicant's mark, when used on or in conjunction with the identified goods, so resembles the mark EAGLEVIEW, U.S. Registration No. 2,084,361 as to be likely to cause confusion, to cause mistake or to deceive. Applicant respectfully disagrees with this determination and requests reconsideration.

In determining a likelihood of confusion, it is well settled that a mark should not be dissected into component parts and then be compared to the potentially conflicting mark, for it is the impression which the mark creates as a whole that is important, and not the individual parts thereof. In this regard the Examining Attorney is respectfully referred to Massey Junior College, Inc. v. Fashion Institute of Technology, 492 F.2d 1399 (CCPA 1974) where the Court stated:

"that the marks must be considered in their entireties in determining whether there is a likelihood of confusion or mistake is a basic rule in comparison of marks."

In the prior Office Action, the prior Examiner cited numerous prior "Eagle" marks as the basis for a rejection under Section 2(d) of the Trademark Act. These included prior registrations and applications for EAGLE'S BLUFF, EAGLEVISION, EAGLE EYE, EAGLE. Clearly, the old saw about "eagle eyes" has informed the use of "Eagle" in each of these marks. The eagle is regarded as exemplifying excellent distance vision. This lends itself to use of the term "eagle" in many different marks pertaining to optical products. As such, the term "Eagle" is a relatively weak mark for optical products. In view of this, it is submitted that EAGLE OPTICS, the mark of the present application, is distinguishable from EAGLEVIEW. The marks have different commercial connotations. EAGLE OPTICS connotes high quality optical products. EAGLEVIEW connotes a product that gives the user an eagle's view. In view of the differences in the marks, and their commercial connotations, the marks are distinguishable.

This conclusion is amply supported by cases relating to weak marks that are applied to similar goods. The decisions in In re Bed & Breakfast Registry, 229 U.S.P.Q. 818 (Fed.Cir. 1986) (BED & BREAKFAST REGISTRY not confusingly similar to BED & BREAKFAST INTERNATIONAL for similar services of making lodging reservations); Swatch Watch, S.A. v. Taxor, Inc., 229 U.S.P.Q. 391 (11th Cir. 1986) (T-WATCH not confusingly similar to SWATCH for watches); Bell Laboratories, Inc. v. Colonial Products, Inc., 231 U.S.P.Q. 569 (S.D.Fr. 1986) FINAL FLIP not confusingly similar to FINAL for rodenticides); In re Best Products Co., Inc., 231 U.S.P.Q. 988 (T.T.A.B. 1986) (JEWELER'S BEST for jewelry not confusingly similar to BEST JEWELERS for jewelry services); Plus Products v. Star-Kist Foods, Inc., 220 U.S.P.Q. 541 (T.T.A.B. 1983) (PLUS for pet vitamins and pet food supplements not confusingly similar to MEAT PLUS for pet food); Lindy Pen Co. v. Bic Pen Corp., 226 U.S.P.Q. 17 (9th Cir. 1984) (AUDITORS FINE POINT not confusingly similar to AUDITORS for pens); Burger King Systems, Inc. v. Sandwich Chef, Inc., 203 U.S.P.Q. 733 (C.C.P.A. 1979) (SANDWICH CHEF not confusingly similar to BURGER CHEF for restaurant services); Redken Laboratories, Inc. v. Clairol, Inc., 183 U.S.P.Q. 84 (9th Cir. 1975) (CONDITION & CURL not confusingly similar to CONDITION for hair treatments); and Sunbeam Corp. v. American Safety Razor Co., 207 U.S.P.Q. 799 (T.T.A.B. 1980) (THE LADY not confusingly similar to LADY SUNBEAM for women's razors); show that the mere use of a common word among trademarks is an insufficient basis on which to find a likelihood of confusion. Instead, the other words in the mark, and the overall impression created by the entire mark must be considered in conjunction with the goods or services recited.

Applicant's mark EAGLE OPTICS, when compared to the registered marks EAGLEVIEW, reveals visual and auditory differences in the marks that make them distinguishable when viewed as a whole. Applicant submits that the term OPTICS, when considered in conjunction with the differences in the visual appearance and auditory differences between the marks when considered in their entirety, is sufficient to distinguish its mark from the prior registered mark.

Applicant also wishes to bring to the Examiner's attention that Applicant's goods have been in concurrent use in the marketplace with Registrants' goods for a period of time greater than five years.

The Applicant agrees with the Examining Attorney that each case must be analyzed in steps to determine if there is a likelihood of confusion. However, Applicant respectfully submits that up to as many as thirteen steps or factors must be considered during this analysis, not just the two steps indicated in the Office Action. In re E. I. DuPont de Nemors & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Three such additional steps to be considered:

"The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing."

"The length of time during and conditions under which there has been concurrent use without evidence of actual confusion."

"The extent of potential confusion, i.e., whether *de minimus* or substantial."

Therefore, when applying these additional steps to the analysis, the products in question are binoculars, a purchase that involves an expense anywhere from \$100 to \$500, and thus is not an impulse purchase, but one where the buyer will make some study before purchasing.

Further, there have been in excess of 5 years concurrent use without any commercial conflict, and certainly without any charge of infringement or other dispute.

Finally, the extent of confusion is *de minimus*. The existence of many registered EAGLE marks on various types of optical goods leads to a determination that the mark EAGLE is weak in respect to the goods and the extent of potential confusion is *de minimus* rather than substantial.

It is respectfully submitted that the foregoing Remarks respond to the issues raised in the Office Action. Accordingly, it is requested that the present application be approved for publication.

Respectfully submitted,



Stephen P. McNamara
Attorney for Applicant
ST. ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155

To: Wohali Outdoors, LLC (iplaw@gablelaw.com)

Subject: U.S. TRADEMARK APPLICATION NO. 77689308 - STEEL EAGLE - 008962.00003

Sent: 6/5/2009 7:05:41 PM

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UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/689308

MARK: STEEL EAGLE

77689308

CORRESPONDENT ADDRESS:

FRANK J. CATALANO
GABLE GOTWALS
100 W 5TH ST FL 10
TULSA, OK 74103-4240

RESPOND TO THIS ACTION:

<http://www.uspto.gov/teas/eTEASpageD.htm>

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Wohali Outdoors, LLC

CORRESPONDENT'S REFERENCE/DOCKET

NO:

008962.00003

CORRESPONDENT E-MAIL ADDRESS:

iplaw@gablelaw.com

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 6/5/2009

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

Search Results

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d).

Identification of Goods

The identification of goods is indefinite and must be clarified. *See* TMEP §1402.01. In the identification of goods, applicant must use the common commercial or generic names for the goods, be as complete and specific as possible, and avoid the use of indefinite words and phrases. If applicant uses indefinite words such as "accessories," "components," "devices," "equipment," "materials," "parts," "systems" or "products," such words must be followed by "namely," followed by a list of the specific goods identified by their common commercial or generic names. *See* TMEP §§1402.01, 1402.03(a).

Applicant may adopt the following identification, if accurate:

**Sheltered Wings, Inc. v. Wohali Outdoors, LLC, Cancellation No. 92054629
Wohali's Exhibit 14 Page 2 of 34**

Magnifying optical equipment, namely, [indicate specific products using common commercial names, e.g., magnifying glasses, etc.] in Class 9.

Identifications of goods can be amended only to clarify or limit the goods; adding to or broadening the scope of the goods is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07. Therefore, applicant may not amend the identification to include goods that are not within the scope of the goods set forth in the present identification.

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netahtml/tidm.html>. *See* TMEP §1402.04.

Disclaimer

Applicant must disclaim the descriptive wording “STEEL” apart from the mark as shown because it merely describes a feature or characteristic of the goods. *See* 15 U.S.C. §1056(a); TMEP §§1213, 1213.03(a). The goods are “magnifying optical equipment.”

As evidence in support of the disclaimer requirement, the examining attorney has attached definitions of STEEL downloaded from www.dictionary.com and copies of current Registrations for various goods that include a disclaimer of STEEL.

The computerized printing format for the Office’s *Trademark Official Gazette* requires a standardized format for a disclaimer. TMEP §1213.08(a)(i). The following is the standard format used by the Office:

No claim is made to the exclusive right to use “STEEL” apart from the mark as shown.

TMEP §1213.08(a)(i); *see In re Owatonna Tool Co.*, 231 USPQ 493 (Comm’r Pats. 1983).

Response

If applicant has questions about its application or this Office action, please contact the assigned trademark examining attorney at the telephone number below.

/Ronald McMorrow/
Examining Attorney

Law Office 105
(571) 272-9306

RESPOND TO THIS ACTION: Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.



steel

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Synonyms

- brace
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steel [steel] [Show IPA](#)

-noun

- any of various modified forms of iron, artificially produced, having a carbon content less than that of pig iron and more than that of wrought iron, and having qualities of hardness, elasticity, and strength varying according to composition and heat treatment; generally categorized as having a high, medium, or low-carbon content.
- a thing or things made of this metal.
- a flat strip of this metal used for stiffening, esp. in corsets; stay.
- a bar of this metal that has one end formed to hold a bit for driving through rock.
- steels**, stocks or bonds of companies producing this metal.
- a sword.
- a rounded rod of ridged steel, fitted with a handle and used esp. for sharpening knives.

-adjective

relating to or made of steel

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- steedless
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- steeking
- steel**
- steel arch bridge
- steel band
- steel blue
- steel company
- steel drum

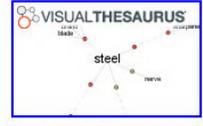
- 8. pertaining to or made of steel.
 - 9. like steel in color, hardness, or strength.
- verb (used with object)**
- 10. to fit with steel, as by pointing, edging, or overlaying.
 - 11. to cause to resemble steel in some way.
 - 12. to render insensible, inflexible, unyielding, determined, etc.:
He steeled himself to perform the dangerous task.

Origin:
bef. 900; (n.) ME *steele*, OE (north) *stæle*; c. D *staal*, G *Stahl*, ON *stǣl*; (v.) ME *stelen*, OE *stýled* edged with steel, deriv. of the n.

Related forms:
steellike, adjective

Dictionary.com Unabridged
Based on the Random House Dictionary, © Random House, Inc. 2009.
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steel (stēl) (stēl) [?]
n.

1. A generally hard, strong, durable, malleable alloy of iron and carbon, usually containing between 0.2 and 1.5 percent carbon, often with other constituents such as manganese, chromium, nickel, molybdenum, copper, tungsten, cobalt, or silicon, depending on the desired alloy properties, and widely used as a structural material.
2. Something, such as a sword, that is made of steel.
3. A quality suggestive of this alloy, especially a hard, unflinching character.
4. Steel gray.

 adj.

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- adj.
1. a. Made with, relating to, or consisting of steel: *steel beams; the steel industry; a bicycle with a steel frame.*
b. Very firm or strong: *a steel grip.*
 2. Of a steel gray.
- tr.v. **steeled, steel-ing, steels**
1. To cover, plate, edge, or point with steel.
 2. To make hard, strong, or obdurate; strengthen: *He steeled himself for disappointment.*

[Middle English stel, from Old English stōle, stēl.]

The American Heritage® Dictionary of the English Language, Fourth Edition
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Steel

Steel, n. [AS. st[=e], st[=y], st[=y]le; akin to D. staal, G. stahl, OHG. stahal, Icel. st[=a], Dan. staal, Sw. st[*a], Old Prussian stakla.]

1. (Metal) A variety of iron intermediate in composition and properties between wrought iron and cast iron (containing between one half of one per cent and one and a half per cent of carbon), and consisting of an alloy of iron with an iron carbide. Steel, unlike wrought iron, can be tempered, and retains magnetism. Its malleability decreases, and fusibility increases, with an increase in carbon.

2. An instrument or implement made of steel; as: (a) A weapon, as a sword, dagger, etc. "Brave Macbeth . . . with his brandished steel." --Shak.

While doubting thus he stood, Received the steel bathed in his brother's blood. --Dryden. (b) An instrument of steel (usually a round rod) for sharpening knives. (c) A piece of steel for striking sparks from flint.

3. Fig.: Anything of extreme hardness; that which is characterized by sternness or rigor. "Heads of steel." --Johnson. "Manhood's heart of steel." --Byron.

4. (Med.) A chalybeate medicine. --Dunglison.

Note: Steel is often used in the formation of compounds, generally of obvious meaning; as, steel-clad, steel-girt, steel-hearted, steel-plated, steel-pointed, etc.

Bessemer steel (Metal.) See in the Vocabulary.

Blister steel. (Metal.) See under Blister.

Cast steel (Metal) a fine variety of steel, originally made by

Cast steel (Metal.), a fine variety of steel, originally made by smelting blister or cementation steel; hence, ordinarily, steel of any process of production when remelted and cast.

Cromium steel (Metal.), a hard, tenacious variety containing a little chromium, and somewhat resembling tungsten steel.

Mild steel (Metal.), a kind of steel having a lower proportion of carbon than ordinary steel, rendering it softer and more malleable.

Puddled steel (Metal.), a variety of steel produced from cast iron by the puddling process.

Steel duck (Zo["o]l.), the goosander, or merganser. [Prov. Eng.]

Steel mill. (a) (Firearms) See Wheel lock, under Wheel. (b) A mill which has steel grinding surfaces. (c) A mill where steel is manufactured.

Steel trap, a trap for catching wild animals. It consists of two iron jaws, which close by means of a powerful steel spring when the animal disturbs the catch, or tongue, by which they are kept open.

Steel wine, wine, usually sherry, in which steel filings have been placed for a considerable time, -- used as a medicine.

Tincture of steel (Med.), an alcoholic solution of the chloride of iron.

Tungsten steel (Metal.), a variety of steel containing a small amount of tungsten, and noted for its tenacity and hardness, as well as for its malleability and tempering qualities. It is also noted for its magnetic properties.

Steel

Steel\, v. t. [imp. & p. p. Steeled; p. pr. & vb. n. Steeling.] [AS. stlan: cf. Icel. st[ae]la. See Steel, n.]

1. To overlay, point, or edge with steel; as, to steel a razor; to steel an ax.
2. To make hard or strong; hence, to make insensible or obdurate.
Lies well steeled with weighty arguments. --Shak.
O God of battles! steel my soldier's hearts. --Shak.
Why will you fight against so sweet a passion, And steel your heart to such a world of charms? --Addison.
3. Fig.: To cause to resemble steel, as in smoothness, polish, or other qualities.
These waters, steeled By breezeless air to smoothest polish. --Wordsworth.

wordsworld

4. (Elec.) To cover, as an electrotype plate, with a thin layer of iron by electrolysis. The iron thus deposited is very hard, like steel.

Webster's Revised Unabridged Dictionary, ©1996, 1998 MICRA, Inc.
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NEW Language Translation for : **steel**
Italian: **acciaio**; **d'acciaio**, German: **der Stahl, Stahl-...**,
Japanese: **鋼鉄(の)**
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steel

O.E. stȳlc, from W.Gmc. adj. *stakhlijan "made of stool" (cf. O.S. stehli, O.N., M.L.G. stal, Dan. staa, Swed. stå, M.Du. stael, Du. staal, O.H.G. stahal, Ger. Stahl), related to *stakhla "standing fast," from PIE *stek-lo-, from base *stak- "to stand, place, be firm" (see [stay](#) (n.1)). No corresponding word exists outside Gmc. except those likely borrowed from Gmc. languages. The fig. verb sense of "make hard or strong like steel" is first recorded 1581. Steel wool is attested from 1896.

Online Etymology Dictionary, ©2001 Douglas Harper
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steel (stēl) [Pronunciation Key](#)

Any of various hard, strong, flexible alloys of iron and carbon. Often, other metals are added to give steel a particular property, such as chromium and nickel to make it stainless. Steel is widely used in many kinds of tools and as a structural material in building.

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Steel

The "bow of steel" in (A.V.) 2 Sam. 22:35; Job 20:24; Ps. 18:34 is in the Revised Version "bow of brass" (Heb. kesheth-nehushah). In Jer. 15:12 the same word is used, and is also rendered in the Revised Version "brass." But more correctly it is copper (q.v.), as brass in the ordinary sense of the word (an alloy of copper and zinc) was not known to the ancients.

Easton's 1897 Bible Dictionary
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steel

In addition to the idiom beginning with steel, also see mind like a

In addition to the idiom beginning with [steel](#), also see [mind like a steel trap](#).

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Print: Jun 5, 2009

78112725

TYPED DRAWING

Serial Number

78112725

Status

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Word Mark

STEEL WARRIOR

Standard Character Mark

No

Registration Number

2768240

Date Registered

2003/09/23

Type of Mark

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Register

PRINCIPAL

Mark Drawing Code

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First Use In Commerce: 2002/09/01.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "STEEL" APART FROM THE
MARK AS SHOWN.

Filing Date

2002/03/05

Examining Attorney

KRISP, JENNIFER

Attorney of Record

Susan B. Flohr

-1-

Print: Jun 5, 2009

78153938

TYPED DRAWING

Serial Number

78153938

Status

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TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

DE LA CRUZ, JOSEPH, A INDIVIDUAL UNITED STATES 746 ARROWWOOD STREET
LONGMONT COLORADO 80503

Goods/Services

Class Status -- ACTIVE. IC 021. US 002 013 023 029 030 033 040 050.
G & S: HOUSEHOLD AND KITCHEN UTENSILS, NAMELY BOTTLE STOPPERS. First
Use: 2000/06/01. First Use In Commerce: 2002/01/31.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "STEEL" APART FROM THE
MARK AS SHOWN.

Filing Date

2002/08/14

Examining Attorney

KRISP, JENNIFER

DESIGN MARK

Serial Number

78476036

Status

REGISTERED

Word Mark

STEEL BLUE

Standard Character Mark

Yes

Registration Number

3017700

Date Registered

2005/11/22

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Footwear Industries Pty Ltd CORPORATION AUSTRALIA 18 Irvine Drive
Malaga, Western Australia AUSTRALIA 6090

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Safety boots; safety shoes; protective industrial boots; protective
industrial shoes; protective work boots; protective work shoes;
protective boots containing a reinforced toe-cap; protective shoes
containing a reinforced toe-cap; protective steel-capped boots;
protective steel-capped shoes. First Use: 2003/04/28. First Use In
Commerce: 2003/04/28.

Prior Registration(s)

2791839

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "STEEL" APART FROM THE
MARK AS SHOWN.

Filing Date

2004/08/30

Print: Jun 5, 2009

78476036

Examining Attorney

SINGH, TEJBIR

Attorney of Record

Hillary A. Brooks

STEEL BLUE

DESIGN MARK

Serial Number

78487633

Status

REGISTERED

Word Mark

CHICAGO STEEL

Standard Character Mark

Yes

Registration Number

3027933

Date Registered

2005/12/13

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Lollar, Stephanie INDIVIDUAL UNITED STATES 9728 SW 264th St. Vashon Island WASHINGTON 98070

Owner

Lollar, Jason INDIVIDUAL UNITED STATES 9728 SW 264th St. Vashon Island WASHINGTON 98070

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S: Electronic sound pickup for guitars and basses. First Use: 2004/09/08. First Use In Commerce: 2004/09/08.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "STEEL" APART FROM THE MARK AS SHOWN.

Filing Date

2004/09/22

Examining Attorney

NADELMAN, ANDREA K.

Print: Jun 5, 2009

78487633

Attorney of Record
David L. Tingey

CHICAGO STEEL

Print: Jun 5, 2009

78668045

DESIGN MARK

Serial Number

78668045

Status

REGISTERED

Word Mark

STEEL POWER

Standard Character Mark

No

Registration Number

3235979

Date Registered

2007/05/01

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

Casillas, Octavio Morales INDIVIDUAL MEXICO Milano No. 44.B. Col
Juarez MEXICO C.P. 0660

Goods/Services

Class Status -- ACTIVE. IC 012. US 019 021 023 031 035 044. G & S:
brake parts for land vehicles, namely brake disks, brake drums, brake
hardware, brake cylinders and brake facings; and clutches for land
vehicles.

Foreign Country Name

MEXICO

Foreign Registration Number

729123

Foreign Registration Date

2001/12/07

Foreign Expiration Date

2011/10/01

-1-

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "STEEL" APART FROM THE MARK AS SHOWN.

Description of Mark

"The mark consists of the stylized word STEEL over the word POWER inside a single-line oval with a decorative border inside two concentric, single-line ovals."

Filing Date

2005/07/12

Examining Attorney

THOMAS, SARA

Attorney of Record

Stewart L. Gitler



DESIGN MARK

Serial Number

78769721

Status

REGISTERED

Word Mark

XTREME STEEL

Standard Character Mark

Yes

Registration Number

3331768

Date Registered

2007/11/06

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

SEABOARD INDUSTRIES, INC. CORPORATION NEW JERSEY 185 Van Winkle Ave.
Hawthorne NEW JERSEY 07506

Goods/Services

Class Status -- ACTIVE. IC 006. US 002 012 013 014 023 025 050. G
& S: Metal swimming pools. First Use: 2006/03/01. First Use In
Commerce: 2006/03/01.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "STEEL" APART FROM THE
MARK AS SHOWN.

Filing Date

2005/12/08

Examining Attorney

CARTY, GEORGIA

Attorney of Record

Thomas P. Philbrick

XTREME STEEL

DESIGN MARK

Serial Number

78958848

Status

REGISTERED

Word Mark

PRO STEEL

Standard Character Mark

Yes

Registration Number

3258486

Date Registered

2007/07/03

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Golf Galaxy Golfworks, Inc. CORPORATION OHIO 4820 Jacksontown Rd.
Newark OHIO 43055

Goods/Services

Class Status -- ACTIVE. IC 028. US 022 023 038 050. G & S: Golf club heads; Golf clubs. First Use: 2003/01/00. First Use In Commerce: 2003/01/00.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE STEEL APART FROM THE MARK AS SHOWN.

Filing Date

2006/08/23

Examining Attorney

HELLA, AMY

Attorney of Record

Bassam N. Ibrahim

PRO STEEL

DESIGN MARK

Serial Number

79023773

Status

REGISTERED

Word Mark

TW STEEL

Standard Character Mark

Yes

Registration Number

3252025

Date Registered

2007/06/12

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Hermanos B.V. UNKNOWN IJssel 25 NL-1509 JB ZAANDAM NETHERLANDS

Goods/Services

Class Status -- ACTIVE. IC 014. US 002 027 028 050. G & S:
Jewellery; watches; horological and chronometric instruments.

Priority Date

2005/10/11

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "STEEL" APART FROM THE
MARK AS SHOWN.

Filing Date

2006/03/21

Examining Attorney

HOFFMAN, DAVID

TW STEEL

DESIGN MARK

Serial Number

79027833

Status

REGISTERED

Word Mark

STEEL BLUE

Standard Character Mark

Yes

Registration Number

3369565

Date Registered

2008/01/15

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Footwear Industries Pty Ltd Incorporated company AUSTRALIA 18 Irvine Drive MALAGA WA 6090 AUSTRALIA

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S: Protective industrial footwear, protective industrial boots, protective industrial shoes, safety footwear, safety boots and safety shoes; footwear for protection against accidents, irradiation and fire, namely, boots and shoes for protection against accidents for use in industry; boots and shoes for protection against accidents for use at work.

Goods/Services

Class Status -- ACTIVE. IC 025. US 022 039. G & S: Footwear, namely, boots, shoes, heavy duty footwear, work boots, work shoes, boots containing a reinforced toe cap, shoes containing a reinforced toe cap, steel-capped boots, steel-capped shoes, water-impervious footwear and hiking boots; clothing, namely, jackets, jumpers, coats, shirts, sweaters, T-shirts, pants, wristbands, belts and socks; headgear, namely, hats and caps.

Print: Jun 5, 2009

79027833

Prior Registration(s)

2791839;3017700

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "STEEL" APART FROM THE MARK AS SHOWN.

Filing Date

2006/08/04

Examining Attorney

BULLOFF, TOBY

Attorney of Record

HILLARY A. BROOKS

STEEL BLUE

DESIGN MARK

Serial Number

79050866

Status

REGISTERED

Word Mark

PAINLESS STEEL

Standard Character Mark

Yes

Registration Number

3587352

Date Registered

2009/03/10

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Transcodent GmbH & Co. KG limited partnership FED REP GERMANY
Oderstraße 60 24539 Neumünster FED REP GERMANY

Goods/Services

Class Status -- ACTIVE. IC 010. US 026 039 044. G & S: Medical instruments and their parts, namely, injection needles for medical and dental use.

Disclaimer Statement

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "STEEL" APART FROM THE MARK AS SHOWN.

Filing Date

2008/02/13

Examining Attorney

CROWLEY, SEAN

Attorney of Record

Lance J. Lieberman

Painless Steel

To: Wohali Outdoors, LLC (iplaw@gablelaw.com)
Subject: U.S. TRADEMARK APPLICATION NO. 77689308 - STEEL EAGLE - 008962.00003
Sent: 6/5/2009 7:05:44 PM
Sent As: ECOM105@USPTO.GOV
Attachments:

IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 6/5/2009 FOR
APPLICATION SERIAL NO. 77689308

Please follow the instructions below to continue the prosecution of your application:

VIEW OFFICE ACTION: Click on this link http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77689308&doc_type=OOA& (or copy and paste this URL into the address field of your browser), or visit <http://tportal.uspto.gov/external/portal/tow> and enter the application serial number to access the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this notification.

RESPONSE MAY BE REQUIRED: You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable response time period. Your response deadline will be calculated from **6/5/2009**.

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the ABANDONMENT of your application.**

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN**

SHELTERED WINGS, INC.,
a Wisconsin corporation,

Plaintiff,

vs.

WOHALI OUTDOORS, LLC,
an Oklahoma limited liability company,

Defendant.

Civil Case No. 11-CV-300
JURY TRIAL DEMANDED

COMPLAINT

Plaintiff Sheltered Wings, Inc. (“Plaintiff”) hereby files its complaint and alleges as follows:

1. This is an action for trademark infringement, false designation of origin, unfair competition and related claims against Defendant Wohali Outdoors, LLC (“Defendant”) based on Defendant’s unauthorized and unlawful use of Plaintiff’s EAGLE mark. Plaintiff brings this action under the Federal Lanham Act and common law to recover damages and enjoin Defendant’s unlawful conduct and for other relief as set forth in this Complaint. Plaintiff also brings this action to cancel Defendant’s federal registration of the STEEL EAGLE trademark inasmuch as it covers precisely the same goods on which Plaintiff has used the EAGLE trademark and Plaintiff has more than two decades of priority using the EAGLE mark in connection with optics.

JURISDICTION AND VENUE

2. This is an action for trademark infringement and unfair competition under the Lanham Act (a.k.a. Trademark Act of 1946, 15 U.S.C. § 1051-1127, as amended), common law trademark infringement, and related state law claims.

3. This Court has subject matter jurisdiction over this action under 28 U.S.C. § 1331 (federal question), 28 U.S.C. 1338(a) (trademarks), and 15 U.S.C. § 1121 (trademarks). This Court has supplemental jurisdiction over Plaintiff's state law claims under 28 U.S.C. § 1367(a) because those claims arise from a common nucleus of operative facts alleged in Plaintiff's federal claims.

4. This Court has personal jurisdiction over Defendant under Wis. Stat. § 801.05(1), (3) and (4) because it is engaged in substantial and not isolated business in this District, actions giving rise to this lawsuit have occurred in this District, and Defendant has caused damage to Plaintiff in this District and goods of the Defendant were used in the District in the ordinary course of trade. In addition, Defendant resides in this district as that term is legally defined.

5. Venue is proper in this District pursuant to 28 U.S.C. § 1391.

THE PARTIES

6. Plaintiff is a Wisconsin corporation doing business as Eagle Optics with its principal place of business in Middleton, Wisconsin. Among other things, Plaintiff provides among other things, binoculars, spotting scopes, monoculars, and related equipment under a family of EAGLE trademarks throughout the United States.

7. Upon information and belief, Defendant is an Oklahoma limited liability company with its principal place of business in Claremore, Oklahoma. Among other things, Defendant

provides magnifying binoculars, scopes and related equipment under the STEEL EAGLE trademark throughout the United States.

GENERAL ALLEGATIONS

I. PLAINTIFF'S RIGHTS

8. Plaintiff owns valuable rights in its trademarks.

9. Plaintiff's extensive trademark rights derive from longstanding and widespread use.

10. Plaintiff owns a series of United States trademark registrations for a family of EAGLE trademarks including EAGLE OPTICS (U.S. TM Reg. No. 3,192,083), EAGLE OPTICS (U.S. TM Reg. No. 2,886,199), EAGLE OPTICS (U.S. TM Reg. No. 3,794,245), STRIKE EAGLE (U.S. TM Reg. No. 3,726,431), and GOLDEN EAGLE (U.S. TM Reg. No. 3,787,739), among others.

11. Plaintiff's trademark rights in the family of EAGLE trademarks derive from longstanding and widespread use of the EAGLE mark in connection with optics (namely binoculars, spotting scopes, telescopes, and related equipment) dating back to at least 1987.

12. Plaintiff also enjoys broad common law trademark rights in the EAGLE trademarks. As a part of its family of EAGLE trademark rights, Plaintiff enjoys common law rights in the EAGLE mark alone. For example, Plaintiff has used the mark EAGLE OPTICS in connection with optics dating back at least as early as 1987. Optics is generic and describes the type of products that Plaintiff sells under the EAGLE mark. Therefore, the most significant and proprietary portion of the goodwill associated with the EAGLE OPTICS trademark is the EAGLE mark used in connection with the sale of optics.

13. Plaintiff's federally registered and common law trademarks in its EAGLE family of marks are herein referred to as the "EAGLE Family of Marks" or "Plaintiff's Mark."

14. As a result of Plaintiff's long and extensive uses, Plaintiff's Mark has become well known and highly respected in the optics industry as a distinctive symbol of the highest quality products.

15. Plaintiff's goods have been widely advertised and extensively promoted under Plaintiff's Mark, and Plaintiff's Mark has become, through widespread and favorable public acceptance and recognition, an asset of substantial value as a symbol of Plaintiff, its exceedingly high quality goods, and its goodwill.

16. Plaintiff enjoys remarkable success and an enviable reputation in its field due in large part to its longstanding use of, and rights in, Plaintiff's Mark.

17. As a result of Plaintiff's favorable reputation and considerable investment in and promotion of its goodwill, Plaintiff's Mark has become synonymous with Plaintiff and its high quality goods.

18. Plaintiff enforces its rights herein under Plaintiff's Mark in order to ensure Plaintiff's continued success and excellent reputation.

19. Plaintiff's Mark has been extensively and continuously advertised and promoted to the public by Plaintiff through various means and modes including but not limited to, over the Internet. By reason of such advertising and promotion, Plaintiff has provided quality goods to many customers throughout the United States.

20. By reason of Plaintiff's advertising and promotion under Plaintiff's Mark, the public has come to recognize Plaintiff's goods as solely emanating from Plaintiff.

II. DEFENDANT'S MISCONDUCT

21. Defendant is using the STEEL EAGLE mark in connection with the sale of optics (namely, binoculars, scopes and related equipment).

22. Defendant's use of the STEEL EAGLE mark is confusingly similar to Plaintiff's Mark and thus constitutes unlawful use of Plaintiff's Mark.

23. Defendant's use of Plaintiff's Mark is likely to cause consumer confusion and a false association between Plaintiff's goods and the goods offered by Defendant, falsely leading consumers to believe that the products emanate from the same source or that Plaintiff and Defendant are affiliated.

24. On information and belief, such diversion has resulted in, and will continue to result in, substantial and irreparable harm to Plaintiff, and to consumers in this District. Such use could tarnish the goodwill associated with Plaintiff's Mark.

25. This offering to the public of goods by Defendant under Plaintiff's Mark has been and is, without permission or authority of Plaintiff and without any legitimate license to Plaintiff's Mark.

26. Defendant has used Plaintiff's Mark in this District as a forum for its infringing activities.

27. Defendant has engaged in the transaction of business and activities and the commission of tortious acts in the state of Wisconsin, and are subject to the jurisdiction of this Court.

28. By using Plaintiff's Mark and offering goods for sale thereunder, Defendant has misrepresented and falsely described to the general public the origin and source of Defendant's goods so as to deceive the public and deliberately create a likelihood of confusion, cause

mistake, or deceive as to the affiliation, connection, or association of Defendant with Plaintiff, or as to the origin, sponsorship, or approval of Defendant's goods by the ultimate purchaser as to both the source and sponsorship of Defendant's goods.

29. Defendant's infringing activities are causing, or are likely to cause, irreparable injury to Plaintiff, including injury to its business reputation.

30. Defendant's infringing activities have, do, and are likely to permit Defendant to pass off its goods as those of Plaintiff, all to the detriment of Plaintiff, and to the unjust enrichment of Defendant.

31. Defendant's infringing activities have caused, currently cause, and are likely to continue to cause, damage to Plaintiff by tarnishing the valuable reputation and image associated with Plaintiff and its goods. Defendant has further passed off their goods in interstate commerce, as those of Plaintiff by Defendant's activities and many continuing misrepresentations to the consuming public, members of which are likely to, and do, believe that Defendant's activities and related goods emanate from or are associated with Plaintiff.

32. Defendant's infringing activities result in irreparable harm and injury to Plaintiff. Among other harms, Defendant's misconduct:

- A. deprives Plaintiff of its absolute right to determine the manner in which its goods are presented to the general public;
- B. deceives the public as to the origin and sponsorship of such goods.
- C. wrongfully trades upon Plaintiff's reputation and exclusive rights in its trademarks; and

D. to the extent Defendant's goods are or may be of inferior quality or unauthorized for sale or distribution, irreparably harms and injures Plaintiff's reputation.

33. Plaintiff is entitled to an injunction restraining Defendant, their officers, agents, servants, employees, and attorneys, and all persons acting in concert with them, from engaging in any further acts in violation of Plaintiff's rights.

34. Plaintiff is further entitled to recover from Defendant the damages, including treble damages, interest, and attorneys' fees and costs it has sustained and will sustain and any gains, profits, and advantages obtained by Defendant as a result of Defendant's acts. At present, the amount of such damages, gains, profits, and advantages cannot be fully ascertained by Plaintiff.

35. Defendant wrongfully obtained a registration for the STEEL EAGLE mark (U.S. TM Reg. No. 3,904,949). Defendant's first use of this formative EAGLE mark in connection with optics came no earlier than late 2009, more than 22 years after Plaintiff began using the EAGLE mark in connection with optics throughout the United States.

36. Defendant has no rights in the STEEL EAGLE mark in connection with optics. Accordingly, U.S. TM Reg. No. 3,904,929 should be cancelled.

37. Plaintiff sent a cease and desist letter to Defendant in late 2010. Defendant failed to acknowledge the letter or send a reply. Accordingly, regardless of its prior knowledge, Defendant now has knowledge of Plaintiff's trademark rights and its ongoing misconduct constitutes a willful violation of Plaintiff's trademark rights.

CAUSES OF ACTION

COUNT I

(TRADEMARK INFRINGEMENT UNDER § 32 OF THE LANHAM ACT)

38. Plaintiff realleges and incorporates by reference all of the foregoing paragraphs.

39. Plaintiff possesses a valid registrations issued by the USPTO for Plaintiff's Mark.

40. Defendant's actions as described above, including Defendant's use of Plaintiff's Mark to promote its business interests, is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association of Defendant with Plaintiff, or as to the origin, sponsorship or approval of Defendant's products by Plaintiff. Defendant's conduct constitutes trademark infringement in violation of § 32 of the Lanham Act (15 U.S.C. § 1114).

41. Defendant's trademark infringement has caused and continues to cause damage and irreparable injury to the value and goodwill of Plaintiff's registered mark, as well as damages and irreparable injury to Plaintiff's business, goodwill, and reputation. Plaintiff has no adequate remedy at law because damages are continuing and difficult to ascertain. On information and belief, Defendant's continued use of Plaintiff's Mark is deliberate, willful, fraudulent, and constitutes a knowing infringement of Plaintiff's Mark, and makes this case exceptional.

42. By virtue of the foregoing, Plaintiff is entitled to an award of treble damages under § 35(a) of the Lanham Act (15 U.S.C. § 1117(a)).

43. By virtue of the foregoing, Plaintiff is entitled to an award of attorneys' fees under § 35(a) of the Lanham Act (15 U.S.C. § 1117(a)).

44. By virtue of the foregoing, Plaintiff is entitled to injunctive relief and monetary damages against Defendant.

COUNT II
(TRADEMARK INFRINGEMENT UNDER § 43(a)(1)(A) OF THE LANHAM ACT)

45. Plaintiff realleges and incorporates by reference all of the foregoing paragraphs.

46. Defendant has used in commerce words, terms and names that are likely to cause confusion, or to cause mistake or to deceive, as to whether Defendant are affiliated, connected, or associated with Plaintiff and/or as to whether Plaintiff originated, sponsored or approved of Defendant's activities.

47. By so acting, Defendant has violated § 43(a) of the Lanham Act (15 U.S.C. § 1125(a)).

48. Plaintiff has been and will continue to be damaged by such wrongful actions.

49. Because Defendant's actions, on information and belief, were intentional, willful and/or deliberate, Plaintiff is entitled to an award of treble damages under § 35(a) of the Lanham Act (15 U.S.C. § 1117(a)).

50. On information and belief, this is an exceptional case, and thus Plaintiff is entitled to an award of attorneys' fees under § 35(a) of the Lanham Act (15 U.S.C. § 1117(a)).

51. By reason of the foregoing, Plaintiff is entitled to injunctive relief and monetary damages against Defendant.

COUNT III
(COMMON LAW TRADEMARK INFRINGEMENT)

52. Plaintiff realleges and incorporates by reference all of the foregoing paragraphs.

53. Plaintiff's Mark is distinctive and has acquired secondary meaning.

54. Defendant's actions, as alleged above, infringe Plaintiff's common law trademark rights under federal common law, Wisconsin common law, and constitute acts of unfair competition.

55. By reason of the foregoing, Plaintiff is entitled to injunctive relief and monetary damages against Defendant.

56. The infringing activities of Defendant, on information and belief, are willful and intentional, thereby justifying an award of exemplary and/or punitive damages.

COUNT IV
(MISREPRESENTATION IN VIOLATION OF WIS. STAT. § 100.18)

57. Plaintiff realleges and incorporates by reference all of the foregoing paragraphs.

58. Defendant has used made representations to third parties in Wisconsin that are untrue, deceptive or misleading as to whether Defendant are affiliated, connected, or associated with Plaintiff and/or as to whether Plaintiff originated, sponsored or approved of Defendant's activities.

59. By so acting, Defendant has violated Wis. Stat. § 100.18(1).

60. Plaintiff has been and will continue to be damaged and suffer pecuniary loss by such wrongful actions.

61. By reason of the foregoing, Plaintiff is entitled to an injunctive relief and an award of damages and costs including reasonable attorneys fees under Wis. Stat. § 100.18(11)(b).

COUNT V
(UNJUST ENRICHMENT)

62. Plaintiff realleges and incorporates by this reference all of the foregoing paragraphs.

63. Defendant has benefited from the improper, unfair, and unauthorized use of Plaintiff's Mark and goodwill attendant thereto, as alleged above.

64. Defendant has knowledge and fully appreciates the benefits it has received from Plaintiff as a result of such actions.

65. Defendant would be unjustly enriched if they were permitted to retain the proceeds obtained from such actions.

66. Equity and good conscience dictate that Defendant be required to account for and turn over to Plaintiff an amount equal to the value of the benefits conferred upon them.

COUNT VI
(CANCELLATION OF TRADEMARK)

67. Plaintiff realleges and incorporates by this reference all of the foregoing paragraphs.

68. Defendant first began using the STEEL EAGLE mark in connection with optics in approximately October of 2009. Plaintiff's use of the EAGLE mark and the EAGLE Family of Marks in connection with optics commenced at least as early as 1987 – approximately 22 years before Defendant's first use.

69. Defendant's use of the STEEL EAGLE mark is confusingly similar to Plaintiff's longstanding use of the EAGLE mark and the EAGLE Family of Marks.

70. Defendant has no trademark rights in the STEEL EAGLE mark.

71. Defendant's federal registration (U.S. TM Reg. No. 3,904,929) was wrongfully obtained.

72. Plaintiff has been and will continued to be damaged by Defendant's purported federal trademark registration.

73. Pursuant to 15 U.S.C. §§ 1064 and 1119, the Court should direct the United States Patent and Trademark Office to cancel Trademark Registration No. 3,904,929.

JURY DEMAND

Plaintiff demands that all claims and causes of action raised in this Complaint against Defendant be tried to a jury to the fullest extent possible under the United States and Wisconsin Constitutions.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff demands judgment against Defendant as follows:

A. Preliminarily and permanently enjoining Defendant, and all other persons participating or acting in concert with them, from infringing any of Plaintiff's rights in Plaintiff's Mark.

B. Preliminarily and permanently enjoining Defendant, and all other persons participating or acting in concert with them, from using any marks similar to Plaintiff's Mark that are likely to cause confusion or mistake as to whether Defendant are authorized by or affiliated with Plaintiff and as to whether Defendant's goods have been authorized or sponsored by Plaintiff;

C. Preliminarily and permanently enjoining Defendant, and all other persons participating or acting in concert with them, from engaging in unfair competition;

D. Preliminarily and permanently enjoining Defendant, and all other persons acting in concert with them, from making a false representation as to the source, sponsorship, approval, or certification of goods by their use of Plaintiff's Mark.

E. Preliminarily and permanently enjoining Defendant, and all other persons acting in concert with them, from making a false representation as to affiliation, connection, association with, or certification by another, by their use of Plaintiff's Mark.

F. An order of the Court directing Defendant to deliver up to Plaintiff all literature, advertisements, business forms, signs, and any other representations, regardless of form, which are in, or come to be in, Defendant's possession, custody, or control and which bear Plaintiff's Mark or any other confusingly similar variant to Plaintiff's Mark, and an order from the Court compelling Defendant to notify their direct customers, agents, and representatives that Defendant's misuse of Plaintiff's Mark or any confusingly similar variant is not connected with Plaintiff.

G. An order from the Court directing Defendant to provide an accounting of all revenues and profits gained by Defendant while engaging in the acts complained of in this Complaint.

H. Awarding Plaintiff its actual damages, and awarding Plaintiff any additional damages that the Court deems just and equitable under the circumstances of the case;

I. Awarding Plaintiff treble damages in accordance with § 35 of the Lanham Act (15 U.S.C. § 1117) on the claim asserted under § 43(a) of the Lanham Act (15 U.S.C. § 1125(a));

J. Establishment of a constructive trust consisting of profits from or obtained by Defendant's wrongful acts, to be held for the benefit of Plaintiff;

K. Awarding Plaintiff damages to which it is entitled based upon Defendant's unjust enrichment.

L. Plaintiff respectfully requests that the Court order that Trademark Registration No. 3,904,929 be cancelled pursuant to 15 U.S.C. §§ 1064 and 1119.

M. Awarding Plaintiff prejudgment interest at the rate established under 26 U.S.C. § 6621(a)(2) from the date of service of the Complaint through the date of judgment;

N. Awarding Plaintiff its allowable costs and attorneys' fees; and

O. Awarding Plaintiff such other and/or further relief as is just and equitable.

Dated this 25th day of April, 2011.

s/ James D. Peterson

James D. Peterson

James D. Peterson

jpeterson@gklaw.com

Jennifer L. Gregor

jgregor@gklaw.com

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Salt Lake City, UT 84101

Telephone: (801) 799-5800

Facsimile: (801) 799-5700

Attorneys for Plaintiff

Sheltered Wings, Inc.

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6291532_3

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WISCONSIN

SHELTERED WINGS, INC.
a Wisconsin corporation,

Plaintiff,

Case No. 11-CV-300

v.

WOHALI OUTDOORS, LLC,
an Oklahoma limited liability company,

Defendant.

**ANSWER AND AFFIRMATIVE DEFENSES
OF WOHALI OUTDOORS, LLC**

Defendant Wohali Outdoors, LLC, by its attorneys, Mark M. Leitner and C.J. Krawczyk of Kravit, Hovel & Krawczyk, s.c., responds as follows to plaintiff's complaint:

1. The allegations of Paragraph 1 are legal conclusions to which no response is required; to the extent a response is required, denies.
2. The allegations of Paragraph 2 are legal conclusions to which no response is required; to the extent a response is required, denies.
3. The allegations of Paragraph 3 are legal conclusions to which no response is required; to the extent a response is required, denies.
4. The allegations of Paragraph 4 are legal conclusions to which no response is required; to the extent a response is required, denies.

5. The allegations of Paragraph 5 are legal conclusions to which no response is required; to the extent a response is required, denies.

6. Lacks information sufficient to form a belief as to the truth of the allegations in Paragraph 6, and therefore denies.

7. Admits.

8. Denies.

9. Lacks information sufficient to form a belief as to the truth of the allegations in Paragraph 9, and therefore denies.

10. Lacks information sufficient to form a belief as to the truth of the allegations in Paragraph 10, and therefore denies.

11. Lacks information sufficient to form a belief as to the truth of the allegations in Paragraph 11, and therefore denies.

12. Lacks information sufficient to form a belief as to the truth of the allegations in Paragraph 12, and therefore denies.

13. The allegations of Paragraph 13 are legal conclusions to which no response is required; to the extent a response is required, denies.

14. Lacks information sufficient to form a belief as to the truth of the allegations in Paragraph 14, and therefore denies.

15. Lacks information sufficient to form a belief as to the truth of the allegations in Paragraph 15, and therefore denies.

16. Lacks information sufficient to form a belief as to the truth of the allegations in Paragraph 16, and therefore denies.

17. Lacks information sufficient to form a belief as to the truth of the allegations in Paragraph 17, and therefore denies.

18. Lacks information sufficient to form a belief as to the truth of the allegations in Paragraph 18, and therefore denies.

19. Lacks information sufficient to form a belief as to the truth of the allegations in Paragraph 19, and therefore denies.

20. Lacks information sufficient to form a belief as to the truth of the allegations in Paragraph 20, and therefore denies.

21. Admits.

22. Denies.

23. Denies.

24. Denies.

25. Denies.

26. Denies.

27. Denies.

28. Denies.

29. Denies.

30. Denies.

31. Denies.

32. Denies.

33. Denies.

34. Denies.

35. Denies.

36. Denies.

37. Lacks information sufficient to form a belief as to the truth of the allegation that plaintiff sent a letter, and therefore denies; states affirmatively that it has no record or recollection of having received such a letter, and further, that if such a letter was sent, said letter speaks for itself and denies all allegations of Paragraph 37 inconsistent therewith; states affirmatively that it could not acknowledge or reply to a letter that it never received; denies the remaining allegations of Paragraph 37.

38. Realleges and reincorporates its responses to Paragraphs 1-37 as if set forth in full.

39. The allegations in Paragraph 39 constitute legal conclusions to which no response is required; to the extent a response is required, denies.

40. Denies.

41. Denies.

42. Denies.

43. Denies.

44. Denies.

45. Realleges and incorporates its responses to paragraphs 1-44 as if set forth in full.

46. Denies.

47. Denies.

48. Denies.

49. Denies.

50. Denies.

51. Denies.

52. Realleges and incorporates its responses to paragraphs 1-51 as if set forth in full.

53. The allegations in Paragraph 53 constitute legal conclusions to which no response is required; to the extent a response is required, denies.

54. Denies.

55. Denies.

56. Denies.

57. Realleges and reincorporates its responses to paragraphs 1-56 as if set forth in full.

58. Denies.

59. Denies.

60. Denies.

61. Denies.

62. Realleges and incorporates its responses to paragraphs 1-61 as if set forth in full.

63. Denies.

64. Denies.

65. Denies.

66. Denies.

67. Realleges and incorporates its responses to paragraphs 1-66 as if set forth in full.

68. Admits that it began using “Steel Eagle” on or about October 21, 2009; lacks information sufficient to form a belief as to the truth of the remaining allegations in Paragraph 68, and therefore denies.

69. Denies.

70. Denies.

71. Denies.

72. Denies.

73. Denies.

AFFIRMATIVE DEFENSES

1. Upon information and belief, plaintiff’s complaint fails to state claims upon which relief can be granted.

2. This court may lack personal jurisdiction over this answering defendant.

3. Upon information and belief, venue may be improper in this judicial district.

4. Upon information and belief, plaintiff may have failed to mitigate its alleged damages, if any.

5. Upon information and belief, some or all of plaintiff’s claims may be barred by the doctrine of unclean hands.

6. Upon information and belief, some or all of plaintiff's claims may be barred by the doctrine of waiver.

7. Upon information and belief, some or all of plaintiff's claims may be barred by the doctrine of estoppel.

8. Upon information and belief, some or all of plaintiff's state law claims may be barred by the doctrine of preemption.

9. Defendant's registration for "Steel Eagle" provides the presumptive exclusive right to use the "Steel Eagle" mark for the goods identified in the registration.

10. Plaintiff's claims based on its alleged rights with respect to rifle scopes are barred because defendant's first use in commerce predates plaintiff's.

11. Plaintiff's own filings before the United States Patent and Trademark Office, and the registrations that have been granted based on those filings, limit the scope of plaintiff's trademark rights to "[b]inoculars, spotting scopes, telescopes, and storage cases therefor, ***all for use in birdwatching.***" (Emphasis added.) Birdwatching is not the intended use for the rifle scopes marketed by defendant under the "Steel Eagle" mark, and defendant does not market its other products to birdwatchers.

12. On or about April 12, 2011, the United States Patent and Trademark Office issued an Office Action refusing plaintiff's Application Serial No. 85095903 "because the applicant's mark, when used on or in connection with the identified goods, so resembles the mark in U.S. Registration No. 3904929 as to be

likely to cause confusion, or to cause mistake, or to deceive.” U.S. Registration No. 3904929 is defendant’s mark “Steel Eagle” for “magnifying optical equipment, namely rifle scopes and binoculars[.]”

13. Defendant reserves the right to add additional affirmative defenses as its investigation continues and discovery proceeds.

WHEREFORE, defendant Wohali Outdoors, LLC respectfully demands the following relief:

- A. Dismissal of plaintiff’s complaint upon its merits and with prejudice;
- B. An award of its costs and expenses, including attorney fees, incurred in defending this action; and
- C. Such other and further relief as this court deems proper.

KRAVIT, HOVEL & KRAWCZYK S.C.

s/Mark M. Leitner

Mark M. Leitner

Christopher J. Krawczyk

Attorneys for Defendant Wohali Outdoors, LLC

Kravit, Hovel & Krawczyk s.c.
825 North Jefferson - Fifth Floor
Milwaukee, WI 53202
(414) 271-7100 - Telephone
(414) 271-8135 - Facsimile
kravit@kravitlaw.com

Dated: May 23, 2011

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN**

SHELTERED WINGS, INC., a Wisconsin corporation,

Plaintiff,

vs.

WOHALI OUTDOORS, LLC, an Oklahoma limited liability company,

Defendant.

Civil Case No. 11-CV-300

**PLAINTIFF’S MOTION FOR VOLUNTARY DISMISSAL
WITHOUT PREJUDICE**

Plaintiff Sheltered Wings, Inc. (“Plaintiff”) hereby moves this Court for a voluntary dismissal without prejudice pursuant to Fed. R. Civ. P. 41(a)(2). In support of this Motion, Plaintiff represents as follows:

1. Plaintiff uses a family of formative EAGLE trademarks in connection with the advertising and sale of optics (*i.e.*, spotting scopes, binoculars, rifle scopes, telescopes, and related equipment) dating back to at least 1987.

2. Plaintiff recently learned of Defendant Wohali Outdoors, LLC’s (“Defendant”) use of the STEEL EAGLE mark for optics (*i.e.*, binoculars, rifle scopes and related equipment) which is confusingly similar to Plaintiff’s formative EAGLE mark (such as its federally registered EAGLE OPTICS, STRIKE EAGLE, and GOLDEN EAGLE marks and its common law rights in the EAGLE mark). Plaintiff filed the present action and requested that Defendant cease and desist from all uses of any formative EAGLE mark in connection with optics.

3. After service of the Complaint, settlement discussions between the parties immediately commenced. During these discussions, Plaintiff learned that a small part of Defendant's business involved utilizing the EAGLE mark in connection with optics – Defendant mostly sells fishing equipment under the EAGLE mark. Plaintiff does not sell fishing equipment.

4. In connection with the parties' settlement discussions, Plaintiff also learned that Defendant's historic sales and inventory were very small, and the parties established a framework through which Plaintiff believed the case would be settled.

5. Just prior to consummating the settlement agreement, Defendant's insurer agreed to defend the case and retained insurance defense counsel for that purpose. Settlement negotiations ceased at that point.

6. Despite the disappointment of not consummating an expected settlement to efficiently resolve this dispute, Plaintiff learned during the course of the settlement discussions that Defendant's alleged misconduct and the current impact on Plaintiff's business is not sufficiently large to justify the substantial cost to litigate this matter.

THEREFORE, the Court should enter an order dismissing this case under Rule 41(a)(2), without prejudice. Plaintiff has asked for Defendant's stipulation concerning this dismissal. To date, Defendant has not responded to that request.

Dated this 6th day of June, 2011.

s/ James D. Peterson

James D. Peterson

James D. Peterson

jpeterson@gklaw.com

Jennifer L. Gregor

jgregor@gklaw.com

GODFREY & KAHN, S.C.

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Attorneys for Plaintiff

Sheltered Wings, Inc.

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IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN

SHELTERED WINGS, INC.,

Plaintiff,

v.

WOHALI OUTDOORS, LLC,

Defendant.

ORDER

11-cv-300-bbc

Plaintiff Sheltered Wings, Inc. has filed a motion to voluntarily dismiss this trademark infringement case without prejudice under Fed. R. Civ. P. 41(a)(2). In its motion, plaintiff explains that it brought this suit against defendant Wohali Outdoors, LLC after learning that defendant recently began to use the “Steel Eagle” mark in connection with the sale of optic equipment and that the mark is confusingly similar to the “Eagle,” “Eagle Optics,” “Strike Eagle” and “Golden Eagle” marks that plaintiff has used in connection with optics, including binoculars, spotting scopes and related equipment since 1987. Plaintiff alleges that it discovered defendant’s Steel Eagle mark on April 12, 2011, when the Patent and Trademark Office rejected plaintiff’s attempt to register its own Eagle trademark on the basis of a likelihood of confusion between defendant’s registered Steel Eagle mark and plaintiff’s Eagle

mark.

Believing that its own mark has priority over defendant's mark, plaintiff served its complaint on defendant. The parties commenced settlement discussions, during which plaintiff learned that only a small part of defendant's business involves use of the Steel Eagle mark in connection with optics and that defendant's historic sales and inventories of optics have been small. The parties were close to settling the case when defendant's insurer agreed to defend the case, retained insurance defense counsel for that purpose, ceased settlement negotiations and filed an answer to plaintiff's complaint. Although plaintiff was disappointed that this case was not settled, it decided that defendant's impact on the optics market and the potential monetary or injunctive relief is not sufficiently large to justify the substantial cost to litigate this matter. Instead, plaintiff plans to resolve the parties' disputes by seeking cancellation of defendant's Steel Eagle registration with the Patent and Trademark office, a significantly less expensive proceeding.

Defendant does not dispute most of the facts recited by plaintiff. However, defendant contends that plaintiff's case should be dismissed only *with* prejudice and on the conditions that plaintiff pay defendant's costs and attorney fees and be prohibited from seeking cancellation of defendant's mark before the Patent and Trademark Office. According to defendant, the real reason plaintiff wishes to dismiss the case is because plaintiff knows it lacks merit. In particular, defendant says that because the Patent and Trademark Office

rejected plaintiff's Eagle mark, plaintiff's trademark infringement case will fail.

Defendant's argument makes little sense. Plaintiff knew about the Trademark Office's rejection of its mark *before* it filed this lawsuit; in fact, the office action is what prompted this lawsuit. Plaintiff hoped for a speedy resolution of the dispute through settlement, which appeared to be imminent until defendant's insurer appeared in the case. A court can grant voluntary dismissal under Rule 41(a)(2) "on terms that the court considers proper." For example, the court may require that dismissal be with prejudice or condition the dismissal on plaintiff's payment of costs and attorney fees. Cauley v. Wilson, 754 F.2d 769, 771 (7th Cir. 1985). In deciding whether to dismiss a claim with prejudice, a court may consider "[t]he defendant's effort and expense of preparation for trial, excessive delay and lack of diligence on the part of the plaintiff in prosecuting the action, insufficient explanation for the need to take a dismissal, and the fact that a motion for summary judgment has been filed by the defendant." Federal Deposit Insurance Corp. v. Knostman, 966 F.2d 1133, 1142 (7th Cir. 1992) (quotation omitted).

It is appropriate to dismiss this case without prejudice and without payment of fees and costs. The case is still in its early stages, no dispositive motions have been filed, no significant fees or costs have been incurred by either party and there is no evidence that plaintiff has acted in bad faith or with excessive delay. Additionally, plaintiff has presented a legitimate reason for seeking dismissal of this case, namely, that the cost of litigation will

likely outweigh the value of any monetary or injunctive relief plaintiff could recover. Id. at 1142-43 (noting that it was appropriate for district court to grant voluntary dismissal of FDIC's claims following FDIC's conclusion that it would not be cost effective to pursue them). Although plaintiff believes pursuing its claims would not be cost effective at this time, it should be allowed to preserve its rights to reinstate its claims or seek other remedies in the event defendant's market share changes. Finally, I will not enter an order prohibiting plaintiff from seeking cancellation of defendant's mark with the Patent and Trademark Office. Defendant cites no support for this request and I can think of no justification for such an extraordinary prohibition.

ORDER

IT IS ORDERED that plaintiff Sheltered Wings, Inc.'s motion to dismiss this case without prejudice and without payment of costs and fees under Fed. R. Civ. 41(a)(2) is GRANTED. The clerk of court is directed to close this case.

Entered this 25th day of July, 2011.

BY THE COURT:

/s/

BARBARA B. CRABB

District Judge

TTAB

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

IN THE MATTER OF TRADEMARK REGISTRATION No. 2084361
REGISTERED: July 29, 1997

-----X
SHELTERED WINGS, INC.

Petitioner,

Cancellation No.

v.

NIKON, INC.

Registrant.

-----X



11-04-2002

U.S. Patent & TMO/TM Mail Rpt Dt. #70

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PETITION FOR CANCELLATION

SHELTERED WINGS, INC. d/b/a EAGLE OPTICS, a Wisconsin corporation,
having offices in Middletown, Wisconsin (hereinafter referred to as "Petitioner") hereby
Petitions to cancel U.S. Trademark Registration No. 2084361 registered July 29, 1997
for the mark EAGLE VIEW in International Class 9 for use in connection with
binoculars.

02 NOV 20 AM 11:30
TRADEMARK TRIAL AND APPEAL BOARD

The grounds for cancellation are as follows:

1. Petitioner is mail order retailer and distributor of optical products, particularly, binoculars, telescopes and spotting scopes, and has used the service mark EAGLE OPTICS in connection with mail order services in the field of optical products since 1986. Examples of such servicemark usage is attached as Exhibit A.

DD

2. In 1996, Petitioner began to distribute and sell its own line of binoculars, telescopes and spotting scopes using the trademark EAGLE OPTICS. Examples of such trademark usage is attached as Exhibit B.

3. Registrant Nikon, Inc. is the owner of U.S. Trademark Reg. No. 2084361 registered July 29, 1997 for the mark EAGLEVIEW for binoculars. According to the registration, Registrant first made use of the mark EAGLEVIEW on November 30, 1996. The application which issued as U.S. Trademark Reg. No. 2084361 was filed under Section 1(b) of the Trademark Act on November 28, 1994, and thus Registrant's rights in its mark arose no earlier than November 28, 1994.

4. Petitioner's first uses of EAGLE OPTICS in 1986 and rights in the mark EAGLE OPTICS occurred long before the Registrant's filing date or first uses of EAGLEVIEW.

5. Petitioner has applied to register EAGLE OPTICS, U.S. Trademark application no. 78/029,311 filed October 5, 2000 for binoculars, telescopes and spotting scopes. Petitioner's application for registration has been refused registration under Section 2(d) of the Trademark Act based on the Examiner's conclusion that the Petitioner's mark EAGLE OPTICS is likely to be confused with Registrant's mark EAGLEVIEW.

6. Petitioner is being harmed by Registrant's U.S. Trademark Reg. No. U.S. Trademark Reg. No. 20843611 registered July 29, 1997 for the mark EAGLEVIEW registered July 29, 1997 for the mark EAGLEVIEW.

WHEREFORE, Petitioner prays that U.S. Trademark Registration No. 20843611 be cancelled.

A duplicate Petition for Cancellation is being filed herewith along with a check in the amount of \$300.00

Petitioner hereby appoints Stephen P. McNamara, Registration No. 32,745 and Mark J. Speciner of the firm of St. Onge Steward Johnston & Reens LLC, 986 Bedford Street, Stamford, CT 06905-5619, to act as attorneys for Petitioner herein, with full power to prosecute this action, and to transact all relevant business with the Patent and Trademark office and in the United States Courts in connection with this Petition for Cancellation.

Respectfully submitted,

SHELTERED WINGS, INC.



Stephen P. McNamara
Attorney of the State of Connecticut

St. Onge Steward Johnston & Reens, LLC
986 Bedford Street
Stamford, CT 06905
Tel. No:(203) 324-6155
Fax No: (203) 327-1096

Certificate of Mailing: I hereby certify that this correspondence is today being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Box TTAB Fee, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513

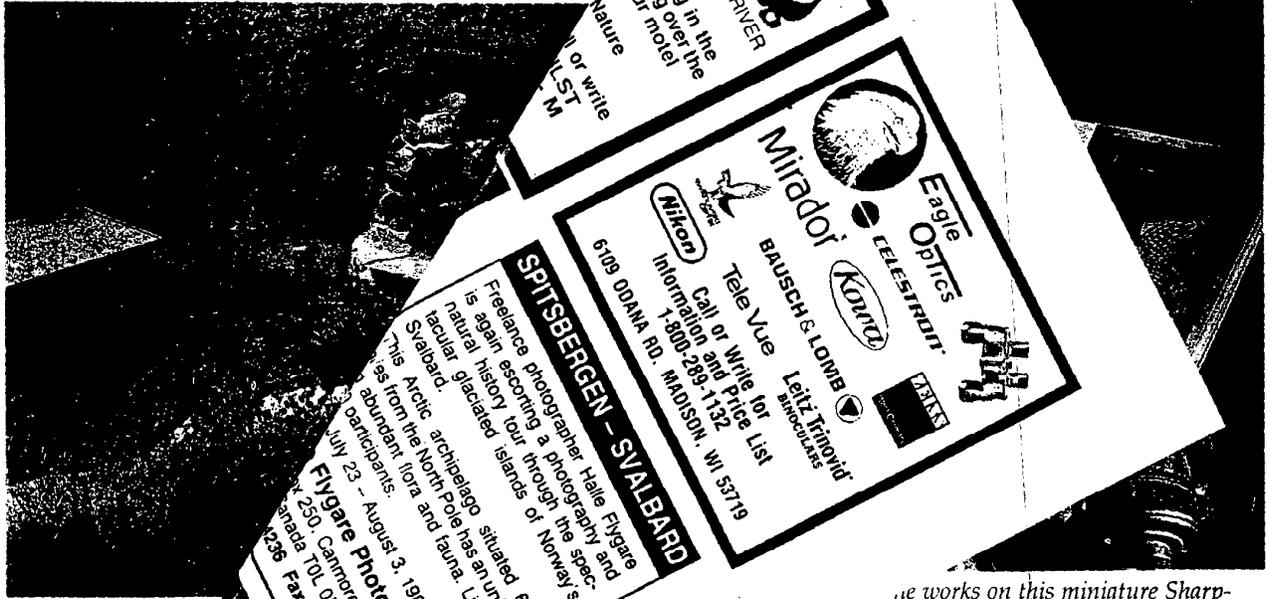
Date: November 1, 2002



Stephen P. McNamara

friend tells the story of how a flying squirrel made 147 unsuccessful attempts at jumping from a nearby tree to a hanging feeder. It fell to the ground each time. On the 148th attempt, however, it landed on the feeder correctly. From that time on, it never missed again.

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ugh. a house, a path. He was remodeling with a windows across the door. And there, behind the windows, in the middle of the work week, was this guy with this big cigar hanging out of his mouth, sitting at a big desk with his feet up, whittling on a duck. I looked at my wife, and I pointed to him and said, 'That's for me. That's what I want to do.'

"It was the whole atmosphere. The idea that someone was making a living carving birds. I don't know for sure if he was or wasn't. But the situation just looked good to me."

He went started carving. He was completely unfamiliar with the art. His father carved decoys for him to use for hunting. And his friend, Harold Haertel, is a renowned carver. Though he has never been a hunter, Guge had tried his hand at a couple of decoys in his day. He enjoyed the carving, but it was certainly not an all-consuming interest, and it never occurred to him that it would one day be a full-time occupation.

Guge worked as a house painter for eight hours a day, coming home to carve for another eight. He kept to this intense routine for four years until he was sure he could support his growing family by selling his carvings.

Now, at age 36, Guge's carvings have earned three World-Class titles at the Ward Foundation's World Championship Wildfowl Carving Competition, in the Decorative

Miniature Wildfowl category. At the 1988 show, he received second place in the Life-size category with "Juncos and Bittersweet." Each year since 1982 his carvings have been accepted at the prestigious "Birds in Art" exhibition of the Leigh Yawkey Woodson Art Museum in Wausau, Wisconsin.

Guge's techniques have reached a wider audience with his feature in Roger Schroeder's *How to Carve Wildfowl, Book 2*, and Stackpole Books' recent release of *Carving Miniature Wildfowl*, cowritten by Schroeder and Guge.

The setting for his life's work is a casual, country style, two-story Cape Cod home located next to his parent's house in his hometown of Carpentersville, Illinois. He lives there with his wife, Jody, daughter, Jordan, and sons, Seth, Joshua, Caleb, Asher, and Gabriel.

Just off the basement family room, Guge works in two small work-

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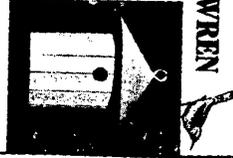
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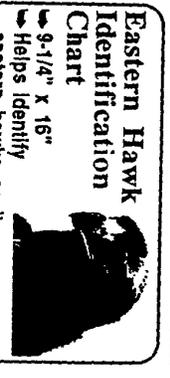
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towers is a major concern of researchers studying migrating birds. According to Sidney Gathreaux, an ornithologist at Clemson University in South Carolina, tall buildings, such as the Washington Monument and the Empire State Building, have always been sources of high mortality for birds that migrate at night.

"With the advent of high tech and very tall television and radio towers, the problem has become substantially greater," says Gathreaux.

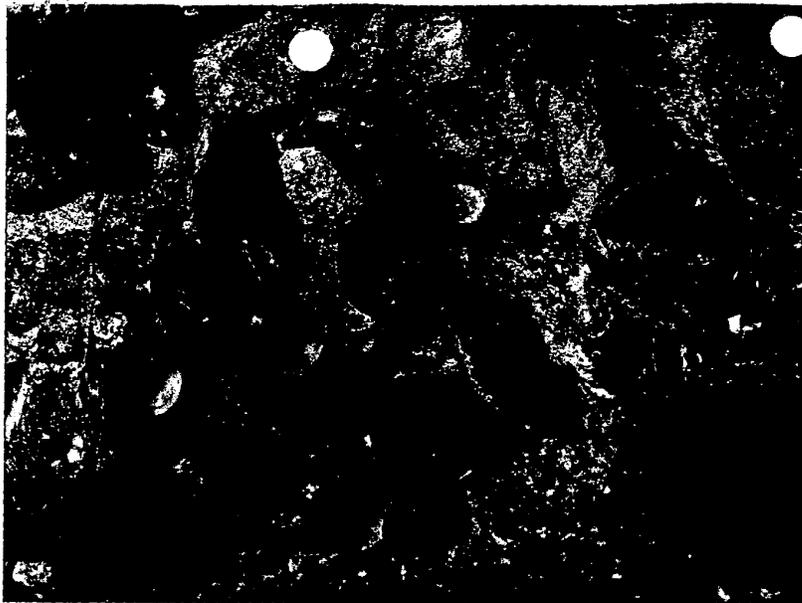
For years, the United States Air Force has realized the attraction airport lights have on migrating birds. But Gathreaux made an interesting discovery—the birds seemed to ignore the runway strobe lights.

"It appears the birds are more attracted to the constantly burning lights at the level at which they were traveling," says Gathreaux. "It may be that light at the bird's eye level is the most important."

Light pollution is a major problem for migrating birds, but the problem is not insurmountable. A number of cities, such as San Diego, California, and Parsippany-Troy Hills, New Jersey, have established new zoning ordinances for street lighting. Some have put in more efficient lighting, using sodium lamps with special deflectors to aim the light at the street, where it is needed, and not at the sky.

Most of these measures were taken primarily to save energy or to make it easier for astronomers at nearby observatories to see into the nighttime sky, rather than to help birds. However, all of these steps will greatly help birds that migrate at night. Many more studies need to be conducted to determine exactly how light pollution affects birds and what can be done to minimize the problem. We all need the light, but we must be sure that we do not pay too dear a price for it.

Patricia Barnes-Svarney is a freelance writer/photographer who specializes in nature subjects. Her articles have appeared in a number of major regional and national publications.



Limpet and mollusk shells scattered around nest site by parent birds after feeding the chicks.

watching chores on 12-hour alternating shift. During this time the chicks' pepper-and-salt-colored down dries and becomes more fluffy in appearance. After growing darker within the next three weeks, the fledgling attains full juvenal plumage by the sixth week, when it resembles a winter adult.

Black Oystercatcher hatchlings are born precocial—down-covered and eyes open—but remain dependent on the adults for some time after hatching. At the beginning, the surf-pounded rock environment must be explored cautiously by the young bird. It usually takes about five weeks before a young oystercatcher develops enough sureness of foot to clamber down to the lower tidal areas to begin foraging for food with its parents.

The feeding skills of oystercatchers are so specialized that it often takes three or four months for the fledglings to learn to open mussels and barnacles efficiently—or even to chip chitons and limpets from the rocks. Typical of all types of young, it has an avid appetite. A young bird will consume the equivalent of 120 mussels per day during the period of rapid growth.

A young oystercatcher is a master at "freezing," blending in perfectly with its surroundings. It is helped by its juvenal plumage, which has

"rusty" feather edgings. When a warning is given by a parent oystercatcher, the young bird will immediately flatten down on the rocks with neck and bill outstretched. Nothing except the all-clear call from the parent bird will set the "frozen" oystercatcher free to move again.

Black Oystercatchers are somewhat gregarious, and tend to flock in limited numbers, except during the breeding season, when established pairs will occupy the same territory used in previous years. From about April through August, these pairs can be found defending their territories on promontories, rocky shores, or on some of the smaller offshore islands located along the Pacific Coast.

During the time I have been privileged to observe Black Oystercatchers, it has become quite evident that there is still much more to be learned about these fascinating shorebirds. For the birding enthusiasts that put forth the time and effort, however, observing the Black Oystercatcher is a most rewarding proposition.

Len Penhale is a naturalist and photo-journalist who has received many awards for his efforts on behalf of wildlife. He is based at Morro Bay, California. This is his first article for *WildBird* Magazine.

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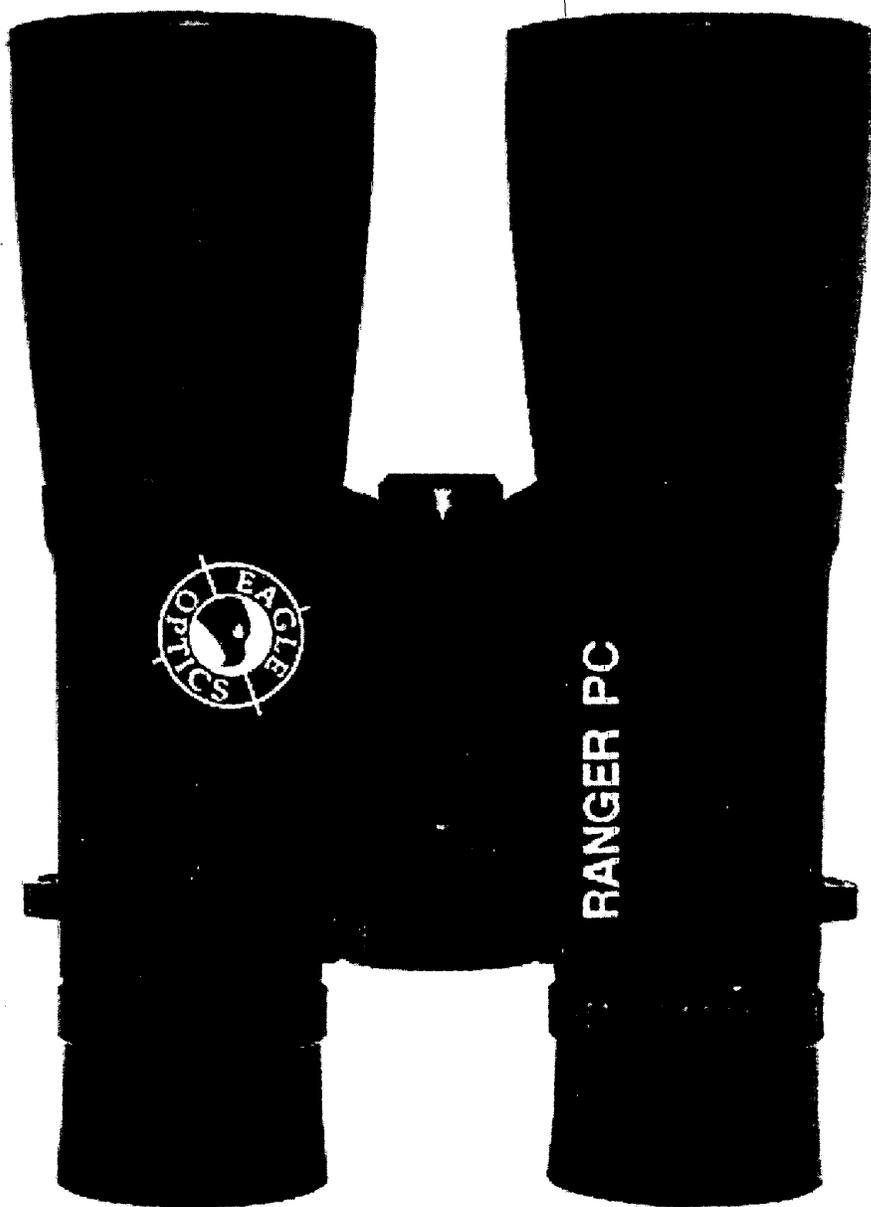
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3



TRADEMARK
03584-T0001A SPM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	Sheltered Wings, Inc.
Serial No. 78/029,311	Filing Date: October 5, 2000
Trademark	EAGLE OPTICS
Law Office: 102	Trademark Attorney: April Lueders Rademacher

BOX RESPONSES – NO FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

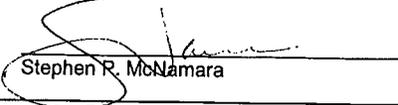
Response to Official Action

Dear Sir:

In response to the Office Action mailed on October 10, 2003, please enter the following Remarks.

Certificate of Mailing: I hereby certify that this correspondence is today being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

125 Jan. 2004


Stephen R. McNamara



01-20-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #77

SW00344

Remarks

The Examining Attorney has refused registration of Applicant's mark EAGLE OPTICS on the basis of Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), because the Examining Attorney believes that Applicant's mark, when used on or in conjunction with the identified goods, so resembles the mark EAGLEVIEW, U.S. Registration No. 2,084,361 as to be likely to cause confusion, to cause mistake or to deceive.

Applicant has entered into a Consent Agreement with the owner of the cited mark. As set forth in the agreement, "the parties believe that as a result of the differences in meaning and commercial impression of their respective trademarks, the differences in commercial identities of the respective companies, and the history of co-existence of the respective trademarks in the U.S. marketplace, said marks can continue to co-exist in the marketplace and should be allowed to co-exist on the U.S. trademark register." A Copy of the Agreement is submitted herewith. Accordingly, in accordance with the Agreement, and in accordance with In re E. I. DuPont de Nemors & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), it is requested that the refusal of registration be withdrawn and that the present application be approved for publication.

Respectfully submitted,



Stephen P. McNamara
Attorney for Applicant
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155

CONSENT AGREEMENT

This CONSENT AGREEMENT is made by and between **SHELTERED WINGS, INC.**, a Wisconsin corporation, with a business address of 2120 W. Greenview Drive #4, Middleton, Wisconsin 53562, U.S.A. [hereinafter "the Applicant"], and **NIKON CORPORATION**, a Japanese corporation, with a business address of 2-3, Marunouchi 3-Chome, Chiyoda-ku, Tokyo 100, Japan [hereinafter "the Registrant"].

WHEREAS, the Applicant has used the words "**EAGLE OPTICS**" as a service mark for mail order services in the field of optical products and has applied to register said words in the United States Patent and Trademark Office as a trademark for "binoculars, spotting scopes, and telescopes, all for use in bird watching, and storage cases therefor", in Int'l. Class 9, Application Ser. No. 78/029,311, filed October 5, 2000, with an alleged date of first use of January 1, 1996; and

WHEREAS, the Registrant owns the trademark "**EAGLEVIEW**" in the United States of America, and has registered said trademark under Reg. No. 2,084,361, dated July 29, 1997, in respect of "binoculars" in Int'l. Class 9, with an alleged date of first use of November 30, 1996; and

WHEREAS, the Registrant's registration of the trademark "**EAGLEVIEW**" has been cited by a United States Patent and Trademark Office Examining Attorney as a bar to registration of the Applicant's trademark "**EAGLE OPTICS**"; and

WHEREAS, the parties believe that as a result of the differences in meaning and commercial impression of their respective trademarks, the differences in commercial identities of the respective companies, and the history of co-existence of the respective trademarks in the U.S.

96984 v 2

SW00346

marketplace, said marks can continue to co-exist in the marketplace and should be allowed to co-exist on the U.S. trademark register, subject to the following terms and conditions;

NOW, THEREFORE, the parties hereby agree as follows:

1) The Applicant acknowledges that the Registrant is the owner of the trademark "EAGLEVIEW" for the goods set forth in the aforementioned U.S. trademark registration owned by the Registrant, and the Applicant agrees to refrain from taking any action or filing any proceeding, legal or otherwise, that will hinder the Registrant in its use or registration of the word "EAGLEVIEW" as, or as part of, a trademark for said goods, or any other goods or services.

2) The Registrant agrees to refrain from taking any action or filing any proceeding, legal or otherwise, that will hinder the Applicant in its use or registration of the trademark "EAGLE OPTICS" in conjunction with "binoculars, spotting scopes, and telescopes, all for use in bird watching, and storage cases therefor", or for related bird watching and outdoor products, unless said trademark is abandoned by the Applicant. The Registrant further acknowledges the right of the Applicant to continue its use of the words "EAGLE OPTICS" as a service mark for mail order and/or retail services in the field of bird watching and outdoor products, and optical products, as long as said words are not used in any manner which is likely to suggest that the Applicant is sponsored by the Registrant or is more than an independent re-seller and authorized dealer in the Registrant's goods.

3) The Applicant shall be entitled to file a copy of this agreement in the United States Patent and Trademark Office as evidence of the Registrant's affirmative consent to registration of the Applicant's trademark "EAGLE OPTICS" for the goods set forth in Paragraph No. 2, *supra*.

4) Simultaneously with the execution of this agreement, the Applicant will make a payment to the Registrant of \$ 9.00. The Applicant shall bear its own costs and attorneys' fees relating to the negotiation, execution and performance of the agreement.

5) This agreement shall be effective solely in the United States of America.

6) This agreement may not be amended or terminated except by an instrument in writing, signed by both parties hereto.

7) This agreement shall inure to the benefit of and be binding upon the successors, related companies and assigns of the parties hereto.

8) This agreement does not create a partnership or joint venture between the parties hereto.

9) In the event that any trade or consumer confusion caused by the permitted use or registration of the aforementioned trademarks is brought to the attention of either of the parties hereto, they shall promptly consult with one another and take whatever steps may be reasonably necessary or desirable, and mutually agreeable, to prevent any further occurrence of confusion.

WHEREFORE, the parties have caused this agreement to be executed by their duly-authorized undersigned officers.

SHELTERED WINGS, INC.

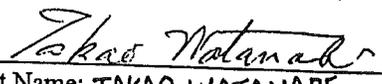
By 

Print Name: DANIEL C. HAMLIN

Title: PRESIDENT

Dated: 7/7/2013

NIKON CORPORATION

By 

Print Name: TAKAO WATANABE

Title: Executive Officer Vice-President

Dated: 2 July 2013

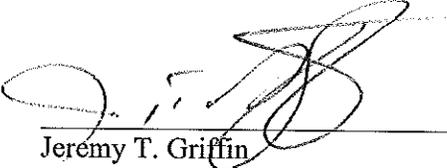
5. Other than Sheltered Wings' contention, there has been no actual confusion concerning the source of Wohali's STEEL EAGLE mark. Wohali has never been informed by anyone of any confusion concerning Wohali's STEEL EAGLE mark.

6. The only similarity between Wohali's mark (STEEL EAGLE) and any of the 5 marks identified on page 2 of the Petition for Cancellation (GOLDEN EAGLE, STRIKE EAGLE and/or EAGLE OPTICS) is that each includes the term "Eagle".

7. The purchase of optics is a careful, thought out process. Rifle scopes and binoculars are expensive items, generally costing at least one hundred dollars, and often times are much more expensive. This is not an impulse purchase.

I, Jeremy T. Griffin, hereby declare, state and verify under penalty of perjury that the above and foregoing statements are true and correct.

Executed this 20th day of July, 2012.



Jeremy T. Griffin

1637-5:mh

432 F.3d 463, 77 U.S.P.Q.2d 1515
(Cite as: 432 F.3d 463)



United States Court of Appeals,
Third Circuit.
* FREEDOM CARD, INC.; Urban Television Net-
work, Inc., Appellants
v.
JPMORGAN CHASE & CO.; Chase Manhattan Bank
USA, N.A. (Dist. of DE No. 03-cv-00432)
Chase Manhattan Bank USA, N.A.
v.
Urban Television Network, Inc.; Freedom Card, Inc.,
Appellants
v.
JPMorgan Chase Bank; JPMorgan Chase & Co., Third
Party Defendants (Dist. of DE No. 03-cv-00217).
* (Amended Per Clerk's Order Dated 12/2/04)

Nos. 04–3874, 04–3876, 04–4285.
Argued Sept. 15, 2005.
Opinion filed Dec. 22, 2005.

Background: Credit card issuer sought declaration that it's "Chase Freedom" card was not infringing competitor's "Freedom Card" trademark. The United States District Court for the District of Delaware, [Kent A. Jordan, J.](#), [333 F.Supp.2d 239](#), granted summary judgment for issuer, and competitor appealed.

Holding: The Court of Appeals, [McKee](#), Circuit Judge, held that issuer's mark was not likely to cause reverse consumer confusion.

Affirmed.

West Headnotes

[\[1\]](#) Trademarks 382T 1420

[382T](#) Trademarks
[382TVIII](#) Violations of Rights
[382TVIII\(A\)](#) In General
[382Tk1418](#) Practices or Conduct Prohibited
in General; Elements
[382Tk1420](#) k. Unfair competition. [Most Cited Cases](#)

Trademarks 382T 1421

[382T](#) Trademarks
[382TVIII](#) Violations of Rights
[382TVIII\(A\)](#) In General
[382Tk1418](#) Practices or Conduct Prohibited
in General; Elements
[382Tk1421](#) k. Infringement. [Most Cited Cases](#)

To prove either trademark infringement or unfair competition, in violation of Lanham Act, plaintiff must show that: (1) mark is valid and legally protectable; (2) mark is owned by plaintiff; and (3) defendant's use of mark is likely to create confusion concerning origin of goods or services. Lanham Trade-Mark Act, §§ 32(1), 43(a), [15 U.S.C.A. §§ 1114\(1\), 1125\(a\)](#).

[\[2\]](#) Trademarks 382T 1084

[382T](#) Trademarks
[382TIII](#) Similarity Between Marks; Likelihood of Confusion
[382Tk1083](#) Nature of Confusion
[382Tk1084](#) k. In general. [Most Cited Cases](#)

Trademarks 382T 1085

[382T](#) Trademarks
[382TIII](#) Similarity Between Marks; Likelihood of Confusion
[382Tk1083](#) Nature of Confusion
[382Tk1085](#) k. Extent or degree of confusion. [Most Cited Cases](#)

"Likelihood of confusion," for purpose of establishing trademark infringement claim, exists when consumers viewing mark would probably assume that product or service it represents is associated with source of different product or service identified by similar mark; relevant inquiry is not whether consumer confusion is possibility, but whether confusion is likely.

432 F.3d 463, 77 U.S.P.Q.2d 1515
(Cite as: 432 F.3d 463)

[3] Trademarks 382T 1084

[382T Trademarks](#)

[382TIII](#) Similarity Between Marks; Likelihood of Confusion

[382Tk1083](#) Nature of Confusion

[382Tk1084](#) k. In general. [Most Cited Cases](#)

Essence of “direct confusion” trademark infringement claim is that junior user of mark attempts to free-ride on reputation and goodwill of senior user by adopting similar or identical mark.

[4] Trademarks 382T 1081

[382T Trademarks](#)

[382TIII](#) Similarity Between Marks; Likelihood of Confusion

[382Tk1081](#) k. Factors considered in general.

[Most Cited Cases](#)

Factors court considers when determining likelihood of confusion in direct confusion trademark infringement case include: (1) degree of similarity between asserted and accused marks; (2) strength of asserted mark; (3) price of marked goods and other factors indicative of care and attention expected of consumers when making purchase; (4) length of time defendant has used accused mark without evidence of actual confusion arising; (5) intent of defendant in adopting accused mark; (6) evidence of actual confusion; (7) whether goods, competing or not, are marketed through same channels of trade and advertised through same media; (8) extent to which targets of parties' sales efforts are same; (9) relationship of marked goods in minds of consumers because of similarity of function; and (10) other factors suggesting that consuming public might expect plaintiff to manufacture product in defendant's market, or that he is likely to expand into that market.

[5] Trademarks 382T 1089

[382T Trademarks](#)

[382TIII](#) Similarity Between Marks; Likelihood of Confusion

[382Tk1083](#) Nature of Confusion

[382Tk1089](#) k. “Reverse” confusion. [Most Cited Cases](#)

“Reverse confusion” trademark infringement occurs when larger, more powerful company uses trademark of smaller, less powerful senior owner and thereby causes likely confusion as to source of senior user's goods or services.

[6] Trademarks 382T 1089

[382T Trademarks](#)

[382TIII](#) Similarity Between Marks; Likelihood of Confusion

[382Tk1083](#) Nature of Confusion

[382Tk1089](#) k. “Reverse” confusion. [Most Cited Cases](#)

Doctrine of “reverse confusion” trademark infringement is designed to prevent larger, more powerful company usurping business identity of smaller senior user.

[7] Trademarks 382T 1089

[382T Trademarks](#)

[382TIII](#) Similarity Between Marks; Likelihood of Confusion

[382Tk1083](#) Nature of Confusion

[382Tk1089](#) k. “Reverse” confusion. [Most Cited Cases](#)

Factors court considers when determining likelihood of confusion in reverse confusion trademark infringement case include: (1) degree of similarity between asserted and accused marks; (2) strength of asserted and accused marks; (3) price of marked goods and other factors indicative of care and attention expected of consumers when making purchase; (4) length of time defendant has used accused mark without evidence of actual confusion arising; (5) intent of defendant in adopting accused mark; (6) evidence of actual confusion; (7) whether goods, competing or not, are marketed through same channels of trade and advertised through same media; (8) extent to which targets of parties' sales efforts are same; (9) relationship of marked goods in minds of consumers, whether because of near-identity of products, similarity of function, or other factors; and (10) other factors suggesting that consuming public might expect larger, more powerful company to manufacture both products, or expect larger company to manufacture product in plaintiff's market, or expect that larger company is

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likely to expand into plaintiff's market.

[8] Trademarks 382T 1082

[382T Trademarks](#)

[382TIII](#) Similarity Between Marks; Likelihood of Confusion

[382Tk1082](#) k. Miscellaneous particular cases; determinations based on multiple factors. [Most Cited Cases](#)

(Formerly 382Tk1096(3))

Trademarks 382T 1089

[382T Trademarks](#)

[382TIII](#) Similarity Between Marks; Likelihood of Confusion

[382Tk1083](#) Nature of Confusion

[382Tk1089](#) k. “Reverse” confusion. [Most Cited Cases](#)

Credit card issuer's use of “Chase Freedom” mark for its card was not likely to cause reverse consumer confusion, and thus did not infringe competitor's “Freedom Card” trademark; competitor had stopped marketing its card more than one year before issuer entered market, issuer stopped marketing its card when competitor raised infringement concerns, competitor's mark was inherently and commercially weak, parties' cards were targeted at different consumer groups, anecdotal evidence of actual confusion was de minimis, and there was no evidence issuer intended to push competitor out of market. Lanham Trade-Mark Act, §§ 32(1), 43(a), [15 U.S.C.A. §§ 1114\(1\), 1125\(a\)](#).

[9] Trademarks 382T 1610

[382T Trademarks](#)

[382TIX](#) Actions and Proceedings

[382TIX\(C\)](#) Evidence

[382Tk1601](#) Presumptions and Burden of Proof

[382Tk1610](#) k. Knowledge, intent, and motive; bad faith. [Most Cited Cases](#)

It is improper to draw inference of bad faith intent from trademark infringement defendant's assertion of attorney-client privilege when asked about reasons for adopting accused mark.

Trademarks 382T 1800

[382T Trademarks](#)

[382TXI](#) Trademarks and Trade Names Adjudicated

[382Tk1800](#) k. Alphabetical listing. [Most Cited Cases](#)

Chase Freedom.

Trademarks 382T 1800

[382T Trademarks](#)

[382TXI](#) Trademarks and Trade Names Adjudicated

[382Tk1800](#) k. Alphabetical listing. [Most Cited Cases](#)

Freedom Card.

*[465 Dana M. Campbell](#), (Argued), Owens, Clary & Aiken, L.L.P., Dallas, Texas, for Appellants.

[Ethan Horwitz](#), (Argued), [Leonard F. Lesser](#), [Kandis M. Koustenis](#), Goodwin Procter LLP, New York, New York, [Richard D. Allen](#), Morris, Nichols, Arsht & Tunnell, Wilmington, DE, for Appellees.

Before [ROTH](#), [MCKEE](#) and [FISHER](#), Circuit Judges.

OPINION

[MCKEE](#), Circuit Judge.

Urban Television Network, Inc (“UTN”) ^{FN1} appeals from the district court's grant of summary judgment on the “reverse confusion” trademark infringement and unfair competition claims UTN brought against Chase. ^{FN2} UTN asserted those claims in counterclaims it filed in response to Chase's declaratory judgment action. Chase filed that action to obtain a judicial declaration that its CHASE FREEDOM credit card did not violate any rights UTN had in its FREEDOM CARD trademark. ^{FN3} The district court ruled that Chase had not violated UTN's trademark, *[466](#) and this appeal followed. For the reasons that follow, we will affirm. ^{FN4}

^{FN1} UTN” refers to Urban Television Network, Inc., and Freedom Card, Inc., both of which are Delaware corporations with their principal place of business in Califor-

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nia. UTN owns U.S. Trademark Registration Nos. 2,398,191 and 2,398,192 for “FREEDOM CARD” in International Class 36 for credit card services and in International Class 16 for credit cards, respectively. Freedom Card, Inc., is the exclusive licensee of the FREEDOM CARD marks.

[FN2.](#) “Chase” refers to JP Morgan Chase Bank and Chase Manhattan Bank, USA, NA, and J.P. Morgan Chase & Co. JP Morgan Chase Bank and Chase Manhattan Bank, USA, NA, are wholly owned subsidiaries of J.P. Morgan Chase & Co.

[FN3.](#) In referring to the trademarks at issue in this case, we will use all upper case letters as the district court did. The district court also noted that “[t]here is some disagreement between [UTN and Chase] as to whether Chase’s allegedly infringing mark is ‘CHASE FREEDOM’ or ‘CHASE FREEDOM card.’ ” However, the court concluded that “the word ‘card’ in this context is descriptive.... Therefore, the inclusion or exclusion of the word ‘card’ as part of Chase’s allegedly infringing mark does not impact the conclusion reached herein.” [Chase Manhattan Bank, U.S.A. v. Freedom Card, Inc., 333 F.Supp.2d 239, 244 n. 10 \(D.Del.2004\)](#). We agree. Moreover, UTN does not suggest the district court erred in analyzing its claim in that context.

[FN4.](#) Although UTN filed notices of appeal from each of the district court’s original and clarifying orders, UTN’s appellate arguments are limited to the district court’s grant of summary judgment to Chase. We have plenary review of the district court’s grant of summary judgment. [Lucent Info. Mgmt., Inc. v. Lucent Techs., Inc., 186 F.3d 311, 315 \(3d Cir.1999\)](#).

I. BACKGROUND

In December 2000, UTN began offering its FREEDOM CARD in conjunction with CompuCredit Corporation. The FREEDOM CARD was offered to extend credit and financial services to the “sub-prime” credit market that is disproportionately comprised of African-American consumers. UTN focused its

promotional efforts on “people who [had] bad credit or [had] filed bankruptcy recently and [were] looking to start all over.” [Chase Manhattan Bank, USA v. Freedom Card, Inc. 333 F.Supp.2d 239, 242 \(D.Del.2004\)](#). UTN entered into a contract with Queen Latifah, a prominent African American entertainer, as part of its efforts to promote the FREEDOM CARD. The majority of FREEDOM CARD customers had credit lines of \$300. On average, they were charged annual fees and interest amounting to 140% over and above their principal balance. [Id.](#)^{FN5} CompuCredit stopped marketing and issuing new accounts for the FREEDOM CARD card after December 2001. [Id. at 242 n. 4](#). The district court found, FREEDOM CARD peaked at 28,193 accounts.

[FN5.](#) The exceedingly high rate of interest and fees meant that the average cardholder who charged a \$100 coat on his/her FREEDOM CARD would pay a total of \$240, \$100 for the coat and another \$140 in interest and fees.

For a number of years, Chase and Shell Oil Company had issued a co-branded credit card called “CHASE Shell MasterCard.” The card offered cash rewards on purchases of Shell gasoline. In March 2002, Shell notified Chase that it was terminating their relationship. Chase owned the Shell accounts and in order to retain those accounts it began developing a new credit card product that would serve existing accounts as well as generate new ones.

Chase’s research eventually lead to a rewards program that allowed Chase’s customers to use its card at any gasoline company’s filling station and receive rebates on gasoline as well as other purchases. Chase claims that it named the card “CHASE FREEDOM card,” because of the freedom it afforded cardholders to purchase gasoline wherever the cardholder chose. On January 11, 2003, Chase sent a letter to its Shell account holders notifying them that their Shell cards would be automatically converted to CHASE FREEDOM cards.

The CHASE FREEDOM card was officially announced in a January 27, 2003, advertisement in the *Wall Street Journal*, more than a year after the FREEDOM CARD card stopped being issued. “The CHASE FREEDOM card [was] a reissue of the CHASE Shell MasterCard.” [Chase, 333 F.Supp.2d at](#)

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[242](#). The CHASE FREEDOM portfolio consisted of approximately 1.5 million converted Shell accounts and fewer than 10,000 accounts acquired after the January 27, 2003 launch.

*[467](#) Chase maintains that the converted account holders were generally between the ages of 46 and 55, had a FICO [FN6](#) score of 800 or higher, owned their own homes, and were married with average annual incomes between \$40,000 and \$50,000. Of the acquired account holders, 80% owned their own home and 60% had a FICO score of 780 or higher. Chase claims that the majority of CHASE FREEDOM cardholders had credit lines of \$5,000—\$10,000, with no annual fee and an annual percentage rate of between 12.4% and 14.4%. *Id.*

[FN6](#). FICO refers to the Fair Isaac Corporation, which is the industry standard credit scoring system. FICO scores are based on a consumer's credit history. "The higher the FICO score, the more likely a consumer is to fulfill his credit obligations." *Chase*, 333 F.Supp.2d at 242 n. 6.

The *Wall Street Journal* advertisement for CHASE FREEDOM card was the only advertisement that ever appeared. Upon seeing the *Wall Street Journal* advertisement the day it first appeared, Wesley Buford, UTN's Chief Executive Officer, contacted Chase and complained that Chase was infringing UTN's FREEDOM CARD mark. *See* n. 1, *supra*. [FN7](#) After Buford objected, Chase immediately halted its advertising and marketing efforts for "CHASE FREEDOM," and refrained from acquiring any new customers. [FN8](#)

[FN7](#). Although Buford describes FREEDOM CARD's market as "sub-prime;" Chase alleges that FREEDOM CARD's customer base was actually "sub-sub-prime" as it consisted of the lowest end of the credit spectrum. According to Chase, prime customers usually have credit scores above 660 and sub-prime customers score below 660. However, Chase claims without contradiction that FREEDOM CARD focused on customers with credit scores below 580, well below the federal guidelines for sub-prime lending. *Chase*, 333 F.Supp.2d at 242.

[FN8](#). The only other reference to the CHASE FREEDOM card that appeared was a one-paragraph news article in *Newsweek* magazine, entitled "Pump Up A Rebate." Chase states that it neither initiated nor promoted that article. However, UTN claims that Chase booked 9,709 new accounts from January 27, 2003 through May 18, 2003, as a result of the *Newsweek* article.

Thereafter, representatives of Chase and UTN met to discuss the problem. Chase claims that discussions broke down after UTN threatened to "have people protesting around [Chase's] branches" and to have demonstrations calling attention to "the evils of Chase and this Freedom Mastercard [sic]" and thereby "cause [Chase] a great deal of harm." Appellees' Br. at 6. UTN claims that these meetings were "positive and friendly" rather than confrontational and, based upon prior positive communication between the parties and Chase's prompt cessation of CHASE FREEDOM card, Buford still believed that the matter could be resolved amicably. Appellants' Br. at 12. As a consequence of that belief, UTN claims that it maintained its relationship with Queen Latifah and even executed another commercial production agreement with her on February 19, 2003.

II. DISTRICT COURT PROCEEDINGS

On February 4, 2003, Chase filed the instant action in district court seeking a declaration that its use of the CHASE FREEDOM mark did not infringe any of UTN's rights in the FREEDOM CARD mark. UTN counterclaimed asserting third-party claims for trademark infringement in violation of [15 U.S.C. § 1114](#), [FN9](#) and *[468](#) unfair competition in violation of [15 U.S.C. § 1125\(a\)\(1\)\(A\)](#). [FN10](#) UTN also sought a determination that Chase was in violation of a 1999 Mutual Confidentiality Agreement between Chase and UTN. [FN11](#)

[FN9](#). Section 32(1) of the Lanham Act, covering trademark infringement, [15 U.S.C. § 1114\(1\)](#) provides:

Any person who shall, without the consent of the registrant -

(a) use in commerce any reproduction, counterfeit, copy or colorable imitation of a registered mark in connection with the

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sale, offering for sale, distribution, or advertising or any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; ... shall be liable in a civil action by the registrant....

[FN10](#). Section 43(a) of the Lanham Act, covering unfair competition, [15 U.S.C. § 1125\(a\)\(1\)\(A\)](#), provides, in relevant part:

Any person who, in connection with any goods or services, ... uses in commerce any word, term, name, symbol, or device, ... or any false designation of origin, which -

(A) is likely to cause confusion, or to cause mistake, or to deceive as to ... the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person ... shall be liable in a civil action by any person who believes that he or she is likely to be damaged by such act.

[FN11](#). The Confidentiality Agreement stems from communications between UTN and Chase when UTN was approaching numerous banks to explore possible affiliations for the FREEDOM CARD that it subsequently issued in conjunction with CompuCredit. The discussions between UTN and Chase ended without any agreement regarding the card.

At the close of discovery, Chase filed several motions including a motion for summary judgment on UTN's trademark infringement and unfair competition claims. The district court granted Chase's motion for summary judgment upon determining that there was no likelihood of confusion between "CHASE FREEDOM" and FREEDOM CARD. *See Chase Manhattan Bank, supra*. Thereafter, the district court issued another order clarifying that the prior order had disposed of all claims and that the judgment against UTN was therefore final. This appeal followed. [FN12](#)

[FN12](#). UTN has also filed a separate trademark infringement and unfair competition complaint against Chase in district court in New York. That action was enjoined and

later transferred to the District Court for the District of Delaware.

III. HISTORICAL CONTEXT.

As noted above, *see n.1, supra*, UTN relies upon two registrations of its FREEDOM CARD mark—Nos. 2,398,191 and 2,398,192. The United States Patent and Trademark Office ("USPTO") initially rejected UTN's applications for those marks because it was concerned about the likelihood of confusion with a prior registration of Parker Oil Company for the mark "Fuel Freedom Card." Parker also used that mark on a credit card. In order to overcome those concerns, UTN entered into a Consent Agreement with Parker Oil, and submitted that agreement to the USPTO. In the Agreement, UTN admitted there was no likelihood of confusion between "FREEDOM CARD" and "Fuel Freedom Card" because the marks "are dissimilar in appearance ... dissimilar in sound ... dissimilar in connotation ... dissimilar in commercial impression" and "when considered in their entirety are not likely to be confused" with one another. The USPTO accepted the Consent Agreement and granted the registrations to UTN. [Chase, 333 F.Supp.2d at 246](#).

UTN also submitted a one-inch thick exhibit of numerous other "freedom" marks in response to concerns the USPTO had with additional "freedom mark" registrations that UTN applied for. UTN argued that these marks, together with third-party marks cited by the USPTO, were "all existing together in the marketplace" and UTN therefore argued that "no one has the exclusive right to use the word 'FREEDOM' alone." *Id. at 246, n. 15*. In response to concerns that UTN's FREEDOM CARD would be confused with Parkers "Fuel Freedom Card," UTN also represented to the USPTO that, because of *469 such frequent third-party use, the addition of the descriptive term "fuel" "when used in conjunction with the FREEDOM CARD mark, eliminated concern that the marks FREEDOM CARD and FUEL FREEDOM CARD would be confusingly similar." *Id. at 246*.

Chase also provided the district court with substantial direct evidence of widespread, third-party use of the term "freedom." According to this undisputed evidence, there are approximately 20 MasterCard and VISA "freedom" credit cards and roughly 50 MasterCard and VISA "freedom" debit and ATM cards. There are also about 25 banks using "freedom" as part

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of their name or in connection with a banking product, as well as about 200 other financial companies that use “freedom” as part of their name.

UTN claims that CompuCredit approached it in October 2002, with an offer for the rights to the FREEDOM CARD name, and that CompuCredit's offer was then valued at \$15 million. UTN maintains that the parties were close to resolving a few remaining issues and expected to execute the agreements at the end of January 2003. However, according to UTN, the negotiations between it and CompuCredit were interrupted by the introduction of the CHASE FREEDOM card on January 27, 2003. UTN contends that after the introduction of the CHASE FREEDOM card, CompuCredit believed that consumer confusion would depress the value of the FREEDOM CARD mark. Therefore, CompuCredit allegedly refused to proceed with UTN because it did not have the resources to compete with Chase. Thus, in UTN's view, given the strength of the “CHASE” mark, and Chase's resources, the introduction of the CHASE FREEDOM card effectively stifled any effort to close the transaction with CompuCredit or to market UTN's product with any other institution that had expressed interest.^{FN13}

^{FN13} In disputing that the CHASE FREEDOM card destroyed UTN's opportunity to consummate the deal with CompuCredit, Chase relies upon deposition testimony from Dennis James of CompuCredit. He testified that after Chase's *Wall Street Journal* advertisement for CHASE FREEDOM, CompuCredit was still prepared to close the transaction on the same basis as before. Chase contends that UTN admitted that the real reason that the CompuCredit deal did not go forward was because UTN wanted too much money from CompuCredit. Buford testified that UTN turned down CompuCredit's offer because UTN wanted an additional \$5 million, and Chase correctly argues that UTN cannot so easily distance itself from Buford's deposition despite its rather intense efforts to do so. See Fed.R.Civ.P. 30(b)(6).

According to UTN, Chase converted 1,506,070 Shell accounts to their new CHASE FREEDOM card. In addition, UTN claims that, although Chase

launched a new CHASE PERFECTCARD in May 2003, purportedly to replace the Freedom card, Chase did not remove existing CHASE FREEDOM cards from the market.

IV. GENERAL PRINCIPLES.

[1] “The Lanham Act defines trademark infringement as use of a mark so similar to that of a prior user as to be ‘likely to cause confusion, or to cause mistake, or to deceive.’” *Kos Pharmaceuticals, Inc., v. Andrx Corp.*, 369 F.3d 700, 711 (3d Cir., 2004) (quoting 15 U.S.C. § 1114(1)). Thus, “[t]he law of trademark protects trademark owners in the exclusive use of their marks when use by another would be likely to cause confusion.” *Fisons Horticulture, Inc. v. Vigoro Industries, Inc.*, 30 F.3d 466, 472 (3d Cir.1994) (citations omitted). Although *Fisons Horticulture* involved trademarks, not ... unfair***470** competition, [as UTN alleges as part of its counterclaim here,] the analysis is the same. See *A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 166 F.3d 197, 202 (3d Cir.1999) (“*A & H III*”). “To prove either form of Lanham Act violation, a plaintiff must show that: (1) the mark is valid and legally protectable; (2) the mark is owned by the plaintiff; and (3) the defendant's use of the mark is likely to create confusion concerning the origin of the goods or services.”^{FN14} *Id.* Because it is undisputed that UTN owns FREEDOM CARD, a valid and legally protectable mark, “the questions in this case involve the delineation and application of standards for the evaluation of likelihood of confusion.” *A & H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 211 (3d Cir.2000) (“*A & H V*”).

^{FN14} Of course, the plaintiff bears the burden of proof. See *American Home Prods. Corp. v. Barr Labs., Inc.*, 834 F.2d 368, 371 (3d Cir.1987). UTN was the named defendant in Chase's declaratory action. However, because UTN filed counterclaims and third-party claims against Chase for trademark infringement and unfair competition, UTN is treated as the plaintiff in this appeal of the district court's dismissal of those claims.

[2] “A likelihood of confusion exists when consumers viewing the mark would probably assume that the product or service it represents is associated with the source of a different product or service identified

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by a similar mark.” *Id.* (citation and internal quotations omitted). The relevant inquiry is not whether consumer confusion is a possibility, but whether confusion is likely. *A & H V*, 237 F.3d at 198. Once a trademark owner demonstrates likelihood of confusion, it is entitled to injunctive relief. *Interpace Corp. v. Lapp, Inc.* 721 F.2d 460, 462 (3d Cir.1983) (citing 15 U.S.C. § 1114(1)).

There are two types of “likelihood of confusion” claims—“direct confusion” claims and “reverse confusion” claims. As we noted at the outset, we are primarily concerned with a claim of reverse confusion because that is how UTN argues this appeal. Although direct confusion and reverse confusion have developed as two separate doctrines, they are not as analytically distinct as may, at first blush, appear. “Isolated instances of direct confusion may occur in a reverse confusion case, and vice-versa.” *Checkpoint Systems, Inc., v. Check Point Software*, 269 F.3d 270, 305 (3d Cir.2001) (citation omitted). Accordingly, although we are resolving UTN’s claim of reverse confusion, we can not ignore the doctrine of direct confusion.

A. Direct Confusion

[3] The essence of a direct confusion claim is that a junior user of a mark attempts to free-ride on the reputation and goodwill of the senior user by adopting a similar or identical mark. *A & H V*, 237 F.3d at 228; see also *Fisons Horticulture*, 30 F.3d at 474 (In a direct confusion claim, “the new or junior user of the mark will use to its advantage the reputation and goodwill of the senior user by adopting a similar or identical mark.”); *Checkpoint Systems*, 269 F.3d at 301. Thus, “the consuming public may assume that the established, senior user is the source of the junior user’s goods.” *Id.*

[4] In deciding whether similar marks create a likelihood of confusion, we have adopted a non-exhaustive test using 10 factors that have come to be known as the “*Lapp* factors,”^{FN15} for determining the likelihood of confusion between two marks where direct confusion is alleged. Pursuant to that analysis, we examine:

^{FN15}. The factors are named for the case in which they were developed, viz., *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460 (3d Cir.1983).

*471 (1) the degree of similarity between the owner’s mark and the alleged infringing mark;

(2) the strength of the owner’s mark;

(3) the price of the goods and other factors indicative of the care and attention expected of consumers when making a purchase;

(4) the length of time the defendant has used the mark without evidence of actual confusion arising;

(5) the intent of the defendant in adopting the mark;

(6) the evidence of actual confusion;

(7) whether the goods, though not competing, are marketed through the same channels of trade and advertised through the same media;

(8) the extent to which the targets of the parties’ sales efforts are the same;

(9) the relationship of the goods in the minds of consumers because of the similarity of function;

(10) other factors suggesting that the consuming public might expect the prior owner to manufacture a product in the defendant’s market, or that he is likely to expand into that market.

Interpace Corp. v. Lapp, Inc., 721 F.2d 460, 463 (3d Cir.1983) (citation omitted). The *Lapp* factors were originally used to determine likelihood of confusion for non-competing goods. *Id.* at 462. Where goods that were the subject of a trademark infringement action directly competed with each other, we originally held that a “court need rarely look beyond the mark itself” to determine likelihood of confusion. *Id.* However, we have since held that the *Lapp* factors should be used for both competing and non-competing goods. *A & H V*, 237 F.3d at 213. In either event, “the *Lapp* test is a qualitative inquiry. Not all factors will be relevant in all cases; further, the different factors may properly be accorded different weights depending on the particular factual setting. A district court should utilize the factors that seem appropriate to a given situation.” *Id.* at 215.^{FN16}

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[FN16](#). We have instructed that, if a district court decides that certain of the [Lapp](#) factors do not advance its analysis, it should explain the reason for not using those factors in order to facilitate our review. [A & H V, 237 F.3d at 215 n. 8](#).

B. Reverse Confusion

[\[5\]](#) We first recognized Lanham Act Section 43(a) reverse confusion claims in [Fisons Horticulture](#). “Reverse confusion occurs when a larger, more powerful company uses the trademark of a smaller, less powerful senior owner and thereby causes likely confusion as to the source of the senior user’s goods or services.” [Fisons Horticulture, 30 F.3d at 474](#). Thus, the “junior” user is junior in time but senior in market dominance or size.

In reverse confusion, the junior user saturates the market with a similar trademark and overwhelms the senior user. The public comes to assume the senior user’s products are really the junior user’s or that the former has become somehow connected to the latter. The result is that the senior user loses the value of the trademark—its product identity, corporate identity, control over its goodwill and reputation, and ability to move into new markets.

Without the recognition of reverse confusion, smaller senior users would have little protection against larger, more powerful companies who want to use identical or confusingly similar trademarks. The logical consequence of failing to recognize reverse confusion would be the immunization from unfair competition liability of a company with a well established trade name and with the economic power to advertise extensively *472 for a product name taken from a competitor. If the law is to limit recovery to passing off, anyone with adequate size and resources can adopt any trademark and develop a new meaning for the trademark as identification of the second user’s products.

[Fisons Horticulture, at 474–75](#) (citations and internal brackets omitted). [FN17](#)

[FN17](#). Although we have recognized reverse confusion claims, we have, nonetheless, noted the problems inherent in such claims.

The chief danger inherent in recognizing reverse confusion claims is that innovative junior users, who have invested heavily in promoting a particular mark, will suddenly find their use of the mark blocked by plaintiffs who have not invested in, or promoted, their own marks. Further, an overly-vigorous use of the doctrine of reverse confusion could potentially inhibit larger companies with established marks from expanding their product lines.

[A & H V, 237 F.3d at 228](#) (citations omitted).

[\[6\]](#) Thus, “the doctrine of reverse confusion is designed to prevent ... a larger, more powerful company usurping the business identity of a smaller senior user.” [Commerce National Ins., v. Commerce Insurance Agency, Inc., 214 F.3d 432, 445 \(3d Cir.2000\)](#).

As noted above, UTN presents its Lanham Act Section 43(a) unfair competition claim as a reverse confusion claim. In [A & H V](#), we held that in a typical case alleging reverse confusion, as in a case of direct confusion, a court should apply the [Lapp](#) factors in assessing likelihood of confusion. [237 F.3d at 208](#). However, economic reality and common sense require that some of the [Lapp](#) factors be analyzed differently when reverse discrimination is at issue. [Id. at 236](#). Thus, the strength of the parties’ marks ([Lapp](#) factor (2)), the intent in adopting the marks (factor (5)), and the evidence of actual confusion (factor (6)), are analyzed differently from the method employed in a typical direct confusion case.^{[FN18](#)} [Id. at 236](#). With these parameters in mind, we turn to the instant dispute.

[FN18](#). Application of [Lapp](#) factors (3), (7), (8) and (9) is typically the same in both direct confusion and reverse confusion cases. [A & H V, 237 F.3d at 236](#). In addition, absent the presence of housemarks and disclaimers, the similarity of the marks (factor (1)) should generally be examined in a similar fashion in both direct and reverse confusion cases. [Id.](#)

(I). Strength of the mark.

In evaluating the strength of the mark under [Lapp](#), we examine: (1) the mark’s distinctiveness or conceptual strength (the inherent features of the mark) and

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(2) its commercial strength (factual evidence of marketplace recognition). *A & H V*, 237 F.3d at 221. The inquiry into distinctiveness or conceptual strength is the same whether plaintiff is alleging direct or reverse confusion. *Id.* at 231–32 (“When it comes to conceptual strength ... we believe that, just as in direct confusion cases, a strong mark should weigh in favor of a senior user.”). The conceptual strength of a mark is measured by classifying the mark in one of four categories ranging from the strongest to the weakest: “(1) arbitrary or fanciful (such as “KODAK”); (2) suggestive (such as “COPPERTONE”); (3) descriptive (such as “SECURITY CENTER”); and (4) generic (such as “DIET CHOCOLATE FUDGE SODA”).” *Id.* at 221. Stronger marks receive greater protection. *Id.* at 222.

In examining a mark's commercial strength, we examine marketplace recognition. *Id.* at 221. “[I]n a reverse confusion claim, a court should analyze the ‘commercial strength’ factor in terms of (1) the commercial strength of the junior user as compared to the senior user; and (2) any advertising or marketing campaign by the junior user that has resulted in a saturation in the public awareness of the junior user's mark.” *Id.* at 231. Our focus in *473 resolving reverse confusion should be the commercial impact of the stronger junior user's mark on the weaker mark of the senior but less dominant user.

(ii). Intent in Adopting the Mark.

In a direct confusion case, the defendant's intent to confuse or deceive consumers can be very probative of the likelihood of confusion. *Id.* at 232. Nevertheless, a defendant's intent to confuse in a reverse confusion case can also be relevant to the likelihood of confusion. *Id.* However, the tenor of the evidence of intent will differ. In a true case of direct confusion, there is an intent to palm-off or ride on the goodwill of the senior user's mark. *Id.* at 225–26. The offender in a reverse confusion case will typically exploit confusion to push the senior user out of the market. *Id.* at 232.

(iii). Evidence of Actual Confusion.

“[O]ne might assume evidence that the public thought that the senior user was the origin of the junior user's products would support a direct confusion claim while evidence that the public thought that the junior user was the source of the senior user's product would support a reverse confusion claim.” *Checkpoint Systems*, 269 F.3d at 305 n. 34 (citing *A & H V*, 237 F.3d at 233). However, as noted earlier, because the

“manifestation of consumer confusion as ‘direct’ or ‘reverse’ may merely be a function of the context in which the consumer first encountered the mark ... [i]solated instances of ‘direct’ confusion may occur in a reverse confusion case, and vice-versa.” *A & H V*, 237 F.3d at 233. Therefore, there is no strict prohibition against using “direct” confusion evidence in a “reverse” confusion case, or vice-versa. *Id.*

(iv). Summary of test for reverse confusion.

[7] In *A & H V*, we summarized the test for reverse confusion as follows:

[I]n the typical case in which there is a claim of reverse confusion, a court should examine the following factors [in determining] whether or not there is a likelihood of confusion:

- (1) the degree of similarity between the owner's mark and the alleged infringing mark;
- (2) the strength of the two marks, weighing both a commercially strong junior user's mark and a conceptually strong senior user's mark in the senior user's favor;
- (3) the price of the goods and other factors indicative of the care and attention expected of consumers when making a purchase;
- (4) the length of time the defendant has used the mark without evidence of actual confusion arising;
- (5) the intent of the defendant in adopting the mark;
- (6) the evidence of actual confusion;
- (7) whether the goods, competing or not competing, are marketed through the same channels of trade and advertised through the same media;
- (8) the extent to which the targets of the parties' sales efforts are the same;
- (9) the relationship of the goods in the minds of consumers, whether because of the near-identity of the products, the similarity of function, or other factors;

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(10) other facts suggesting that the consuming public might expect the larger, more powerful company to manufacture both products, or expect the larger company to manufacture a product in the plaintiff's market, or expect that the *474 larger company is likely to expand into the plaintiff's market.

[237 F.3d at 234.](#)

Here again, “no one factor is dispositive.” The weight given each factor can vary with the circumstances of a particular case. *Id.* (citation and internal quotations omitted).

V. DISCUSSION

[8] UTN's underlying contention before us is that the district court did not properly apply the *Lapp* factors in the context of its reverse confusion claim. It is true that the district court's opinion does not contain the phrase “reverse confusion,” and the district court only cites the *Lapp* factors as they are applied to direct confusion claims. [333 F.Supp.2d at 245.](#) In UTN's view, this means that we must reverse and remand for a correct analysis of the *Lapp* factors to UTN's claim.

At first blush, there is some support for UTN's position. In *A & H V*, we said:

Because the District Court failed to undertake the *Lapp* analysis with respect to A & H Sportswear's reverse confusion claim, we must vacate the judgment and remand to the District Court for a redetermination of those factors that receive different treatment under direct and reverse confusion theories, and for a reweighing of all of the factors once those redeterminations have been made.

[237 F.3d at 236.](#) However, a closer reading of *A & H V* establishes that we did not create a bright-line rule requiring reversal and remand whenever a district court fails to properly apply the *Lapp* factors. Rather, we there explained:

The District Court interpreted our precedents to require a two-step inquiry, engaging in the *Lapp* factors only after an initial assessment that the disparity in commercial strength reached a high threshold. Because the degree of commercial disparity that the court believed was required was not met, the court did not even examine whether there existed a likelihood of confusion.

Id. at 208. Indeed, we noted in *A & H V* that if the record supported a finding that the plaintiff could not succeed on a reverse confusion claim as a matter of law, we would “be bound to explicate our reasoning and affirm the judgment of the district court.” *Id.* at 236. Moreover, it is a long-established principle of appellate review, that “we may affirm a correct decision of the district court on grounds other than those relied upon by the district court.” *Central Pennsylvania Teamsters Pension Fund v. McCormick Dray Line, Inc.*, 85 F.3d 1098, 1107 (3d Cir.1996). Thus, the district court's purported failure to apply the *Lapp* factors does not necessarily mandate reversal and remand.

Moreover, we have serious doubts that UTN's claim is really a claim of reverse confusion to begin with. The essence of reverse confusion is that the more powerful junior user saturates the market with a similar trademark and overwhelms the smaller senior user. *Fisons*, 30 F.3d at 474. The “relatively large advertising and promotion of the junior user ... is the hallmark of a reverse confusion case.” *A & H V*, 237 F.3d at 231 (quoting 3 J. Thomas McCarthy, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 23–10, at 23–37). “The question ... is whether consumers doing business with the senior user might mistakenly believe that they are dealing with the junior user.” *Checkpoint Systems*, 269 F.3d, at 303 (internal quotation marks omitted).

Here, Chase did not overwhelm UTN's FREEDOM CARD at all. It is undisputed that CompuCredit FREEDOM CARD was not promoted or marketed after December 2001. Thus, FREEDOM CARD was out of the market for more than a year before Chase launched the CHASE *475 FREEDOM card on January 27, 2003. We are therefore hard-pressed to understand how CHASE FREEDOM card could have overwhelmed UTN's FREEDOM CARD when FREEDOM CARD was not even participating in the market when CHASE FREEDOM was launched. Moreover, any claim that Chase heavily promoted and advertised CHASE FREEDOM card and thereby overwhelmed UTN's FREEDOM CARD via marketing and promotion would be fanciful at best. On the contrary, Chase published a single advertisement for CHASE FREEDOM in a single publication on a single day. Chase thereafter stopped its marketing and advertising efforts once it was contacted by Buford of

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UTN. UTN attempts to extend Chase's marketing efforts by pointing to the aforementioned news article in *Newsweek* magazine that reported about the CHASE FREEDOM card. However, even if Chase is somehow deemed responsible for “planting” and/or exploiting that article, it would still only amount to an additional one-paragraph news item. Even when combined with the single advertisement in the *Wall Street Journal*, that would hardly support a claim that Chase created confusion in the market by overwhelming FREEDOM CARD, the senior mark.

Nevertheless, “if we were to create a rigid division between direct and reverse confusion evidence, we would run the risk of denying recovery to meritorious plaintiffs.” [A & H V, 237 F.3d at 233](#) (internal quotation marks omitted). Accordingly, despite real doubts about whether UTN's claim can properly be characterized as a claim of reverse confusion, we must nevertheless determine whether the district court properly applied the [Lapp](#) factors to it.

UTN contends that the district court failed to properly analyze the similarity of the marks; the strength of the marks; and any facts indicating that the parties will expand into each other's markets. UTN also contends that the district court erred in analyzing some of the remaining [Lapp](#) factors including: consumer care when making a purchase; actual confusion; and intent. We will therefore address each of those claims of error.

A. Similarity of the marks.

As we noted above, inquiry into similarity of the marks is the same in cases of reverse confusion and direct confusion. Here, Chase's FREEDOM card also includes the housemark “CHASE.” ^{FN19} Chase claims that any possible potential for confusion with UTN was substantially reduced because “CHASE” appears together with “FREEDOM” on the face of the card, and the district court agreed.

^{FN19}. A “housemark” is a company's corporate name. Eric J. Lubochinski, *Hegel's Secret: Personality and the Housemark Cases*, 52 *Emory L.J.* 489, 490 (2003).

The district court explained:

Given that Chase is a well-known provider of financial services, I agree that the inclusion of the

CHASE housemark with FREEDOM (or FREEDOM card), in connection with credit cards and credit card services is enough to lessen any likelihood of confusion between the two marks and render the CHASE FREEDOM and FREEDOM CARD marks dissimilar.

[333 F.Supp.2d at 246.](#)

The district court therefore concluded that the presence of Chase's housemark mitigated any potential for market confusion. However, UTN correctly argues that the junior user's housemark can aggravate reverse confusion by reinforcing the association of the trademark exclusively with the junior user to the detriment of *476 the smaller senior user. [A & H III, 166 F.3d at 230.](#) UTN believes that the district court ignored the fact that Chase's housemark reinforced consumers' association of “Freedom” exclusively with Chase, and therefore increased the likelihood of reverse confusion. We disagree.

The district court's holding was based partly on UTN's own admissions about the widespread commercial use of the word “freedom.” We have already explained that UTN made certain representations in connection with its two registrations for FREEDOM CARD. We have noted that the USPTO initially rejected UTN's applications because of the likelihood of confusion with Parker Oil's prior registration for its “Fuel Freedom Card,” and UTN responded by entering into a Consent Agreement with Parker Oil in which UTN and Parker Oil agreed that there was no likelihood of confusion between UTN's FREEDOM CARD and Parker's Fuel Freedom Card.

As we have also noted above, UTN overcame objections to additional “freedom” marks it applied for by submitting a one-inch thick exhibit of numerous other “freedom” marks to the USPTO. UTN argued that those marks, together with third-party marks cited by the USPTO, were “all existing together in the marketplace” and as a result, “no one has the exclusive right to use the word ‘FREEDOM’ alone.” UTN also represented that, because of such third-party use, the addition of the term “fuel” “creates a significantly different commercial impression than the cited registration [sic] and applications, and thus is not so similar as to preclude its registration.”

The district court viewed UTN's representations

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to the USPTO through the lens of judicial estoppel.^{FN20} [Chase, 333 F.Supp.2d at 246](#). Whether we view the district court's treatment of UTN's prior representations about the commercial availability of marks containing the word "freedom" as judicial estoppel, an admission, waiver, or simply hoisting UTN by its own petard, we agree with the district court's conclusion about the commercial impact of "freedom" in the two marks at issue here. Thus, UTN's own statements and actions, together with Chase's undisputed evidence of the widespread and common use of "freedom," undermine UTN's belated attempt to establish likelihood of confusion from the juxtaposition of "FREEDOM" and Chase's housemark. See [SquirtCo v. Tomy Corp., 697 F.2d 1038, 1043 \(Fed.Cir.1983\)](#).

^{FN20}. See [In re Chambers Development Co., 148 F.3d 214, 229 \(3d Cir.1998\)](#), for a discussion of judicial estoppel.

B. Strength of the marks.

In analyzing the strength of UTN's mark, the district court wrote:

UTN has not come forward with any evidence of the commercial strength of the FREEDOM CARD mark, i.e., the amount of money that it spent on advertising, whether it took any steps to increase public recognition of the FREEDOM CARD mark, and whether the public does, in fact, recognize the FREEDOM CARD mark. In fact, the evidence strongly indicates that there is no commercial strength to UTN's mark. At its peak, UTN had 28,193 cardholders. That was three years ago. UTN only issued cards for one year. Given these facts, it is hardly surprising that UTN has chosen to offer no evidence at all of commercial strength. There is none, and this factor weighs against a finding of likelihood of confusion.

[333 F.Supp.2d at 248](#). The district court also found that the conceptual strength of *477 UTN's mark was weak, [Chase, 333 F.Supp.2d at 248](#), and UTN does not dispute that finding. Rather, UTN argues that the district court erred in focusing only on the commercial weakness of UTN's mark. We agree that the weakness of the senior user's mark can, in theory, advance a claim of reverse confusion rather than undermine it. The "the lack of commercial strength of the smaller senior user's mark is to be given

less weight in the analysis because it is the strength of the larger, junior user's mark which results in reverse confusion." [A & H V, 237 F.3d at 231](#) (citation omitted). Nonetheless, "analysis of the strength of the senior user's mark is relevant" in a reverse confusion case. [Checkpoint Systems, 269 F.3d at 303](#).

Here, UTN failed to produce any evidence of the commercial strength of its mark and tries to explain that failure by claiming that "it was the strength of the mark of the corporate giant, Chase, that essentially drove [UTN] from the marketplace." Appellants' Br. at 30. However, that is a frivolous rejoinder. As we have already discussed, Chase did not drive UTN out of the marketplace in the first place. Rather, UTN stopped marketing and issuing FREEDOM CARD more than a year before CHASE FREEDOM card was launched.

C. Sophistication of consumers.^{FN21}

^{FN21}. This issue was discussed in the district court's analysis of [Lapp](#) factor (3), i.e., the price of the goods and other factors indicative of the care and attention expected of consumers when making a purchase. This factor is the same for both direct and reverse confusion.

The district court concluded that consumers "do exercise considerable care in selecting who will carry their debt [, and held that] [t]his factor therefore also weighs against a finding of likelihood of confusion." [333 F.Supp.2d at 249](#). In doing so, the court relied in part upon [First Nat'l Bank in Sioux Falls v. First Nat'l Bank South Dakota, 153 F.3d 885, 888–89 \(8th Cir.1998\)](#). There, the court explained that consumers generally exercise a high degree of care in choosing banking services. They are therefore more likely to notice what, in other contexts, may be relatively minor differences in names. This would undermine UTN's likelihood of confusion over these marks.

The district court also relied upon the testimony of Chase's expert, Pierce Sioussat.^{FN22} He stated that consumers "do look to a number of factors when considering whether to apply for and carry a credit card, such as interest rate, rewards offered, affinity relationship, and introductory offers." [Id. at 248](#).

^{FN22}. Sioussat was offered as an expert in

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the credit card industry. UTN filed a [Daubert](#) motion to exclude his testimony. See [Daubert v. Merrell Dow Pharmaceuticals, Inc.](#), 509 U.S. 579, 113 S.Ct. 2786, 125 L.Ed.2d 469 (1993). However, the district court denied that motion, [333 F.Supp.2d at 249 n. 17](#), and UTN is not challenging that ruling.

UTN believes this was error because Sioussat's testimony "had no application in the sub-prime market targeted by [UTN]." Appellants' Br. at 30. Admittedly, we have explained that "[w]here the buyer class is mixed, the standard of care to be exercised by the reasonably prudent purchaser will be equal to that of the least sophisticated consumer in the class." [Ford Motor Co. v. Summit Motor Prods., Inc.](#), 930 F.2d 277, 293 (3d Cir.1991). However, UTN never made this argument in the district court. Rather, UTN only argued that Sioussat's testimony was "absurd and unsupported" and asserted, without offering any substantive evidence, that while consumers exercise care in choosing their bank, they do not necessarily exercise the same care in choosing a *478 credit card. [Chase](#), 333 F.Supp.2d at 248–49. Accordingly, UTN cannot now argue that the district court erred in relying upon the expert's testimony about the amount of care exercised in the relevant market. See, e.g., [Bailey v. United Airlines](#), 279 F.3d 194, 204 (3d Cir.2002).

D. Actual confusion.

The district court concluded that "UTN [did] not come forward with any competent evidence of actual confusion. Thus, this factor also weighs significantly against a finding of likelihood of confusion." ^{FN23} [333 F.Supp.2d at 249–50](#). UTN argues that this was error because the district court (1) ignored the length of time that it had used the mark and (2) ignored anecdotal evidence of actual confusion.

^{FN23}. The district court considered the fourth and sixth [Lapp](#) factors together in its actual confusion inquiry.

UTN faults the district court's concern over the absence of evidence of actual confusion, reminding us that it was driven from the marketplace. However, that is yet another frivolous rejoinder since UTN stopped marketing the FREEDOM CARD approximately one year before Chase introduced its CHASE FREEDOM card. Chase's short-lived launch of its card, and its willingness to stop marketing CHASE FREEDOM

immediately after being contacted by UTN, is uncontradicted. Moreover, even if we credit UTN's claim that CompuCredit refused to continue its relationship with UTN because of Chase's CHASE FREEDOM card, UTN could still not prevail on this record because UTN and Chase were in different markets. The district court found that "the undisputed evidence in this case indicates that [CHASE FREEDOM] and [FREEDOM CARD] are targeted at different groups of consumers.... Mr. Buford, UTN's CEO, made the distinction saying, 'Chase is targeting the high-income level and FreedomCard is targeting the middle-to-low income level.'" [Chase Manhattan Bank](#), 333 F.Supp.2d at 250. Absent more than appears here, this seriously undermines UTN's claim of likelihood of confusion.

Nevertheless, UTN attempts to argue the significance of anecdotal evidence of actual confusion that it introduced. UTN claims that the district court ignored evidence that UTN's accountant, Richard Moon, believed that CHASE FREEDOM was a joint venture between UTN and Chase. However, the district court did not credit that evidence because it was based on Buford's deposition testimony rather than anything Moon testified to. UTN had every opportunity to explore that issue during Moon's own deposition but refrained from doing so. UTN now invites us to ignore Moon's silence and focus on Buford's uncorroborated and self serving proclamations. That is an invitation we must decline.

Moreover, the district court correctly concluded that Moon's purported belief was not sufficient to establish actual confusion even if credited. [333 F.Supp.2d at 249 n. 18](#). ("Even accepting as true that Mr. Moon was confused, such *de minimis* evidence of actual confusion does not establish a genuine issue of material fact on the likelihood of confusion issue and is insufficient to prevent dismissal on summary judgment.") (citing [Universal Money Ctrs., Inc. v. Am. Tel. & Tel. Co.](#), 22 F.3d 1527, 1535 (10th Cir.1994)).

UTN correctly reminds us that anecdotal evidence can be both relevant and probative, and argues the district court improperly dismissed the anecdotal evidence of Moon's confusion. Appellants' Br. at 34 ("in addressing the actual confusion factor, courts must often consider anecdotal evidence."). That argument ignores the fact *479 that, unlike the cases UTN relies upon, the anecdotal evidence here was *de*

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minimis just as the district court concluded. Accordingly, we do not think the district court erred in analyzing the evidence of actual confusion on this record.

E. Chase's Intent in Adopting the CHASE FREEDOM Mark.

The district stated that “UTN has not set forth any competent evidence to prove that Chase adopted the CHASE FREEDOM mark with the intent to confuse consumers.” [Chase Manhattan Bank, 333 F.Supp.2d at 250](#). The court concluded that the evidence here establishes that:

Chase created the CHASE FREEDOM mark by hiring outside consultants, conducting qualitative research that included focus groups, and forming a team from its internal staff to facilitate the development of a new credit card product. On the basis of that research, Chase adopted the CHASE FREEDOM credit card to replace the CHASE Shell Mastercard.

Id. The court reasoned that this factor weighs against a finding of likelihood of confusion. *Id.* UTN argues that this is error because the district court “failed to address a significant volume of evidence establishing [Chase] had full knowledge of the “FREEDOM CARD” mark.” Appellants' Br. at 36.

UTN attempts to advance that contention by correctly noting that the intent inquiry in a reverse confusion case differs from an intent inquiry in a direct confusion case. However, UTN's argument is misleading. As noted earlier, intent to confuse is relevant to both reverse confusion and direct confusion. [A & H V, 237 F.3d at 232](#). The difference is that the tenor of the intent to confuse evidence changes from the deliberate intent to palm off or exploit the goodwill of the senior user's mark (deliberate confusion), *id.* at 225–26, to the deliberate intent to push the senior user out of the market (reverse confusion). *Id.* at 232.

There is no evidence here from which a reasonable fact finder could conclude that Chase intended to push UTN out of the market, and this is true even if we assume *arguendo* that Chase was in UTN's market. To reiterate, Chase was in the prime market, and UTN was in the sub-prime market (or the sub-sub-prime market as Chase suggests). UTN never attempted to promote its card in the credit market for Chase's card, and vice-versa. ^{FN24} Moreover, as we have repeatedly

noted, UTN was not issuing or marketing its FREEDOM CARD in any market when Chase started its CHASE FREEDOM card, and Chase stopped marketing its card when UTN objected. Thus, even if we credit UTN's claim that Chase was considering entering UTN's market and improperly relied on UTN's mark in order to enter it (a true case of reverse confusion), the record would still not allow a reasonable fact finder to conclude that Chase's mark created a likelihood of confusion.

^{FN24} Indeed, given the 140% annual charges in interest and fees, UTN's card would have been a “hard sell” to credit-worthy consumers.

^[9] In responding to the district court's analysis of intent, UTN first argues that the district court ignored the fact that Chase conducted a trademark search, learned of UTN's FREEDOM CARD mark and nevertheless adopted the CHASE FREEDOM mark. UTN claims that this demonstrates that Chase used the word “freedom” with the intention of confusing consumers. ^{FN25}

^{FN25} Chase claimed attorney-client privilege with respect to the trademark search. UTN suggests that Chase's assertion of the privilege constitutes evidence of Chase's bad faith. However, we agree that it is improper to draw an inference of bad faith from the assertion of the attorney-client privilege. *See Chase's Br.* at 44 (citing [Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc., 220 U.S.P.Q. 609, 612, 1983 WL 51933 \(D.Mass.\), aff'd 718 F.2d 1201 \(1st Cir.1983\)](#)).

*480 We disagree, and again note UTN's own USPTO filings about the prevalence of “freedom” in the marketplace. Given UTN's own submissions to the USPTO we agree that the district court correctly concluded that Chase's use of the word does not constitute evidence of an intent to deceive. ^{FN26}

^{FN26} We do not rule out the possibility that, in an appropriate case, a party could establish that a competitor's use of a common word could constitute evidence of an intent to deceive. However, this record does not support any such inference with regard to Chase's use

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of “freedom.”

We are similarly unimpressed by evidence that Chase conducted a trademark search and presumably learned of UTN’s registration of FREEDOM CARD. Absent UTN’s own filings with the USPTO, it might be possible to claim that Chase’s search and subsequent use of “FREEDOM” constituted carelessness at best. However, we have not yet adopted that standard for such an analysis, and we are certainly not willing to adopt it on this record. See [A & H V, 237 F.3d at 232–33](#) (“Although we recognize that our opinion in [Fisons](#) perhaps implied that mere carelessness, as opposed to deliberate intent to confuse, would weigh in a plaintiff’s favor in a reverse confusion case, we are reluctant to adopt such an interpretation, as it would be manifestly out of step with our prior holdings regarding the relevance of ‘intent’ in trademark infringement claims.”). However, given the undisputed evidence of how common the use of “freedom” has become in the relevant marketplace, even that requires an analytical stretch beyond the reach of a reasonable fact finder.

UTN next argues that Chase intentionally adopted the word “freedom” to confuse consumers because Chase knew in 1999 that UTN had FREEDOM CARD. That argument is rooted in the discussions that occurred after UTN approached Chase to explore possible affiliation with UTN’s FREEDOM CARD. UTN alleges that at a meeting, it gave Chase graphic copies of a credit card that is virtually identical to the CHASE FREEDOM card. Although UTN makes this allegation, at his deposition, Buford could not say when the presentation was made. Moreover, it is undisputed that no such card exists in Chase’s files. Finally, as we noted above, even if UTN could establish when this happened, it would still not establish the likelihood of confusion that UTN had to establish to prevail on its counterclaim.

UTN suggests that intent to confuse can be inferred because certain Chase employees were involved in both the 1999 discussions between UTN and Chase and a subsequent project that Chase undertook in 2002–2003 called “Project Poet” that led to the development of the CHASE FREEDOM card. According to UTN, an employee named “Dzierzynski” told other Chase employees in 1999 that they needed to followup on a Chase–FREEDOM CARD joint venture and that she was a member of the Project Poet

team. UTN cites to e-mails to support that connection. However, Dzierzynski was not the author of those e-mails; she was only a recipient. Moreover, Dzierzynski was not a member of Project Poet and had no involvement in the development of CHASE FREEDOM.

UTN further alleges that a person named “Dias,” a Chase executive who was present at the 1999 meetings, briefed her supervisor, “Johri,” on all of her projects and that Johri was later a member of Project Poet. However, Dias left Chase *481 long before Chase began Project Poet and Johri did not work for Chase until September 1, 1999, after all discussions with UTN ended. Chase concedes that Johri met with Dias for 15–20 minutes when he first joined Chase; however, UTN produced no evidence that Dias told Johri about the UTN–Chase discussions. The district court realized that UTN needed more than these largely unsupported conclusions to survive Chase’s motion for summary judgment.

Moreover, these meetings and discussions still cannot overcome the other problems with UTN’s proof detailed above. We therefore find UTN’s argument regarding the 1999 discussions between UTN and Chase unpersuasive.

F. Other factors. ^{FN27}

^{FN27}. This argument centers on [Lapp](#) factor (10).

We have noted that [Lapp](#) factor (10) is necessarily transformed in the reverse context to an examination of other facts suggesting that the consuming public might expect the larger, more powerful company to manufacture both products, or expect the larger company to manufacture a product in the plaintiff’s market, or expect that the larger company is likely to expand into the plaintiff’s market.

[A & H V, 237 F.3d at 234](#) (citation omitted). UTN argues that the district court erred in applying this factor because it “gave no consideration to whether the consuming public might expect [Chase] to (a) offer both the FREEDOM CARD and the CHASE FREEDOM CARD, (b) offer a card for the subprime market, or (c) enter the subprime market.” Appellants’ Br. at 22–23. However, that is the sum of UTN’s argument on this point. UTN does not attempt to demonstrate how such an inquiry would

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have resulted in finding a likelihood of confusion, nor does UTN discuss how the district court's failure to conduct the inquiry prejudiced it.

UTN does claim that

the consuming public clearly might expect [Chase] to produce a credit card product, including a credit card product for the subprime market served by FREEDOM CARD. In that regard, it is undisputed that [Chase was] investigating the subprime market following its meetings with FREEDOM CARD in 1999.

UTN's Br. at 25. However, this statement is not correct. There was undisputed deposition testimony that Chase was preparing, but had not yet started, some targeted testmarketing in the sub-prime market. However, that activity took place in 2004, not when Chase and UTN met in 1999. Moreover, the record does not establish that any such entry would have involved the CHASE FREEDOM mark; a mark that Chase discontinued in 2003. In addition, Chase and UTN defined the sub-prime market very differently. CHASE defined the sub-prime market as consumers with a credit score lower than 660 with no bankruptcies. UTN defined that market as consumers having credit scores below 580 with recent bankruptcies. *See* n. 6, *supra*.

G. Failure to address all of the *Lapp* factors.

Finally, UTN argues that the district court failed to address *Lapp* factor (9)—the relationship of the goods in the minds of consumers because of the similarity of function. According to UTN, this failure, in and of itself, warrants reversal and remand. In support of that contention, UTN relies on *Kos Pharmaceuticals*, 369 F.3d at 711–12. There, we said that if a district court finds that certain of the *Lapp* factors do not apply or do not further the *482 inquiry, the court should explain why it did not use those factors in arriving at its decision. In *Kos*, the district court only considered two of the *Lapp* factors and simply said that the “remaining *Lapp* factors do not [weigh in the Petitioner's favor].” *Id.* at 712. We held that this statement “does not explain the basis for [the district court's] holding as to each factor, whether it viewed each as neutral, irrelevant, or favorable to Andrx, or how it weighed and balanced the combined factors.” *Id.*

However, this does not help UTN now because UTN and Chase agreed in the district court that *Lapp* factors (1) through (6) and (8) were the most relevant factors for the district court to analyze. *Chase*, 333 F.Supp.2d at 245 n. 14. (“the parties agree that, because their goods compete in the same field, the most relevant *Lapp* factors are (1) through (6) and (8).”). UTN cannot fault the district court for not analyzing its claim under factor (9) when it agreed that that factor was of dubious relevance. The district court explained it was not discussing *Lapp* factors 7, 9, and 10 because they “are not apposite for directly competing goods ...”. *Id.* Moreover, UTN does not even now discuss how the district court's failure to address any factor, including factor (9), resulted in prejudice or altered the outcome in this case.

V. CONCLUSION

For all of the above reasons, we will affirm the district court.

C.A.3 (Del.),2005.
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United States Court of Customs and Patent Appeals.
 CONTINENTAL DISTILLING CORPORATION,
 Appellant,

v.

NORMAN WILLIAMS CO., Assignee of E. Marti-
 noni Company, Appellee.

Patent Appeal No. 8413.
 June 17, 1971.

Proceeding to register trademarks CANADIAN BELLE, CUMBERLAND BELLE, HEATHER BELLE and RIVER BELLE for various whiskeys. The trade-mark trial and appeal board, serial Nos. 219,030, 219,018, 219,023, 219,020, dismissed opposition to registration, and opposer appealed. The United States Court of Customs and Patent Appeals, Baldwin, J., held that evidence did not indicate that registration of marks in question would result in confusion, mistake or deception with respect to opposer's mark DIXIE BELLE in association with design for gin.

Affirmed.

West Headnotes

Trademarks 382T 1310

[382T](#) Trademarks

[382TVII](#) Registration

[382TVII\(B\)](#) Proceedings Concerning Federal Registration

[382Tk1306](#) Evidence

[382Tk1310](#) k. Weight and Sufficiency.

[Most Cited Cases](#)

(Formerly 382k224 Trade Regulation)

Evidence in proceeding to register trademark CANADIAN BELLE, CUMBERLAND BELLE, HEATHER BELLE and RIVER BELLE for various whiskeys did not indicate that registration of such marks would result in confusion, mistake or deception with respect to opposer's mark DIXIE BELLE in association with design for gin. Lanham Trade-Mark

Act, § 2(d), [15 U.S.C.A. § 1052\(d\)](#).

****393 *1301** Henry W. Leeds, Washington, D.C. (Mason, Fenwick & Lawrence), Washington, D.C., attorney of record, for appellant.

Warren L. Kern, Los Angeles, Cal., Russell L. Law, Washington, D.C., for appellee.

Before RICH, ALMOND, BALDWIN, LANE, Judges, and NEWMAN, Judge, United States Customs Court, sitting by designation.

BALDWIN, Judge.

This is an appeal by Continental Distilling Corporation from the decision of the Trademark Trial and Appeal Board^{FN1} dismissing its ***1302** opposition to the registration by appellee's predecessor^{FN2} of the marks Canadian Belle^{FN3} for Canadian whiskey, Cumberland Belle^{FN4} for bourbon whiskey, Heather Belle^{FN5} for Scotch whiskey and River Belle^{FN6} for bourbon whiskey.

[FN1](#). Abstracted at [157 USPQ 715 \(1968\)](#).

[FN2](#). E. Martinoni Company.

[FN3](#). Serial No. 219,030, filed May 17, 1965, and published Mar. 22, 1966.

[FN4](#). Serial No. 219,018, filed May 17, 1965, and published Mar. 22, 1966.

[FN5](#). Serial No. 219,023, filed May 17, 1965, and published Mar. 22, 1966.

[FN6](#). Serial No. 219,020, filed May 17, 1965, and published Mar. 22, 1966.

The opposer-appellant, hereinafter appellant, is the owner of the mark comprising the words Dixie Belle in association with a design for gin. [FN7](#) Priority is established in the record.

[FN7](#). Registration No. 310,075, dated February 13, 1934 and 501,311, dated August 3,

1948, annexed to the Notice of Opposition filed April 22, 1966.

The opposition was based on the ground that the marks Canadian Belle, Cumberland Belle, Heather Belle and River Belle so resemble the appellant's mark as to be likely to cause confusion, mistake or deception when used in connection with distilled spirits. [15 USC 1052\(d\)](#). Neither party took testimony in the proceedings below. While appellee did rely on the existence of ten third party registrations, our decision does not take those third party registrations into consideration.

Appellant's case centers around the position that the dominant portion of the respective marks is the word Belle and the argument that the consumer, seeing that word with a geographic-type prefix, would be confused. Appellant has relied heavily on the case involving the marks Virginia Gentleman, Indiana Gentleman, and American Gentleman, all for whiskey. [A. Smith Bowman Distillery, Inc. v. Schenley Distillers, Inc., 198 F.Supp. 822 \(D.Del.1961\)](#). We are not convinced.

The factual situation in the Bowman case is distinguishable from the present case. In that case, there was extensive evidence of the substantial sales by the plaintiff under its mark and the public recognition and prestige of the product. The court there concluded that plaintiff had acquired a valuable goodwill in the mark Virginia Gentleman and that the ****394** infringer's course of conduct was an attempt to come as close as possible to a mark with a high degree of established customer goodwill and 'to take a free ride on a popular brand product.'

Here, on the other hand, there is no evidence before the court as to the advertising, sale, reputation or goodwill of the mark Dixie Belle. Neither do we find evidence of the appellee's attempt to trade on the appellant's mark.

The mark Dixie Belle and design for gin and appellee's marks Cumberland Belle, River Belle, Heather Belle and Canadian Belle do not look alike or sound alike. ***1303** The fact that all the marks share the word Belle is not controlling. When the marks are taken in their entireties, we fail to see any likelihood of confusion, mistake or deception.

For the reasons stated above, the decision of the Trademark Trial and Appeal Board is affirmed.

Affirmed.

Cust. & Pat.App. 1971.
Continental Distilling Corp. v. Norman Williams Co.
58 C.C.P.A. 1301, 443 F.2d 392, 170 U.S.P.Q. 132

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476 F.2d 1357, 177 U.S.P.Q. 563
(Cite as: 476 F.2d 1357)



United States Court of Customs and Patent Appeals.
Application of E. I. DuPONT DeNEMOURS & CO.
(Assignee of Horizon Industries Corporation).

Patent Appeal No. 8866.
May 3, 1973.

Appeal from a decision of the Trademark Trial and Appeal Board, Serial No. 307,711, affirming a refusal to register applicant's mark "RALLY" for a combination polishing, glazing and cleaning agent for use on automobiles on the basis of likelihood of confusion with another's registered mark "RALLY" for an all-purpose detergent. The Court of Customs and Patent Appeals, Markey, C. J., held that confusion was not likely to stem from the concurrent use of "RALLY" by registrant on its household cleaning products and by applicant on its automotive cleaning products, since the respective parties had entered into an agreement restricting registrant to the general purpose cleaning market and restricting applicant to the automobile market, and since the fact that the goods of one party could be used in the field of the other was too conjectural and too widely applicable to form the sole basis of a decision against the applicant, particularly where the parties had agreed to avoid the promotion of such cross use.

Reversed.

Baldwin, J., dissented.

West Headnotes

[\[1\] Trademarks 382T](#) 1005

[382T](#) Trademarks

[382TI](#) In General

[382Tk1003](#) Constitutional and Statutory Provisions

[382Tk1005](#) k. Purpose and Construction in General. [Most Cited Cases](#)

(Formerly 382k251, 382k1)

Basic goal of the Lanham Trade-Mark Act is the protection of trademarks, securing to the owner the good will of his business, and protecting the public against spurious and falsely marked goods. Lanham Trade-Mark Act, § 1 et seq., [15 U.S.C.A. § 1051](#) et seq.

[\[2\] Trademarks 382T](#) 1244

[382T](#) Trademarks

[382TVII](#) Registration

[382TVII\(A\)](#) In General

[382Tk1243](#) Eligibility for Registration; Grounds for Allowing or Denying

[382Tk1244](#) k. In General. [Most Cited](#)

[Cases](#)

(Formerly 382k181)

Under the Lanham Trade-Mark Act, the Commissioner must refuse registration when convinced that confusion is likely because of concurrent use of the marks of an applicant and a prior user on their respective goods. Lanham Trade-Mark Act, §§ 2, 2(d), [15 U.S.C.A. §§ 1052, 1052\(d\)](#).

[\[3\] Trademarks 382T](#) 1081

[382T](#) Trademarks

[382TIII](#) Similarity Between Marks; Likelihood of Confusion

[382Tk1081](#) k. Factors Considered in General.

[Most Cited Cases](#)

(Formerly 382k182.1, 382k182)

Criteria listed to be considered in testing for likelihood of confusion under Lanham Trade-Mark Act provision prohibiting refusal to register a trademark on account of its nature unless it consists of or comprises a mark which so resembles a registered mark or a mark or trade name previously used by another and not abandoned as to be likely, when applied to the goods of the applicant, to cause confusion or to cause mistake or to deceive. Lanham Trade-Mark Act, §§ 2, 2(d), [15 U.S.C.A. §§ 1052, 1052\(d\)](#).

[\[4\] Trademarks 382T](#) 1080

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[382T Trademarks](#)

[382TIII Similarity Between Marks; Likelihood of Confusion](#)

[382Tk1080](#) k. In General. [Most Cited Cases](#)
(Formerly 382k182.1, 382k182)

In every trademark case turning on likelihood of confusion, it is the duty of the examiner, the board and the Court of Customs and Patent Appeals to find, upon consideration of all the evidence, whether or not confusion appears likely in the event the applicant's mark is registered. Lanham Trade-Mark Act, §§ 2, 2(d), [15 U.S.C.A. §§ 1052, 1052\(d\)](#).

[5] Trademarks 382T 1114

[382T Trademarks](#)

[382TIII Similarity Between Marks; Likelihood of Confusion](#)

[382Tk1114](#) k. Doubt as to Confusion. [Most Cited Cases](#)
(Formerly 382k186)

If there is no indication of likely confusion, registration of mark must promptly issue, but if there is some indication that confusion may be likely, the question must remain open until any or all of the elements bearing on likelihood of confusion have been reviewed and studied, the final decision being made on the basis of the entire record. Lanham Trade-Mark Act, §§ 2, 2(d), [15 U.S.C.A. §§ 1052, 1052\(d\)](#).

[6] Trademarks 382T 1184

[382T Trademarks](#)

[382TVI Nature, Extent, and Disposition of Rights](#)
[382Tk1182](#) Right to Use in General; Exclusivity

[382Tk1184](#) k. Manner of Use; Misuse. [Most Cited Cases](#)
(Formerly 382k181)

Reputable businessmen-users of valuable trademarks have no interest in causing public confusion. Lanham Trade-Mark Act, §§ 2, 2(d), [15 U.S.C.A. §§ 1052, 1052\(d\)](#).

[7] Trademarks 382T 1308

[382T Trademarks](#)

[382TVII Registration](#)

[382TVII\(B\) Proceedings Concerning Federal Registration](#)

[382Tk1306](#) Evidence

[382Tk1308](#) k. Presumptions and Burden of Proof. [Most Cited Cases](#)
(Formerly 382k224)

Trademarks 382T 1310

[382T Trademarks](#)

[382TVII Registration](#)

[382TVII\(B\) Proceedings Concerning Federal Registration](#)

[382Tk1306](#) Evidence

[382Tk1310](#) k. Weight and Sufficiency. [Most Cited Cases](#)
(Formerly 382k224)

When those most familiar with use in the marketplace and most interested in precluding confusion enter into agreements designed to avoid it, the scales of evidence are clearly tilted, and it is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it will not; a mere assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not. Lanham Trade-Mark Act, §§ 2, 2(d), [15 U.S.C.A. §§ 1052, 1052\(d\)](#).

[8] Trademarks 382T 1104

[382T Trademarks](#)

[382TIII Similarity Between Marks; Likelihood of Confusion](#)

[382Tk1100](#) Relationship Between Goods or Services Underlying Marks

[382Tk1104](#) k. Markets and Territories; Competition. [Most Cited Cases](#)
(Formerly 382k201)

Trademarks 382T 1106

[382T Trademarks](#)

[382TIII Similarity Between Marks; Likelihood of Confusion](#)

[382Tk1106](#) k. Relationship Between Parties or Actors Using Marks. [Most Cited Cases](#)
(Formerly 382k201)

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Confusion was not likely to stem from the concurrent use of “RALLY” by registrant on its household cleaning products and by applicant on its automotive cleaning products, since the respective parties had entered into an agreement restricting registrant to the general purpose cleaning market and restricting applicant to the automobile market, and since the fact that the goods of one party could be used in the field of the other was too conjectural and too widely applicable to form the sole basis of a decision against the applicant, particularly where the parties had agreed to avoid the promotion of such cross use. Lanham Trade-Mark Act, §§ 2, 2(d), [15 U.S.C.A. §§ 1052, 1052\(d\)](#).

[\[9\]](#) Trademarks [382T](#) 1184

[382T](#) Trademarks

[382TVI](#) Nature, Extent, and Disposition of Rights
[382Tk1182](#) Right to Use in General; Exclusivity
[382Tk1184](#) k. Manner of Use; Misuse. [Most Cited Cases](#)
(Formerly 382k181)

Right to use is not a right to confuse.

[\[10\]](#) Trademarks [382T](#) 1183

[382T](#) Trademarks

[382TVI](#) Nature, Extent, and Disposition of Rights
[382Tk1182](#) Right to Use in General; Exclusivity
[382Tk1183](#) k. In General. [Most Cited Cases](#)
(Formerly 382k91)

Trademarks [382T](#) 1242

[382T](#) Trademarks

[382TVII](#) Registration
[382TVII\(A\)](#) In General
[382Tk1242](#) k. Right to Registration in General. [Most Cited Cases](#)
(Formerly 382k152)

Rights to use and to register are not identical. Lanham Trade-Mark Act, §§ 2, 2(d), [15 U.S.C.A. §§ 1052, 1052\(d\)](#).

[\[11\]](#) Trademarks [382T](#) 1242

[382T](#) Trademarks

[382TVII](#) Registration
[382TVII\(A\)](#) In General
[382Tk1242](#) k. Right to Registration in General. [Most Cited Cases](#)
(Formerly 382k152, 382k91)

Although a naked right to use cannot always result in registration, the Lanham Trade-Mark Act intends that registration and use be coincident so far as possible. Lanham Trade-Mark Act, §§ 2, 2(d), [15 U.S.C.A. §§ 1052, 1052\(d\)](#).

[\[12\]](#) Trademarks [382T](#) 1244

[382T](#) Trademarks

[382TVII](#) Registration
[382TVII\(A\)](#) In General
[382Tk1243](#) Eligibility for Registration; Grounds for Allowing or Denying
[382Tk1244](#) k. In General. [Most Cited Cases](#)
(Formerly 382k227)

Citation of “the public interest” as a basis for refusal of registration is a bootless cry; it is fallacious notion to think that the patent office is somehow guarding the public against confusion when it refuses a registration. Lanham Trade-Mark Act, §§ 2, 2(d), [15 U.S.C.A. §§ 1052, 1052\(d\)](#).

[\[13\]](#) Trademarks [382T](#) 1366

[382T](#) Trademarks

[382TVII](#) Registration
[382TVII\(C\)](#) Effect of Federal Registration
[382Tk1364](#) Scope of Rights Acquired; Limitations
[382Tk1366](#) k. Effect on Rights of Others in General. [Most Cited Cases](#)
(Formerly 382k251)

Trademarks [382T](#) 1371

[382T](#) Trademarks

[382TVII](#) Registration
[382TVII\(C\)](#) Effect of Federal Registration
[382Tk1371](#) k. Effect of Denial, Cancellation, or Other Loss of Registration. [Most Cited Cases](#)

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(Formerly 382k227)

Guardianship role of the patent office lies not in a negative, nay-saying of refusal alone, but in the protection of a mark by registering it and then rejecting later improper attempts, of which the registrant is unaware, to register it or a similar mark. Lanham Trade-Mark Act, §§ 2, 2(d), [15 U.S.C.A. §§ 1052, 1052\(d\)](#).

[\[14\] Trademarks 382T](#) 1371

[382T](#) Trademarks

[382TVII](#) Registration

[382TVII\(C\)](#) Effect of Federal Registration

[382Tk1371](#) k. Effect of Denial, Cancellation, or Other Loss of Registration. [Most Cited Cases](#)
(Formerly 382k227)

Refusal to register a trademark cannot prevent confusion; at most, it might discourage further use. Lanham Trade-Mark Act, §§ 2, 2(d), [15 U.S.C.A. §§ 1052, 1052\(d\)](#).

[\[15\] Trademarks 382T](#) 1244

[382T](#) Trademarks

[382TVII](#) Registration

[382TVII\(A\)](#) In General

[382Tk1243](#) Eligibility for Registration; Grounds for Allowing or Denying

[382Tk1244](#) k. In General. [Most Cited Cases](#)

(Formerly 382k181)

“Guardianship of the public interest” is no ground for refusing to register a trademark under Lanham Trade-Mark Act provision prohibiting refusal to register unless the trademark consists of or comprises a mark which so resembles a registered mark as to be likely, when applied to the good of the applicant, to cause confusion or mistake or to deceive. Lanham Trade-Mark Act, §§ 2, 2(d), [15 U.S.C.A. §§ 1052, 1052\(d\)](#).

*1359 Eugene L. Grimm, Wilmington, Del., atty. of record, for appellant. Gerald A. Hapka, Washington, D. C., of counsel.

S. Wm. Cochran, Washington, D. C., for Commis-

sioner of Patents. Jack E. Armore, Washington, D. C., of counsel.

Before MARKEY, Chief Judge, RICH, BALDWIN and LANE, Judges, and WATSON, Judge, United States Customs Court, sitting by designation.

MARKEY, Chief Judge.

This appeal is from the decision of the Trademark Trial and Appeal Board, [166 USPO 351 \(1970\)](#), affirming a refusal to register DuPont's mark RALLY for a combination polishing, glazing and cleaning agent for use on automobiles ^{FN1} on the basis of likelihood of confusion under section 2(d) of the Lanham Act with Horizon's registered mark RALLY for an all-purpose detergent. ^{FN2} We reverse.

^{FN1}. Serial No. 307,711, filed September 19, 1968.

^{FN2}. Reg.No.675,713, issued March 17, 1959.

The application now before us was originally filed by Horizon. DuPont had earlier filed for registration of RALLY for a combination wax and cleaning agent for automobiles. ^{FN3} That application was refused in view of Horizon's registration. DuPont appealed and the board affirmed. ^{FN4}

^{FN3}. Serial No. 270,842, filed May 8, 1967.

^{FN4}. Decision of Trademark Trial and Appeal Board, abstracted at [160 USPO 830 \(1968\)](#).

While its appeal was pending, DuPont purchased Horizon's mark for the automobile product, the present application and the good will of that business. Because Horizon retained RALLY for allpurpose detergent, an agreement designed to avoid conflict was entered into on the same day. Boundaries of use of the marks were established, permitting the sale of products “incidentally usable” in the other party's market but prohibiting any promotion as “especially suited for use in such market.” DuPont's realm was the “automotive aftermarket.” Horizon's encompassed the “commercial building or household market.”

The examiner, aware of the assignment and

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agreement, nonetheless refused registration, citing Horizon's registration and describing the issue as "ruled upon" in the board's earlier decision. The board affirmed, holding:

It is our opinion that despite any agreement between the parties the public interest cannot be ignored, and when the goods of the parties are as *1360 closely related as those here involved, their sale under the identical mark "RALLY" would be likely to result in confusion, mistake, or deception. cf. In re Avedis Zildjian Co., 157 U.S. p. 2517 [394 F.2d 860, 55 CCPA 1126] (CCPA, 1968); and In re Continental Baking Company, 156 U.S. p. 2514 [390 F.2d 747, 55 CCPA 967] (CCPA, 1968). * * * The mere fact that registrant may have precluded itself from selling an automobile cleaner under the mark "RALLY" does not overcome the likelihood of confusion as set forth in Section 2(d) of the Trademark Statute.

OPINION

Our decision turns on the application of Sec. 2(d) to the facts before us. DuPont, having an unquestioned right to use, argues that the "right to register follows the right to use," particularly where the right on its goods is exclusive, Horizon having given up use of the mark in DuPont's market. The Patent Office solicitor denies such a broad relationship in the rights to use and register and emphasizes the duty of the Patent Office "to guard the public interest" against confusion.

Both parties have cited prior opinions of this court. We are thus presented with a welcomed opportunity to set forth a reliable guide for decision-making in cases involving Sec. 2(d). It need hardly be said that concepts expressed in our prior opinions and inconsistent with what we say here may be considered no longer viable in this court.

THE STATUTE

[1] We begin with interpretation of the Lanham Act (Chapter 22, Title 15) as it applies here. The legislative history^{FN5} of the Act as a whole describes its objectives as making registration "more liberal," dispensing with "mere technical prohibitions and arbitrary provisions" and modernizing the trademark statutes "so that they will conform to legitimate present-day business practice." The basic goal of the Act, which dealt with a good deal more than registration, was "the protection of trademarks, securing to the owner the good will of his business and protecting the

public against spurious and falsely marked goods." Accordingly, we consider the pre-Lanham Act decisions^{FN6} presented here to be inapt.

^{FN5} S.Rep.No.1333, 79th Cong., 2d Sess. (1946) in U.S.Code Cong.Service, 79th Cong., 2d Sess. at 1274-1278 (1946).

^{FN6} Skookum Packers Association v. Pacific Northwest Canning Co., 45 F.2d 912, 18 CCPA 792 (1930); Van Camp Sea Food Co., Inc. v. Westgate Sea Products Co., 48 F.2d 950, 18 CCPA 1311 (1931); Jacob Ries Bottling Works, Inc. v. The Coca-Cola Co., 138 F.2d 56, 31 CCPA 706 (1943).

Sec. 2 (15 U.S.C. § 1052), in pertinent part reads:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent Office or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when applied to the goods of the applicant to cause confusion, or to cause mistake or to deceive: * * *

[2] Under the statute the Commissioner must refuse registration when convinced that confusion is likely because of concurrent use of the marks of an applicant and a prior user on their respective goods.

The phrase "on account of its nature" in Sec. 2 clearly applies to the "resembles" element of Sec. 2(d). But the question of confusion is related not to the *nature* of the mark but to its *effect* "when applied to the goods of the applicant." The only *relevant* application is made in the marketplace. The words *1361 "when applied" do not refer to a mental exercise, but to all of the known circumstances surrounding use of the mark.

THE DECISIONAL PROCESS

The ultimate question of the likelihood of consumer confusion has been termed a question of fact.

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[Coca-Cola Company v. Snow Crest Beverages, Inc.](#), 162 F.2d 280 (1st Cir. 1947), cert. den. 332 U.S. 809, 68 S.Ct. 110, 92 L.Ed. 386 (1947). If labeled a mixed question or one of law, it is necessarily drawn from the probative facts in evidence. As so often said, each case must be decided on its own facts. There is no litmus rule which can provide a ready guide to all cases.

[3] In testing for likelihood of confusion under Sec. 2(d), therefore, the following, when of record, must be considered:

(1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

(2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.

(3) The similarity or dissimilarity of established, likely-to-continue trade channels.

(4) The conditions under which and buyers to whom sales are made, i. e. “impulse” vs. careful, sophisticated purchasing.

(5) The fame of the prior mark (sales, advertising, length of use).

(6) The number and nature of similar marks in use on similar goods.

(7) The nature and extent of any actual confusion.

(8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.

(9) The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark).

(10) The market interface between applicant and the owner of a prior mark:

(a) a mere “consent” to register or use.

(b) agreement provisions designed to preclude

confusion, i. e. limitations on continued use of the marks by each party.

(c) assignment of mark, application, registration and good will of the related business.

(d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.

(11) The extent to which applicant has a right to exclude others from use of its mark on its goods.

(12) The extent of potential confusion, i. e., whether *de minimis* or substantial.

(13) Any other established fact probative of the effect of use.

Where the Patent Office follows such process,^{FN7} it is not abandoning its duty under Sec. 2(d) or allowing individuals to take the law into their own hands. Consideration of evidence emanating from the only place where confusion can occur, i. e. the marketplace, is not related to *who* decides but to the *process* of deciding.

^{FN7}. See the decisions listed in “Appendix A” to Judge Smith’s dissenting opinion in [In re Continental Baking Co.](#), 390 F.2d 747 at 753, 55 CCPA 967 at 976.

The required inquiry, though more sweeping, is not unlike that provided for in Patent Office Rule 2.41 wherein the applicant is specifically invited to submit all evidence, including *letters from the trade or public*, tending to show that the mark, otherwise merely descriptive, distinguishes the goods.

The evidentiary elements are not listed above in order of merit. Each may *1362 from case to case play a dominant role. In [Schenley Distillers, Inc. v. General Cigar Co., Inc.](#), 427 F.2d 783, 57 CCPA 1213 (1970), and in [McKesson & Robbins, Inc. v. P. Lorillard Co.](#), 120 USPQ 306 (TTAB 1959), element (9) led to a finding that confusion was unlikely when the same mark was used on a beverage and a tobacco product. In [John Walker & Sons, Limited v. Tampa Cigar Company, Inc.](#), 124 F.Supp. 254 (S.D. Fla.1954), aff’d, 222 F.2d 460 (5th Cir. 1955) element (5) made confusion likely when the same mark was used on

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beverages and tobacco. See, also, [Carling Brewing Company, Inc. v. Phillip Morris, Inc.](#), 277 F.Supp. 326 (N.D.Ga.1967) and [Geo. A. Dickel Co. v. Stephano Brothers](#), 155 USPQ 744 (TTAB 1967) involving beverages and tobacco.

[4] We find no warrant, in the statute or elsewhere, for discarding *any* evidence bearing on the question of likelihood of confusion. Reasonable men may differ as to the *weight* to give specific evidentiary elements in a particular case. In one case it will indicate that confusion is unlikely; in the next it will not. In neither case is it helpful or necessary to inject broad maxims or references to “the public interest” which do not aid in deciding. Only the facts can do that. In every case turning on likelihood of confusion, it is the duty of the examiner, the board and this court to find, upon consideration of *all* the evidence, whether or not confusion appears likely. That determination ends the decisional process.

DECISION

Applying the above criteria, and after a thorough review of the entire record, we are convinced that confusion is not likely. The agreement and assignment herein constitute far more than mere “consent.” They play, in this case, a dominant role.

The record of DuPont's original application, like so many, included only the application, specimens, reference mark and descriptions of goods. From these the examiner made a judgment, necessarily subjective and requiring assumptions. The only facts were identical marks on “related” goods. Confusion appeared likely and registration was refused.

The present application, however, was rejected without proper consideration, in our view, of all the evidence. The examiner said the earlier decision had “ruled upon” the issue and referred to the “public interest” as though likelihood of confusion were established. The board, also citing the public interest, found confusion likely “despite any agreement.”

[5] It has been said that agreement evidence may resolve “doubt,” [In re Harvey Aluminum \(Inc.\)](#), 161 USPQ 366 (TTAB 1969) or may be useful when the issue is “debatable,” [In re Vim Corp.](#), 161 USPQ 58 (TTAB 1969), but there are only two practical possibilities. Either there is no indication of likely confusion, in which case the registration promptly issues, or

there is some indication that confusion may be likely. In the latter case, the question must *remain open* (i. e., “debatable”) until any or all of the elements listed above have been reviewed and studied, the final decision being made on the basis of the entire record.

In considering agreements, a naked “consent” may carry little weight. Absent more, the consent may continue or expand his use. The consent may be based on ignorance or misconception of the law. The facts may show, on the other hand, that consent could exist only in the absence of any real likelihood of confusion.

[6] The weight to be given more detailed agreements of the type presented here should be substantial. It can be safely taken as fundamental that reputable businessmen-users of valuable trademarks have no interest in *causing* public confusion. The genius of the free competitive system is the paralleling of the interest of the entrepreneur and the consuming public so far as possible. Altruism aside, it is in his *pecuniary* interest, *1363 indeed a matter of economic survival, that the businessman obtain and retain customers, the very purpose and function of a trademark, and that he avoid and preclude confusion. Millions of advertising dollars are spent daily for that precise purpose. The history of trademark litigation and the substantial body of law to which it relates demonstrate the businessman's alertness in seeking to enjoin confusion. In so doing he guards both his pocketbook and the public interest.

[7] Thus when those most familiar with use in the marketplace and most interested in precluding confusion enter agreements designed to avoid it, the scales of evidence are clearly tilted. It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere *assumption* that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not.

[8] The parties here agreed to restrict themselves in effect to the general purpose cleaning market (Horizon) and the automobile market (DuPont). Horizon is subject to suit for breach of contract and infringement if it promotes its RALLY products for cleaning automobiles. DuPont can be sued if it promotes its RALLY products in general cleaning. The fact that the goods of one party “could be used” in the

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field of the other is too conjectural and too widely applicable to form the sole basis of decision, particularly where, as here, the parties have agreed to avoid the promotion of such cross-use.

The mere fact of diverse marketing emphasis alone may not in every case preclude confusion. Without more, it may well be that purchasers active in both markets and familiar with products sold under a particular mark could attribute to the same source closely related goods sold under the same mark. The agreements herein, however, considered as a whole and notwithstanding certain phrases subject to contrary interpretation, evidence that confusion will be unlikely. As we read them, the very purpose and aim of the present agreements is the avoidance of public confusion. Under provision 6 of the assignment the parties agreed “to take any further actions and execute any further agreements needed to carry out the spirit and intent of this agreement.” The words of this court in a concurrent use proceeding, [In re Beatrice Foods, Co.](#), 429 F.2d 466, 57 CCPA 1302 (1970) are particularly apt:

* * * there can be no better assurance of the absence of any likelihood of confusion, mistake or deception than the parties' promises to avoid any activity which might lead to such likelihood.

It is reasonable to conclude that experienced businessmen fully and continuously alert to each others' products, labels, trade channels and advertising and parties to the agreements before us, will be quick to act against confusion. We cannot believe that Horizon would have sold its automotive business, assigned its mark and entered into the agreement or that DuPont would have accepted and paid for the assignment and entered into the agreement, if either thought for a moment that purchasers would seriously be confused as to source. Dollars were at stake. Decisions of men who stand to lose if wrong are normally more reliable than those of examiners and judges.

We have no hesitancy in holding, therefore, under the facts of this case, that confusion is not likely to stem from concurrent use of RALLY by Horizon and DuPont on their respective goods under the terms of their agreement. Accordingly, the decision of the board must be *reversed*.

From all of the foregoing, it can be seen that the

arguments presented in this and prior cases regarding the effect of a right to use and the need for protection of the public interest against confusion provide of themselves inadequate guides in determining likelihood of confusion under Sec. 2(d).

*1364 RIGHT TO USE-RIGHT TO REGISTER

[9][10] Decisional maxims like “the right to register follows the right to use,” sometimes defended as “reflecting the realities of the marketplace,” founder on their non-universality of application and the existence of Sec. 2(d). As attractive as that approach appears in [In re National Distillers Products Co.](#), 297 F.2d 941, 49 CCPA 854 (1962) and in the dissents in [Ultra-White Company, Inc. v. Johnson Chemical Industries, Inc.](#), 465 F.2d 891, 59 CCPA - (1972), [In re Avedis Zildjian Co.](#), 394 F.2d 860, 55 CCPA 1126 (1968) and [In re Continental Baking Co.](#), 390 F.2d 747, 55 CCPA 967 (1968), it is recognized as a goal and that the phrase “as nearly as possible” must be read into it. Clearly, a right to use is not a right to confuse. The rights to use and register are not identical. [Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc.](#), 293 F.2d 685, 49 CCPA 730 (1961), cert. den., 369 U.S. 864, 82 S.Ct. 1030, 8 L. Ed.2d 84 (1962). Many Marks, including those described in Sec. 2(a), (b), and (c), merely descriptive terms and those on labels defective under other laws (Rule 2.69), might all be used but not registered.

[11] Although a naked right to use cannot always result in registration, the Act does intend, as we said above, that registration and use be coincident so far as possible. Post-Lanham Act opinions relating to Sec. 2(d) which maintain an iron curtain between the rights to use and register do not contribute to stability in the law. Treating those rights as totally divorced entities only perpetuates the “arbitrary provisions” respecting confusion that the Congress thought it was eliminating more than twenty-five years ago.

THE PUBLIC INTEREST

[12] Whether offered in response to a right-to-use argument or against any of the evidentiary considerations listed above, citation of “the public interest” as a basis for refusal of registration is a bootless cry.^{FNS} We need add little to the shattering of that shibboleth in the concurring opinion in *National Distillers, supra*, and in the dissents in *Ultra-White*, *Zildjian* and *Continental Baking, supra*. Writers and scholars listed in those reported opinions have also shown the fallacy in

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the notion that the Patent Office is somehow guarding the public against confusion when it refuses a registration. After a likelihood of confusion is found (and the case thus decided) citation of the public interest is unnecessary.

[FN8](#). We are aware, of course, of our part in encouraging this very cry. In re Contimental Baking Co., above.

[\[13\]\[14\]](#) The Patent Office does have a guardianship role under Sec. 2(d). It lies not in a negative, nay-saying of refusal alone, but in the protection of a mark by registering it and then rejecting later improper attempts, of which the registrant is unaware, to register it or a similar mark. Refusal to register cannot prevent confusion. At most, it *might* discourage further use. [FN9](#) Refusal can, under certain circumstances, encourage potential confusion. Absence of a registration of RALLY for auto cleansers in the present case may, for example, lead others to adopt and use that or a similar mark for auto cleansers. Granting a registration will not produce confusion. Use alone can do that and neither we nor the Patent Office can grant or deny a right to use.

[FN9](#). That a rejected applicant might elect to abandon use, and thus reduce the potential for confusion, is a matter of the applicant's choice. Cf. [Glenwood Laboratories, Inc. v. American Home Products Corp., 455 F.2d 1384, 59 CCPA -\(1972\)](#).

[\[15\]](#) Presumably, everything the Patent Office and this court does is in the public interest. We find no place for “the guardianship of the public interest” as support for refusals to register under Sec. 2(d).

***1365 CONCLUSION**

What we have said under the heading “decisional process,” supra, which has been in effect or in part followed on occasion in the past by this and other courts and by the Patent Office, and the elimination of considerations regarding right to use and the public interest should in time lead, we believe, to increased conformity of the register with the realities of use in the marketplace, and to the greater stability sought in the Act.

Reversed.

BALDWIN, J., dissents.

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