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

Proceeding	92054629
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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In re Registration No. 3,904,929	)	
	)	
SHELTERED WINGS, INC.	)	
d/b/a/ Eagle Optics	)	
	)	Cancellation No. 92054629
Petitioner,	)	
	)	
v.	)	
	)	
WOHALI OUTDOORS, LLC	)	
	)	
Respondent.	)	

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**OPPOSITION TO WOHALI OUTDOORS, LLC'S  
MOTION FOR SUMMARY JUDGMENT**

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## **Introduction and Summary of Argument**

The ultimate issue in this cancellation proceeding is whether Wohali's registration for STEEL EAGLE should have issued over Eagle Optics' registrations for EAGLE OPTICS, EAGLE OPTICS and design, and GOLDEN EAGLE (the "EAGLE Marks"). Priority is not disputed: Eagle Optics applied for federal registration of each of the EAGLE marks years before Wohali applied for registration of STEEL EAGLE. Nor is there any dispute that the goods involved—particularly binoculars—are either identical or highly related to Eagle Optics' goods and retail services. The only contested issue is whether STEEL EAGLE poses a likelihood of confusion with the EAGLE Marks.

Wohali seeks early summary judgment, basing its motion almost exclusively on two purportedly undisputed facts. First, Wohali contends that in examining the application for STEEL EAGLE, the USPTO has already determined that there is no likelihood of confusion with the EAGLE Marks. Second, Wohali contends that in 2002, Eagle Optics admitted that the EAGLE OPTICS mark was weak. But neither of these so-called facts entitle Wohali to summary judgment.

Wohali's motion is fundamentally flawed. The USPTO's determination of registrability is, of course, not conclusive or there would be no need for opposition or cancellation proceedings. In this case, the examination of the STEEL EAGLE application was impeded by Wohali's indefinite description of the goods as "magnifying optical equipment," which the examining attorney rejected. But at the time the examining attorney made the search on which he based his likelihood of confusion analysis, he did not know that STEEL EAGLE would be registered for binoculars. Accordingly, when he narrowed his search by using Wohali's indefinite description of the goods, he missed the EAGLE Marks.

Eagle Optics' 2002 statements about the strength of EAGLE OPTICS are no longer pertinent because Eagle Optics has spent the last decade expanding its business and developing its reputation for high-quality binoculars and scopes. As a result of a sustained marketing effort, and successful trademark enforcement, the EAGLE OPTICS mark has acquired substantial strength and it is now widely recognized as a leading brand in the outdoor optics market.

Applying the *Du Pont* factors, as Eagle Optics shows in the rest of this brief, the Board must deny Wohali's motion. Wohali has not demonstrated that it is entitled to judgment as a matter of law. However, if after reviewing the evidence submitted by Eagle Optics, the Board determines that the material facts are not genuinely undisputed, the Board may grant summary judgment against Wohali. TBMP § 528.01. It should do so here, because it is Eagle Optics that is entitled to judgment as a matter of law on the likelihood of confusion issue.

### **Summary Factual Background**

Eagle Optics provides here a summary factual background to provide information omitted by Wohali. Additional factual detail is provided where it is pertinent in the Argument section.

Eagle Optics started as a retail business 25 years ago. The founding and growth of the company, and its use of the EAGLE Marks, is described in the Declarations of Daniel C. Hamilton (the "Hamilton Decl.") and Ben Lizdas ("Lizdas Decl."), and thus it need not be repeated in full here. Eagle Optics been using its EAGLE OPTICS mark for retail services since at least as early as 1987 to sell binoculars, spotting scopes, and other optics. Hamilton Decl. at ¶¶ 2-17. In 1996, Eagle Optics been selling its own EAGLE OPTICS branded binoculars and spotting scopes. *Id.* at ¶ 7. In Eagle Optics' current line, its GOLDEN EAGLE binocular is its top-of-the-line product, which it has sold continuously since 2010. *Id.* at ¶ 18.

In the 25 years that Eagle Optics has been in business, and particularly in the last ten years, the company and the EAGLE OPTICS brand has grown into a multi-million dollar company and a well-known optics brand. Hamilton Decl. ¶¶ 2-18, 28-35. Eagle Optics sells its EAGLE OPTICS branded products through its retail store in Wisconsin, the EAGLE OPTICS website, the Wild Birds Unlimited franchise system, as well as many other retailers. Hamilton Decl. ¶¶ 29-31. Eagle Optics engages in many advertising and promotional activities, and it has been featured favorably in third party articles and product reviews. Hamilton Decl. ¶¶ 32-35; Lizdas Decl. ¶¶ 2-13. In 2000, Eagle Optics began a program of trademark registration and enforcement. Hamilton Decl. ¶ 36.

The Eagle Optics’ registrations pertinent to this proceeding are set out in the chart below:

Mark/Reg. No.	Application and Registration Dates	Goods and Services
GOLDEN EAGLE Reg. No. 3,787,739	App: Dec. 8, 2006 Reg: May 11, 2010	Class 9: Binoculars
EAGLE OPTICS Reg. No. 2,886,199	App: Oct. 5, 2000 Reg: Sep. 21, 2004	Class 9: Binoculars, spotting scopes, and telescopes, all for use in bird watching, and storage cases therefore
 Reg. No. 3,192,083	App: Aug. 24, 2005 Reg: Jan. 2, 2007	Class 9: Binoculars, spotting scopes, telescopes, and storage cases therefore, all for use in birdwatching  Class 35: Retail store, mail order and online retail store services featuring binoculars, spotting scopes, telescopes, and storage cases therefore, all for use in birdwatching

Hamilton Decl. ¶ 14; *see also* Declaration of Jacqueline M. Schwartz, (“Schwartz Decl.”) ¶¶ 2-7, Exs. A-F. Reg. Nos. 2,886,199 and 3,192,083 are incontestable. Schwartz Decl. ¶¶ 2, 4, Exs. A, C.

Wohali began business in 2009; its primary business is fishing related items, particularly clothing. *See* Wohali’s Website, Reg. No. 3,911,635 for WOHALI, and Oklahoma Secretary of State summary (Schwartz Decl. ¶¶ 16-18, Exs. O-Q); *see also* Declaration of Brett L. Foster ¶¶ 6-7 filed in *Sheltered Wings, Inc. v. Wohali Outdoors, LLC*, No. 11-cv-300 (W.D. Wis.), (Schwartz Decl. ¶ 15, Ex. N) (regarding Wohali’s counsel’s explanation of its business and “miniscule” use of STEEL EAGLE for optics). The Wohali registration pertinent to this proceeding is:

Mark/Reg. No.	Application and Registration Dates	Goods and Services
STEEL EAGLE Reg. No. 3,904,929	App: Mar. 12, 2009 Reg: Jan. 11, 2011	Class 9: Magnifying optical equipment, namely, rifle scopes and binoculars.

Responding directly to Wohali’s numbered statement of facts, Eagle Optics sharply disputes Wohali’s proposed fact No. 14, concerning the similarities between the parties’ marks, for reasons explained below. Proposed facts Nos. 6 (concerning Wohali’s awareness of Eagle Optics’ trademarks) and 15 (concerning the sophistication of consumers) are disputed on the grounds that Wohali is obligated to provide discovery responses on these issues, but these facts are not material. Eagle Optics does not dispute the purely factual aspects of Wohali’s proposed facts Nos. 1-5, 7-13 and 16-17, although Eagle Optics rejects Wohali’s interpretation of these facts.

**Argument**

**I. Wohali’s “bare motion” for summary judgment should be denied.**

Wohali’s motion for summary judgment is premised on the peculiar notion that Eagle Optics has “failed to submit any evidence supporting its claim.” Wohali Br. 5. Wohali is correct that Eagle Optics bears the burden here, and that as the respondent, Wohali may submit a bare

motion for summary judgment pointing out the petitioner's lack of evidence. But Wohali overlooks that Eagle Optics has not yet been required to, or even had the opportunity to, submit evidence.<sup>1</sup> Until now.

Eagle Optics submits here evidence supporting its petition for cancellation, and Wohali's "bare motion" does not demonstrate that there are no genuine disputes of material fact and that it is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56; TBMP § 528.01; *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). Eagle Optics' evidence, which Wohali cannot controvert, shows that Eagle Optics is entitled to judgment as a matter of law. If the Board concludes that there is no genuine issue of material fact, the Board may enter summary judgment in favor of Eagle Optics. TBMP § 528.01.

But in evaluating Wohali's motion, standard summary judgment principles apply. As the non-moving party, Eagle Optics receives the benefit of any inferences which may be drawn from the underlying facts, and the evidence of record must be viewed in the light most favorable to Eagle Optics. *See Texas Dep't of Transp. v. Tucker*, 95 U.S.P.Q.2d 1241, 1242 (T.T.A.B. 2010) (citing *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 U.S.P.Q.2d 1542 (Fed. Cir. 1992)). The Board may not resolve issues of material fact against the non-moving party; it may only ascertain whether such issues are present. *See Texas Dep't of Transp.*, 95 U.S.P.Q.2d at 1242-43 (citing *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 U.S.P.Q.2d 2027 (Fed. Cir. 1993) and *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 U.S.P.Q.2d 1471 (Fed. Cir. 1992)).

Wohali faces an uphill battle as the "junior" user of its mark. As the newcomer to the outdoor optics market, Wohali had an obligation to select a mark that would avoid confusion,

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<sup>1</sup> Wohali's early motion for summary judgment suspended discovery before it had received Eagle Optics' written discovery responses, and before Wohali had to put up a witness for the Rule 30(b)(6) deposition that Eagle Optics had noticed.

which it did not do. *J&J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1463-64, 18 U.S.P.Q.2d 1889, 1892 (Fed. Cir. 1991). Thus, to the extent that there is any doubt on the issue of likelihood of confusion, such doubt must be resolved in favor of Eagle Optics. *See TBC Corp. v. Holsa, Inc.*, 126 F.3d 1470, 1473, 44 U.S.P.Q.2d 1315, 1318 (Fed. Cir. 1997); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 U.S.P.Q.2d 1025 (Fed. Cir. 1988).

**II. Eagle Optics' trademark rights in its EAGLE Marks are prior to Wohali's application for its STEEL EAGLE mark.**

There can be no dispute that Eagle Optics has priority. Wohali filed its intent-to-use application for STEEL EAGLE on March 12, 2009, and began using STEEL EAGLE for binoculars and riflescopes on October 21, 2009. *See* Wohali's Resp. to Interrog. No. 3, (Schwartz Decl. ¶ 13, Ex. L); *see also* File Hist., Reg. No. 3,904,929 for STEEL EAGLE (Schwartz Decl. ¶¶ 9-10, Exs. H-I). Because 15 U.S.C. § 1057(c) gives an applicant the benefit of constructive nationwide use of a registered mark as of the application filing date, the date to beat is March 12, 2009.

Eagle Optics' rights are long prior to March 12, 2009. Eagle Optics has been using EAGLE OPTICS in connection with selling binoculars and other optics since at least as early as 1987, and has been selling EAGLE OPTICS branded optics since 1996. Hamilton Decl. ¶¶ 2-18. Eagle Optics also filed its applications to register each of its EAGLE Marks before Wohali filed its application. *See* Regs. and File Histories (Schwartz Decl. ¶¶ 2-7, Exs. A-F).

**III. Under the *Du Pont* factors, there is a likelihood of confusion between STEEL EAGLE and Eagle Optics' EAGLE Marks.**

Wohali's use of the STEEL EAGLE mark is likely to cause confusion with Eagle Optics' use of its EAGLE marks—EAGLE OPTICS and GOLDEN EAGLE. The familiar *Du Pont* factor test governs the analysis of likelihood of confusion under Section 2(d) of the Trademark Act. *See In re E.I. Du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (C.C.P.A.

1973). Not all of the factors are relevant and only those relevant factors for which there is evidence in the record must be considered. *Id.* at 1361-62, 177 U.S.P.Q. at 567-68.

Although there is no mechanical test for determining likelihood of confusion, the two most important factors are usually the similarities between the parties' goods and the similarity between the parties' marks. *See In re SL& E Training Stable, Inc.*, 88 U.S.P.Q.2d 1216 (T.T.A.B. 2008) (citing *Federated Foods, Inc. v. Ft. Howard Paper Co.*, 544 F.2d 1098, 1103, 192 U.S.P.Q. 24, 29 (C.C.P.A. 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.") Where, as here, the parties' goods are identical or closely related, the degree of similarity of the marks necessary to find a likelihood of confusion does not need to be as great as where the goods are less similar. *See SL&E*, 88 U.S.P.Q.2d 1216.

As explained below, the two most important factors—similarity of the goods and similarity of the marks—favor Eagle Optics. Because the EAGLE Marks are strong in the outdoor optics market, and because the parties sell their products through identical trade channels and to the same categories of purchasers, these factors also favor Eagle Optics. The only other factors on which there is evidence are actual confusion, intent, and sophistication of the consumers, but the evidence on these factors does not favor either party. Thus, under the *Du Pont* test, there is a likelihood of confusion between the parties' marks.

**A. The parties' respective goods are identical.**

The goods in the parties' respective registrations are identical. The similarity of the goods is one of the most important factors in the likelihood of confusion analysis. *SL&E*, 88 U.S.P.Q.2d 1216. Wohali's registration for STEEL EAGLE is for "magnifying optical equipment, namely rifle scopes and binoculars." *See* Reg. Cert. (Schwartz Decl. ¶ 9, Ex. H). Eagle Optics' Registration No. 3,787,739 for GOLDEN EAGLE is for "binoculars." Schwartz

Decl. ¶ 6, Ex. E. Eagle Optics' Registration Nos. 2,886,199 and 3,192,083 for EAGLE OPTICS and EAGLE OPTICS and Design are for "Binoculars, spotting scopes, telescopes, and storage cases therefore, all for use in birdwatching." Schwartz Decl. ¶¶ 2, 4, Exs. A, C. The '083 Registration also covers "Retail store, mail order and online retail store services featuring binoculars, spotting scopes, telescopes and storage cases therefore, all for use in birdwatching." *Id.* This factor is not in dispute, and it favors Eagle Optics.

**B. STEEL EAGLE is confusingly similar to the EAGLE Marks.**

The parties marks here are similar. They share the dominant element "EAGLE," and have similar commercial impressions. The *Du Pont* factor concerning the similarity of the parties' marks requires that the marks be compared in their entirety, and should not be dissected. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 U.S.P.Q. 272 (C.C.P.A. 1974). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison; the issue is whether the marks create a similar commercial impression. *Visual Information Institute, Inc. v. Vicon Industries, Inc.*, 209 U.S.P.Q. 179 (T.T.A.B. 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than a specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 U.S.P.Q. 537 (T.T.A.B. 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 U.S.P.Q. 106 (T.T.A.B. 1975); *see also* TMEP § 1207.01(b) (8th ed. Oct. 2011). What is important is not whether people will necessarily confuse the marks, but whether the marks will be likely to confuse people into believing that the goods they are purchasing emanate from the same source. *See Kangol, Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 23 U.S.P.Q.2d 1945 (Fed. Cir. 1992).

**1. The commercial impression of STEEL EAGLE is similar to that of EAGLE OPTICS and GOLDEN EAGLE.**

The parties' marks have similar commercial impressions because the dominant portion of the marks is the shared term EAGLE. In most composite marks, part of the mark is dominant in its impact on consumers. It is well established that a "disclaimed segment of a composite registration is not the 'dominant' part." 4 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 23:45 (4th ed. 2012) ["McCarthy"]; *see also e.g., In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 U.S.P.Q.2d 1531 (Fed. Cir. 1997) (finding that the dominant part of THE DELTA CAFE and design was "DELTA" because "CAFE" was disclaimed). Because the term EAGLE is more dominant than the other elements of the parties' marks, greater weight should be given to this term when comparing the marks. *See Kangol, Ltd.*, 974 F.2d 161, 23 U.S.P.Q.2d 1945. In *Kangol*, the Federal Circuit held that it was appropriate to give greater weight to the dominant element "KANG" in comparing KANGOL and design for golf shirts to KANGAROOS and design for athletic shirts, and that the similarities in these two marks outweighed the differences. *Id.* at 163, 23 U.S.P.Q.2d at 1946.

Here, Wohali disclaimed the term STEEL from its mark, and Eagle Optics disclaimed the term OPTICS. *See* Reg. Certs. (Schwartz Decl. ¶¶ 2, 4, 9, Exs. A, C, H). Thus, the dominant portion of each of the marks: STEEL EAGLE, GOLDEN EAGLE, and EAGLE OPTICS is the term "EAGLE." Because of the dominance of the term EAGLE, the parties marks are also similar in sight, sound, and any connotation associated with the term EAGLE. The disclaimed—thus presumptively descriptive—elements of the parties' marks are insufficient for consumers to distinguish between the source of products bearing those marks. As further evidence of similarity, the examiner of Eagle Optics' application to register the mark EAGLE refused the

application because of Wohali's STEEL EAGLE registration. *See* Apr. 12, 2011 Office Action, (Schwartz Decl. ¶ 8, Ex. G).

The parties' marks are also similar because the marks STEEL EAGLE and GOLDEN EAGLE both connote or suggest that an aspect of the product is the respective metal, STEEL or GOLD. Consumers would naturally expect optics bearing STEEL EAGLE and GOLDEN EAGLE to come from the same source. Because the EAGLE OPTICS company has been a retailer of optics for more than 25 years and sells a line of EAGLE OPTICS binoculars, consumers would also logically expect that STEEL EAGLE binocular may be one product in the EAGLE OPTICS branded line of binoculars.

This case is similar to many other cases in which the Board and the federal courts have held that marks sharing a term for similar goods or services are likely to cause confusion, for example: CHIC and L.A. CHIC both for women's clothing<sup>2</sup>; DUTCH MASTERS and LITTLE DUTCHMAN for cigars<sup>3</sup>; UNCLE BEN's and BEN's BREAD for various food products<sup>4</sup>; HARD ROCK CAFE and COUNTRY ROCK CAFE both covering apparel;<sup>5</sup> ITUNES and VTUNES.NET for digital music and video downloads;<sup>6</sup> TITAN and VANTAGE TITAN for ultrasound machines and MRI machines respectively;<sup>7</sup> JOSE GASPAR GOLD and GASPAR ALE for tequila and beer respectively;<sup>8</sup> SQUIRT SQUAD and SQUIRT for water toys, and

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<sup>2</sup> *Henry Siegel Co. v. M&R Int'l Mfg. Co.*, 4 U.S.P.Q.2d 1154 (T.T.A.B. 1987).

<sup>3</sup> *Consolidated Cigar Corp. v. M. Landaw, Ltd.*, 474 F.2d 1402, 177 U.S.P.Q. 328 (C.C.P.A. 1973).

<sup>4</sup> *Uncle Ben's, Inc. v. Stubenberg Int'l*, 47 U.S.P.Q.2d 1310 (T.T.A.B. 1998).

<sup>5</sup> *Hard Rock Cafe Int'l (USA) v. Elsea*, 56 U.S.P.Q.2d 1504 (T.T.A.B. 2000).

<sup>6</sup> *Apple Computer v. TVNET.net, Inc.*, 90 U.S.P.Q.2d 1393 (T.T.A.B. 2007).

<sup>7</sup> *In re Toshiba Med. Sys. Corp.*, 91 U.S.P.Q.2d 1266 (T.T.A.B. 2009).

<sup>8</sup> *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 U.S.P.Q.2d 1944 (Fed. Cir. 2004).

balloons and soda respectively;<sup>9</sup> POWERWAVE and ACCOUSTIC WAVE for amplifying systems;<sup>10</sup> and THE DELTA CAFE and CAFE for restaurant services.<sup>11</sup>

By contrast, the only case cited by Wohali concerning the similarity of the marks factor is inapposite. *See* Wohali Br. 6 (citing *Continental Distilling Corp. v. Norman Williams Co.*, 443 F.2d 392, 170 U.S.P.Q. 132 (C.C.P.A. 1971)). In *Continental*, registrations for CUMBERLAND BELLE, RIVER BELLE, HEATHER BELLE, and CANADIAN BELLE for whiskey were allowed in view of a registration for DIXIE BELLE for gin. *Id.* at 394, 170 U.S.P.Q. at 133. But in *Continental*, there was “no evidence before the court as to the advertising, sale, reputation or goodwill of the mark DIXIE BELLE,” and the court clearly did not view the term BELLE as the dominant term in the mark. *Id.* at 394, 170 U.S.P.Q. at 133.

**2. The examining attorney that reviewed Wohali’s application to register STEEL EAGLE did not consider Eagle Optics’ EAGLE Marks.**

Wohali relies heavily on the USPTO’s issuance of a registration of STEEL EAGLE as support for its motion, but that determination is of course not definitive and it is subject to review by the Board. In this case, the prosecution history of the registration shows why the examining attorney overlooked the EAGLE marks.

The examining attorney’s search for conflicting marks was impeded by Wohali’s indefinite identification of goods in its application. The application identified the goods only as “magnifying optical equipment,” which the examining attorney rightly rejected as indefinite. Because the examining attorney had only this indefinite identification when he evaluated the likelihood of confusion, he did not at that time know that the STEEL EAGLE mark was to be registered for “binoculars.” The search strategy is documented in the file history:

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<sup>9</sup> *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 U.S.P.Q. 937 (Fed. Cir. 1983).

<sup>10</sup> *Bose Corp. v. QSC Audio Prod., Inc.*, 293 F.3d 1367, 1378, 63 U.S.P.Q.2d 1303, 1311 (Fed. Cir. 2002).

<sup>11</sup> *In re Dixie Restaurants, Inc.*, 105 F.3d at 1407, 41 U.S.P.Q.2d at 1533-34.

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*** User:rmcmorrow ***
#   Total   Dead   Live   Live   Status/   Search
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                                Docs   Images   Duration
01  3747     N/A     0       0     0:01     *steel*[bi,ti]
02 10227     N/A     0       0     0:02     *eagl* or *eag(v)1* or *egl* or *eg(v)1*[bi,ti]
03   5       0       5       3     0:01     1 and 2 not dead[ld]
04 2625046   N/A     0       0     0:03     "009"[cc]
05  2705     N/A     0       0     0:02     (1 or 2) and 4 not dead[ld]
06  778837   N/A     0       0     0:04     "009"[ic] or "200"[ic] or "a"[ic] or "b"[ic]
07  709      0       709     456   0:01     5 and 6
08 17657     N/A     0       0     0:02     magnifying[gs] or lenses[gs]
09  15       0       15      11    0:01     7 and 8

Session started 6/5/2009 2:07:22 PM
Session finished 6/5/2009 2:23:27 PM
Total search duration 0 minutes 17 seconds
Session duration 16 minutes 5 seconds
Default NEAR limit=1ADJ limit=1

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See File Hist., (Schwartz Decl. ¶ 10, Ex. I at 83).

As shown above, the examining attorney began with query 1 for marks that include variations of the term “steel,” producing 3,747 results. Query 2 found marks that included variations of the term “eagle,” producing 10,227 results. The EAGLE marks would have been within query 2, but there were too many results to review individually. Queries 4 and 6 identified marks in classifications related to international class 9. Query 7 identified marks that included variations of either “steel” or “eagle” within classes related to international class 9, producing 709 results. The EAGLE marks would have been within query 7, but the examining attorney could not have carefully evaluated 709 marks in a session that took only 16 minutes and 5 seconds, because it would have given him only 1.36 seconds per mark. Instead, the examining attorney focused the search using Wohali’s description of the goods. Queries 8 and 9 identified marks that had “magnifying” or “lenses” in the identification of goods and services. This produced a reasonable set of 15 marks, but it did not include the EAGLE marks, which do not use those terms in the description of goods and services.

When an office action issued—the same one in which the examiner said he “found no conflicting marks”—Wohali was required to clarify its identification of goods to add the language “namely, binoculars and rifle scopes.” *See* June 5, 2009 Office Action, (Schwartz Decl. ¶ 10, Ex. I at 49-52). But at the time the examining attorney searched for conflicting marks, he did not know that STEEL EAGLE would be used for binoculars. If he had used “binoculars” in query 8, he would have found the EAGLE marks, and he should have rejected the application to register STEEL EAGLE.

In sum, the similarity of the marks factor strongly favors Eagle Optics.

**C. The parties sell their optics products through identical trade channels and to the same categories of purchasers.**

The *Du Pont* factors require evaluating the similarity or dissimilarity of the parties’ trade channels. *See Du Pont*, 177 U.S.P.Q. 563, 567. Where the parties’ goods are identical, the law presumes that the channels of trade and the classes of purchaser are the same. *SL&E*, 88 U.S.P.Q.2d 1216. The evidence here shows it as well.

Both parties sell their optics products through “wholesale, distribution, and retail channels.” *See* Wohali’s Resp. to Interrog. No. 5 (Schwartz Decl. ¶ 13, Ex. L); Hamilton Decl. ¶ 29. The parties’ consumers also overlap. Wohali describes its actual and intended consumers are “outdoor related product consumers.” *See* Wohali’s Resp. to Interrog. No. 6 (Schwartz Decl. ¶ 13, Ex. L). Eagle Optics’ target consumers are outdoor enthusiasts, including, birdwatchers and hunters. Hamilton Decl. ¶ 28. This factor is undisputed, and favors Eagle Optics.

**D. The EAGLE Marks are strong in the outdoor optics market.**

As strong marks in the outdoor optics market, the EAGLE Marks are entitled to a wide scope of protection in that market. The factor concerning the fame or strength of the mark, when present, plays a dominant role in the process of balancing the *Du Pont* factors. *See Kenner*

*Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 U.S.P.Q.2d 1453 (Fed. Cir. 1992). The concept of “fame” for purposes of the likelihood of confusion analysis is not the same as the concept of fame for dilution purposes. While dilution fame is an “either/or proposition,” the fame factor in the likelihood of confusion analysis varies along a spectrum from very strong to very weak. *Palm Bay Imps. v. Veuve Clicquot Ponsardin Maison Fondée En* 1772, 396 F.3d 1369, 1374-75, 73 U.S.P.Q. 2d 1689, 1694 (Fed. Cir. 2005).

Here, the EAGLE Marks are on the “strong” end of the spectrum; not on the “weak” end as Wohali contends. Eagle Optics has considerable evidence of the strength of its EAGLE Marks, submitted in the accompanying declarations of Daniel C. Hamilton, president of Eagle Optics, and Ben Lizdas, Sales Manager of Eagle Optics. By contrast, Wohali only cites two pieces of evidence as support for its argument that the EAGLE Marks are weak: 1) a consent agreement with Nikon executed in 2003, and 2) statements made during prosecution of a trademark application for EAGLE OPTICS that are now 10-years old. However, Wohali’s evidence is outdated and unpersuasive, and the Board should find that the strength of the mark factor favors Eagle Optics.

**1. Eagle Optics is a well-known company in the outdoor optics market and the EAGLE Marks have significant market strength.**

The Eagle Optics company is well-known among purchasers and potential purchasers of outdoor optics products, especially among bird watchers and other outdoor enthusiasts. In assessing the strength of the EAGLE Marks, the relevant class of consumers is “the class of customers and potential customers and potential customers of a product of service, and not the general public.” *Id.* at 1375; 73 U.S.P.Q.2d at 1695. Direct evidence of the strength of a mark is not necessary; indirect or circumstantial evidence has always been accepted, in much the way that secondary meaning is proven. *See Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 63

U.S.P.Q.2d 1303 (Fed. Cir. 2002); *Barbara's Bakery, Inc. v. Landesman*, 82 U.S.P.Q.2d 1283, 1287 (T.T.A.B. 2007) (finding that opposer's marks BARBARA'S and BARBARA'S BAKERY "have achieved a degree of renown, at least in the natural foods marketplace" and explaining that this is "sufficient to establish that opposer's mark is a strong mark").

The Eagle Optics company and the EAGLE OPTICS brand are well-known among outdoor enthusiasts and bird watchers. Eagle Optics has been using the EAGLE OPTICS mark since 1986—for more than 25 years—in connection with the sale of binoculars, spotting scopes, and other optics related equipment and accessories. Hamilton Decl. ¶¶ 2-17, Exs. 1-12; Lizdas Decl. ¶ 3, Ex. A. Over the years, the Eagle Optics company and the EAGLE OPTICS brand grew from a small mail order retail business into a multi-million dollar company and well-known optics brand. Hamilton Decl. ¶ 13. At first, Eagle Optics sold optics from other companies, such as Nikon, Swarovski, Bushnell, and Zeiss, but in 1996, Eagle Optics introduced its own EAGLE OPTICS branded optics products. *Id.* at ¶¶ 3-7. The EAGLE OPTICS line of products grew to include binoculars, spotting scopes, and telescopes. *Id.* at ¶ 7. Currently, in Eagle Optics' EAGLE OPTICS line of binoculars, its GOLDEN EAGLE binocular is its top of the line binocular, which it has sold continuously since 2010. *Id.* at ¶ 18.

Eagle Optics sells its products directly and through distributors. Eagle Optics created its website at [www.eagleoptics.com](http://www.eagleoptics.com) in 1996, and began to sell optics through its website in 1998. Hamilton Decl. ¶¶ 8, 10. Eagle Optics also still sells directly to customers through its retail store in Middleton, WI. *Id.* at ¶ 29. Since about 2000, EAGLE OPTICS products have been the primary in-store optics brand for the Wild Birds Unlimited franchise system. *Id.* at ¶ 30. Currently, Wild Birds Unlimited has approximately 220 franchise stores that sell EAGLE OPTICS branded products, and in many cases, the optics carried by Wild Birds Unlimited stores

are exclusively EAGLE OPTICS products. *Id.* at ¶ 30. EAGLE OPTICS branded products are also sold by independent retailers such as: B&H Photo, Optics Planet, Binoculars.com, Gold Crest Distribution, Aveoptica Mexico, Eagle Optics Canada, Birdwatching.com, Optics 4 Birding, and Online Nature Mall. *Id.* at ¶ 31.

Because of Eagle Optics' success, the company and its EAGLE OPTICS products have been featured in industry publications and product reviews by third parties. EAGLE OPTICS binoculars are regularly featured in independent product reviews of midpriced binoculars, along with the other major optics companies in the industry. Hamilton Decl. ¶¶ 34-35, Exs. 18-22. Because of the company's remarkable growth from humble beginnings, Eagle Optics has also been the subject of feature articles written by third parties. Hamilton Decl. ¶ 33, Exs. 16-17.

Even consumers who have not purchased EAGLE OPTICS products themselves will be familiar with the EAGLE OPTICS brand and the GOLDEN EAGLE binocular because of Eagle Optics' promotional activities, such as advertisements placed in major bird watching printed publications such as Bird Watcher's Digest, Birding Magazine Living Bird Magazine, WildBird Magazine, Indiana Outdoor News, and Michigan Birds and Natural History, as well as online with Internet news providers, blogs, Internet search engines, Facebook, and YouTube. Lizdas Decl. ¶¶ 4-5, 12, Exs. B-F. Eagle Optics' websites receive approximately 41,000 unique visitors each month; and Eagle Optics publishes its electronic newsletter to 16,000 people weekly. Lizdas Decl. ¶ 13. Eagle Optics also promotes its company and its brands through regular attendance and participation at trade shows, festivals, and other events. Lizdas Decl. ¶ 6 (listing 16 different events typically attended by Eagle Optics); *see also* ¶ 7, Ex. G (photos from recent tradeshow). As part of its promotional and marketing efforts, and to be a good citizen in the outdoor and bird watching communities, Eagle Optics also makes regular donations of money

and products to certain organizations in the bird watching and hunting markets, and sponsors events and activities in these markets. Lizdas Decl. ¶ 9 (listing 91 donations in 2011); *see also* Lizdas Decl. ¶¶ 10-11, Exs. I-L (discussing special promotions with the U.S. Fish & Wildlife Service and Operation Migration).

Eagle Optics greatly values its trademark rights and takes active steps to protect its marks. Eagle Optics has had several successes in enforcing its trademark rights in the EAGLE OPTICS mark against infringers. *See* Hamilton Decl. ¶ 36, Exs. 23-29. *See* 2 McCarthy § 11.91 (“an active program of prosecution of infringers . . . enhances the distinctiveness and strength of a mark.”).

**2. The 2003 consent agreement with Nikon is not compelling evidence of the weakness of EAGLE OPTICS.**

Wohali overstates the significance of a 2003 consent agreement between Eagle Optics and Nikon as evidence of the weakness of the EAGLE OPTICS mark. A prior consent agreement with a third party does not preclude enforcement of trademark rights against a different, infringing third party. *See Anthony’s Pizza & Pasta Int’l Inc. v. Anthony’s Pizza Holding Co.*, 95 U.S.P.Q.2d 1271 (T.T.A.B. 2009), *aff’d*, 415 Fed. App’x 222 (Fed. Cir. 2010); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 U.S.P.Q.2d 1201 (Fed. Cir. 2003); *DC Comics v. Pan Am. Grain Mfg. Co.*, 77 U.S.P.Q. 2d 1220 (T.T.A.B. 2005). A prior consent agreement is just one fact that may be received in evidence as part of “the total picture confronting the decision maker.” *Anthony’s Pizza*, 95 U.S.P.Q.2d at 1281. The Board has explained that: “[u]nder no circumstances, may a party’s opinion, earlier or current, relieve the decision maker of the burden of reaching his own ultimate conclusion on the entire record.” *Id.* at 1281 (citing *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 929, 198 U.S.P.Q. 151, 153-54 (C.C.P.A. 1978)).

Although Wohali submitted the consent agreement itself, Wohali is missing the relevant context. One of Eagle Optics' first trademark applications was to register the word mark EAGLE OPTICS, which was filed in 2000, many years after the company had been in business. Hamilton Decl. ¶ 19. In 2002, when its trademark application serial no. 78/029,311 for EAGLE OPTICS was refused over Nikon's registration number 2,084,361 EAGLEVIEW for binoculars, Eagle Optics petitioned to cancel Nikon's registration on the ground that Eagle Optics' use of its mark was prior to Nikon's use of its mark. Hamilton Decl. ¶¶ 19-22. Eagle Optics has been using its EAGLE OPTICS mark long before NIKON started using the term EAGLEVIEW. *Id.* at ¶ 22, Ex. 13.

In response to the petition for cancellation, Nikon informed Eagle Optics that its petition was filed after the 5-year statute of limitations in 15 U.S.C. § 1064 for seeking cancellation of a similar mark. Hamilton Decl. ¶ 23. Nikon and Eagle Optics had a nearly 15-year long relationship by 2002. *Id.* at ¶ 24. Eagle Optics had been an authorized dealer of Nikon products since about 1988. *Id.* At all times known to Eagle Optics, and as shown in specimens of use in the USPTO file history for Nikon's Registration No. 2,084,361, Nikon uses the mark as NIKON EAGLEVIEW ZOOM. Hamilton Decl. at ¶ 25, Ex. 14; see also Nikon's Specimens of Use filed in 2003 and 2007, (Schwartz Decl. ¶ 12, Ex. K at 9 and 17). Given the actual use of Nikon's mark, Eagle Optics' priority, the untimely petition to cancel, and the long relationship with Nikon—all during Eagle Optics' early experience in the USPTO, the consent agreement seemed like a reasonable solution to Eagle Optics. Hamilton Decl. ¶ 24. The consent agreement was eventually signed in 2003. Taken together with the relevant context, the 2003 consent agreement does not constitute a binding admission.

Wohali incorrectly argues that *Freedom Card, Inc. v. JP Morgan Chase & Co.*, 432 F.3d 463, 77 U.S.P.Q.2d 1515 (3d Cir. 2005) requires the Board to treat Eagle Optics' consent agreement with Nikon as an admission, or a judicial estoppel. As an initial matter, the case is factually distinct from the case at hand. In *Freedom Card*, the marks in issue were CHASE FREEDOM (owned by JP Morgan Chase) and FREEDOM CARD (licensed exclusively by Freedom Card, Inc.) both for credit cards. One key factual distinction is that Freedom Card, the senior user, had stopped using the mark before JP Morgan Chase began using its mark. 432 F.3d at 466, 77 U.S.P.Q.2d at 1518. This was also a reverse confusion case, in which the law is concerned with a larger more powerful company usurping the mark of a smaller company, which is not the case here. The marks in *Freedom Card* were differently positioned as well; the house mark CHASE is extremely well known and the term FREEDOM was extremely common or weak for financial services. The opinion explained that there were "20 MasterCard and VISA 'freedom' credit cards and roughly 50 MasterCard and VISA 'freedom' debit and ATM cards" as well as "about 25 banks using 'freedom' as part 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.'" 432 F.3d at 469, 77 U.S.P.Q.2d at 1519. On these facts, the court should have found that there was no likelihood of confusion, even without the prior consent agreement.

More important, Wohali also failed to mention that the TTAB has specifically considered but declined to apply *Freedom Card* in *Anthony's Pizza & Pasta Int'l Inc. v. Anthony's Pizza Holding Co.*, 95. U.S.P.Q.2d 1271 (T.T.A.B. 2009), which provides the better view of the Board's treatment of prior consent agreements with third parties. In *Anthony's Pizza*, the Board held that the owner of ANTHONY'S PIZZA & PASTA, who sought cancellation of the respondent's mark ANTHONY'S COAL-FIRED PIZZA, was not prevented from enforcing its

mark in that proceeding because of a prior consent agreement with a third party (using ANTHONY’S PIZZA THE WORLD’S GREATEST). 95 U.S.P.Q.2d at 1282 (ultimately cancelling respondent’s registration). Just like the case at hand, in *Anthony’s Pizza*, circumstances had changed since the consent agreement. In *Anthony’s Pizza*, the petitioner admitted that the consent agreement “seemed like a good idea at the time” because petitioner’s business was in its infancy and not in a good position to negotiate. *Id.* at 1281. The Board explained that the consent agreement was just one fact in evidence, and the “total picture” must be considered, (*id.* at 1282), which is how the consent agreement between Nikon and Eagle Optics should be considered here.

**3. Ten-year old statements made during trademark prosecution of the application for EAGLE OPTICS should be disregarded.**

The Board should give no evidentiary value to statements made by Eagle Optics’ former trademark counsel during prosecution of its Application Serial Number 78/029,311 (Registration No. 2,886,199) for EAGLE OPTICS (word mark). The statements at issue are statements in responses to office actions in 2002—10 years ago—in which Eagle Optics’ former counsel said that the term “eagle” was weak for optical products in view of existing marks containing the term for optical products. *See* Wohali Br. 3, 8. Wohali incorrectly argues that these statements should be treated as judicial admissions.

These statements are not admissions; there is no doctrine of “file wrapper estoppel” in trademark cases. *See Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 U.S.P.Q. 955, 963 (T.T.A.B. 1986) (citing *Goodyear Tire & Rubber Co. v. A.J. Indus. Corp.*, 165 U.S.P.Q. 665 (T.T.A.B. 1970); *Allstate Life Ins. Co. v. Cuna Int’l, Inc.*, 169 U.S.P.Q. 313 (T.T.A.B. 1971), *aff’d*, 487 F.2d 1407 (C.C.P.A. 1973)). In *Giant Food*, the Board held that statements made by the opposer (owner of SUPER SORB for paper towels) concerning likelihood of confusion with

a third party's mark (SUPERSORB for paper hospital supplies) during prosecution of its application to register its pleaded registration would not be given preclusive effect against the applicant's mark (SUPRASORB for utility towels). 229 U.S.P.Q. at 957, 963.

The statements in 2002 by Eagle Optics' former counsel were also taken out of context. The only other marks containing the term EAGLE in the prosecution file history for the '199 registration were: EAGLE'S BLUFF (Reg. No. 2,365,057 for binoculars); EAGLEVISION (Reg. No. 1,998,951 for sunglasses and sport goggles); EAGLE EYE (Reg. No. 1,587,502 for night vision equipment such as infrared goggles, helmet screens and image intensifiers); EAGLE (Reg. No. 1,245,781 for ophthalmic frames and mountings); and Nikon's EAGLEVIEW (Reg. 2,084,361 for binoculars). *See* File Hist. (Schwartz Decl. ¶ 3, Ex. B). Only two of these marks were for binoculars: EAGLE'S BLUFF (Registration no. 2,365,057) which was cancelled in 2007 (*see* TDSR Status Report for Reg. No. 2,365,057 (Schwartz Decl. ¶ 14, Ex. M); and Nikon's EAGLEVIEW, which is addressed in Section III.D.2. above.

Any evidence Wohali has submitted in support of the strength or weakness of the EAGLE Marks should be either discounted or disregarded entirely, whereas Eagle Optics has submitted evidence regarding the strength of its EAGLE Marks. This factor favors Eagle Optics.

**E. The *Du Pont* factors concerning actual confusion, sophistication of the consumers, and intent are neutral.**

The *Du Pont* factors concerning actual confusion, the sophistication of the relevant consumers, and intent, are neutral in this case, and do not favor either Wohali or Eagle Optics.

Because Wohali is new to the industry, it is not surprising that there is not yet evidence of actual confusion. Wohali was just founded in 2009. *See* Oklahoma Sec. of State Record, (Schwartz Decl. ¶ 16, Ex. O). In the middle of last year, 2011, Wohali had only \$25,000 inventory of binoculars and was interested in settling this dispute. *See* Declaration of Brett L.

Foster ¶¶ 6-7. filed in *Sheltered Wings, Inc. v. Wohali Outdoors, LLC*, No. 11-cv-300 (W.D. Wis. July 7, 2011) (Schwartz Decl. ¶ 15, Ex. N). After Wohali’s insurance counsel became involved in the matter, Wohali apparently changed its mind about settlement. *See* Foster Decl. ¶¶ 8-9. In fact, the reason that Eagle Optics dismissed its civil action in the United States District Court for the Western District of Wisconsin was that the district court litigation did not make economic sense—not because it thought its position was incorrect as Wohali contends. *See* Foster Decl. ¶ 10; *see also* Wohali Br., Ex. 18 (Order of dismissal). In any event, the relevant test is “likelihood” of confusion, not actual confusion. It is not necessary to show actual confusion to establish likelihood of confusion. *See Weiss Assocs. v. HRL Associates*, 902 F.2d 1546, 1549, 14 U.S.P.Q.2d 1840, 1842-43 (Fed. Cir. 1990). Thus, this factor is neutral.

The factor concerning sophistication of the purchasers is also neutral here. The only record evidence concerning this factor is conclusory, unsupported statements from Wohali’s Declaration of JT Griffin. *See* Wohali Br. 4. In any event, even if purchasers are sophisticated or knowledgeable in a particular field, it does not mean that they are immune from confusion. *See In re Decombe*, 9 U.S.P.Q.2d 1812 (T.T.A.B. 1988).

The evidence so far regarding Wohali’s intent in adopting its mark is also neutral. The only evidence of record regarding Wohali’s intent is the statement from the Griffin Declaration that Wohali was not aware of Petitioner’s marks when it filed its application to register STEEL EAGLE. *See* Wohali Br. 2, ¶ 6. Even if Wohali was not aware of Eagle Optics’ registrations, it does not establish that Wohali was not aware of the Eagle Optics company and its products. Perhaps, tellingly, Wohali did not fully answer Eagle Optics’ interrogatory number 16, which sought information of when Wohali first learned “of Petitioner and Petitioner’s marks.” *See* Schwartz Decl. ¶ 13, Ex. L. Eagle Optics has not yet deposed Wohali because Wohali filed its

motion for summary judgment and the Board stayed discovery before the noticed deposition date. In any event, evidence of intent to trade on another's good will is not a requirement under Section 2(d). *See Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 853 F.2d 888, 891, 7 U.S.P.Q.2d 1628, 1630 (Fed. Cir. 1988).

Thus, each of the factors concerning actual confusion, sophistication of the consumers, and intent do not favor either party, and are neutral in the likelihood of confusion analysis.

**F. Balancing the relevant *Du Pont* factors compels a finding of a likelihood of confusion under Section 2(d).**

The most important *Du Pont* factors all weigh in favor of a likelihood of confusion between STEEL EAGLE and the EAGLE Marks (EAGLE OPTICS and GOLDEN EAGLE): the parties goods are identical; their marks are similar, sharing the dominant term EAGLE; they sell products through identical trade channels and to the same categories of purchasers; and the EAGLE Marks are strong in the outdoor optics market. But even if the EAGLE Marks are not considered to be "strong," they are still entitled to protection. It is well settled that even a weak mark is entitled to protection against the registration of a similar mark for closely related goods or services. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 U.S.P.Q. 108 (C.C.P.A. 1974). Here, the parties' goods are identical. The only other *Du Pont* factors for which there is any evidence, are all neutral, namely factors concerning actual confusion, sophistication of the consumers, and Wohali's intent. To the extent there is any doubt on the issue of likelihood of confusion, such doubt must be resolved in favor of Eagle Optics as the senior user. *See TBC Corp.*, 126 F.3d 1470, 44 U.S.P.Q.2d 1315; *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 U.S.P.Q.2d 1025; *see also Olde Tyme Foods Inc.* 961 F.2d 200, 22 U.S.P.Q.2D 1542 (inferences must be drawn in favor of the nonmoving party).

**Conclusion**

Wohali's registration for STEEL EAGLE never should have issued. As explained above, there is a likelihood of confusion between Wohali's use of STEEL EAGLE and Eagle Optics' use of its EAGLE MARKS – EAGLE OPTICS and GOLDEN EAGLE. The Board should deny Wohali's motion for summary judgment in its entirety.

Respectfully submitted,

SHELTERED WINGS, INC.

Date: August 24, 2012

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of following documents:

- Opposition to Wohali Outdoors, LLC's Motion for Summary Judgment
- Declaration of Daniel C. Hamilton
- Declaration of Ben Lizdas
- Declaration of Jacqueline M. Schwartz

were served by first class mail, postage prepaid, on August 24, 2012, upon the following:

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