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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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**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 REPLY IN SUPPORT OF ITS  
MOTION FOR SUMMARY JUDGMENT AND BRIEF IN SUPPORT**

COMES NOW the Respondent, Wohali Outdoors, LLC (“Wohali” or “Respondent”), and files this reply in further support of Respondent’s Motion for Summary Judgment and Brief in Support, filed July 20, 2012.

**I. THE DECLARATIONS IN SUPPORT OF PETITIONER’S RESPONSE BRIEF PROVE NOTHING**

Petitioner’s evidence in support of its response consists entirely of 3 self-serving declarations, each containing a phone book of exhibits in the hopes of convincing the Court Petitioner’s claim should not be dismissed. Reflecting how weak its evidence is, one of the three declarations is from a paralegal with the law firm representing Petitioner in this case.<sup>1</sup>

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<sup>1</sup> Ms. Schwartz (paralegal with Godfrey & Kahn) has no first-hand knowledge, and Wohali objects to the use of Ms. Schwartz’s declaration.

**1. Petitioner Has Not Provided Any Evidence Of Its Sales Or Financial Condition**

Petitioner has not produced any evidence concerning the historical sales, profits and losses or anything financially related to the business of Petitioner or the marks at issue. The closest Petitioner comes to presenting evidence of its financial status, is paragraph 13 of Hamilton's declaration and paragraphs 9 and 11 of Lizdas' declaration.

Concerning Hamilton, his statement that "the Eagle Optics company and the EAGLE OPTICS brand for optics has grown into a multi-million dollar company" means nothing standing alone. Petitioner has not in any way referred to or stated how or why this is allegedly so, or how the statement pertains to this summary judgment motion. For all we know, Petitioner may have gotten lucky in the stock market or Hamilton could have inherited the money.

Regarding Lizdas, his statement in paragraph 9 that Eagle Optics has "made donations to the 91 organizations listed in Exhibit H" is irrelevant. Nothing is stated concerning the amount of the donations. Further, in paragraph 11 Lizdas stated the profits from the sales of a PELICAN binocular were donated. Yet, Petitioner conveniently has not disclosed the number of sales, the profits and/or the alleged donation amount. Lizdas' statements are irrelevant and should not be considered.<sup>2</sup>

If Petitioner was really the big time, famous company it claims to be, certainly it would have produced a financial statement and/or other documents reflecting the number of sales, gross profits, net profits, etc. Nowhere within the hundreds of pages filed by Petitioner is there a single reference to or document reflecting any actual sales and/or financial figures.

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<sup>2</sup> The Hamilton and Lizdas declarations consist entirely of vague and conclusory statements, and should be disregarded.

## **2. Petitioner Has Not Provided Any Relevant Evidence Concerning Its Advertising Or Alleged Fame**

Concerning Petitioner's alleged advertising, no statements are made concerning the annual budget for advertising, how much has been historically spent on advertising, etc. Instead, Hamilton and Lizdas make vague statements about various magazines that Petitioner has advertised "regularly" in. (Of course Petitioner has not elaborated on what "regularly" means.) At paragraph 3 of Lizdas' declaration, he stated the advertising and marketing efforts have grown over the years, in correlation with the growth of the company. However, Petitioner has not provided any documents/information concerning advertising expenditures (at any point in time) nor about the growth of the company (at any point in time). These declarations do not serve to prove anything. We have no information concerning sales of the company, financial information (profits/losses), etc. We do not know who received the magazines/advertisements or whether they even cost Petitioner a penny. The reviews referenced in paragraphs 33-35 must be disregarded.<sup>3</sup>

## **3. Petitioner Is A Trademark Troll**

Paragraph 36 of Hamilton's declaration states that Petitioner has sent cease and desist letters to various persons/entities.<sup>4</sup> The statements merely prove that Petitioner is a trademark troll. The only reason these third parties likely complied is because it was not worth the money to fight Petitioner's claims. It in no way means any of those claims had any merit, and certainly provides no support for Petitioner's bogus action filed here.

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<sup>3</sup> Wohali objects to Exhibits 16-21 of the Hamilton declaration as they consist of inadmissible hearsay and should be disregarded pursuant to FRE 801, and moves to strike them in their entirety.

<sup>4</sup> Wohali objects to paragraph 36 of Hamilton's declaration and to Exhibits 23-29 referenced therein, as they consist of inadmissible hearsay. FRE 801. Wohali moves to strike them in their entirety.

## **II. PETITIONER HAS ADMITTED RESPONDENT'S STATEMENT OF FACTS FOR WHICH NO GENUINE ISSUE EXISTS**

At page 5 of Petitioner's response, Petitioner admits the following numbered facts in Wohali's Statement of Material Facts for Which No Genuine Issue Exists - pages 1-4 of Wohali's Motion ("SOF"): Nos. 1-13 and 15-17. Concerning Fact Nos. 6 and 15, Petitioner stated they "are disputed on the grounds that Wohali is obligated to provide discovery responses on these issues, but these facts are not material". Defendant further contends that Wohali did not fully respond to an interrogatory request and that Petitioner has not had an opportunity to depose Wohali.

Petitioner's arguments/complaints must be disregarded. Petitioner did not file a motion to stay a ruling on Wohali's Motion to allow Petitioner to conduct additional discovery. Petitioner had this option available pursuant to Fed. R. Civ. P. 56(d), TBMP Rule 528.06 and/or 37 CFR § 2.127(e)(1). Moreover, Petitioner never advised Respondent it felt any discovery response was inadequate, and certainly did not file a motion to compel.

Petitioner's statements at pages 22-23 concerning settlement are completely inappropriate, sanctionable and must be disregarded.<sup>5</sup>

## **III. PETITIONER ADMITTED THE TERM "EAGLE" IS WEAK AND THERE ARE 174 REGISTERED MARKS CONTAINING THE TERM "EAGLE" THAT SUPPORT PETITIONER'S STATEMENTS AND SHOW THERE IS NO LIKELIHOOD OF CONFUSION HERE**

### **1. Petitioner's Admissions Prove There Is No Likelihood Of Confusion**

Petitioner admitted the term "Eagle" is weak and made statements to the USPTO that the term "Eagle" was in widespread use. (See SOF No. 13-17 of Wohali's Motion.) Recognizing that *Freedom Card, Inc. v. JP Morgan Chase*, 432 F.3d 463 (3<sup>rd</sup> Cir. 2005) proves Petitioner's

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<sup>5</sup> Wohali objects to and moves to strike those portions of Petitioner's brief that refers to settlement discussion, as well as the declaration of Brett Foster. FRE 408.

claim must be dismissed, at pages 20-21 Petitioner infers that Wohali has misled the Court by not mentioning *Anthony's Pizza & Pasta Int'l, Inc. v. Anthony's Pizza*, 95 U.S.P.Q.2d 1271.

Addressing this, *Anthony's* supports Wohali's argument and proves that *Freedom* is the controlling case law. *Anthony's* involved a consent agreement whereby the parties believed that the services moved in different channels of trade.<sup>6</sup> (That situation is not present here.) In explaining why the Court declined to follow *Freedom Card*, the Court stated:

“In *Freedom Card, Inc. v. JP Morgan Chase Co.*, 77 USPQ2d at 1525, the court found that plaintiff's earlier, contrary statements regarding the widespread use of the word ‘freedom,’ undermined plaintiff's attempt to prove likelihood of confusion. Similarly in *Petro Stopping Centers, L.P. v. James River Petroleum*, 44 USPQ2d at 1926, the court found that plaintiff's ‘own representations to the PTO in 1981 [regarding the widespread use of the word ‘petro’] *undercut* the company's current argument to this court. **However, in this case, Plaintiff never argued that it is entitled to register its mark because of the widespread use of the name ‘Anthony's’ in connection with restaurant services.**”

*Anthony's Pizza*, 95 USPQ2d at 1282 (bold added).

The *Anthony's* Court indicated that *Freedom* should be followed (and is the applicable law) when a Petitioner attempts to contradict its prior statements to the USPTO about a mark or term being in widespread use. Here, Petitioner advised the USPTO that the term “Eagle” was in widespread use, was weak and the potential for confusion was *de minimus*.<sup>7</sup> Now Petitioner seeks to retract those statements (i.e. use them as a sword then and as a shield now). Petitioner

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<sup>6</sup> “After learning the Army and Air Force Exchange Service used its mark only on military bases, plaintiff believed that the services moved in different channels of trade and that, therefore, there was ‘common ground by which we could all use these marks.’”

*Anthony's Pizza*, 95 U.S.P.Q.2d 1271, 1281.

<sup>7</sup> SOF No. 13 of Wohali's Motion filed July 20, 2012.

argues these statements should be disregarded because they were made in 2002 but has no authority to support this.

Petitioner contends “file wrapper estoppel” does not apply to this case. The label is not important. Perhaps Petitioner would rather Wohali refer to it as “judicial estoppel”, an “admission”, “waiver” or simply “hoisting Petitioner by its own petard”.<sup>8</sup> Regardless, the result is the same.<sup>9</sup> As the Court stated in *Freedom Card*:

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 Card*, 432 F.3d at 476 (emphasis added). See also *New Hampshire v. Maine*, 532 U.S. 742, 743 (2001) (U.S. Supreme Court stated: “The purpose of the doctrine [judicial estoppel] is to protect the integrity of the judicial process by prohibiting parties from deliberately changing positions according to the exigencies of the moment.”)

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<sup>8</sup> Injured by the same device that you intended to use to injure others.

<sup>9</sup> Within Wohali’s Answer (filed December 13<sup>th</sup>, 2011), at page 2 each of these affirmative defenses was pleaded. Wohali incorporates by reference herein its Answer and Affirmative Defenses.

**2. There Are 174 Registered Marks In International Class 009 Containing The Term Eagle, Proving There Is No Likelihood Of Confusion**

Further, there are 174 registered marks (and far more pending applications) in International Class 009 that support Petitioner's admissions.<sup>10</sup> (See Ex. 25.) Plaintiff's admissions, the number of marks containing the term "Eagle" and Petitioner's failure to produce evidence to the contrary, prove Petitioner's marks are weak and there is no likelihood of confusion. Further, Petitioner has abandoned some of its marks as admitted in its response at page 7.<sup>11</sup> The two remaining "EAGLE OPTICS" marks are limited to use for bird watching. (See Ex. 25 at p. 39 and 73.) Wohali's mark has no reference to bird watching.

See *Citigroup, Inc. v. Capital City*, 637 F.3d 1344, 1356 (Fed Cir. 2011) (In determining there was no likelihood of confusion, Court stated: "Pervasive third-party use of the phrase 'City Bank' in marks for financial services also limits the protection afforded to the CITIBANK mark.") See also *Amstar Corp. v. Domino's Pizza*, 615 F.2d 252, 260-261 (5<sup>th</sup> Cir. 1980) ("The greater number of identical or more or less similar trade-marks already in use on different kinds of goods, the less is the likelihood of confusion.") See also *Estee Lauder Inc. v. Gap, Inc.*, 108 F.3d 1503, 1511 (Mark not strong or distinctive when there were more than 70 trademark registrations, pending applications that incorporated term "100%.")

**3. The Purchase Of Optics Is A Careful, Sophisticated Process; It Is Not An Impulse Purchase**

The purchase of optics is a careful, sophisticated process. It is not an impulse purchase. (SOF No. 15.) The cases cited on pages 11-12 of Petitioner's response are inapplicable because (1) they do not contain the same facts (i.e. the admissions made by Petitioner and the 174 similar

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<sup>10</sup> See SOF Nos. 13-17 to Wohali's Motion filed July 20, 2012.

<sup>11</sup> See also Petitioner's Motion for Leave to File Amended Petition for Cancellation, filed August 24, 2012 which is incorporated herein by reference.

other marks); and (2) the majority of them involved impulse purchases rather than a careful, sophisticated process.

#### **4. Wohali's Mark and Petitioners' Marks Are Not Similar**

The only thing Petitioner's marks and Wohali's Steel Eagle mark have in common is the term "Eagle". As demonstrated herein, 174 marks in International Class 009 have this in common. (See Ex. 25.) Based on this, the USPTO has determined these "Eagle" marks can co-exist without confusion, and made this determination when registering Wohali's STEEL EAGLE mark. Petitioner's comments about the search process do not change this and should be disregarded.

Petitioner's claim that the marks are similar because the USPTO rejected Petitioner's mark for "EAGLE" based on Wohali's "STEEL EAGLE" mark is misleading. Here, we are comparing Wohali's mark "STEEL EAGLE" to Petitioner's marks "EAGLE OPTICS" and "GOLDEN EAGLE". We are not comparing "STEEL EAGLE" to "EAGLE", as was the case in Petitioner's rejected application.<sup>12</sup>

#### **IV. THE DUPONT FACTORS WEIGH IN WOHALI'S FAVOR**

Petitioner's statement on page 8 of its brief, that the 2 most important factors are usually the similarity of the goods and the similarity of the marks, is false and unsupported by the case cited by Petitioner. The case cited by Petitioner states: "In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods." *In re SL&E Training Stable, Inc.*, 88 USPQ2d 1216, 1217.

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<sup>12</sup> The only reason these parties are before the Court is because the USPTO examiner identified Wohali's mark as the reason why Petitioner's application for "EAGLE" was rejected. If the USPTO had identified a different mark, Petitioner would be going after them and would know nothing about Wohali's mark.

Referring to the 13 factors set forth in *Application of E.I. DuPont*, 476 F.2d 1357 (Ct. Custom Appeals 1973), the Court stated: “The evidentiary elements are not listed above in order of merit. Each may from case to case play a dominant role.” *DuPont*, 476 F.2d at 1361-1362. Analyzing the *DuPont* factors, Factors 1, 4-7, 10 and 12 weigh heavily in favor of Wohali. Petitioner has wholly failed to meet its burden and summary judgment must be granted in favor of Wohali and against Petitioner, dismissing Petitioner’s claim with prejudice.

**V. CONCLUSION/PRAYER**

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There is no genuine issue concerning any of the facts set forth in Wohali’s Motion. Within the hundreds of pages filed by Petitioner, there is no evidence of Petitioner’s sales or financial condition now, or ever. If Petitioner is truly the big time, famous entity that it contends, it certainly would have produced evidence of its financial condition, annual sales, growth rate, etc. It did not.

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,

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of Respondent's Reply in Support of Its Motion for Summary Judgment and Brief in Support (without Ex 25) was deposited in the U.S. Mail, via U.S. First Class Mail, postage prepaid, this 13<sup>th</sup> day of September, 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 (with Exhibit 25) was sent via electronic mail, this 13<sup>th</sup> day of September, 2012, to:

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

/s/ S. Max Harris/

S. Max Harris

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