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

Proceeding	92055358
Party	Defendant Urban Asphalt Skatewear
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

UNDER ARMOUR, INC.	)	
	)	Cancellation No. 92055358
Petitioner,	)	
	)	Mark
V.	)	
URBAN ASPHALT SKATEWEAR, LLC	)	
Registrant.	)	Registration No: 3611357 Registration Date: April 28, 2009

REGISTRANT'S REPLY TO PETITIONER'S OPPOSITION AGAINST REGISTRANT'S MOTION FOR SUMMARY JUDGMENT

Urban Asphalt Skatewear ("Registrant" or "Urban Asphalt") submits this Reply to Under Armour, Inc. ("Petitioner") Opposition to Registrant's Motion for Summary Judgment ("Petitioner's Opposition" or "Opposition") pursuant to 37 C.F.R. §2.127 (e)(1). Urban Asphalt respectfully denies Petitioner's assertion that Urban Asphalt is not entitled to summary judgment because there are numerous disputed issues of material fact relevant to whether the Urban Asphalt Mark (Registration No. 3611357) is likely to cause confusion with and/or dilute Petitioner's Stylized "UA" Design Marks and Petitioner's "UA" Word Marks. For the reasons addressed in Urban Asphalt's Motion for Summary Judgment ("MSJ") and in this Reply, there are no disputed issues of material fact and, viewing the evidence in a light most favorable to the non-moving party, Urban Asphalt's Motion for Summary Judgment should be granted in favor of Urban Asphalt.

I. STATEMENT OF FACTS

Petitioner's 46 registrations asserted against Urban Asphalt's Mark in this Cancellation proceeding have been provided and classified in Registrant's MSJ (MSJ 3-6) as Petitioner's Stylized "UA" Design Marks and Petitioners "UA" Word Marks (or collectively, "Petitioner's Marks"). The commingling of these distinct classes of marks (design marks and word marks) into a single classification of "UA Marks" by Petitioner (Petitioner's Opposition 2) attenuates the distinct analysis required for each

category of mark, including the likelihood of confusion and dilution factors. As such, Urban Asphalt continues its analysis under the same classifications as in its MSJ.

Further, in Petitioner's Opposition, Petitioner states "the filing of most of Under Armour's registrations occurred *before* the filing of Urban Asphalt's Registration No. 3611357." (Petitioner's Opposition 3). Even still, of the relevant 46 registrations cited by Petitioner against the Urban Asphalt Mark, 21 of those registrations occurred *after* the registration of the Urban Asphalt Mark (i.e., almost half of Petitioner's asserted registrations). To further break down those 21 registrations, six were filed after the filing date of the Urban Asphalt Mark and the remaining 15 were filed after the registration of the Urban Asphalt Mark. (Exhibit A).

Moreover, in its response Petitioner attempts to introduce two additional marks, Reg. No. 3880683 and Serial No. 85209107, both in International Class 16 for "stickers". (Petitioner's Opposition 14). It is noted that Petitioner failed to properly introduce the above registration and application into the record and, as such, they are not of record and should not be considered by the Trademark Trial and Appeal Board ("Board") in this motion for summary judgment. TBMP §704.03(b)(1).

Additionally, Urban Asphalt, provides evidence rebutting Petitioner's claim (Petitioner's Opposition 16-17) that Urban Asphalt has not provided evidence that third-party trademarks were well-promoted, used, and recognized for the purpose of showing a crowded field and that Petitioner does not enjoy substantially exclusive use of the literal elements "UA" for Petitioner's dilution by blurring claim. (See Exhibit B); (MSJ 19); *cf. San Fernando Elec. Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683 (C.C.P.A. 1977); *cf. In re Mighty Leaf Tea*, 601 F.3d 1342 (Fed. Cir. 2010)

II. SUMMARY JUDGMENT AGAINST PETITIONERS' LIKELIHOOD OF CONFUSION CLAIM SHOULD BE GRANTED IN FAVOR OF URBAN ASPHALT

a. Fame of Petitioner's Stylized "UA" Design Marks or Petitioner's "UA" Word Marks Fails to Raise a Genuine Issue of Material Fact

In Petitioner's Cancellation, Petitioner relies extensively on the alleged fame of both Petitioner's Stylized "UA" Design Marks and/or Petitioner's "UA" Word Marks and a fame-influenced and facilitated

likelihood of confusion. Indeed, Petitioner goes so far as to declare "as the fame of a mark increases, the degree of similarity between the marks and goods and services necessary to support a likelihood of confusion decreases." (Petitioner's Opposition 4 citing *Bose Corp. v. QSC Audio Prods.*, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002)). Respectfully, Petitioner's axiomatic assertion is misplaced.

Federal Circuit precedent recognizes the interaction of fame and the similarity or relatedness of goods in the likelihood of confusion analysis. *Bose Corp.* 63 USPQ2d 1303 at 1305. So, where a mark is famous, fame deserves its full measure of weight in assessing a likelihood of confusion between two marks. *Recot, Inc.*, 214 F. 3d 1322, 1328 (Fed. Cir. 2000). However, fame alone cannot overwhelm the other *DuPont* factors as a matter of law. *Recot* 214 F.3d at 1328; (MSJ 14). Likelihood to cause confusion means more than the likelihood that the public will recall a famous mark on seeing the same mark used by another. It must also be established that there is a reasonable basis for the public to attribute the particular product or service of another to the source of the goods or services associated with the famous mark. To hold otherwise would result in recognizing a right in gross, which is contrary to principles of trademark law. *U. of Notre Dame Du Lac v. JC Gourmet Food*, 703 F. 2d 1372, 1374 (Fed. Cir. 1983); *See also Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 1367 (Fed. Cir. 2012).

Since fame alone, as a matter of law, cannot overwhelm the other *DuPont* factors, the other *DuPont* factors enumerated in Registrant's MSJ (MSJ 11-16) and Reply must be given their proper weight in this motion for summary judgment. Likelihood of confusion and the analysis of the *DuPont* factors, including fame and the dissimilarity of the marks, is a question of law. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565 (Fed. Cir. 1983); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943 (Fed. Cir. 2000). As much as Petitioner alleges that its Stylized "UA" Design Marks and "UA" Word Marks enjoy "game-changing" fame (Petitioner's Opposition 12), the factors enumerated in Registrant's MSJ and Reply, even when factoring fame and viewing the evidence in a light most favorable to the non-moving party, weigh in favor of finding no likelihood of confusion between Petitioner's Marks and the Urban Asphalt Mark. (MSJ 11-16). As such, no genuine issue of material fact exists and summary judgment should be granted in favor of Urban Asphalt.

b. Dissimilarity of Marks in Sound, Appearance, Connotation, and Overall Commercial Impression Fails to Raise a Genuine Issue of Material Fact

In the Opposition, Petitioner fails to raise any genuine issue of material fact as to the dissimilarity of the marks. The dissimilarity of the Urban Asphalt Mark and Petitioner's Stylized "UA" Design Marks/Petitioner's "UA" Word Marks is dispositive and substantially outweighs any other relevant factors. *Missiontrek Ltd. V. Onfolio, Inc.*, 80 U.S.P.Q.2d 1381 (TTAB 2005); *accord Kellogg Co. v. Pack'Em Enterprises, Inc.*, 951 F.2d 330 (Fed. Cir. 1991); *See also* (MSJ 13-14). Since likelihood of confusion is a question of law, application of the *DuPont* factors as enumerated in Urban Asphalt's MSJ and Reply is proper.

Petitioner focuses on the Urban Asphalt Mark and Petitioner's Marks containing "the identical literal portion 'UA'" and that the Urban Asphalt Mark "presents the letters 'UA' in the same format as [Petitioner's Stylized "UA" Design Mark]" (Petitioner's Opposition 12-13). Registrant addressed this issue in the MSJ, and reiterates that the Urban Asphalt Mark is visually and phonetically distinct from all of Petitioner's Marks, the Urban Asphalt Mark is not in the same format as Petitioner's Stylized "UA" Design Mark but in fact is clearly distinct, and the Urban Asphalt Mark has different commercial impressions and connotations from Petitioner's Marks. (MSJ 12-13, 15). Indeed, Petitioner's focus on the design element of the Urban Asphalt Mark alone highlights Petitioner's failure to compare the marks in their entireties. The Urban Asphalt Mark does not solely consist of the Design Portion, but also consists of the word elements "Urban Asphalt". *M.C.I. Foods, Inc. v. Brady Bunte,* 96 U.S.P.Q.2d 1544 (TTAB 2010) (In a word-design combination mark, the word is normally accorded greater weight); *Columbian Steel Tank Co. v. Union Tank & Supply Co.*, 277 F.2d 192 (C.C.P.A. 1960); *Arnold, Schwinn & co. v. Evans Products Co.*, 302 F.2d 765 (C.C.P.A. 1962); *In re Electrolyte Laboratories, Inc.*, 913 F.2d 930 (Fed. Cir. 1990). To determine a likelihood of confusion, it is necessary to compare the marks in their entireties as to not dissect the marks. *In re Shell Oil Co.*, 992 F.2d 1204 (Fed. Cir. 1993) (MSJ 7-9, 11). The determination of the dissimilarity of the Urban Asphalt Mark and Petitioner's Marks is a question of

law and, in light most favorable to the non-moving party, Petitioner has failed to raise any genuine issue of material fact as to the dissimilarity of the marks.

c. Office Actions from an Examining Attorney Is Not Conclusive or Probative Evidence of Actual Confusion or a Likelihood of Confusion

Petitioner fails to raise a genuine issue of material fact when alleging that two United States Patent and Trademark Office ("USPTO") Examining Attorneys have "refused" registration on Application Serial No. 85209107 and Serial No. 77819895. (Petitioner's Opposition 13). This statement is misleading; Serial No. 77819895 matured into registration on December 28, 2010 and Serial No. 85209107 was suspended by Petitioner by commencing this Cancellation. It should be noted that both Application Serial Nos. 85209107 and 77819895 were both for Petitioner's "UA" Word Marks.

Petitioner relies on the Examining Attorneys refusal as conclusive evidence that there is a likelihood of confusion between the Urban Asphalt Mark and Petitioner's Marks; previous Office Actions by examining attorneys do not raise a genuine issue of material fact. An Office Action by an Examining Attorney at the USPTO alleging confusing similarity between marks can be overcome in numerous manners, including submitting arguments showing there is no likelihood of confusion. Indeed, Office Actions are not a final refusal by the USPTO and can and have been appealed and overturned by the Board. There is no *res judicata* effect of an *ex parte* determination of an examining attorney on the issue of likelihood of confusion, with respect to a later cancellation or opposition proceeding brought by the owner of the cited mark considered by the examining attorney. *Worthington Corp. v. Air Conditioning Heating Specialists, Inc.*, 148 USPQ 392 (TTAB 1965); *Gruen Industries, Inc. v. Ray Curran & Co.*, 152 USPQ 778 (TTAB 1967); *H. Sichel Sohne, GmbH v. John Gross & Co.*, 204 USPQ 257 (TTAB 1979); *McDonald's Corp. v. McClain*, 37 U.S.P.Q.2d 1274 (TTAB 1995). A likelihood of confusion analysis is not whether a judge, jury, or examining attorney would be personally confused, but rather, whether the ordinary, prudent customer in the marketplace would likely be confused. *In re Save Venice New York, Inc.*, 259 F.3d 1346 (Fed. Cir. 2001). As such, Petitioner fails to establish there is a likelihood of

confusion between the Urban Asphalt Mark and Petitioner's Marks and fails to raise a genuine issue of material fact in regard to the previous actions by the examining attorneys.

d. Use of "UA" on Urban Asphalt's Website Is Irrelevant to this Proceeding

Petitioner details that "Urban Asphalt has used the block letter form of the mark 'UA' ... to refer to Urban Asphalt on its Facebook page and website" (Petitioner's Opposition 13). The alleged use by Urban Asphalt on its website and Facebook page is out of the scope of this Cancellation; the issue in a cancellation proceeding is the cancellation of a registration, not the cancellation of common law rights in a trademark. *Crash Dummy Movie, LLC v. Mattel, Inc.*, 601 F.3d 1387 (Fed. Cir. 2010). That is, the use alleged by Petitioner in its Opposition does not involve the Urban Asphalt Mark and is irrelevant to this Cancellation proceeding.

e. Urban Asphalt's Goods Are Not Related to Petitioner's Goods

Petitioner's reliance on *Octocom Systems* and *Hewlett-Packard* is misplaced because these cases discuss the similarity/dissimilarity of goods for a trademark *opposition*, not a cancellation. (See Petitioner's Opposition 14-15). In an opposition proceeding, the only issue is registrability of the mark applied for on the goods or services specified. *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937 (Fed. Cir. 1990); 4 J. Thomas McCarthy, *Trademarks and Unfair Competition* §24:43 (4th ed. 2012). In a cancellation, the issue is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of the goods. *Teledyne Technologies, Inc. v. Western Skyways, Inc.*, 78 U.S.P.Q.2d 1203 (TTAB 2006); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); *In re International Telephone & Telephone Corp.*, 197 USPQ 910, 911 (TTAB 1978).

It should be noted that when comparing the goods where identical marks are involved, the degree of similarity between the parties' goods that is required to support a finding of likelihood of confusion declines. *In re Shell Oil Co.*, 992 F.2d 1204, 26 U.S.P.Q.2d 1687, 1688-1689 (Fed. Cir. 1993); *Time Warner Entertainment Co. v. Jones*, 65 U.S.P.Q.2d 1650, 1661 (TTAB 2002); *In re Opus One Inc.*, 60 U.S.P.Q.2d 1812 (TTAB 2001). In the case at hand, the Urban Asphalt Mark and Petitioner's Marks are not identical or similar. (MSJ 11-16).

Proper analysis of relatedness of goods requires a finding that in the mind of the consuming public, goods come from the same source, or are somehow connected with or sponsored by a common company. *Shen Mfg. Co., Inc. v. Ritz Hotel, Ltd.*, 393 F.3d 1238 (Fed. Cir. 2004); 4 J. Thomas McCarthy, *Trademarks and Unfair Competition* §24:24 (4th ed. 2012). If customers are likely to mistakenly think that the Urban Asphalt goods come from the same source as Petitioner's goods, or are sponsored by, affiliated with, or connected with Petitioner, the goods are related. *In re Save Venice New York Inc.*, 259 F.3d 1346 (Fed. Cir. 2001). This related goods test is an observation to be made after full analysis of the facts shows that there is a likelihood of confusion as to source, affiliation, sponsorship or connection because of the similarity of the marks and other facts in the case. 4 J. Thomas McCarthy, *Trademarks and Unfair Competition* §24:25 (4th ed. 2012).

Petitioner fails to raise any genuine issue of material fact that customers are likely to think that Urban Asphalt goods come from the same source as, or are sponsored by, affiliated with, or connected with Petitioner. The common goods between Urban Asphalt and Petitioner in this Cancellation is wearing apparel. Applying the related goods test, the dissimilarity of the Urban Asphalt Mark and Petitioner's Marks, along with no actual confusion after concurrent use of the marks for nearly five years and other facts, mitigates any likelihood that consumers will mistakenly think that Urban Asphalt goods are related with Petitioner's goods. (MSJ 11-16) When considering the relatedness of wearing apparel, as is the case here, even similar marks used on items of wearing apparel may coexist without confusion. *See In re British Bulldog, Ltd.*, 224 USPQ 854 (TTAB 1984); *In re Shoe Works, Inc.*, 6 U.S.P.Q.2d 1890 (TTAB 1988); *The H.D, Lee Company, Inc. v. Maiden-form, Inc.*, 87 U.S.P.Q.2d 1715 (TTAB 2008). Bearing in

mind the dissimilarity of the Urban Asphalt Mark when compared to Petitioner's Marks and all of the other *DuPont* factors, the use of the Urban Asphalt Mark on wearing apparel is unlikely to cause any consumer confusion as to the source, sponsorship, affiliation, or connection of Urban Asphalt with Petitioner. *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984). As such, viewing the evidence on record in a light most favorable to Petitioner, summary judgment in Urban Asphalt's favor is appropriate.

f. Lack of Actual Confusion Is a *DuPont Factor* and Relevant

Petitioner states that actual confusion is not required to establish likelihood of confusion (Petitioner's Opposition 15). This statement is correct. However, Petitioner's claim that "actual confusion is notoriously difficult to document" (Petitioner's Opposition 15) should not and does not discount the relevance of the seventh *DuPont* factor in this Cancellation, nor does it raise a genuine issue of material fact.

The Urban Asphalt Mark and Petitioner's Stylized "UA" Design Marks and Petitioner's "UA" Word Marks have been in concurrent use for nearly five years (first use in commerce date of the Urban Asphalt Mark is March 31, 2008), which provides a reasonable opportunity for actual confusion to occur. Indeed, Registrant is still unaware of and Petitioner fails to allege any actual confusion between the marks. (MSJ 16 and Petitioners Opposition 15-16). That there is no actual confusion between the Urban Asphalt Mark and Petitioner's Marks is relevant evidence in a likelihood of confusion analysis. *Smith v. Tobacco By-Products and Chemical Corp.*, 243 F.2d 188 (C.C.P.A 1957); *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 U.S.P.Q2d 1645 (TTAB 2010); *aff'd* 637 F.3d 1344 (Fed. Cir. 2011) As such, viewing the evidence on record in a light most favorable to Petitioner, Petitioner has failed to raise a genuine issue of material fact and failed to discount the probative value of the seventh *DuPont* factor in this proceeding.

III. SUMMARY JUDGMENT AGAINST PETITIONER'S DILUTION CLAIM SHOULD BE GRANTED IN FAVOR OF URBAN ASPHALT

a. Standard for Dilution

As previously discussed in Urban Asphalt's MSJ (MSJ 9-11), a mark is entitled to dilution protection only when such mark is widely recognized by the general consuming public of the United

States as a designation of source of the goods or services of the mark's owner. 15 USC §1125(c)(2)(A). To establish fame of a mark, all relevant factors, including the four factors enumerated in 15 USC §1125(c)(2)(A), must be considered. However, it is well-established that fame for dilution claims is difficult to prove. *Coach Services, Inc. v. Triumph Learning LLC*, 668 F.3d 1356 (Fed. Cir. 2012)

Although the fame of Petitioner's "UA" Word Marks is questionable (MSJ 17), even when assuming that Petitioner can establish fame of Petitioner's Marks, fame alone is insufficient to sustain Petitioner's dilution by blurring or dilution by tarnishment through summary judgment. (Petitioner's Opposition 16). Dilution claims are either dilution by blurring and/or dilution by tarnishment. 15 USC §1125(c)(1). Petitioner's inability to claim any genuine issue of material fact for either of those dilution claims demonstrates that there is no genuine issue of material fact that would make summary judgment in favor of Urban Asphalt inappropriate. The fame of Petitioner's Marks is not a genuine issue of material fact that would alter the legal conclusion that dilution by blurring or dilution by tarnishment of Petitioner's Marks has not and/or will not occur. (MSJ 17-20).

b. Petitioner Raised No Genuine Issue of Material Fact Raised Regarding Dilution by Blurring

Petitioner fails to discuss and fails to allege any genuine issue of material fact in its Opposition regarding its dilution by blurring claim. Indeed, Petitioner fails to discuss or introduce any evidence to satisfy any of the six statutory factors for dilution by blurring enumerated in 15 USC §1125(c)(2)(B). Petitioner claims that the Urban Asphalt Mark is "substantially similar," without any substantive discussion on how Petitioner reaches this conclusion. (Petitioner's Opposition 18)

However, the test is whether the Urban Asphalt Mark and Petitioner's Marks are similar enough that consumers will be immediately reminded of Petitioner's Marks. *Rolex Watch U.S.A., Inc. v. AFP Imaging Corporation*, 101 U.S.P.Q.2d 1188 (Fed. Cir. 2012) As discussed in detail in Urban Asphalt MSJ (MSJ 17-20), the evidence of record, even when viewed in a light most favorable to Petitioner, points to the legal conclusion that consumers are not and will not be immediately reminded of Petitioner's Marks when encountering the Urban Asphalt Mark. The dissimilarity of the marks, the lack of intent by

Urban Asphalt to create an association with Petitioner and Petitioner's Marks, the lack of any actual association between the Urban Asphalt Mark and Petitioner's Marks, and Petitioner's lack of substantially exclusive use of the literal element "UA" clearly indicates that there is no dilution by blurring. (MSJ 17-20) As such, granting a motion for summary judgment in favor of Urban Asphalt and dismissal of Petitioners dilution by blurring claim is proper.

c. No Genuine Issue of Material Fact Raised by Petitioner Regarding Dilution by Tarnishment

Petitioner fails to discuss and fails to allege any genuine issue of material fact in its Opposition regarding its dilution by tarnishment claim. Petitioner has not alleged/provided any evidence of tarnishment, nor has Petitioner even claimed that there is any genuine issue of material fact regarding dilution by tarnishment. As discussed in Urban Asphalt's MSJ (20-21), the Urban Asphalt Mark has not and is not used in a manner to cause tarnishment. As such, there is no genuine issue of material fact regarding Petitioner's tarnishment claim, and viewing the evidence in a light most favorable to Petitioner, the motion for summary judgment should be rendered in favor of Urban Asphalt.

IV. CONCLUSION

For the reasons discussed above and in Urban Asphalt's MSJ, Urban Asphalt respectfully requests that Urban Asphalt's Motion for Summary Judgment be granted and that this Cancellation be dismissed with prejudice.

Dated: March 29, 2013

Respectfully submitted,

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CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing REGISTRANT'S REPLY TO PETITIONER'S OPPOSITION TO REGISTRANT'S MOTION FOR SUMMARY JUDGMENT was served first class mail, postage prepaid, on this March 29 2013, upon counsel for Under Armour, Inc.:

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