

ESTTA Tracking number: **ESTTA542023**

Filing date: **06/06/2013**

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

Proceeding	92056035
Party	Plaintiff The Armor All/STP Product Company
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Date	06/06/2013
Attachments	Motion for Summary Judgment (F1240364).PDF(809732 bytes)

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

In the matter of Registration No. 4,137,345
Mark: STP & Design

-----X		
THE ARMOR ALL/STP PRODUCTS	:	
COMPANY,	:	
	:	
Petitioner,	:	Cancellation No. 92056035
	:	
- against -	:	
	:	
LIMITED LIABILITY COMPANY;	:	
“AUTOPLASTIC,”	:	
	:	
Autoplastic.	:	
-----X		

PETITIONER’S MOTION FOR SUMMARY JUDGMENT

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Petitioner The Armor All/STP Products Company (“Petitioner”), pursuant to Trademark Rule of Practice 2.127 and Federal Rule of Civil Procedure 56(a), hereby moves for entry of summary judgment in its favor. In support of its motion for summary judgment, Petitioner submits this supporting memorandum pursuant to Trademark Rule of Practice 2.127(a), together with the accompanying declaration of Jason D. Jones and the exhibits thereto.

INTRODUCTION

For more than a half century, the mark STP has been associated with the wide variety of automotive products offered by Petitioner and its predecessors, including among many others motor oil, brake fluid, lubricants, filters, and cleaning preparations for tires. Against this long history, Registrant, under the name “Limited Liability Company ‘Autoplastic’” (hereinafter “Autoplastic”), seeks to register the nearly identical mark “StP” as shown below in connection with automotive products.

As set forth in detail below, Autoplastic has **admitted** every fact necessary to prove that its registration and use of the mark StP is likely to cause confusion with the long-used, federally-registered STP mark of Petitioner. Petitioner therefore respectfully requests that its motion for summary judgment be granted.

I. STATEMENT OF FACTS

A. A Brief Overview of Petitioner and the STP Brand and Registrations

Petitioner, a leader in the automotive care industry, owns numerous federal registrations for the STP trademark and STP logo (together the “STP Marks”), which have been used continuously for more than half a century. As shown in the USPTO status and title records attached to the Petition to Cancel demonstrate—which make the referenced registrations part of the record pursuant to Trademark Rule of Practice 2.122(d)—Petitioner’s registrations for the

STP Marks cover a wide variety of automotive and other goods. These registrations include (but are not limited to) four incontestable registrations for the word mark STP, nine incontestable registrations for the STP logo mark, and two registrations for the STP logo mark that have not yet become incontestable. (See Petition to Cancel (TTABVUE Dkt. # 1) at ¶¶ 6-7 and Exhibit A thereto). Many of these registrations issued in the 1950s, 60s and 70s. (*Id.*)

B. Autoplastic and Its StP Registration

As Autoplastic admits in its Amended Answer, it is a Russian Federation limited liability company that requested that its International Registration No. 1036364 for the mark StP shown below (“Autoplastic’s StP Mark”) be extended to the United States pursuant to Section 66(a) of the Lanham Act, 15 U.S.C. § 1141(a) (“Autoplastic’s I.R. Extension”):



Autoplastic’s I.R. Extension Request was granted a filing date of April 8, 2010. (See Amended Answer (TTABVUE Dkt. # 10) at ¶¶ 8-9).

As Autoplastic’s registration indicates—a registration which is part of the record pursuant to Trademark Rule of Practice 2.122(b)—the registration was issued on May 8, 2012 for the following automotive goods:

“Insulating paper for acoustical, acoustic, thermal and heat insulation of automobiles; insulating felt for automobiles; insulators for automobiles, namely, polyurethane and penopolyethylene insulators of interiors of automobile and other automobile parts from noise, heat and corrosion; insulating tape and band, adhesive bands being tapes all being other than stationery and not for medical or household purposes; soundproofing materials for automobiles; insulating materials; insulating refractory materials; rubber material for recapping tires or tyres; non-conducting materials for retaining heat, namely, insulating penopolietilen being polyethylene

foam, polyurethane foam, and foam plastic membranes for insulating surfaces of automobiles; sealant compounds for joints; insulating plaster; cords of rubber for cylinder jointings, pipe gaskets and joint packings for pipes; non-metal gaskets for joint packings and seals in the automotive industry; substances for insulating buildings against moisture, namely, polyurethane film for use as a moisture barrier; fiberglass insulation for automobiles; insulating fabrics; waterproof packings for water-tight rings; foils of metal for insulating automobiles” in International Class 17.

(See Registration No. 4,137,345—hereinafter “the Registration”).

C. This Cancellation Proceeding

Petitioner instituted this cancellation proceeding on August 10, 2012 and the Board instituted the proceeding as Cancellation No. 92056035 six days later and issued the governing scheduling order. (Declaration of Jason D. Jones, Esq. In Support of Motion for Summary Judgment (“Jones Decl.”) at ¶ 2; TTABVUE Dkt. ##1-2). Petitioner has sought to cancel the Registration on the grounds that Autoplastic’s StP Mark is likely to cause confusion in violation of Section 2(d) of the Lanham Act, 15 U.S.C § 1052(d), as well as on the grounds of dilution and abandonment. (See Petition to Cancel at ¶¶ 16-36). Autoplastic, represented by U.S. counsel Mr. Sergei Orel, filed its Amended Answer to the Petition to Cancel on December 15, 2012. (Jones Decl. at ¶ 3; TTABVUE Dkt. # 10).

D. Autoplastic Fails to Respond to Petitioner’s Discovery Requests

Under the Board’s governing scheduling order, discovery opened on December 24, 2012. (Jones Decl. at ¶ 4; TTABVUE Dkt. ## 6-7). On that date, Petitioner served on Autoplastic’s counsel Petitioner’s First Set of Requests for Admission (“Petitioner’s Requests for Admission”), Petitioner’s First Set of Interrogatories (“Petitioner’s Interrogatories”), and Petitioner’s First Set of Requests for the Production of Documents and Things (“Petitioner’s Document Requests” and, collectively with Petitioner’s Interrogatories and Petitioner’s Requests For Admission, “Petitioner’s Discovery Requests”). (Jones Decl. at ¶ 5 & Exhibit A). At this same time,

Petitioner served Autoplastic with Petitioner's Initial Disclosures. (*Id.*) Under the applicable rules, Autoplastic's responses to Petitioner's Discovery Requests were due on or before January 23, 2013. (*Id.* at ¶ 6).

Autoplastic did not respond to Petitioner's Discovery Requests, or request an extension of the deadline from Petitioner or the Board, on or before January 23, 2013. (Jones Decl. at ¶ 7). Petitioner then engaged in a lengthy meet and confer process with Autoplastic's counsel. (*Id.* at ¶ 8). On February 27, 2013, when Autoplastic still had not served any responses, Petitioner filed a motion to compel Autoplastic to respond to Petitioner's Interrogatories and Document Requests without objection, since Autoplastic had waived its right to object to these discovery requests on their merits pursuant to Trademark Trial and Appeal Board Manual of Procedure §§ 403 and 407. (*See* TTABVUE Dkt. #12 ("Motion to Compel")); *see also* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") §§ 403.03, 407.03. In its motion, Petitioner also requested that the Board rule, pursuant to Fed. R. Civ. P. 36, that all of Petitioner's Requests for Admission were deemed admitted as a matter of law because Autoplastic had completely failed to respond to Petitioner's Requests for Admission. (Jones Decl. at ¶ 9; Motion to Compel at p. 11 & n.1; *see also* TTABVUE Dkt. # 16 at p. 5). Petitioner's motion to compel also set forth Autoplastic's history of dilatory conduct in this proceeding. (*See* Motion to Compel at pp. 5-9).

On March 19, 2013 (and still failing to serve any responses to Petitioner's Discovery Requests), Autoplastic opposed Petitioner's motion to compel. (TTABVUE Dkt. # 15). In its opposition, Autoplastic did not argue that it was not properly served with Petitioner's Discovery Requests or that it was unaware of its January 23 deadline to respond, nor did Autoplastic dispute that it had failed to provide any responses to Petitioner's Discovery Requests. Rather, Autoplastic argued that its failure to respond to Petitioner's Discovery Requests (including

Petitioner's Requests for Admission) was the result of "excusable neglect." Autoplastic asserted that an alleged three-week Russian winter holiday from December 24, 2012 to January 13, 2013 made it "impossible" for Autoplastic to comply with its obligation to serve discovery responses by the January 23, 2013 deadline. (TTABVUE Dkt. # 15 at p. 2). On March 28, 2013, Petitioner filed its reply. (TTABVUE Dkt. #16).

E. The Board's Order Granting Petitioner's Motion to Compel

On May 21, 2013, the Board granted Petitioner's motion to compel in its entirety. (TTABVUE Dkt. # 17—hereinafter "the May 21 Order"). The Board held that "the circumstances recited by respondent fall far short of constituting excusable neglect so as to justify its failure to respond to the first set of interrogatories and document requests propounded by petitioner (or for its U.S. counsel to seek an extension)." (*Id.* at p. 3). The Board ordered Autoplastic, within 30 days—*i.e.*, by June 20, 2013—to "provide complete responses *without objection* to petitioner's first set of interrogatories and requests for production of documents and things." (*Id.*) (emphasis in original). The Board further ordered: "[P]etitioner's first set of requests for admission stand admitted pursuant to Fed. R. Civ. P. 36." (*Id.*)

II. ARGUMENT

A. Standard for Summary Judgment

A motion for summary judgment is an appropriate method for disposing of an *inter partes* proceeding when "there is no genuine issue as to any material fact [such] that the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a); *see also* 37 C.F.R. § 2.116(a) (Federal Rules of Civil Procedure generally apply to *inter partes* proceedings). Summary judgment "is regarded as 'a salutary method of disposition,' and the Board does not hesitate to dispose of cases on summary judgment when appropriate." TBMP § 528.01 (citations omitted).

Likelihood of confusion is “a legal conclusion based on underlying facts.” *Cunningham v. Laser Golf Corp.*, 55 U.S.P.Q.2d 1842, 1843-44 (Fed. Cir. 2000). As such, it is an issue that “the [B]oard may unquestionably resolve . . . on summary judgment.” *Sweats Fashions Inc. v. Pannill Knitting Co.*, 4 U.S.P.Q.2d 1793, 1797 (Fed. Cir. 1987); *see also Hewlett-Packard Dev. Co. v. Vudu, Inc.*, 92 U.S.P.Q.2d 1630, 1632-33(T.T.A.B. 2009) (granting summary judgment on the issue of likelihood of confusion).

B. Petitioner’s Requests for Admission are Conclusively Admitted and Established

Federal Rule of Civil Procedure 36(a)(3) provides that requests for admission are deemed admitted *as a matter of law* if the receiving party fails to respond in writing within the required time period. Fed. R. Civ. P. 36(a)(3). As set forth in the Board’s May 21 Order, all of Petitioner’s Requests for Admission are admitted pursuant to this rule. (May 21 Order at p. 3).

Moreover, Autoplastic’s argument that Petitioner’s Requests for Admission should not be admitted because its failure to respond was the result of “excusable neglect,” (*see* Dkt. # 15 at p. 3), has already been considered and expressly rejected by the Board in the May 21 Order. (May 21 Order at p. 3).

C. Autoplastic’s Admissions Establish that its StP Mark is Likely To Cause Confusion As a Matter of Law

To establish a likelihood of confusion on a motion for summary judgment, Petitioner must establish that there is no genuine dispute of material fact that (1) it has standing to petition to cancel the Registration; (2) it has priority of use; and (3) Autoplastic’s use of the mark StP is likely to cause confusion among consumers as to the sponsorship, affiliation or connection of goods offered under the parties’ respective marks. *See, e.g., Lipton Indus., Inc. v. Ralston Purina Co.*, 213 U.S.P.Q. 185, 187 (C.C.P.A. 1982); *Hornblower & Weeks, Inc. v. Hornblower &*

Weeks, Inc., 60 U.S.P.Q.2d 1733, 1735 (T.T.A.B. 2001). As detailed below, based on the undisputed evidence in the record and Autoplastic's own admissions, there can be no genuine dispute that Petitioner has established each of these elements.

1. There Can Be No Dispute that Petitioner Has Standing

Under the Lanham Act, "any person who believes that he is or will be damaged . . . by the registration of a mark" may file a petition for cancellation. 15 U.S.C. § 1064. This threshold standing requirement is satisfied where the petitioner possesses a "real interest" in the proceeding. *Compuclean Mktg. & Design v. Berkshire Prods. Inc.*, 1 U.S.P.Q.2d 1323, 1324 (T.T.A.B. 1986) (citing cases). As the owner of the 15 registrations for the STP Marks made of record in the Petition to Cancel, Petitioner unquestionably has a "real interest" in challenging the registration of Autoplastic's StP Mark. Moreover, Autoplastic has admitted that it does not challenge Petitioner's standing to maintain the instant cancellation proceeding and does not contest Petitioner's ownership of the STP Marks. (Jones Decl. at **Exhibit A** (the "RFAs") at RFA ## 39-40). Accordingly, there is no dispute that Petitioner has standing.

2. There Can Be No Dispute that Petitioner Has Priority

Priority is established by Petitioner's showing of proprietary rights in its STP Marks arising from "a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights." *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 64 U.S.P.Q.2d 1375, 1378 (Fed. Cir. 2002); TBMP § 309.03(c)(A).

Autoplastic has admitted that it claims no rights prior to April 2010 (the date of the filing of its I.R. Extension). (RFA # 38). Here, Petitioner is the owner of 15 registrations of record for marks that consist of or include STP. (Petition to Cancel at ¶ 6 and **Exhibit A** thereto). Thirteen

of these issued before April 2010, including many that issued in the 1950s, 60, and 70s. (*Id.*) This established Petitioner's priority. See, e.g., *Herbko*, 64 U.S.P.Q.2d at 1378; *King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 U.S.P.Q. 108, 110 (C.C.P.A. 1974); TBMP § 309.03(c)(A).

Therefore, no dispute exists regarding Petitioner's priority of rights.

3. There is No Dispute of Material Fact that Autoplastic's StP Mark Is Not Entitled to Registration Under Section 2(d) of the Lanham Act

Section 2(d) of the Lanham Act states in pertinent part that a trademark shall be refused registration if it so resembles a prior used or registered mark "as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d). In determining likelihood of confusion, the Board reviews the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 177 U.S.P.Q. 563, 567 (C.C.P.A. 1973) ("*du Pont*"), to the extent relevant. See also *Recot, Inc. v. Becton*, 54 U.S.P.Q.2d 1894, 1896-97 (Fed. Cir. 2000). Here, the relevant factors are: (i) the strength and fame of Petitioner's STP Marks; (ii) the similarity of the STP Marks and Autoplastic's StP Mark; (iii) the relatedness of the parties' respective goods; (iv) the overlap of the parties' trade channels and consumers; (v) the nature and extent of any actual confusion; (vi) the sophistication of the parties' consumers; (vii) a lack of third-party use of similar marks; and (viii) Autoplastic's intent.

In this case, Autoplastic has **admitted** all the facts necessary to show that the *du Pont* factors overwhelmingly evidence a likelihood of confusion. Accordingly, Petitioner is entitled to summary judgment on its Section 2(d) claim.

a. There Can Be No Dispute that Petitioner's STP Marks are Strong and Famous

An important *du Pont* factor is the strength and fame of the senior mark. See *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.*, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992) (a famous mark "casts a long shadow which competitors must avoid").

By Autoplastic's own admission, Petitioner's STP Mark is famous in the United States in connection with automotive products. (RFA # 5).

By Autoplastic's own admissions, it was aware of Petitioner's STP Marks and registrations before adopting or applying to register the StP Mark in the U.S. (RFA ## 1-4).

As such, this *du Pont* factor weighs conclusively in favor of Petitioner.

b. There Can Be No Dispute that the STP and StP Marks are Highly Similar

Another key *du Pont* factor focuses on the similarity of the marks in their entireties as to appearance, sound, and commercial impression. *du Pont*, 177 U.S.P.Q. at 567.

By Autoplastic's own admission, its StP Mark is highly similar in appearance to Petitioner's STP Mark. (RFA # 7).

By Autoplastic's own admission, its StP Mark is aurally indistinguishable from Petitioner's STP Mark. (RFA # 8).

By Autoplastic's own admission, its StP Mark and Petitioner's STP Mark create a highly similar commercial impression. (RFA # 9).

Accordingly, this *du Pont* factor weighs conclusively in favor of Petitioner.

c. There Can Be No Dispute That Autoplastic's Automotive Goods are Closely Related to Petitioner's Automotive Goods

Another key *du Pont* factor is the similarity and relatedness of the parties' products offered under their respective marks. *du Pont*, 177 U.S.P.Q. at 567. The goods at issue need not be identical for confusion to be likely; there need only be some similarity or relatedness between them. *In re Melville Corp.*, 18 U.S.P.Q.2d 1386, 1388 (T.T.A.B. 1991); *Recot, Inc.*, 54 U.S.P.Q.2d. at 1898 ("It is the sense of relatedness that matters in the likelihood of confusion analysis.").

By Autoplastic's own admission, it uses its StP Mark on automotive products (RFA # 24)—the same kind of products for which Petitioner has registered and uses its STP Marks.

By Autoplastic's own admission, Autoplastic's goods offered under its StP Mark are similar to Petitioner's goods offered under its STP Marks. (RFA # 22).

By Autoplastic's own admission, Autoplastic's goods offered under its StP Mark are related to Petitioner's goods offered under its STP Marks. (RFA # 23).

Accordingly, the *du Pont* factor concerning similarity of the parties' respective goods weighs conclusively in Petitioner's favor.

d. There Can Be No Dispute That the Parties' Trade Channels and Consumers Overlap

Another *du Pont* factor is the overlap of the parties' trade channels and consumers.

By Autoplastic's own admission, the goods offered under Autoplastic's StP Mark are or will be sold through the same channels of trade as Petitioner's goods offered under Petitioner's STP Marks. (RFA # 25).

By Autoplastic's own admission, it has no intention to restrict the channels of trade through which goods offered under its StP Mark will be marketed. (RFA # 27).

By Autoplastic's own admission, the goods offered under the StP Mark are or will be advertised in the same channels as Petitioner's goods offered under Petitioner's STP Marks. (RFA # 13).

By Autoplastic's own admission, consumers for the goods offered or intended to be offered under Autoplastic's StP Mark will overlap with consumers of Petitioner's goods sold under Petitioner's STP Marks. (RFA # 11).

Accordingly, the *du Pont* factor concerning the overlap of trade channel and customers weighs conclusively in favor of Petitioner.

e. There Can Be No Dispute Concerning Consumer Sophistication

The next *du Pont* factor considers “the conditions under which and buyers to whom sales are made, *i.e.*, ‘impulse’ vs. careful, sophisticated purchasing.” *du Pont*, 177 U.S.P.Q. at 567. Here, there is no dispute that the consumers for the parties’ goods are not discriminating purchasers likely to spend considerable time examining the competing marks in order to discern any slight difference.

By Autoplastic’s own admission, it has no evidence that consumers of the parties’ goods are sophisticated purchasers. (RFA # 41).

By Autoplastic’s own admission, it has no evidence that the consumers of the parties’ goods are discriminating purchasers. (RFA # 42).

Accordingly, this *du Pont* factor weighs in Petitioner’s favor.

f. There Is No Evidence of Third Party Uses to Weaken Petitioner’s STP Marks

Another *du Pont* factor assesses “[t]he number and nature of similar marks in use on similar goods.” *du Pont*, 177 U.S.P.Q. at 567. “Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005) (citations omitted).

By Autoplastic’s own admission, it is not aware of any third party use of the STP mark in connection with automotive products other than Petitioner. (RFA # 30).

By Autoplastic’s own admission, it has no evidence that consumers associate the mark STP with any entity other than Petitioner. (RFA # 31).

By Autoplastic's own admission it has no evidence that consumers associate goods offered under the mark STP with any entity other than Petitioner. (RFA # 32).

Accordingly, this *du Pont* factor also strongly supports a finding of likelihood of confusion.

g. Autoplastic's Intent

It is clear that Autoplastic was well-aware of Petitioner's STP Marks for automotive products when it adopted and registered its StP Mark for automotive products.

By Autoplastic's own admission it was aware of Petitioner's STP Marks used in connection with automotive products before it adopted its StP Mark in connection with the sale of goods in the U.S. (RFA # 1).

By Autoplastic's own admission it was aware of Petitioner's STP Marks used in connection with automotive products before it applied to register its StP Mark in connection with the sale of goods in the U.S. (RFA # 2).

By Autoplastic's own admission it was aware of Petitioner's registrations for the STP Mark it applied to register its StP Mark in connection with the sale of goods in the U.S. (RFA # 3).

By Autoplastic's own admission it was aware of Petitioner's registrations for the STP Mark it adopted its StP Mark in connection with the sale of goods in the U.S. (RFA # 4).

Accordingly, the evidence strongly suggests that Autoplastic acted in bad faith in applying to register its StP Mark.

Moreover, even if there were a dispute concerning Autoplastic's intent, it is not a material dispute—in fact, it is irrelevant given all of the other factors discussed above. *See, e.g., Daddy's Junky Music Stores, Inc v. Big Daddy's Family Music Ctr.*, 42 U.S.P.Q.2d 1173, 1183 (6th Cir.

1997) (“[T]he *presence* of intent can constitute strong evidence of confusion The converse of this proposition, however, is not true; the *lack* of intent by a defendant is largely irrelevant in determining if consumers likely will be confused as to source.”) (emphases in original).¹

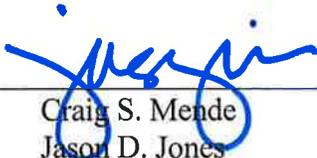
CONCLUSION

For the foregoing reasons, the undisputed facts and admissions establish a likelihood of confusion, mistake and deception arising from registration of Autoplastic’s StP Mark and, thus, Petitioner is entitled to summary judgment on its Section 2(d) claim.

Accordingly, Petitioner respectfully requests that Registration No. 4,137,345 be cancelled and that judgment for Petitioner be entered in this proceeding.

Dated: June 6, 2013
New York, NY

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

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¹ Likewise, it is well-established that “it is unnecessary to show actual confusion in establishing a likelihood of confusion,” which is the test for infringement. *Giant Food, Inc v. Nation’s Foodservice, Inc.*, 218 U.S.P.Q. 390, 396 (Fed. Cir. 1983).

CERTIFICATE OF SERVICE

I hereby certify that on this 6th day of June 2013, I caused a true and correct copy of the foregoing **Petitioner's Motion For Summary Judgment** to be deposited with the United States Postal Service as First Class mail, postage prepaid, in an envelope addressed counsel for Autoplastic as follows:

Sergei Orel, Esq.
Miskin & Tsui-Yip, LLP
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New York, NY 10018



Jason D. Jones