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TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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JK

Mailed: June 30, 2015

Cancellation No. 92059235

Nite Ize, Inc.

v.

Zhangwei Mo

**Before Bergsman, Gorowitz and Goodman,
Administrative Trademark Judges.**

By the Board:

Zhangwei Mo (“Respondent”) owns Registration No. 4179235 for the mark NITEYE (standard characters) for the following International Class 11 goods:

aquarium lights; bicycle lights; diving lights; flashlights; landscape lighting installations; overhead lamps; pocket search lights; safety lamps for underground use; searchlights; ultraviolet lamps not for medical purposes; table, floor and street lamps.¹

Nite Ize, Inc. (“Petitioner”) filed a petition to cancel the registration on the grounds of 1) priority and likelihood of confusion pursuant to Trademark Act § 2(d), 2) dilution pursuant to Trademark Act § 43(c), 3) misrepresentation of source pursuant to Trademark Act § 14(3), and 4) fraud on the USPTO. Petitioner pleads common law use of the mark NITE IZE on “flashlight accessories” since 1989 (pet.

¹ Registration issued July 24, 2012 from an application filed December 2, 2011, and asserting a date of first use anywhere of October 11, 2008 and date of first use in commerce of May 1, 2010.

to cancel, para. 4), on “flashlights...in combination flashlight sets” since November 3, 2005 (pet. to cancel, para. 10), and on “flashlights” as early as May 24, 2010 (pet. to cancel, para. 11), and pleads ownership of two registrations for the mark NITE IZE (typed) for:

- 1) “headbands to be worn by a person and designed to hold a flashlight” in International Class 25; and²
- 2) “holders for and attachments to flashlights, namely, non-metallic bands for holding a flashlight to a person or to another object; non-metallic connectors for holding a flashlight to a bicycle; cords for attachment to a flashlight for use in carrying a flashlight; non-metallic loops for holding a flashlight; non-metallic holders for carrying a flashlight; non-metallic hand held holders for carrying a flashlight and spare flashlight batteries; non-metallic holsters for carrying a flashlight and spare flashlight batteries; adapters for attaching a fiber optic light element to a flashlight; connectors for holding a flashlight to a helmet; magnetic holders for attaching a flashlight to magnetic or magnetically permeable articles; mouthpiece shaped holders for use in holding a flashlight in the mouth of a person; non-metallic attachments for converting a flashlight to a signal light; non-metallic holders in the shape of a sleeve for holding a flashlight; non-metallic holders in the shape of a sleeve with a combined hand strap for holding a flashlight; non-metallic underwater holders for flashlights; non-metallic underwater holders, including a float, for flashlights; and display racks for holding any or all of the above flashlight holders and attachments” in International Class 11.³

In the amended answer, filed September 9, 2014, Respondent admitted that the marks are comprised in part of the term “nite.” (Answer, para., 12).

Respondent otherwise denied the salient allegations in the petition to cancel.

² Registration No. 1620077 issued October 30, 1990, from an application filed February 20, 1990, and asserting a date of first use anywhere and date of first use in commerce of February 13, 1990. A second renewal was issued November 10, 2010.

³ Registration No. 2237945 issued April 13, 1999, from an application filed July 22, 1996, and asserting a date of first use anywhere and date of first use in commerce of February 13, 1990. The first renewal was issued January 17, 2009.

Petitioner filed a motion for partial summary judgment on its claim of priority and likelihood of confusion. The motion is fully briefed.⁴

ANALYSIS

Summary judgment is appropriate where the movant shows that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). A party asserting that a fact cannot be true or is genuinely disputed must support its assertion by either 1) citing to particular parts of materials in the record, or 2) showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact. *See* Fed. R. Civ. P. 56(c). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). The party seeking judgment in its favor carries the burden of proof. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986).

Evidence on summary judgment must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029

⁴ Respondent's brief is not numbered, as required by Trademark Rule 2.126(a)(5). This creates problems for the Board in referencing the record. The Board expects that all future filings will comply with this rule.

Respondent's motion, filed concurrently with its brief in opposition to the motion for summary judgment, requesting leave to file its brief out of time, is granted as conceded. *See* Trademark Rule 2.127(a).

(Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472. The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. See *Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1544. See TBMP § 528.01 (2014), and cases cited therein.

To prevail on summary judgment on its §2(d) claim, Petitioner must demonstrate that there is no genuine dispute that 1) it has priority, and 2) the contemporaneous use of the parties' respective marks on their respective goods is likely to cause confusion, mistake or to deceive consumers regarding the source of the goods. See *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001).

Priority

Petitioner must, in the first instance, establish prior rights in the same or a similar mark. Respondent can, in turn, establish that it has rights in its mark that are superior to those of Petitioner. See *Brewski Beer Co. v. Brewski Bros. Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998). Either party may rely on the filing date of the application underlying its registration or registrations, and if neither party submits proof of its use prior to its respective application filing date, priority belongs to the party with the earlier filing date.⁵ See Trademark Act § 7(c). See also *Dan Foam*

⁵ Petitioner did not submit a status and title copy of pleaded Registration No. 2237945 in connection with its motion for summary judgment. However, Petitioner did submit with its motion the TESS printout of its pleaded Registration No. 1620077, the underlying application filing date of which is February 20, 1990. The filing date of the application underlying Respondent's registration is December 2, 2011; on summary judgment Respondent submitted no evidence of use of its mark prior to that date. While this

ApS v. Sleep Innovations Inc., 106 USPQ2d 1939, 1945 (TTAB 2013), *citing Hilson Research Inc. v. Society for Human Resource Mgmt.*, 27 USPQ2d 1423, 1428-29 n.13 (TTAB 1993) and *Brewski Beer Co. v. Brewski Bros. Inc.*, *supra*.

As noted, Petitioner pleads common law use of the mark for “flashlight accessories” and “flashlights.” In its response to the summary judgment motion, Respondent challenges Petitioner’s priority with respect to “flashlights.”

In its supporting declaration, Petitioner states:

[O]n February 1, 2010, Nite Ize announced the acquisition of INOVA brand LED performance flashlights. Nite Ize has been selling and co-branding INOVA brand LED performance flashlights since shortly thereafter. (Clint Todd decl., para. 7).

This testimony, and in particular the attestation of use “since shortly (after February 1, 2010)” does not set forth Petitioner’s date of first use of the mark NITE IZE on “flashlights” with sufficiently clear and convincing specificity.

Furthermore, the testimony is not supported or clarified by documentary evidence. *See H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1722-23 (TTAB 2008). Although Petitioner states in its reply brief that as evidenced by the web archive record, it used its NITE IZE mark at least as early as May 24, 2010 in connection with flashlights (reply brief, p. 6), the web archive record referred to by Petitioner from its own website was submitted with its petition to cancel, and not

submission by Petitioner into evidence would be sufficient to demonstrate that there is no genuine dispute as to its § 2(d) priority with respect to the goods identified in its pleaded Registration No. 1620077, “headbands to be worn by a person and designed to hold a flashlight,” we decline to address priority piecemeal.

with the summary judgment motion. Therefore, it is not evidence on summary judgment.⁶

On this record, the testimony does not establish Petitioner's priority with respect to "flashlights." As a result, its priority with respect to these goods is an issue on which there is a genuine dispute. At trial, if and to the extent that Petitioner relies on a claim of priority based on common law use of the mark NITE IZE for "flashlights," it must prove its priority.

Likelihood of confusion

Consideration of likelihood of confusion in the context of summary judgment motions involves an analysis of all of the probative facts in evidence that are relevant to the thirteen factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("du Pont factors"). See also, *M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1946 (Fed. Cir. 2006); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 UPSQ2d 1201, 1203 (Fed. Cir. 2003). We look to whether there are genuine disputes with respect to any of these factors which would be material to a decision on the merits.

The marks

⁶ With the exception of a registration made of record in a manner set forth in Trademark Rule 2.122(d)(1), exhibits to pleadings are not evidence on behalf of the party to whose pleading the exhibit is attached unless properly identified and introduced in evidence, either on summary judgment or during the assigned period for the taking of testimony. See Trademark Rule 2.122(c); TBMP § 317 (2014).

Both parties acknowledge that the first four letters of their marks are identical. Regarding the marks as a whole, Petitioner argues that the difference between “IZE” and “EYE” is immaterial because, with respect to sound, its mark is pronounced as “nite eyes” and Respondent’s mark is pronounced as the singular “nite eye.” Regarding commercial impression, it argues that both marks “refer to the night and eyes, suggesting the ability to see at night” (brief on motion, p. 6), and submits the declaration of its general counsel stating, “[T]he NITE IZE Mark is suggestive of aiding the user to see at night, *i.e.* having night eyes” and “[T]he NITEYE Mark ... is suggestive of the same: aiding the user to see at night, *i.e.* having night eyes” (Todd decl., para. 5-6).

Respondent argues that the marks do not create the same appearance, connotation, and commercial impression because “-IZE” in Petitioner’s mark creates a connotation that differs from the “night eyes” meaning. It submits a page from the *Merriam-Webster’s Online Dictionary* defining “IZE” as a verb suffix with the following meanings:

- :to cause to become or become like something specified
- :to become or become like (something specified)
- :to treat like something specified
- :to talk or write about someone or something in a specified way

After thorough consideration of what the record shows regarding the similarity or dissimilarity between the marks NITEYE and NITE IZE, as well as the commercial impressions created by these marks - both of which issues are material to a decision on the merits – there is a genuine dispute with respect to the first *du Pont* factor. First, regarding sound, to the extent that Petitioner’s argument goes to

how the parties' marks are spoken, it is well-settled that there is no single correct pronunciation of a trademark because it is impossible to predict how the public pronounces or will pronounce any particular mark. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1409 (TTAB 2010); *Centraz Indus. Inc. v. Spartan Chem. Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006). Second, regarding commercial impression, Respondent has come forward with evidence of meanings of the "-IZE" portion of Petitioner's mark that indicate that the commercial impression and connotation engendered by the mark NITE IZE can reasonably differ from that which Petitioner attributes to its mark. The parties' marks include differences that are sufficient to preclude a finding that, as a matter of law, the marks are so similar that they sound the same and create in the minds of consumers the same commercial impression and connotation. On this record, there is, at a minimum, a genuine dispute regarding the similarity or dissimilarity between the marks NITEYE and NITE IZE.

Other du Pont factors

Both parties address actual confusion. Petitioner argues that there has been actual confusion online inasmuch as a search for NITE IZE on the third-party site www.lightmalls.com retrieves products bearing Respondent's NITEYE mark (brief on motion, p. 14, Exh. E), and that this shows that Lightmalls itself, as a reseller, has been confused. For its part, Respondent argues that this does not create an

inference of actual confusion in the marketplace or confusion by a prospective consumer.

We find that there is a genuine dispute on this record regarding whether actual confusion as to the parties' goods has taken place.

Summary

Inasmuch as Petitioner has not carried its burden of demonstrating the lack of genuine dispute with respect to the elements of its claim, the motion for summary judgment, is denied.⁷

The evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See, e.g., Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1438 n.14 (TTAB 2007); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993). Moreover, the fact that we have identified certain issues that are in dispute should not be construed as a finding that these are necessarily the only issues which remain for trial.

SCHEDULE

Proceedings are resumed. Expert disclosure, discovery and trial dates are reset as follows:

Expert Disclosures Due	7/15/2015
Discovery Closes	8/14/2015
Plaintiff's Pretrial Disclosures Due	9/28/2015
Plaintiff's 30-day Trial Period Ends	11/12/2015
Defendant's Pretrial Disclosures Due	11/27/2015

⁷ The parties shall not file any further motions for summary judgment in this proceeding.

Defendant's 30-day Trial Period Ends	1/11/2016
Plaintiff's Rebuttal Disclosures Due	1/26/2016
Plaintiff's 15-day Rebuttal Period Ends	2/25/2016

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.