

ESTTA Tracking number: **ESTTA675311**

Filing date: **06/01/2015**

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

Proceeding	92060308
Party	Plaintiff SFM, LLC
Correspondence Address	NICOLE M MURRAY QUARLES & BRADY LLP 300 N LASALLE ST, STE 4000 CHICAGO, IL 60654 UNITED STATES tm-dept@quarles.com, nicole.murray@quarles.com, christi-an.stahl@quarles.com
Submission	Opposition/Response to Motion
Filer's Name	Matthew T. Ingersoll
Filer's e-mail	matthew.ingersoll@quarles.com, tm-dept@quarles.com, nicole.murray@quarles.com, christian.stahl@quarles.com
Signature	/Matthew T. Ingersoll/
Date	06/01/2015
Attachments	SJ Response with Exhibits.pdf(588251 bytes)

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

In the Matter of Registration No. 3,708,453; Mark: SPROUT;
Date of Registration: November 10, 2009

SFM, LLC

Petitioner,

v.

Cancellation No: 92060308

CORCAMORE, LLC

Respondent.

**PETITIONER’S MEMORANDUM OF LAW IN OPPOSITION TO RESPONDENT’S
MOTION FOR SUMMARY JUDGMENT**

Respondent Corcamore, LLC’s (“Respondent”) Motion for Summary Judgment¹ is meritless, and should be denied. The doctrine of issue preclusion does not apply here. And even if it did, Respondent cannot establish that there is no genuine issue of material fact that issue preclusion should apply.

In a previous preliminary injunction proceeding between SFM and a third-party that is unrelated to Respondent, SFM was almost preliminarily enjoined from using its mark in a small region in southern California due to fact-specific issues unique to that case. Based on this preliminary finding by a California district court judge, Respondent argues that SFM should be precluded from asserting priority in the present cancellation proceeding. *See* Respondent’s Motion to Dismiss, Dkt. No. 8 (“MTD”), at 14-17. Respondent’s argument is wholly without

¹ Respondent’s Motion for Summary Judgment arises from its Motion to Dismiss and addition of extra pleading material.

merit. It fails to satisfy even a single element required to prove issue preclusion, and belies common sense. For example, the issues in the prior proceeding were not identical as required nor were the issues actually litigated. Given Respondent's complete failure to prove that issue preclusion should apply here, SFM requests that the Board deny this motion.

I. Background

The 2012 preliminary injunction order from a California district court relied on by Respondent stemmed from a trademark dispute between SFM, which operates a chain of grocery stores under the "SPROUTS FARMERS MARKET" mark, and the proprietor of a grocery store in Temecula, California, which was operating under the name "Sprouts Natural Market" (the "Temecula-grocer"). *Id.*, Tab 1 at 1. In the prior dispute, SFM brought a trademark infringement action against the Temecula-grocer, and the Temecula-grocer counterclaimed, asserting various claims and seeking to enjoin SFM's use of its SPROUTS FARMERS MARKET mark in Temecula, Riverside, Hemet, Corona, Carlsbad, Vista, Escondido, San Marcos, Fallbrook, and Oceanside, California. *Id.*, Tab 1 at 1-3.

At the preliminary injunction stage of that proceeding, the court made a finding of fact that the Temecula-grocer had priority for use of its mark over SFM. *Id.*, Tab 1 at 9. And as a result of the similarity of the marks, and the fact that both parties operated grocery stores, the court found confusion between the parties' marks likely. *Id.*, Tab 1 at 10-11. The court narrowly enjoined SFM's use of the mark, limiting the scope of the injunction to the county in which Temecula is located: Riverside County, California. *Id.*, Tab 1 at 16.

However, the preliminary injunction was never entered, the required bond was never posted, and the case settled. *See* Order Granting Revised Joint Motion to Stay, attached hereto as Exhibit A and Order Granting Joint Motion And Stipulation For Dismissal With Prejudice,

attached hereto as Exhibit B; *see also* Civil Docket For Case #: 3:11-cv-02640, attached hereto as Exhibit C.

In this case, SFM seeks to cancel Respondent's registration on the grounds of likely confusion between its registrations for SPROUTS and SPROUTS FARMERS MARKET (for use with grocery store services), and Respondent's registration for SPROUT (for use with vending machine services). *See generally* First Amended Petition for Cancellation, Dkt. No. 6. Respondent moved to dismiss SFM's petition, arguing that SFM should be precluded from alleging it has priority for use of its mark over Respondent, because SFM was almost preliminarily enjoined in the earlier proceeding from using its mark in Riverside County, California. *See* MTD at 15. In its April 30, 2015 Order, the Board converted Respondent's motion to dismiss to one for summary judgment, and allowed SFM thirty days to oppose the converted summary judgment motion. *See* April 30, 2015 Order, Dkt. No. 15 at 9.

II. Legal Standard

A party is not entitled to summary judgment unless it proves the absence of any dispute of material fact. *See* Fed. R. Civ. P. 56(a). If there is any issue of material fact, the motion must be denied. *Id.* When a reasonable fact finder could find for the nonmoving party based on the evidence of record, the motion must be denied. *Software Dev. Solutions, Inc. v. Aircast Mobile, Inc.*, 2013 WL 6046663, at *3 (T.T.A.B. 2013)². All evidence presented by the movant is to be viewed in a light favorable to the nonmoving party, and all justifiable inferences will be drawn against the movant. *Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 U.S.P.Q.2d 2027, 2029 (Fed. Cir. 1993). It is the movant's burden to establish the absence of any dispute of material fact. *See id.* Here, Respondent must prove an absence of material fact as to whether issue preclusion should apply.

² Copies of non-precedential decisions are attached hereto as Exhibit D.

The doctrine of issue preclusion (also sometimes known as “collateral estoppel”), which serves to bar the revisiting of “issues” that have been already fully litigated, requires the movant to prove four factors: (1) that the issues in a prior proceeding were identical to those in the proceeding at issue; (2) that those issues were actually litigated; (3) that the determination of the issues was necessary to the resulting judgment; and, (4) that the party defending against preclusion had a full and fair opportunity to litigate the issues. *See Montana v. United States*, 440 U.S. 147, 153-55 (1979); *Jet Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 1365 (Fed. Cir. 2000).

Issue preclusion is especially inappropriate when the alleged issue was decided at preliminary injunction. For example, in *The Sturgis Area Chamber of Commerce v. Sturgis Bike Week, Inc.*, the Board noted “that prior decisions on motions for preliminary injunction generally [should] not [be] given preclusive effect, in part due to the tentative nature of such decisions.” 2004 WL 1701274, *3 n. 5 (T.T.A.B. 2004). In *Sturgis*, the opposer sought to rely on a previous preliminary injunction decision in a civil action between the parties as a basis for its motion for summary judgment on its 2(d) claim. *Id.* at *3. The Board rejected the opposer’s attempt to rely upon the preliminary injunction decision at summary judgment in a subsequent proceeding before the Board, explaining that after issuance of the preliminary injunction order, “the parties in the civil action entered into a co-existence agreement, settlement agreement and release . . . which led to dismissal with prejudice of the civil action and a permanent injunction that did not enjoin” the applicant’s continued use of the mark. *Id.* As a result, the Board found that “at a minimum, there exists a genuine issue of material fact as to whether the finding in the preliminary injunction decision” that use of the applicant’s mark is likely to cause confusion was necessary to the resulting final judgment in the civil action between the parties. *Id.*

III. Argument

Issue preclusion does not apply in this case. First, the issues in the prior proceeding are different than those in this case. Second, the issues in the prior proceeding were not actually litigated. Third, the judgment in the prior case is irrelevant and was never entered. And finally, Petitioner SFM did not have an opportunity to fully and fairly litigate its claim in the prior proceeding. Since issue preclusion does not apply here, the Board should deny Respondent's motion for summary judgment.

A. The issues in the California district court case relied on by Respondent differ from those here.

The issues at stake in the prior and current proceedings are different, and Respondent's arguments to the contrary constitute an improper *jus tertii* defense. Respondent argues that since the court in the prior proceeding preliminarily found that SFM did not have priority over the Temecula-grocer in Riverside County, California, SFM is now precluded from asserting priority against Respondent in this proceeding. *See* MTD at 16. This argument fails for at least two reasons.

First, issue preclusion requires that the issues at stake be identical. *Jet Inc.*, 223 F.3d at 1365. The issue of who has priority between SFM and the Temecula-grocer on the one hand, and SFM and Respondent on the other hand, are two separate and unrelated issues. Respondent does not claim to be in privity with the Temecula-grocer, so the prior court's preliminary finding that the Temecula-grocer has priority over SFM does not somehow inure to the benefit of Respondent. The issue of who has priority between SFM and the Temecula-grocer, and SFM and Respondent is therefore irrelevant³ in this case.

³ Moreover, even ignoring the preliminary nature of the prior proceeding and its complete lack of relevance here, and assuming *arguendo* that the Temecula-grocer had priority over SFM, the scope of the injunction was limited to Riverside County. *See* MTD, Tab-1 at 16. Implicit in the scope of the

Second, Respondent's argument appears to be an attempt to raise an improper *jus tertii* defense. The defense of *jus tertii* arises when a defendant attempts to raise the right of a third party. 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 31.160 (4th Ed. 2013). In a trademark dispute, a claim by a defendant that a third party has rights in the mark superior to a plaintiff is in effect, a *jus tertii* defense. See *The Maytag Co. v. Luskin's, Inc.*, 228 U.S.P.Q. (BNA) 747, 749 (T.T.A.B. 1986). The *jus tertii* defense has been clearly rejected in opposition and cancellation proceedings. *Id.*; *McCarthy* at § 31.160. *McCarthy* explains the policy why *jus tertii* is disfavored by the Board:

As a matter of policy, *jus tertii* should not be allowed as a defense in any trademark case. So long as plaintiff proves rights superior to defendant, that is enough. Defendant is no less an infringer because it is brought to account by a plaintiff whose rights may or may not be superior to the whole world. The plaintiff's speculative dispute with a third party does not concern the defendant.

Id.

Here, whether or not SFM has priority over the Temecula-grocer should have no impact on the priority issue between SFM and Respondent. In other words, SFM's "speculative dispute with a third-party does not concern" Respondent. And even if it did, the prior dispute with the Temecula-grocer is over, and no injunction was entered. See Exhibits A & B.

The issues in the prior and current proceedings are not identical, and Respondent's motion amounts to nothing more than an improper *jus tertii* argument. The Board should therefore reject Respondent's motion.

B. The issues in the California district court case were not actually litigated.

The issues raised by Respondent were not actually litigated in the prior proceeding. Respondent's suggestion that preliminary injunctions result in issue preclusion is at best

injunction is that SFM's rights were superior to the Temecula-grocer's everywhere else in the United States.

misleading. In support of this inaccurate statement, Respondent cites two cases: *Abbott Laboratories v. Andrx Pharmaceuticals Inc.*, 473 F.3d 1196, 1204 (Fed. Cir. 2007) and *Miller Brewing v. Jos. Schlitz Brewing Co.*, 605 F.2d 990, 996 (7th Cir. 1979).

Miller is inapposite. In *Miller*, the Seventh Circuit affirmed a district court's denial of a preliminary injunction based on the finding that the asserted trademark (LITE for beer) was generic and upheld the district court's finding that the trademark was invalid. *Miller*, 605 F.2d at 991. Subsequent to the Seventh Circuit's affirmation, Miller sued another competitor, Schlitz, based on the same trademark. *Id.* The district court found that the finding of invalidity in the preliminary injunction context in the prior proceeding precluded Miller from asserting the mark against Schlitz. *Id.* at 991-92. On appeal, the Seventh Circuit held that the generic status of the mark had been so thoroughly litigated in the first preliminary injunction proceeding that, as to that issue, there was a sufficient final judgment. *Id.* Moreover, in *Miller*, the issue was invalidity of the LITE trademark because of genericness, which would affect Miller's rights nationwide. In contrast, in SFM's California district court case, the preliminary injunction order was not actually entered by the district court nor was it affirmed by any appellate court. Even if it had been entered, the affect of the order would have been limited to Riverside County, California, not nationwide.

In *Abbott*, the other case relied on by Respondent, the court declined to give the preliminary injunction order at issue preclusive effect. *Abbott Laboratories*, 473 F.3d at 1206-07. The defendant in *Abbott* claimed issue preclusion based on a preliminary finding that an unrelated defendant in another case had a likelihood of success of proving the invalidity of Abbott's patents. *Id.* at 1206. The Federal Circuit declined to give the finding in the other case preclusive effect. *Id.* The court explained "[a] determination that there is merely a likelihood of

proving invalidity is a determination made solely in terms of probabilities, not certainties and is therefore not full litigation and decision on the merits for purposes of issue preclusion.” *Id.* (internal citations and quotations omitted).

The *Abbott* court also put *Miller* in context. Relying on a later Seventh Circuit opinion, the *Abbott* court deemed *Miller*’s holding “the exception to the rule,” that will only arise “in certain rare circumstances.” *Id.* 1206-07 (internal citations and quotations omitted). Affording preliminary relief decisions preclusive effect should only occur “based on a determination that concludes an insuperable obstacle to the [nonmoving party’s] success on the merits.” *Id.* (internal citations and quotations omitted). “Such an insuperable obstacle exists when a prior decision made in connection with a preliminary injunction proceeding clearly intended to firmly and finally resolve the issue, rather than estimate the likelihood of success of proving that issue.” *Id.* (internal citations and quotations omitted).

Here, SFM faced no such “insuperable obstacle” in overcoming the prior finding that the Temecula-grocer had a likelihood of prevailing on its infringement claim. The “insuperable obstacle” in *Miller* was a finding that LITE was generic, which that court “clearly intended to firmly and finally resolve.” In this case, the California district court in the prior litigation merely estimated that the Temecula-grocer had a likelihood of success of proving it had priority over SFM in *Riverside County, California only*. As *Abbott* makes clear, such a preliminary finding is not the type of issue that is intended to have preclusive effect. *See also Starbuck v. City & County of San Francisco*, 556 F.2d 450, 457 n. 13 (9th Cir. 1977) (granting a preliminary injunction in [the prior] case is not a final judgment sufficient for collateral estoppel purposes); *Sorenson v. Raymond*, 532 F.2d 496, 498–499 (5th Cir. 1976) (holding that “a finding against a defendant at a preliminary injunction hearing cannot estop him from contesting the same issue in

another suit, because the judge in a preliminary injunction hearing seeks only to preserve the status quo by determining whether the plaintiffs have ‘a substantial likelihood’ of succeeding on the merits”); *Shayne v. National Hockey League*, 504 F. Supp. 1023, 1030 (E.D.N.Y. 1980) (ruling that extensive findings of fact and conclusions of law made before trial solely for purposes of granting motions for preliminary injunction had no collateral estoppel effect, since no final judgment was ever entered in the prior litigation).

The preliminary finding by the California district court in the prior proceeding was not “actually litigated” for purposes of issue preclusion. The Board should therefore also deny Respondent’s motion due to Respondent’s failure to satisfy the second necessary element for a finding of issue preclusion.

C. The third element of issue preclusion is irrelevant in this case.

The third element of issue preclusion requires the moving party to show that the determination of the issues was necessary to the resulting judgment. The third element is irrelevant here. While determination of priority was necessary to the district court’s preliminary finding, as outlined above, that proceeding does not bear on this case.

D. The parties in the California district court case settled, the preliminary injunction was never entered, and SFM never had the opportunity to fully and finally adjudicate the issue.

Finally, Respondent failed to satisfy the fourth element of issue preclusion, that the party defending against preclusion had a full and fair opportunity to litigate the issues, for reasons similar to its failure to satisfy the second element: since it was a preliminary ruling, SFM did not have the opportunity to fully and fairly litigate the priority issue in the first proceeding. Had the case proceeded, SFM would have had an opportunity to overcome the district court’s finding that the Temecula-grocer had priority in Riverside County. Ultimately, the preliminary injunction

was never entered and the parties settled. A settlement agreement that results in a dismissal with prejudice is not entitled to preclusive effect. As the Supreme Court explained, “[t]he general rule is that issue preclusion attached only when an issue is actually litigated and determined by a valid and final judgment.” *Arizona v. California*, 530 U.S. 392, 395 (2000). And “settlements ordinarily lack issue-preclusive effect.” *Id.* The Court went on to hold that issue preclusion did not apply because the consent judgment in the first action “was ambiguous as between the mutually exclusive theories of recovery,” and therefore “too opaque to serve as a foundation for issue preclusion.” *Id.* at 396. Here, in the California district court action, SFM and the Temecula-grocer accused the other of trademark infringement. Like in *Arizona*, the consent judgment terminating the California district court case did not differentiate between these two mutually exclusive theories of recovery. Therefore, the consent judgment in the California district court case is “too opaque to serve as a foundation for issue preclusion.” Thus, there was no opportunity for SFM to fully adjudicate the case on the merits.

IV. Conclusion

The doctrine of issue preclusion does not apply in this case. And even assuming *arguendo* that it did, Respondent has failed to meet its burden of showing that there are no disputed issues of material fact regarding its applicability. Accordingly, Respondent’s motion for summary judgment should be denied.

Dated: June 1, 2015

By: /s/ Christian G. Stahl
Christian G. Stahl

Nicole M. Murray
nicole.murray@quarles.com
Christian G. Stahl
christian.stahl@quarles.com
QUARLES & BRADY LLP
300 N. LaSalle St., Suite 4000
Chicago, IL 60654
(312) 715-5000

Attorneys for Petitioner SFM, LLC

CERTIFICATE OF SERVICE

I certify that on June 1, 2015, a true and correct copy of the foregoing was served via U.S. Mail upon the following:

Charles L. Thomason
55 W. 12th Ave.
Columbus, Ohio 43210

/s/ Christian G. Stahl

QB\35177246.3
5/26/15

EXHIBIT A

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

SFM, LLC, a Delaware limited liability company,

Plaintiff,

vs.

SPROUTS NATURAL MARKET, INC., a California corporation,

Defendant.

Case No. 11-CV-2640-JAH NLS

ORDER GRANTING REVISED JOINT MOTION TO STAY THE ORDER GRANTING IN PART DEFENDANT’S/ COUNTERCLAIMANT’S MOTION FOR A PRELIMINARY INJUNCTION

SPROUTS NATURAL MARKET, INC., a California corporation,

Counterclaimant,

vs.

SFM, LLC, a Delaware limited liability company; SPROUTS FARMERS MARKET, LLC, an Arizona limited liability company; and PREMIER GROCERY, INC., a California corporation,

Counterdefendant and Cross-Defendants, respectively.

1 Having considered the parties' joint motion to stay the Court's Order Granting in Part
2 Defendant's/Counterclaimant's Motion for a Preliminary Injunction [Doc. No. 52] ("Order"),
3 filed September 27, 2012, for a period of fifteen (15) days and good cause appearing, the Court
4 HEREBY ORDERS:

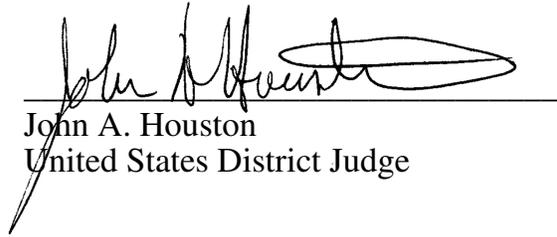
5 (1) The Order Granting in Part Defendant's/Counterclaimant's Motion for a Preliminary
6 Injunction shall be stayed until October 11, 2012;

7 (2) The Defendant shall post a bond in the amount of \$500,000 with the Clerk of the
8 Court pursuant to Federal Rule of Civil Procedure 65(c) no later than October 12, 2012.

9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

IT IS SO ORDERED.

DATED: October 2, 2012



John A. Houston
United States District Judge

EXHIBIT B

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

SFM, LLC, a Delaware limited liability company,
Plaintiff,
vs.
SPROUTS NATURAL MARKET, INC., a
California corporation,
Defendant.

Case No. 11-CV-2640-JAH KSC

**ORDER GRANTING JOINT MOTION AND
STIPULATION FOR DISMISSAL WITH
PREJUDICE**

SPROUTS NATURAL MARKET, INC., a
California corporation,
Counterclaimant,
vs.
SFM, LLC, a Delaware limited liability
company; SPROUTS FARMERS MARKET,
LLC, an Arizona limited liability company; and
PREMIER GROCERY, INC., a California
corporation,
Counterdefendant and
Cross-Defendants, respectively.

IT IS HEREBY ORDERED, pursuant to the parties' Joint Motion and Stipulation for Dismissal with Prejudice, that this action and all claims, counterclaims, and cross-claims among SFM, LLC, Sprouts Farmers Market, LLC, Premier Grocery, Inc., and Sprouts Natural Market, Inc., are dismissed WITH PREJUDICE. Each party will bear its own costs and attorneys' fees.

DATED: October 19, 2012



Hon. John Houston
United States District Judge

EXHIBIT C

CLOSED,ENE

**U.S. District Court
Southern District of California (San Diego)
CIVIL DOCKET FOR CASE #: 3:11-cv-02640-JAH-KSC**

SFM, LLC v. Sprouts Natural Market Inc.
Assigned to: Judge John A. Houston
Referred to: Magistrate Judge Karen S. Crawford
Cause: 15:1114 Trademark Infringement

Date Filed: 11/11/2011
Date Terminated: 10/22/2012
Jury Demand: Plaintiff
Nature of Suit: 840 Trademark
Jurisdiction: Federal Question

Plaintiff

SFM, LLC
a Delaware limited liability company

represented by **Frank G. Long**
Greeberg Traurig, LLP
2375 East Camelback
Suite 700
Phoenix, AZ 85016
602-445-8388
Fax: 602-445-8100
Email: longf@gtlaw.com
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Franklin D Ubell
Greenberg Traurig LLP
3161 Michelson Drive
Suite 1000
Irvine, CA 92612
(949) 732-6500
Fax: (949) 732-6501
Email: ubellf@gtlaw.com
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Joseph R.R. Tache
Greenberg Traurig LLP
3161 Michelson Drive
Suite 1000
Irvine, CA 92612
949-732-6500
Fax: 949-732-6501
Email: tacher@gtlaw.com
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Lindsay A. Ayers

Greenberg & Traurig, LLP
3161 Michelson Drive
Suite 1000
Irvine, CA 92612
(949) 732-6527
Fax: (949) 732-6501
Email: ayersl@gtlaw.com
TERMINATED: 04/16/2012
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Nathan T. Mitchler
Greenberg Traurig
2375 East Camelback Road
Suite 700
Phoenix, AZ 85016
602-445-8000
Fax: 602-445-8735
Email: mitchlern@gtlaw.com
ATTORNEY TO BE NOTICED

V.

Defendant

Sprouts Natural Market Inc.
a California corporation

represented by **Robert H Tyler**
Tyler & Bursch, LLP
24910 Las Brisas Road
Suite 110
Murrieta, CA 92562
(951) 600-2733
Fax: (951) 600-4996
Email: rtyler@tylerbursch.com
ATTORNEY TO BE NOTICED

Cross Claimant

Sprouts Natural Market Inc.
a California corporation

represented by **Robert H Tyler**
(See above for address)
ATTORNEY TO BE NOTICED

V.

Cross Defendant

Premier Grocery, Inc.

represented by **Frank G. Long**
(See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Franklin D Ubell

(See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Joseph R.R. Tache
(See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Lindsay A. Ayers
(See above for address)
TERMINATED: 04/16/2012
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Nathan T. Mitchler
(See above for address)
ATTORNEY TO BE NOTICED

Cross Defendant

Sprouts Farmers Market, LLC

represented by **Frank G. Long**
(See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Franklin D Ubell
(See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Joseph R.R. Tache
(See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Lindsay A. Ayers
(See above for address)
TERMINATED: 04/16/2012
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Counter Claimant

Sprouts Natural Market Inc.
a California corporation

represented by **Robert H Tyler**
(See above for address)
ATTORNEY TO BE NOTICED

V.

Counter Defendant

SFM, LLC
a Delaware limited liability company

represented by **Frank G. Long**
 (See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Franklin D Ubell
 (See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Joseph R.R. Tache
 (See above for address)
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Lindsay A. Ayers
 (See above for address)
TERMINATED: 04/16/2012
LEAD ATTORNEY
ATTORNEY TO BE NOTICED

Nathan T. Mitchler
 (See above for address)
ATTORNEY TO BE NOTICED

Date Filed	#	Docket Text
11/11/2011	<u>1</u>	COMPLAINT with Jury Demand against Sprouts Natural Market Inc. (Filing fee \$350 receipt number 0974-4160459), filed by SFM, LLC. The new case number is 3:11-cv-2640-JAH-NLS. Judge John A. Houston and Magistrate Judge Nita L. Stormes are assigned to the case. (Ayers, Lindsay)(rlu) (cap). (Entered: 11/14/2011)
11/11/2011	<u>2</u>	REPORT on the filing or determination of an action regarding patent and/or trademark number(s) *2,798,632*, *2,924,760*, *3,322,841*, *3,441,913*, *3,730,903*, *3,748,830*, *4,002,187* cc:USPTO (rlu) (cap). (Entered: 11/14/2011)
11/14/2011	<u>3</u>	Summons Issued. Counsel receiving this notice electronically should print this summons and serve it in accordance with Rule 4, Fed.R.Civ.P and LR 4.1. (rlu) (cap). (Entered: 11/14/2011)
11/21/2011	<u>4</u>	ANSWER to <u>1</u> Complaint, with Jury Demand, CROSSCLAIM against Premier Grocery, Inc., Sprouts Farmers Market, LLC, COUNTERCLAIM against SFM, LLC by Sprouts Natural Market Inc.. (Attachments: # <u>1</u> Counterclaim and Cross-Claim, # <u>2</u> Summons)(Tyler, Robert) Summons attached not issued, QC mailer sent to atty (cge). (Entered: 11/21/2011)

11/21/2011	5	***STRICKEN PER DOCKET ORDER # 7*** MOTION for Preliminary Injunction by Sprouts Natural Market Inc. (Attachments: # 1 Memo of Points and Authorities, # 2 Declaration, # 3 Declaration, # 4 Declaration, # 5 Declaration, # 6 Declaration, # 7 Declaration, # 8 Exhibit, # 9 Exhibit, # 10 Exhibit, # 11 Exhibit, # 12 Exhibit, # 13 Exhibit, # 14 Exhibit, # 15 Exhibit) (Tyler, Robert) No hearing date and time, QC mailer sent to atty (cge). (Main Document 5 replaced on 11/22/2011) (ecs). (Entered: 11/21/2011)
11/22/2011	6	Summons Issued on Counterclaim and Cross-Claim. Counsel receiving this notice electronically should print this summons and serve it in accordance with Rule 4, Fed.R.Civ.P and LR 4.1. (cge) (Entered: 11/22/2011)
11/22/2011	7	Notice of Document Discrepancies and Order Thereon by Judge John A. Houston Rejecting Document: Motion for Preliminary Injunction from Defendant Sprouts Farmers Market, LLC. Non-compliance with local rule(s), Civ. L. Rule 5.1: Missing time and date on motion and/or supporting documentation. IT IS HEREBY ORDERED: The document is rejected. It is ordered that the Clerk STRIKE the document from the record, and serve a copy of this order on all parties. Signed by Judge John A. Houston on 11/22/11.(ecs) (jcj). (Entered: 11/22/2011)
11/22/2011	8	NOTICE AND ORDER for Early Neutral Evaluation Conference. Early Neutral Evaluation set for 1/17/2012 02:30 PM in the chambers of Magistrate Judge Nita L. Stormes. Signed by Magistrate Judge Nita L. Stormes on 11/22/2011.(mtb) (jcj). (Main Document 8 replaced on 11/23/2011) (mtb). (Entered: 11/22/2011)
11/22/2011	9	SUMMONS Returned Executed by SFM, LLC. Sprouts Natural Market Inc. served. (Ayers, Lindsay) (cge). (Entered: 11/22/2011)
11/23/2011	10	MOTION for Preliminary Injunction by Sprouts Natural Market Inc.. (Attachments: # 1 Memo of Points and Authorities, # 2 Declaration, # 3 Declaration, # 4 Declaration, # 5 Declaration, # 6 Declaration, # 7 Declaration, # 8 Exhibit, # 9 Exhibit, # 10 Exhibit, # 11 Exhibit, # 12 Exhibit, # 13 Exhibit, # 14 Exhibit, # 15 Exhibit)(Tyler, Robert). (jah). (Entered: 11/23/2011)
12/06/2011	11	SUMMONS Returned Executed by Sprouts Natural Market Inc.. Sprouts Farmers Market, LLC served. (Tyler, Robert) (jpp). (Entered: 12/06/2011)
12/06/2011	12	SUMMONS Returned Executed by Sprouts Natural Market Inc.. Premier Grocery, Inc. served. (Tyler, Robert) (jpp). (Entered: 12/06/2011)
12/15/2011	13	<i>Counterdefendant and Cross-Defendants'</i> ANSWER to 4 Answer to Complaint, Crossclaim, Counterclaim,, and Demand for Jury Trial by Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC.(Ayers, Lindsay) (jpp). (Entered: 12/15/2011)
12/21/2011	14	Joint MOTION for Discovery by Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC. (Attachments: # 1 Exhibit Exhibit A, # 2 Exhibit Exhibit B)(Ubell, Franklin) (jpp). (Entered: 12/21/2011)
12/23/2011	15	ORDER granting 14 Motion for Expedited Discovery. Signed by Magistrate Judge Nita L. Stormes on 12/23/11. (jpp)(jrd) (Entered: 12/23/2011)

01/06/2012	16	NOTICE by Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC <i>of Association of Counsel</i> (Ubell, Franklin)(atty contacted re wrong s/) (lmt). (Entered: 01/06/2012)
01/09/2012	17	NOTICE of Appearance by Nathan T. Mitchler on behalf of Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC (Mitchler, Nathan)(kaj). (Entered: 01/09/2012)
01/09/2012	18	Joint MOTION to Continue <i>Request to Continue the Early Neutral Evaluation Conference</i> by Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC. (Ayers, Lindsay) (lmt). (Entered: 01/09/2012)
01/09/2012	19	NOTICE of Appearance by Franklin D Ubell on behalf of Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC (Ubell, Franklin) (lmt). (Entered: 01/09/2012)
01/10/2012	20	ORDER Granting 18 Motion to Continue Early Neutral Evaluation Conference. The Early Neutral Evaluation will be held on February 1, 2012 at 2:30 p.m. in the Chambers of Magistrate Judge Nita L. Stormes. Signed by Magistrate Judge Nita L. Stormes on 1/10/12. (ecs)(jrl). (Entered: 01/10/2012)
01/10/2012	21	MOTION for Extension of Time to File Response/Reply as to 10 MOTION for Preliminary Injunction by Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC. (Mitchler, Nathan) (ag). (Entered: 01/10/2012)
01/12/2012	22	ORDER granting 21 Motion for Extension of Time to File Response/Reply re 10 MOTION for Preliminary Injunction. Responses due by 1/17/2012. Replies due by 1/24/2012. Signed by Judge John A. Houston on 1/12/12. (cge) (Entered: 01/12/2012)
01/13/2012	23	PRO HAC VICE APPOINTED: Frank G. Long appearing for Defendants Premier Grocery, Inc., Sprouts Farmers Market, LLC, Cross Defendants Premier Grocery, Inc., Sprouts Farmers Market, LLC, Counter Defendant SFM, LLC, Plaintiff SFM, LLC (All non-registered users served via U.S. Mail Service)(ldp) (Entered: 01/13/2012)
01/17/2012	24	RESPONSE in Opposition re 10 MOTION for Preliminary Injunction filed by Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC. (Attachments: # 1 Declaration of Doug Sanders ISO SFM, LLC, Sprouts Farmers Market, LLC and Premier Grocery, Inc's Opposition to SNM's Motion For Preliminary Injunction, # 2 Declaration of Shon Boney ISO SFM, LLC, Sprouts Farmers Market, LLC and Premier Grocery, Inc's Opposition to SNM's Motion For Preliminary Injunction, # 3 Declaration of Scot Wing ISO SFM, LLC, Sprouts Farmers Market, LLC and Premier Grocery, Inc's Opposition to SNM's Motion For Preliminary Injunction, # 4 Declaration of Nathan T. Mitchler ISO SFM, LLC, Sprouts Farmers Market, LLC and Premier Grocery, Inc's Opposition to SNM's Motion For Preliminary Injunction, # 5 Exhibit A through K to Declaration of Nathan T. Mitchler ISO SFM, LLC, Sprouts Farmers Market, LLC and Premier Grocery, Inc's Opposition to SNM's Motion For Preliminary Injunction, # 6 Exhibit L through O to Declaration of Nathan T. Mitchler ISO SFM, LLC, Sprouts Farmers Market, LLC and Premier Grocery, Inc's

		Opposition to SNM's Motion For Preliminary Injunction)(Mitchler, Nathan) (ag). (Entered: 01/17/2012)
01/25/2012	25	REPLY to Response to Motion re 10 MOTION for Preliminary Injunction filed by Sprouts Natural Market Inc.. (Attachments: # 1 Request for Additional Pages, # 2 Declaration, # 3 Exhibit, # 4 Exhibit, # 5 Exhibit, # 6 Declaration)(Tyler, Robert) Modified on 1/26/2012 atty contacted re: doc untimely (leh). (Entered: 01/25/2012)
01/25/2012	26	Minute Entry for proceedings held before Magistrate Judge Nita L. Stormes: Upon the Court's own motion, the Early Neutral Evaluation set for February 1, 2012 is HEREBY VACATED AND RESET for 3/8/2012 at 02:30 PM to allow the district court an opportunity to rule on the motion for a preliminary injunction.(sdh) (Entered: 01/25/2012)
01/26/2012	27	MOTION to Strike <i>Additional Pages and New Evidence or in the Alternative to Continue the Hearing, Grant Further Discovery, and Grant Filing of a Surreply</i> by Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC. (Attachments: # 1 Declaration of Nathan Mitchler in Support of Plaintiff, Counterdefendant and Cross-Defendants' Motion to Strike Additional Pages and New Evidence or in the Alternative to Continue the Hearing, Grant Further Discovery, and Grant Filing of a Surreply)(Ayers, Lindsay) (ecs). (Entered: 01/26/2012)
01/30/2012	28	RESPONSE in Opposition re 27 MOTION to Strike <i>Additional Pages and New Evidence or in the Alternative to Continue the Hearing, Grant Further Discovery, and Grant Filing of a Surreply</i> filed by Sprouts Natural Market Inc. (Attachments: # 1 Declaration)(Tyler, Robert) (knb). (Entered: 01/30/2012)
01/31/2012	29	REPLY - Other re 27 MOTION to Strike <i>Additional Pages and New Evidence or in the Alternative to Continue the Hearing, Grant Further Discovery, and Grant Filing of a Surreply</i> filed by Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC. (Mitchler, Nathan)(aef). (Entered: 01/31/2012)
02/01/2012	30	ORDER re: Defendant's Request for Additional Pages and Submission of New Evidence and Plaintiff's Motion to Strike or in the Alternative to Continue the Hearing. Defendant's request to permit additional pages and submission of new evidence is granted. Plaintiff's Motion to Strike is denied. Plaintiff's alternative request to continue the hearing and permit surreply is granted. The hearing on Defendant's Motion for a Preliminary Injunction set for 2/6/2012 is vacated. Signed by Judge John A. Houston on 1/31/2012. (All non-registered users served via U.S. Mail Service)(aef) (jcj). (Entered: 02/02/2012)
02/06/2012	31	Ex Parte MOTION for Discovery [<i>Requesting Additional, Expedited</i>] by Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC. (Mitchler, Nathan) (jpp). (Entered: 02/06/2012)
02/08/2012	32	RESPONSE in Opposition re 31 Ex Parte MOTION for Discovery [<i>Requesting Additional, Expedited</i>] filed by Sprouts Natural Market Inc.. (Attachments: # 1 Declaration)(Tyler, Robert) (jpp). (Entered: 02/08/2012)
02/09/2012	33	

		REPLY to Response to Motion re 31 Ex Parte MOTION for Discovery [<i>Requesting Additional, Expedited</i>] filed by Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC. (Mitchler, Nathan) (jpp). (Entered: 02/09/2012)
02/15/2012	34	ORDER granting 31 Motion for additional expedited discovery. Signed by Magistrate Judge Nita L. Stormes on 02/15/12. (All non-registered users served via U.S. Mail Service)(jpp) (cej). (Entered: 02/15/2012)
02/21/2012	35	ORDER rescheduling hearing date on 10 Motion for Preliminary Injunction. Motion Hearing continued to 4/9/2012 at 2:30pm in Courtroom 11 before Judge John A. Houston. Plaintiff may file a surreply of no more than 10 pages on or before 03/19/12. Signed by Judge John A. Houston on 02/21/12.(All non-registered users served via U.S. Mail Service)(jpp) (Entered: 02/21/2012)
02/23/2012	36	ORDER rescheduling hearing date on 10 Motion for Preliminary Injunction to 4/30/2012 at 2:30pm in Courtroom 11 before Judge John A. Houston. Plaintiff may file a surreply of no more than 10 pages on or before 03/28/12. Signed by Judge John A. Houston on 02/22/12.(All non-registered users served via U.S. Mail Service)(jpp) (Entered: 02/23/2012)
02/24/2012	37	DECLARATION of <i>Doug Sanders Re Expedited Discovery</i> by Cross Defendants Premier Grocery, Inc., Sprouts Farmers Market, LLC, Counter Defendant SFM, LLC, Plaintiff SFM, LLC. (Mitchler, Nathan) (jpp). (Entered: 02/24/2012)
02/24/2012	38	DECLARATION OF <i>PAUL COOK REGARDING EXPEDITED DISCOVERY</i> by Defendant Sprouts Natural Market Inc., Counter Claimant Sprouts Natural Market Inc., Cross Claimant Sprouts Natural Market Inc.. (Tyler, Robert) (jpp). (Entered: 02/24/2012)
02/27/2012	39	ORDER sua sponte continuing Early Neutral Evaluation to 3/2/2012 02:30 PM before Magistrate Judge Nita L. Stormes. Signed by Magistrate Judge Nita L. Stormes on 02/27/12.(All non-registered users served via U.S. Mail Service) (jpp) (cej). (Entered: 02/28/2012)
03/02/2012	40	AMENDED DOCUMENT by Sprouts Natural Market Inc.. Amendment to 25 Reply to Response to Motion, . (Tyler, Robert) No leave of court to file amended document (cge). (Entered: 03/02/2012)
03/28/2012	41	SUR-REPLY - re 10 MOTION for Preliminary Injunction [<i>in Opposition</i>] filed by Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC. (Attachments: # 1 Exhibit Exhibit A - Part 1, # 2 Exhibit Exhibit A - Part 2, # 3 Exhibit Exhibit A - Part 3, # 4 Exhibit Exhibit B)(Mitchler, Nathan) (jpp). (Entered: 03/28/2012)
04/13/2012	42	NOTICE by Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC of <i>Withdrawal as to Lindsay A. Ayers</i> (Ayers, Lindsay) (jpp). (Entered: 04/13/2012)
04/23/2012	43	NOTICE by Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC re 41 Sur-Reply, [<i>of Errata</i>] (Mitchler, Nathan) (jpp). (Entered: 04/23/2012)
04/24/2012	44	NOTICE by Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC [<i>of Service</i>] (Mitchler, Nathan) (jpp). (Entered: 04/24/2012)

04/26/2012	45	TRANSFER ORDER: This case is transferred from the calendar of the Honorable Nita L. Stormes, to the calendar of the Honorable Karen S. Crawford, for all further proceedings. All conference or hearing dates set before Magistrate Judge Stormes, if any, are Vacated and will be rescheduled before Magistrate Judge Crawford. Any dates set before the district judge remain unchanged. The new case number is 11cv2640-JAH(KSC). Signed by Magistrate Judge Nita L. Stormes on 4/20/12.(All non-registered users served via U.S. Mail Service)(ecs) (Entered: 04/26/2012)
04/30/2012	46	Minute Entry for proceedings held before Judge John A. Houston: Motion Hearing held on 4/30/2012 re 10 MOTION for Preliminary Injunction filed by Sprouts Natural Market Inc. Plaintiff's supplemental briefs due by 5/10/12; defendant's briefs due by 5/16/12.(Court Reporter Cameron Kircher).(Plaintiff Attorney Frank G. Long, Nathan T. Mitchler). (Defendant Attorney Robert Tyler, Jordan Borsch). (lwm) (Entered: 05/03/2012)
05/10/2012	47	SUPPLEMENTAL BRIEFING by Defendants Premier Grocery, Inc., Sprouts Farmers Market, LLC, Cross Defendants Premier Grocery, Inc., Sprouts Farmers Market, LLC, Counter Defendant SFM, LLC, Plaintiff SFM, LLC. (Mitchler, Nathan) (jpp). (Entered: 05/10/2012)
05/16/2012	48	SUPPLEMENTAL BRIEFING by Defendant Sprouts Natural Market Inc., Counter Claimant Sprouts Natural Market Inc., Cross Claimant Sprouts Natural Market Inc. re 10 MOTION for Preliminary Injunction . (Tyler, Robert) (jpp). (Entered: 05/16/2012)
05/17/2012	49	MOTION for Leave to File <i>Declaration of Lawrence A. Maxham</i> by Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC. (Attachments: # 1 Exhibit 1)(Mitchler, Nathan) (jpp). (Entered: 05/17/2012)
05/21/2012	50	RESPONSE in Opposition re 49 MOTION for Leave to File <i>Declaration of Lawrence A. Maxham</i> filed by Sprouts Natural Market Inc.. (Tyler, Robert) (jpp). (Entered: 05/21/2012)
05/30/2012	51	ORDER: The parties shall contact Judge Crawford's chambers to set a date for an Early Neutral Evaluation ("ENE") within three court days of a ruling by Judge Houston on the Motion for Preliminary Injunction. Should the parties feel that an ENE would be beneficial at an earlier time they may contact chambers at (619) 446-3964 to inquire about available dates for a joint or ex parte motion to set an ENE. Signed by Magistrate Judge Karen S. Crawford on 5/30/12.(sdh) (Entered: 05/30/2012)
09/27/2012	52	ORDER Granting In Part 10 Defendant's/Counterclaimant's Motion for Preliminary Injunction. Defendant shall post a bond in the amount of \$500,000 with the Clerk of Court pursuant to Federal Rule of Civil Procedure 65(c) no later than October 8, 2012. Signed by Judge John A. Houston on 09/26/12. (cc: Financial). (All non-registered users served via U.S. Mail Service)(jpp)(jrd) (Entered: 09/27/2012)
09/28/2012	53	NOTICE of Appearance by Joseph R.R. Tache on behalf of SFM, LLC (Tache, Joseph) (jpp). (Entered: 09/28/2012)
10/01/2012	54	

		Joint MOTION to Stay re 52 Order on Motion for Leave to File, Order on Motion for Preliminary Injunction,, by Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC. (Mitchler, Nathan) (jpp). Modified on 10/2/2012 to term, revised joint motion filed see 55 (jpp). (Entered: 10/01/2012)
10/01/2012	55	Joint MOTION to Stay re 52 Order on Motion for Preliminary Injunction,, by Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC. (Mitchler, Nathan) (jpp). (Entered: 10/01/2012)
10/02/2012	56	ORDER granting 55 revised Joint Motion to stay the order granting in part Defendant's/Counterclaimant's motion for a preliminary injunction. The Defendant shall post a bond in the amount of \$500,000 with the Clerk of the Court pursuant to Federal Rule of Civil Procedure 65(c) no later than October 12, 2012. (cc: financial). Signed by Judge John A. Houston on 10/02/12. (jpp) (jcj). (Entered: 10/02/2012)
10/03/2012	57	A ruling having been issued on the Motion for Preliminary Injunction, the Court HEREBY RESETS the Early Neutral Evaluation for 11/5/2012 at 02:30 PM before Magistrate Judge Karen S. Crawford at 101 W. Broadway, Suite 1100, San Diego, CA 92101. The parties shall read and comply with Judge Crawford's Chambers' Rules which are posted on the Court's website. Confidential settlement briefs shall be lodged in chambers by the parties no later than 10/29/12. Signed by Magistrate Judge Karen S. Crawford on 10/3/12.(no document attached) (sdh) (Entered: 10/03/2012)
10/11/2012	58	Joint MOTION to Stay re 56 Order on Motion to Stay, by Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC. (Tache, Joseph) (jpp). (Entered: 10/11/2012)
10/18/2012	59	Joint MOTION to Dismiss <i>with Prejudice; Stipulation</i> by Premier Grocery, Inc., SFM, LLC, Sprouts Farmers Market, LLC. (Tache, Joseph)(jpp). (Entered: 10/18/2012)
10/22/2012	60	ORDER granting 59 Joint Motion for dismissal with prejudice of this action and all claims, counterclaims, and cross-claims. Signed by Judge John A. Houston on 10/19/12. (jpp) (Entered: 10/22/2012)

PACER Service Center			
Transaction Receipt			
05/21/2015 11:26:34			
PACER Login:	qb0005:2618591:0	Client Code:	146845.00092
Description:	Docket Report	Search Criteria:	3:11-cv-02640-JAH-KSC
Billable Pages:	8	Cost:	0.80

EXHIBIT D

2004 WL 1701274 (Trademark Tr. & App. Bd.)

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

THE STURGIS AREA CHAMBER OF COMMERCE

v.

STURGIS BIKE WEEK, INC.

Opposition Nos. 91152141; 91152896; 91154893

July 13, 2004

*1 Before Hanak, [Walters](#) and Bottorff
Administrative Trademark Judges

By the Board:

Sturgis Bike Week, Inc. (“applicant”) seeks to register the mark STURGIS BIKE WEEK in typed form in seven applications covering a variety of goods.¹

The Sturgis Area Chamber of Commerce (“opposer”) has opposed registration of applicant's mark on the grounds that the mark falsely suggests a connection with opposer under Trademark Act Section 2(a), [15 U.S.C. Section 1052\(a\)](#), and likelihood of confusion with opposer's previously used and registered mark BLACK HILLS MOTOR CLASSIC STURGIS RALLY & RACES BLACK HILLS S.D. and design in the following form



for “promoting sports competitions and/or events of others, namely motorcycle rallies, exhibits and competitions; and promoting economic development in the city of Sturgis and the Black Hills area of South Dakota and Wyoming” in International Class 35,² as well as its common law rights in the mark STURGIS RALLY AND RACES as used in connection with an annual “series of races, rallies, and other motorcycle-related exhibits, promotions, competitions, concerts and other related activities.” Applicant denied the salient allegations of the notices of opposition in its answers and asserted affirmative defenses. The Board consolidated the three proceedings in a May 14, 2003 order.

This case now comes up for consideration of (1) opposer's motion (filed August 18, 2003) for summary judgment on its Section 2(a) and Section 2(d) grounds; (2) applicant's former attorney's motion (filed September 22, 2003 by certificate of mailing) to withdraw from this proceeding; (3) applicant's motion (filed September 22, 2003 by certificate of mailing) to extend time to respond to the motion for summary judgment to October 22, 2003; (4) applicant's motion (filed October 22, 2003 by certificate of mailing) to extend time to respond to the motion for summary judgment to November 22, 2003; (5) applicant's motion (filed November 22, 2003) to extend time to respond to opposer's motion for summary judgment to December 15, 2003; (6) opposer's alternative motion (filed January 5, 2004 by certificate of mailing) to strike applicant's brief in response to the motion for summary judgment or to consider opposer's reply brief.

Turning first to applicant's former attorney's motion to withdraw from this proceeding, the Board notes that applicant's new attorneys filed an entry of appearance herein concurrently with applicant's motion to extend time to respond to the motion for summary judgment to October 22, 2003. Accordingly, applicant's former attorney's request to withdraw is moot.

*2 Turning to applicant's motion to extend time to respond to the motion for summary judgment to October 22, 2003, opposer filed a paper in response thereto wherein it provided its consent to the extension sought. In view thereof, applicant's first motion to extend time to respond to the motion for summary judgment to October 22, 2003 is hereby granted.

Turning next to applicant's motion to extend time to respond to the motion for summary judgment to November 22, 2003, that motion is hereby granted as conceded. See [Trademark Rule 2.127\(a\)](#).

Turning next to applicant's motion to extend time to respond to the motion for summary judgment to December 15, 2003, applicant contends that it needs further additional time so that its new attorneys can become familiar with the records in these consolidated oppositions and earlier litigation between the parties prior to responding to the motion for summary judgment. In addition, applicant contends that its lead attorney was out of the office between November 8 and 22, 2003 because of the death of a parent.

In opposition thereto, opposer contends that the Board should deny applicant's motion to extend time to respond the motion for summary judgment to December 15, 2003 because of applicant's lack of diligence prior to the death of its lead attorney's parent; and that opposer will be prejudiced by the extension sought because its unextendable time to file a reply brief would fall during the Christmas holidays.

The standard for allowing an extension of a prescribed period prior to the expiration of that period is "good cause." See Fed. R. Cir. P. 6(b) and TBMP section 509. The Board is generally liberal in granting extensions before the period to act has lapsed, so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused. See, e.g., [American Vitamin Products, Inc. v. DowBrands Inc.](#), 22 USPQ2d 1313 (TTAB 1992). The Board finds that circumstances surrounding the death of a parent of applicant's lead attorney constitute good cause for the extension sought.

In view thereof, applicant's motion to extend time to respond to the motion for summary judgment to December 15, 2003 is hereby granted. The brief in opposition to the motion for summary judgment that applicant filed by certificate of mailing on December 15, 2003 is deemed timely filed, and opposer's motion to strike applicant's brief in opposition to the motion for summary judgment is therefore denied.³

We now turn to opposer's motion for summary judgment. Opposer seeks entry of summary judgment on its Section 2(a) and 2(d) grounds and relies primarily on the doctrine of issue preclusion as a result of determinations made by the United States District Court for the District of South Dakota in a May 25, 2000 preliminary injunction decision that was issued in a civil action between the parties. Opposer also relies on applicant's statements made in *ex parte* prosecution of its involved application Serial Nos. 76012802, 76012841, and 76012877 that its goods relate to and are sold at the annual motorcycle rally in Sturgis, South Dakota, which is or has been known officially as Sturgis Rally & Races, Black Hills Motorcycle Rally, and Black Hills Motor Classic and is known unofficially as Sturgis Bike Week.⁴

*3 We note initially that opposer did not plead in its notices of opposition that the preliminary injunction decision precludes applicant from seeking to register the STURGIS BIKE WEEK mark for the goods identified in its applications. However, the parties have briefed the question of issue preclusion on the merits, and applicant has not objected to the motion for summary judgment on the ground that it is based on an unpleaded issue. Accordingly, the Board deems the pleadings to have been amended, by agreement of the parties, to allege the matter. See *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994); TBMP Section 528.07(a).

With regard to opposer's reliance upon the preliminary injunction decision as a basis for its motion for summary judgment on its Section 2(d) claim, we find that disposition of this proceeding by summary judgment is inappropriate. The doctrine of issue preclusion (also sometimes known as "collateral estoppel"), which serves to bar the revisiting of "issues" that have been already fully litigated, requires four factors: (1) that the issues in a prior proceeding be identical to those in the proceeding at issue; (2) that those issues were actually litigated; (3) that the determination of the issues was necessary to the resulting judgment; and, (4) that the party defending against preclusion had a full and fair opportunity to litigate the issues. See *Montana v. United States*, 440 U.S. 147, 153-55 (1979); *Jet Inc. v. Sewage Aeration Systems*, 55 USPQ2d 1854, 1859 (Fed. Cir. 2000). The Board notes that, subsequent to the preliminary injunction decision, the parties in the civil action entered into a co-existence agreement, settlement agreement and release wherein opposer released applicant from all claims in the civil action and which led to dismissal with prejudice of the civil action and a permanent injunction that did not enjoin applicant from using the STURGIS BIKE WEEK mark in connection with the goods identified in its involved applications. As such, we find that, at a minimum, there exists a genuine issue of material fact as to whether the finding in the preliminary injunction decision that use of applicant's mark in connection with goods and services other than T-shirts and caps is likely to cause confusion with opposer's marks was necessary to the resulting final judgment in the civil action.⁵

Further, notwithstanding applicant's admissions that its goods relate to and are sold at the annual motorcycle rally in Sturgis, South Dakota, we note that applicant has alleged that third parties own or have applied for registrations for marks containing STURGIS for goods and services connected with the annual motorcycle rally and has submitted a copy obtained from the USPTO's Trademark Electronic Search System of its Registration No. 2070955 for the mark STURGIS BIKE WEEK for "clothing, namely T-shirts and caps." We find that these allegations and registration are sufficient to preclude entry of summary judgment on opposer's Section 2(d) claim. There are, at minimum, genuine issues of material fact as to the similarity or dissimilarity of the overall commercial impressions of the marks at issue, the strength of opposer's pleaded marks, and as to the scope of protection to which opposer's pleaded marks are entitled.

*4 With regard to opposer's claim that applicant's mark falsely suggests a connection with it, opposer must demonstrate (i) that applicant's is the same or a close approximation of opposer's previously used name or identity; (ii) that applicant's mark would be recognized as such; (iii) that opposer is not connected with the activities performed by applicant under applicant's mark; and (iv) that opposer's name or identity is of sufficient fame or reputation that when applicant's mark is used on its goods or services, a connection with the plaintiff would be presumed. See *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985). The critical requirement, under this concept of the protection of one's identity, is that the name (or an equivalent thereof) points uniquely and unmistakably to a particular personality or persona. See *McDonnell Douglas Corporation v. National Data Corporation*, 228 USPQ 45 (TTAB 1985). Notwithstanding applicant's admissions that its goods relate to and are sold at the annual motorcycle rally in Sturgis, South Dakota, we find that the allegations and registration discussed in the foregoing are sufficient to preclude entry of summary judgment on opposer's Section 2(a) claim. At minimum, there exist genuine issues of material fact as to whether opposer's name or identity is STURGIS BIKE WEEK, as to whether STURGIS BIKE WEEK points uniquely and unmistakably to opposer,⁶ and as to whether STURGIS BIKE WEEK is of sufficient fame or reputation that when it is used on the goods at issue, a connection with opposer would be presumed.

In view thereof, opposer's motion for summary judgment is hereby denied. Proceedings herein are resumed. Discovery and trial dates are hereby reset as follows.

DISCOVERY PERIOD TO CLOSE:	7/30/04
Plaintiff's thirty-day testimony period to close:	10/28/04
Defendant's thirty-day testimony period to close:	12/27/04
Plaintiff's fifteen-day rebuttal period to close	2/10/05

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 Rule 2.128\(a\)](#) and [\(b\)](#). An oral hearing will be set only upon request filed as provided by [Trademark Rule 2.129](#).

Footnotes

- Opposition No. 91152141 involves the following applications: Application Serial No. 76012802, filed March 29, 2000, for “jewelry, including watches” in International Class 14, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), [15 U.S.C. Section 1051\(b\)](#). The application includes a disclaimer of any exclusive right to use STURGIS apart from the mark as shown.

Application Serial No. 76012877, filed March 29, 2000, for “embroidered goods, namely, patches and emblems” in International Class 26, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), [15 U.S.C. Section 1051\(b\)](#). The application includes a disclaimer of any exclusive right to use STURGIS apart from the mark as shown.

Opposition No. 91152896 involves the following applications:

Application Serial No. 76012800, filed March 29, 2000, for “smokers' articles, namely, cigarettes, cigarette lighters not of precious metal, cigarette cases not of precious metal, ash trays and matches” in International Class 34, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), [15 U.S.C. Section 1051\(b\)](#). The application includes a disclaimer of any exclusive right to use STURGIS apart from the mark as shown.

Application Serial No. 76012878, filed March 29, 2000, for “toys and sporting goods, namely, soccer balls, stuffed toy animals and golf balls, and Christmas tree ornaments and decorations” in International Class 28, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), [15 U.S.C. Section 1051\(b\)](#).

Opposition No. 91154893 involves the following applications:

Application Serial No. 76012840, filed March 29, 2000, for “paper goods, namely, stationery, postcards, table mats and napkins; and printed publications, namely, pamphlets, brochures and magazines relating to an annual motorcycle event” in International Class 16, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), [15 U.S.C. Section 1051\(b\)](#). The application includes a disclaimer of any exclusive right to use BIKE apart from the mark as shown.

Application Serial No. 76012841, filed March 29, 2000, for “clothing, namely, shirts, sweaters, sweatshirts, scarves, bandanas, and aprons, and embroidered clothing, namely, shirts, sweaters, sweatshirts, scarves, bandanas, and aprons” in International Class 25, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), [15 U.S.C. Section 1051\(b\)](#). The application includes a disclaimer of any exclusive right to use STURGIS apart from the mark as shown.

Application Serial No. 76012893, filed March 29, 2000, for “giftwares and housewares, namely, beverageware glasses, drinking glasses, mugs, shot glasses, and beer steins” in International Class 21, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), [15 U.S.C. Section 1051\(b\)](#).

Applicant is also the record owner of Registration No. 2070955 for the mark STURGIS BIKE WEEK in typed form for “clothing, namely t-shirts and caps” in International Class 25, issued June 17, 1997, Section 8 affidavit accepted, Section 15 affidavit acknowledged. Applicant included a copy of this registration obtained from the USPTO'S Trademark Electronic Search System as an exhibit to its brief in opposition to the motion for summary judgment.
- Registration No. 1948097, issued January 16, 1996, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The registration includes a disclaimer of any exclusive right to use MOTOR CLASSIC or RALLY & RACES BLACK HILLS S.D. apart from the mark as shown, and a claim of acquired distinctiveness under Trademark Act Section 2(f), [15 U.S.C. Section 1052\(f\)](#), with regard to the words BLACK HILLS MOTOR CLASSIC.

- 3 However, because opposer's reply brief clarifies the issues before the Board, we have, in our discretion, elected to consider it. See [Trademark Rule 2.127\(a\)](#).
- 4 The civil action is styled *The Sturgis Area Chamber of Commerce and The City of Sturgis, South Dakota v. Sturgis Rally & Races, Inc. and Sturgis Bike Week, Inc.*, Case No. 00-5023, filed in the United States District Court for the District of South Dakota. In the civil action, plaintiffs brought claims of infringement under Trademark Act Sections 32(1) and 43(a), [15 U.S.C. Sections 1114\(1\) and 1125\(a\)](#), dilution under Trademark Act Section 43(c), [15 U.S.C. Section 1125\(c\)](#), and unlawful cybersquatting under Trademark Act Section 43(d), [15 U.S.C. Section 1125\(d\)](#), as well as claims based on state law.
- In the civil action, the district court issued a preliminary injunction decision on May 25, 2000, wherein it stated, in relevant part, that “evidence indicates that[,] to the relevant public, Bike Week is synonymous with Rally & Races” and found that “[d]efendants’ continued use of the Sturgis Bike Week logo and mark for anything other than sale of t-shirts and caps is likely to cause confusion in the marketplace.” Preliminary injunction decision at 14 and 25. Accordingly, the district court granted plaintiffs’ motion for preliminary injunction and enjoined defendants, pending final determination of the civil action, from, among other things, “[u]sing ‘Sturgis Bike Week’ in conjunction with any services or goods other than t-shirts and caps”. See preliminary injunction decision at 26.
- The parties reached a settlement of the civil action, which was dismissed without prejudice on April 4, 2001, subject to the parties’ right to reopen if a settlement was not consummated. In September 2001, the parties executed a co-existence agreement, settlement agreement and release, wherein the parties, among other things, agreed to release one another from “any and all existing and future claims” in the civil action and agreed that a permanent injunction and consent judgment in which plaintiffs agreed to cause the civil action to be voluntarily dismissed with prejudice shall be entered in the civil action. The permanent injunction did not enjoin applicant from using the STURGIS BIKE WEEK mark in connection with the goods identified in its involved applications. Upon consummation of the settlement, the district court dismissed the civil action with prejudice on December 14, 2001.
- 5 We further note that prior decisions on motions for preliminary injunction generally not given preclusive effect, in part due to the tentative nature of such decisions. See [18 Wright, Miller & Cooper, Federal Practice and Procedure, Section 4445 at 393-96 \(1981\)](#).
- 6 We note that The City of Sturgis, South Dakota was co-plaintiff in the civil action.

2004 WL 1701274 (Trademark Tr. & App. Bd.)

2013 WL 6046663 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

SOFTWARE DEVELOPMENT SOLUTIONS, INC.

v.

AIRCAST MOBILE, INC.

Cancellation No. 92055910

October 30, 2013

*1 Before [Bucher](#), [Ritchie](#) and Adlin
Administrative Trademark Judges

By the Board:

This case now comes up on petitioner's motion to strike respondent's affirmative defenses and its motion for summary judgment, both filed on June 14, 2013. Respondent opposes the motions.

Background

Petitioner has filed a petition for cancellation of respondent's Registration No. 4138501 for the mark JAMCAST, in standard characters, for "Computer application software for mobile phones, namely, software for recording, streaming, distributing, and listening to music and live concerts." ¹ In its petition for cancellation, petitioner pleads prior common law use and a later-filed trademark application for the mark JAMCAST for "Computer application software for electronic devices, namely, software for sending and receiving music, pictures and video across a computer network." ² As grounds for cancellation, petitioner alleges that respondent's mark is likely to cause confusion with petitioner's previously-used pleaded mark pursuant to Trademark Act Section 2(d), [15 U.S.C. Section 1052\(d\)](#). In its answer, respondent denies the salient allegations in the petition for cancellation and asserts eight "affirmative defenses," a number of which are merely amplifications of respondent's denials, namely: (1) failure to state a claim upon which relief may be granted; (2) estoppel, waiver and acquiescence; (3) laches; (4) that respondent's involved mark is inherently distinctive; (5) that petitioner's mark is not famous; (6) that respondent adopted the involved mark in good faith; (7) that petitioner does not have priority in the mark JAMCAST; and (8) that respondent "reserves its right to add, amend or withdraw its affirmative defenses." Answer, ¶¶ 7-14.

Motion to Strike

A motion to strike should be filed within 21 days of service of an answer upon a party. *See* [Fed. R. Civ. P. 12\(f\)](#); *See also* TBMP § 506.02 (3d ed. rev.2 2013). As respondent argues, petitioner's motion to strike is untimely because it was filed more than nine months after respondent filed its answer to the petition for cancellation. Accordingly, petitioner's motion to strike will be given no consideration.

Motion for Summary Judgment

The Parties' Arguments

Petitioner argues that its “open and notorious use of the JAMCAST mark since 2006” constitutes “use analogous to trademark use” and that this analogous use predates both the filing date of respondent's involved registration and respondent's claimed first use date of January 1, 2011. Motion for Summary Judgment, p. 5-7. Petitioner further argues that consumer confusion is inevitable because the parties' marks are identical, the parties' goods are “highly-related, if not identical,” and the parties' trade channels are the same. Motion for Summary Judgment, pp. 7-11.

*2 In support of its motion, petitioner has submitted an affidavit from its Chief Executive Officer, Scott Streaker (the “Streaker Affidavit”), stating that (i) petitioner “first used the mark JAMCAST anywhere, at least as early as June 11, 2006 and first used the JAMCAST mark in commerce at least as early as March 27, 2010,” *id.* at ¶ 5; (ii) “[b]eginning in 2010, and continuously since then, the nonbeta version of the JAMCAST media software solution that enables consumers to effortlessly send digital audio from a specific source to a specific device has been available for purchase and download to the public,” *id.* at ¶ 4; and (iii) “[b]y January 1, 2011, the JAMCAST product had been downloaded over 48,000 times by more than 23,000 users and the numbers ballooned to over 106,000 downloads by over 60,000 users by the end of 2012,” *id.* at ¶ 6. In addition, petitioner has submitted two press releases from thirdparty websites,³ dated June 29, 2010, showing full and partial screen shots of petitioner's software product bearing the JAMCAST mark and a March 27, 2010 blog entry from getjamcast.com/Blog/post/Stream-Jamcast-To-YouriPhone.aspx showing the JAMCAST mark displayed on two mobile phone devices. Petitioner has also submitted excerpts from the discovery deposition of respondent's chief executive officer, Michael Linhardt (the “Linhardt Deposition”),⁴ testifying that (i) respondent first used the JAMCAST mark on January 1, 2011, Linhardt Deposition, p. 34; (ii) he believes there “could be” confusion between the parties' marks, *id.* at p. 62; and (iii) he would change his response to petitioner's Request for Admission No. 20 to admit that “[r]egistrant's mark is confusingly similar to [p]etitioner's mark.” *Id.* at pp. 66-67.

In opposition to the motion, respondent argues that petitioner does not have standing to bring the petition for cancellation. Specifically, respondent contends that petitioner cannot claim “present or future damage” because its pleaded application has been abandoned⁵ and petitioner “asserts growth in users” of its product. Summary Judgment Response, pp. 7-8.

Respondent further “disputes the priority of use claimed by [petitioner]” arguing that press releases “do not meet the criteria for evidence of prior use” because they are advertising “and not acceptable for specimens of use on goods in commerce” and they do not demonstrate use “analogous to trademark use.” *Id.* at p. 4. Respondent also relies on purported discrepancies between petitioner's summary judgment evidence and its discovery responses to argue that petitioner's first use in commerce of the JAMCAST mark “has not been confirmed.” *Id.* at pp. 1-2.

*3 With respect to likelihood of confusion, respondent concedes that the parties' marks have “the same spelling,” but argues that it conducted a “search of trademarks and did not find any alleged mark of [petitioner].” *Id.* at p. 6 and Linhardt Deposition, pp. 10-11. Respondent also argues that petitioner's “announcement of its UPnP compliant network audio server for Windows code named ‘JAMCAST’” and its claims of “public exposure [of the JAMCAST product] on or after 2010 ... appear contrary to Interrogatory No. 13, to which petitioner responded “that it used the JAMCAST mark on its Jamcast Server (Beta) at least as early as June 11, 2006” Response to Summary Judgment, p. 6 and Exhibit 1, p. 10. Lastly, respondent argues that any doubt regarding a likelihood of confusion should be resolved in its favor as registrant. *See id.* at pp. 5 and 7.

Summary Judgment Standard

Summary judgment is only appropriate where there are no genuine disputes as to any material facts, thus allowing the case to be resolved as a matter of law. *Fed. R. Civ. P. 56(a)*. The party seeking summary judgment bears the burden of demonstrating the absence of any genuine dispute of material fact, and that it is entitled to judgment under the applicable law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). 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).

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 (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.

Evidentiary Issue

As an initial matter, both parties submitted documents that they purportedly produced to one another during discovery. However, neither party submitted the corresponding document requests as required by [Trademark Rule 2.127\(e\)\(2\)](#), and as such, we have considered these documents only to the extent that they have been authenticated or comply with Board rules. Many of the produced documents are website printouts, which we have considered to the extent that they identify either their dates of publication or the dates they were accessed and printed, and their URL address.⁶ See *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010); TBMP § 528.05(e). We hasten to add, however, that even if we had considered unauthenticated documents or those not submitted in compliance with Board rules, it would not change our decision herein.

Standing and Priority

*4 There are no genuine disputes as to any material fact regarding petitioner's standing, which is established by its common law rights in the JAMCAST mark for software for sending digital audio content, as discussed more fully below.⁷ Respondent's erroneous assertion that petitioner has abandoned its pleaded application, even if true, would not change this conclusion, as standing may be established based solely on common law rights in a mark, as petitioner has established here. See *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (standing established by a showing of common law rights); *Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Ltd.*, 86 USPQ2d 1283, 1285 (TTAB 2008) (prior use ...); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1106 (TTAB 2007) (prior use ...). Respondent's arguments notwithstanding, "there is no requirement that actual damage be pleaded and proved" to establish standing and prevail in a cancellation action. TBMP § 309.03(b) and cases cited in footnote 6 therein.

For petitioner to prevail on its claim of likelihood of confusion based on common law rights in the JAMCAST mark, "the mark must be distinctive, inherently or otherwise, and [petitioner] must show priority of use." *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1634 (TTAB 2007) (citing *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981)). Respondent has not raised any issue regarding the distinctiveness of the mark JAMCAST in its response to petitioner's motion for summary judgment or in its answer to the petition for cancellation. In fact, in its answer, respondent maintains that its identical mark JAMCAST "is inherently distinctive." Answer, Fourth Affirmative Defense, ¶ 10. Accordingly, and because there is no evidence that JAMCAST is merely descriptive or generic, we find that there are no genuine disputes of material fact regarding the distinctiveness of the JAMCAST mark, which is inherently distinctive.

Upon careful consideration of all of the admissible evidence, we also find that there are no genuine disputes of material fact regarding petitioner's priority in the JAMCAST mark. We need not consider whether petitioner has established use of the JAMCAST mark analogous to trademark use⁸ because the evidence of record, consisting of the Streaker Affidavit and website printouts of March 27, 2010 and June 29, 2010, is sufficient to establish petitioner's prior and continuous use in commerce of the mark JAMCAST since 2010 for software for sending digital audio content.⁹ Respondent did not submit any evidence or even attempt to argue that it commenced use of the JAMCAST mark prior to this date, and its constructive first use date of September 7, 2011 is after petitioner commenced use of its JAMCAST mark in commerce.¹⁰ Moreover, we find that the alleged discrepancies between petitioner's summary judgment evidence and discovery responses do not create any genuine disputes of material fact regarding petitioner's prior use in commerce of the JAMCAST mark.¹¹ In fact, the evidence is consistent that petitioner used the mark JAMCAST before respondent's filing date, which is the earliest date upon which respondent may rely. See 15 USC § 1057(c); see also *Larami Corp. v. Talk to Me Programs, Inc.*, 36 USPQ2d 1840 (TTAB 1995).

Likelihood of Confusion

*5 “We determine likelihood of confusion by focusing on ... whether the purchasing public would mistakenly assume that the [respondent's] goods originate from the same source as, or are associated with,” petitioner's goods. *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In considering the question on a motion for summary judgment, we analyze all probative facts in evidence which are relevant to the thirteen likelihood of confusion factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), as well as whether there are genuine disputes as to any of these factors which would be material to a decision on the merits. In this case, the parties have introduced evidence concerning the similarities of the marks, goods, and trade channels, and respondent's intent in adopting the JAMCAST mark.

We turn first to the similarity of the marks. The involved registration is for the mark JAMCAST in standard characters, meaning that the mark is not limited to any specific form of display. Accordingly, the Board must assume that respondent's mark could be displayed in the same style as petitioner's mark. See *In re RSI Systems LLC*, 88 USPQ2d 1445, 1448 (TTAB 2008). For this reason, there is no genuine dispute of material fact that the parties' marks are essentially identical. This factor weighs heavily in favor of a finding of likelihood of confusion. See *Kohler*, 82 USPQ2d at 1106; *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001).

With respect to the similarity of the parties' goods, we must compare the goods identified in the involved registration to those petitioner offers under its mark. *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). Here, respondent has registered the mark JAMCAST for “Computer application software for mobile phones, namely, software for recording, streaming, distributing, and listening to music and live concerts” and petitioner has proven use of its mark for software that enables users to send digital audio content from a specific source to a specific device, including mobile phones. Therefore, we find that there is no genuine dispute of material fact that the parties' goods are highly similar, and as such, this fact also weighs heavily in favor of a finding of likelihood of confusion.

There also is no genuine dispute of material fact regarding the channels of trade for the parties' goods or the classes of consumers. Where, as here, “there is no limitation on the channels of trade” in the identification in the involved registration, it is presumed that respondent's goods move in all normal channels of trade for the goods. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) (“Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identification [] of [the involved registration as] to trade channels and purchasers,” the parties' goods “could be offered and sold to the same classes of purchasers through the same channels of trade”); See also, e.g., *Octocom Systems, Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *Venture Out Properties LLC v. Wynn Resorts Holdings, LLC*, 81 USPQ2d 1887, 1893 (TTAB 2007). Furthermore, even if we construed the words “for mobile phones,” “recording,” “streaming,” “distributing,” and “listening” in the involved registration as limitations on respondent's channels of trade, petitioner's evidence establishes that petitioner's channels of trade include mobile phones and the distribution of audio content.

*6 In addition, while there is no evidence that respondent adopted the JAMCAST mark in bad faith, respondent's apparent good faith does not create a genuine dispute of material fact regarding a likelihood of confusion between the parties' marks, because respondent's apparent good faith is easily outweighed by the similarity of the marks, goods and channels of trade.¹² See *Lebanon Seaboard Corp. v. R&R Turf Supply, Inc.*, 101 USPQ2d 1826, 1834 (TTAB 2012) (“Good faith adoption of a mark will not prevent a finding of likelihood of confusion.”); see also *Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1713 (TTAB 2010) (that defendant adopted its mark in good faith “does very little to obviate a finding of a likelihood of confusion because it is expected that [defendant] is acting in good faith.”) *aff'd mem.*, No. 2011-1052, 2011 WL 5400095 (Fed. Cir. 2011).

Lastly, in its response to petitioner's motion, respondent has not asserted, much less established, any of the affirmative defenses raised in its answer to the petition for cancellation. Accordingly, such defenses, to the extent they are viable affirmative defenses,

are deemed waived.¹³ See *Miller v. Miller*, 105 USPQ2d 1615, 1616 n.3 (TTAB 2013); *Baroness Small Estates Inc. v. American Wine Trade Inc.*, 104 USPQ2d 1224, 1225 n.2 (TTAB 2012).

Conclusion

Based on the record herein and the applicable law, we find that there are no genuine disputes as to any material facts and that petitioner has established its standing and priority and likelihood of confusion as a matter of law. Moreover, respondent has waived its affirmative defenses. Accordingly, petitioner's motion for summary judgment is hereby **GRANTED**. Judgment is hereby entered against respondent, the petition to cancel is granted, and Registration No. 4138501 will be cancelled in due course.

Footnotes

- 1 Registration No. 4138501, issued on May 8, 2012, from an application filed on September 7, 2011 and claiming first use anywhere on January 1, 2011 and first use in commerce on August 19, 2011.
- 2 Filed on July 17, 2012, based on a claim of first use anywhere on June 11, 2006 and first use in commerce on March 27, 2010.
- 3 "eHomeUpgrade.com" and "WeGotServed.com."
- 4 Neither party submitted pages from the Linhardt Deposition that reflect Mr. Linhardt's title, but he signed the underlying application, which is automatically of record in this case, as respondent's chief executive officer.
- 5 Petitioner's application is in fact suspended, not abandoned.
- 6 However, we have not considered pages from foreign websites as use outside the United States is not relevant to this proceeding, which concerns only registration of the JAMCAST mark in the United States.
- 7 In its petition to cancel, petitioner expressly alleged damage based on "confusion in the marketplace" as well as respondent's registration "preventing [p]etitioner's [m]ark from being registered." Petition for Cancellation, ¶ 4.
- 8 "[A] party may establish priority in a proceeding based on 'analogous use,' *i.e.*, any non-technical use of a mark which is sufficient to create in the mind of the relevant public an association between the goods and their source. Thus, even before proper trademark use commences, advertising or similar pre-sale activities may establish priority if they create the necessary association in the mind of the consumer." *Central Garden & Pet Company v. Dorskocil Manufacturing Company, Inc.*, 108 USPQ2d 1134, 1142 (TTAB 2013) (internal citation omitted).
- 9 To be clear, we do not conclude that the press releases themselves demonstrate petitioner's use of the JAMCAST mark. Instead, we have considered the press releases for what they show on their face, namely, recognition of petitioner's actual use of the JAMCAST mark on computer software, including software for mobile phones. This evidence sufficiently corroborates the Streaker Affidavit.
- 10 Respondent submitted evidence that its Google and domain name searches for the mark JAMCAST in early 2011 did not yield any results. However, there is no requirement that a party's mark be discoverable by particular search engines or similar to registered domain names. Accordingly, this evidence is not sufficient to rebut petitioner's evidence establishing its use of the JAMCAST mark as early as 2010.
- 11 The fact that petitioner indicated that it had no documents responsive to respondent's Document Request No. 8 does not disprove that petitioner commenced use of its mark before respondent's filing date. Document Request No. 8 sought documents in a specific format, namely, documents referring or relating "to the amount of sales (actual and/or projected) by calendar quarter of goods and/or services sold by or for [petitioner] using JAMCAST from 2006 to the present." It is conceivable that petitioner does not keep records of sales by calendar quarter. Moreover, sales are not necessarily required to establish use in commerce. See 15 U.S.C. § 1127.
- 12 Respondent also argues that the trademark examining attorney did not uncover petitioner's common law use of the JAMCAST mark when he/she examined respondent's underlying application. However, "[r]efusal [of a trademark application] on the basis of an unregistered mark ... is not applied in *ex parte* examination because of the practical difficulties with which an examining attorney is faced in locating 'previously used' marks, and determining whether anyone has rights in them and whether they are 'not abandoned.'" TMEP § 1207.03 (April 2013).
- 13 "Affirmative defenses" 4-7 are not proper affirmative defenses, but mere amplifications of respondent's denials. Similarly, "affirmative defense" 8 merely paraphrases Fed. R. Civ. P. 15, and does not include any affirmative defense. To the extent that respondent may have attempted to argue acquiescence by asserting that it "has expanded its presence with the public," Response, p.

7, it has not argued or submitted any evidence that petitioner affirmatively acted in a way that led respondent to reasonably believe that petitioner would not assert its rights in the JAMCAST mark against respondent, which is required to prove the defense of acquiescence. See *CBS, Inc. v. Man's Day Publishing Company, Inc.*, 205 USPQ 470, 473-474 (TTAB 1980) (to establish the defense of acquiescence a defendant must prove that the plaintiff's conduct amounted to "an assurance by the plaintiff to the defendant, either express or implied that the plaintiff will not assert his trademark rights against the defendant."). Moreover, respondent's assertion that petitioner's delay in seeking registration of its mark for four and one half years, see Response, p. 7, does not support a claim for laches because laches arises out of a plaintiff's failure to challenge a defendant's application or registration, not a plaintiff's delay in seeking to register its own mark. See *National Cable Television Association, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1581, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991); see also *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1114 (TTAB 2007).

2013 WL 6046663 (Trademark Tr. & App. Bd.)

End of Document

© 2015 Thomson Reuters. No claim to original U.S. Government Works.