

ESTTA Tracking number: **ESTTA712814**

Filing date: **12/04/2015**

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

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| Proceeding | 92060428 |
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| Date | 12/04/2015 |
| Attachments | SMJ Motion.pdf(330679 bytes) |

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

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| QUALITY BICYCLE PRODUCTS, INC., Petitioner, Vs. MIDDLEBROOK DESIGN LLC dba LOVE TRAVERSE CITY, Registrant. | Proceeding No. 92060428 Marks:  and 45°NORTH Registration Nos. 4496120 and 4414967 Registered: Oct. 8, 2013 and March 11, 2014 |
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**REGISTRANT MIDDLEBROOK DESIGN LLC DBA LOVE TRAVERSE CITY'S
OPPOSITION TO PETITIONER QUALITY BICYCLE PRODUCTS'S MOTION FOR
SUMMARY JUDGMENT AND REGISTRANT MIDDLEBROOK DESIGN'S MOTION
FOR SUMMARY JUDGEMENT**

Middlebrook Design LLC DBA Love Traverse City ("LTC" or "Registrant") hereby responds in opposition to Quality Bicycle Products, Inc.'s ("QBP" or "Petitioner") Motion for Summary Judgment. Registrant also moves for Summary Judgment on Petitioner's Petition to Cancel, as there is no likelihood of consumer confusion between the at-issue marks. In support of Registrant's Opposition and its own Motion for Summary Judgment, Registrant submits the supporting Brief pursuant to 37 C.F.R. § 21.27(a).

**REGISTRANT'S BRIEF IN SUPPORT OF ITS OPPOSITION TO PETITIONER'S
MOTION FOR SUMMARY JUDGMENT ON REGISTRANT'S COUNTERCLAIM AND
IN SUPPORT OF REGISTRANT'S MOTION FOR SUMMARY JUDGEMENT**

I. INTRODUCTION

Registrant is the owner of a 400 square foot brick and mortar retail store in the Downtown district of a small resort town called Traverse City, Michigan. Registrant's business

is run wholly by Laruen Creighton, with the exception of a few part time employees who help fill in some occasional hours running the store. Registrant's store offers goods such as t-shirts, long sleeved shirts, sweatshirts, and hats. All of these products are directed towards tourists visiting the region but also locals who enjoy showing their hometown pride. Registrant's marks are all used in connection with products designed with the purpose of promoting and celebrating Traverse City, and all of Michigan.

Petitioner QBP employs hundreds of workers and is described as the largest distributor of bicycle parts and accessories in the bicycle industry. Petitioner, under its 45NORTH mark is a company that specializes in winter weather biking products, such as studded tires, studded pedals, and protective winter biking gear. All of Petitioner's products are directed towards an extremely niche market, specifically, avid winter weather biking enthusiasts. Petitioner's products are targeted to specialty bicycle shops, specially, bicycle shops in cold climates.

Petitioner has moved for Summary Judgment of Registrant's Counterclaim that Petitioner's Registration No. 4268136 and applications No. 86232342 and 86232330 are void *ab initio* as the marks in question were not in use as of the filing dates of their respective applications and allegations of use. Petitioner makes much of the fact that this Counterclaim was initiated at a time in which Registrant was proceeding *pro se* and that Registrant has offered some evidence of use of its mark in connection with some of the products listed in each application. However, Petitioner's Motion for Summary Judgment on this issue must be denied, as a genuine issue of material fact exists as to whether Petitioner has in fact made use of the marks in question as a *trademark* to identify the products listed in each respective filing.

In addition, Registrant asserts that it should be granted summary judgment on Petitioner's sole cause of action in this proceeding, as there is no likelihood of consumer confusion between the at-issue marks.

II. RELEVANT PROCEDURAL HISTORY AND FACTS

Registrant operates a small store in Traverse City, Michigan. Traverse City is located on the 45th Parallel. Registrant's store sells products that promote the local city, which is a popular tourist attraction. Registrant's products are offered for sale in Registrant's store and via an online website. Registrant's customers are individuals that are seeking to obtain a piece of memorabilia to commemorate a trip to the area, or locals of the town that wish to display their hometown pride.

Registrant obtained Registration No. 4414967 on October 8, 2013 and Registration No. 4496120 on March 11, 2014. Registrant, through Laruen Creighton, obtained both registrations after researching federal trademark law and the federal trademark application process on her own. Registrant through its search of the online trademark filing database conducted searches on its own to check the availability of the marks it was using or planned to use to identify clothing products sold in its retail store to promote Registrant's hometown. Registrant saw no conflicting trademark registrations or prior filed applications, a fact that was later confirmed by the United States Trademark Office through its registration of the at-issue marks.

Many months later, Registrant was contacted by Petitioner with a hostile request to abandon its trademark registrations. Petitioner asserted that they had been using a mark that is similar to Registrant's marks for longer than Registrant had been, and that Registrant needed to surrender its trademark registrations for the marks. It soon became clear that Petitioner had recently filed applications for its mark for protective clothing gear. Registrant did not agree to

Petitioner's demands, and Petitioner filed the instant Cancellation proceeding. Petitioner, in response, timely filed its Answer and a Counterclaim that Petitioner's filings are void *ab initio*, as Registrant's research and the materials submitted by the Petitioner to the Trademark Office showed that it had not made use of its mark as a *trademark* to identify its clothing products.

Registrant continues to assert, however, that there is no likelihood of confusion between the at-issue marks. Registrant believes that both marks can co-exist within the marketplace and on the Principal Register due to the differences in appearance between the marks, the products sold under the marks, and the sophistication of consumers involved. Registrant therefore also moves for summary judgment on Petitioner's cause of action.

III. ARGUMENT

A. Petitioner's Motion for Summary Judgment Must Be Denied as There is A Genuine Issue of Material Facts as to Whether Petitioner Used its Marks as a Trademark.

As Petitioner has stated, when a trademark is not in use as of the filing of a use-base application, the resulting registration may be found to be void *ab initio*. Petitioner states that because its has made some use of the mark prior to the filing of each application, the applications cannot be considered to be void *ab initio*. However, Petitioner's summary judgment motion must be denied as Petitioner has not shown there is no genuine issue of material fact as to whether Petitioner in fact made use of its marks as a *trademark* for these products prior to filing each application.

1. Summary Judgment Cannot be Entered When There is a Genuine Issue of Material Fact.

Summary judgment is appropriate where the movant demonstrates 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). Material facts are those that may affect the outcome of the case. *See Anderson v. Liberty Lobby, Inc.* 477 U.S. 242, 248 (1986). A dispute as to a material fact is “genuine” if there is sufficient evidence . . . to return a verdict for the nonmoving party. *See id.* 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). The Board may not resolve genuine disputes as to material facts. *Id.* It may only ascertain whether genuine disputes as to material facts exist. *Id.*

2. There is a Genuine Issue of Material Fact as to Whether Petitioner Used its Marks as a Trademark to Identify its Clothing Products.

For a trademark to be in use, a word, name, symbol, or device, or any combination thereof must be “used to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods.” 15 U.S.C. § 1127. “[N]ot every designation that is placed or used on or in connection with a product necessarily functions . . . as a trademark for said product; not every designation adopted with the intention that it performs a trademark function and even labeled as a trademark necessarily accomplishes that purpose; and there are certain designations that are inherently incapable of functioning as trademarks to identify and distinguish the source of the products in connection with which they are used.” *American Velcro, Inc. v. Charles Mayer Studios, Inc.*, 177 USPQ 149, 154 (TTAB 1973). “The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public.” *In re Eagle Crest Inc.*, 96 USPQ2d at 1229. To be a mark, “the term, or slogan, must be used in a manner calculated to project to purchasers or potential purchasers a single source or origin for the goods in question. Mere intent that a term

function as a trademark is not enough in and of itself, any more than attachment of the trademark symbol would be, to make a term a trademark.” *In re Manco, Inc.*, 24 USPQ2d at 1941.

When evaluating a mark that appears to be ornamental, rather than functioning as an indicator of source, “the size, location, dominance and significance of the alleged mark as applied to the goods” are all relevant factors in determining whether it is inherently distinctive. *In re Pro-Line Corp.*, 28 USPQ2d 1141, 1142 (TTAB 1993).

Petitioner’s specimens of record with the USPTO show that its mark is used in the following manner:





(Petitioner's Exhibit E).

Petitioner thus uses its mark in an ornamental or decorative manner. Namely, its mark is placed on the front and center of a clothing product, the very place where most ornamental and decorative designs are placed. The mark is also placed largely around the sides of a sock, again in a manner that is likely to be construed as an ornamental or decorative use.

This conclusion is buttressed by the manner in which Petitioner refers to its clothing products. For example, Petitioner refers to its sock product as the "45North by Swiftwick 7" Wool Sock." (Affidavit of David Gabrys, Ex. D). Here, the wording "by Swiftwick" is more likely to be perceived as the indicator of source of the product than the mark 45NORTH. The wording 45NORTH appears to be a reference to the design found on the product, and Swiftwick is the representation of where the product is originating from.

Thus, while Petitioner may have used its mark in question in a decorative or ornamental manner, Petitioner has not clearly established that it used its mark as a trademark to identify its

products at the time its applications were filed. A party must make use of a mark to identify its products prior the filing of an application on an in use basis. Registrant's specimens as submitted to the USPTO indicate that Registrant was not, in fact, making use of its mark as a trademark that would be perceived by consumer's as identifying the source of its products at the time the applications were filed. This presents an issue of material fact, and therefore, Petitioner's motion for summary judgment must be denied.

B. Registrant Should be Granted Summary Judgment as There is No Likelihood of Consumer Confusion Between the Marks.

Registrant, in turn, hereby moves that summary judgment should be decided in its favor, as there is not a likelihood of consumer confusion between the at issue marks.

A determination of likelihood of confusion between marks is determined on a case-specific basis. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The test for likelihood of confusion is whether a 'reasonably prudent consumer' in the marketplace is likely to be confused as to the origin of the good or service bearing one of the marks. *In re E.I. DuPont de Nemours and Co.*, 177 U.S.P.Q. 563 (C.C.P.A 1973). There are several factors as established in *DuPont* to determine whether a likelihood of confusion exists; those relevant to the present case are:

- (1) the similarity or dissimilarity as to appearance, sound, connotation, and commercial impression;
- (2) the similarity or dissimilarity and the nature of the goods or services as described in the application or registration in connection with which a prior mark is in use; and
- (3) the degree of care/sophistication likely to exercised by consumers.

See id.

Registrant asserts that summary judgment should be granted in its favor, as there is no genuine issue of material fact as to whether there is a likelihood of confusion between the marks at issue.

1. The Marks Are Not Similar in Appearance, Sound, or Commercial Context.

In comparing the similarity of two marks, the comparison must be based on an analysis of the mark as a whole. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Even when a mark may contain a dominant element, the comparison for likelihood of confusion must take into account the entirety of the mark. *See Parfums de Coeur, Ltd. v. Lory Lazarus*, Opposition No. 91161331, (TTAB 2007). For purposes of determining whether a likelihood of confusion exists between two marks, the overall *visual* impression of the marks derived from viewing the marks in their entireties is controlling. *See In re Homeland Vinyl Products, Inc.*, Serial No. 76361399, (TTAB 2006) (emphasis added).

In *Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, the Supreme Court established the *Anti-Dissection Rule* and held that composite conflicting marks are to be compared by looking at them as a whole rather than breaking the marks up into their component parts for comparison. The rationale of this rule is that the commercial impression of a composite trademark on an ordinary prospective buyer is created by the mark as a whole, not by its component parts.

Thus, in comparing the similarity of two marks, the comparison must be based on an analysis of the mark as a whole. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Even when a mark may contain a dominant element, the comparison for likelihood of confusion must take into account the entirety of the mark. *See Parfums de Coeur, Ltd. v. Lory Lazarus*, Opposition No. 91161331, (TTAB 2007). For purposes of determining

whether a likelihood of confusion exists between two marks, the overall visual impression of the marks derived from viewing the marks in their entireties is controlling. *See In re Homeland Vinyl Products, Inc.*, Serial No. 76361399, (TTAB 2006) (emphasis added).

When marks at issue contain design elements, such a “feature of a mark cannot be ignored.” *F.D.C. Wholesale Corp. v. La Cibeles, Inc.*, Opposition No. 104,891 (T.T.A.B. Aug. 25, 1995) (non-precedential), quoting *In re Appetito Provisions Co.*, 3 U.S.P.Q.2d 1553 (T.T.A.B. 1987). As designs are viewed, not spoken, a stylized design cannot be treated simply as a word mark. *In re Bundy Corp.*, 300 F. 2d 938, 940 (C.C.P.A. 1962). This is true even if the “letters are visually prominent . . . [where] they also serve as background for the display of words . . . [and] are plainly not subordinate matter.” *In Re TSI Brands, Inc*, 67 U.S.P.Q. 2d 1657 (T.T.A.B. 2002) (held that a mark with highly stylized letters surrounded by an oval or circle “as a vehicle for their display” was not dominant matter).

The Trademark Trial and Appeal Board has recently confirmed this rationale in a precedential opinion. *See In re Covalinski*, Serial No. 85685983 (T.T.A.B. 2014). There, the court reiterated that “it is entirely appropriate to accord greater importance to the more distinctive elements in the marks.” *Id.* There, even though the goods in question were found to be legally identical, the court held that consumer confusion was unlikely due to the significant differences in the visual appearance of the marks. *Id.*

Registrant asserts that its marks are not sufficiently similar in appearance as to the Registrant’s marks as for there to be a likelihood of consumer confusion. Namely, Registrant notes that its marks consists of the following designs:



Registrant's marks thus feature and contain the degree symbol and spell out the word NORTH. In contrast, the Petitioner's marks are a word mark consisting of the elements 45NRTH and the following design mark:



Registrant submits that the key visual differences establish that the marks are not similar in appearance to each other. Registrant's unique stylization and design elements, taken together with the additional elements found in its mark, renders a completely different visual look than Petitioner's mark.

Even in cases where two marks are similar in appearance or sound, differences in connotation between the marks can be sufficient to eliminate possible consumer confusion. *See In re Sears, Roebuck and Co.*, 2 U.S.P.Q. 2d 1312 (TTAB 1987); *In re Sydel Lingerie Co., Inc.*, 197 U.S.P.Q. 629 (TTAB 1977) (finding that CROSS-OVER when applied to bras carried different connotation and/or commercial impression from CROSSOVER as applied to women's sportswear); *In re British Bulldog, Ltd.*, 224 U.S.P.Q. 854 (TTAB 1984) (finding that PLAYERS for men's underwear carried different connotation and/or commercial impression from

PLAYERS for shoes); *In re Sydel Lingerie Co., Inc.*, 197 U.S.P.Q 629 (TTAB 1977) (finding that BOTTOMS UP for ladies' and children's underwear held a different connotation and/or commercial impression from BOTTOMS UP for men's clothing). Furthermore, such connotation and/or significance can be determined based upon a mark holder's current use in commerce. *In re Nationwide Industries*, 6 USPQ2d 1882, 1884 (TTAB 1984) ("Thus, it is settled that evidence of the context in which a mark is used on labels, packaging, advertising, etc., is probative of the significance which the mark is likely to project to Ser. No. 764198257 purchasers").

Registrant's marks here convey a distinct commercial impression from that of Petitioner's marks. Registrant's marks are designed to purposefully call to mind the local area of the Registrant, namely, Traverse City Michigan. Traverse City is located on the 45 parallel. Thus, the 45 Degree message found in registrant's marks is a reference to the geographic location of its products. The consumers' of Registrant's products—tourists and locals seeking to obtain products that reference the local area—know and appreciate this. That, in fact, is the reason behind their interest in purchasing the products.

In contrast, the impression behind the Petitioner's marks is one associated with that of cold weather. The Petitioner's products are all products designed to help a bicycle rider survive cold weather conditions. Thus, the 45 degrees mentioned in Petitioner's products is a reference to cold weather conditions.

B. Registrant and Petitioner Offer Different, Non-Competing and Non-Related Products Under Their Respective Marks.

When considering the similarity of the goods associated with the marks, the relevant question is whether purchasers would perceive both parties' goods as emanating from the same source. *See Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, Opposition No. 91116242, (TTAB 2006). It is not sufficient to demonstrate that goods are related by finding a

particular term that broadly describes the goods. *See In re The W.W. Henry Company, L.P.*, Serial No. 78401595, (TTAB 2007).

While the goods of the parties need not be identical or directly competitive to find a likelihood of confusion, *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, if the goods in question are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then even if the marks are similar, confusion is not likely. *See, e.g., Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) (cooking classes and kitchen textiles not related); *Local Trademarks, Inc. v. Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990) (LITTLE PLUMBER for liquid drain opener not held confusingly similar to LITTLE PLUMBER and design for advertising services, namely the formulation and preparation of advertising copy and literature in the plumbing field); *Quartz Radiation Corp. v. Comm/Scope Co.*, 1 USPQ2d 1668 (TTAB 1986) (QR for coaxial cable held not confusingly similar to QR for various products (e.g. lamps, tubes) related to the photocopying field); *See generally* TMEP § 1207.01(a)(i).

Merely because the parties operate in a broad industry, such wearable products, does not by itself establish that their goods and services are related. *See National Rural Electric Cooperative Association v. Suzlon Wind Energy Corporation*, Cancellation No. 92043377, (TTAB 2006). Even where marks are placed within the same class, it is possible to avoid a likelihood of confusion where the goods and/or services vary. *See, e.g., Taj Mahal Enterprises, Ltd. v. Trump*, 16 U.S.P.Q. 2d 1577 (D.N.J. 1990). In *Taj Mahal*, the marks under scrutiny were TAJ MAHAL for an Indian restaurant and TAJ MAHAL for a casino-hotel resort. The court held that the mark TAJ MAHAL for restaurants is suggestive of Indian food, while TAJ MAHAL for

casino-hotel evokes images of grandeur, opulence and extravagance. Therefore, despite both falling under the same class of services for the purposes of registration, the *Taj Mahal* court found that there was no likelihood of confusion. Thus, Registrant's and Petitioner's products cannot be considered as being related simply because they both may fall under the broad category of wearable products.

Registrant further asserts that the products listed under its registrations, "Headwear; Hooded sweatshirts; T-shirts" are not related and of a fundamental different nature than the products listed under the Petitioner's registration and applications. Petitioner makes use of its mark most prominently in connection with bike products, which are the subject of its registration. Petitioner also appears to make ornamental and decorative use of the mark on winter survival clothing gear for bicyclists, which are the subject of its pending trademark applications. Such clothing survival gear like "balaclavas" and "gaiters" are products that are not related to Registrant's products, which are clothing items such as sweatshirts, t-shirts, and headwear that promote Registrant's local city.

3. Buyers of Goods Associated With Both Marks are Likely to be Sophisticated and Knowledgeable, Thus Decreasing the Likelihood of Confusion.

Circumstances that suggest consumers exercise care in purchasing minimize the likelihood of confusion. *See In re N.A.D., Inc.*, 754 F.2d 996, 999-1000 (Fed. Cir. 1985). Goods that are sold to consumers that have a sophisticated knowledge of a given activity are less likely to be confused with goods that are sold to a different class of sophisticated buyers. *See Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 21 USPQ 2d 1388, 1392 (Fed. Cir. 1992).

The consumers that purchase both Registrant's and Petitioner's products will exercise caution and care in making their purchasing decisions. As Petitioner's evidence establishes, its

clothing products are sold at high prices, ranging well above the standard price for a clothing product. Additionally, Registrant's products are sold and marketed towards a small audience that will have direct knowledge and appreciation behind the meaning of Registrant's products, namely, those that are visiting the local area of Registrant's home town.

IV. CONCLUSION

Because Registrant has established that there is a genuine issue of material fact as to whether Petitioner has made use of its marks as a trademark to identify its products, summary judgment on Registrant's counterclaim must be denied to Petitioner. Furthermore, because Registrant has established that there is not a likelihood of consumer confusion between the mark, Registrant has established that summary judgment in regards to the Petitioner's Petition to Cancel should be entered in Registrant's favor, and the Petition to Cancel should be dismissed.

Dated: December 4, 2015

Respectfully submitted,

/s/ Chris Civil

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of REGISTRANT'S OPPOSITION TO PETITIONER QUALITY BICYCLE PRODUCTS'S MOTION FOR SUMMARY JUDGMENT AND REGISTRANT'S MOTION FOR SUMMARY JUDGEMENT is being served by mailing a copy thereof, by first class mail, postage prepaid addressed to the following individuals, identified in the Notice of Cancellation as the attorneys of record and correspondents on this 4th day of December, 2015:

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