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

Proceeding	92060428
Party	Plaintiff Quality Bicycle Products, Inc.
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mark in an ornamental or decorative manner.” (Registrant’s Response, p. 7.) This is an unpleaded issue, upon which a defense to QBP’s Motion for Summary Judgment cannot rely.

The evidence of use in this matter unequivocally shows that QBP’s 45NRTH mark and the 45NRTH and Design mark (collectively, the “45NRTH marks”) were in use before the filing dates of QBP’s Trademark Application Nos. 86/232,342 (for clothing), 86/232,330 (for clothing), and 85/625,684 (for bicycle tires) - and that they function as trademarks. Summary judgment should be entered in favor of Petitioner on Registrant’s counterclaim.

II. ARGUMENT

A trademark application based on use in commerce may only be found to be “void ab initio” when the trademark was not in use in commerce as of the application filing date.² *Am. Hygienic Labs., Inc. v. Tiffany & Co.*, 12 USPQ 2d 1979, 1984 (TTAB 1989); *see also Grand Canyon West Ranch, LLC v. Hualapai Tribe*, 78 U.S.P.Q.2d 1696, 2006 WL 802407, at *2 (TTAB March 17, 2006) (“[A]s long as the mark was used on some of the identified goods or services as of the filing of the application, the application is not void in its entirety”). In this case, the evidence unequivocally demonstrates that the 45NRTH marks were in use prior to the application filing dates. Therefore, the applications at issue are in no way “void ab initio.”

² An application may also be found void when the pleaded ground is fraud (*Grand Canyon West Ranch, LLC v. Hualapai Tribe*, 78 U.S.P.Q.2d 1696, 2006 WL 802407, at *1 (TTAB March 17, 2006)), but fraud is not an issue in the present case.

A. Registrant's Opposition Is Improperly Based on an Unpleaded Issue.

As an initial matter, Registrant's Opposition should be rejected, as Registrant attempts to rely on an argument that has not been previously pled. Notably, Registrant's counterclaim filed on January 2, 2015 ("Registrant's Counterclaim") is based solely on its argument that Petitioner's applications are "void ab initio" because, it alleges, Petitioner did not use its marks as of May 15, 2012 (the filing date of Application No. 85/625,684 for 45NRTH in connection with "bicycle parts, namely, tires") and October 1, 2011 (the date of first use provided in Application No. 85/625,684). (*See* Registrant's Counterclaim ¶¶ 7-9.) Now, in an attempt to avoid summary judgment, Registrant argues that, even *if* Petitioner was using the marks, the marks were not functioning as trademarks because they were being used ornamentally. (*See* Registrant's Opposition, pp. 7-8.) This is an entirely new argument, which was not previously pled by Petitioner. This approach is contrary to the Rules and should be rejected outright. *See* TBMP 528.07(b) ("A party may not defend against a motion for summary judgment by asserting the existence of genuine disputes of material facts as to an unpleaded claim or defense.")

Despite this objection, Petitioner replies to Registrant's arguments in an abundance of caution. Such reply should not be read as a concession to Registrant amending its claims or defenses. What is more, this reply should not be read as a concession that, should this motion be denied, the Registrant be allowed to argue this unpleaded ornamentation claim at trial.

B. There Is No Issue of Any Fact About Whether QBP's 45NRTH Mark Subject Of Trademark Application No. 85/625,684 (for bicycle tires) Was In Use As Of The Application Filing Date.

It is undisputed that the 45NRTH mark was in use on bicycle tires before the filing date of Application No. 85/625,684. Indeed, the specimen of use submitted with Application No. 85/625,684 is an image of a QBP bicycle tire showing the 45NRTH mark. (Declaration of

Audrey Babcock submitted with Petitioner's summary judgment brief on November 2, 2015 ("Babcock Decl."), Ex. A, p. 7.) This tire specimen shows the 45NRTH mark affixed to a bicycle tire in a manner which creates the commercial impression of a trademark, particularly given the size, location, and dominance of the 45NRTH mark. *See* TMEP 1202.03(a). The tire specimen clearly shows the 45NRTH mark used as a trademark.

Registrant's Opposition does not address the evidence of use established by the tire specimen, and includes no arguments as to why the 45NRTH mark might be viewed as "ornamental" when used in connection with bicycle tires.

As a matter of law, there is no genuine issue of material fact to allow Registrant's counterclaim over Application No. 85/625,684 and the resulting Registration No. 4,268,136 to proceed.

C. There Is No Genuine Issue of Any Material Fact About Whether QBP's 45NRTH Marks Subject of Pending Trademark Application Nos. 86/232,342 (for clothing) and 86/232,330 (for clothing) Are or Were in Use.

1. The 45NRTH Marks Subject of Pending Trademark Application Nos. 86/232,342 (for clothing) and 86/232,330 (for clothing) Serve a Source-Indicating Function.

Designations that serve a source-indicating function are recognized as trademarks. TMEP 1202.03(c); *In re Expo '74*, 189 USPQ 48, 1975 WL 20893, at *3 (TTAB 1975); *In re Olin Corp.*, 181 USPQ 182, 1973 WL 19761 (TTAB 1973) (finding that a mark used on t-shirts served as an identifier of a secondary source and was registrable, after original use of mark on sports gear was established). In *Olin*, the applicant originally applied to register a stylized letter "O" in connection with skis, and later filed application to register the same stylized letter "O" in connection with t-shirts. *In re Olin Corp.*, at *1. In examining the second application, the examiner refused registration of the mark on the ground that that the use of the mark on T-shirts

was merely ornamental. *Id.* On appeal, the applicant argued that the mark had previously been registered for skis, and therefore functioned as a trademark. *Id.* The Board reversed the refusal to register, stating, “[a]s used on the T-shirts, we conclude that the mark serves as an identifier of a secondary source and as such is registrable.” *Id.* at *2.

Likewise, in this case, QBP originally applied to register its mark in connection with bicycle tires, and later filed an application to register the same mark in connection with clothing products. The 45NRTH marks serve a source-indicating function.

2. The 45NRTH Marks Subject of Pending Trademark Application Nos. 86/232,342 (for clothing) and 86/232,330 (for clothing) Are, and Have Been, in Use.

The evidence unequivocally shows that the 45NRTH marks subject of pending trademark application nos. 86/232,342 (for clothing) and 86/232,330 (for clothing) are, and have been, in use at all relevant times. (Affidavit of David Gabrys submitted with Petitioner’s summary judgment brief on November 2, 2015 (“Gabrys Aff.”) at ¶¶ 5-10 & Ex. B.) The sales of socks were first, with sales beginning on March 12, 2012, and then sales of other goods in class 25 followed. *Id.* For example, the first sale of the 45NRTH Jaztronaut insole was on September 18, 2012. (Gabrys Aff. at ¶ 10 & Ex. B.) The first sale of the 45NRTH Lung cookie balaclava was on October 25, 2012. (Gabrys Aff. at ¶ 8 & Ex. B.) The first sale of the 45NRTH Toaster Fork balaclava/cap was on October 25, 2012. (Gabrys Aff. at ¶ 9 & Ex. B.) Footwear, insoles, balaclavas, and hats were all listed in the description of goods, under class 25, in the pending applications. (Babcock Decl., Exs. E & G.) Accordingly, the undisputed record evidence shows that the 45NRTH marks were in use in connection with goods identified in the pending applications, prior to the March 26, 2014, filing date of the pending applications.

It is well-settled that the use of a mark on a tag is an acceptable form of trademark use. *See* 15 U.S.C. § 1127 (“[A] mark shall be deemed to be in use in commerce (1) on goods when (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto. . . .”). For example, the C.C.P.A. has found that a three-dimensional embodiment of a trademark affixed as a charm to a bracelet was an acceptable specimen showing trademark use. *In re Penthouse Int’l Ltd.*, 565 F.2d 679, 683, 195 U.S.P.Q. 698 (C.C.P.A. 1977) (“The capacity of a mark to indicate origin is not destroyed because the mark appears as a charm on a bracelet, instead of as a symbol on the box which contains the bracelet.”)

QBP’s use of the 45NRTH marks in connection with clothing items is not limited to printing the marks directly on clothing items. For example, a clothing hangtag bearing the 45NRTH and Design mark is attached to 45NRTH Greazy cap, Lung Cookie balaclava, and Toaster Fork balaclava/cap products upon sale and delivery. (Gabrys Aff. at ¶ 26 & Exs. O-P.) The clothing hangtag bearing the 45NRTH and Design mark was created on August 8, 2012 (Gabrys Aff. at ¶ 26), and the 45NRTH Greazy cap, Lung Cookie balaclava, and Toaster Fork balaclava/cap products were first sold on October 25, 2012 (Gabrys Aff. at ¶¶ 7-9). Examples of use of the clothing hangtag in connection with the 45NRTH Greazy cap are shown in Exs. H-J of the Gabrys Affidavit. (Gabrys Aff. at ¶ 22.)

As was the case in *Penthouse*, if a charm on a bracelet may function as a trademark instead of being merely ornamental, a mark on a disposable tag for clothing, such as the tag

shown in Exhibits H-J and O-P of the Gabrys Affidavit, certainly functions as a trademark. The pending applications are in no way void ab initio for non-use as of the application filing dates.³

3. Use of 45NRTH Marks on Clothing Products Does Not Make QBP's Use Ornamental.

QBP's use of the 45NRTH marks is not mere ornamentation and is not merely decorative. When goods are clothing, marks used as trademarks are often placed on the front and center of clothing products. As the Board has recently observed:

It may have once been the practice in the clothing industry to limit logos to small sizes in discrete areas rather than to have them 'emblazoned' across a garment...however, we find that such is no longer the industry practice, or at least no longer the only one. Accordingly, we reject a *per se* rule regarding registrability based on the size of a mark on clothing.

In re Lululemon Athletica Can. Inc., 105 USPQ2d 1684, 2013 WL 326567, at *4 (TTAB 2013) (citations omitted). Registrant argues that Petitioner's "mark is placed on the front and center of a clothing product, the very place where most ornamental and decorative designs are placed." *Id.* However, Registrant's argument misses the mark. To the extent that QBP's marks appear on the front and center of clothing products, that fact does not mean the mark is not in use or that it fails to function as a mark.

The evidence of record, moreover, shows that the QBP marks conspicuously appear not only on the front and center of clothing products, but also appear diminutively in discrete locations on clothing products. For example, photographs of the 45NRTH Wolvhammer and

³ Even if trademark use prior to the filing date of the pending applications were not established, the pending applications could be amended to cure defects in the date of first use or the filing basis. See TMEP 903.04; *Grand Canyon West Ranch, LLC v. Hualapai Tribe*, 78 U.S.P.Q.2d 1696, 2006 WL 802407, at *3 (TTAB March 17, 2006) ("[I]n the absence of a fraud claim, an applicant who bases its application on Section 1(a) (use in commerce) but who did not use the mark on some or all of the goods or services identified in the application may 'cure' this problem by amending its basis to Section 1(b) (intent to use).")

45NORTH Fasterkatt cycling shoes are shown in Exs. E and F of the Gabrys Affidavit. (Gabrys Aff. at ¶¶ E-F.) These photographs show the 45NORTH marks in a small size, placed on a discrete area near the heels of the shoes.⁴

4. The Appearance Of Another Mark With QBP's 45NORTH Marks Does Not Make QBP's Use Ornamental.

Finally, the use of SWIFTWICK on the 45NORTH sock as a trademark does not cause 45NORTH to lose its trademark function. Registrant argues that, with regard to the 45NORTH sock, "Swiftwick is the representation of where the product is originating from." (Registrant's Opposition, p. 7.) However, both 45NORTH and SWIFTWICK are used as trademarks in connection with the 45NORTH sock. (See Gabrys Aff., Ex. A.) The Board has stated that "it is well established that a party may use more than one trademark on its goods." *In re Marsh Stencil Machine Co.*, 178 USPQ 318, 1973 WL 19938, at *1 (TTAB 1973). QBP's marks are in use.

⁴ The 45NORTH Wolvhammer and 45NORTH Fasterkatt cycling shoes were added to the QBP.com online sales catalog on June 6, 2012, and February 2, 2013, respectively. (Gabrys Aff. at ¶¶ 13-14.) The 45NORTH Wolvhammer cycling shoe was first sold on November 2, 2012. (Gabrys Aff. at ¶ 6.) These dates are well before the March 26, 2014, filing date of the pending applications.

