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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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**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 CROSS MOTION
FOR SUMMARY JUDGMENT**

Middlebrook Design LLC DBA Love Traverse City (“LTC” or “Registrant”) hereby responds in opposition to Quality Bicycle Products, Inc.’s (“QBP” or “Petitioner”) Cross Motion for Summary Judgment. Contrary to the statements of Petitioner, the circumstances at issue in this proceeding show that there is not a likelihood of confusion between the marks. Much less, the Petitioner has not established that Petitioner made use of its asserted marks as a trademark for clothing products prior to Registrant. In support of Registrant’s Opposition, 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
CROSS MOTION FOR SUMMARY JUDGMENT**

I. INTRODUCTION

As Registrant has previously detailed, 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 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 originally 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. Registrant, in response, has argued that Petitioner's Motion 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.

Registrant additionally asserted 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. In response, Petitioner filed a Cross Motion for Summary Judgment on likelihood of confusion grounds in its favor.

Registrant continues to assert that there is not a likelihood of consumer confusion between the marks at issue due to the difference in appearance of the marks and products sold under the respective marks. Registrant additionally asserts that the additional factors addressed by Petitioner do not show there is a likelihood of consumer confusion between the marks. Contrary to Petitioner's assertions, the trade channels at issue are distinct from each other, and use of the wording and number 45 North is not unique to that of Registrant or the Petitioner.

Registrant therefore asserts that Petitioner's Cross Motion for Summary Judgment should be denied. Instead, the Board should grant Registrant's Motion for Summary Judgment, as there is not a likelihood of consumer confusion between the 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. When Registrant did not cave to these demands, Petitioner filed the instant Cancellation proceeding. Petitioner then previously filed a Motion for Summary Judgment on Registrant's Counterclaims, to which Registrant has opposed on the basis of factual issues that remain regarding Petitioner's use.

As Registrant believes there to be a lack of likelihood of confusion between the marks at issue, Registrant then also moved for Summary Judgment in its favor. In response, Petitioner filed a Cross Motion for Summary Judgment in favor of Petitioner on the issue of whether there is a likelihood of confusion between the marks at issue. For the reasons Registrant has previously explained, Registrant asserts that there is not a likelihood of consumer confusion between the marks at issue.

III. ARGUMENT

A. Petitioner’s Cross Motion for Summary Judgment Must Be Denied as There is A Genuine Issue of Material Facts as to Whether Petitioner Has Priority.

As Petitioner has stated, in order for Petitioner to prevail on its Cross Motion, it must establish priority of use, as well as that there is a likelihood of consumer confusion between the marks. *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (“Under the statute, the Commissioner must refuse registration when convinced that confusion is likely because of concurrent use of the mark of an applicant and a prior user on their respective goods.”). Petitioner, in its Cross Motion, has attempted to obscure the fact that a live, genuine issue of material fact exists in this proceeding as to whether Petitioner has made use of its respective marks as a trademark prior to Registrant’s use. As such, Petitioner’s Cross Motion must be denied.

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.*

Petitioner has asserted that it has made use of its respective marks "since early 2012." Br. of Petitioner at 3, FN 3. However, Petitioner has not established that it has made use of its respective marks as a trademark as of those dates. 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. 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).

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 as of the early dates mentioned by Petitioner. In fact, it appears that the opposite is the case: Petitioner used its mark to identify bicycle products in early 2012. Petitioner may have made limited use of its mark in an ornamental, non-distinctive fashion on some products that bicyclists would wear to protect themselves from the elements, such as insoles, balaclavas, and protective socks. However, Petitioner has not established that it made use of its mark as a trademark for such products. Instead, what is more readily apparent is the Petitioner, a bicycle company, made ornamental use of the mark on products it was beginning to develop.

Petitioner’s assertions regarding its priority of use are also obscured by Petitioner’s blending of its product line and development. Petitioner, in its Cross Motion, attempts to paint a picture that its early use of its mark was for products similar to that of Registrant. For example, when Petitioner compares the use of the respective marks in its Brief, Pet. Br. at 5, it does so by showing photos of its mark on T-shirts and standard, average-consumer oriented socks. Petitioner also takes time to thoroughly explain how it has, over time, begun to make of its mark on clothing products that are similar to that of Registrant. However, Petitioner has not established that prior to the central dates in the proceeding—February 2013, the filing date of Registrant’s first application for its mark—Petitioner was using its marks as a trademark for products that are similar to that of Registrant. Instead, the evidence clearly indicates that Petitioner, as a bicycle company, used its respective marks on bicycle products in early 2012 and only much later began to have plans or make use of the marks on products that could be seen as similar to that of Registrant.

Thus, Petitioner has failed to establish that there is, in fact, an absence of genuine issues of material fact relating to its priority of use. As this is a requirement for Petitioner’s Cross Motion to succeed, the Board should deny Petitioner’s Cross Motion.

B. Petitioner’s Cross Motion for Summary Judgment Must Be Denied as There is Not a Likelihood of Confusion Between the Marks.

Petitioner’s Cross Motion for Summary Judgment should also be denied because Petitioner has not established that there is a likelihood of confusion between the 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).

Petitioner has tried to establish that it uses its marks at issue to identify products that are similar to that of Registrant's, that the connotation between the marks is the same, and that its products are sold under the same conditions and retail establishments. Such assertions are opposite of the true manner in which Petitioner brands and markets its products. Petitioner is a company that makes bicycle products, pure and simple. Petitioner sells products under its respective marks that are for individuals in the biking community and for use in extreme whether conditions. Registrant is the owner of a small shop that sells clothing products directed towards everyday wear by locals in the community and tourists.

1. The Marks Are Not Similar in Appearance and Commercial Context.

Petitioner has asserted that the first *DuPont* factor weighs heavily in its favor. This is simply not the case, as the marks at issue, as Petitioner admits, have distinguishing features. Registrant's marks do not make minor use of the degree symbol; it is featured in each mark as a key portion of the mark. In addition, Registrant's marks both contain the letter "O" which is not found in Petitioner's mark. The letter "O", in fact, is emphasized in each of Registrant's mark through creative spacing that makes the letter appear to be overlapping with the of the letter "N" preceding it.

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 entirety 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). The Board has established that “it is entirely appropriate to accord greater importance to the more distinctive elements in the marks.” *In re Covalinski*, Serial No. 85685983 (T.T.A.B. 2014). In *Covalinski*, the Board established that visual differences between the marks at issue avoided a likelihood of confusion between the marks at issue. Registrant asserts that the marks at issue in the proceeding, contrary to the assertions of Petitioner, are similarly distinct. Registrant’s marks feature and contain the degree symbol and spell out the word NORTH. In contrast, the Petitioner’s marks lack the word NORTH; instead, they contain the lettering NRTH. In addition, the overall design of Registrant’s marks are different from that of the Petitioner’s marks. Registrant’s marks contain a unique box image that surrounds one mark and a stylized version of an overlapping “O” in both marks. Petitioner’s mark, in contrast contains an image of a triangle on the upper right side of the mark.

The differences in spelling and stylization between the marks at issue here, like in *Covalinski*, make it difficult to notice any similarities that may exist between the marks. Upon looking at Registrant’s mark, the key visual impression of its marks are the numbers “45”, a degree symbol, and the wording “North.” In contrast, the key visual imagery found in the Petitioner’s mark is the wording “45NRTH,” with a particular emphasis on the three numbers and letters “45N”. The visual differences between the marks thus makes it likely that a consumer

will focus on imagery in the Registrant's marks that creates a phrase of "45 Degrees North," whereas the Petitioner's mark creates a phrase of "45N" followed by "RTH". The fact that both marks may make reference to "45 North" is not seen through a visual comparison of the marks.

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.

Petitioner has asserted that the connotation behind the marks are, contrary to Registrant's previous assertion, similar to each other. Registrant, in turn, wishes to establish that this is not the case, at least not from the perspective of the average consumer that encounters Petitioner's products. As previously explained, 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 45th 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.

Petitioner has asserted that the connotation associated with its mark is the same as Registrant's mark because Petitioner "named its 45NORTH line after the 45-degree latitude line that crosses the Twin Cities." Pet. Br. at 10. However, it is Petitioner that is merely asserting that this is the connotation of its mark. All of Petitioner's marketing materials and use of its mark suggest that the reference to the number 45 found in the mark is a reference to cold weather temperatures. Petitioner's marketing materials and promotional efforts fail to make any reference

or suggestion to the fact that the brand identifies the 45th Parallel. Consumers encountering Petitioner's products thus will not impart such a connotation to Petitioner's marks.

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). As there are differences in connotation between the marks at issue, there is not a likelihood of consumer confusion between the marks.

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

Petitioner asserts that the second *DuPont* factor favors it as well, because “QBP and Registrant both use their marks on clothing.” Br. of Pet. at 11. However, Petitioner's assertions that the products of both parties are the same or even similar to other inaccurately characterizes the nature of the products at issue. Petitioner's use of its mark and Registrant's use should be compared based on use by the Petitioner prior to that of the Registrant. At that time, Petitioner's used its mark to identify bicycle products and extreme weather clothing products. These products are far from being the same, nor similar, to that of the Registrant.

Petitioner has offered no case law or evidence to support the fact that its products—extreme weather clothing and bicycle products—would be considered to be similar to that of the products that Registrant provides, namely, clothing products that cater to tourists and locals in the Traverse City, Michigan area. Petitioner instead attempts to obscure the nature of its use of the mark by pointing to recent use of its mark on hats and t-shirts. Such use comes after Registrant's use of its respective marks. The products on which Petitioner originally may have made use of its mark are products that cater to bicyclists and individuals that enjoy extreme whether activities. Those products are distinct from and not similar to Registrant's products.

Indeed, the entire marketing line and promotional activities surrounding Petitioner's marks centers around extreme weather conditions. Petitioner's products are referred to as ultimate cold weather performance gear for committed winter cyclists. The products are described as being designed to increase winter riding comfort and control. Registrant's products, in contrast, are items that are designed to be worn casually and to promote local hometown pride.

The products at issue in this proceeding are thus significantly different from each other, thus indicating that there is not a likelihood of consumer confusion between the marks.

3. The Trade Channels Through Which Petitioner's and Registrant's Products are Sold are Vastly Different.

Petitioner has asserted that an additional *DuPont* factor, "[t]he similarity or dissimilarity of established, likely-to-continue trade channels" weighs in its favor. *DuPont*, 476 F.2d at 1361. Petitioner makes this assertion based on the belief that Registrant's and the Petitioner's products are sold in brick-and-mortar shops and online. However, the fact that Registrant's and the Petitioner's items are sold in retail stores and online is, to put it simply, far from being significant or noteworthy. Indeed, the same could be said for just about *any* product that is offered for sale. In order to be offered for sale in commerce, a product must be sold *somewhere*, and that somewhere is usually a physical store or online.

Petitioner obscures the fact that there is an enormous difference between the trade channels where the products at issue are actually sold. As Registrant has explained, its products are sold in a small store that caters to tourists and locals that wish to express their affinity for their hometown. Registrant also operates an online store that caters to a similar clientele and services a similar purpose. Petitioner's products are sold in retail establishments that are of an entirely different nature than Registrant's. Petitioner's products are sold in bicycle stores and stores that sell extreme weather equipment. For example, the retail establishment that Petitioner references

throughout its brief as being so similar in nature to Registrant is a bicycle store that primarily sells and rents bicycles and bicycle equipment.

Thus, the trade channels at issue are worlds apart from each other. Registrant's products are sold through tourist and local pride stores, whereas the Petitioner's products are found in bicycle shops and extreme weather clothing stores. The trade channels do not overlap. Individuals seeking to obtain Registrant's products would never think to look at the retail establishments where Petitioner's products are sold, and vice versa.

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

Petitioner also asserts that purchasers will purchase both Registrant's and Petitioner's products under "impulse" circumstances. This is simply not the case. Registrant's products are unique products that cater to a very specific class of purchasers, that is, those seeking to display their pride for their hometown or a souvenir. Petitioner's products, in contrast, are high-quality, expensive extreme weather gear. 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.

5. Petitioner Has Not Established that Its Marks at Issue are Famous.

Petitioner points to an additional *DuPont* factor, "[t]he fame of the prior mark", as a factor that sides in its favor. Petitioner's claim of having a famous mark, however, is not supported based on the materials and information presented by Petitioner. Petitioner's references to events and promotion appear to center around promoting the company and the company's name, Quality Bicycle Products, not the trademarks at issue in this proceeding. In order for Petitioner to establish that this factor sides in its favor, Petitioner needs to establish that the marks at issue in this proceeding are famous. References to overall marketing efforts and events held by Petitioner thus are not relevant.

In any event, Registrant asserts that the evidence that is put forth by Petition to establish that it has a famous mark is not sufficient. Petitioner has failed to establish that there is widespread recognition of its mark of the kind the Board requires for this factor to side in Petitioner's favor. Registrant asserts that this factor at best remains neutral between the parties.

6. As the Phrase 45 North Refers to a General Geographical Feature, Its Use is Not Unique to Petitioner and Registrant.

Finally, Petitioner points to an apparent lack of third party registrations containing the number "45" and the terms "NORTH" or "NRTH" as evidence that Petitioner and Registrant are the only entities selling similar goods under similar marks. Registrant wishes to establish that this is not the case. As the phrase "45 North" refers to the 45th Parallel, there are a wide variety of retailers and business that make use of the phrase. Clothing retailers and other small business that wish to create a fun way of creating a reference to the local geography.

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 prior to Registrant's use, Petitioner's Cross Motion for Summary Judgment must be denied.

Furthermore, because Registrant has established that there is not a likelihood of consumer confusion between the marks, Petitioner's Cross Motion for Summary Judgment must be denied.

Instead, Registrant asks the Board to grant Registrant's previously filed Motion for Summary Judgment, as there is not a likelihood of confusion between the marks.

Dated: February 26, 2016

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 CROSS MOTION FOR SUMMARY 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 26th day of February, 2016:

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