

**Exhibits**

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

**In the Matter of Trademark Application Serial No. 76/179,674**

**For the Mark GLOBAL DÉCOR**

**YOSHIDA METAL INDUSTRY CO., LTD.,**

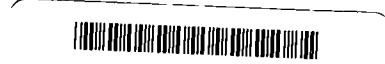
**TTAB  
Attorney Nancy O'Melco  
Ext. 239**

v.

**GLOBAL DECOR,**

**Applicant**

**Opposition No. 91156618**



09-02-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

**APPLICANT'S MOTION FOR SUMMARY JUDGMENT  
AND  
EXHIBITS A-Q LODGED HEREWITH UNDER SEPARATE COVER**

Applicant seeks summary judgment that Opposer cannot prevail on its opposition and therefore the opposition must be dismissed in its entirety. This Motion is timely, as it is filed before the close of discovery. Applicant's statement of proposed uncontested facts are attached as Appendix I; a listing of the exhibits lodged herewith in support of this motion is attached as Appendix II.

**I. Summary**

Applicant, Global Decor, hereinafter "Decor", on December 12, 200, filed an application to register the mark Global Decor in International Class 21 for the following goods: housewares, soaps, toilet tissue roller, kitchen utensils, cookie cutters, baking pans, cheese utensils, barware utensils, chopsticks, bath and shower accessories, chopstick dinner sets, seafood utensil sets and children's furniture. (See Exhibit A - Application, lodged herewith). The description of goods was subsequently amended to read as follows:

“decorative hand soaps” in International Class 003

“chopsticks and chopstick dinner sets, forks, knives and spoons, hand held chopper, and non electric can opener,” in International Class 008

“pulsating shower massage head, slip on portable hand held shower sprayer” in International Class 011

“children’s furniture; non-metal utility hooks,” in International Class 020;

“housewares in the nature of kitchen utensils, namely cookie cutters, baking pans, cheese cutters, serving spoons, serving ladles, pie servers, spatulas, draining spoons, skimming spoons, serving spoons, serving forks, wire egg cup holders, condiment bowls, pepper sauce holders, condiment steel shaker cans, stainless steel hand juicer; barware utensils, consisting of strainers, ice tongs, and condiment picks; seafood utensil sets consisting of shell cracker and seafood picks; bath and shower accessories, namely shower organizer, plunger, pop-up sink plugs, tooth brush holders, soap dish and towel hangars; toilet tissue rollers,” in International Class 021. (See Exhibit B, lodged herewith).

Yoshida Metal Industry Co., Inc. filed a Notice of Opposition on May 28, 2003 based in part, on its registered mark Global. Yoshida’s mark Global is registered for use with forks, utility knives, spoons, fish bone tweezers, whetstones, whetstone holders, knife steels in International Class 08; turners, carving forks, spatulas and knife bags for holding knives in International Class 021. See Notice of Opposition, ¶4, ¶8.

a. **No Likelihood of Confusion**

To grant judgment in favor of Applicant and deny the opposition, the Board need only determine that “Global” alone, as used in commerce, on or in connection with the goods, is weak.

Once having determined the weakness of Global, the Board can conclude as a matter of law that “Global” and Global Decor have sufficient dissimilarities to avoid confusion. The term Global in combination with the term Decor, when used in connection with Applicant’s goods,



consider the differences in the sight, sound, and meaning of the respective marks. *see Lebowbros Inc., v. Lebowbros Euro Comp S.P.A.*, 503 F.2d 309, 212 U.S.P.Q. 693 (E.D. PA 1980); *see also TMEP 1207.01(b)(i); GolfStates Paper Corp. v. Crown Zellerbeck Corp.*, 312 F.2d 940, 136 U.S.P.Q. 589 (C.C.P.A. 1969); *Republics Steel Corp. v. M.P.H. Mfg. Corp.*, 312 F.2d 940, 136 U.S.P.Q. 447 (C.C.P.A. 1963). The Board, however, must ultimately consider the overall impression created by the marks. *Id.* Although marks must be compared in their entireties and not dissected, it is proper in considering marks, to consider what portion of the mark dominates. *Id.* If the common element of two marks is weak, consumers will typically be able to avoid confusion. *See e.g., In re Bed & Breakfast Registry*, 791 F.2d 157, 229 U.S.P.Q. 818 (Fed. Cir. 1986) (BED & BREAKFAST REGISTRY for making lodging reservations for others in private homes held not likely to be confused with BED & BREAKFAST INTERNATIONAL for room booking agency services). Put another way, if a mark is weak, then another's combining the term mark with another term, will not likely cause confusion provided the combination has some synergy so as to alter the overall impression. *See American Heritage Life Ins. v. Heritage Life Insurance*, 494 F.2d 3, 13 (5<sup>th</sup> Cir. 1974), no confusion because Heritage is weak and the addition of American is sufficient to avoid confusion; *see also United States Shoe Corp. v. Chapman*, 229 U.S.P.Q. 74 (T.T.A.B. 1985) (COBBLER'S OUTLET for shoes held not likely to be confused with CALIFORNIA COBBLERS [stylized] for shoes); *In re Istituto Sieroterapico E Vaciniogeno Toscano "SCLAVO" S.p.A.*, 226 U.S.P.Q. 1035 (T.T.A.B. 1985) (ASO QUANTUM [with ASO disclaimed] for diagnostic laboratory reagents held not likely to be confused with QUANTUM I for laboratory instrument for analyzing body fluids); *Sweats Fashions v. Pannill Knitting Company*, 4 U.S.P.Q. 2d 1793 (Fed.

09/09/2001 09:11:13 AM

Cir. 1987); no likelihood of confusion between the marks "ULTRASWEATS" and "SWEATS" design.

Applicant can establish the weakness of Opposer's Global mark as a matter of law in a variety of ways. First, Applicant can show the mark is laudatory, descriptive or highly suggestive. See *Tektronix v. DataTronics*, 187 U.S.P.Q. 588 (T.T.A.B. 1975) aff'd. 534, F.2d 915, 189 U.S.P.Q. 693 (C.C.P.A. 1976). Applicant can make reference to third party registrations to show descriptiveness. See TMEP 12.07.01 [c] (iv). Alternatively, Applicant can establish weakness by pointing to wide spread adoption and use of the term Global. See *Amstar Corporation v. Domino's Pizza, Inc.*, 615 F. 2d 252, 260, U.S. App. Lexis 1883-1, 205 U.S.P.Q. 969 (9<sup>th</sup> Cir. 1980). Further, weakness can also be established by showing use of the same or similar marks by others on the same or similar goods. See *Armstrong Cork Company v. World Carpets*, 597 F.2d 496; 1979 U.S. App. Lexis 13770; 203 U.S.P.Q. 19 (5<sup>th</sup> Cir. 1979). Finally, weakness can be shown by pointing to Opposer's toleration of use. *Id.*

Applicant has obtained a variety of evidence types, to demonstrate weakness of Global. Applicant has printouts from the USPTO database, in part, summarized below which show applications and registrations for Global marks. The records lodged herewith in support of this motion as Exhibit E are admissible as they are self-authenticating public records published by the United States government. See Federal Rule of Evidence 901 b(4), (7). See also attached affidavit lodged herewith as Exhibit Q.

| Mark   | Registration No./Serial No. | Registrant                     | Filing Date | Goods  |
|--------|-----------------------------|--------------------------------|-------------|--|
| Global | 2,486,406                   | Global Computer Supplies, Inc. | 09/11/2001  | A variety of goods in International Classes 2, 3, 5, 6, 7, 8, 9, 10, 11, 12, 14, 17, 20, 21, and 27, <b>including utility knives</b> |
| Global | 2,163,891                   | Global One                     | 06/09/1998  | Mugs, and beverage can   |

|                                      |                                 |  |            |  |
|--------------------------------------|---------------------------------|--|------------|--|
|                                      |                                 | Communications World Holding BEVY. Netherlands/Holland Corporation |            | insulators in International Class 21   |
| Global                               | 76/522,962                      | Englewood Ventures Inc.  | 06/17/2003 | Paper towel dispensers, toilet tissue dispensers and soap dispensers in International Class 21   |
| Global Living                        | Pending Use Application-Current | Global Living, LLC   | 02/06/2003 | A variety of goods in International Classes 20, 21, and 35,  |
| Global Pets                          | 1,479,669                       | Global Pet Industries, Inc.  | 03/08/1988 | Pet cages; accessories for pet cages, namely, cups, perches, water bottles, swings, ladders, plastic water dishes, plastic holders for bird greens; parrot stands; cage stands   |
| Global Riders                        | 75/403,485                      | Velasquez, Gilberto Monsanto                                       | 12/09/1997 | A variety of goods in International Classes 2, 4, 9, 12, 16, 18, 21, 25, 28, 35, 36, 37, 41 and 42   |
| Siemens Global Network of Innovation | 76/289,222                      | Siemens Aktiengesellschaft   | 07/17/2001 | A variety of goods in International Classes 7, 9, 11, 12, 16, 35, 36, 37, 38, 39, 41 and 42  |
| GlobalGifts                          | 2,604,633                       | Reborn Products Co., Inc.  | 08/06/2002 | A variety of goods in International Classes 35 and 42, including pocketknives, penknives, razors, sport knives and tool belts; billfolds   |
| GMC Global Machinery Company         | 76/048,148                      | GMCA Pty Ltd.  | 05/15/2000 | A variety of goods in International Classes 7 and 8  |
| Global Restaurant Supply             | 75/913,483                      | Global Restaurant Supply, LLC                                      | 02/08/2000 | Wholesale distributorship and retail store services featuring restaurant furniture and restaurant food service equipment, namely, ranges, ovens, fryers, grills, fume removal hoods, walk-in coolers and freezers, commercial pots and |

|        |            |                                     |            |   |
|--------|------------|-------------------------------------|------------|---|
|        |            |                                     |            | pans, commercial eating utensils, plates, cups and saucers                                    |
| Global | 1,218,397  | Global Castors and Hardware Limited | 11/30/1982 | Furniture castors in International Class 20   |
| Global | 76/416,284 | Global House of Trims LLC           | 06/03/2002 | Home furnishings, namely fabric trims, tassels, cords and draperies in International Class 24 |
| Global | 2,409,662  | Global Total Office                 | 12/05/2000 | A variety of goods in International Class 20  |

Applicant has also obtained web page printouts, summarized below, which show that third parties use the term "Global". The web pages are lodged herewith as Exhibit F in support of this motion and admissible evidence as they are self-authenticating records. See Federal Rules of Evidence 901(4). See also attached affidavit lodged herewith as Exhibit Q.

| Goods                     | URL                       | Company                   |
|---------------------------|---------------------------|---------------------------|
| Global Pet Products, Inc. | www.GlobalPetProducts.com | Global Pet Products, Inc. |
| Global Pottery            | www.GlobalPottery.com     | Global Pottery            |

Applicant has further obtained directories, summarized below, lodged herewith as Exhibit G, from the International Housewares Show which took place in Chicago in 2000 and 2003 and the 2003 Restaurant Show. The directories show the use of Global as part of companies' trade name. The directories are self-authenticating. See also attached affidavit lodged herewith as Exhibit Q.

| Company                       | Goods/Services  |
|-------------------------------|---|
| Global Business Services      | Water based finishes  |
| Global Household Brands, Inc. | Nationally advertised brands of household cleaning products |

|                                      |  |
|--------------------------------------|--|
| Global Instruments                   | Pest repelling products  |
| Global Pottery                       | Decorative pottery   |
| Globaltech Trading & Marketing, Inc. | World's largest tarpaulin manufacturer and P.E. related bags   |
| Global Marketing Corporation         | Air pots, aluminum cookware, cook & bakeware, drip coffee makers, food warmers, non-stick coating, non-stick cookware, non-stick fry pans, tea kettles, brewers & accessories, thermal carafes |
| Global Pet Products, Inc.            | Pet accessories, pet apparel, pet beds, pet carriers   |
| Global Carts & Food Equipment        | N/A  |
| Global Choice, Inc.                  | N/A  |
| Global Consortium, LLC               | N/A  |
| Global Food-Partner A/S              | N/A  |
| Global Growth Group                  | N/A  |
| Global Linking Solutions             | N/A  |
| Global Micro Bio Products, LLC       | N/A  |
| Global Payments                      | N/A  |
| Global Vending, Inc.                 | N/A  |

Applicant has further obtained promotional material and packaging from third parties, summarized below, and lodged herewith as Exhibit H, which show further use of Global. See affidavit for authentication lodged herewith as Exhibit Q.

| Company                 | Goods/Services  |
|-------------------------|---|
| Global Market           | Lighting, home appliances, audio and video, IT, communications and household products |
| A & A Global Industries | Temporary tattoos   |



09/09/02  
09/09/02  
09/09/02

|                  |   |
|------------------|---|
| Global Sources   | Premium, gifts and housewares   |
| SKF Global, Inc. | Premier Bath products, including mesh sponges and shower curtain hooks; extension cords; nightlight bulbs; and paintbrushes |

Applicant also encloses the additional search results performed on the USPTO's website. The pages, lodged herewith as Exhibit I, show there are 3133 pending or registered marks which incorporate the term Global. Additionally, lodged herewith as Exhibit J, are printouts from the electronic database "white pages.com" which indicates there are thousands of listings for companies with the term "Global".

The registrations, applications and third party usages all demonstrate the weakness of Global. Global is clearly used laudatorily and descriptively to connote expansive, worldly, wide ranging, and/or powerful. In addition to the above referenced documents, See also Webster's Dictionary definitions lodged herewith as Exhibit K; See further Opposer's own catalogue lodged herewith as Exhibit N. For example, Global Pet Products and Global Pottery both use "Global" to connote expansive. With regards to pet products, it connotes the products' ability to expand the opportunities to travel with a pet on a plane, in a car, in the rain. With regards to pottery, it connotes the breadth of pottery styles.

The above described evidence also shows Global has been widely adopted and used. Further, the evidence shows Global is in use by third parties on similar goods. Registration 2,486,406 for Global is for use in connection with utility knives. Also, the company, Global Marketing Corporation sells cookware. See Exhibit G. Applicant itself is currently using the mark GD Global Decor, Registration No. 2653440, with kitchen utensils. This use was in fact specifically known to and tolerated by Yoshida. See Exhibit P (letter dated May 16, 2002) lodged herewith. The Board can conclude that Global is weak.



consisting of shell cracker and seafood picks; bath and shower accessories, namely shower organizer, plunger, pop-up sink plugs, tooth brush holders, soap dish and towel hangars; toilet tissue rollers.

The attached promotional materials lodged herewith as Exhibits L and M show that the marketing associated with the above goods is different from the marketing associated with Yoshida's kitchen utensil type goods. (See Exhibit N, lodged herewith). The exhibits show Decor's bath and shower accessories and furniture are sold through their own unique catalogues distinct from kitchen utensils. Applicant's barware, and egg cup holders are depicted under distinct headers and on separate pages from the kitchen utensils. Further, a look at Linen N Things website and the Bed Bath & Beyond website, (Exhibit O) shows the strong dichotomy and separateness of the markets from Yoshida's kitchen utensil market.

The strong dissimilarity between Opposer's goods and Applicant's barware, egg holder, furniture, bath accessories, soaps and lighting means no likelihood of confusion with respect to these goods. Weak marks, such as Opposer's simply cannot make a commercial impression which extends into dissimilar goods. Extending weak marks into goods not actually associated with the mark requires a purchaser to ignore the strong goods/mark association. It also requires a purchaser to associate ownership with a term which suggests a quality of the goods. See *United Foods, Inc. v. J.R. Simplot Co.*, 4 U.S.P.Q. 2d 1172, 1174; see also *Texas Dairy Queen Operators*, 1 U.S.P.Q. 2d 1804.

### **III. The Letters Form a Binding Settlement**

Applicant and Opposer's attorneys exchanged letters which form a binding agreement to settle the case. The agreement requires dismissal of the entire proceeding.

It is axiomatic that [w]hether a writing that contains all of the essential terms of a contract but contemplates a later execution of a formal agreement is itself a contract or merely negotiation depends on the intent of the parties. If the parties to the writing intend that it

09/09/03 08:11:48

be contractually binding, that intention would not be defeated by the mere recitation that a more formal agreement was yet to be drawn.

Further,

“a writing is sufficient if it allows the court to ascertain the agreement of the parties.” *Chicago Investment Corp. v. Dolins*, 93 Ill. App.3d 971, 418 N.E. 2d 59 (1<sup>st</sup> Dist. 1981). *Accord White Hen Pantry v. Rak Woo Cha*, 214 Ill. App.3d 627, 634, 574 N.E. 2d 104. The fact that some matters have been left for future agreement does not necessarily preclude a finding of enforceable contract.” *In re: Midway Airlines*, 180 B.R. 851 (Bkrcty. N.D. Ill. 1995).

Finally,

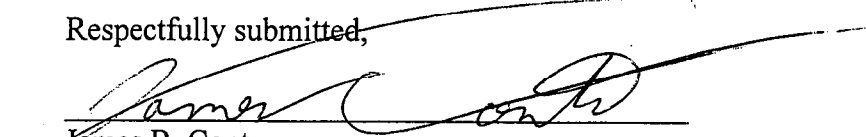
the determination of the intent of the parties may be a question of law or a question of fact, depending on the language of writing. If the language of writing is unambiguous, the construction of the writing is a question of law, and the intention of the parties must be determined solely from the language used. (Citations omitted.) *Quake Construction, Inc. v. American Airlines, Inc.*, 130 Ill. Dec. 534, 181 Ill. App.3d 908 (1<sup>st</sup> Dist. 1989).

The intention of the parties here is unambiguous and beyond dispute. It can and must be determined from the correspondence. See Exhibits C and D. The parties agreed to settle the matter: Opposer will allow the registration and Applicant will amend its description of goods and follow the other provisions of the agreement. The present proceedings are in violation of the settlement and must be dismissed.

**Conclusion**

Applicant is entitled to register the mark Global Decor. Each of the grounds stated in the Notice of Opposition have no merit. The opposition is precluded by agreement to settle. Judgment should be entered in favor of Applicant and the Board should dismiss the opposition.

8/27/03  
Date

Respectfully submitted,  
  
James B. Conte  
Barnes & Thornburg  
P. O. Box 2786  
Chicago, Illinois 60690-2786  
Telephone: (312) 357-1313

**APPENDIX I**

**MOVANT, GLOBAL DECOR'S PROPOSED UNCONTESTED FACTS FOR  
PURPOSES OF ITS SUMMARY JUDGMENT MOTION**

1. Global Decor is seeking to register, under Serial No. 76/179,674, the mark Global Decor for use with the below listed goods.

“decorative hand soaps” in International Class 003

“chopsticks and chopstick dinner sets, forks, knives and spoons, hand held chopper, and non electric can opener,” in International Class 008

“pulsating shower massage head, slip on portable hand held shower sprayer” in International Class 011

“children’s furniture; non-metal utility hooks,” in International Class 020;

“housewares in the nature of kitchen utensils, namely cookie cutters, baking pans, cheese cutters, serving spoons, serving ladles, pie servers, spatulas, draining spoons, skimming spoons, serving spoons, serving forks, wire egg cup holders, condiment bowls, pepper sauce holders, condiment steel shaker cans, stainless steel hand juicer; barware utensils, consisting of strainers, ice tongs, and condiment picks; seafood utensil sets consisting of shell cracker and seafood picks; bath and shower accessories, namely shower organizer, plunger, pop-up sink plugs, tooth brush holders, soap dish and towel hangars; toilet tissue rollers,” in International Class 021. See Exhibit B.

2. The mark Global has been and is presently adopted by numerous third parties for use in connection with a wide variety of goods and services. See Exhibits E, F, G, H, I and J.

3. The mark Global is used by numerous third parties in connection with a wide variety of goods and services. See Exhibits E-J

4. The mark Global is used by third parties on or in connection with goods identical to at least some of the goods used by Opposer in connection with the mark Global. See Id.

5. The mark Global is used by third parties on or in connection with goods which are similar to the goods Opposer uses in connection with the mark Global. See Id.

02/09/2007 11:09 AM

6. Applicant has a registration for the mark GD Global Decor, Registration No. 2653440 for use on or in connection with goods which are similar and identical to those used by Opposer in connection with Opposer's mark Global. See Exhibits E and I.

7. Opposer had knowledge of Applicant's application to register the mark GD Global Décor and Design prior to the mark maturing into Registration No. 2653440. See Exhibit P.

8. The mark Global is laudatory, descriptive or at least highly suggestive when used on or in connection with Opposer's goods. See Exhibit E-K and N.

9. The mark Global is used in commerce to connote the expansive, worldly, wide-ranging, and/or powerful nature of goods and service used in connection with the term Global. See Id.

10. The term Global is a weak source designator. See Id.

11. The term Global in combination with the term Decor used in connection with Applicant's products have the connotation of both products fitting in with anyone's style. See Exhibits K, L, M.

12. Applicant uses the mark torchlight décor with lamps, kid décor with furnishings and seasonal décor with holiday knickknacks. See Exhibit L.

13. The sight and sound of Applicant's mark is completely different from Opposer's mark. See Exhibits K, L, M.

14. The following goods listed in Applicant's application are dissimilar from the goods Opposer uses with its mark Global Décor;

pulsating shower massage head; slip on portable hand held shower sprayer; decorative hand soaps; children's furniture; non-metal utility hooks; wire egg cup holders; barware utensils, consisting of strainers, ice tongs, and condiment picks; seafood utensil sets, consisting of shell cracker and seafood picks; bath and shower accessories, namely shower organizer, plunger, pop-up sink plugs, tooth brush holders, soap dish and towel hangars; toilet tissue rollers. See Exhibits K-O.



00/00/2002TAS  
00/00/2002TAS

**APPENDIX II**

**EXHIBITS A-Q LODGED IN SUPPORT OF APPLICANT'S  
MOTION FOR SUMMARY JUDGMENT**

- A. Global Decor Application No. 76/179,674
- B. Global Decor Tess Report 76/179,674
- C. July 2, 2002 letter from Opposer
- D. July 18, 2002 letter to Opposer
- E. PTO Third Party Tess Reports for Global
- F. Web pages
- G. Directories for Housewares Show
- H. Photos of third party Global products
- I. Tess Search Reports for \*Global\*
- J. Whitepages.com for Global
- K. Webster's Dictionary definitions
- L. Kid Decor seasonal décor products
- M. Global Decor products
- N. Toshida catalogue
- O. Linen N Things, Bed Bath & Beyond websites
- P. May 16, 2002 letter from Opposer's attorney
- Q. Declaration in support of motions



00/00/2003TTAV

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing Applicant's Motion for Summary Judgment and Exhibits A-Q Lodged Herewith has been served on the below-named attorneys, via U.S. mail, by depositing same in the U.S. mail chute at One North Wacker Drive, Chicago, Illinois 60606, with proper postage prepaid, on or before 5:00 p.m.

Jeffrey H. Kaufman, Esq.  
Amy C. Sullivan, Esq.  
Oblon, Spivak, McClelland, Maier & Neustadt, P.C.  
1940 Duke Street  
Alexandria, Virginia 22314

**CERTIFICATE OF MAILING**

I hereby certify that the correspondence is being Deposited with the United States Postal Service as first class mail in an envelope with sufficient postage addressed to:

TTAB  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

on the date indicated below:

on this 27 day of August, 2003.

  
\_\_\_\_\_  
Rose Ranegar