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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

New York State Department of Economic Development fka The
New York State Department of Commerce

v.

I Love Santa Barbara, Inc.

Opposition No. 91165648
to application Serial No. 78364580
filed on February 9, 2004

Lawrence V. Molinar of CMG Worldwide, Inc. for The New York
State Department of Economic Development fka The New York
State Department of Commerce.

Jeffrey Furr for I Love Santa Barbara, Inc.

Before Quinn, Holtzman and Taylor, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

I Love Santa Barbara, Inc. filed an application to
register the mark shown below

I ♥ SB

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for services identified as "promoting Santa Barbara, California as a place to live and visit and the economic development thereof" in International Class 35.¹

The New York State Department of Economic Development opposed registration, alleging that since 1977 opposer and its predecessors have engaged in a program to promote travel and tourism in the state of New York; that since 1977 it has been engaged in the sale and distribution of a wide spectrum of goods and services under its I♥NY marks; that I♥NY marks have become synonymous with the state of New York and its various attractions, commercial markets and entertainment venues; that opposer owns registrations of various I♥NY marks for a variety of goods and services, including printed and paper products, apparel, jewelry, toys, advertising and multimedia; that opposer's marks are famous; and that applicant's mark is likely to cause confusion or mistake or to confuse the public into believing that applicant's goods are associated with opposer, in violation of Section 2(d) of the Trademark Act.²

¹ Application Serial No. 78364580, filed on February 9, 2004, alleging March 1, 2002 as the date of first use anywhere and in commerce.

² Opposer also asserted that registration of applicant's I♥SB mark would likely dilute the distinctive quality of opposer's I♥NY marks, in violation of Section 43(c) of the Trademark Act. However, opposer never discussed this ground in its brief, and, moreover, it identified likelihood of confusion as the only issue in the case. (Brief, p. 13). Accordingly, we consider the dilution claim to have been waived.

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In its answer to the notice of opposition, applicant "does not deny" that opposer "obtained" its pleaded registrations, but applicant goes on to essentially deny the validity of several of the registrations by indicting that they are either expired or canceled. (Paragraph 5). In addition, applicant "does not deny" that opposer's registrations are *prima facie* evidence of the validity of the registered marks and of opposer's exclusive right to use I♥NY in commerce in connection with the goods and services listed in the registrations. (Paragraph 6). Applicant denied the other salient allegations of the notice of opposition. Applicant also pleaded certain affirmative defenses, and further set forth allegations that serve to amplify its denials.

The Record

There are numerous critical problems with the record sought to be introduced by opposer. Opposer did not take any testimony, but rather sought to make of record, essentially by notice of reliance, a number of exhibits. We note, however, that almost all of these exhibits are not appropriate for introduction under a notice of reliance.³

³ These evidentiary problems are virtually identical to the ones the Board encountered in Opposition No. 91162024, *The New York State Department of Economic Development v. Michael Nnamdi Stewart* (final decision dated March 13, 2007). In that decision, the Board stated that the evidentiary matters were reminiscent of the ones in *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400 (TTAB 1998), wherein the opposer also attempted to submit,

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In this connection, applicant, in its brief, objected to several of the exhibits on a variety of grounds. (Brief, pp. 2-4).

In order to determine what constitutes the record upon which we must decide this case, we will examine the parties' notices of reliance.

Opposer has submitted printouts from various websites. Webpages may not be made of record, however, by notice of reliance. As the Board stated in *Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1302 n.3 (TTAB 2004):

Internet evidence is not proper subject matter for introduction by notice of reliance because the evidence is not self-authenticating. As the Board has stated in the past, the element of self-authentication cannot be presumed to be capable of being satisfied by information obtained and printed out from the Internet. *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368, 1370 (TTAB 1998). See also TBMP §704.08 (2d ed. rev. 1 March 2004).

Accordingly, Exhibits A, C, D, CC, EE, FF, UU and VV, and the copy of the Kwigy-Bo website that is part of Exhibit Q are not properly of record, and have not been considered.

Opposer has submitted "soft" copies of its pleaded trademark registrations. Trademark Rule 2.122(d) provides

by notice of reliance, declarations of the opposer's officer and photocopies of goods on which the opposer's marks appeared. The Board found that those exhibits were not properly made of record by opposer's notice of reliance, and they were not considered.

the manner in which an opposer may properly make its registration(s) of record:

- (1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies (originals or photocopies) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. For the cost of a copy of a registration showing status and title, see §2.6(b)(4).
- (2) A registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification during the taking of testimony or by filing a notice of reliance, which shall be accompanied by a copy (original or photocopy) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. The notice of reliance shall be filed during the testimony period of the party that files the notice.

Further, the Board's June 30, 2006 decision denying opposer's motion for summary judgment indicated that "opposer did not submit sufficient evidence of its ownership of its pleaded registrations," specifically noting that opposer did not submit status and title copies of its registrations, and referring opposer to Trademark Rule 2.122(d)(1) and TBMP §528.05(d) (2d ed. rev. 2004). The

Board thus found that priority of use remained an issue for trial. The registrations submitted by opposer during its testimony period are not copies prepared by the Office showing current status of and current title to the registrations.⁴ Accordingly, opposer's registrations are not properly of record. Exhibits MM, NN, OO, PP, QQ, RR, SS and TT have not been considered.

Opposer submitted the declarations of Thomas Regan and Danielle Luhmann; these declarations were also submitted in connection with its motion for summary judgment. Evidence submitted with a motion for summary judgment is of record only for purposes of that motion. Thus, to be part of the evidentiary record to be considered at final hearing, the evidence must be properly introduced in evidence during the appropriate testimony period. TBMP §528.05(a) (2d ed. rev. 2004). Further, Trademark Rule 2.123(b) provides, in part, that "[b]y written agreement of the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses."

⁴ The Board's new rules allow proof of a pleaded registration by submission of a "current printout of information from the electronic database records of the USPTO showing the current status and title of the registration" as an alternative to submission of a status and title copy of the registration. See Trademark Rule 2.122(d) (effective August 31, 2007, by Final Rule Notice, 72 Fed. Reg. 42242 (August 1, 2007)). However, the rule, as now amended, applies only to cases filed on or after the effective date of August 31, 2007, and it is not applicable here. Further, and in any event, the copies submitted by opposer are mere photocopies of the registrations, and are not copies retrieved from a USPTO electronic database.

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No stipulation has been submitted to allow opposer to submit the testimony of its witnesses by affidavit or declaration. Accordingly, Exhibits F and G are not properly of record, and have not been considered.

Opposer submitted several photo prints of what it asserts to be licensed products. While opposer cites to Trademark 2.122 in submitting these exhibits, there is nothing in this rule that provides for the submission of photo prints of products under a notice of reliance. As previously discussed, Trademark Rule 2.122(d)(2) concerns registrations, and Trademark Rule 2.122(e) provides for the introduction of printed publications and official records under a notice of reliance. Photo prints of products do not fall under any of these categories. See *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d at 1403-05.

Accordingly, Exhibits I, J, K, L, M, N, O, P, Q, R, S, T, U, V and DD have not been considered.

Opposer also submitted copies of license agreements for several of the products shown in the above-mentioned exhibits. Because these agreements are not printed publications or official records, they cannot be made of record by a notice of reliance. Accordingly, Supplemental Exhibits K, L, M, N, O, P, Q, R, S, T, U, V, W, X and Y have not been considered.

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Similarly, the photo prints of a storyboard for a television commercial, and the photo prints of "image captures" and artwork attributable to the production of two motion pictures and a television program, are not proper subject matter for introduction by way of a notice of reliance. Accordingly, Exhibits GG, HH, II and JJ have not been considered.

Opposer also submitted copies of license agreements related to the uses in the above media. As indicated above, because license agreements are neither printed publications nor official records, they cannot be made of record by a notice of reliance. Accordingly, Supplemental Exhibits Z, AA, BB and CC have not been considered.

The fact that opposer has accompanied its notice of reliance with counsel's affidavit is of no moment. Mr. Molinar affirms in his affidavit "the authenticity of the photo prints submitted as true and accurate images of said specimens, as well as the existence of agreements." Firstly, the affidavit in itself is inappropriate inasmuch as the parties did not agree thereto. See Trademark Rule 2.123(b). Secondly, as indicated earlier, the photo prints and license agreements are not proper subject matter for introduction by way of notice of reliance, and Mr. Molinar's affidavit does not cure opposer's failure to follow the

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proper procedures for making this evidence of record in a Board proceeding.

Exhibit H, opposer's listing of advertising expenditures, and Exhibit WW, copies of written communications between the parties' attorneys, cannot be made of record by a notice of reliance, and these exhibits have not been considered.

Opposer also has submitted with its notice of reliance copies of catalogs that appear to be catalogs of some of its licensees or sub licensees. However, because there is no evidence that these catalogs are available to the general public in libraries or of general circulation among members of the public, they cannot be treated as printed publications. See *Daggett & Ramsdell, Inc. v. Procter & Gamble Co.*, 275 F.2d 955, 125 USPQ 236 (CCPA 1960) [finding that Fuller Brush catalogs should not be admitted into evidence by notice of reliance]. The assumption that printed publications, such as books and periodicals, may be submitted by notice of reliance is that a party is or may readily become familiar with printed matter in libraries open to the public or in general circulation. *Glamorene Products Corp. v. Earl Grissmer Co., Inc.*, 203 USPQ 1090 (TTAB 1979). See also *Wagner Electric Corp. v. Raygo Wagner, Inc.*, 192 USPQ 33, 36 n.10 (TTAB 1976) ["Applicant's objections to opposer's catalogs and house publications are

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well taken because it has not been shown that they are 'available to the general public in libraries or of general circulation'"); and *Standard Pressed Steel Co. v. Midwest Chrome Process Co.*, 183 USPQ 758, 760 n.2 (TTAB 1974)

[Brochures and price lists distributed by third parties do not constitute printed publications, such as books and periodicals, available to the general public in libraries or of general circulation]. Accordingly, Exhibits W, X, Y, Z, AA and BB are not properly of record, and have not been considered.

There are a few exhibits that opposer submitted under notice of reliance that are properly of record. They are Exhibit B, excerpts from a book; Exhibit E, a newspaper article; and Exhibit KK, applicant's responses to opposer's interrogatories. Opposer also attempted to introduce applicant's responses to opposer's request for production of documents, Exhibit LL. Trademark Rule 2.120(j)(3)ii) provides, however, that "[a] party which has obtained documents from another party under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of §2.122(e)." The produced documents are not admissible by notice of reliance. Accordingly, Exhibit LL

is not properly of record, and these documents have not been considered.

Applicant, for its part, did not take testimony or introduce any other evidence. Applicant did, however, attach to its brief notices of reliance accompanied by exhibits. There are problems with applicant's evidentiary submissions as well.

The overriding problem with applicant's submission is its untimeliness. A notice of reliance must be filed during the offerer's testimony period; applicant failed to take this action during the appropriate time period. See TBMP §704.02 (2d ed. rev. 2004). Further, exhibits attached to a brief can be given no consideration unless they were properly made of record during the time for taking testimony. See TBMP §704.05(b) (2d ed. rev. 2004). Accordingly, none of the exhibits accompanying applicant's brief have been considered in reaching our decision.

In addition to opposer's Exhibits B, E and KK, the record includes the pleadings and the file of the opposed application. Both parties have filed briefs.

Facts

As is readily apparent from the above rulings, there is very little factual information that is properly of record about the parties. With respect to opposer and its activities, the book and newspaper article (Exhibits B and

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E), the only documents of record that contain any information about opposer, cannot be used to prove the truth of the statements made therein.

With respect to applicant and its activities, we have only the interrogatory answers that it provided to opposer. Applicant was incorporated in 2002, and since that time "has been actively developing the core business of PhotoTours, Inc. which has been designed to promote the sale of real estate and tourism in and around Santa Barbara, California, using both online and print outlets." (No. 1). Applicant states that it "is currently using [its mark] online and intends to use [its mark] in connection with various tangible goods once it has been registered," and that "[w]hile there are prototypes of such goods and services and the actual use of [its mark] online, to date there has been no actual offer of sale of these goods or services bearing applicant's mark." (No. 3). Further, applicant states that the trade channels for its products are "print media and Internet" (No. 8), and that its customers are "local businesses, real estate brokers and agents; and tourists and real estate consumers from a global audience" (No. 9).

Standing

A threshold requirement to bring an opposition proceeding is that the plaintiff must establish its standing. *See Ritchie v. Simpson*, 170 F.3d 1902, 50 USPQ2d

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1023 (Fed. Cir. 1999). We find that opposer has failed to do so in this case.

We note applicant's statements, in its answer, that it "does not deny" that opposer obtained certain registrations (Paragraph 5), and that opposer's registrations are *prima facie* evidence of the validity of the registered marks and of opposer's exclusive right to use I♥NY in commerce in connection with the goods and services listed in the registrations (Paragraph 6). We find, however, that the answer did not relieve opposer of its burden of proof relative to standing. There is no clear admission by applicant and, in fact, applicant went on in the next sentence of its answer to point out that several specific registrations were canceled.

Opposer has the burden to prove its standing. Opposer failed to meet this burden because it did not make its evidence properly of record. It is very apparent that opposer itself did not consider applicant's answer as an admission of any aspect of opposer's case, including standing or priority. Thus, opposer did not rely on any perceived "admissions" made by applicant in its answer such that opposer believed it had no need to file evidence to prove its standing. Further, opposer, in its brief, relied upon its improperly submitted evidence rather than on any perceived admissions by applicant. Thus, opposer was not

under a mistaken belief that it did not need to file evidence to prove its standing. And, indeed, opposer, during its testimony period, attempted to make certain evidence of record, including its registrations. However, as discussed above, the evidence was improperly submitted and thus cannot be considered.

In sum, the record is devoid of any probative evidence to establish that opposer is more than a mere intermeddler. Accordingly, we find that opposer has failed to prove its standing. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

Priority and Likelihood of Confusion

Even assuming opposer had proven its standing, opposer has failed to establish priority. For the same reasons as set out above in finding a lack of proof regarding standing, opposer has failed to prove that it has priority.

Opposer, during its testimony, attempted to introduce evidence bearing on priority. Opposer's burden in this regard should have been clear to opposer when it received the Board's pre-trial order denying opposer's motion for summary judgment. In the order, the Board reviewed the pleadings and opposer's evidence bearing on priority. The Board found that priority remained an issue for trial because "opposer did not submit sufficient evidence of its ownership of its pleaded registrations." Thus, opposer was

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on notice that it needed to take affirmative action during its testimony period to make the registrations of record or to otherwise prove its priority. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Because opposer did not prove priority, it cannot succeed on the ground of likelihood of confusion.

Decision: The opposition is dismissed.