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

Proceeding	91171206
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 76/633,973
Published in the Official Gazette on: December 6, 2005
Filed: March 14, 2005
Applicant: Osram GmbH
Mark: OSTAR
International Class: 9
For: Light-emitting diodes; light emitting diode displays and display circuit modules; and components of the aforementioned goods, in International Class 9.

SUNBEAM PRODUCTS, INC., a Delaware corporation,

Opposer,

v.

OSRAM GMBH, a company of the Federal Republic of Germany,

Applicant.

Opposition No. 91171206

OPPOSER'S REPLY BRIEF

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I. INTRODUCTION

Osram admits Sunbeam’s first use of OSTER pre-dates its first use of OSTAR by more than **80 years**. Applicant’s Brief at 4. Osram also admits Sunbeam has introduced “mind-numbing volumes of documents” that show OSTER is well-known and the public has seen “**billions of impressions**” of the mark. *Id.* at 7. Osram admits LEDs are sold in the **same channels of trade** as OSTER products. *Id.* at 10. Nonetheless, Osram argues that because it does not **currently** sell the same products in the same channels of trade in which OSTER products are sold, no likelihood of confusion exists. The Board should reject this narrow view for three reasons.

First, evidence in the record suggests Osram has recently begun selling OSTAR LEDs in at least one retail outlet that also sells OSTER products. Perkins Deposition Ex. 30 (offer by Amazon.com to sell flashlight containing “OSRAM OSTAR LEDs”). The legal question raised by this opposition is not where Osram is using the mark OSTAR now but whether the goods claimed by Application Serial No. 76/633,973 are sold in the same channels of trade in which Sunbeam owns rights in the OSTER mark. Osram could have limited its application to seek registration of the mark for goods to be sold only in industrial channels of trade, but it did not. Regardless of whether the Board ignores or considers the obvious use of OSTAR to identify an LED being sold in consumer channels of trade, it must evaluate the potential for likelihood of confusion should Osram join the swaths of other companies selling LEDs in consumer channels of trade.

Second, the law does not require proof that the parties sell the same products to support a finding of a likelihood of confusion. In this case, there is no doubt that consumers already purchase the goods claimed by the Application in the same channels of trade in which Sunbeam owns rights in the OSTER mark. Those consumers may very well assume that goods such as LED light bulbs or LED flashlights originate from the same manufacturer as the variety of consumer goods sold under the OSTER trademark.

OPPOSER’S REPLY BRIEF - 1

1 **Third**, Sunbeam has provided a wealth of evidence that establishes the strength of the
2 OSTER mark, which is sufficient to support a finding that OSTER has become famous. That
3 fame makes it very likely that consumers will be confused as to the origin of OSTAR-branded
4 LEDs.

5 II. ARGUMENT

6 A. Sunbeam Has Prior Rights in the Mark OSTER.

7 Osram *admits* it began using OSTAR in United States commerce no earlier than July
8 22, 2005, more than **80 years** before Sunbeam's first use of OSTER. Applicant's Brief at 4.
9 Thus, there cannot be any doubt that Sunbeam has priority.¹

10 B. Osram Seeks Registration of OSTAR in the Same Channels of Trade in 11 Which Sunbeam Owns Rights in the Mark OSTER.

12 Sunbeam has provided ample evidence that the same retail outlets that sell OSTER
13 products sell LEDs. *See, e.g.*, Perkins Deposition Exs. 30, 31, 34, 35, 37-40.² Sunbeam also
14 introduced evidence that OSTAR LEDs are being sold by at least one retailer that sells
15 OSTER-branded products. Perkins Deposition Ex. 30. Osram does not attack this evidence
16 directly, but instead claims (without any supporting evidence) that it only sells OSTAR-
17 branded products at trade fairs and through electronics distributors. *See* Applicant's Brief at
18 10.³ Even if the Board accepts this representation as true, where Osram *currently* sells its

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20 ¹ Applicant's citations to its foreign registrations, Applicant's Brief at 4, 6, are "not evidence of the use,
21 registrability, or ownership of the subject mark in the United States." TBMP § 704.03(b)(1)(A). *See also*
Hitachi Metals Int'l, Ltd. v. Yamakyu Chain Kabushiki Kaisha, 209 U.S.P.Q. 1057, 1059 (TTAB 1981).

22 ² Although Osram objected to the Perkins deposition as improper rebuttal testimony, as counsel for
23 Sunbeam noted, Ms. Perkins's testimony rebutted testimony by Osram's witness, Ludwig Wildmoser, about the
24 channels of trade in which LEDs are sold. *See, e.g.*, Wildmoser Deposition Transcript at 17:13-24. In any event,
25 Ms. Perkins merely authenticated nearly identical documents on which Mr. Wildmoser was cross-examined. *See*
id. at 18:12-55:15, Exs. 20-25.

26 ³ This and numerous other statements by Osram have no evidentiary support. "Evidence not obtained
27 and filed in compliance with [the rules] will not be considered." 37 C.F.R. § 2.123(1). Accordingly, Sunbeam
asks the Board to disregard the following statements which are not supported by any evidence in the record:
Opposer is "best known for small motorized appliances in 4 niches: (1) blenders, (2) toasters, (3) hair-dryers and
(4) pet shears & clippers." Applicant's Brief at 3; "The term 'lamp' according to industry terminology means
light source itself, not the supporting fixture. Unlike older lighting products, LEDs do not need to be surrounded
by a glass envelope or bulb, and therefore are generally not made in a bulb shape." *id.* at 3-4; "OSRAM's

1 goods is irrelevant. The Board must evaluate “the identification of goods set forth in the
2 application regardless of what the record may reveal as to the particular nature of an
3 applicant’s goods, the particular channels of trade or the class of purchasers to which sales of
4 the goods are directed.” *Octocom Sys., Inc. v. Houston Computer Servs., Inc.*, 918 F.2d 937,
5 16 U.S.P.Q.2d 1783, 1787 (Fed. Cir. 1990) (collecting cases). Osram seeks registration of
6 OSTAR in all channels of trade, not just those in which it currently sells LEDs. Even if
7 Osram’s presence in the retail market is small now, it may expand and join the numerous
8 manufacturers, including Osram Sylvania, who already sell LEDs in retail channels of trade.
9 This result is very likely to confuse consumers as to the origin of OSTAR-branded products.

10 Osram also mistakenly contends that the parties’ goods must be the same or
11 competitive for a likelihood of confusion to exist, arguing that no one would “mistake an LED
12 for a motorized appliance or a cooking pot,” that “OSTER is not registered for any lighting
13 products,” and pointing out at length the physical characteristics of LEDs that distinguish
14 them from other goods. Applicant’s Brief at 4, 7, 8, 10. This ignores well-established case
15 law that explicitly rejects any required direct competition, and instead requires only that the
16 circumstances surrounding marketing of the parties’ goods be such that they would create a
17 likelihood of confusion among consumers. *See, e.g., In re Martin’s Famous Pastry Shoppe,*
18 *Inc.*, 748 F.2d 1565, 223 U.S.P.Q. 1289, 1290 (Fed. Cir. 1984). Here, consumers are likely to
19 encounter Sunbeam’s products in the same retail outlets where they find LEDs, creating a
20 high likelihood that they will assume that LEDs bearing the OSTAR mark originate with
21 Sunbeam. Thus, this is not like the maker of SMART cars arguing “it is identified in the
22 public mind with the mark SMART for screws.” Applicant’s Brief at 9. Consumers do not

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25 OSTAR purchasers are predominantly male industrial managers.” *id.*; “OSTAR buying decisions typically are
26 made based upon technical requirements, cost, and delivery timeframes.” *id.*; “OSTAR sales are predominantly
27 made at trade fairs, or via electronics distributors such as Digi-Key Corporation.” *id.*; and all of the statements in
the section “PLAINTIFF MISUNDERSTANDS THE NATURE OF APPLICANT OSRAM’S GOODS.” *Id.* at
10-11.

1 encounter screws and cars in the same places. By contrast, consumers do encounter LEDs
2 and OSTER products in the same channels of trade both online and in stores.

3 Just as the parties' goods need not be the same or identical to cause confusion, they
4 also need not fall within the same international class. Applicant's Brief at 8. The Board has
5 rejected this "mistaken ... belief," noting that "[t]he classification system was established for
6 the convenience of the Office rather than to indicate that goods in the same class are
7 necessarily related or that classification in different classes indicates that they are not related."
8 *Nat'l Football League v. Jasper Alliance Corp.*, 16 U.S.P.Q.2d 1212, 1216 n.5 (TTAB 1990)
9 (citation omitted). *See also Malarkey-Taylor Assocs., Inc. v. Cellular Telecom. Indus. Ass'n*,
10 929 F. Supp. 473, 476, 40 U.S.P.Q.2d 1136, 1138 (D.D.C. 1996) ("The class to which a
11 product may be assigned does not limit or extend the registrant's rights and has no bearing on
12 likelihood of confusion."). Nonetheless, Sunbeam does own registrations for OSTER in Class
13 9. *See* Opposer's Notice of Reliance, Exs. 13, 16.

14 Finally, no case requires that the purchasers of the parties' goods be the same gender.
15 *See* Applicant's Brief at 9. As an initial matter, Osram did not submit any evidence to support
16 its claim that OSTAR products are sold to "male industrial managers." In fact, Osram's sole
17 witness refused to testify "what percentage of customers for the OSTAR product are typically
18 male versus female." Wildmoser Deposition Transcript at 16:21-23. Setting aside the
19 evidentiary issue, this argument requires the incredible assumptions that only women buy
20 blenders, only men buy industrial products, only women use or see blenders, only men use or
21 see industrial products, and OSTAR LEDs will never be sold in retail channels of trade. The
22 argument also ignores the vast evidence (which is not gender-specific) showing consumers
23 widely recognize the OSTER mark.

24 **C. The OSTER Mark is Strong.**

25 In an effort to argue that protection for the OSTER mark extends only to certain
26 products, Osram makes unsupported factual assertions and misstates the relevant legal
27 standard to determine fame. Applicant's Brief at 6-7. As Sunbeam has already shown, the

1 recognition and protection afforded the OSTER mark reach beyond the individual products
2 with which the mark has been used and encompass the channels of trade in which the mark is
3 used. Moreover, the standard for fame under *DuPont* did not change, even after the 2006
4 enactment of the Trademark Dilution Revision Act (“TDRA”).

5 To find a mark is famous under the *DuPont* factors, courts do not, as Applicant
6 implies, require direct evidence of fame. *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d
7 1367, 1371 (Fed. Cir. 2002). Instead, fame “may be measured indirectly, among other things,
8 by the volume of sales and advertising expenditures of the goods traveling under the mark,
9 and by the length of time those indicia of commercial awareness have been evident.” *Id.* For
10 example, in *Bose Corp.*, the Federal Circuit found that the mark ACCOUSTIC WAVE was
11 famous where Bose provided evidence showing 17 years of continuous use, more than \$50
12 million in annual sales, total sales of 850,000 units, and \$5 million annually to advertise the
13 covered products. *Id.* at 1372. Similarly, in *Specialty Brands, Inc. v. Coffee Bean Distribs.,*
14 *Inc.*, the court found that SPICE ISLANDS was famous where the opposer had used the mark
15 for more than 40 years, sold \$37 million annually in SPICE ISLANDS goods, and spent
16 substantial sums on advertising. 748 F.2d 669, 674 (Fed. Cir. 1984). *See also Estee Lauder,*
17 *Inc. v. Cinnabar 2000 Haircutters, Inc.*, 218 U.S.P.Q. 191, 192 (S.D.N.Y.), *aff’d*, 714 F.2d
18 112 (2d Cir. 1982) (advertising expenditures of more than \$1.5 million and sales of more than
19 \$40 million).⁴

20 Here, Sunbeam has offered comparable evidence and more to show OSTER is famous.
21 Sunbeam and its predecessors-in-interest have used the OSTER mark for more than **80 years**;
22 and from 2000 to 2010 alone, Sunbeam spent more than **\$160 million** advertising OSTER-

24 ⁴ Although Applicant argues the TDRA “rewrote” the definition of “famous,” Applicant’s Brief at 7, it
25 did so only for purposes of the anti-dilution statute. “Fame for likelihood of confusion and dilution is not the
26 same. Fame for dilution requires a more stringent showing.” *Lacoste Alligator S.A. v. Maxoly, Inc.*, 91
27 U.S.P.Q.2d 1594, 1597 n.8 (TTAB 2009). Even so, Osram has failed to explain why Opposer’s trademark is not
famous under the TDRA, which requires consideration of similar factors. *See* 15 U.S.C. § 1125(c)(2)(A).
Rather than explain why Sunbeam has failed to meet its burden on its dilution claim, Osram merely recites the
elements of the claim and asserts Sunbeam has not met them. Applicant’s Brief at 11.

1 branded products, of which it sold more than **103 million** for **\$2.14 billion** in revenue. *See*
2 Gonzalez Deposition Ex. 18 at SUNBEAM003962-74; Ex. 11 at SUNBEAM003975.
3 Sunbeam products appear in nearly every American home. Not only do OSTER products
4 account for 34.68 percent of the total blender market, but they also comprise 26.6 percent of
5 the toaster market. *See* Gonzales Deposition Ex. 18 at SUNBEAM004023. About 89 percent
6 of American households have blenders. No evidence in the record shows the percent of
7 American households that have toasters, but a vast majority undoubtedly do have a toaster.
8 This means that nearly all Americans have seen, used, or owned an OSTER product.

9 OSTER is not well-known only for blenders, toasters, hairdryers, and pet grooming
10 tools, as Osram asserts (again, without any support in the record). *See* Applicant's Brief at 3,
11 7. Instead, the OSTER mark appears on a wide range of kitchen products, including tea
12 makers, kettles, wine openers, bread makers, can openers, deep fryers, electric knives, electric
13 skillets, food processors, steamers, waffle makers, warming trays, and fondue pots; personal
14 care items, including electric trimmers, shears, combs, and shampoo capes; and a variety of
15 pet grooming tools. *See* Gonzalez Deposition Ex. 14.

16 Osram asserts that a famous mark is only famous for the particular products sold in
17 association with that mark. Applicant's Brief at 5-6. A finding of fame is not so trivial.
18 "When an opposer's trademark is a strong, famous mark, it can never be of little
19 consequence." *Specialty Brands, Inc.*, 748 F.2d at 674. Fame "plays a dominant role in the
20 process of balancing the *DuPont* factors" because "famous marks are more likely to be
21 remembered and associated in the public mind than a weaker mark, and are thus more
22 attractive as targets for would-be copyists." *Bose Corp.*, 293 F.3d at 1371. Thus, someone is
23 more likely to believe that a product bearing the mark MCDONALD'S originates with the
24 hamburger giant even if the product is not a hamburger. Here, too, consumers widely
25 associate OSTER with a variety of consumer products, so much so that they are more likely to
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1 falsely assume that goods bearing the mark OSTAR—particularly when sold in the same
2 channels of trade as OSTER products—originate with Sunbeam.⁵

3 **D. The Marks Are Nearly Identical.**

4 Finally, Osram attempts to argue the marks are not similar, but in doing so relies on
5 two fundamentally flawed arguments. *First*, Osram contends the marks differ because “many
6 of the pleaded OSTER registrations are in stylized forms.” Applicant’s Brief at 8. This
7 ignores the fact that Sunbeam has broad rights to use OSTER in a non-stylized form, as
8 evidenced by the *eighteen* registrations for the typed mark OSTER. *See* Opposer’s Notice of
9 Reliance, Exs. 2, 3-5, 8, 10-17. *Second*, Osram claims that OSTER and OSTAR are
10 pronounced differently. The Board has in numerous instances found that marks with slight
11 differences in pronunciation do not create material dissimilarities between marks. *See Nupro*
12 *Co. v. Nypro Inc.*, 221 U.S.P.Q. 693, 695 (D. Mass. 1983) (declaring it “obvious” that
13 NUPRO and NYPRO were similar, “differing by only one letter”); *E.I. du Pont de Nemours*
14 *and Co. v. Sunlyra Int’l Inc.*, 35 U.S.P.Q.2d 1787, 1789 (TTAB 1995) (LYRA and LYCRA
15 were similar; “even when ‘properly’ pronounced, the two marks are, at a minimum, similar in
16 sound”); *Aveda Corp. v. Evita Mktg., Inc.*, 706 F. Supp. 1419, 1423 (D. Minn. 1989)
17 (AVEDA and AVITA were similar). There can be no doubt that OSTER and OSTAR—
18 varying by just one letter—are confusingly similar.

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26 ⁵ Osram makes much of the fact that OSTER originated as a surname. Applicant’s Brief at 5, 8. But it
27 cites to no cases that distinguish between surnames and other marks for purposes of analyzing fame. That makes
good sense. Some of the most famous trademarks—including the likes of MCDONALD’S, ARMANI,
CHANEL, and LACOSTE—are surnames and no weaker as a result.

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III. SUMMARY AND CONCLUSION

Based on the foregoing arguments and the evidence and arguments previously submitted, Sunbeam respectfully requests the Board enter judgment in its favor and deny registration of the mark OSTAR as requested by Application Serial No. 76/633,973.

Dated this 20th day of June, 2011.

DAVIS WRIGHT TREMAINE LLP

s/Cindy L. Caditz
Cindy L. Caditz
Attorney for Opposer

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CERTIFICATE OF FILING

I hereby certify that this OPPOSER’S REPLY BRIEF is being filed in Opposition No. 91171206 with the Trademark Trial and Appeal Board using the ESTTA filing system of the U.S. Patent and Trademark Office on the below date.

Date: June 20, 2011 s/Cindy L. Caditz

CERTIFICATE OF SERVICE

I hereby certify that this OPPOSER’S REPLY BRIEF is being duly served upon the Attorney of Record for Applicant by mailing a copy thereof via the U.S. Postal Service in a sealed envelope via First Class Mail with postage thereupon fully prepaid and addressed to:

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Date: June 20, 2011 s/Ron Rutherford