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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Wendy L. Reed
v.
ML Bonnell, Inc.

Opposition No. 91171282
to application Serial No. 78634920

Wendy L. Reed, pro se.

Remy J. VanOphem of VanOphem & VanOphem, P.C. for ML Bonnell, Inc.[1]

Before Bucher, Drost, and Cataldo, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On May 23, 2005, ML Bonnell Inc. (applicant) applied to register the mark SUGAR BUZZ in standard character form on the Principal Register for "entertainment services, namely, conducting children's birthday parties" in Class 41. The application (Serial No. 78634920) was based on applicant's allegation of a bona fide intent to use the mark in commerce.

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[1] Applicant did not file a brief in this case.

07-24-2008

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #72

Opposer, Wendy L. Reed, filed a notice of opposition to the registration of applicant's mark on June 7, 2006. In her notice of opposition (p. 1), opposer alleges that she "is the owner of Application Serial No. 78/637318 for the mark SUGAR BUZZ" in standard character form for the goods and services identified as follows and currently classified in Class 9:

> Prerecorded audio and video tapes and/or digital featuring children's music and performances of interest to children; Newsletters for subjects of interest to children; "Party in the box"-- party hats, paper goods (napkins, plates, cups, tablecloths), party games, party streamers, party decorations (props, balloons, table decorations, balloon weights, stickers, thematic awards, trophies and prizes, thematic trinkets and paperwork), party bags, party cards, party invitations, picture frames, disposable cameras, paper party ornaments and any party favors or promotional items imprinted with the trademark; Goodie "Bags" in the form of paper bags, boxes, trunks, cloth bags, buckets; Picture frames; Mascots, puppets and other characters; Adult and children's clothing and accessories, namely jewelry, handbags, backpacks, wigs, make-up cases, uniforms, sweatshirts, sweatpants, pants, socks, hats, shirts, jackets, T-shirts, aprons, costumes, shoes and shorts; Entertainment and amusement services, at various locations of the client's choosing, in the nature of theme parties, indoor games, imaginative play and crafts, music, dance, face painting, yoga, outdoor games; event planning, consultation and facilitation; Nurseries and day care centers; Café restaurants with Internet access; Retail establishment specializing in parties and goods of interest to children and parents.

Opposer also alleges that applicant's "filing date is long after Opposer's date of first use of its SUGAR BUZZ mark and just two days after Opposer filed its application… The registration of Applicant's mark is inconsistent with

Opposer's prior rights in the SUGAR BUZZ mark." Notice of Opposition at 3.

Finally, opposer alleges that applicant's "SUGAR BUZZ mark is identical to Opposer's prior used SUGAR BUZZ mark and is identical in sound, meaning, appearance and commercial impression to Opposer's mark. In addition, Applicant seeks to register its mark for services identical to or nearly identical to the services long provided by Opposer under its mark." Notice of Opposition at 5.

Applicant denied the salient allegations of the notice of opposition.

The Record

The record includes the file of the involved application and the testimony deposition of opposer with accompanying exhibits; the testimony deposition of Pam Weaver, opposer's business partner, with accompanying exhibits; opposer's two notices of reliance; and applicant's notice of reliance.

Opposer has filed an opening brief, but applicant has not submitted a brief. It did file a paper that advised the board "that it has chosen not to file a brief in this matter. In view of the Opposer's failure to prove interstate commerce use by clear and convincing evidence, the Applic[ant] will rely on the record as submitted." Paper dated April 11, 2008.

Priority

Priority is the key issue in this case.[2] We begin by addressing applicant's statement in its paper dated April 11, 2008, that opposer has failed "to prove interstate commerce use by clear and convincing evidence." Applicant is incorrect on two points. While an applicant normally must show that it has used the mark in commerce before it is entitled to registration, an opposer does not need to show use in interstate commerce before it can establish priority.

> In the proceedings below, the Board based its analysis on the assumption that an "opposer's claim of prior use can succeed only if it has proved use of its marks in connection with services rendered in commerce lawfully regulated by Congress, as required under Section 45 of the Trademark Act, 15 U.S.C. §1127." Such an assumption was unwarranted, however, in light of the plain language of the statute, which merely requires the prior mark to have been "used in the United States by another." 15 U.S.C. §1052(d).

First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc., 476 F.3d 867, 81 USPQ2d 1375, 1378 (Fed. Cir. 2007) (citation omitted). *See also Bourns, Inc. v. International Resistance Co.*, 341 F.2d 146, 144 USPQ 424, 425 (CCPA 1965) ("It is not necessary under 15 U.S.C. 1063 for an opposer to aver and prove use of the mark in

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[2] Inasmuch as "opposer has asserted a non-frivolous likelihood of confusion claim, we find that opposer has established its standing to oppose registration of applicant's" mark. *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 (TTAB 2004).

interstate commerce") and *Flatley v. Trump*, 11 USPQ2d 1284, 1287-90 (TTAB 1989):

> it is well established that a plaintiff in a proceeding such as this need not establish prior use of a designation in a technical trademark or service mark manner in order to prevail when the proceeding is based on the ground of likelihood of confusion, mistake, or deception under Section 2(d) of the Act, it being sufficient for the purpose that plaintiff establish priority of use of the designation in connection with a product or service in interstate or intrastate commerce in a manner analogous to trademark or service mark use, i.e., use as a grade mark, use in advertising, use as the salient feature of a trade name, or any other manner of public use, provided that the use has resulted in the development of a trade identity, i.e., is an open and public use of such nature and extent as to create, in the mind of the relevant purchasing public, an association of the designation with the plaintiff's goods or services.

Accord National Cable Television Ass'n v. American Cinema Editors, Inc. 937 F.2d 1572, 19 USPQ2d 1424, 1429 n.4 (Fed. Cir. 1991) ("Were failure to show 'use in commerce' a bar to petitioning for cancellation of a registration, a party could never cancel a mark based solely on intrastate use. This is not the law. Section 14 requires only prior use; 'in commerce' is noticeably absent").[3]

Second, an opposer does not have to show by clear and convincing evidence that it has priority. In a case

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[3] Also, there is no evidence that the mark SUGAR BUZZ is merely descriptive so opposer does not have to establish the date its mark acquired distinctiveness. *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 45 (CCPA 1981) ("Assuming that the board properly held that BRIE NOUVEAU is merely descriptive or deceptively misdescriptive, it did not require, as it should have, that appellee prove secondary meaning before applying the §2(d) likelihood of confusion test").

involving common law rights, the Federal Circuit held that "the decision as to priority is made in accordance with the preponderance of the evidence." *Hydro-Dynamics Inc. v. George Putnam & Company Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987). *See also Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1929 (TTAB 2006) ("In order to establish priority based on common law rights, opposer's burden is to demonstrate by a preponderance of the evidence proprietary rights in TUNDRA and TUNDRA SPORT for clothing prior to June 1, 1998, the filing date of applicant's intent-to-use application").[4]

Therefore, the question is whether opposer has shown that it has used the mark in the United States before applicant by the preponderance of the evidence. We begin by examining the evidence to determine opposer's priority date. Opposer claims that she had "actual use in commerce as early as 2001." Brief at 3. To support this position, opposer has testified that:

[4] This is not a case where a party is seeking to allege an earlier date of use than the one set forth in its application. *Hydro-Dynamics*, 1 USPQ2d at 1774 ("Where an applicant seeks to prove a date earlier than the date alleged in its application, a heavier burden has been imposed on the applicant than the common law burden of preponderance of the evidence"). "When a party seeks to carry the date of first use back to a date prior to that stated in the application, the proof of an earlier date must be by clear and convincing evidence." *American Hygienic Laboratories Inc. v. Tiffany & Co.*, 12 USPQ2d 1979, 1984 (TTAB 1989). Even if the requirement was, as applicant maintains, clear and convincing, opposer's evidence would meet this standard.

> Sugar Buzz started out as a soda fountain and candy store. But over the course of the next year I found that more and more people requested the use of my shop for birthday parties, so I decided to add birthday party services. By the end of 2000 I had a toddler and was stretched too thin, so I decided to close Artzy Phartzy, focus all my energy on Sugar Buzz and formally add birthday parties.

Reed dep. at 4.

Opposer's other witness testified that:

> I've been a personal friend of the plaintiff for many years and know that she bought her Sugar Buzz shop in 1999. The shop was not originally a party place; it was a candy shop and soda fountain. But I know she started to offer parties when her son was about two which was in 2001. We talked about these things at regular social gatherings, and I would also regularly see signs in the Sugar Buzz window that said, Closed for a private party.

Weaver dep. at 4.

Opposer also submitted other evidence to support her 2001 date of first use. An article in the *Indianapolis Star* dated May 19, 2001 reports that "Offbeat Broad Ripple shop [Artzy Phartzy] planning to close its doors." The article goes on to explain:

> "I feel like Artzy Phartzy is a real Broad Street staple," Martin said, "For the village itself, it's really too bad." Still, it's a good thing for Reed, who says that the closing will give her time to focus on Cooper. And her latest endeavor - the Sugar Buzz, a homemade ice cream shop opened this month next door to Artzy Phartzy - allows Reed to mix her business with motherhood. In addition to selling the frozen treats, she's offering a party service for children's birthdays and other special occasions.

Notice of Reliance dated June 28, 2007.

Other articles also refer to the SUGAR BUZZ services in 2002. Notice of Reliance dated June 28, 2007.

> The main attraction of Sugar Buzz are the all-inclusive parties for kids, according to the 42-year old store owner.
> *Topics (North Central Edition)* July 4, 2002
>
> Sundae's has developed a name awareness said Wendy Reed, owner of Sugar Buzz, a Sundae's client that hosts children's parties in addition to running a retail shop.
> *Indianapolis Business Journal*, July 1, 2002.

Opposer also submitted SUGAR BUZZ party services advertisements in the *Indianapolis Kids' Directory* from 2001, 2003, 2004, and 2005.

The evidence of record convinces us that opposer has established a date of first use at least as early as 2001.

Now that we have determined opposer's date of first use, we turn to applicant's date of actual or constructive first use date. Inasmuch as its application was filed on May 23, 2005, it is entitled to rely on the filing date of this application as its constructive use date. *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991) ("[T]here can be no doubt but that the right to rely upon the constructive use date comes into existence with the filing of the intent-to-use application and that an intent-to-use applicant can rely upon this date in an opposition brought by a third party asserting common law rights").

In addition, applicant has submitted a notice of reliance that sets out some evidence that shows that applicant may have used its mark earlier. However, even if we considered all the evidence as admissible, none of it predates opposer's 2001 date. In addition, much of the evidence does not even mention the mark, such as Exhibits 1-3 (2004), which discuss the "bee" logo, and Exhibits 14, applicant's Articles of Incorporation dated May 22, 2002 and other corporate filings (Exhibits 15, 16, 18, and 19),[5] as well as other exhibits (Nos. 20 and 21). Others are either undated (Exhibits 6, 7, 8, 10, and 30) or the identified date is well after opposer's priority date (Exhibits 5 ("Expires May 31, 2007)," 11 (May 25, 2004), 17 (July 6, 2004), 22-28 (May 2005), 29 (June 1, 2006), and 31 (July 31, 2006)). When we consider all of applicant's evidence both individually and as a whole, it does not show that applicant has a date of first use prior to opposer's 2001 priority date.

Likelihood of Confusion

Finally, we address the likelihood of confusion issue. In these cases, we look to the relevant factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177

[5] We note that Ex. 15, a 2003 Michigan Profit Corporation Update, contains the following response under the block "Describe the general nature and the kind of business in which the corporation is engaged:" "Corp. Inactive at this time."

USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003) and *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). The Court of Customs and Patent Appeals has noted that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). Here, applicant has sought registration of the mark SUGAR BUZZ in standard character form. Opposer uses the identical words. Inasmuch as applicant's mark is depicted in standard character form, there can be no difference in the marks based on the stylization of the marks. *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983). *See also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000) ("Registrations with typed drawings are not limited to any particular rendition of the mark and, in particular, are not limited to the mark as it is used in commerce"). Therefore, the marks are legally identical.

Next, we look at applicant's services, which are entertainment services, namely, conducting children's birthday parties. The evidence shows that opposer is using

her mark on the same services of providing children's birthday parties.

When we consider that applicant and opposer are using the legally identical mark on the same services as well as all the other evidence of record, we conclude that there is a likelihood of confusion. In view of our determination that opposer has priority, she is entitled to prevail in this proceeding.

Decision: The opposition is sustained, and registration to applicant is refused.

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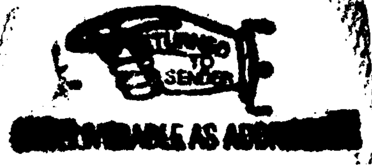

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