

THIS OPINION  
IS NOT A PRECEDENT OF  
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Mailed: 7/30/08

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Chrysler LLC  
v.  
Anthony S. Pimpo

Opposition No. 91171962  
to application Serial No. 78647106  
filed on June 9, 2005

Judy A. Powell, Theodore H. Davis, Jr., and Jonathan D.  
Goins of Kilpatrick Stockton for Chrysler LLC.<sup>1</sup>

Anthony S. Pimpo, *pro se*.

Before Quinn, Rogers and Taylor, Administrative Trademark  
Judges.

Opinion by Quinn, Administrative Trademark Judge:

Anthony S. Pimpo filed an application to register the  
mark RAMBLER for "automobiles and structural parts  
therefor."<sup>2</sup>

Chrysler LLC opposed registration under Section 2(d) of  
the Trademark Act, 15 U.S.C. §1052(d), on the ground of

<sup>1</sup> Present counsel did not make an appearance in this case until  
the briefing stage after trial.

<sup>2</sup> Application Serial No. 78647106, filed June 9, 2005, alleging a  
bona fide intention to use the mark in commerce.

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priority and likelihood of confusion. Opposer alleged that applicant's mark, as applied to applicant's goods, so resembles opposer's previously used mark RAMBLER for automobiles, and parts and accessories for automobiles, and other related merchandise, as to be likely to cause confusion. Opposer also alleged, in pertinent part, that:

From 1950 through 1969, Opposer, through its predecessors-in-interest, used the RAMBLER mark to identify and distinguish compact motor vehicles.

Upon information and belief, over 4,200,000 RAMBLER vehicles had been manufactured and sold.

Since prior to the filing date of Application Serial No. 78/647,106, Opposer has licensed, and continues to license, others to use the RAMBLER mark for parts and accessories for motor vehicles and other related merchandise.

A reservoir of goodwill in the RAMBLER trademark exists that inures to Opposer as a consequence of the large number of RAMBLER vehicles manufactured and still on the road.

A reservoir of goodwill in the RAMBLER trademark exists that inures to Opposer as evidenced by the existence of RAMBLER enthusiast clubs.

Applicant, in his answer, stated "[i]t is correct that AMC [American Motors Corporation, a predecessor of opposer] did use this mark Rambler in commerce"; "the mark's use by AMC in commerce was not limited to just 'compact' motor vehicles"; "I believe [over 4.2 million RAMBLER vehicles had been manufactured and sold] to be a true statement"; "my

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Rambler mark may be similar in appearance and sound to a long forsaken mark"; and "my mark may indeed resemble the original mark, #71597895."<sup>3</sup> Nevertheless, applicant goes on to essentially deny the allegation of likelihood of confusion because his mark "can in no way cause confusion or to mistake or deceive for [RAMBLER] has no direct association with Opposer." Applicant also alleged, in pertinent part, that:

AMC itself obviously lost interest in the use of mark #71597895 as evidenced by its lack of use of the mark in commerce since 1969, and although the purchase of the aforementioned corporation would entitle Opposer, as its new owner to legal rights in all of the company's current trademarks, Opposer displayed a clear lack of interest in mark #71597895 by not renewing the application at its time of expiration, neither pursuing it any further, therefore relinquishing rights in any such name and allowing it to be available to any interested party.

There truly may be a reservoir of goodwill and negative feelings alike in the Rambler trademark and there is truly a portion of Rambler vehicles still on the road today, however, this name has never been personally associated with Opposer in commerce, and if such goodwill existed to the Opposer, they would have concluded it valuable to them and put it into usage years ago, which

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<sup>3</sup> This is a reference to the serial number of the underlying application that subsequently matured into Reg. No. 586425 of the mark RAMBLER (stylized) for "passenger automobiles and structural parts therefor." The registration issued on March 9, 1954 to Nash-Kelvinator Corp., one of opposer's predecessors in interest. The registration expired on December 12, 1994 due to the failure to file an affidavit of continued use.

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would have included the renewing of trademark #71597895. Opposer's lack of doing such is the obvious evidence that they themselves have considered it worthless.

The record consists of the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by opposer; and an excerpt from a printed publication and portions of the discovery deposition, with corresponding exhibits, of applicant, introduced by opposer's notice of reliance.<sup>4</sup> Applicant submitted the entirety of his discovery deposition and a copy of an email to him from opposer's former counsel, together with a paper captioned "Testimony for Defendant" that reads like a brief. Although a party may not rely on its own discovery deposition (except in a very limited circumstance not present herein), and an email is not proper subject matter for introduction by a notice of reliance (moreover it includes settlement proposals), opposer, in its brief, stated, "[I]t is unclear as to whether Applicant's 'Testimony for Defendant' pleading is the equivalent of what should have been filed as Applicant's Notice of Reliance; nonetheless Opposer treats it as such given that Applicant is *pro se*." (Brief, p. 1, n. 1). Thus, we deem applicant's "testimony" to be stipulated into the record by opposer.

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<sup>4</sup> Opposer's notice of reliance on certain admissions in applicant's answer to the notice of opposition is superfluous inasmuch as the pleadings are automatically of record.

The email discussing settlement, however, has not been considered. Only opposer filed a brief at final hearing.<sup>5</sup>

The Parties

Opposer's earliest predecessor-in-interest began using the mark RAMBLER in connection with automobiles in 1900. The last year of production of automobiles under the mark RAMBLER was 1969. As admitted by applicant, opposer's predecessors-in-interest produced over 4.2 million automobiles under the mark. It is undisputed that neither opposer nor any predecessor manufactured an automobile or other motor vehicle under the mark RAMBLER after the 1969 model year.

The discovery deposition of Mr. Pimpo sheds light on his selection of the mark RAMBLER. Applicant's application originally listed "automobiles and automobile associated goods; parts and memorabilia pertaining to this specific brand." As set forth earlier, the identification of goods was later amended to "automobiles and structural parts therefor." Mr. Pimpo operates his own company that does business in the car field. Applicant's plans include a new business called "Rambler Coachbuild" and, in this connection, applicant has created computer-generated pictures of a Rambler series car. To date, however,

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<sup>5</sup> In this regard, we have considered applicant's remarks in his "Testimony for Defendant" that, as noted above, reads much like a brief at final hearing.

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applicant has not used the mark on an actual car. Mr. Pimpo acknowledged that he was aware of AMC's use of the mark back in the 1960s. Mr. Pimpo also admitted that he has seen RAMBLER cars on the road, and is aware of car clubs dedicated to RAMBLER cars. Applicant testified that he chose the mark because he thought his son would like it, and it is an "All American" sounding name. (Pimpo Discovery Dep., pp. 25-26).

Opposer asked Mr. Pimpo about his other attempts to register marks previously used by automobile manufacturers, including opposer. These marks include ASPEN (previously used by opposer) and STINGRAY (previously used by General Motors). With respect to the ASPEN mark (Pimpo Dep., p. 34, Ex. No. 4), Mr. Pimpo indicated that "the reason why we picked 'Aspen' and 'Rambler' is we thought that there's been enough time that has gone by that people would not associate our product with something in the past that wasn't necessarily very successful." (Pimpo Dep., p. 50). Mr. Pimpo went on to indicate that ASPEN was selected to suggest a connection with Aspen, Colorado--"think of people who have a desire to do things luxuriously, maybe people who have money." (Pimpo Dep., p. 61). The STINGRAY mark was selected, according to Mr. Pimpo, because one of his sons "likes the way it sounds." (Pimpo Dep., pp. 37-38, Ex. No. 5).

**Standing**

A party has standing to oppose within the meaning of Section 13 of the Trademark Act if that party can demonstrate a "real interest" in the proceeding. *Ritchie v. Simpson*, 170 F.3d 1092, 41 USPQ2d 1859 (Fed. Cir. 1996). In its pleading, opposer has alleged that it is the owner of the mark RAMBLER that it continues to license to others. Opposer introduced testimony and exhibits showing that its predecessors used the mark RAMBLER for automobiles until 1969, and that opposer presently licenses the mark RAMBLER. Thus, the record establishes that opposer has a personal interest in this proceeding beyond that of the general public and, therefore, opposer has standing.

**Priority**

In order to prevail on the ground of likelihood of confusion, opposer must also prove, by a preponderance of the evidence, that it has priority of use.

Inasmuch as applicant did not take testimony or submit any other evidence, his priority date is determined by his application. In such a situation, applicant can rely on the filing date of his involved application. In this case, the filing date is June 9, 2005. *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991). Thus, applicant's priority date is June 9, 2005.

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Insofar as opposer's priority is concerned, its Registration No. 586425 of the mark RAMBLER for automobiles and structural parts therefor expired on December 12, 1994. Because opposer is not claiming ownership of a valid and subsisting registration, it must show, by a preponderance of the evidence, that it has common law rights prior to applicant's priority date. *Hydro-Dynamics Inc. v. George Putnam & Company Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987).

Opposer's predecessors produced the RAMBLER automobile between 1900 and 1969. To state the obvious, if opposer had continuously used the mark since that time, opposer would have priority of use for automobiles. It is undisputed, however, that neither opposer nor its predecessors produced an automobile under the RAMBLER mark since the 1969 model year.

This almost forty-year period of nonuse for automobiles raises the issue of whether opposer has abandoned its mark RAMBLER. The Trademark Act specifically states that "[n]onuse for 3 consecutive years shall be prima facie evidence of abandonment." 15 U.S.C. §1127. The statutory presumption of abandonment applies equally to a registered mark and "to a party's unregistered common-law mark." *Miller Brewing Company v. Oland's Breweries [1971] Limited*, 548 F.2d 349, 192 USPQ 266, 267 (CCPA 1976). Evidence of

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nonuse of the mark for three consecutive years constitutes a *prima facie* showing of abandonment and shifts the burden to the party contesting the abandonment to produce either evidence to disprove the underlying facts showing three years of nonuse and triggering the presumption of abandonment, or evidence of an intent to resume use to disprove the presumed fact of no intent to resume use.

*Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390, 1393 (Fed. Cir. 1990); and *Rivard v.*

*Linville*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998)

["This presumption shifts the burden to the registrant to produce evidence that he either used the mark during the statutory period or intended to resume or commence use."].

Opposer has not shown that it or its predecessors ever used the mark on automobiles during the nearly forty-year period since the last RAMBLER automobile was produced. Moreover, the record is devoid of any testimony or other evidence relating to plans to resume use of the mark RAMBLER on automobiles. So as to be clear on this point, there is not a single statement or document indicating that opposer or any of its predecessors ever had an intention to resume use of the mark on automobiles; there is not even a bare assertion of possible future use on automobiles (which, in any event, would not be enough to preserve rights in a mark). "Use" of a mark means "the bona fide use of such

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mark made in the ordinary course of trade, and not made merely to reserve a right in the mark." 15 U.S.C. §1127. Merely because a party used a mark a long time ago and it could use the mark in the future is not enough to avoid abandonment. *Silverman v. CBS Inc.*, 870 F.2d 40, 9 USPQ2d 1778 (2d Cir. 1989).

Opposer contends that there is residual goodwill in the mark for automobiles, and even goes so far as to argue that "[o]pposer's extensive length of use, sales, and advertising of numerous product lines bearing the RAMBLER mark on or in connection with automobiles, accessories, structural parts and merchandise spanning over 100 years should leave little doubt that it has become a very well-known mark." (Brief, p. 16). In this connection opposer points to an earlier Board decision involving the same mark as the one at issue here. *See American Motors Corp. v. Action-Age, Inc.*, 178 USPQ 377 (TTAB 1973). In that case, the Board found that the mark RAMBLER was a very well known mark in the automotive industry, recounting the number of RAMBLER automobiles still on the road in the early 1970s, and AMC's continued sales of replacement parts. However, that decision issued thirty-five years ago, and since then neither opposer nor any predecessor used the mark RAMBLER for automobiles.

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In attempting to avoid a finding of abandonment of its mark for automobiles opposer points to the reintroduction of "heritage" brands in the automotive industry, and the existence of several car enthusiast clubs dedicated to the RAMBLER automobile.

As to the first point, to reiterate, opposer's witnesses did not testify about any plans, specific or speculative, to reintroduce the RAMBLER mark on automobiles. Moreover, the Board has recently discussed the heritage brand issue:

The fact that brands in the automobile industry are sometimes re-introduced does not exempt the industry in toto from the normal statutory presumption that trademarks can become abandoned and that trademark owners must have an intent to resume use and an explanation for any nonuse.

*General Motors Corp. v. Aristide & Co., Antiquaire de Marques*, 87 USPQ2d 1179, 1183 (TTAB 2008).

Opposer introduced the testimony of Donna Berry, opposer's senior staff trademark attorney, and of Debra Joester, president and chief executive officer of Joester-Loria Group, a licensing agency representing various clients, including opposer. They testified that opposer has never intended not to use the RAMBLER mark in the future.

While Ms. Berry and Ms. Joester testified that opposer did not intend to abandon the RAMBLER mark for automobiles, this testimony does not by itself show that opposer did not

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abandon the mark for automobiles long prior to the filing date of applicant's application. Even "[a] registrant's proclamations of his intent to resume or commence use in United States commerce during the period of nonuse are awarded little, if any, weight." *Rivard v. Linville*, 45 USPQ2d at 1376. In this case, opposer has not even proclaimed an intent to resume use, but only denies an intent to abandon the mark for automobiles. The record, however, is to the contrary and is entirely devoid of any evidence convincing us that, after almost a forty-year hiatus, opposer has any serious intent to reintroduce a RAMBLER automobile that was last produced in 1969.

With respect to the second point, Ms. Berry opined that "there's a tremendous amount of residual goodwill from our production of these [RAMBLER] vehicles." (Berry Dep., p. 45). In this connection, she pointed to the "vehicle enthusiast population that to this day maintains and restores Rambler vehicles." The record also includes the testimony of Michelle DeCarlo, a trademark litigation paralegal for the law firm formerly representing opposer in this proceeding. Ms. DeCarlo was asked to conduct a search of the Internet for references to the mark RAMBLER in an effort "[t]o show that the Rambler mark is still in use and it's still in the public eye." (DeCarlo Dep., p. 7). The exhibits to Ms. DeCarlo's testimony include printouts from

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the National AMC Rambler Car Club (www.amcrc.com); Galvin's AMC Rambler Parts (www.ramblerparts.com); and AMC Rambler Connection (www.amcconnection.com), to name a few. The record shows the websites of several other car enthusiasts' clubs dedicated to the RAMBLER automobile.

The simple fact that there are collectors of an item, or that clubs exist for enthusiasts of a certain item (in this case, RAMBLER automobiles) does not, by itself, defeat the statutory presumption of abandonment by the mark's owner after almost forty years of nonuse in the ordinary course of trade. *General Motors Corp. v. Aristide & Co., Antiquaire de Marques*, 87 USPQ2d at 1183.

We also are not convinced that Encyclopedia of American Cars, A Comprehensive History of American Automakers from 1930 to Today (2006) shows residual goodwill in the mark. Opposer relied upon an excerpt from this book "to show how Opposer's mark RAMBLER is perceived by members of the public and to show that the mark is still in the public eye." Although the article chronicles the life of the RAMBLER automobile, it falls far short of showing the state of mind of the public and the degree to which the public still recognizes the mark as a source indicator for automobiles.

Opposer operates a vehicle museum on its campus in Auburn Hills, Michigan; and according to Ms. Berry, it opened "seven or eight years" ago. The museum includes a

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1902 RAMBLER vehicle on display. About 50,000 patrons visit the museum each year. Contrary to opposer's arguments, these facts hardly establish continued use sufficient to fend off a finding of abandonment.

Simply put, we find that the totality of the record does not support a finding that there is sufficient residual goodwill in the mark RAMBLER for automobiles so as to avoid a finding of abandonment. A finding of abandonment cannot be avoided where the asserted residual goodwill is generated through subsequent sales of a product by distributors and retailers. *Societe des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L.*, 10 USPQ2d 1241, 1244 n. 5 (TTAB 1989).<sup>6</sup> Nonetheless, opposer urges that the licenses it has granted (see *infra*) evidence residual goodwill inasmuch as each license shows an entity is willing to pay for the right to use the mark. We are not inclined to reach that conclusion, however, without more evidence. It may very well be that the licensees were willing to pay an amount of consideration (in this case, the amount is unknown) simply

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<sup>6</sup> We add that we do not find that the licensed products are so closely related to opposer's automobiles such that sales of these products preclude a finding of abandonment of the mark for automobiles. See generally J.T. McCarthy, McCarthy on Trademarks and Unfair Competition, §17:23 (4<sup>th</sup> ed. 2008). Stated differently, the licensed uses, begun some twenty-five years after cessation of production of RAMBLER automobiles, do not evidence an intent to resume use on automobiles. This finding is to be contrasted with our later finding herein that the licensed products are sufficiently related to applicant's identified goods for purposes of the likelihood of confusion analysis.

as a way of avoiding being sued.

In finding abandonment we have taken into account the nature of opposer's goods, automobiles. We recognize that automobiles generally are a long-lasting product, and that the goodwill value of a mark used for automobiles may persist long after production of automobiles with that mark has ceased. See *Emergency One, Inc. v. American FireEagle, Ltd.*, 228 F.3d 531, 56 USPQ2d 1343, 1348 (4<sup>th</sup> Cir. 2000) [dealing with fire engines]; *Ferrari S.p.A. Escercizio Fabrice Automobili e Corse v. Roberts*, 944 F.2d 1235, 20 USPQ2d 1001 (6<sup>th</sup> Cir. 1991); and *Ferrari S.p.A. Escercizio Fabrice Automobili e Corse v. McBurnie*, 11 USPQ2d 1843 (S.D. Cal. 1989). The time lapse in the present case, however, far exceeds the years of nonuse in the cited cases. Although opposer pleaded that there are a "large number" of RAMBLER vehicles "still on the road," no specific number is given. Here, the period of almost four decades of nonuse on automobiles presents a persuasive case for abandonment. See *L. J.G. Stickley, Inc. v. Canal Dover Furniture Co.*, 79 F.3d 258, 38 USPQ2d 1202 (2d Cir. 1996) [sixty years of nonuse resulted in abandonment].

Opposer's nonuse of the RAMBLER mark for automobiles for almost forty years constitutes a *prima facie* showing of abandonment. Furthermore, opposer has not introduced

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evidence of an intent to resume use to disprove the presumption of no intent to resume use.

In view of our finding of abandonment and the absence of sufficient residual goodwill in the RAMBLER mark for automobiles, we now look to opposer's licensing of its mark beginning in 1995 to see if opposer has established a new priority date based on use of the mark for various licensed products. *AmBRIT Inc. v. Kraft Inc.*, 812 F.2d 1531, 1 USPQ2d 1161, 1170 (11<sup>th</sup> Cir. 1986) [a subsequent use does not retroactively cure a past abandonment].

Licensing activity may indicate that a trademark owner has not abandoned its mark because it intends to resume use. *See Sands, Taylor & Wood Co. v. The Quaker Oats Co.*, 978 F.2d 947, 24 USPQ2d 1001 (7<sup>th</sup> Cir. 1992). In the present case, however, we have found that opposer abandoned its mark long before it began licensing its mark. Thus, the question now is whether its licensing evidence has established a new priority date for opposer and, if so, for what specific goods. *See Stromgren Supports Inc. v. Bike Athletic Co.*, 43 USPQ2d 1100, 1112 (TTAB 1997) ["[T]hese later efforts, had actual use ever commenced, would represent a new and separate use which cannot serve to cure the abandonment."].

According to Ms. Berry, she is "personally involved in the restoration parts and merchandise licensing program that uses the Rambler trademark." She testified that opposer has

a licensing program for its marks and that "the fame of our marks lend themselves to leveraging of the trademarks for use on products outside of the automotive industry directly." (Berry Dep., p. 10). Ms. Berry refers to the mark RAMBLER as a "heritage mark," and further that opposer has "an active restoration parts program and a heritage mark licensing program." (Berry Dep., p. 11). She testified that opposer uses the mark on a "variety of automotive-related parts and accessories, such as batteries, decal strips, restoration manuals and service specification documents, a wide variety of things." (Berry Dep., p. 14).

Ms. Berry testified that opposer has not stopped use of the mark at any time in the past ten years; that it is currently using the mark; and that opposer has never intended to discontinue use of the Rambler mark. (Berry Dep., p. 17). Ms. Berry gave the following testimony:

Has Daimler Chrysler either directly or through its predecessors ever licensed the Rambler mark?

Yes.

When is the earliest year that you're aware of that DaimlerChrysler licensed the Rambler mark?

Well, the database that we currently maintain shows the earliest license to be with a July 1995 effective date. I believe that was with the Franklin Mint Corporation.

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Has DaimlerChrysler obtained revenues through use of the Rambler mark during the past ten years?

Yes.

And how has it obtained that revenue?

Primarily through royalties obtained from our authorized Rambler trademark licensees.

Any parts sales?

Yes. (Berry Dep., pp. 18-19)

A significant exhibit to Ms. Berry's testimony is Exhibit No. 2, "a spreadsheet compiling trademark licensees for the Rambler trademark past and present from the database that we currently maintain. So, the records in the database with respect to the Rambler trademark only go back as far as 1995." (Berry Dep., pp. 20-21). Ms. Berry identifies the products listed:

Automobile batteries, clothing, collector cards, lapel pins; the little popular chrome steel air filter wall clocks; automotive decals and stripes; video games. We have several toy replica licensees; key rings, calendars, cell phone cases, MP3 cases, tote bags, tapestry throws, decorative pillows, reproduction owners manuals, parts books and shop manuals, technical manuals; reproduction engine designation decals; photographs, paper weights, playing cards, license plate frames, nostalgic signage. (Berry Dep., p. 22)

Ms. Berry testified that "all of our license agreements contractually obligate our licensees to submit to us for approval prior to production a certain number of samples of

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every product that they intend to produce, and it's only after we reviewed and approved the quality and ensure that the market [sic] is depicted correctly that our licensees are allowed to produce and sell the merchandise." (Berry Dep., p. 34).

Ms. Joester describes her firm as "a full service licensing company," and she testified about her firm's efforts on behalf of opposer. More specifically, Ms. Joester identified the firm's work: "We develop and execute licensing strategies for our clients, so we will start with strategic planning for their marks and execute those programs, including negotiating terms of agreements, developing the contracts, reviewing product for quality control and appropriateness, and managing the retail distribution and revenue collection." (Joester Dep., p. 5). Ms. Joester testified that "[a]ll royalty statements are kept in-house as well. So we do have a history of sales and what product is actually marketed." (Joester Dep., p. 8). Ms. Joester began negotiating licenses for the RAMBLER mark around 1995. Ms. Joester indicated that at least one of the licenses has been ongoing for the entire period 1995-2007.

Do you have personal knowledge of the use of the Rambler trademark?

Yes.

How do you have that knowledge?

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I see product that has been submitted by licensees from time to time and the samples internally and we have line reviews.

Have revenues been generated from DaimlerChrysler's licenses for the mark Rambler during the past 10 years?

Yes.

Continuously, would you say?

Yes. (Joester Dep., p. 14)

Ms. Joester identified a particular trend in the licensing industry over the past 10 years:

One of the most important trends of the last several years has certainly been the return of retro or heritage intellectual property, and that includes vehicles, muscle cars and other vehicles from the '50s, '60s and '70s. (Joester Dep., p. 17)

In this connection Ms. Joester further testified:

How would you define a retro or heritage mark?

It is a mark that existed sometime 20, 30 years ago, had built an affinity and emotional connection with the consumer as a result of the original product that was in the marketplace, and continues to have nostalgia appeal with consumers who are still interested in acquiring product that is built around the mark's core values and replicates the markets and the mark itself.

Would you say it's kind of a resurgence in a pre-existing mark, resurgence in interest?

In interest and in consumer demand for product that reflects those nostalgic memories in many cases.

Is Rambler a retro or heritage mark?

Yes, we actually manage Rambler as part of the retro/heritage marks that we proactively develop licenses for DaimlerChrysler. (Joester Dep., p. 18)

During the course of her testimony Ms. Joester testified about some of the uses already identified earlier in this opinion, as for example, calendars, key rings and toy replicas. Ms. Joester also testified about another company that produces die-cast replica vehicles and, in this connection, she identified a website of a collector shown to be reselling these replicas. ([www.jlcollector.com](http://www.jlcollector.com)).

Ms. Joester identified licenses for products that "may be in the product development stage or pre-product development stage now, so [the licensees] have not produced product that's been shipped to market." (Joester Dep., p. 37). She specifically identified fabrics, lighters, carrying bags and another manufacturer of toy replicas. (Joester Dep., pp. 37-38). There is no further testimony or evidence to show that these products have been manufactured and offered for sale. Mere entry into licensing arrangements is not by itself use of the mark. Use of the mark on the licensed product must occur for the licensed use to inure to the licensor's benefit. Accordingly, we accord no rights in the mark for these products that are merely in development.

We now turn to determine the specific products for which opposer has established licensed use for purposes of priority.

Opposer first would have us conclude that it has rights in the mark RAMBLER for automobile parts. Ms. Berry testified as follows:

[I]n connection with these restoration vehicle enthusiasts, we maintain a parts locator database that all of our dealers and our dealer network can access. So, for example, if a consumer is looking for, I don't know, an emergency brake cable or a windshield wiper blade or something that was authentic to the Rambler, they would go to our dealer. The dealer would access this database that DaimlerChrysler maintains to determine how to get his hands on one of those parts from someone else within the dealer database if that dealer himself did not already have it in stock.

So there are dealers that are currently selling the Rambler parts?

Yes.

Automotive parts?

Yes. (Berry Dep, p. 15)

Notwithstanding this testimony, the record is completely devoid of any evidence that opposer directly sells automobile parts *under the RAMBLER mark*. Although opposer may sell fungible parts, such as windshield wipers, that fit several different models of cars, including RAMBLER automobiles still on the road, there is no indication that these parts are sold under the RAMBLER mark. The record

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shows that there are various third-party suppliers in the trade that stock parts for RAMBLER automobiles. These third parties, however, are not related to opposer, and there is not even a hint that these suppliers are licensees of opposer such that any use of the mark would inure to opposer's benefit. Opposer failed to introduce any pictures of parts bearing the mark, or any labels or packaging bearing the mark. Accordingly, we see no basis upon which to accord any rights to opposer in the mark RAMBLER for automobile parts.

Opposer contends that it has rights in metal or die cast replica model toy vehicles. Exhibit 13 comprises two catalogs of one of opposer's licensees, Franklin Mint. The most recent license runs until 11/30/09, covering metal or die cast replica model toy vehicles. The toy vehicles are produced in a 1:43 scale, approximately 4.5 inches in size. These replicas are displayed in the catalog as a set along with other "Cars of the 60s Collection" or "The Classic Cars of the Fifties."

We find that the testimony and evidence fall short of establishing rights in toy vehicles. It is telling, we think, that opposer needed to resort to the use of Post-it brand notes on catalog pages to identify a RAMBLER model shown among the other toy replicas. In each instance, the note, presumably prepared by counsel, has a printed arrow

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pointing to the toy RAMBLER replica. Nowhere is the mark RAMBLER displayed and, given the small size of the toys, anyone other than a tried and true car enthusiast would be hard pressed to identify the particular replica that is the RAMBLER model. While the catalog page specifically lists some of the replicas as licensed products of General Motors, Chevrolet or Ford, no mention is made of opposer or any predecessor, let alone the RAMBLER mark itself.

Based on the record before us, we find that opposer has not established rights in RAMBLER for the toy replicas. The mark is conspicuously absent from any of the sales literature, and the mark does not appear to be shown on any of these very small toy replicas.

Also included in the record are printouts from a private individual's listing on eBay. ([www.ebay.com](http://www.ebay.com)). This individual was attempting to resell the Franklin Mint collection of cars, and the seller specifically mentioned the various models of cars in the set, including the RAMBLER model. Ms. Joester testified that Franklin Mint tends to produce collectable offerings in cycles, and it is likely that this collection has been "retired," thereby presumably creating a market for the product on eBay. (Joester Dep., p. 32). While one of the close-up and enlarged photographs of the very small toy replicas appears to show the RAMBLER mark, the photograph is not particularly clear. Moreover,

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given that this toy replica is being offered for sale by a third party, we are not inclined to accord any value to this use as inuring to opposer's benefit. See *Societe des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L.*, 10 USPQ2d at 1244, n. 5.

There is testimony and evidence regarding use of RAMBLER on decals for placement on automobiles, presumably RAMBLER models that are still on the road. The evidence includes a printout from a website of Graphic Express that shows for sale a RAMBLER decal. (Berry Dep., Ex. No. 3). This entity is listed as one of opposer's licensees in Exhibit No. 2, and the most recent term of the license is shown as 1/1/05 to 12/31/07.<sup>7</sup>

Exhibit 4 is a 2007 calendar captioned "American Muscle Cars." Included in the calendar, as the pictured car for May, is a 1969 AMC SC/Rambler (listing production as 1,512 units). The back of the calendar indicates the licensing stamps of "Chrysler Licensed Product," as well as of General Motors and Ford. Ms. Berry indicates that the first calendar listing a RAMBLER automobile was dated 2001. (Berry Dep., pp. 25-27). Exhibit 2 shows the licensing term running until 12/31/08.

Exhibit 5 is a licensing agreement with a third-party

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<sup>7</sup> Ms. Berry and Ms. Joester testified in June, 2007, that is, prior to the expiration of this license.

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to produce a variety of decals and manuals. The agreement runs through 12/31/09. Ms. Berry indicated that the products, continuously available since 1998, are reproduction vehicle decals, sales literature, stripe kits, specification sheets and owner's manuals, all dealing with the RAMBLER mark. (Berry Dep. pp. 27-29).

Exhibit 10 is a key ring displaying the RAMBLER mark; the most recent license term ran from 4/1/04 to 12/31/07.

Opposer, in order to establish priority, need only show that it is using the mark in the United States prior to applicant's priority date. *First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc.*, 476 F.3d 867, 81 USPQ2d 1375, 1378 (Fed. Cir. 207). Although it is a bit surprising that opposer did not offer any testimony or evidence regarding the extent of the sales of licensed products (e.g., sales revenues, sales volume in units), applicant neither attacked nor questioned this aspect of opposer's licensed use. That is to say, applicant has not argued that the licensed uses have been token or de minimis. Thus, we see no reason to question, *sua sponte*, this aspect of the licensed uses.

Oral testimony, even of a single witness, if "sufficiently probative," may be sufficient to prove priority. *Powermatics, Inc. v. Glebe Roofing Products Co.*, 341 F.2d 127, 144 USPQ 430 (CCPA 1965); and *4U Co. of*

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*America, Inc. v. Naas Foods, Inc.*, 175 USPQ 251 (TTAB 1972).

In the present case, the testimony of Ms. Berry and Ms. Joester is not "characterized by contradictions, inconsistencies and indefiniteness," but rather carries with it "conviction of its accuracy and applicability." *B.R. Baker Co. v. Lebow Bros.*, 150 F.2d 580, 66 USPQ 232 (CCPA 1945). Further, the oral testimony is buttressed by corroborating evidence, most significantly, by the actual licensed products themselves. *See Elder Mfg. Co. v. International Shoe Co.*, 194 F.2d 114, 92 USPQ 330 (CCPA 1952).

At this point, we take into consideration the Federal Circuit's admonition when we are determining dates of use for priority purposes:

The TTAB concluded that each piece of evidence individually failed to establish prior use. However, whether a particular piece of evidence by itself establishes prior use is not necessarily dispositive as to whether a party has established prior use by a preponderance. Rather, one should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use. The TTAB failed to appreciate this. Instead, the TTAB dissected the evidence to the point that it refused to recognize, or at least it overlooked, the clear interrelationships existing between the several pieces of evidence submitted. When each piece of evidence is considered in light of the rest of the evidence, rather than individually, the evidence as a whole

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establishes by a preponderance that West used the "FAST EDDIE'S" mark prior to Jet's admitted first use of the mark.

*West Florida Seafood Inc. v. Jet Restaurants*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994).

Similarly, when we consider all the pieces of the puzzle relating to opposer's licensed use of its mark RAMBLER on certain products, we conclude that opposer has established a priority date earlier than the filing date of the involved application. That is not to say, however, that opposer has established priority on all of the items mentioned by the witnesses, at least not on the present record. Ms. Berry and Ms. Joester mentioned several additional licensed items, but they did not offer the products themselves or any specifics about such uses (e.g., on batteries, clothing and video games). Although Exhibit No. 2 lists licenses for those products, opposer failed to present any evidence that its licensees actually manufactured such products, let alone that its licensees actually sold such goods with the RAMBLER mark appearing thereon. To reiterate, licensing is not by itself use of the mark. Nonetheless, opposer's credible testimony, coupled with corroborating evidence, satisfies its burden of proof in showing, by a preponderance of the evidence, that it has priority of use, at the very least with respect to

key rings, calendars, decals, specification sheets and owner's manuals, all relating to RAMBLER automobiles. The testimony regarding the licensed uses, coupled with the production of the licensed goods themselves, form critical distinctions between this record and the one in *General Motors Corp. v. Aristide & Co., Antiquaire de Marques*.

Thus, we will decide the likelihood of confusion issue on the basis of these goods on which opposer established rights prior to the filing date of the involved application.

**Likelihood of Confusion**

We accordingly turn to the issue of likelihood of confusion. Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods and/or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence.

Turning first to the marks in this proceeding, they are identical in sound, appearance, meaning and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot*

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*Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). This factor heavily favors opposer.

With respect to the goods, it is well established that the goods of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. See *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telephone Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source of the goods. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

In comparing the goods, we initially note that where identical marks are involved, as is the case here, the degree of similarity between the parties' goods that is required to support a finding of likelihood of confusion declines. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d

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1687, 1688-1689 (Fed. Cir. 1993); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002); and *In re Opus One Inc.*, 60 USPQ2d 1812 (TTAB 2001).

Based on the particular set of facts in this case, we find that opposer's key rings, calendars, decals, specification sheets and owner's manuals, all being collateral products licensed in connection with the RAMBLER mark, formerly used by opposer's predecessors for automobiles, are sufficiently related to applicant's automobiles so that consumers would ascribe a single source to the products. See *Tiffany & Co. v. Classic Motor Carriages*, 10 USPQ2d 1835 (TTAB 1989).

It is common knowledge that items such as key rings, decals and calendars are widely used as promotional items for a diverse range of goods and services, including automobiles. See *L.C. Licensing, Inc. v. Cary Berman*, 86 USPQ2d 1883, 1889 (TTAB 2008) ["It is common knowledge, and a fact of which we can take judicial notice, that the licensing of commercial trademarks on 'collateral products' has become a part of everyday life."]. See also *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 n. 3 (CCPA 1981) ["'collateral product' use is a matter of textbook discussion"], *aff'g*, 204 USPQ 396 (TTAB 1979) [collateral product use "has become a part of everyday life which we cannot ignore"]; and *Turner*

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*Entertainment Co. v. Nelson*, 38 USPQ2d 1942, 1945-46 (TTAB 1996).

We find that the *du Pont* factors, on balance, weigh in favor of a finding of likelihood of confusion.

Lastly, to the extent that there may be any doubt on our finding of likelihood of confusion, we resolve that doubt, as we must, in favor of opposer as the prior user. *See Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983).

In reaching our conclusion, we are cognizant of the unusual set of facts surrounding opposer's use/nonuse of the mark RAMBLER. We have determined that the record falls short of establishing residual goodwill in the mark RAMBLER for automobiles sufficient to avoid a finding of abandonment of the mark for such goods. Nonetheless, there is undeniably present some degree of goodwill in the mark, so that if applicant were to use the mark on automobiles, then confusion would be likely among consumers familiar with opposer's various licensed products, when it might not be absent such goodwill. In the present case, we cannot ignore the fact that purchasers of opposer's licensed goods or applicant's automobile may be buying such goods because they know of the earlier RAMBLER automobile, and these purchasers would view both types of goods as originating from the same

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source, namely the manufacturer of the old line of RAMBLER automobiles.

**Decision:** The opposition is sustained on the ground of likelihood of confusion, and registration to applicant is refused.