

THIS OPINION IS NOT A PRECEDENT
OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

MBA

Mailed: August 13, 2008

Opposition No. 91178693

Opposition No. 91178694

Impact Sports, Inc.

v.

Impact Sports Technologies,
Inc.

**Before Hairston, Rogers and Bergsman, Administrative
Trademark Judges**

By the Board:

Impact Sports Technologies, Inc. ("applicant") seeks to register the mark IMPACT SPORTS, in standard character format, for "Clothing, namely wristbands, armbands, anklebands, shirts and gloves,"¹ and for "Athletic gloves namely work-out gloves,"² and registration is opposed by Impact Sports, Inc. ("opposer"). Opposer alleges in the above-referenced opposition proceedings that it has priority of use and that the mark identified in applicant's applications is confusingly similar to opposer's identical

¹ Application Serial No. 78977254, filed March 17, 2005, based on an intent to use the mark in commerce.

² Application Serial No. 78977255, filed March 17, 2005, based on an intent to use the mark in commerce.

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mark IMPACT SPORTS, which opposer claims to use for, among other things, clothing, clothing accessories, and the sale and distribution of clothing, clothing accessories, sporting goods and sports-related equipment manufactured by others. Opposer also alleges that use of applicant's mark will "lead to the belief that Applicant's goods are sponsored by, affiliated with, approved by, or otherwise emanate from Opposer," and that applicant's mark will "falsely suggest a connection between Applicant and Opposer." In its answers, applicant denies the salient allegations in the notices of opposition but admits that it has not yet used its mark for the goods identified in its applications. Applicant also pleads, as affirmative defenses in each proceeding, that the oppositions are barred by opposer's alleged unclean hands and fraud, because opposer filed intent to use applications for marks which opposer claims, in this proceeding, to actually be using in commerce.

These cases now come up for consideration of opposer's motions, filed April 17, 2008 in each proceeding, seeking summary judgment "on the grounds that there are no genuine issues of material fact with regard to likelihood of confusion under Trademark Act Section 2(d) ... and Opposer is entitled to judgment as a matter of law ..." Applicant contests the motions, which are fully briefed and ready for decision.

Consolidation

Before addressing the motions for summary judgment, it is clear that these proceedings involve identical parties, closely related applications and virtually identical issues. When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. See Fed. R. Civ. P. 42(a); see also, Regatta Sport Ltd. v. Telux-Pioneer Inc., 20 USPQ2d 1154 (TTAB 1991). In view thereof, Opposition Nos. 91178693 and 91178694 are hereby consolidated.

Opposer's Motions for Summary Judgment

In its motions for summary judgment, opposer argues that it has priority of use based on: (1) applicant's responses to opposer's requests for admission (attached to opposer's motion as Exhibit 1), which establish that applicant has not yet used its mark on any of the goods identified in its applications; and (2) the Declaration of Daniel Paltz ("Paltz Dec."), opposer's Controller and Corporate Secretary, and the exhibits submitted therewith. In his Declaration, Mr. Paltz testifies, among other things, that "[s]ince at least as early as May, 2004:"

- Opposer "has marketed and sold its own private label line of athletic clothing and clothing accessories under the private label brand name and trademark IMPACT SPORTS," including "shirts, t-shirts, polo shirts, jerseys, sweatshirts, crew neck sweatshirts, hooded

sweatshirts, sweat pants, jackets, athletic shorts and athletic caps and hats;" Paltz Dec. ¶¶ 5-6;

- Opposer's IMPACT SPORTS mark "has been and is displayed on tags affixed to the aforementioned clothing and clothing accessories or has been and is imprinted directly on the clothing and clothing accessories, and has been applied to brochures, advertisements and promotional literature and materials used in connection with the advertisement and sale of the aforementioned clothing and clothing accessories;" Paltz Dec. ¶ 7;
- Opposer "has continuously used the mark IMPACT SPORTS in connection with advertising and promoting the distribution and sale of ... third party clothing and clothing accessories," including athletic gloves, and "has also been a wholesale and retail distributor and seller of sporting goods and sports equipment manufactured by others," including athletic gloves; Paltz Dec. ¶¶ 13-15; and
- Opposer has "conducted and continues to conduct its business under the trade name Impact Sports;" Paltz Dec. ¶ 21.

Opposer submitted with the Declaration, among other things: photographs showing opposer's use of IMPACT SPORTS on clothing; brochures bearing the mark IMPACT SPORTS which display clothing and clothing accessories, including at least one distributed beginning in 2004; and "Item Sales Reports" and customer invoices regarding clothing and

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clothing accessory items sold under the mark IMPACT SPORTS, some of which establish sales of clothing and clothing accessories bearing IMPACT SPORTS "throughout the country including in the states of California, Florida, Illinois, Michigan, Minnesota and Wisconsin." Paltz Dec. ¶¶ 24, 25, 27, 31-43 and Exhibits 2, 3, 5 and 9-19.

Opposer further argues that there is a likelihood of confusion between the parties' respective marks because they are identical, because the goods sold under the parties' marks are "identical or closely related" and because "the channels of trade for the parties's (sic) respective goods and services are assumed to be identical" given the lack of any limitation as to channels of trade in applicant's applications.

Applicant introduces no evidence whatsoever in its response to opposer's motion. Instead, it relies on mere argument and claims, without evidentiary support, that during prosecution of its Class 28 application it "demonstrated that there were over 731 U.S. Registered Trademarks or Trademark Applications that include the word IMPACT, with 40 different registered marks in international class 28 that include the word IMPACT and 40 different registered marks in international class 25 that include the

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word IMPACT," none of which are owned by opposer.³

Applicant further argues that opposer has "unclean hands" and that the Paltz Declaration should not be accepted because the testimony therein "contradicts" two of opposer's trademark applications.⁴ Specifically, applicant argues that because the Paltz Declaration claims that opposer has actually used the marks shown in its application Serial Nos. 76643420 and 76643418, and those applications were filed under the intent to use provisions of 15 U.S.C. § 1051(b), opposer has unclean hands. Applicant asserts that opposer has not established use of IMPACT SPORTS on gloves or other goods in Class 28, and that opposer's distribution of gloves bearing third party marks does not establish opposer's use of IMPACT SPORTS for gloves.

Applicant effectively concedes that opposer has priority of use, by not contradicting opposer's evidence regarding opposer's priority date, and by admitting that applicant has not used its mark on any of the goods identified in its applications and that "[t]he earliest possible date that [applicant] can rely upon for purposes of priority" is the filing date of its applications, i.e. March 17, 2005. In addition, applicant does not dispute that the

³ In fact, applicant only identified six allegedly relevant registrations, by registration number, during prosecution of its application.

⁴ These applications were not pleaded in the notices of opposition and are not at issue in these proceedings.

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parties' marks and channels of trade are identical, or that many of the parties' goods are at least related.

In its reply brief, opposer points out that applicant has not introduced any evidence. It further argues that the classification of goods and services "is a purely administrative determination and has no bearing on the issue of likelihood of confusion" (emphasis in original).

Finally, opposer argues that its intent to use applications are not at issue in this proceeding or a basis upon which to find that opposer has unclean hands.

Decision

Summary judgment is only appropriate where there are no genuine issues of material fact in dispute, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(c). Opposer, as the movant seeking summary judgment, bears the initial burden of demonstrating the absence of any genuine issue of material fact. See, Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986); Sweats Fashions, Inc. v. Pannill Knitting Co. Inc., 833 F.2d 1560, 1563, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. See, Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 850, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992);

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Olde Tyme Foods, Inc. v. Roundy's, Inc., 961 F.2d 200, 202, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

The evidence on summary judgment must be viewed in a light most favorable to the non-movant, in this case applicant, and all justifiable inferences are to be drawn in applicant's favor. Lloyd's Food Products, Inc. v. Eli's, Inc., 987 F.2d 766, 767, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); Opryland USA, supra. The Board may not resolve issues of material fact; it may only ascertain whether issues of material fact exist. See, Lloyd's Food Products, 987 F.2d at 766, 25 USPQ2d at 2029; Olde Tyme Foods, 961 F.2d at 200, 22 USPQ2d at 1542.

Evidentiary Issue

Applicant argues that we should not consider the Paltz Declaration because it contains testimony that opposer has actually used two marks for which opposer seeks registration under 15 U.S.C. § 1051(b), and that the Declaration is, therefore, "contradictory." We do not agree that there is any contradiction between the Declaration and the intent to use applications, or that the Declaration should not be considered. The filing of an intent to use application is not inconsistent with actual use of the mark prior to the application's filing date. See e.g., Corporate Document Services Inc. v. I.C.E.D. Mgmt. Inc., 48 USPQ2d 1477, 1479 (TTAB 1998); TMEP § 903 (5th ed. 2007) ("A § 1(b) applicant

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may assert dates of use that are earlier than the filing date of the application in an amendment to allege use or statement of use.”).

Standing

There is no genuine issue of material fact regarding standing. Opposer’s evidence establishes “its standing to bring this opposition as the prior user of the mark” IMPACT SPORTS for clothing and related products and services.

Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Ltd., 86 USPQ2d 1283, 1285 (TTAB 2008) (citations omitted).

Applicant does not contend otherwise, much less introduce contradictory evidence.

Priority

There is no genuine issue of material fact regarding priority. Opposer’s declaration testimony and the accompanying exhibits establish that opposer’s first use of IMPACT SPORTS was at least as early as May 2004. Green Spot (Thailand), 86 USPQ2d at 1284 (relying on declaration testimony of opposer’s chairman to establish date of first use). Applicant concedes that the “earliest possible date” it can rely upon is March 17, 2005.

Likelihood of Confusion

“We determine likelihood of confusion by focusing on ... whether the purchasing public would mistakenly assume that the applicant’s goods originate from the same source as, or

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are associated with," opposer's goods. In re Majestic Distilling Co., 315 F.3d 1311, 1314-15, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In considering the question on a motion for summary judgment, we analyze all probative facts in evidence which are relevant to any of the 13 likelihood of confusion factors set forth in In re E.I. du Pont de Menours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), as well as whether there are genuine disputes as to any of these factors which would be material to a decision on the merits. In this case, opposer has introduced evidence concerning, and we have therefore considered, the similarity of the parties' marks, goods and services and channels of trade. Applicant has not introduced any evidence.⁵

Turning first to the similarity of the parties' marks, there is no genuine issue of material fact. The parties'

⁵ Although applicant claims that there are many third party applications and registrations for marks including the word IMPACT in International Classes 25 and 28, we may not consider this argument because it is unsupported by any evidence. That is, while an involved application is part of the record in a Board proceeding, the contents of the application file are not, unless properly introduced as evidence. Trademark Rule 2.122(b); British Seagull Ltd. v. Brunswick Corp., 28 USPQ2d 1197, 1200 (TTAB 1993), aff'd, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); see also, Motion Picture Ass'n of America, Inc. v. Respect Sportswear, Inc., 83 USPQ2d 1555, 1563 (TTAB 2007) ("Applicant's mere assertion of such use has no probative value ..."). Furthermore, even if the claim was supported by evidence, it would not be persuasive because, among other things: (a) there is no indication whether the alleged marks are confusingly similar, in overall commercial impression, to IMPACT SPORTS; (b) there is no indication whether the alleged marks are used on goods or services similar or related to those at issue in these proceedings; and (c) the classification of goods sold under the alleged marks is irrelevant.

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marks are identical. This factor weighs heavily in favor of a finding of likelihood of confusion. Kohler Co. v. Baldwin Hardware Corp., 82 USPQ2d 1100, 1109 (2007); Hornblower & Weeks Inc. v. Hornblower & Weeks Inc., 60 USPQ2d 1733, 1735 (TTAB 2001).

Turning next to the parties' goods, opposer uses its mark for, among other things, clothing, including shirts. In its Class 25 application, applicant seeks to register an identical mark for, among other things, clothing, including shirts. "Use of identical marks for virtually identical services would create a likelihood of confusion." Hornblower & Weeks, 60 USPQ2d at 1735. Furthermore, while the gloves identified in applicant's Class 28 application are not identical to opposer's goods, they are clearly related, if not similar. Indeed, opposer has established its use of IMPACT SPORTS for sports-related clothing, and applicant intends to offer "work-out gloves," which are also sports-related clothing, under an identical mark. Applicant does not deny that at least some of the goods in its Class 25 application are identical to some of opposer's goods, or that the goods in its Class 28 application are at least related to some of opposer's goods. As opposer points out, even if opposer does not use its mark on any goods in Class 28, that is irrelevant. Jean Patou Inc. v. Theon Inc., 9 F.3d 971, 975, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993) ("The

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benefits of a Principal Register registration apply with respect to the goods named in the registration without regard to the class or classes named in the registration.”). There is therefore no genuine issue of material fact that the parties’ goods are in some respects identical, and in other respects at least related. This factor therefore also weighs in favor of a finding of likelihood of confusion.

Finally, where, as here, “there is no limitation on the channels of trade” in the recitations of goods in the applications at issue, it is presumed that the goods move in all normal channels of trade, as do opposer’s. See, e.g., Octocom Systems, Inc. v. Houston Computers Services, Inc., 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); Venture Out Properties LLC v. Wynn Resorts Holdings, LLC, 81 USPQ2d 1887, 1893 (TTAB 2007). Therefore, this factor also weighs in favor of a finding of likelihood of confusion.

There is no evidence of record bearing on DuPont factors other than those discussed herein.

Conclusion

Because we find, based on opposer’s uncontradicted evidence and the applicable law, that the parties’ marks are identical and the goods are identical in part and otherwise highly related, because we must presume that the channels of trade are the same, and because applicant has failed to introduce any evidence whatsoever which would raise a

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genuine issue of material fact, we find that opposer has established likelihood of confusion as a matter of law. Accordingly, opposer's motions for summary judgment are **GRANTED**. The oppositions are sustained.

News from the TTAB

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stdnagmnt.htm>
