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

Proceeding	91178693
Party	Plaintiff Impact Sports, Inc.
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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.: 78/977,254
Filed on: March 17, 2005
For the Mark: IMPACT SPORTS
Published in the Official Gazette on: April 3, 2007

IMPACT SPORTS, INC.)	
)	Opposition No. 91178693
Opposer,)	
)	
v.)	
)	OPPOSER’S REPLY MEMORANDUM
IMPACT SPORTS TECHNOLOGIES, INC.)	IN SUPPORT OF OPPOSER’S MOTION
Applicant)	FOR SUMMARY JUDGMENT

INTRODUCTION

On April 17, 2008, Opposer filed its Motion for Summary Judgment (“Motion”) seeking summary judgment in its Opposition to Application No. 78/977,254 (“Application”) on the grounds that there are no genuine issues of material fact with regard to likelihood of confusion under Trademark Act Section 2(d). The Motion was accompanied by a supporting memorandum (“Memorandum”) and a supporting Declaration of Daniel Paltz (“Declaration”). On May 12, 2008, Applicant served its response (“Response”) to the Motion on Opposer. Opposer respectfully submits this reply memorandum (“Reply”) in response thereto.

In its Response, Applicant fails to provide a single shred of credible or admissible evidence on the issue of likelihood of confusion to counter the evidence provided by Opposer. Applicant did not submit any affidavits or declarations with its Response and did not provide any exhibits attached to its Response relating to the issue of likelihood of confusion. Applicant’s entire Response on this issue, therefore, amounts to nothing more than a few unsworn and unsupported statements and assertions. The bulk of Applicant’s Response is therefore inadmissible for purposes of establishing the existence of any genuine issues of material fact on the issue of likelihood of confusion and, to the extent Applicant’s Response is admissible for consideration by the Board, it fails to establish the existence of a genuine issue of material fact.

Applicant's Response also alleges that the Board should deny Opposer the relief that it seeks on the grounds that Opposer comes before the Board in this proceeding with unclean hands. Unfortunately for Applicant, there simply is nothing improper about the conduct of Opposer upon which Applicant bases its allegation that Opposer's hands are unclean. And furthermore, even if the Board were to find in favor of Applicant on this issue, such a finding would not extinguish Opposer's right to relief on the issue of likelihood of confusion.

ARGUMENT

I. Summary Judgment Is Appropriate On the Issue of Likelihood of Confusion Because Applicant Has Submitted No Admissible Evidence That Raises A Genuine Issue Of Material Fact.

When a moving party's motion is supported by evidence sufficient, if unopposed, to demonstrate that there is no genuine issue of material fact and that the moving party is entitled to judgment, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must offer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. *See* Fed. R. Civ. P. 56(e), *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

In this case, Opposer's Motion is supported by evidence sufficient to demonstrate that there are no genuine issues of material fact and that Opposer is entitled to summary judgment. Applicant, on the other hand, in its Response, has provided no countering evidence on the issue of likelihood of confusion that is admissible or credible for consideration by the Board. Applicant's Response is not accompanied by a single affidavit or declaration. Applicant's Response is also not accompanied by any exhibits relevant to the issue of likelihood of confusion. As a result, Applicant is left with nothing more than mere denials and conclusory assertions on this issue which are simply insufficient to raise any genuine issues of material fact.

It should be noted for the record that Applicant does assert in the Response that during prosecution of the Application, Applicant "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 25 that

include the word IMPACT and 40 different registered marks in international class 28 that include the word IMPACT.” (See Response, pg. 1). Applicant does not, however, provide any evidence to support this statement or the facts asserted therein. Applicant also does not reference or identify any documents from the file history of the Application that provide evidentiary support for this statement or the facts asserted in this statement (this is because during prosecution of the Application, no evidential support was provided to support the asserted facts).

Statements of this nature, even if cited from the Application file, must be established by competent evidence and the documents containing such statements are not evidence if they are not properly introduced into evidence. See *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 TBMP § 704.04 (2nd ed. 2004). Therefore, without some form of proper evidentiary support and introduction, this unsupported assertion and the facts contained therein are improper and should not be considered by the Board.

In summary, Applicant’s Response on the issue of likelihood of confusion amounts to nothing more than Applicant’s unsworn arguments as to why Applicant is entitled to registration of its mark, unsupported by any credible or admissible evidence. A majority of those arguments are irrelevant and immaterial to the likelihood of confusion issue. Applicant simply has not offered any admissible countering evidence, by affidavit or as otherwise provided in Fed. R. Cir. P. 56, to show that there is a genuine factual dispute for trial and Opposer’s motion for summary judgment should therefore be granted on this basis alone.

II. Even If Applicant’s Response is Considered In Its Entirety, Applicant Has Failed To Raise A Genuine Issue of Material Fact With Regard To the Issue of Likelihood of Confusion.

Even if the Board were to consider the Response in its entirety, it still does not raise a genuine issue of material fact with regard to the issue of likelihood of confusion.

A. Applicant Has Failed To Raise A Genuine Issue of Material Fact With Regard To Opposer’s Standing To Maintain This Proceeding.

Applicant has not challenged Opposer's standing to maintain this proceeding. Given the record in this proceeding, it is clear that Opposer's likelihood of confusion claim is not wholly without merit. Therefore, there is no genuine issue of material fact with respect to Opposer's standing in this proceeding.

B. Applicant Has Not Raised a Genuine Issue Of Material Fact With Regard To Opposer's Priority of Use.

Opposer has established continuous use of its IMPACT SPORTS mark on and in connection with its own private label line of athletic clothing and clothing accessories, and in connection with providing its wholesale and retail distributorship services in the fields of clothing, clothing accessories, sporting goods and sports equipment, since at least as early as May, 2004 to the present date. (See Declaration, ¶¶ 5 - 7, 14, 15, 20, 22-43 and Ex. 1-19).

Applicant has provided no evidence to dispute, and does not dispute, Opposer's continuous use of its IMPACT SPORTS marks at least as early as May, 2004 on and in connection with the above-mentioned goods and services.

Applicant also has provided no evidence to support a date of first use of the mark IMPACT SPORTS that is earlier than the filing date of the Application, namely March 17, 2005. In the absence of any proof of earlier use, this filing date is the earliest date upon which Applicant can rely for priority. Thus, there is no genuine issue of material fact as to priority of use of the IMPACT SPORTS mark.

C. Applicant Has Not Raised A Genuine Issue Of Material Fact With Respect To Likelihood Of Confusion.

In this proceeding, the only pertinent *du Pont* factors of record are the similarity of the parties' respective marks, the similarity and nature of the parties' respective goods and services, and the similarity of the trade channels and class of purchasers for the parties' respective goods and services. Even after taking Applicant's Response into consideration in its entirety, these pertinent factors of record continue to overwhelmingly favor Opposer to such a degree that there must be a finding of likelihood of confusion.

1. Applicant Has Not Raised A Genuine Issue Of Material Fact With Respect To The Similarity Of The Marks.

Applicant has not and cannot dispute that it is seeking to register the mark IMPACT SPORTS. Applicant also has not disputed, and has provided no evidence to dispute, that Opposer's mark is IMPACT SPORTS. It remains undisputed, therefore, that the marks are identical with regards to their appearance, sound, connotation and commercial impression. This factor continues to overwhelmingly favor Opposer.

2. Applicant Has Not Raised A Genuine Issue Of Material Fact With Respect To The Similarity And Nature Of The Goods And Services Of The Parties.

Applicant cannot and has not disputed that it is seeking to register the mark IMPACT SPORTS for use in connection with "clothing, namely wristbands, armbands, anklebands, shirts and gloves." Applicant also has not disputed, and has provided no evidence to dispute, that Opposer uses its IMPACT SPORTS mark on and in connection with its own private label line of athletic clothing and clothing accessories, and in connection with the wholesale and retail distribution of clothing, clothing accessories, sporting goods and sports equipment including, among other things, wristbands, armbands, anklebands, shirts and gloves. (See Declaration ¶¶ 6, 13-15, 20, 25, 27, 29, 30, and Ex. 3, 5, 7 and 8). It remains undisputed, therefore, that the goods identified in the Application are identical to the goods provided and sold by Opposer. This factor also continues to overwhelmingly favor Opposer.

It should be noted that Applicant does allege in the Response that Opposer has not used its IMPACT SPORTS mark on any goods in International Class 28. Applicant does not provide any evidence to support this allegation however. To the contrary, Applicant improperly attempts to reach this conclusion by stating that since Opposer provided no evidence to establish that Opposer is using the IMPACT SPORTS mark on goods classified in International Class 28, Opposer must not be using the IMPACT SPORTS mark on such goods. Such a conclusion is improper given that Opposer had no obligation to provide any such evidence. In any event, it is well settled that the classification of goods and services by the U.S. Patent and Trademark Office ("Office") is a purely administrative determination and has no bearing on the issue of likelihood of confusion. See *Jean Patou Inc. v. Theon Inc.*, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993); *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1216 (TTAB 1990).

3. Applicant Has Not Raised A Genuine Issue Of Material Fact With Respect To The Similarity Of Established Likely-To-Continue Trade Channels and the Conditions Under Which And Buyers To Whom Sales Are Made.

It is also well settled that registration must be determined "on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to . . . the particular channels of trade or the class of purchasers to which the sales of the goods are directed." *Id.* Where there is no limitation on the channels of trade in the identification of goods and services in the subject application, it is presumed that the identification encompasses all goods and services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. *In re Continental Graphics Corp.*, 52 USPQ2d 1374, 1377 (TTAB 1999).

Applicant cannot and does not dispute in its Response the obvious fact that the description of goods in the Application is not limited to any particular channels of trade or class of purchasers. Applicant's Response goes even further however - Applicant also does not dispute that the channels of trade and class of purchasers for its goods are different from those for Opposer's goods and services. In view of the fact that Applicant's identification of goods does not contain any limitations as to channels of trade and class of purchasers, the Board must assume that Applicant's recited goods will be marketed in all normal channels of trade for such goods and to all the usual classes of purchasers of such goods, including those channels of trade and classes of purchasers targeted by Opposer for its goods. Therefore, there are no genuine issues of material fact relating to the channels of trade and class of purchasers for the parties' respective goods and services and these factors also continue to overwhelmingly favor Opposer.

4. Applicant Has Not Raised Any Genuine Issues of Material Fact With Respect To Any Of The Other *du Pont* Evidentiary Factors and the Pertinent *du Pont* Evidentiary Factors of Record Remain the Same And Continue to Overwhelmingly Favor a Finding of Likelihood of Confusion.

Even if Applicant's Response is considered in its entirety by the Board, it does not contain any credible or admissible evidence with regard to any of the *du Pont* evidentiary factors which were not of record in this

proceeding prior to the filing of the Response. Thus, the only *du Pont* evidentiary factors of record remain the same. Since there is no genuine issue of material fact relating to any of those evidentiary factors, it is appropriate for the Board to find that there is a likelihood of confusion as a matter of law.

III. Applicant’s Claim that Opposer Appears Before the Board In This Proceeding With Unclean Hands Is Unsupported And Without Merit

In its Response, Applicant attempts to deflect the Board’s attention from the real issue at hand, namely the presence of a likelihood of confusion, by alleging that Opposer’s hands are unclean and as a result, Opposer should not be granted the relief it seeks in this proceeding. (See Response, pgs. 3-5). As grounds for Applicant’s affirmative defense, Applicant alleges that Opposer submitted false statements to the Office under oath during prosecution of two trademark applications that are unrelated to, and not at issue in, this proceeding. Those applications are Application Nos. 76/643,418 and 76/643,420 (the “418 Application” and the “420 Application”).

A. Applicant has Failed to Provide Sufficient and Relevant Evidence to Support Its Claim That Opposer Appears Before the Board In This Proceeding With Unclean Hands.

As a preliminary matter, it should be noted that Opposer objects to the introduction of Applicant’s evidence with respect to the ‘420 Application because this evidence was not properly introduced into evidence by Applicant. Applicant has simply referenced Exhibit B to its Answer as evidentiary support for introducing the ‘420 Application into evidence. The problem with this is that Exhibit B to Applicant’s Answer cannot be considered as evidence on behalf of Applicant unless it is identified and introduced into evidence as an exhibit to Applicant’s Response. See 37 § CFR 2.122(c). Applicant did not do this.

In addition, Exhibit B to Applicant’s Answer also presents another evidentiary problem for Applicant. Exhibit B to Applicant’s Answer contains nothing more than excerpts from two documents of unknown origin. Nothing in Applicant’s Answer or the Response identifies these documents or the origin of these documents. Furthermore, the only way in which to properly introduce these documents into evidence is by affidavit or declaration because they are not self-authenticating. See *Raccioppi v. Apogee, Inc.*, 47 USPQ2d 1368, 1369 (TTAB 1998). Applicant has not done this either.

For all of the reasons stated above, Opposer objects to the introduction of these documents into evidence, requests that the Board not consider them, and further requests that the Board deny Applicant's request for a finding of unclean hands on the part of Opposer with respect to the '420 Application.

Also as a preliminary matter, as Applicant has stated in its response, "[t]he concept of unclean hands must be related to a plaintiff's claim, and misconduct unrelated to the claim in which it is asserted as a defense does not constitute unclean hands." (See Response, pg. 4, citing to *Tony Lama Co., Inc v. Di Stefano*, 206 USPQ 176, 179 (TTAB 1980). With respect to both the '418 and '420 Applications, neither of these applications are at issue in this proceeding and Opposer is not relying on these applications for support of any kind in this proceeding. In addition, the '418 Application is for a mark that is totally unrelated to the marks at issue in this proceeding. For these reasons, these two applications are totally unrelated to Opposer's claim in this proceeding and the Board should deny Applicant's request for a finding of unclean hands on the part of Opposer with respect to these two applications for these reasons as well.

B. Even If The Board Decides To Consider Applicant's Evidence, The Affirmative Defense of Unclean Hands Does Not Apply In This Case Because Opposer's Hands Are Clean.

At its core, Applicant has alleged that it was improper for Opposer to file each of the two subject applications under Section 1(b) on an intent-to-use basis because Opposer was using each of the marks sought to be registered on some of the goods recited in the applications at the time the applications were filed. Opposer is not aware of any laws or regulations that prohibit such a filing. In fact, the Board has stated that "[a]n applicant who is actually using its mark may, for various reasons, choose to file an intent-to-use application." *In re Promo Ink*, 78 USPQ2d 1301, 1303 (TTAB 2006). See also *Corporate Document Servs. Inc. v. I.C.E.D. Mgmt. Inc.*, 48 USPQ 1477, 1479 (TTAB 1998); *Dyneer Corp. v. Auto. Prods. plc*, 37 USPQ 1251, 1256 (TTAB 1995). The Trademark Manual of Examining Procedure ("TMEP") also makes it clear that such a filing is proper:

A §1(b) applicant 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.

See TMEP § 903 (5th ed. 2007).

It is clear, therefore, that Opposer did not do anything improper when it filed the '418 and '420 Applications on an intent-to-use basis even though Opposer was, at the time of filing, using the marks sought to be registered in connection with some of the goods recited in each of those applications. There is no basis, therefore, for Applicant's allegations that Opposer comes before the Board in this proceeding with unclean hands.

C. Even if the Board Were To Find That Opposer's Hands Are Unclean, Such A Finding Will Not Extinguish Opposer's Common Law Rights And Will Not Bar Opposer From the Relief Sought

Even if the Board were to rule that Opposer's hands are unclean as a result of its conduct in prosecuting the '418 and '420 Applications, such a finding does not extinguish Opposer's common law trademark rights in the IMPACT SPORTS mark or its right to pursue its opposition to the Application based on those common law rights. See *VIP Foods Inc. v. V.I.P. Food Products*, 200 USPQ 105, 114 (TTAB 1978).; see also *Ginseng-Up Corp. v. American Genseng Co.*, 215 USPQ 471, 473 (SDNY 1981); *Duffy-Mott Company v. Cumberland Packing Company*, 165 USPQ 422 (CCPA 1972). Therefore, even if the Board rules in favor of Applicant on the issue of the cleanliness of Opposer's hands, Opposer would still be entitled to its requested relief on the issue of likelihood of confusion because it is relying on its common law trademark rights to oppose the Application.

CONCLUSION

Applicant has conceded that Opposer has priority over Applicant concerning use of the IMPACT SPORTS mark. There is no question that Applicant's mark and Opposer's mark are legally identical and Applicant cannot and does not dispute this obvious fact in its Response. Furthermore, although Applicant attempts to argue in its Response that its goods are different from Opposer's goods and services, Applicant cannot escape the obvious fact that the clothing goods identified in the Application are identical to Opposer's clothing and sports related goods and services. Finally, Applicant cannot and does not dispute the obvious fact that the description of goods in the Application is not limited to any particular channels of trade or class of purchasers. As a result, the Board must presume that the channels of trade and class of purchasers for Applicant's goods are the same as those for Opposer's identical goods and services.

In the end, the undisputed facts that Opposer has priority of use and that the marks of the parties are identical, combined with the indisputable facts that the goods of Applicant are identical to the goods and services of Opposer, the channels of trade for the parties' goods and services are identical, and the class of purchasers for the parties' goods and services are identical, can lead to no-other result than summary judgment in Opposer's favor. For these reasons, Opposer respectfully submits that the Board grant it summary judgment, sustain the Opposition, and refuse registration to Applicant.

Dated this 2nd day of June, 2008.

Respectfully submitted,

/Joseph W. Byrne/

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CERTIFICATE OF SERVICE

I hereby certify and declare under penalty of perjury that I served a true and correct copy of this document upon Attorney Michael Catania, attorney for Applicant Impact Sports Technologies, Inc., by depositing such copy with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Attorney Michael Catania, Clause Eight Intellectual Property Services LLP, P.O. Box 131270, Carlsbad, California 92013 on the 2nd day of June, 2008.

/Joseph W. Byrne/

Executed on June 2, 2008

Joseph W. Byrne
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