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

|                        |   |
|------------------------|---|
| Proceeding             | 91186206  |
| Party                  | Plaintiff<br>General Motors Company   |
| Correspondence Address | CHANILLE CARSWELL<br>BROOKS KUSHMAN PC<br>1000 TOWN CENTER, 22ND FLOOR<br>SOUTHFIELD, MI 48075<br>UNITED STATES<br>ccarswell@brookskushman.com, tcunningham@brookskushman.com,<br>lsavage@brookskushman.com, hshovein@brookskushman.com |
| Submission             | Reply in Support of Motion  |
| Filer's Name           | Chanille Carswell   |
| Filer's e-mail         | ccarswell@brookskushman.com, tcunningham@brookskushman.com,<br>lsavage@brookskushman.com, hshovein@brookskushman.com  |
| Signature              | /chanille carswell/   |
| Date                   | 07/28/2011  |
| Attachments            | GM Reply in support of Mtn for Summary Jmt.pdf ( 8 pages )(254874 bytes )   |

**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

GENERAL MOTORS COMPANY, )  
 )  
 Opposer, )  
 )  
 v. )  
 )  
 CALIFORNIA MOTORS LLC, )  
 )  
 Applicant. )

Serial No. 77/362,098

Opposition No. 91186206

**OPPOSER'S REPLY IN SUPPORT OF MOTION  
FOR PARTIAL SUMMARY JUDGMENT**

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## I. ARGUMENTS

### A. **Respondent Has Not Come Forward With Evidence Which Raises A Material Issue Of Fact**

In response to a motion for summary judgment, “[t]he nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial.” *Venture Out Properties LLC v. Wynn Resort Holdings LLC*, 81 USPQ2d 1887, 1890 (TTAB 2007); *see also Anderson v. Liberty Lobby, Inc.*, 477 US 242, 250 (1986). Respondent California Motors LLC (“California Motors”) failed to carry its burden.

In its opening brief, Opposer General Motors Company (“GM”) presented evidence and authority which established that it has priority of use of the EV1 mark, that California Motors seeks a registration for the identical mark for identical goods, and that the indisputable similarities in the proposed mark are likely to cause confusion in the marketplace, given the unique history of GM’s use of the identical mark in connection with pioneering auto technology. *See* Exhs. A, B, D-F, J, K.<sup>1</sup> California Motors, however, did not come forward with any evidence with respect to these issues which rebuts the evidence and authority presented by GM.

Instead, California Motors baldly proclaims without any substantiating evidence or authority that confusion is unlikely because (1) cessation of EV1 vehicle production was unpopular with some consumers, as demonstrated by the film *Who Killed the Electric Car?*, (2) there is no expectation that GM will reintroduce an EV1 vehicle, and (3) GM has produced an electric hybrid vehicle under a different name, namely the Chevrolet Volt. Again, however,

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<sup>1</sup> Note that GM refers to and incorporates by reference the Exhibits (A-M) attached to its opening brief. For ease of reference, it further continues the same sequence for the Exhibits attached to this Reply.

California Motors failed to cite any evidence to establish the factual or legal basis of any of these claims or, if true, that they establish even *prima facie* that confusion is unlikely. Indeed, there is no factual or legal support for these claims.

That is, films such as *Who Killed the Electric Car?* actually heightened interest in the EV1 vehicle and consumers' association of the EV1 mark with GM as is evident from the extensive media discourse which followed. *See e.g.* Exh. N; Exh. O. Therefore, if anything, the controversy drew more attention to the EV1 mark and its association with GM and the EV1 vehicle, making confusion more likely. Secondly, as California Motors has not conducted a survey or otherwise polled consumers, there is no basis for its proclamation that the public does not expect GM to reintroduce an EV1 vehicle. Lastly, GM's production of one vehicle clearly does not preclude it from producing another under a different name, including EV1, if it so chooses. So, the mere fact that GM has produced another vehicle using electric hybrid technology, namely the Volt, does not minimize the likelihood that consumers would be confused if California Motors begins using a mark which the public has associated with GM for over 15 years in exactly the same way that GM has used the mark.

In short, California Motors' unsupported, conclusory assertions amount to nothing more than attorney argument. However, "[i]n countering a motion for summary judgment, more is required than mere assertions of counsel." *Sweats Fashion, Inc. v. Pannill Knitting Co.*, 4 USPQ2d 1793, 1795 (Fed. Cir. 1987) (citation and quotation marks omitted). Therefore, California Motors' claims are insufficient to raise a question of fact on the issue of likelihood of confusion.

**B. Respondent Has Not Come Forward With Evidence Which Refutes GM's Showing Of Residual Goodwill In EV1**

California Motors does not deny that the existence of residual goodwill negates a claim of abandonment. *See Seidelmann Yachts Inc. v. Pace Yacht Corp.*, 14 USPQ2d 1497, 1501-1502 (D. Md. 1989). Nor has California Motors come forward with any evidence to rebut GM's showing that it, in fact, has enjoyed continued consumer recognition and goodwill in its EV1 mark since the inception of the EV1 vehicle, in the years after production of the vehicle ceased in 2003,<sup>2</sup> and still today. *See* Exhs. D-F, J, K. Therefore, as discussed more fully below, California Motors' claim of abandonment does not insulate it from summary judgment.

A period of non-use of a trademark gives rise to a presumption of the intent not to resume use. *Sterling Brewers, Inc. v. Schenley Industries, Inc.*, 169 USPQ 590, 593 (CCPA 1971). However, that presumption is rebutted where a party shows that "circumstances . . . do not justify an inference of intent not to resume use . . . ." *Id.* For example, the Board in *Sterling Brewers, Inc. v. Schenley Industries, Inc.*, *supra*, explicitly held that a demonstration of goodwill built up in a mark, irrespective of a period of non-use as long as 8 years, is sufficient to overcome the presumption of abandonment. *Id.* The Board found this to be the case, reversing the grant of the petition to cancel, despite the fact that the respondent's predecessor did nothing more during the 8-year hiatus than maintain the facility where products were manufactured under the disputed mark and attempt to sell the facility and the trademark. *Id.* at 592.

California Motors attempts to distinguish *Sterling Brewers* based on the fact that, in that case, the period of non-use was prompted by a labor dispute—a so-called "outside force." However, there is no indication that the Board's decision was based on or influenced by the fact

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<sup>2</sup> There is no merit to California Motors' attempt to create a question of fact about whether GM continuously manufactured distributed and leased the EV1 vehicle through 2003, because California Motors has already admitted this fact in its Answer to GM's Notice of Opposition. *See* GM Notice of Opp. at ¶3; California Motors Answer at ¶3.

that non-use may have been involuntary. Rather, the Board focused on the goodwill that had built up in the mark as well as the fact that the petitioner was willing to pay a considerable sum for rights to the mark and the associated goodwill, despite 8 years of non-use.<sup>3</sup> Likewise, in *Skippy, Inc. v. CPC Intern., Inc.*, 216 USPQ 1061, 1066 (4<sup>th</sup> Cir. 1982), the Court declined to find abandonment despite 23 years of non-use even though there was no evidence of intent to resume use and no indication that cessation of use was involuntary.

Here, GM built up goodwill (1) during its manufacture, distribution and lease of the EV1 from 1996 through 2003, (2) by extensive marketing of the EV1 vehicle at a cost of approximately \$50 million, (3) by virtue of the groundbreaking innovation that the EV1 represents, (4) by continued use of the mark in marketing and promotional activities even after production of the vehicle ceased in 2003, including a 2005 donation of an EV1 vehicle to the Smithsonian, donation of an EV1 vehicle to educational institutions for academic use (which continued to be driven as late as 2007), and promotion of the EV1 vehicle as the technological basis for the 2010 Chevrolet Volt since as early as 2006. *See* GM Notice of Opp. at ¶3; California Motors Answer at ¶3; Exh. C at ¶¶10, 24, 26; Exh. G; Exh. H at pp. 9, 16; Exh. P at ¶18. And, through its unrefuted evidence of numerous articles, blogs, books, clubs, and a film documentary about GM and the EV1 vehicle, GM has shown that this goodwill exists and has been sustained essentially since the inception of the EV1 vehicle. *See* Exhs. D-F, K, J.

It is also important to note that, contrary to California Motors' suggestion, GM does not have to present facts which are the mirror-image of any particular prior case in order to rebut the

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<sup>3</sup> The Board stated that the petitioner's interest "amount[ed] to substantial evidence that the mark still had significance as an indication of origin and a symbol of good will." *Id* at 593. So too here, California Motors' interest in obtaining the identical mark for the identical types of goods alone speaks volumes about the mark as a continuing source of goodwill. For California Motors to claim otherwise defies logic and reason.

presumption of abandonment, inasmuch as the Board has noted that “the determination of abandonment is peculiarly dependent on the facts of each particular situation and remarks in prior opinions are of little help.” *Sterling Brewers*, 169 USPQ at 593. The necessity for a case-by-case analysis is, in fact, illustrated by the unprecedented circumstances presented here.

That is, GM used the EV1 to launch a groundbreaking product and technology which captured national (if not worldwide) attention. For several years after production of the EV1 vehicle, GM and the EV1 vehicle continued to be the subject of intense and expansive media and consumer scrutiny, while GM also continued to utilize the mark in marketing and promotional activities. And, beginning as early as 2006, there was yet another surge of media and consumer interest in GM and its association with the EV1 vehicle as the EV1 vehicle served as a platform for further innovation by GM in electric vehicle technology. In all, GM has shown that the public has made a consistently strong connection between the EV1 mark and GM for the past 15 years. While these are undoubtedly a unique set of circumstances, they are no less a compelling demonstration of residual goodwill than was established in *Sterling Brewers* and *Skippy*.

Finally, California Motors’ claim that GM has not “‘maintained conditions conducive to resumption of production’ of any automobile under the EV1 mark” is contradicted by its attempt to register the mark for automobiles. Indeed, the fact that California Motors wants to produce automobiles under the EV1 mark shows that it obviously does not believe that any of GM’s actions have foreclosed such an endeavor. The question is whether California Motors should be allowed to do so by trading on the goodwill that GM has established in the mark. The Board and courts have repeatedly said “No.” See *Sterling Brewers*, 169 USPQ 590, 593; *Skippy*, 216 USPQ at 1066.

## II. CONCLUSION

For all of the aforementioned reasons, the Opposer respectfully requests that the Board grant its Motion for Summary Judgment in its entirety, enter judgment for the Opposer, and refuse to register Application Serial No. 77/362,098.

Respectfully submitted,

**BROOKS KUSHMAN P.C.**

By:           /Chanille Carswell/            
Mark A. Cantor  
Thomas W. Cunningham  
Chanille Carswell  
1000 Town Center, 22nd Floor  
Southfield, MI 48075-1238  
Phone: 248-358-4400  
Fax: 248-358-3351  
*Attorneys for Opposer*

Date: July 28, 2011



**CERTIFICATE OF SERVICE**

I certify that I served:

**OPPOSER'S REPLY IN SUPPORT OF MOTION FOR PARTIAL SUMMARY  
JUDGMENT AND BRIEF IN SUPPORT**

on July 28, 2011 by:

delivering

✓ mailing (via First-Class mail)

a copy to:

SaraLynn Mandel  
Mandel Law  
645 Lynwood St.  
Thousand Oaks, CA 91360

\_\_\_\_\_/Chanille Carswell/\_\_\_\_\_  
Chanille Carswell