

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

wbc

Mailed: November 19, 2014

Opposition No. 91202952

Atari Interactive Inc.

v.

Andrew N. Greenberg

Wendy Boldt Cohen, Interlocutory Attorney:

This case now comes up for consideration of Atari Interactive Inc.'s ("Opposer") motion (filed July 31, 2014) to strike Andrew N. Greenberg's ("Applicant") Exhibits A3, and A07-A17 in Applicant's Notice of Reliance filed July 17, 2014. The motion has been fully briefed. The Board has considered the parties' submissions and presumes the parties' familiarity with the arguments made therein. The parties' arguments will not be summarized herein except as necessary to explain the Board's decision.

Exhibits A3, A07-A08, and A11-A17

Opposer alleges, with respect to Exhs. A3, A07-A08, and A11-A17, various Internet printouts, Applicant has failed to indicate the relevance of the material offered and therefore, the exhibits should be stricken from the record.

Pursuant to *Safer*, a document obtained from the Internet may be admitted into evidence pursuant to a notice of reliance in the same manner as a printed publication in general circulation, in accordance with Trademark

Rule 2.122(e), so long as the date the Internet documents were accessed as well as their source (the Internet address or URL) is provided and the party filing the notice of reliance indicates the general relevance of the documents. *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1759 (TTAB 2013), *aff'd* 565 Fed. Appx. 900 (Fed. Cir. 2014), *citing Safer, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010). *See also* TBMP § 704.08(b) (2014). To meet the requirement that the notice of reliance indicate the general relevance of material being offered, the offering party should associate the materials with a specific factor relevant to likelihood of confusion or a specific fact relevant to determining a particular issue. *Safer*, 94 USPQ2d at 1039-40. If the offering party introduces the same document to support more than one element of a claim or defense, or more than one relevant fact, the propounding party should also indicate the specific element or fact supported by the various documents in a group of documents. *Id.* at 1040. For example, under *Safer*;

[I]f printed materials or Internet web pages introduced through a notice of reliance are submitted to show the similarity of the products, the similarity of the channels of trade, and the strength of the mark, ***the propounding party should identify which of the documents support each element or fact*** (e.g., plaintiff's exhibits 1-10 demonstrate the similarity of the products, plaintiff's exhibits 3-5 and 11-15 demonstrate the similarity of the channels of trade, and plaintiff's exhibits 7-8, 16 and 16-30 demonstrate the strength of plaintiff's mark).

Id. at 1040 (emphasis added).

Here, Applicant has submitted exhibits, purporting to indicate the relevance of same in the Notice of Reliance and in its response to the motion to

strike, without specifying the *du Pont* factors for which the evidence is pertinent.¹ Applicant should have indicated which web page or group of web pages within each exhibit support each specific *du Pont* factor. *Safer*, 94 USPQ2d at 1040.

Notwithstanding the foregoing, “[w]hen a motion to strike a notice of reliance is filed on the ground that it does not meet the procedural requirements of the rules, and the Board finds that the notice is defective but that the defect is curable, the Board may allow the party which filed the notice of reliance time in which to cure the defect, failing which the notice will stand stricken.” *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230, 1233 (TTAB 1992), *citing Heaton Enterprises of Nevada Inc. v. Lang*, 7 USPQ2d 1842 (TTAB 1988). Such a defect is one that can be cured by the offering party as soon as it is raised by any adverse party, without reopening the testimony period of the offering party. *Safer*, 94 USPQ2d at 1040. Therefore, inasmuch as this error in filing is correctable, Applicant is allowed until **FIFTEEN (15) DAYS** from the mailing date of this order to submit to the Board a revised notice of reliance relating to Exhibits A3, A07-A08, and A11-A17 submitted on July 17, 2014, that indicates which web pages relate to which likelihood of confusion factor. If Applicant fails to comply, the exhibits may not be considered.

Exhibits A09-A10

Opposer argues that Exhibit A09 is a TESS printout of an apparent trademark search and that Applicant has not indicated the relevance of the

¹ The ground upon which the notice of opposition was filed is likelihood of confusion.

material offered in Exh. A09. Further, Opposer argues that because Exh. A09 is a list of applications and registrations not of record, it is inadmissible.

Applicant appears to argue that because the trademark search was generated from the TESS website and not a general search engine, Exhibit A09 is a permissible under a notice of reliance.

Exhibit A10 appears to be a TESS printout of a third party registration for the mark HAUNTED HOUSE. Opposer alleges that Applicant has not indicated the relevance of the material offered in Exh. A10 and therefore, it should be stricken from the record.

A party that wishes to make a third-party registration of record in a Board inter partes proceeding may do so by filing, during its testimony period, a plain copy of the registration or a printout of the registration from the Office's electronic database records, together with a notice of reliance thereon specifying the registration and indicating generally its relevance. *See* Trademark Rule § 2.122(e); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1070 n.11 (TTAB 2011) (not necessary to submit title and status copies of third-party registrations prepared by Office; plain copies from the USPTO's electronic database would have sufficed). On the other hand, a party may not make a third-party registration of record simply by introducing a list of third-party registrations that includes it; or by filing a trademark search report in which the registration is mentioned. *See, e.g., Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012) (listing of third-

party marks downloaded from Office database does not make registrations of record); *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1829 n.8 (TTAB 2012) (summary of search results from USPTO's electronic database is not an official record of the Office); TBMP § 704.03(b)(1)(B). “The summary listings of third-party applications and registrations retrieved from searches of terms in the USPTO’s TESS database are not official records and therefore are not appropriate material for a notice of reliance.” *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1219 (TTAB 2011). The *Safer* holding allowing documents printed from internet websites to be made of record by notice of reliance does not apply to search summaries, which are more in the nature of listings of documents, i.e., the website pages that the summary links to, than to the documents per se. See *Calypso Technology Inc.*, 100 USPQ2d at 1219; *Safer, Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031, 1039 (TTAB 2010).

In view thereof, Opposer’s motion to strike Exhibit A09 is **granted** because it is a search summary in the nature of a listing of third-party applications and registrations and fails to indicate to which likelihood of confusion factor the evidence is relevant. The motion to strike Exhibit A10 is **granted** because, as discussed above, the relevancy as to the specific likelihood of confusion factor of this third-party registration has not been provided.

Notwithstanding the foregoing, inasmuch as this error in filing is correctable, Applicant is allowed until **FIFTEEN (15) DAYS** from the mailing date

of this order to submit to the Board a revised notice of reliance which remedies the procedural defects noted above, namely to:

1. provide the Board with a plain copy of the application/registration or a printout of the application/registration from the Office's electronic database records noted in the list contained in Exhibit A09, together with a notice of reliance thereon specifying the application/registration and indicating generally its relevance by explaining which likelihood of confusion factor it assertedly supports; and
2. Indicate the relevance of Exhibit A10 by explaining which likelihood of confusion factor it assertedly supports.

If Applicant fails to comply, the exhibits may not be considered. *See Weyerhaeuser Co.*, 24 USPQ2d at 1233; TBMP § 704.03(b)(1)(B).

Proceedings herein are resumed. The Board deems the filing of the motion to strike as tolling the remaining dates and resets dates as follows:

Plaintiff's Rebuttal Disclosures	11/27/2014
Plaintiff's 15-day Rebuttal Period Ends	12/27/2014

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.