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

Proceeding	91204389
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In the matter of trademark application Serial No. 85/134,559
For the mark: COPPER
Published in the Official Gazette on: Sept. 13, 2011

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In the matter of trademark application Serial No. 85/134,552
For the mark: 29 CU COPPER
Published in the Official Gazette on: Sept. 13, 2011

Coppermark Bank, an Oklahoma corporation Opposer, v. Coastal Federal Credit Union, a federally chartered credit union Applicant.	)	Opposition No. 91204389

OPPOSER'S BRIEF IN RESPONSE TO APPLICANT'S MOTION FOR JUDGMENT ON THE PLEADINGS

Coppermark Bank ("Coppermark") possesses common law rights in the mark COPPERMARK for precisely the same goods and services listed in Coastal Federal Credit Union's ("Applicant's") applications for COPPER and 29 CU COPPER. As alleged in the Notice of Opposition ("Opposition"), the Applicant's proposed marks are to be used in connection with identical good and services, in identical markets, and with identical distribution channels. Applicant's Motion for Judgment on the Pleadings fails to acknowledge, much less address, Coppermark's common law rights, but instead boldly asserts there are no facts that could demonstrate a likelihood of confusion. Applicant's position is untenable. A proper examination

of the undisputed material facts, an analysis of all thirteen *DuPont* factors and resolving all doubts in Coppermark's favor, clearly demonstrates that a likelihood of confusion exists.

Applicant moved for judgment on the pleadings on the ground that, even assuming that all of Coppermark's allegations are true, "there is no likelihood of confusion between Applicant's marks and Coppermark's marks **as a matter of law**." Applicant's Mot. for J. on the Pleadings 2 (emphasis added). However, Applicant ignored several significant material facts stated in Coppermark's Opposition, such as Coppermark's common law trademark rights. Additionally, Applicant ignored relevant factors from *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1990), which should be applied to determine whether there is a possibility of confusion. Instead of addressing each of the applicable *DuPont* factors, Applicant addresses only a single factor, namely the "appearance, sound, connotation and commercial impression" of the marks. Applicant's Mot. for J. on the Pleadings 3-6. Because Applicant has failed to meet its burden of showing that there is no genuine issue of material fact and that Applicant is entitled to judgment as a matter of law, the Board should deny Applicant's motion for judgment on the pleadings. *See* TBMP § 504.02.

I. STANDARD OF REVIEW

The Board may grant a motion for judgment on the pleadings only when "there is no genuine issue of material fact to be resolved, and the moving party is entitled to judgment, on the substantive merits of the controversy, as a matter of law." TBMP § 504.02. For the purposes of the motion, the Board examines "the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice." *Id*. Because Coppermark is the nonmoving party, the Board must treat Coppermark's factual allegations as true and draw all reasonable inference in favor of Coppermark. *See id*.

II. APPLICANT OMITTED SEVERAL SIGNIFICANT MATERIAL FACTS ALLEGED IN THE OPPOSITION.

Applicant incorrectly states that all of the material facts relevant to the motion are listed in paragraphs four and eight of the Opposition. *See* Applicant's Mot. for J. on the Pleadings 2-3. Contrary to this assertion, Coppermark alleged several other significant facts in the Opposition and reiterates them here:

> 3. Prior to Applicant's filing date for both the COPPER and 29 CU COPPER applications . . . and prior to any use by Applicant, Opposer adopted and has continuously and exclusively used the mark COPPERMARK . . . as a trademark for various goods/services including but not limited to the Opposed Goods and Services.
>
> . . . .
>
> 5. Since November 17, 2004, Opposer has extensively, continuously and without interruption used its COPPERMARK mark in connection with the Registered Goods and Services, which include but are not limited to the Opposed Goods and Services. By reason of Opposer's activities, Opposer's COPPERMARK mark has become well known to the relevant public as identifying and distinguishing Opposer, Opposer's business, and Opposer's goods and services from those of others. Opposer, through great expense and quality control, has created, and is the owner of, substantial goodwill, consumer recognition and reputation in the COPPERMARK mark for both the Registered Goods and Services and the Opposed Goods and Services. Accordingly, Opposer possesses common law trademark rights in the COPPERMARK mark in connection with the Registered Goods and Services and the Opposed Goods and Services.
>
> . . . .
>
> 7. Applicant's marks are substantially identical in appearance, sound and connotation to Opposer's mark. Applicant's marks so resemble Opposer's mark as to be likely, when used in connection with Opposed Goods and Services, to cause confusion, to cause mistake, or to deceive the consuming public.
>
> . . . .
>
> 9. Due to the similarities in Applicant's marks and Opposer's mark, the similarities in the goods and services used, or to be used, with the respective marks, and the overlap in consumers who purchase, or will purchase, goods related to the respective marks, Applicant's marks are likely to be confused with and mistaken for Opposer's mark, so as to cause confusion and lead to deception as to source, sponsorship, or affiliation by the consuming public.

Coppermark's Notice of Opp'n ¶¶ 3-9. The Board must treat all of Coppermark's factual allegations listed in these paragraphs as true for the purposes of the motion. *See* TBMP § 504.02.

III. APPLICANT FAILED TO ESTABLISH THAT THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN THE MARKS AS A MATTER OF LAW.

In deciding whether there is a possibility of confusion, the Board should consider the thirteen factors from *E.I. DuPont*, 476 F.2d at 1361. There is no formula for applying the factors, and one factor may be most important in a given case. *See id.* at 1361-62. **If there is any doubt as to the risk of confusion, the Board must resolve that doubt in favor of the existing registrant.** *See In re Shell Oil Co.,* 992 F.2d 1204, 1209 (Fed. Cir. 1993) (emphasis added).

A. The marks are similar in appearance, sound, connotation, and impression.

Applicant's Motion addresses only the first factor of the *DuPont* analysis, namely the "similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." *E.I. DuPont*, 476 F.2d at 1361. Applicant's arguments notwithstanding, the COPPERMARK mark is very similar to both the proposed COPPER and 29 CU COPPER marks in both appearance and sound. Importantly, the identical term "copper" is shared between each of the marks and makes up the dominant portion of each mark. Additionally, the marks have a similar connotation and commercial impression, namely an identification with the metal "copper." Because of this similar connotation, consumers are likely to confuse the marks as identifying the same source of goods and services.

Applicant's suggestion that COPPERMARK "has an entirely different meaning" because it refers to a "coppersmith's stamp" and 29 CU COPPER refers to the periodic table is ridiculous. Applicant's Mot. for J. on the Pleadings 5. Applicant's argument relies upon a presumption that consumers are sophisticated enough to distinguish between elemental copper and refined copper utilized in the production of copperwares. Applicant offers no evidence to

support this unfounded presumption. Because a motion for judgment on the pleadings requires the Board to draw reasonable inferences in favor of Coppermark, the Board must presume that consumers are not so sophisticated and that confusion is therefore likely in this case. *See* TBMP § 504.02

The Federal Circuit and the Board have previously compared marks with similar characteristics as those at issue in this case and have found marks containing the same word to be so similar as to cause confusion. *See, e.g.*, *In re Mighty Leaf Tea*, 601 F.3d 1342, 1347-48 (Fed. Cir. 2010) (ML and ML MARK LEES for similar skin-care products); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee en 1772*, 396 F.3d 1369, 1372-73 (Fed. Cir. 2005) (VEUVE ROYALE for wine and VEUVE CLICQUOT and VEUVE CLICQUOT PONSARDIN for champagne); *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1343 (Fed. Cir. 2004) (GASPAR'S ALE for beer and JOSE GASPAR GOLD for tequila); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (T.T.A.B. 2009) (VANTAGE TITAN for MRI equipment and TITAN for ultrasound equipment); *In re El Torito Rests. Inc.*, 9 USPQ2d 2002, 2004 (T.T.A.B. 1988) (MACHO COMBOS and MACHO for food items); *In re Equitable Bancocorporation*, 229 USPQ 709, 711 (T.T.A.B. 1986) (RESPONSE and RESPONSE CARD for banking services). These cases clearly establish that where a proposed term ("copper") is entirely incorporated into an existing mark (COPPERMARK), a likelihood of confusion is certainly possible, if not likely. At a minimum, the above cited authority demonstrates that Applicant is not entitled to a finding that COPPERMARK is so dissimilar to COPPER and 29 CU COPPER as to make confusion unlikely **as a matter of law**.

Applicant attempts to circumvent this preponderance of authority by citing several cases for its proposition that marks incorporating the same word can be so dissimilar as to establish

that confusion is unlikely as a matter of law. Applicant's Mot. for J. on the Pleadings 3-4 (citing *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 47 USPQ2d 1459, 1460 (Fed. Cir. 1998) (CRYSTAL CREEK for wine and CRISTAL for champagne); *Kellogg Co. v. Pack'Em Enters., Inc.*, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (FROOT LOOPS for cereal and FROOTEE ICE for frozen desserts); *Keebler Co. v. Murray Bakery Prods.*, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989) (PECAN SANDIES and PECAN SHORTIES for cookies)). These cases are readily distinguishable from the facts and allegations in this matter. Each of the marks in Applicant's authority describes the characteristics of the product. Thus, "crystal" describes the quality of wine, "froot" refers to a flavor, and "pecan" describes a type of cookie. Because these terms are descriptive, a consumer would focus on the unique, non-descriptive portion of the marks to identify a particular brand. For example, a consumer seeking to purchase pecan cookies would focus on "sandies" or "shorties," rather than "pecan."

Consequently, the terms and marks at issue in the cases identified by Applicant are not helpful in an analysis of the term "copper" as used in the marks at issue in this case. Importantly, Applicant's proposed marks for COPPER and 29 CU COPPER and Coppermark's mark COPPERMARK are simply names which do not describe any particular feature or characteristic of a bank. Accordingly, consumers will focus their attention on the identical and dominant portions of Applicant's and Coppermark's marks, the term "copper," making confusion more likely.

Because the Board must draw reasonable inferences in favor of Coppermark, the similarity in appearance, sound, connotation, and impression between the marks indicate that consumers may be confused by Applicant's proposed marks for COPPER and 29 CU Copper.

Accordingly, because the first *DuPont* factor indicates that confusion is likely, the Board should deny Applicant's motion for judgment on the pleadings.

B. The other twelve DuPont factors also indicate that confusion is likely to occur.

While Applicant fails to address the remaining *DuPont* factors, consideration of these factors clearly demonstrates that confusion is likely. Accordingly, the Board should consider factors two through thirteen:

> (2) [t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use,
>
> (3) [t]he similarity or dissimilarity of established, likely-to continue trade channels,
>
> (4) [t]he conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing,
>
> (5) [t]he fame of the prior mark (sales, advertising, length of use),
>
> (6) [t]he number and nature of similar marks in use on similar goods,
>
> (7) [t]he nature and extent of any actual confusion,
>
> (8) [t]he length of time during and conditions under which there has been concurrent use without evidence of actual confusion,
>
> (9) [t]he variety of goods on which a mark is or is not used . . .
>
> (10) [t]he market interface between [the parties] . . .
>
> (11) [t]he extent to which applicant has a right to exclude others from use of its mark on its goods,
>
> (12) [t]the extent of potential confusion, i.e., whether *de minimis* or substantial, [and]
>
> (13) [a]ny other established fact probative of the effect of use.

E.I. DuPont, 476 F.2d at 1361 (punctuation altered). Treating all of Coppermark's factual allegations as true for the purposes of Applicant's motion for judgment on the pleadings, these

remaining factors strongly indicate a likelihood of confusion between Applicant's proposed marks and Coppermark's COPPERMARK mark. *See* TBMP § 504.02.

To begin with, taking Coppermark's allegations in its Notice of Opposition as true, the goods and services in question "are virtually identical." Coppermark's Notice of Opp'n ¶ 8. Therefore, the second factor indicates that confusion is likely. Similarly, Coppermark alleges that many of the same consumers purchase goods from both Coppermark and Applicant, so the third factor shows that confusion is not only likely, but probable. *See id.* at ¶ 9. Further, Coppermark also alleges that the COPPERMARK "mark has become well known to the relevant public," meaning the fifth factor also weighs in favor of a finding of a likelihood of confusion. *Id.* at ¶ 5. In short, these three *DuPont* factors strongly indicate that confusion is likely to occur.

Although the pleadings provide no information about the remaining nine factors, the *DuPont* court itself noted that when "there is some indication that confusion may be likely . . . the question must *remain open* . . . until any or all of the elements . . . have been reviewed and studied, the final decision being made on the basis of the entire record." *E.I. DuPont*, 476 F.2d at 1362. Because four of the factors favor Coppermark, and there is insufficient discovery regarding the remaining factors, the Board should deny Applicant's motion for judgment on the pleadings.

C. Denial of registration of Applicant's marks does not grant Coppermark exclusive rights in the term "copper."

Applicant argues that, if Coppermark succeeds in opposing the COPPER and 29 CU COPPER registrations, Coppermark would "possess exclusive rights to the term 'copper' alone when used with respect to financial and investment services." Applicant's Mot. for J. on the Pleadings 5. However, it is unclear how this would occur. Denying registration of Applicant's marks will not grant Coppermark exclusive rights in the term "copper." Regardless of the

outcome of Coppermark's opposition of the COPPER and 29 CU COPPER registrations, Coppermark's rights do not extend beyond its existing federal registration and common law rights. Another entity could still register a mark that includes "copper" in connection with goods and services not covered by Coppermark's existing federal registration and common law rights.

Nevertheless, ignoring the fact that its applications include the exact same goods and services as those associated with Coppermark's mark, Applicant presses forward with its policy argument, relying on a series of third party registrations that include the term "copper." It is well established that third party registrations cannot justify the registration of yet another confusingly similar mark. *In Re Toshiba Med. Sys. Corp.*, 91 U.S.P.Q.2d 1266 (T.T.A.B. 2009) ("As we have said innumerable times, prior decisions on other marks for other goods are of very little help one way or the other in cases of this type. Each case must be decided on its own facts and the differences are often subtle ones."). Furthermore, Applicant has not properly made these third-party registrations of record, so the Board should not consider them. *See* TBMP § 704.03(b)(1)(B) (explaining that "[t]he Board does not take judicial notice of registrations" and providing a procedure for introducing third-party registrations).

Even if the Board decides to consider these third-party registrations, there is still no basis for Applicant's policy argument because the goods and services associated with the third-party registrations are significantly different than those associated with the marks at issues in this matter. Coppermark's federal registration for COPPERMARK covers "[c]ommercial and consumer banking, estate trust management, lending, funds investment [and] [c]ommercial and consumer financial services, namely, investment securities." U.S. Registration No. 3,118,247. Additionally, Coppermark possesses common law rights in COPPERMARK for the same goods and services listed by Applicant in its applications for COPPER and 29 CU COPPER, including

"banking, credit card, debit card consumer lending and financial services." Coppermark's Notice of Opp'n ¶ 1, 5. By contrast, the third party registrations identified by Applicant are associated with substantially different goods and services, including transmission of electronic debit and credit transactions, business consulting services, brokerage services and the like. Accordingly, because the goods and services associated with Coppermark's mark are identical to those identified in Applicant's applications for COPPER and 29 CU COPPER, and distinguishable from those used by the third-party registrations, it is highly likely that consumers will be confused over the source of Applicant's marks. In short, not only has Applicant failed to properly introduce the third-party registrations, but Applicant's discussion of the third-party registrations is not germane to its motion for judgment on the pleadings.

V. Conclusion

Applicant has failed to show an absence of material facts which would entitle Applicant to Judgment on the pleadings as a matter of law. Taking Coppermark's factual allegations as true and drawing all reasonable inferences in favor of Coppermark clearly shows that there is a likelihood of confusion between Applicant's proposed marks for COPPER and 29 CU COPPER and Coppermark's COPPERMARK mark. Accordingly, Coppermark respectfully requests that the Board deny Applicant's motion for judgment on the pleadings.

Respectfully submitted,

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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being electronically transmitted via ESTTA to the United States Patent and Trademark Office on this 5th day of June, 2012.

/s/ Drew T. Palmer
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing *Notice of Opposition* was mailed first class mail, postage prepaid, this 5th day of June, 2012 to the following:

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