

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

CME

Mailed: October 22, 2013

Opposition No. 91205331 (parent)

Opposition No. 91205338

Ms. Teresa H. Earnhardt

v.

Kerry Earnhardt, Inc.

**Before Taylor, Mermelstein, Bergsman,  
Administrative Trademark Judges**

**By the Board:**

This case now comes up for consideration of opposer's fully-briefed motion for partial summary judgment, filed May 28, 2013, in the above-captioned consolidated opposition proceedings.

By way of background, applicant seeks registration of the mark EARNHARDT COLLECTION, in standard characters, for "Furniture"<sup>1</sup> and "Custom construction of homes,"<sup>2</sup> with a disclaimer of the term "collection." In the amended

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<sup>1</sup> Application Serial No. 85383910, filed on July 28, 2011, based on applicant's allegation of a *bona fide* intention to use the mark in commerce pursuant to Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

<sup>2</sup> Application Serial No. 85391456, filed on August 6, 2011, based on applicant's allegation of a *bona fide* intention to use the mark in commerce pursuant to Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

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notices of opposition, opposer alleges that applicant's mark is: (i) likely to falsely suggest a connection with "Dale Earnhardt or his successor-in-interest"; (ii) likely to cause confusion with opposer's prior registered mark DALE EARNHARDT for key rings, pocket knives, certain printed materials and entertainment services related to automobile racing, clothing, and miniature cars<sup>3</sup> and its common law marks EARNHARDT and DALE EARNHARDT; (iii) likely to dilute opposer's pleaded marks; and (iv) primarily merely a surname. In its answers, applicant denies the salient allegations in the amended notices of opposition. Opposer has moved for summary judgment only on the ground that the involved mark is primarily merely a surname.

As an initial procedural matter, we note that opposer has not adequately set forth claims for dilution because it has not pled that its marks became famous prior to the **filing dates** of the involved intent-to-use applications. See *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1174 (TTAB 2001). Opposer is allowed until **November 12, 2013** to replead its dilution claims by filing separate amended complaints in each of the consolidated cases, failing which, the existing allegations regarding dilution will be

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<sup>3</sup> Registration No. 1644237 issued on May 14, 1991; Section 8 affidavit accepted, Section 15 affidavit acknowledged, and twice renewed.

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stricken and the dilution claims will be given no further consideration. In the event that opposer files amended complaints, applicant is allowed until **December 2, 2013** to file its answers or to otherwise respond to the notices of opposition.<sup>4</sup>

With respect to opposer's motion, summary judgment is only appropriate where there are no genuine disputes as to any material facts, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(a). The party seeking summary judgment bears the burden of demonstrating the absence of any genuine dispute of material fact, and that it is entitled to a judgment under the applicable law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 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 Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). Evidence on summary judgment must be viewed in a light most

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<sup>4</sup> Complaints and answers, unlike other filings, must be filed in each separate consolidated proceeding.

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favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA, supra*. The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. See *Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1542.

Upon careful consideration of the arguments and evidence presented by the parties, and drawing all inferences with respect to the motion in favor of applicant as the non-moving party, we find that genuine disputes of material fact preclude granting summary judgment in favor of opposer on the claims that the involved mark is primarily merely a surname. There are genuine disputes regarding the surname significance of the term "Earnhardt" and whether, when considered as a whole, the primary significance of the involved mark to the purchasing public would be that of a surname. Accordingly, opposer's motion for summary judgment is hereby **DENIED**.<sup>5</sup>

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<sup>5</sup> The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat*

Proceedings herein are resumed, and discovery, disclosure, trial and other dates are reset as follows:

Deadline to File Any Amended Complaints	11/12/2013
Time to Answer Any Amended Complaints	12/2/2013
Expert Disclosures Due	1/21/2014
Discovery Closes	2/20/2014
Plaintiff's Pretrial Disclosures	4/6/2014
Plaintiff's 30-day Trial Period Ends	5/21/2014
Defendant's Pretrial Disclosures	6/5/2014
Defendant's 30-day Trial Period Ends	7/20/2014
Plaintiff's Rebuttal Disclosures	8/4/2014
Plaintiff's 15-day Rebuttal Period Ends	9/3/2014

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.

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*Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981). Furthermore, the fact that we have identified certain genuine disputes as to material facts should not be construed as a finding that these are necessarily the only disputes which remain for trial.