

coggins

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Mailed: July 26, 2013

Opposition No. 91208807

Dr. Stan Vaughan

v.

TradeAuthority, L.L.C.

**By the Board:**

Now before the Board is opposer's motion (filed March 18, 2013) for summary judgment on the grounds of priority and likelihood of confusion, and dilution. By way of its brief in opposition, applicant cross-moves in the alternative for leave to take discovery under Fed. R. Civ. P. 56(d).

Background

Opposer, appearing *pro se*, filed a notice of opposition on January 11, 2013, followed by an amended notice of opposition on January 14, 2013, against application Serial No. 85518008 for the mark SMARTER BARTER (in standard

characters).<sup>1</sup> On January 29, 2013, the amended notice of opposition was accepted as a matter of course under Fed. R. Civ. P. 15(a) and became opposer's operative pleading for this proceeding. In the amended notice of opposition, opposer indicates the grounds for opposition as deceptiveness; false suggestion of a connection; priority and likelihood of confusion; dilution; and "other grounds," claiming, *inter alia*, that the "owner of Smarter Barter trademark currently has registration of the mark used in commerce since 1992 Nevada State registration certificate C20130107-0219" [sic], and "Stan Vaughan, owner of trademark Smarter Barter TM already has clients in numerous states and anticipates expansion throughout the United States and Internationally, (globally) of Smarter Barter Trade Exchange and services and goods" [sic].

Before the amended notice of opposition was associated with the case file, opposer requested Board participation in the parties' mandatory settlement and discovery conference. In the Board's order accepting the amended notice of opposition, opposer was informed that his request for Board participation in the conference was premature and that the

---

<sup>1</sup> Application Serial No. 85518008 was filed January 17, 2012, under Trademark Act § 1(b), for "barter exchange services, namely, providing commercial barter and trade exchange of products and services via a global computer information network; exchange services, namely, bartering of goods for others." No claim is made to the exclusive right to use BARTER apart from the mark as shown.

Board would contact the parties to schedule the conference after an answer to the amended notice of opposition was filed. When the answer was filed, the Board scheduled the conference; however, opposer - not waiting for the conference - filed the motion for summary judgment.

Motion for Summary Judgment

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to any material facts, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating that there is no genuine dispute of material fact remaining for trial and that it is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1987); and *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

---

By way of his motion, opposer moves for summary judgment only on the grounds of priority and likelihood of confusion, and dilution. Generally, only well pleaded issues may be the basis for grant of summary judgment. See *Consolidated Foods Corp. v. Berkshire Handkerchief Co., Inc.*, 229 USPQ 619, 621 (TTAB 1986); and *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1480 (TTAB 2009), citing *Intermed Communications, Inc. v. Chaney*, 197 USPQ 501, 503 n. 2 (TTAB 1977) ("If a claim has not been properly pleaded, one cannot obtain summary judgment thereon"). In view thereof, the Board must examine the amended notice of opposition to determine if opposer's allegations of priority and likelihood of confusion, and dilution, are well pleaded.

Upon review of the amended notice of opposition, the Board finds that neither likelihood of confusion nor dilution is sufficiently pleaded. See discussion of these grounds, *infra*. In view thereof, it would be futile to take up the merits of opposer's motion for summary judgment. Accordingly, the motion will be given no consideration and is effectively **denied** without prejudice.

Notwithstanding this treatment, the Board notes that, even if opposer had properly pleaded likelihood of confusion and dilution, the motion would have been denied because genuine disputes of material fact appear to remain, at a minimum, as to opposer's priority and the fame of opposer's

mark. Opposer failed to support any of the specific facts in the motion for summary judgment by affidavit or declaration or as otherwise provided in Fed. R. Civ. P. 56(c)(1). Moreover, opposer appears to rely on a state trademark registration which was not submitted with the motion or reply brief, and which is otherwise incompetent to establish opposer's common law trademark rights. See *The Bd. of Trs. of The Univ. of Alabama and Paul W. Bryant, Jr. v. William Pitts, Jr. and Christopher Blackburn*, \_\_\_ USPQ2d \_\_\_ n.83 (TTAB 2013, Opposition No. 91187103) ("ownership of a state trademark registration does not constitute evidence of common law trademark rights"). See also *Faultless Starch Co. v. Sales Producers Assocs., Inc.*, 530 F.2d 1400, 189 USPQ 141, 142 n.2 (CCPA 1976) (state registrations do not establish use); and *Kraft, Inc. v. Balin*, 209 USPQ 877, 880 (TTAB 1981) (although parties stipulated to introduction of state registration, said registration is incompetent to prove anything material to opposition proceeding).

#### Cross-Motion

In view of the treatment of the motion for summary judgment, applicant's alternative cross-motion for Rule 56(d) discovery is **moot**.

#### Amended Notice of Opposition

The amended notice of opposition is comprised of single-spaced paragraphs under five numbered headings,

specifically, (1) deceptiveness, (2) false suggestion of a connection to others, (3) priority and likelihood of confusion, (4) dilution, and (5) other grounds. As discussed below, none of the individual grounds is sufficiently pleaded. In view thereof, the entire amended notice of opposition is **stricken**, and opposer is allowed until **August 19, 2013**, in which to file a second amended notice of opposition; failing which, the opposition will be dismissed with prejudice. The second amended notice of opposition should comply with the formatting requirements of Fed. R. Civ. P. 10(b) ("A party must state its claims ... in numbered paragraphs, each limited as far as practicable to a single set of circumstances") and Trademark Rule 2.126(a)(1) ("A paper submission must be printed in at least 11-point type and double-spaced"). Applicant is allowed until **September 9, 2013**, in which to file an answer to the second amended notice of opposition.

Deceptiveness

In order to plead a proper claim of deceptiveness under Trademark Act § 2(a), 15 U.S.C. § 1052(a), opposer must plead that (1) applicant's involved mark misdescribes the identified services, (2) consumers would be likely to believe the misrepresentation, and (3) the misrepresentation would materially affect potential purchasers' decision to purchase

the product or service. See *In re Bulge*, 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988).

It appears that opposer attempted to allege a portion of a § 2(d) likelihood of confusion claim instead of any element of a § 2(a) claim. Section 2(d) prohibits registration of marks which are likely to deceive a consumer as to the source or origin of goods or services; by contrast, § 2(a) prohibits registration of marks which lead a consumer to draw a false conclusion about the nature or quality of goods or services under circumstances where such a conclusion will be material to the consumer's deliberations regarding purchase of the goods or services. See, e.g. *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894 (TTAB 1992) (issue was whether use of PARMA for meat products not made in Parma, Italy deceived consumers in regard to geographic origin of goods); *U.S. West Inc. v. BellSouth Corp.*, 18 USPQ2d 1307 (TTAB 1990) (issue was whether use of THE REAL YELLOW PAGES for telephone directories deceived consumers by suggesting that competitive directories were somehow invalid, inaccurate or incomplete).

Opposer has made no allegation as to how use of the SMARTER BARTER mark by applicant would be deceptive in relation to applicant's barter exchange services, and there is nothing in the pleading that would allege plausibility or materiality of a § 2(a) deceptiveness claim.

False suggestion of a connection

In order to properly assert a ground of false suggestion of a connection under Trademark Act § 2(a), 15 U.S.C. § 1052(a), opposer must plead that (1) applicant's mark is the same or a close approximation of opposer's previously used name or identity; (2) that the mark would be recognized as such, in that it points uniquely and unmistakably to opposer; (3) that opposer is not connected with the services offered by applicant under the mark; and (4) that opposer's name or identity is of sufficient fame or reputation that when applicant's mark is used in connection with its services, a connection with opposer would be presumed. See *Petróleos Mexicanos V. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010), and *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008). Although opposer implies that he is not connected with the services offered by applicant under the mark, opposer makes no specific allegations in the amended notice as to any of the necessary elements of this claim. Opposer should note that a false suggestion of a connection claim must involve opposer's name or identity -not merely a prior mark that opposer may own.

Priority and likelihood of confusion

In order to properly state a claim of priority and likelihood of confusion under Trademark Act § 2(d), 15



U.S.C. § 1052(d), opposer must plead that (1) applicant's mark, as applied to its services, so resembles opposer's mark as to be likely to cause confusion, mistake or deception; and (2) opposer has either priority of use or a federal registration of opposer's pleaded mark. See Fed. R. Civ. P. 8(a); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

It is unclear from the amended notice of opposition whether opposer claims ownership one, two, three, or four marks; what the priority date is for each mark; and what the goods and services are for each mark. For example, the amended notice contains references to SMARTER BARTER, SMARTER BARTER TM, a SMARTER BARTER logo, and SMARTER BARTER TRADE EXCHANGE. There is no reference to any specific goods or services in the body of the amended notice, but an attachment thereto (i.e., a state trademark registration certificate) references "caps and t-shirts, clothing."

#### Dilution

In order to properly state a claim of dilution under Trademark Act § 43(c), 15 U.S.C. § 1125(c), opposer must plead that his mark is famous and that his mark became famous prior to applicant's first use of the mark or applicant's filing date. See *General Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1595 n.13 (TTAB 2011); *The Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164, 1174

n.9 (TTAB 2001); *Polaris Indus. Inc. v. DC Comics*, 59 USPQ2d 1798, 1880 (TTAB 2000). In the amended notice of opposition, opposer does not allege that his mark became famous prior to the filing date of the subject application or prior to applicant's first use of its mark.

The Board advises opposer that "[f]ame for dilution purposes is difficult to prove ... The party claiming dilution must demonstrate by the evidence that its mark is truly famous." See *Toro Co. v. ToroHead Inc.*, *supra*, 61 USPQ2d at 1180. See also *Avery Dennison Corp. v. Sumpton*, 189 F.3d 1868, 51 USPQ2d 1801, 1805 (9th Cir. 1999) ("The Federal Trademark Dilution Act of 1995 applies only to a very select class of marks - those with such powerful consumer associations that even non-competing uses can impinge upon their value.").

Other grounds

Opposer may plead (and later prove) any other available statutory ground for opposition. See TBMP § 309.03(c). However, the "other grounds" in the amended notice of opposition appear to be nothing more than an (unsuccessful) attempt to allege priority and likelihood of confusion under § 2(d).

Had opposer not rushed to file his motion for summary judgment, and instead waited until the Board conducted the settlement and discovery conference, opposer would have been

informed of his defective pleading during the conference and could have saved the parties and the Board both time and resources.

Pro Se Information for Opposer

It appears that opposer is representing himself. Opposer may do so; however, it should be noted that while Patent and Trademark Rule 11.14 permits any person to represent himself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in a Board proceeding to secure the services of an attorney who is familiar with such matters. If opposer does not retain counsel, then opposer will have to familiarize himself with the rules governing this proceeding. Strict compliance with the Trademark Rules of Practice and all other applicable rules is expected of all parties, even those representing themselves.

Summary

Opposer's motion for summary judgment is given no consideration and is effectively **denied** without prejudice.

Applicant's alternative cross-motion for Rule 56(d) discovery is **moot**.

The amended notice of opposition is **stricken** in its entirety. Opposer is allowed until **August 19, 2013**, in which to file a second amended notice of opposition; failing which, the opposition will be dismissed with prejudice.

Applicant is allowed until **September 9, 2013**, in which to file an answer to the second amended notice of opposition.

Schedule

Proceedings are resumed. Dates are reset on the following schedule.

Second Amended Complaint Due	8/19/2013
Time to Answer	9/9/2013
Deadline for Discovery Conference <sup>2</sup>	9/30/2013
Discovery Opens	9/30/2013
Initial Disclosures Due	10/30/2013
Expert Disclosures Due	2/27/2014
Discovery Closes	3/29/2014
Plaintiff's Pretrial Disclosures	5/13/2014
Plaintiff's 30-day Trial Period Ends	6/27/2014
Defendant's Pretrial Disclosures	7/12/2014
Defendant's 30-day Trial Period Ends	8/26/2014
Plaintiff's Rebuttal Disclosures	9/10/2014
Plaintiff's 15-day Rebuttal Period Ends	10/10/2014

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.

---

<sup>2</sup> As noted earlier in this order, opposer has requested Board participation in the settlement and discovery conference. In view thereof, after the answer to the second amended complaint is filed the parties must telephone the Board at 571-272-4270 to schedule the conference.