

THIS OPINION
IS NOT A PRECEDENT
OF THE T.T.A.B.

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

DUNN

Mailed: April 29, 2015

Opposition No. 91218136

Disney Enterprises, Inc.

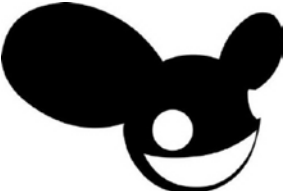

v.

Ronica Holdings Limited

Before Bergsman, Greenbaum, and Goodman, Administrative Trademark Judges:

By the Board:

This case comes up on Opposer’s combined motion to strike the answer in part and motion for partial summary judgment on Applicant’s prior registration, or “Morehouse” defense.¹ See *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969). The motion is contested.

Applicant’s Registration No. 3836648	Applicant’s opposed Application Serial No. 85972976
	

¹ Opposer’s motion indicates it served its initial disclosures on November 10, 2014.

On June 28, 2013, Ronica Holdings Limited, the wholly-owned corporate entity of the individual known as deadmau5, filed an application pursuant to Trademark Act Sec. 44(e) seeking registration of the design mark depicted above, described in the application as “a caricature of a mouse head” for a wide variety of goods and services in International Classes 9, 12, 16, 18, 25, 28, 30, 32, and 41. Applicant claims ownership of Registration No. 3836648 for the design mark depicted above, described in the registration as “a stylized small animal with a smiling face” for a wide variety of goods and services in International Classes 9, 16, 25, and 41.

On September 2, 2014, Opposer Disney Enterprises filed a notice of opposition comprising a 22 page ESTTA-generated filing form and a 20 page Complaint with 25 numbered allegations. The notice of opposition claims that registration of Applicant’s mark would cause dilution of, and a likelihood of confusion with, Opposer’s design marks described, in some instances, as “the stylized head of a mouse,” also used with a wide variety of goods and services, and the subject of pleaded registrations as well as common law use. The notice of opposition is accompanied by more than 130 pages of exhibits, including 30 pages alleged to show use of Opposer’s marks (Exhibit A) and 100 pages with status and title copies of the pleaded registrations (Exhibit B).

On October 13, 2014, Applicant filed its answer comprising 34 pages with 16 pages responding to Opposer’s 25 allegations and 18 pages with 61 numbered allegations describing Applicant’s affirmative defenses, including (Affirmative

Defense Par. 57) the allegation that “Opposer cannot be damaged by registration of the Subject Mark because Applicant already owns an existing registration for the same or substantially identical mark for the same or substantially similar goods.”

The answer denies the salient allegations of the notice of opposition. The answer is accompanied by more than 1400 pages of exhibits, including 14 separate filings of about 100 pages each, alleged to show use or recognition of Applicant’s mark.

MOTION TO STRIKE IS DENIED

Pursuant to Fed. R. Civ. P. 12(f), the Board may order stricken from a pleading any insufficient or impermissible defense, or any redundant, immaterial, impertinent or scandalous matter. *See also* Trademark Rule 2.116(a), and TBMP § 506 (2014). Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. *See Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999), and *Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570 (TTAB 1988). Opposer moves to strike Applicant’s answer in part.² More specifically, Opposer seeks to strike all references to foreign use and recognition of Applicant’s mark, such as “deadmau5 served as Grand Marshal in the Canada Day parade put on by his hometown of Niagara Falls, Ontario, and was given the key to the city” (Answer, Affirmative Defenses Par. 24). Opposer also moves to strike Applicant’s affirmative defenses and exhibits as argumentative.

² Inasmuch as Applicant responded to Opposer’s motion to strike the affirmative defenses of laches, estoppel and acquiescence by specifically withdrawing those defenses (Response to Motion, p. 3, n. 2), no further consideration will be given to the affirmative defenses of laches, estoppel and acquiescence.

With the exception of pleaded registrations, exhibits to the pleadings do not form part of the record. Trademark Rule 2.122(c). Opposer's arguments as to the relevance of the exhibits are misplaced. The Board will not give any consideration to the 1400 pages of exhibits submitted by Applicant with its answer, or the 30 pages of exhibits unrelated to the pleaded registrations submitted with the notice of opposition. *See Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925, 1927 n.8 (TTAB 2014); TBMP § 317 and TBMP § 506.03. Accordingly, Opposer's motion to strike is denied with respect to the exhibits to the answer.

The Board turns to whether the disputed portions of Applicant's answer have any bearing on the case. The notice of opposition alleges that Opposer is "one of the world's leading producers and providers of entertainment" (emphasis added), and then tells the story of Mickey Mouse (and not just the mouse head design marks which are pleaded) from 1928 to the present, including how the "mouse ears" design became associated with the popular Mickey Mouse character, all as support for Opposer's contention that its design marks warrant protection against dilution by, or likelihood of confusion with, Applicant's mark.

Applicant's affirmative defenses assert that deadmau5 is a renowned musician and producer, and then tells the story of his career from 2002 to the present, including how use of the mau5head mask and logos became associated with his performances, and his international stature as a performer and producer, all as support for his contention that the parties' marks are so dissimilar that there has not been any dilution or confusion between the parties' marks during a substantial

period of coexistence, and there will not be any dilution or likelihood of confusion between the parties' marks if Applicant's application issues as a registration. The broad scope of the allegations in Applicant's answer have a bearing on the issues of the case and will not be stricken. Specifically, Applicant has provided a "road map" for its defense. Presumably, this will allow Opposer, and the Board, to understand the purpose of Applicant's evidence and to prepare rebuttal evidence, if necessary.

However, the leeway the Board grants in the pleadings, which allows explanatory information regarding Applicant's foreign use and recognition to stand, does not pertain to the scope of the pleaded claims and discovery, or alter the burden of proof. Applicant's use and registration outside the United States does not give rise to trademark rights in the United States, either directly or as a result of any failure by Opposer to contest Applicant's foreign trademark rights. *See Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1479 (Fed. Cir. 1990) ("The concept of territoriality is basic to trademark law; trademark rights exist in each country solely according to that country's statutory scheme.") and *Jenaer Glaswerk Schott & Gen. v. The General Electric Company Limited*, 137 USPQ 607 (TTAB 1963) ("The mere fact that opposer did not elect to oppose applicant's prior registrations of 'GENALEX' for different goods does not in any way act as a bar to the present opposition, nor does the fact that opposer did not object to the registration of applicant's mark in foreign countries since opposer's rights in this country are completely independent of any rights of the parties in such countries.") (citations omitted). In fact, because Applicant's foreign trademark rights are

irrelevant to the trademark rights to be determined in this proceeding, the Board will not allow discovery, and will not consider trial evidence, regarding activities involving the parties' marks outside the United States. *See Double J of Broward Inc. v. Skalony Sportswear GmbH*, 21 USPQ2d 1609, 1612 (TTAB 1991).³

Opposer's motion to strike Applicant's answer in part is DENIED.

MOTION FOR SUMMARY JUDGMENT ON MOREHOUSE DEFENSE IS GRANTED

A motion for summary judgment is a pretrial device intended to save the time and expense of a full trial when the moving party is able to demonstrate, prior to trial, that there is no genuine dispute of material fact, and that it is entitled to judgment as a matter of law. *See Fed. R. Civ. P. 56(a); Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). In reviewing a motion for summary judgment, the evidentiary record and all reasonable inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the nonmoving party. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). The Board may not resolve issues of material fact; it may only ascertain whether such issues exist. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

³ While it appears that no exceptions to the rule barring evidence of foreign use are applicable here, to the extent that a party believes that information regarding foreign use is necessary under the specific facts of this case and supported by case law, the party may seek a conference between the parties and the Board in which to make an oral motion to be allowed to serve discovery or submit evidence regarding such foreign use. To arrange the conference with the Board, the party should call TTAB Interlocutory Attorney Elizabeth Dunn at 571-272-4267.

The *Morehouse* defense is an equitable affirmative defense which is available in situations where a party already owns a registration for the substantially identical mark for substantially identical goods and services. It is based on the theory that a party cannot be further injured by the registration sought or already owned because there already exists a substantially similar registration and, therefore, an additional registration for the same mark for substantially identical goods and services can no more injure the plaintiff than the subsisting prior registration. *See Morehouse Mfg. Corp. v. J. Strickland & Co.*, 160 USPQ at 715. “The courts and the Trademark Board have been quite strict in requiring that the mark and goods be almost identical.” 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (“MCCARTHY”) § 20:38 (4th ed. 2014). *See also Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1651 (TTAB 2010), *aff’d*, *Citigroup Inc. v. Capital City Bank Group Inc.*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011) (“This defense applies where an applicant owns a prior registration for essentially the same mark identifying essentially the same goods or services that are the subject of the proposed application.”); *Green Spot (Thailand) Ltd. v. Vitasoy International Holding Ltd.*, 86 USPQ2d 1283, 1285 (TTAB 2008).

Here, Opposer submits copies of Applicant’s prior Registration No. 3836648 and opposed Application Serial No. 85972976, and contends that the opposed application involves a much broader listing of goods and services than the registration, and marks which have different features and make different

commercial impressions. Applicant opposes the motion, and argues that the goods have “sufficient overlap”, are “necessarily related”, and are “functionally” identical, and that the marks are “literally the exact same mark” except for a change in perspective.

Below is a comparison of the goods and services in Applicant’s application and registration, with items in the application which do not appear in the registration underlined:⁴

Registration No. 3836648	Application Serial No. 85972976
<p>Int. Cl. 9 Music sound recordings; music video recordings; audio tapes, audio cassettes, compact discs, motion picture films, video cassettes and CD ROMs featuring music; digital audio tape and video recorders; computer game software for use with personal computers, home video game consoles used with televisions, and for arcade-based video game consoles; video cameras; cameras; photographic and cinematographic cameras; apparatus for recording, transmission, reproduction of sound or images; photographic transparencies, exposed photographic films; batteries; encoded magnetic cards, magnetically-encoded credit cards or debit cards; spectacles, spectacle cases, sunglasses; electronic arcade-type games adapted for use with television receivers; video game software; mouse pads; computer screen savers software; downloadable electronic publications in the nature of magazines in the field of music</p>	<p>Int. Cl. 9 Apparatus and instruments for recording, receiving, processing, reproducing or transmitting sound or visual information or recordings; <u>stereo turntables, slipmats, namely, elastomeric appliques for placement onto electronic devices to prevent slipping, headphones; audio speakers; radio broadcasting receiving and transmitting apparatus; telephone apparatus and instruments; telephones, mobile telephones and telephone handsets; power supply adapters for use with telephones; battery chargers for use with telephones; cases adapted for mobile telephones; sunglasses; spectacles, spectacle frames and cases; sound and/or visual recordings featuring music or videos featuring music, music videos, concerts, interviews and entertainment news; interactive sound or visual recordings featuring music or videos featuring music, music videos, concerts, interviews and entertainment news; <u>blank electric sound or visual recording storage media; juke boxes; computer games adapted</u></u></p>

⁴ While the answer asserted the *Morehouse* defense without qualification, in response to Opposer’s motion for summary judgment arguing that the *Morehouse* defense could not apply to the five classes of goods (12, 18, 28, 30, and 32) in the opposed application which do not appear in the registration, Applicant specifically withdrew the *Morehouse* defense (Response to Motion, p. 11) with respect to International Classes 12, 18, 28, 30, and 32.

	<p><u>for use with television receivers; video games software and programs; coin or counter operated video games; arcade apparatus and games; computer game programs and software; computer software for music playback, music download, gaming or database management; computers; data processing equipment; USB sticks; mouse pads; mice for computers; computer screen saver software; downloadable publications provided on-line from databases from the Internet or from any other communications network including wireless, cable or satellite, namely, a magazine featuring entertainment news; compact discs featuring music; DVDs featuring music and videos featuring music, music videos, concerts, interviews and entertainment news; carrying cases adapted for compact discs; carrying cases adapted for DVDs; video cameras; cameras; photographic and cinematographic apparatus and instruments, namely, cameras; photographic transparencies, exposed photographic films; downloadable digital music; MP3 players; personal digital assistants and other hand held electronic devices; metronomes; downloadable telephone ring tones; electronically encoded magnetic cards and cards bearing machine readable information; magnetically encoded blank bank cards for issuance by a financial institution; magnetically encoded credit cards; magnetically encoded cheque cards; magnetically encoded cash cards; blank electronic smart cards; automatic vending machines and mechanisms for coin operated apparatus; batteries; digital holographic images; digital holographic cards; digital holograms, magnetically encoded credit cards with holograms</u></p>
<p>Int. Cl. 16 Printed matter, namely, newspapers, periodical publications, magazines, books in the field of music; photographs, pictures, prints; posters; greeting cards; postcards; notepads; address books; scrapbooks;</p>	<p>Int. Cl. 16 Printed matter, namely, <u>magazines in the field of entertainment; printed publications, namely, magazines in the field of entertainment; books in the field of music and entertainment; greeting cards, post</u></p>

<p>folders; catalogues in the field of music; printed tickets; calendars; photographs albums; diaries; postage stamps; protective covers for postage stamps; stamp albums; stickers; car stickers; decalcomanias; blank cards; cardboard articles, namely, boxes; stationery, pens, pencils, erasers, pencil sharpeners, pencil cases, drawing rulers, boxes for pens, book markers; drawing materials for blackboards, artists' materials, namely, brushes, pastels, pencils and pens; printed instructional and teaching materials in the field of music; paper gift bags, paper carrier bags; envelopes; blackboards; printed height charts</p>	<p>cards; <u>picture cards</u>; photographs, pictures, prints, posters, stationery, pens, pencils, erasers, pencil sharpeners, pencil cases, <u>staplers, staple removers, rulers</u>, boxes for pens, book markers, notepads; address books; diaries; scrapbooks; albums for photographs; catalogues in the field of music; stickers; <u>printed gift vouchers</u>; gift bags; carrier gift bags; calendars; artists' materials, namely, pens and brushes; paint brushes; decalcomanias; <u>plastic materials for packaging not included in other classes, namely, bags</u>; <u>cheques and travelers cheques; banking cards, other than encoded or magnetic; credit cards, other than encoded or magnetic</u></p>
<p>Int. Cl. 25 Articles of outer clothing, namely, coats and jackets; articles of underclothing, namely, undershirts, panties, shorts and briefs; footwear; headwear; scarves; dressing gowns; boxer shorts; socks; t-shirts, hats and caps, jackets, pajamas, slippers; wristbands, headbands, ties, articles of clothing for babies and toddlers, namely, shirts and shorts; footwear and headwear for babies and toddlers</p>	<p>Int. Cl. 25 Clothing for men, women and children, namely, t-shirts, <u>tank tops</u>, <u>sweat shirts</u>, <u>sweaters</u>, jackets, hats, caps, visors, head bands, scarves, shorts, socks and casual footwear</p>
<p>Int. Cl. 41 Entertainment services, namely, sound recording studios; entertainment services, namely, providing video podcasts in the field of music; entertainment in the nature of live stage performances in the nature of musical performances and concerts by an individual; entertainment services, namely, providing an on-going radio program in the field of music and performing artists; entertainment services, namely, cabarets; entertainment, namely, production of stage shows; production of video and/or sound recordings; presentation, production and performance of musical shows, concerts, radio and television programs; production of video and multimedia videos; audio or video recording</p>	<p>Int. Cl. 41 Entertainment in the nature of live performances by a musical artist; <u>educational services, namely, providing classes, seminars or workshops in the field of music</u>; <u>production and distribution services in the field of sound and/or visual recordings and entertainment programs, namely, motion pictures, radio programs or videos in the field of music</u>; <u>music library services</u>; music publishing services; recording studio services; <u>disk jockey services</u>; <u>provision of information relating to music, entertainment, games and events provided on-line from a computer database, from the Internet or any other communications</u></p>

<p>services; publishing of books, magazines; music publishing; film distribution; arranging and conducting of educational seminars, conferences and exhibitions; publication of books, magazines and other texts</p>	<p><u>network including wireless, cable or satellite; provision of non-downloadable digital music from the Internet; provision of non-downloadable digital music from MP3 websites; production, preparation, presentation, distribution, and rental of television and radio programs and films, animated films and sound and/or visual recordings; production of live entertainment features in the nature of music concerts; organization, production and presentation of quiz shows, exhibitions for entertainment purposes, sporting events, shows in the nature of music concerts, road shows, live staged events in the nature of musical performances, theatrical performances, concerts, live musical performances and audience participation events; provision of on-line non-downloadable electronic publications, namely, a magazine in the field of music; electronic computer game services provided from a computer database, the Internet or any other communications network including wireless, cable, satellite; advisory and consultancy services related to the aforementioned services</u></p>
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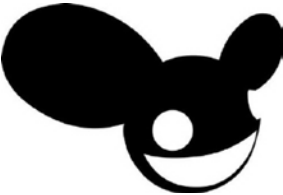

The presence of overlapping goods and services alone does not support the application of the *Morehouse* defense where the opposed application also includes goods and services which are different from those listed in the registration. *La Fara Importing Co. v. F. Lle de Cecco di Filippo Fara S. Martino S.p.A.*, 8 USPQ2d 1143, 1147 (TTAB 1988) (*Morehouse* defense inapplicable where “the identification of goods in the application at issue is not only for alimentary pastes [listed in the prior registration], but also includes a wide variety of additional items such as coffee, sugar, rice, cakes and sauces, excluding cranberry sauce and applesauce.”). *Accord DC Comics Inc. v. Scholastic Magazines, Inc.*, 210 USPQ 299, 301 (TTAB 1980)

(*Morehouse* defense inapplicable where “the goods set forth in the involved applications cover goods such as educationally oriented magazines, records and tape cassettes, which are not encompassed by the listing of goods in the registration.”).

Here, the opposed application includes many goods and services not included in Applicant’s prior registration. Some of the goods and services in the application may be, as Applicant contends, related to those listed in the registration, but this is insufficient for the *Morehouse* defense to apply. *Teledyne Technologies Inc. v. Western Skyways Inc.*, 78 USPQ2d 1203, 1209 (TTAB 2006) (“it is clear that ‘aircraft log books’ and ‘repair and maintenance services, namely, aircraft engine overhaul and reconditioning services’ covered by respondent’s prior registrations are related to the goods, that is, ‘aircraft engines,’ listed in the registration petitioner seeks to cancel. Nevertheless, the goods in the involved registration clearly are different from the goods and services listed in the prior registrations.”); *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1314 (TTAB 1989) (“it is clear that the goods in the five registrations opposer relies upon for its prior registration defense are related to and within the natural scope of expansion of a producer of the goods listed in the three registrations applicant seeks to cancel. Nevertheless, the goods in the registration are different.”).

With respect to the necessary relationship between the marks, the Board’s primary reviewing court has held that the *Morehouse* defense requires that the prior and proposed marks must “be essentially the same.” *O-M Bread Inc. v. United States Olympic Committee*, 65 F.3d 933, 36 USPQ2d 1041, 1045 (Fed. Cir. 1995)

(OLYMPIC and OLYMPIC KIDS are neither the same nor legally equivalent). *Accord Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ2d 1701, 1713 (TTAB 2010), *aff'd mem*, No. 2011-1052 (Fed. Cir. 2011) (“We find that the *Morehouse* defense is not available to Brinkmann in this opposition because the registered mark, MAGNUM MAX, is not substantially the same as that being applied for, MAGNUM MAXFIRE. For purposes of the *Morehouse* defense, the two marks must be ‘substantially identical,’ meaning that they are either literally identical or legally equivalent.”).

Applicant’s Registration No. 3836648	Applicant’s opposed Application Serial No. 85972976
	

Far from substantial identity, the marks shown above have few identical elements, and create different commercial impressions. The mark already registered includes a black circle with an off-center white crescent and small white circle, with a larger black oval protruding from the top of the black circle on one side and a smaller black oval protruding on the other side. The mark in the application includes a black circle with a centered white semicircle, two evenly placed white ovals, and two identical black circles protruding symmetrically from the top of the black circle. While both marks have a central black circle, differing portions of the

black circle are visible with the other different design elements. In addition, a crescent is not a semicircle; one white circle is not equivalent to two white ovals; and the shapes protruding from the top of the black circle are the same in color and number but different in shape and position. The number and nature of the differences between the marks precludes a finding that they are substantially the same mark.

In comparing the marks and the goods and services in Applicant's prior registration and opposed application, there are no genuine disputes of material fact that Applicant's marks are not essentially the same, and are not applied to the same goods and services. Accordingly, we find as a matter of law that the *Morehouse* defense is not available to Applicant in this proceeding. In view thereof, Opposer's motion for summary judgment is GRANTED, and Applicant's affirmative defense (Par. 57) is stricken from the answer.

PROCEEDINGS RESUMED

Proceedings herein are resumed, and discovery is open.

Absent permission obtained by the Board as described above, the Board will not allow discovery, and will not consider trial evidence, regarding activities involving the parties' marks outside the United States.

Inasmuch as Opposer stated in its motion that Opposer served its initial disclosures the day before the due date for the discovery conference, it is not clear if the discovery conference took place. If it did not take place, the parties are ordered

to conduct the conference within **FOURTEEN DAYS** of the mailing date of this order.

If Applicant has not served its initial disclosures, Applicant is ordered to do so within **THIRTY DAYS** of the mailing date of this order. Neither party may serve discovery until the discovery conference takes place, and its initial disclosures have been served.

Expert Disclosures Due	10/31/2015
Discovery Closes	11/30/2015
Plaintiff's Pretrial Disclosures	1/14/2016
Plaintiff's 30-day Trial Period Ends	2/28/2016
Defendant's Pretrial Disclosures	3/14/2016
Defendant's 30-day Trial Period Ends	4/28/2016
Plaintiff's Rebuttal Disclosures	5/13/2016
Plaintiff's 15-day Rebuttal Period Ends	6/12/2016

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.