

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  
General Contact Number: 571-272-8500

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Mailed: November 22, 2016

Opposition No. 91222920

*Standard Tools and Equipment Co.*

*v.*

*Dropship LLC DBA Tool USA*

**Before Cataldo, Gorowitz, and Hightower,  
Administrative Trademark Judges.**

**By the Board:**

On August 26, 2014, Dropship LLC (“Applicant”) filed an application for the trademark



for the following goods: “manually operated hand tools, namely, hammers, trowels, sanding wire wool, drill accessories, namely, bits for hand drills” in International Class 8.<sup>1</sup> Applicant has disclaimed the wording “TOOL” and “USA.COM” apart from the mark.

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<sup>1</sup> Application Serial No. 86377838, based on Applicant’s allegation of use in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), claiming February 2, 2007 as its date of first use and date of first use in commerce. The application includes the following color claim and description of the mark:

On July 23, 2015, Standard Tools and Equipment Co. (“Opposer”) filed a notice of opposition to the registration of Applicant’s mark. As grounds for opposition, Opposer claims likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on (1) ownership of Supplemental Registration No. 2011200 for the typed<sup>2</sup> or standard character mark TOOLS USA<sup>3</sup>; (2) Registration No. 2041542 for the mark



on the Principal Register,<sup>4</sup> both reciting “equipment catalogs for vehicle repair shops;” (3) a pending application for the standard character mark TOOLS USA for “on-line retail store services featuring equipment for automotive, body shop, and painting industries” in International Class 35<sup>5</sup>; and (4) common law use of the mark TOOLS USA and banner design (“banner trademark”) since the end of 1999 in connection with “on-line sales of tools and equipment.”<sup>6</sup> Opposer’s typed or standard character

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The colors red, white, blue, black, and gray are claimed as a feature of the mark. The mark consists of the word “TOOL” in white with blue outlining and to the upper right the wording “USA” with an American Flag in the background of the letters with white stars and stripes, a blue background behind the stars and red stripes, which appear over the wording “.COM” in gray.

<sup>2</sup> Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. A typed mark is the legal equivalent of a standard character mark. *In re Vittera Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012).

<sup>3</sup> Registered on October 26, 1996, claiming 1988 as the date of first use and date of first use in commerce.

<sup>4</sup> Registered on April 22, 1993, claiming 1985 as the date of first use and date of first use in commerce. The registration does not include a description of the mark.

<sup>5</sup> Application Serial No. 86426730 filed on October 17, 2014, based on an allegation of use in commerce under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), and claiming June 29, 1997 as the date of first use and date of first use in commerce. Applicant claims acquired distinctiveness under Section 2(f), 15 U.S.C. § 1052(f), for the entire mark and disclaims the word “TOOLS” apart from the mark.

<sup>6</sup> 13 TTABVUE at 9.

mark on the Supplemental Register includes a disclaimer of the word “TOOLS.” Opposer’s registration on the Principal Register includes a disclaimer of the entire wording “TOOLS USA.”

Applicant, in its answer, denied the salient allegations in the notice of opposition and asserted affirmative defenses, including waiver, estoppel, and unclean hands.

This case now comes before the Board for consideration of Opposer’s motion (filed June 27, 2016) for summary judgment. The motion is fully briefed.

### **The Pleadings**

As an initial matter, a decision on summary judgment requires a review of the operative pleadings in the case. *See* Fed. R. Civ. P. 56(a). In this case, we find that the notice of opposition is legally sufficient to the extent that it contains allegations which, if proven, would establish Opposer’s asserted claim of likelihood of confusion under Section 2(d). In addition, we note that the ESTTA generated cover sheet includes claims of deceptiveness and false suggestion of a connection under Section 2(a), and a claim of dilution under Section 43(c); however, Opposer has not included allegations in the text of the notice of opposition to support the claims. To the extent that Opposer intends to pursue claims under Section 2(a) and 43(c), identifying the claim on the electronic cover sheet of the complaint is insufficient to constitute a pleading of that claim. *Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1827 n.2 (TTAB 2013) (mere mention of ground on ESTTA cover sheet is insufficient for pleading a ground for opposition).<sup>7</sup>

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<sup>7</sup> For a legally sufficient pleading of deceptiveness, *see* *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894 (TTAB 1992); for false suggestion of a

In view thereof, we *sua sponte* dismiss the claims of deceptiveness, false suggestion of a connection and dilution from the ESTTA cover sheet. *See NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1039 n.19 (TTAB 2014) (Board may *sua sponte* dismiss any insufficiently pleaded opposition).

In the interest of judicial economy, we have also reviewed Applicant's answer to the notice of opposition and found that Applicant has failed to allege sufficient facts to support its affirmative defenses of waiver, estoppel, statute of limitations, unclean hands, and "trademark misuse." *See IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009) (for pleading purposes, Section 18 defense must be specific enough in nature to provide fair notice).<sup>8</sup> In addition, Applicant's allegation in paragraph 18 of the notice of opposition that Opposer's marks are unregistrable and subject to cancellation constitutes an impermissible collateral attack on the validity of Opposer's pleaded registrations which, in the absence of a counterclaim, the Board cannot entertain. *See Trademark Rule 2.106(b)(2)(ii); Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1549 n.6 (TTAB 2012). Finally, Applicant's attempt to reserve the right to further amend its affirmative defenses is improper under the

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connection, *see Petróleos Mexicanos V. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010); and for dilution, *see Nike Inc. v. Maher*, 100 USPQ2d 1018, 1023 (TTAB 2011).

<sup>8</sup> We note that the equitable defense of estoppel is generally not available in Board opposition proceedings. *See Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 n.14 (TTAB 2007). In these proceedings, equitable defenses start to run from the time the mark is published for opposition, not from the time of actual knowledge of use. *See National Cable Television Association v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991). Thus, Applicant's state registration does not serve as constructive notice of federal trademark registration.

Federal Rules of Civil Procedure. *See FDIC v. Mahajan*, 923 F. Supp. 2d 1133, 1141 (N.D. Ill. 2013).<sup>9</sup>

In view thereof, we *sua sponte* strike Applicant's affirmative defenses in paragraphs 16, 17, 18 and 19 of the answer.

### **The Record**

Opposer's evidence on summary judgment consists of, *inter alia*, the following exhibits: (1) a web page from Opposer's website showing use of Opposer's mark in connection with the retail sale of auto body hammers;<sup>10</sup> (2) a web page from Applicant's website showing use of Applicant's mark with hammers;<sup>11</sup> (3) the declaration of Michael Kestler, President of Opposer, testifying to Opposer's date of first use of the mark TOOLS USA in commerce and to instances of actual consumer confusion between the parties' marks and introducing evidence including Applicant's packaging slips and product returns sent to Opposer;<sup>12</sup> and (4) photocopies of Opposer's pleaded registration and a printout of Opposer's pending application.

With its response, Applicant submitted the declaration of Ram Bahetti, Manager of Applicant. Mr. Bahetti testifies to Applicant's first use of the mark on its website and first use of the mark in commerce on Applicant's goods. In addition, Applicant introduced a trademark search report from the USPTO trademark database for marks using the terms "TOOLS" or "USA."

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<sup>9</sup> The proper way to plead additional affirmative defenses or counterclaims is to file a motion under Fed. R. Civ. P. 15.

<sup>10</sup> 13 TTABVUE at 57.

<sup>11</sup> *Id.* at 59.

<sup>12</sup> *Id.* at 63-79.

### **Evidentiary Objections**

Before considering the merits of the motion for summary judgment, we consider the following issues with respect to Opposer's evidence on summary judgment.

Applicant objects to Opposer's evidence consisting of two packing slips and a complaint from a customer of Applicant. Applicant argues that the packing slips are not self-authenticating and not properly authenticated by affidavit or declaration as to their nature, source and date of the materials. With respect to the customer complaint, Applicant contends that the complaint is hearsay under Fed. R. Evid. 802 because it is offered for the truth of the matter asserted in the communication. Applicant's objections are overruled. The packaging slips were properly introduced into evidence by the declaration of Mr. Kestler. In addition, communications from customers are recognized as an exception to the hearsay rule under Fed. R. Evid. 803(3). *See National Rural Electric Cooperative Ass'n v. Suzlon Wind Energy Corp.*, 78 USPQ2d 1881, 1887 n.4 (TTAB 2006).<sup>13</sup>

### **Standing**

In every inter partes proceeding before the Board, a plaintiff must prove its standing at trial or at summary judgment. *Ritchie v. Simpson*, 171 F.3d. 1092, 50

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<sup>13</sup> We note that the Internet documents submitted by Opposer are unauthenticated as they do not identify the publication date or the date the web page was accessed and printed and the source of the document (URL). *See Safer, Inc. v. OMS Investments*, 94 USPQ2d 1031, 1039 (TTAB 2010); TBMP § 528.05(e) (2016). However, Applicant has not objected to the evidence on the basis of lack of authentication. The 2010 amendments to Fed. R. Civ. P. 56(c)(2) allow a court to consider unauthenticated documents on summary judgment, eliminating the unequivocal requirement that documents submitted in connection with such a motion must be authenticated. Fed. R. Civ. P. 56(c)(2) (advisory committee notes to 2010 amendment). Inasmuch as Applicant has not objected to this evidence on the basis that it cannot be admissible at trial, we have considered it.

USPQ2d 1023, 1025-26 (Fed. Cir. 1999); *see also Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1037 (TTAB 2007) (at summary judgement, opposer must not only establish a valid ground, but also must prove its standing).

Here, Opposer has established its standing through the introduction of its pending application and the declaration testimony of Mr. Kestler that the application has been suspended pending the disposition of the subject application. *See Giersch v. Scripps Networks*, 90 USPQ2d 1020, 1022 (TTAB 2009) (pending application must be properly introduced, and the fact that it was refused pending outcome of proceeding must be evinced by testimony or documentation).<sup>14</sup>

### **Summary Judgment**

We turn next to the merits of Opposer's 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 and the moving party is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). In reviewing a motion for summary judgment, the evidentiary record and all justifiable inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the non-moving party. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029-30 (Fed. Cir. 1993); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1546 (Fed. Cir. 1992). The Board may not resolve disputes of material fact; it

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<sup>14</sup> 13 TTABVUE 63. Although Opposer has not submitted evidence of the suspension in the form of the Office action issued by the assigned Examining Attorney, Mr. Kestler's testimony establishes the status of Opposer's pleaded application. Furthermore, Applicant admits in its brief that Opposer's pending application has been suspended pending the outcome of this proceeding. 18 TTABVUE 4.

may only ascertain whether a genuine dispute regarding a material fact exists. *See Lloyd's Food Products*, 25 USPQ2d at 2029; *Old Tyme Foods*, 22 USPQ2d at 1544.

A party moving for summary judgment has the burden of demonstrating a particular fact cannot be disputed by citing to particular parts of materials in the record, including affidavits or declarations, admissions or interrogatory answers; or showing that the cited materials do not establish the absence or presence of a genuine dispute, or that the adverse party cannot produce admissible evidence to support the fact. Fed. R. Civ. P. 56(c)(1). *See generally Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986).

For Opposer to prevail on summary judgment, there must be a demonstration that there are no genuine disputes of material fact as to Opposer's claim of likelihood of confusion. *See Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001). Applicant as the nonmoving party may not rest on mere allegations, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine dispute of material fact for trial. *See Venture Out Properties LLC v. Wynn Resort Holdings LLC*, 81 USPQ2d 1887, 1890 (TTAB 2007); *see also* Fed. R. Civ. P. 56(c)(1).

In support of its motion for summary judgment, Opposer argues that its registered and pending marks establish its priority. Opposer further contends that Applicant's use of the subject mark is well after Opposer's first use in commerce of its "banner trademark" for TOOLS USA and design in which Opposer claims common law rights.

With respect to the similarity of the marks, Opposer argues that Applicant's mark TOOL USA.COM is highly similar to Opposer's TOOLS USA marks because the difference in the singular and plural form of the word "TOOL" and the addition of ".COM" "do not meaningfully change the appearance of the marks."<sup>15</sup> In addition, Opposer contends that the dominant element of each of the design marks is the word element, and that the sound, connotation and overall commercial impression of the parties' marks are "virtually identical."<sup>16</sup>

Concerning the relationship between the goods and services of the parties, Opposer argues that Applicant's goods and Opposer's goods and services are nearly identical and, in fact, overlap; that Applicant's goods are within Opposer's natural zone of expansion; and that, inasmuch as both parties sell tools to consumers online, the parties' channels of trade are identical.

Finally, Opposer alleges that it has received "numerous inquiries" from consumers who were confused about the source of Applicant's goods. Opposer has also provided examples of three particular instances of the alleged consumer confusion.<sup>17</sup>

In opposition to the motion for summary judgment, Applicant argues that there are genuine disputes of material fact regarding priority because Opposer's evidence of first use is inconsistent, indefinite and not accompanied by documentation; because Opposer's registered mark on the Supplemental Register is merely descriptive and Opposer has not submitted evidence of secondary meaning; and because Opposer's

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<sup>15</sup> 13 TTABVUE 14.

<sup>16</sup> *Id.* at 17.

<sup>17</sup> 13 TTABVUE 64-65.

common law banner trademark does not function as a trademark and would be perceived by consumers as merely a trade name identifying Opposer's business entity.

Applicant further argues that, despite sharing common terms, there are genuine disputes of material fact with respect to the similarity of the marks in appearance, sound, connotation and overall commercial impression. In addition, Applicant contends that because of the differences in its Class 8 goods and Opposer's Class 35 services, disputed material facts exist regarding the similarity of the goods and services and their respective channels of trade. Applicant further contends that, in view of the number of similar marks in use for similar goods and services and the descriptive nature of Opposer's marks, genuine disputes of material fact exist regarding the strength of Opposer's mark and Opposer's right to exclude others from use of similar marks.

In its reply, Opposer argues that the likelihood of confusion analysis "weighs heavily" in favor of Opposer inasmuch as the marks and trade channels are identical or virtually identical, the goods and services are related, and there is evidence of actual confusion.<sup>18</sup> Further, Opposer contends that Applicant has not introduced any evidence or specific facts that would demonstrate that a genuine dispute of material fact regarding likelihood of confusion exists.

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<sup>18</sup> 20 TTABVUE 11.

Likelihood of Confusion

Consideration of likelihood of confusion in the context of summary judgment involves an analysis of all of the undisputed facts in evidence that are relevant to the thirteen evidentiary factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). Any of the *du Pont* factors “may from case to case play a dominant role.” *Id.* Thus, we look to whether there are genuine disputes with respect to any of these *du Pont* factors which would be material to a decision on the merits.

Before comparing the marks, we note that the evidence in the record indicates that the literal elements in each of the marks at issue are merely descriptive. Opposer’s pleaded registration for the typed mark TOOLS USA is registered on the Supplemental Register. *See Perma Ceram Enterprises Inc. v. Preco Indus., Ltd.*, 23 USPQ2d 1134, 1137 n.11 (TTAB 1992) (mark on the Supplemental Register constitutes an implied admission that the term is descriptive, at least at the time of registration). In addition, Opposer disclaimed the exclusive right to use the term “TOOLS USA” in its registration on the Principal Register for the mark **TOOLS USA**  and Applicant has disclaimed the terms “TOOL” and “USA.COM” in the subject application. *See Bass Pro Trademarks, LLC v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1851 (TTAB 2008) (disclaimer in application may be considered an admission that the disclaimed term is merely descriptive); *SMS, Inc. v. Byn-Mar, Inc.*, 228 USPQ 219, 220 (TTAB 1985). Further, Opposer’s pending application for the standard character mark TOOLS USA includes a claim of acquired distinctiveness

for the entire mark and a disclaimer of the term “TOOLS.” *See Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) (“[A]n applicant’s reliance on Section 2(f) during prosecution presumes that the mark is descriptive.”). Finally, Opposer’s webpage indicates that the wording “TOOLS USA” in Opposer’s asserted common law mark is descriptive/geographically descriptive of the services provided, namely, online sales of tools and equipment in U.S. commerce. *See, e.g., In re U.S. Cargo, Inc.*, 49 USPQ2d 1702 (TTAB 1998) (U.S. CARGO primarily geographically descriptive of towable trailers carrying cargo and vehicles).

In view of thereof, we find that there is no genuine dispute of material fact that the literal elements in each of the marks at issue are, at a minimum, merely descriptive of the goods or services of the parties.

*Registration No. 2011200 on the Supplemental Register*

Turning to the merits of Opposer’s motion for summary judgment, we consider first Opposer’s motion based on likelihood of confusion with its pleaded registration on the Supplemental Register for the word mark TOOLS USA. In order to oppose registration of a mark under Section 2(d), “the opposer must prove he has proprietary rights in the term he relies upon to demonstrate likelihood of confusion as to source....” *Otto Roth & Co., Inc. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *see also Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002). However, while evidence of ownership of an existing mark on the Supplemental Register is sufficient to establish priority, a mark

on the Supplemental Register is insufficient to establish proprietary rights in the mark because it is not entitled to the presumptions of Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). *McCormick & Co. v. Sumner*, 354 F.2d 668, 148 USPQ2d 272 (CCPA 1966); *see also Copperweld Corp. v. Arcair Co.*, 200 USPQ 470, 474 (TTAB 1978) (ownership of a registration on the Supplemental Register “does not constitute prima facie evidence of registrant’s ownership of the mark, or its exclusive right to use the mark in commerce”); *Otter Products v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1255 (TTAB 2012), and cases cited therein.

In order to establish proprietary rights in its descriptive mark on the Supplemental Register, Opposer must demonstrate that the mark has acquired distinctiveness. *See Otter Products*, at 1255-56. Because Opposer has not claimed that its mark on the Supplemental Register has acquired distinctiveness or introduced any evidence sufficient to establish that the mark has acquired distinctiveness, Opposer has failed to establish proprietary rights in the typed mark TOOLS USA on the Supplemental Register. Accordingly, Opposer’s motion for summary judgment based on likelihood with its pleaded mark on the Supplemental Register is **denied** on that basis.

*Application No. 86426730*

In view of the above findings that the wording TOOLS USA is merely descriptive, Opposer must also establish a proprietary right in the standard character mark TOOLS USA with respect to the identified services in its pleaded application in order to oppose registration of the subject application under Section 2(d) based on

ownership of the mark. While Opposer has claimed acquired distinctiveness in the application for registration, Opposer has not introduced evidence of acquired distinctiveness with its summary judgment motion. Opposer's pending application based on a claim under Section 2(f) does not benefit from a presumption of acquired distinctiveness. *See Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1680 (TTAB 2007) (presumption of *prima facie* case of acquired distinctiveness when application is approved for publication); *see also Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988). Thus, Opposer has failed to establish proprietary rights in the standard character mark TOOLS USA in Application Serial No. 86426730. Accordingly, Opposer's motion for summary judgment based on likelihood of confusion with the mark in its pleaded application is **denied**.<sup>19</sup>

*Registration No. 2041542 and Opposer's Common Law Mark*

A. Similarity of the Marks

With respect to Opposer's claim of likelihood of confusion based on its registered mark for **TOOLS USA**  and its common law mark for TOOLS USA and banner design, we note that Opposer argues that the dominant elements of its marks and Applicant's mark are the literal elements.<sup>20</sup> In view of the descriptive nature of the wording in the marks, and because Opposer has failed to provide any evidence that the wording

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<sup>19</sup> We note that, with respect to the mark in the pleaded application, Opposer must establish priority of acquired distinctiveness through use in connection with the services in the pending application. *See Bass Pro Trademarks, LLC v. Sportsman's Warehouse, Inc.*, 89 USPQ2d 1844, 1851-52 (TTAB 2008).

<sup>20</sup> 13 TTABVUE at 14.

“TOOLS USA” has acquired distinctiveness as a source indicator for its goods and services, we find that genuine disputes of material fact exist with respect to the strength of Opposer’s pleaded marks and the weight to be afforded the descriptive wording in the marks. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975) (“the scope of protection afforded a merely descriptive or even highly suggestive term is less than that accorded an arbitrary or coined mark”); *see also, e.g., Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-39, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015) (remanded for consideration of whether and what degree “PEACE & LOVE” was suggestive or descriptive in the food industry); *Bass Pro Trademarks, L.L.C. v. Sportsman’s Warehouse, Inc.*, 89 at 1857-58 (finding that, although cancellation petitioner’s and respondent’s marks were similar by virtue of the shared descriptive wording “SPORTSMAN’S WAREHOUSE,” this similarity was outweighed by differences in terms of sound, appearance, connotation, and commercial impression created by other matter and stylization in the respective marks).

In addition, we find that the design elements in the parties’ marks are not so similar as to establish the absence of a genuine dispute of material fact with respect to the appearance and overall commercial impression of the marks.

**B. Similarity in Goods/Services and Classes of Consumers**

In support of its argument that the parties’ goods and services are nearly identical and, in fact, overlap, Opposer has submitted an unauthenticated web page from each party’s website showing that both parties provide hammers through their respective

websites. However, we note that Opposer's services offered on its website are specifically directed to auto body repair, including retail sale of "auto body hammers" under the category of "body shop tools." Further, Opposer's registrations for equipment catalogs and its application for online retail store services are specifically limited to use by vehicle repair shops and body shops. There is no evidence that Applicant's hand tools, including hammers, may be used for auto body repair or that Applicant's goods are marketed and sold to auto repair or body shops.

In view thereof, we find that genuine disputes of material fact remain with respect to the similarities of the goods and services of the parties and the classes of consumers to whom the parties' goods and services are marketed.

#### Priority

While we have not addressed the issue of priority, we note that priority is not at issue where the opposer establishes its ownership of an "existing registration," including a registration on the Supplemental Register, provided there is no counterclaim or separate petition to cancel the pleaded registration. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *see also Otter Products LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1254-55 (TTAB 2012) (priority not at issue in opposition where pleaded registration of record resides on Supplemental Register). However, because Opposer has not properly introduced into the record *current* status and title copies of its pleaded registrations, *see* Trademark Rule 2.122(d) and TBMP § 704.03(b)(1)(A) (2016), Opposer has not established priority with respect to its pleaded registrations for purposes of its

summary judgment motion. *See Demon International LC v. Lynch*, 86 USPQ2d 1058, 1060 (TTAB 2008) (opposer must properly introduce its pleaded registrations into the record so that priority will not be an issue).

**Decision**

Based on the record herein and the applicable law, we find that, at a minimum, genuine disputes of material facts exist with respect to Opposer's likelihood of confusion claim.<sup>21</sup>

Accordingly, Opposer's motion for summary judgment is **DENIED**.

Proceedings are resumed. Dates are reset as follows:

Plaintiff's 30-day Trial Period Ends	<b>12/28/2016</b>
Defendant's Pretrial Disclosures	<b>1/12/2017</b>
Defendant's 30-day Trial Period Ends	<b>2/26/2017</b>
Plaintiff's Rebuttal Disclosures	<b>3/13/2017</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>4/12/2017</b>

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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<sup>21</sup> The fact that we have identified only 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. The evidence submitted in connection with a motion for summary judgment or opposition thereto is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).