

This decision 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
General Email: TTABInfo@uspto.gov

Baxley

March 9, 2021

Opposition No. 91255001

Trigon Turf Sciences LLC

v.

JRM, Inc.

Before Thurmon, Deputy Chief Trademark Judge, and
Wolfson and Heasley, Administrative Trademark Judges.

By the Board:

This case now comes up for consideration of Opposer's motion (filed October 23, 2020) for summary judgment. The motion has been fully briefed.

Applicant seeks to register the mark SAMURAI TINE in standard characters for "[m]etal turf aeration tines" in International Class 6.¹ Opposer opposes registration of Applicant's mark under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), on the ground of likelihood of confusion with its previously used and registered mark NINJA



TINES and design in the following form, , for "[m]etal turf aeration tines" in

¹ Application Serial No. 88649876, filed October 10, 2019, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

International Class 6.² Applicant, in its answer, denied the salient allegations of the notice of opposition.³

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to material facts, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(a). In deciding motions for summary judgment, we follow the well-established principles that, in considering the propriety of summary judgment, all evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the nonmovant's favor. The Board may not resolve disputes of material fact; it may only ascertain whether such disputes exist. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

For the Board to grant Opposer's motion, Opposer must establish that there is no genuine dispute that (1) it is entitled to bring a cause of action,⁴ (2) it is the prior user of, or owns a registration for, its pleaded mark, and (3) there is a likelihood of

² Registration No. 5600255, issued November 6, 2018, and alleging January 31, 2018 as the date of first use anywhere and of first use in commerce. The registration includes a disclaimer of TINES and a statement that "[t]he mark consists of the words 'NINJA TINES' below a stylized image of a samurai."

³ Applicant asserted affirmative defenses and counterclaimed to cancel Opposer's pleaded registration in its answer. However, the Board struck the affirmative defenses in an August 18, 2020 order, 12 TTABVUE 3, and dismissed the counterclaim without prejudice in a September 22, 2020 order, 15 TTABVUE 1.

⁴ Board decisions have previously analyzed the requirements of Trademark Act Sections 13 and 14 U.S.C. §§ 1063-64, under the rubric of "standing." Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Section 13 and 14 remain applicable. *See Spanishtown Enters., Inc. v. Transcend Resources, Inc.*, 2020 USPQ2d 11388, at *2 (TTAB 2020).

confusion between the marks at issue. *See Fram Trak Indus., Inc. v. WireTracks LLC*, 77 USPQ2d 2000, 2004 (TTAB 2006). In view of Opposer's submission of a copy obtained from the USPTO's Trademark Status and Document Retrieval (TSDR) database of Opposer's pleaded registration, we find for purposes of this motion only that there is no genuine dispute that Opposer is entitled to bring a cause of action and that priority is not at issue with respect to the pleaded mark for the goods identified in that registration.⁵ *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109-10 (CCPA 1974).

In any likelihood of confusion analysis, two key factors are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). Likelihood of confusion in this case must be determined on the basis of the identification of goods in Applicant's involved application and Opposer's pleaded registration, regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed. *See Octocom Sys., Inc. v. Hous. Computer Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Where the goods at issue are broadly described and there are no limitations in the identification of goods as to their nature, type, channels of trade or classes of purchasers, the Board must presume that those goods

⁵ Opposer must maintain its entitlement to a cause of action throughout this proceeding.

encompass all goods of the nature and type described, that those goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers. *See In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Because the parties' goods at issue are wholly identical, the degree of similarity between the marks that is required to support a finding of likelihood of confusion is less than it would be if the goods were not identical. *See Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992), *cert. denied* 506 U.S. 1034 (1992). The question of likelihood of confusion is to be resolved upon a consideration of the marks in their entireties. *See Kayser-Roth Corp. v. Royal Knit Co., Ltd.*, 185 USPQ 826, 828 (TTAB 1975). Where a mark is a composite of design and word elements, the word element is generally the dominant feature thereof because purchasers usually call for the goods by referring to the wording rather than to the design. *See In re Imperial Jade Mining, Inc.*, 193 USPQ 725, 727 (TTAB 1976).

In support of its motion for summary judgment, Opposer asserts that there is no genuine dispute that there is a likelihood of confusion between the parties' marks because "(1) the two marks are legally identical in appearance, sound, connotation, and commercial impression; (2) the two marks are used in connection with identical goods; (3) the channels of trade are identical; (4) the purchasers are the same; and (5) actual confusion exists." 16 TTABVUE 7. Because the parties' goods are identical, we must presume that they are sold through the same trade channels to the same purchasers.

Nonetheless, we find that disposition of the Section 2(d) claim by summary judgment is unwarranted because Opposer has failed to meet its initial burden of establishing that there is no genuine dispute as to whether Opposer's mark NINJA TINES and design and Applicant's mark SAMURAI TINES, when considered in their entireties, are confusingly similar. Opposer's assertion that the marks are confusingly similar is based largely on the description, in its pleaded registration, of the design element of its pleaded mark as "a stylized image of a samurai." However, simply because Opposer chose to describe the image in its mark as a "samurai" does not restrict the perception of the mark to that image only; rather, the connotation drawn from the design by prospective consumers will be based on the impression actually created by the mark in the minds of consumers, not on the impression that Opposer states the mark is intended to convey. *See Trademark Manual of Examining Procedure (TMEP) § 808.02.* "[A]n applicant's or registrant's intended interpretation of the mark is not necessarily the same as the consumer's perception of it." *In re Yale Sportswear Corp.*, 88 USPQ2d 1121, 1125 (TTAB 2008); *see also Interpayment Servs. Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1465 (TTAB 2003) ("In short, it does not matter what applicant's intentions were in creating its mark or what its characterization of its mark is."). In addition, where a design element in a mark is so highly stylized or abstract that it would not readily evoke in the purchaser's mind the wording featured in another mark, the marks may not be confusingly similar. *See, e.g., In re Serac, Inc.*, 218 USPQ 340, 341 (TTAB 1983) (concluding that applicant's design mark was "so highly stylized that an image of a ram's head would not be

immediately discerned and the connection with [the registered mark] ‘RAM’S HEAD’ would not be readily evoked with the resulting generation of a likelihood of source confusion”). Further, the two instances of actual confusion cited by Opposer, 16 TTABVUE 56-60, are insufficient to establish that there is no genuine dispute that confusion between the marks is likely. Bearing in mind that we cannot resolve issues of fact on motion for summary judgment and that we must draw all inferences in Applicant’s favor as the nonmovant, Opposer’s motion for summary judgment is denied.

In view of the limited issues in this case, the parties should consider resolution of this case by accelerated case resolution (ACR). The parties are directed to review the Board’s ACR information at <https://www.uspto.gov/trademarks/ttab> and contact the Board attorney assigned to this case if they have an interest in or questions about ACR.

Proceedings are resumed. Remaining dates are reset as follows.

Initial Disclosures Due	4/8/2021
Expert Disclosures Due	8/6/2021
Discovery Closes	9/5/2021
Plaintiff's Pretrial Disclosures Due	10/20/2021
Plaintiff's 30-day Trial Period Ends	12/4/2021
Defendant's Pretrial Disclosures Due	12/19/2021
Defendant's 30-day Trial Period Ends	2/2/2022
Plaintiff's Rebuttal Disclosures Due	2/17/2022
Plaintiff's 15-day Rebuttal Period Ends	3/19/2022
Plaintiff's Opening Brief Due	5/18/2022
Defendant's Brief Due	6/17/2022
Plaintiff's Reply Brief Due	7/2/2022
Request for Oral Hearing (optional) Due	7/12/2022

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).