

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

Butler

Mailed: December 13, 2007

Cancellation No. 92046260

DUNHAM'S ATHLEISURE CORPORATION

v.

NEW BALANCE ATHLETIC SHOE, INC.

Before Walters, Rogers and Mermelstein, Administrative Trademark Judges.

By the Board:

Petitioner seeks to cancel respondent's registration for the mark DUNHAM for "clothing namely, t-shirts, golf shirts, denim shirts, and wind resistant jackets."<sup>1</sup> As grounds for cancellation, petitioner alleges priority of use and likelihood of confusion with its following marks: DUNHAM'S,<sup>2</sup> DUNHAM'S SPORTS<sup>3</sup> and DUNHAM'S SPORTS and design,<sup>4</sup> all for "retail store services featuring sporting goods and clothing." Petitioner also alleges that respondent's mark wrongfully registered on the

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<sup>1</sup> Registration No. 3016520, issued on November 22, 2005, claiming a date of first use anywhere and a date of first use in commerce of May 1, 1999.

<sup>2</sup> Petitioner alleges that this mark is the subject matter of pending application Serial No. 78828267.

<sup>3</sup> Petitioner alleges that this mark is the subject matter of pending application Serial No. 75828266.

<sup>4</sup> Petitioner alleges that this mark is the subject matter of pending application Serial No. 76618514.

Principal Register because respondent (as applicant) amended its application to seek registration on the Supplemental Register.<sup>5</sup>

In its answer, respondent admits that it amended its underlying application to seek registration on the Supplemental Register; that its Registration No. 3016520 is defective because it should have registered on the Supplemental Register; and that petitioner is the owner of the three pending applications it relies upon. Respondent denies the remaining essential allegations of the petition to cancel. Respondent asserts affirmative defenses including that it is the owner of Registrations Nos. 740975, 895088, and 973456; that such registrations are for the same or substantially identical marks and for the same or substantially identical goods as identified in its subject Registration No. 3016520; that petitioner has not sought to cancel such registrations, which have long existed with petitioner's knowledge; and that petitioner cannot be damaged by Registration No. 3016520 in view of respondent's ownership of the older registrations.

Discovery closed on March 27, 2007. This case now comes up on respondent's request, filed March 2, 2007, that the USPTO correct the mistake to its registration and respondent's fully-

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<sup>5</sup> As discussed later in this order, with respect to the Register, petitioner avers that it filed an opposition proceeding, but such proceeding was dismissed because respondent's registration was supposed to have been issued on the Supplemental Register.

briefed motion for summary judgment in its favor based on its affirmative defenses.

**Respondent's request for corrective action**

Respondent requests correction of the USPTO's error in registering its mark on the Principal Register rather than the Supplemental Register. According to respondent, the underlying application was refused registration on the Principal Register on the basis that the term sought to be registered was primarily merely a surname. To overcome the refusal, respondent (as applicant and as successor-in-interest to the original applicant) amended the application to seek registration on the Supplemental Register. In an Office Action dated March 12, 2001, the Examining Attorney entered the amendment. Inadvertently, the application published for opposition as though applicant were seeking registration on the Principal Register. Petitioner (as opposer) filed a notice of opposition (No. 91159972), which was dismissed as a nullity on September 25, 2004, because marks on the Supplemental Register are not subject to opposition. In the dismissal, the Board also ordered as follows: "Application Serial No. 75759998 will go forward for appropriate corrective action and registration on the Supplemental Register." As respondent points out, this corrective action did not take place. Instead, its underlying application matured into Registration No. 3016520, on the Principal Register.

Respondent requests that the Board undertake the appropriate corrective action now or provide instructions to respondent on how to effectuate the correction.

In response, petitioner notes that the requested corrective action does not resolve the issues presented by the petition to cancel and this proceeding should continue whether or not the corrective action is taken at this time. Petitioner notes that it has not consented to an "amendment" of respondent's registration but recognizes that the subject registration ought to have registered on the Supplemental Register.

Corrective action to respondent's registration, should respondent be successful in this litigation, is deferred until final disposition of this cancellation proceeding. Making the correction now will only add to the administrative confusion already occasioned with respect to Registration No. 3016520 and will not resolve the claims presented by the petition to cancel. However, because the correction is merely an administrative action and the Board and both parties agree that the subject matter is properly registered on the Supplemental Register, in moving forward with the cancellation proceeding, the issues of priority and likelihood of confusion will be considered with the understanding that the mark is properly registered on the Supplemental Register.

**Respondent's motion for summary judgment**

Respondent seeks summary judgment in its favor as a matter of law on the basis of the *Morehouse* defense, also known as the prior registration defense. See *Morehouse Mfg. Corp. v. J. Strickland Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969).

The *Morehouse* doctrine is an equitable defense to the effect that a plaintiff cannot be injured by the subject application or registration because there already exists an injurious registration and, therefore, an additional (or later) registration for the same mark for substantially identical goods and services does not add to the injury. See *O-M Bread, Inc. v. United States Olympic Committee*, 65 F.3d 933, 36 USPQ2d 1041 (Fed. Cir. 1995); and *Morehouse Mfg. v. J. Strickland & Co.*, *supra*. The mark and the goods or services in the prior registration must be the same or substantially the same as those in the subject application or registration. See *Jackes-Evans Manufacturing Co. v. Jaybee Manufacturing Corp.*, 481 F.2d 1342, 179 USPQ 81 (CCPA 1973); and *Bausch & Lomb, Inc. v. Leupold & Stevens, Inc.*, 1 USPQ2d 1497 (TTAB 1986).

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the

non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

In support of its motion, respondent explains that, in addition to the registered mark DUNHAM that is the subject matter of this proceeding, it is the owner of three existing registrations which include the term DUNHAM as follows: DUNHAM for "footwear";<sup>6</sup> DUNHAM TYROLEANS for "shoes";<sup>7</sup> and DUNHAM WAFFLE-STOMPERS for "leather outdoor shoes for hiking, climbing and casual wear."<sup>8</sup> Certified copies showing status and title of the three registrations accompanied respondent's motion. Respondent notes that all four of its registrations have been cited under Trademark Act Section 2(d) against petitioner's pending applications. Respondent argues that petitioner will not be any more hurt by the existence of Registration No. 3016520 than it is by the registrations it is not seeking to cancel; that petitioner has long known of the older three registrations as

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<sup>6</sup> Registration No. 859088, issued on July 21, 1970, claiming a date of first use anywhere and a date of first use in commerce of September 1959. Second renewal.

<sup>7</sup> Registration No. 740975, issued on November 20, 1962, claiming a date of first use anywhere and a date of first use in commerce of May 14, 1956. Second renewal.

<sup>8</sup> Registration No. 973456, issued on November 20, 1973, claiming a date of first use anywhere and a date of first use in commerce of April 3, 1970. Second renewal.

indicated by petitioner's ownership of Registration No. 1496249 for SINCE 1937 DUNHAM'S SPORTS OUTFITTERS for "retail store services for the sale of sporting goods, exclusive of footwear and clothing," which acknowledges that petitioner's rights did not include "footwear and clothing."<sup>9</sup> Respondent, noting that one of its older registrations is for the identical term as the registration that is the subject matter of this cancellation proceeding (DUNHAM), contends nevertheless that its registrations need not be identical as to either the marks or the goods but only need to be "close enough in the context of the issues raised in the Board proceeding to make the *Morehouse* doctrine applicable." Here, respondent argues that its older registered DUNHAM mark for "footwear" is for the identical word and is "strongly associated" with respect to the goods identified in its DUNHAM registration for "clothing namely, t-shirts, golf shirts, denim shirts, and wind resistant jackets" so as to make the registrations "functional equivalents."

In response, petitioner argues that the *Morehouse* defense is not applicable to the facts of this case. More specifically, petitioner argues that respondent's older registrations for, *inter alia*, "footwear" are not the same or substantially identical to its subject registration for "t-shirts, golf shirts, denim shirts, and wind resistant jackets" and that the long

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<sup>9</sup> According to the TARR record submitted by respondent, Registration No. 1496249 was cancelled on January 16, 1995 under Trademark Act Section 8.

period of coexisting registrations, combined with the history between the parties (and their predecessors-in-interest) creates issues of fact. According to petitioner, its DUNHAM's retail outlets coexisted peacefully with respondent's shoe line and the relevant public was accustomed to making distinctions between the parties. Petitioner believes that respondent is attempting to change the status quo by expanding into clothing items. As to the *Morehouse* defense, petitioner argues respondent's registrations for "footwear" cannot provide a basis for establishing rights in the mark for the named clothing items. Petitioner contends that none of respondent's older registrations is the legal equivalent of respondent's subject registration.

In reply, respondent notes that petitioner's now cancelled registration was for "retail store services for the sale of sporting goods, exclusive of footwear and clothing," while petitioner's pending applications are for "retail store services for the sale of sporting goods and clothing." Respondent argues that it is useless for petitioner to seek to cancel the present registrations "when it already accepts a DUNHAM registration for footwear as preventing it from re-registering its mark for anything other than" the services for which it was originally registered and which excluded footwear and clothing.

In *Morehouse*, the Board dismissed an application to register BLUE MAGIC for "pressing oil" in view of applicant's existing registration for BLUE MAGIC for "hair dressing." Respondent



references several cases applying the *Morehouse* doctrine, or an earlier similar concept, to show that the defense is applicable to the present case. They are: *Joseph & Feiss Co. v. Sportempos, Inc.*, 451 F.2d 1401, 172 USPQ 235 (CCPA 1971), where the court affirmed the Board's dismissal of an opposition to register SPORTEMPOS for "suits, jackets, and skirts; trousers and slacks; outer shorts, coats, outer dresses and sport shirts, blouses, shells, with and without sleeves; sweaters, shifts; and caps, all for women, young women and girls" in view of applicant's existing registration for SPORTEMPOS for "ladies suits, jackets and skirts"; *Missouri Silver Pages Directory v. Southwestern Bell Media*, 6 USPQ2d 1028 (TTAB 1988), where the Board dismissed an opposition to register the mark SILVER PAGES for "compiling a telephone directory; promoting the goods and services of others through placing advertisements and listing in directories" and "publication of telephone directories" in view of applicant's existing registration for the mark SILVER PAGES for a "telephone and discount directory addressed to senior citizens"; *Place for Vision, Inc. v. Pearle Vision Center, Inc.*, 218 USPQ 1022 (TTAB 1983), where the Board dismissed an opposition to register the mark PEARLE VISION CENTER and design for "retail optical store, optometric and opticians' services" in view of applicant's two existing registrations for the mark VISION CENTER for "optical, contact lens and sun glass (*sic*) service, namely, examination of eyes, prescription of eyeglasses

and custom fitting of eyeglasses, and sunglasses" and "eyeglasses and sunglasses"; and *College Inn Food Products Corp. v. College Hill Poultry*, 133 USPQ 346 (TTAB 1962), where the Board held that an earlier registration for "dressed poultry, dressed rabbits, and eggs" served as the basis for dismissal of an opposition to a later application for the mark for "dressed poultry, dressed rabbits, fresh eggs, eviscerated poultry, in canned and packaged form, and fresh chicken."

As to these cases referenced by respondent, petitioner argues that they support petitioner's position because, in each case, the marks involved are identical to or the legal equivalents of the marks in the respective prior registrations and the goods in the applications are the same as the goods in the prior registrations. In *Morehouse, supra*, the court found that "pressing oil" and "hair dressing" were different words for the same product. Petitioner points out that, in *Joseph & Feiss, supra*, the goods identified in applicant's prior registration were, in fact, identical to specified goods in the application, because the former included "ladies' suits, jackets, and skirts" and the latter included "suits, jackets and skirts; ... all for women, young women and girls." In *Missouri Silver Pages, supra*, the Board determined that the directory compilation and publication services recited in the application were not the same or substantially identical to the goods identified ("telephone and discount directory addressed to senior citizens") in the

registration.<sup>10</sup> In *Place for Vision, supra*, petitioner notes that one of applicant's two registrations was for "optical, contact lens and sun glass (*sic*) service, ..." which is the same service in part as that recited in the application, "retail optical store, optometric and opticians' services." Finally, in *College Inn, supra*, the goods in the earlier registration were in fact identical to, and encompassed by the goods in the application as to "dressed poultry, dressed rabbit, and eggs."

In this case, it is clear that the goods identified in respondent's older registrations are not identical to the goods identified in its subject registration within the context of the *Morehouse* defense. Although the mark in Registration No. 859088 is nearly identical to the mark in the subject registration, the goods are clearly different.<sup>11</sup> Respondent's other two registrations, Nos. 740975 and 973456, include different marks and different goods. Accordingly, the *Moorehouse* defense does not apply with respect to any of respondent's prior registrations. See, for example, *TBC Corp. v. Grand Prix*, 12 USPQ2d 1311 (TTAB 1989) ("...goods in the five registrations opposer relies upon for its prior registration defense are

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<sup>10</sup> In this case, opposer was basing its rights in the term SILVER PAGES for a senior citizen directory. The Board determined that applicant's applied-for services were not substantially the same as or identical to the registered goods. However, because applicant owned the registration for the directories, the Board found that opposer could not be further damaged by registration of the mark for the closely related services of compiling and publishing such directories.

<sup>11</sup> We do not reach, on the present motion for summary judgment, the question of whether the goods are related for purposes of a likelihood of confusion

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 registrations are different. Therefore, opposer's ownership of the five other registrations cannot serve to preclude applicant from contesting opposer's right to maintain the three registrations applicant seeks to cancel."); *La Fara Importing Co. v. F. Lle de Cecco di Filippo Fara S. Martino S.p.A.*, 8 USPQ2d 1143 (TTAB 1988), (goods in the prior registration relied upon by applicant, "alimentary pastes," were found not to be identical to or substantially the same as the goods sought to be registered by applicant, which were "not only for alimentary pastes, but also includes a wide variety of additional items such as coffee, sugar, rice, cakes and sauces, excluding cranberry sauce and applesauce").

If the Board concludes, upon motion for summary judgment, that there is no genuine issue of material fact, but that it is the nonmoving party, rather than the moving party, which is entitled to judgment as a matter of law, the Board may, in appropriate cases, enter summary judgment *sua sponte* in favor of the nonmoving party. See TBMP §528.08 (2d ed. rev. 2004). As discussed above, the goods identified in respondent's older registrations are not substantially the same as the goods identified in its subject registration.

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analysis. The only issue raised here is whether they meet the rather strict requirements for application of the *Morehouse* defense.

Accordingly, because there exists no triable issue of law or fact with respect to respondent's *Morehouse* defense, and because such defense is not applicable in this case, summary judgment in respondent's favor is denied. Summary judgment on this defense is granted in petitioner's favor. This case now goes forward on petitioner's main claims: priority and likelihood of confusion.

Trial dates are reset as follows:<sup>12</sup>

THE PERIOD FOR DISCOVERY TO CLOSE:	CLOSED
30-day testimony period for party in position of plaintiff to close	February 1, 2008
30-day testimony period for party in position of defendant to close:	April 1, 2008
15-day rebuttal testimony period to close:	May 16, 2008

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>12</sup> The Board, in resetting the trial dates, accounts for the end-of-calendar-year holidays.