UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Opposition No. 91195620
(parent case)
Cancellation No. 92052716

Under Armour, Inc.

v.

Evade, LLC

Before Zervas, Wellington and Shaw,
Administrative Trademark Judges.

By the Board:

Cancellation No. 92052716 is before the Board for consideration of the motion for partial summary judgment filed by Evade, LLC ("Evade") on October 10, 2012. The motion has been fully briefed.

Background

Evade owns Registration No. 3752925[1] for the mark EVADE OFFSHORE ARMOR (standard characters), and Registration No. 3752926[2] for the mark EVADE OFFSHORE ARMOR and design (shown below), both for "shirts, hats, visors, sweatshirts, jackets, shorts in the field of fishing" in International Class 25.

[1] Registered February 23, 2010.
[2] Registered February 23, 2010.

Under Armour, Inc. ("Under Armour")[3] filed a petition to cancel said registrations on the grounds of 1) priority and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), and 2) dilution under Trademark Act Section 43(c), 15 U.S.C. § 1125(c). Under Armour asserts common law rights in the mark UNDER ARMOUR for retail store services featuring apparel and sporting goods, and footwear, sporting goods and related accessories, as well as ownership of 48 registrations of marks, and 17 pending applications to register marks, that consist of or incorporate the terms UNDER ARMOUR or ARMOUR.

The Board granted Under Armour's motion to amend its petition to cancel so as to add allegations regarding its common law rights and its pleaded properties, and Evade filed its answer to the amended petition. Thereafter, Evade filed an amended answer to the amended petition,[4] wherein it denied the salient allegations set forth in the amended petition, and asserted the following first affirmative defense:

> Petitioner's claim for cancellation on the ground of dilution-by-blurring is barred by the federal registration defense set forth in Section 43(c)(6)(B) of the Trademark Act. *See Academy of Motion Picture Arts and Sciences v. Alliance of Professionals & Consultants, Inc.*, Cancellation No. 92055081 (September 27, 2012) [precedential].

[3] Under Armour's December 11, 2012 change of correspondence information has been entered.

In Cancellation No. 92052716, Evade now seeks partial summary judgment with respect to this affirmative defense.

Analysis

In *Academy of Motion Picture Arts and Sciences v. Alliance of Professionals & Consultants Inc.,* 104 USPQ2d 1234 (TTAB 2012) ("*Academy*"), the Board granted a cancellation respondent's motion to dismiss a claim of dilution pursuant to Fed. R. Civ. P. 12(b)(6). The Board applied the Trademark Dilution Revision Act of 2006 ("TDRA"), Trademark Act Section 43(c)(6), 15 U.S.C. § 1125(c)(6) as it was in effect at the time the Board rendered its decision. Trademark Act Section 43(c)(6), at that time, read as follows:

> (6) Ownership of valid registration a complete bar to action.
> The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register under this Act shall be a complete bar to an action against that person, with respect to that mark, that
> (A)(i) is brought by another person under the common law or a statute of a State; and
> (ii) seeks to prevent dilution by blurring or dilution by tarnishment; or
> (B) asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark, label, or form of advertisement.

In *Academy*, the provision that the Board applied, commonly known as the "federal registration defense," provided that ownership of a valid federal registration acted

[4] Pursuant to Fed. R. Civ. P. 15(a)(1)(A), Evade filed its amended answer to the amended petition to cancel as a matter of course.

as a complete bar against both state and federal dilution claims. The Board dismissed the dilution claim, but acknowledged that the applicability of the defense to federal dilution claims was "a clerical error (that) occurred during the passage of the TDRA." *Academy of Motion Picture Arts and Sciences,* 104 USPQ2d at 1236.

On October 5, 2012, eight days after the *Academy* decision, President Obama signed H.R. 6215, entitled *An Act to amend the Trademark Act of 1946 to correct an error in the provisions relating to remedies for dilution* ("Act"),[5] which corrected the unintended error in the numbering of the subparagraphs of Section 43(c)(6). Specifically, the Act corrected Section 43(c)(6) in such a manner so as to provide that the "federal registration defense" is available to a defendant only against dilution claims brought under the common law or a state statute. The Act provides as follows:

> *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,*
>
> **SECTION 1. REMEDIES FOR DILUTION.**
>
> (a) In General- Section 43(c)(6) of the Act entitled `An Act to provide for the registration and protection of trademarks used in commerce, to carry out the provisions of certain international conventions, and for other purposes', approved July 5, 1946 (commonly referred to as the `Trademark Act of 1946'; 15 U.S.C. 1125(c)(6)), is amended by striking subparagraphs (A) and (B) and inserting the following:
>
> `(A) is brought by another person under the common law or a statute of a State; and

[5] Pub.L. 112-190, § 1(a), Oct. 5, 2012, 126 Stat. 1436.

> `(B)(i) seeks to prevent dilution by blurring or dilution by tarnishment; or
> `(ii) asserts any claim of actual or likely damage or harm to the distinctiveness or reputation of a mark, label, or form of advertisement.'.
>
> (b) Effective Date- The amendment made by subsection (a) shall apply to any action commenced on or after the date of the enactment of this Act.

Summary Judgment

Summary judgment is appropriate where the movant shows that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). The movant carries the burden of proof. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323-24 (1986). *See* TBMP § 528.01 and cases cited therein.

Evade asserts that, based on its ownership of Registration Nos. 3752925 and 3752926, the "federal registration defense" is a complete bar to the dilution claim as a matter of law in Cancellation No. 92052716. It asserts that the TDRA, and specifically Section 43(c)(6), as amended by the Act, is not retroactive, and thus is inapplicable to Under Armour's claim inasmuch as this cancellation proceeding commenced before October 5, 2012.[6]

In opposing the motion, Under Armour maintains that Evade is trying to benefit from a mere technical error, and is

[6] In its brief, Evade states that "the instant petition to cancel was filed on July 12, 2012" (brief, p. 1, fn 1). The Board deems this to be a typographical error. The cancellation commenced on July 12, 2010.

focused on avoiding the intent that Congress always had. In particular, Under Armour argues that the Act became effective before Evade filed its motion for partial summary judgment. It also asserts that the defense was available to Evade when Under Armour filed its petition to cancel and when Evade filed its original answer thereto. It argues that Evade waited 26 months after commencement of this cancellation before asserting and moving for partial summary judgment on the defense, and that granting partial summary judgment at this stage in the proceedings would be extremely prejudicial to Under Armour by foreclosing its dilution claim altogether and leaving it with only its likelihood of confusion claim in the cancellation.

As the Board has noted, the TDRA applies equally to cases before it. *See Academy of Motion Picture Arts and Sciences,* 104 USPQ2d at 1237. Moreover, what the Board recognized in *Academy* is true here as well:

> (T)he Board must apply and enforce the statute as written, rather than picking and choosing a preferred interpretation… this Board must assume that Congress means what it says.

Id.

With respect to the effective date of the Act, the express language that Congress set forth therein is clear and unambiguous:

> (b) Effective Date- The amendment made by subsection (a) shall apply to any action commenced on or after the date of the enactment of this Act.

Accordingly, the Act only applies prospectively to actions which commenced on or after October 5, 2012, and the Board is bound to adhere to the stated effective date of the statute. Consequently, the current Trademark Act Section 43(c)(6), which limits the applicability of the "federal registration defense" to dilution claims that are brought under common law or a statute of a State, is not applicable with respect to dilutions claims brought in inter partes proceedings that commenced prior to October 5, 2012.

Inasmuch as Cancellation No. 92052716 commenced prior to that date, the defense, which Evade sufficiently set forth in its operative pleading, is available and may be asserted against Under Armour's dilution claim.

In view of these findings, Evade has demonstrated that it is entitled to judgment as a matter of law in Cancellation No. 92052716 with respect to Under Armour's dilution claim under Trademark Act Section 43(c)(6)(B), 15 U.S.C. § 1125(c)(6). Evade's motion for partial summary judgment is granted.

Cancellation No. 92052716 shall proceed to trial with respect to Under Armour's claim of priority and likelihood of confusion.

Schedule

Proceedings are resumed. Inasmuch as Evade moved for partial summary judgment 45 days prior to the expiration of time allowed for it to conduct discovery solely limited to

Under Armour's allegations regarding its newly pleaded OFFSHORE ARMOUR mark (*see* Board order of October 17, 2012, p. 1), it is allowed until 45 days from the mailing date of this order in which to complete said discovery.

Trial dates are reset as follows:

Plaintiff's Pretrial Disclosures due	**5/16/2013**
Plaintiff's 30-day Trial Period Ends	**6/30/2013**
Defendant's Pretrial Disclosures due	**7/15/2013**
Defendant's 30-day Trial Period Ends	**8/29/2013**
Plaintiff's Rebuttal Disclosures due	**9/13/2013**
Plaintiff's 15-day Rebuttal Period Ends	**10/13/2013**

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.l25.

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.l29.