

THIS OPINION
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OF THE TTAB

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

COHEN

Mailed: November 14, 2013

Cancellation No. 92056035

The Armor All/STP Product
Company

v.

Limited liability company
"Autoplastic"

**Before Seeherman, Lykos and Adlin,
Administrative Trademark Judges.**

By the Board:

Limited liability company "Autoplastic" ("respondent")¹ owns a registration for the mark STP and design, displayed below:



for "insulating paper for acoustical, acoustic, thermal and heat insulation of automobiles; insulating felt for automobiles; insulators for automobiles, namely, polyurethane and










¹ Respondent, as identified in Registration No. 4137345, is "Limited liability company 'Autoplastic'" (without a semicolon between "company" and "Autoplastic"). Petitioner identified respondent in the petition to cancel as "Limited liability company; 'Autoplastic'" (with a semicolon between "company" and "Autoplastic"). The Board considers the name as it appears in respondent's registration to be the correct version.

penopolyethylene insulators of interiors of automobile and other automobile parts from noise, heat and corrosion; insulating tape and band, adhesive bands being tapes all being other than stationery and not for medical or household purposes; soundproofing materials for automobiles; insulating materials; insulating refractory materials; rubber material for recapping tires or tyres; non-conducting materials for retaining heat, namely, insulating penopolietilen being polyethylene foam, polyurethane foam, and foam plastic membranes for insulating surfaces of automobiles; sealant compounds for joints; insulating plaster; cords of rubber for cylinder jointings, pipe gaskets and joint packings for pipes; non-metal gaskets for joint packings and seals in the automotive industry; substances for insulating buildings against moisture, namely, polyurethane film for use as a moisture barrier; fiberglass insulation for automobiles; insulating fabrics; waterproof packings for water-tight rings; foils of metal for insulating automobiles."²

On August 10, 2012, The Armor All/STP Product Company ("petitioner") filed a petition to cancel respondent's registration on the grounds of priority and likelihood of confusion, abandonment

² Registration No. 4137345 issued May 8, 2012 from an application filed April 8, 2010, which was based on Trademark Act Section 66(a). Registration No. 4137345 claims the colors "white and blue" and includes the following description of the mark: "The mark consists of the stylized term 'STP' enclosed within three concentric hexagons; the color blue appearing in the outermost and innermost heagons (sic) and in the stylized term 'STP'; the color white appears in the middle hexagon and in the background of the mark."



and dilution of its pleaded registrations.³ In support of these grounds, petitioner relies on its alleged common law rights in the "STP trademark and STP logo" and the following registrations:⁴

- Registration No. 648087 for the mark STP (typed drawing) for "additive compound for motor oils";
- Registration No. 827102 for the mark  for "additive compound for motor oils and motor fuels";
- Registration No. 929938 for the mark  for "toys and sporting goods-namely, model vehicles";
- Registration No. 958574 for the mark  for "filters for automotive and marine engines";
- Registration No. 1061958 for the mark  for "brake fluid";
- Registration No. 1072497 for the mark  for "motor oil";
- Registration No. 1117051 for the mark  for "restorer and beautifier for plastic, rubber, leather and wood";
- Registration No. 1206873 for the mark  for "degreasing cleaner for vehicle engines and industrial equipment";
- Registration No. 1267491 for the mark  for "lubricants-namely, power steering oil and transmission oil";
- Registration No. 2103468 for the mark  for "automotive and household cleaners, degreasers and cleaning concentrates; glass cleaners; multi-purpose cleaners for interior and exterior home and automotive use, preparations to clean and shine tires; brake parts cleaner, carburetor cleaner and hand

³ Petitioner included status and title copies of each of its pleaded registrations as attachments to its petition to cancel.

⁴ Petitioner also pleaded Registration No. 2570964 for the mark STP (typed drawing). This registration was cancelled on December 28, 2012 and we therefore give no probative value to this registration.

cleaner”;

- Registration No. 2540084 for the mark STP (typed drawing) for “providing information on-line through global computer networks about stock car racing, stock car racing personages, and automotive products”;
- Registration No. 2704259 for the mark STP (typed drawing) for “preparation to shine and protect tires”;
- Registration No. 3779058 for the mark  for “air filters for automobile passenger cabins”; and
- Registration No. 3779025 for the mark  for “shirts.”

Respondent’s answer denied the salient allegations of the petition to cancel. Respondent asserted the affirmative defenses of failure to state a claim and laches, acquiescence and/or equitable estoppel,⁵ and enumerated additional “affirmative defenses” which are not affirmative defenses but rather, amplifications of its denials. *See Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995).

This case is now before the Board for consideration of petitioner’s motion for partial summary judgment, filed June 6, 2013, based solely on the ground of priority and likelihood of confusion. The motion is fully briefed.

Requests for Admission

⁵ Respondent has not submitted any evidence in support of its defenses in response to the motion for summary judgment. Accordingly, such defenses, to the extent they are viable affirmative defenses, are waived. *See Miller v. Miller*, 105 USPQ2d 1615, 1616 n.3 (TTAB 2013); *Baroness Small Estates Inc. v. American Wine Trade Inc.*, 104 USPQ2d 1224, 1225 n.2 (TTAB 2012).

Petitioner's motion is predicated largely upon its requests for admissions ("RFAs")⁶ deemed admitted under Fed. R. Civ. P. 36(a)(3) pursuant to the Board's May 21, 2013 order.⁷ Petitioner contends that, by virtue of respondent's deemed admissions, there are no genuine disputes of material fact with respect to petitioner's standing, or its claim of priority and likelihood of confusion, and that, as a consequence, petitioner is entitled to judgment as a matter of law. In particular, petitioner argues, *inter alia*, that respondent effectively admitted the following facts relevant to petitioner's likelihood of confusion claim:

- petitioner has standing to bring this proceeding (RFA Nos. 39-40);
- respondent "claims no right in or to [respondent's registration] in the U.S. prior to April 2010" (RFA No. 38);
- petitioner's mark "is famous in the [United States] in connection with automotive products" (RFA No. 5);
- petitioner's and respondent's marks are "highly similar in appearance" (RFA No. 7);
- petitioner's and respondent's registrations are "aurally indistinguishable" (RFA No. 8);
- petitioner's and respondent's registrations "create a highly similar commercial impression" (RFA No. 9);
- respondent's registration is used on automotive products (RFA

⁶ As noted in the Board's May 21, 2013 order, respondent was allowed until January 23, 2013 in which to either respond to the petitioner's outstanding discovery requests or to move for an extension of time in which to respond. Having failed to avail itself of either option, the Board granted petitioner's motion (filed February 27, 2013) to compel responses and ordered respondent to respond by June 20, 2013. As of final briefing of petitioner's motion for summary judgment, September 25, 2013, respondent has not provided any discovery responses as ordered in the May 21, 2013 Board order.

⁷ The Board order noted that "petitioner's first set of requests for admission stand admitted pursuant to Fed. R. Civ. P. 36" because respondent failed to timely respond to them.

No. 24);

- respondent's goods offered under respondent's registration are similar to or related to petitioner's goods offered under petitioner's registrations (RFA Nos. 22-23);
- respondent's goods offered under respondent's registration are and/or will be advertised in and sold through the same channels of trade as petitioner's goods offered under petitioner's registrations (RFA Nos. 13, 25, and 27);
- consumers for respondent's goods offered under respondent's registration will overlap with consumers for petitioner's goods sold under petitioner's registrations (RFA No. 11); and
- respondent has no evidence that consumers of the parties' goods are sophisticated or discriminating purchasers (RFA Nos. 41-42).

Petitioner's first set of admissions along with its interrogatories were introduced by a declaration from its counsel, Jason D. Jones.

In its response, respondent now denies that the deemed admissions are accurate, arguing, *inter alia*, that its "use has not caused and is not likely to cause any confusion"; that its channels of trade and class of consumers are different from petitioner's; that its mark and goods are different from petitioner's; and that it "has not admitted any of the [p]etitioner's allegations." Respondent's response is accompanied by the following attachments: webpages purportedly from petitioner's and respondent's respective websites, a copy of respondent's registration certificate, and a copy of one of petitioner's pleaded registrations, Registration No. 1072497.

In serving requests for admission, a party asks its adversary to stipulate to certain matters as a means of reducing issues for trial. See TBMP § 407.02. Fed. R. Civ. P. 36(a) requires that the answering party admit or deny the matter set forth in the requests

for admission, or detail the reasons why the party can do neither. An admission in response to a request for admission "conclusively establishe[s]" the matter that is the subject of that request. Fed. R. Civ. P. 36(b). "This conclusive effect applies to those admissions made affirmatively and those established by default, even if the matters admitted relate to material facts that defeat a party's claim." *American Automobile Ass'n v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142, 1144 (5th Cir. 1991) (citing *United States v. Kasuboski*, 834 F.2d 1345, 1350 (7th Cir. 1987); *Rainbolt v. Johnson*, 669 F.2d 767, 769 (D.C.Cir. 1981); *Brook Village North Assocs. v. General Electric Co.*, 686 F.2d 66, 70 (1st Cir. 1982)); see *Fram Trak Indus. Inc. v. WireTracks LLC*, 77 USPQ2d 2000, 2005 (TTAB 2006) ("Respondent failed to respond to petitioner's requests for admission and failed to file a motion to amend or withdraw those admissions. Accordingly, those requests for admission are deemed admitted and conclusively established.").

Fed. R. Civ. P. 36(a)(3) provides that requests for admissions are deemed admitted unless written answers or objections thereto are received by the requesting party within thirty days of service of the requests. In this case, respondent did not make any attempt to submit either its answers or objections to petitioner. As noted in the Board's May 21, 2013 order, the requests were therefore deemed admitted as a result of respondent's failure to serve timely responses. At that point, or even in response to the motion for

summary judgment, respondent could have filed a motion to withdraw or amend its admissions pursuant to Fed. R. Civ. P. 36(b). See *Giersch v. Scripps Networks Inc.*, 85 USPQ2d 1306 (TTAB 2007); *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064 (TTAB 1990). However, respondent failed to avail itself of this option. Therefore, it cannot rely merely on "disputing" the effective admissions as it did in its response. An admission that is not withdrawn or amended cannot be rebutted by contrary argument or testimony. See *Texas Department of Transportation v. Tucker*, 95 USPQ2d 1241, 1244 (TTAB 2010); *AAA Legal Clinic of Jefferson Crooke*, 19 USPQ2d at 1144.

In view thereof, the Board finds that the facts set forth in each of petitioner's RFAs have been conclusively established.

Summary Judgment

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to material facts, thus allowing the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). In deciding motions for summary judgment, the Board must follow the well-established principles that, in considering the propriety of summary judgment, all evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant'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 American 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).

Standing

We turn first to the issue of standing, a threshold issue that must be proven by a plaintiff in every *inter partes* case. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987). The Board finds that there is no genuine dispute of material fact concerning opposer's standing. A party has standing to seek cancellation of a trademark registration if the party believes it is likely to be damaged by the registration and the belief in likely damage can be shown by establishing a direct commercial interest. See *Cunningham v. Laser Golf Corp.*, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *International Order of Job's Daughters v. Lindeburg & Co.*, 727 F.2d 1087, 1091, 220 USPQ 1017, 1019 (Fed. Cir. 1984). Petitioner has submitted status and title copies obtained from a USPTO database of its pleaded registrations with its petition to cancel. See Trademark Rule 2.122(d)(1). These registrations and the goods listed in those registrations⁸ suffice

⁸ For example, Registration No. 958574 for STP and design is for "filters for automotive and marine engines"; Registration No. 1206873 for STP and design is for "degreasing cleaner for vehicle engines and industrial equipment"; and Registration No. 3779058 for STP and design is for "air filters for automobile passenger cabins."

to establish a direct commercial interest and therefore petitioner's standing to bring this proceeding. See *Edwards Lifesciences Corp. v. Vigilanz Corp.*, 94 USPQ2d 1399, 1408 (TTAB 2010); *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1844; *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Moreover, respondent has not disputed petitioner's standing. Indeed, through its deemed admission of RFA No. 39, respondent admits it "does not challenge [p]etitioner's standing to bring the instant Cancellation proceeding."

Priority

In a cancellation proceeding, whereas here both parties own registrations, petitioner must prove priority of use. See *Brewski Beer Co. v. Brewski Bros., Inc.*, 47 USPQ2d 1281 (TTAB 1998) and cases cited therein. In this case, because both parties' registrations are of record, either party may rely on the filing date of its registration(s), without further proof, to establish priority. See *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009); *J. C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 437 (CCPA 1965). The filing dates of the applications for each of petitioner's pleaded registrations⁹ are

⁹ The filing date of the application which resulted in Registration No. 648087 was filed October 22, 1956; The filing date of the application which resulted in Registration No. 827102 was filed May 4, 1966; The filing date of the application which resulted in Registration No. 929938 was filed August 28, 1970; The filing date of the application which in resulted Registration No. 958574 was filed August 19, 1971; The filing date of the application which resulted in Registration No. 1061958 was filed August

prior to the April 8, 2010 filing date of the application which resulted in respondent's involved registration, which is the earliest date on which respondent is entitled to rely given the absence of any evidence of earlier use. Further, respondent has admitted, see RFA No. 38, that it does not claim any rights to its mark in the United States prior to April 2010. Thus, petitioner has established its priority.

Likelihood of Confusion

In determining the issue of likelihood of confusion and, in this case, whether there is any genuine dispute of material fact relating to that ultimate legal question, we must consider the pertinent evidentiary factors listed in *In re E.I. du Pont de Nemours & Co.*¹⁰ The determination of a likelihood of confusion does not necessarily require examination and findings as to each *du Pont*

19, 1976; The filing date of the application which resulted in Registration No. 1072497 was filed December 29, 1976; The filing date of the application which resulted in Registration No. 1117051 was filed July 26, 1978; The filing date of the application which resulted in Registration No. 1206873 was filed May 27, 1980; The filing date of the application which resulted in Registration No. 1267491 was filed September 20, 1982; The filing date of the application which resulted in Registration No. 2103468 was filed October 24, 1996; The filing date of the application which resulted in Registration No. 2540084 was filed March 5, 2001; The filing date of the application which resulted in Registration No. 2704259 was filed April 22, 2002; The filing date of the application which resulted in Registration No. 3779058 was filed December 4, 2008; and the filing date of the application which resulted in Registration No. 3779025 was filed November 10, 2008.

¹⁰ In *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the Court of Customs and Patent Appeals, our primary reviewing court's predecessor, discussed the factors relevant to a determination of likelihood of confusion.

factor. See *Kenner Parker Toys, Inc. v. Rose Art Indus., Inc.* 963 F.2d 350, 352, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Rather, the "scope of examination by the Board in any particular case will ordinarily be established by the record presented by the parties." *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). Here, the ultimate legal question is framed by the inquiry into four *du Pont* factors in view of respondent's admissions: similarity of the marks, similarity of the goods, channels of trade and fame. There is no evidence regarding the remaining *du Pont* factors, nor has a genuine dispute been raised regarding them.

Similarity of Marks

With regard to respondent's registration and petitioner's registrations, respondent admitted that the parties' marks are visually and aurally similar and create the same commercial impression. See RFA Nos. 7-9. We note, too, that the marks are similar in sound, appearance and connotation inasmuch as they share the common letters S, T, and P in the same sequence. Thus, no genuine dispute of material fact exists that the parties' marks are similar in sight, sound, connotation and commercial impression.

Similarity of Goods/Channels of Trade

Respondent further effectively admitted that respondent's goods offered under respondent's mark are similar to or related to petitioner's goods offered under petitioner's marks; that the

consumers of the parties' goods may and will overlap; and that the parties' goods travel in the same channels of trade. See RFA Nos. 13, 22-25, and 27. Thus, there is no genuine dispute of material fact that the parties' respective goods, as recited, are in part the same, and travel in the same channels of trade.

Fame

Fame of a mark, if it exists, plays a "dominant role in the process of balancing *du Pont* factors . . . Famous marks thus enjoy a wide latitude of legal protection." *Bose Corp.*, 63 USPQ2d at 1305 (citing *Recot Inc.*, 214 F.3d at 1327, 54 USPQ2d at 1897). Inasmuch as respondent has admitted that petitioner's mark is famous in the United States in connection with automotive products, see RFA No. 5, this *du Pont* factor weighs heavily in favor of a finding of likelihood of confusion.

Based on respondent's admissions, and viewing these admitted facts in the light most favorable to respondent, we conclude that there are no genuine disputes of material fact and that a likelihood of confusion exists in this case.

Because we find on this record that no genuine disputes of material fact remain as to petitioner's standing, or its claim of priority and likelihood of confusion, and that petitioner is entitled to judgment as a matter of law, petitioner's motion for partial summary judgment is **granted.**

Petitioner is allowed until TWENTY (20) DAYS from the mailing

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date of this order to inform the Board whether petitioner wishes to go forward on the remaining grounds in the petition to cancel, failing which the Board will dismiss the remaining claims, cancel respondent's involved registration, and enter judgment against respondent solely on the grounds of priority and likelihood of confusion. Proceedings remain otherwise suspended.