

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

wbc

Mailed: October 22, 2014

Cancellation No. 92057550

Board of Trustees of The
University of Alabama and
Paul Bryant, Jr.

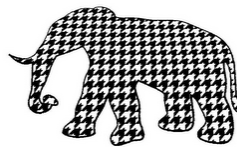
v.

Richard Diaz

Before Quinn, Wolfson and Masiello,
Administrative Trademark Judges.

By the Board:

Richard Diaz (“Respondent”) is the record owner of a registration for the
mark:



for “bib shorts; caps; cloth bibs; dresses; gloves; headbands; infant and toddler
one piece clothing; infant diaper covers; jackets; nightshirts; pants; rain
jackets; scarves; shirts; shorts; sweatshirts; t-shirts; ties; toboggan hats,
pants and caps” in International Class 25.¹

¹ Registration No. 3993520, issued July 12, 2011, alleging November 11, 2010 as the
date of first use anywhere and in commerce.

On July 11, 2013, Board of Trustees of The University of Alabama and Paul Bryant, Jr. (collectively “Petitioners”) filed a petition to cancel and, on April 25, 2014, a motion, which was granted, to amend the petition to cancel the involved registration, on the grounds of likelihood of confusion under Section 2(d), false suggestion of a connection under Section 2(a), and failure to use the mark on all goods identified in the involved registration as of the filing date of the application. In support of its petition to cancel, Petitioners pleaded prior use of the following marks and ownership of registrations for such marks:

1. Registration No. 2706104² for:



2. Registration No. 3730292³ for

² Registration No. 2706104 issued April 15, 2003 for “men’s, women’s and children’s clothing, namely hats, socks, shoes, shirts, shorts, pants, jackets, jerseys, t-shirts” in International Class 25.

³ Registration No. 3730292 issued December 29, 2009 for “metal and non-metal key chains, metal license plates, metal padlocks” in International Class 6; “flash lights, lamps, electric night lights, water coolers” in International Class 11; “earrings, necklaces, bracelets being jewelry, watches, rings being jewelry, pendants ornamental lapel pins, medallions” in International Class 14; “stickers, letterhead stationery, postcards, blank note cards, wrapping paper, bows, playing cards, address books, appointment books, paperweights, media guides, programs, brochures about upcoming events and educational and entertainment programs at the University of Alabama, parking decals, envelopes, paper bags and pouches for packaging, ,” in International Class 16; “bar stools, bunk beds, chairs, benches, tables, baby cribs, wooden picture frames, snow globes, plastic novelty license plates, metal picture frames” in International Class 20; “drinking glasses, shot glasses, stained glass decoration, decorative glass figurines, water bottles sold empty, mugs, bottle openers, portable coolers” in International Class 21; “men’s, women’s and children’s’ clothing – namely, hats, socks, shoes, shirts, shorts, pants, jackets,



3. Registration No. 3730291⁴ for

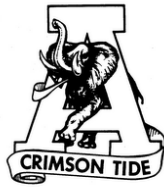


4. Registration No. 1322955⁵ for

jerseys, t-shirts” in International Class 25; “stuffed animals, yo-yo’s, spring toys, basketballs, golf balls, footballs, toy model cars and planes, board games, Christmas tree ornaments” in International Class 28; and “educational services, namely, university undergraduate, graduate, extension and community education, public lectures, and workshops, seminars, and conferences conducted in connection with the foregoing” in International Class 41.

⁴ Registration No. 3730291 issued December 29, 2009 for “metal key chains; metal license plates; metal padlocks” in International Class 6; “flash lights, lamps, electric night lights, water coolers” in International Class 11; “earrings, necklaces, bracelets being jewelry, watches, rings being jewelry, pendants” in International Class 14; “stickers, letterhead stationery, postcards, blank note cards, wrapping paper and bows, playing cards, address books, appointment books, paper weights, media guides, programs, brochures about upcoming university events and educational and entertainment programs, parking decals, envelopes, paper bags and pouches for packaging” in International Class 16; “bar stools, bund beds, chairs, benches, furniture tables, baby cribs, wooden picture frames and coat hangers, snow globes, plastic novelty license plates, metal picture frames, non-metal key chains, wooden picture frames and coat hangers, snow globes, plastic novelty license plates, metal picture frames, non-metal key chains” in International Class 20; “drinking glasses, shot glasses, stained glass decoration, decorative glass figurines, water bottles sold empty, mugs, portable coolers” in International Class 21; “men’s, women’s and children’s clothing, namely, hats, socks, shoes, shirts, shorts, pants, jackets, jerseys, t-shirts” in International Class 25; and “stuffed animals, yo-yo’s, basketballs, golf balls, footballs, toy model cars and planes, board games, Christmas tree ornaments” in International Class 28.

⁵ Registration No. 1322955 issued March 5, 1985 for “key chains” in International Class 6; “notebooks, notepad holders, wall calendars, pens and calendars” in International Class 16.



5. Registration No. 1351302⁶ for



6. Registration No. 2745882⁷ for

⁶ Registration No. 1351302 issued July 30, 1985 for “key rings, metal license plates, and license plate frames” in International Class 6; “gold pins, tie tacs, necklaces, bracelets, jewelry chains, broaches, rings, watches and clocks” in International Class 14; “drinking mugs, glasses, cups, plates, vacuum bottles, picnic coolers, soap dishes, ceramic statues, and wastebaskets” in International Class 21; and “sleep shirts, robes, shirts, t-shirts, tennis shirts, ladies' tops, jerseys, warm-up suits, sweaters, blazers, jackets, vests, shorts, baby pants, bibs, ties, shoes, mittens, scarves, socks, caps, and visors” in International Class 25.

⁷ Registration No. 2745882 issued August 5, 2003 for “metal and non-metal key chains, metal license plates, metal padlocks” in International Class 6; “earrings, necklaces, bracelets being jewelry, watches, rings being jewelry, pendants, ornamental lapel pins, medallions” in International Class 14; “stickers, letterhead stationery, postcards, blank note cards, wrapping paper, bows, playing cards, address books, appointment books, paper weights, media guides, programs, brochures about upcoming events and educational and entertainment programs at the University of Alabama, parking decals, envelopes, paper bags and pouches for packaging” in International Class 16; “bar stools, bunk beds, chairs, benches, tables, baby cribs, wooden picture frames, snow globes, plastic novelty license plates, metal picture frames” in International Class 20; “drinking glasses, shot glasses, stained glass decoration, decorative glass figurines, water bottles sold empty, mugs, bottle openers” in International Class 21; “men’s women’s and children’s clothing; namely, hats, socks, shoes, shirts, shorts, pants, jackets, jerseys, t-shirts; men’s clothing, namely, hats, shirts, jerseys; women’s clothing, namely, shorts, shirts, pants; children’s clothing, namely, socks, shirts, pants, jackets” in International Class 25; “toy stuffed animals, yo-yo’s, spring toys, basketballs, golf balls, footballs, toy model cars and planes, board games, Christmas tree ornaments” in International Class 28; and “educational services, namely, university undergraduate, graduate, extension



Petitioners have now filed a second motion to amend their petition for cancellation, in which they seek to add the following application to their pleaded marks:

7. Application Serial No. 77342852⁸ for



Respondent, in his answer filed August 28, 2014, denied the salient allegations of the original petition to cancel and enumerated three affirmative defenses. Respondent has not yet filed an answer to the first amended petition to cancel.

This case now comes up for consideration of:

1. Petitioners' second motion (filed June 6, 2014) to amend their petition to cancel;

and community education, public lectures, and workshops, seminars and conferences conducted in connection with the foregoing" in International Class 41.

⁸ Application Serial No. 77342852 was filed December 3, 2007 alleging a date of first use anywhere and in commerce of September 1, 2007 for "shirts, hats" in International Class 25.

2. Respondent's motion for summary judgment on the claims of likelihood of confusion and false suggestion of a connection (filed June 11, 2014);⁹
3. Petitioners' motion to strike (filed July 16, 2014) Respondent's exhibits to his motion for summary judgment; and
4. Petitioners' motion to strike (filed August 25, 2014) Respondent's Notice of Reliance (filed August 5, 2014).

The motions enumerated 1-3 above have been fully briefed. Petitioners' motion to strike in number 4, above, has not been contested by Respondent and is therefore **granted** as conceded. *See* Trademark Rule 2.127(a); *Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, 1541 n.16 (TTAB 2010) (Board will generally treat unopposed motion as conceded); TBMP § 502.04. Respondent's Notice of Reliance filed August 5, 2014 is hereby stricken from the record.

Motion to Amend Petition to Cancel

Leave to amend pleadings must be freely given when justice so requires, unless entry of the proposed amendment would violate settled law, would be prejudicial to the rights of the adverse party, or would be futile. *See* Fed. R. Civ. P. 15(a); TBMP § 507.02. Under appropriate circumstances, the Board liberally grants leave to amend pleadings at any stage of the proceeding. *See, e.g., Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505 (TTAB 1993); and *United States Olympic Committee v. 0-M Bread*

⁹ The Board deems the proceeding suspended as of the filing date of the motion for summary judgment. *See* TBMP § 510.03(a) (2014).

Inc., 26 USPQ2d 1221, 1222 (TTAB 1993). The timing of the motion for leave to amend plays a large role in the Board's determination of whether the adverse party would be prejudiced by allowance of the proposed amendment. For example, the Board will liberally grant such motions when the proceedings are still in the pre-trial stage. *See, e.g., United States Olympic Committee*, 26 USPQ2d at 1222 (applicant not prejudiced because proceeding still in pre-trial phase); *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316, 1318 (TTAB 1992) (motion to amend filed prior to opening of petitioner's testimony period permitted); TBMP § 507.02(a).

Petitioners seek to amend the petition to cancel to allege ownership of application Serial No. 77342852 for the mark shown below:



Petitioners allege that the Board of Trustees of The University of Alabama acquired the mark and the application by assignment on May 13, 2013. Respondent, in his response to the motion to amend, argues, *inter alia*, that “the time has passed for Petitioners to amend their petition as a matter of course.” *See June 26, 2014 Response*, p. 1.

After review of the parties' submissions, the Board finds that Petitioners have set forth a sufficient basis for the second amended petition to cancel. *See*

TBMP § 309.03(d). There are no allegations that Petitioners unduly delayed in filing their motion after the assignment of the application and underlying mark. Additionally, it appears unlikely that Respondent will be prejudiced by allowance of the amendment inasmuch as trial has not yet begun and discovery is still open. In view of the foregoing, Petitioners' motion to amend is hereby **granted**. The second amended petition to cancel included in Petitioners' motion shall be treated as the operative pleading.

Motion to Strike Exhibits

Petitioners seek to strike Respondent's Exhs. B, H, I, K, L and M for lack of foundation and relevance, and Exh. C as hearsay. Each of these exhibits consists of webpage printouts, except that Exh. L also comprises webpage printouts and a copy of the *Visual Identity and Graphic Standards* from California State University Fullerton, and Exh. M also comprises third-party registrations.

"Internet printouts that are otherwise properly authenticated are acceptable to show that the statements contained therein were made or that information was reported, but not to prove the truth of the statements contained therein." TBMP § 704.08(b); *see, e.g., Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1735 (TTAB 2012) (Internet printouts submitted as exhibits to testimony are not hearsay). Internet documents that show the URL and the date printed are self-authenticating and as such, are admissible in the same manner as a

printed publication in general circulation under Trademark Rule 2.122(e). *See Swiss Watch*, 101 USPQ2d at 1735; *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031 (TTAB 2010); *see also* TBMP §§ 528.05(e) and 704.08(b). Nonetheless, the probative value of such Internet documents is limited. “They can be used to demonstrate what the documents show on their face; however, documents obtained through the Internet may not be used to demonstrate the truth of what has been printed.” TBMP § 704.08(b).

Because the web pages contained in Exhs. B, C, H, I K, L and M provide the URL and date they were printed, they are admissible evidence. *See* TBMP § 528.05(a). Although they may contain hearsay, they are admissible for what they show on their face (namely, that the content appeared and the public was exposed to it) but not for the truth of what is printed therein. With respect to the *Visual Identity and Graphic Standards* from California State University Fullerton found in Exh. L, although not a webpage printout, it is a printed publication available to the general public.¹⁰ *See* TBMP §§ 528.05(a)(1) and 528.05(e). Therefore, it may be made of record without further authentication for purposes of the summary judgment motion, as an exhibit to the motion for summary judgment as done by Respondent herein. *See* TBMP §§ 528.05(a)(1) and 528.05(e).

The third-party registrations found in Exh. M are likewise properly made of record for purposes of summary judgment because Respondent included

¹⁰ The publication appears to be available on the Internet at www.fullerton.edu/identity, as noted on the cover page of the publication.

TSDR printouts of the registrations as an exhibit to his motion for summary judgment. *See* TBMP § 528.05(d).

In view of the foregoing, the motion to strike is **denied**. The Board has considered Exhs. B, C, H, I, K, L, and M in its consideration of the motion for summary judgment.

Motion for Summary Judgment

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute as to any material fact, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating that there is no genuine issue of material fact remaining for trial and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1987); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). Evidence on summary judgment 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. *See Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472.

The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1542.

In support of their opposition to the motion for summary judgment, Petitioners have shown, *inter alia*, as supported by declarations from its attorney and Paul W. Bryant, Jr., that the University of Alabama's former coach, Coach Paul Bryant, was known for wearing a houndstooth-patterned hat; that the houndstooth pattern is now used by the University of Alabama with permission from Coach Bryant's estate; and that Paul W. Bryant, Jr. is the sole heir and executor of Coach Bryant's estate. Further, Petitioners have made of record portions of the deposition of Respondent in which Respondent admits the houndstooth pattern is associated with Petitioners and that he "intentionally incorporate[d] the elements of the [h]oundstooth [p]attern and elephant design to evoke Petitioners in order to appeal to fans of the University," *Response to Summary Judgment*, p. 16 and that Respondent sells his goods "at University home football games to target fans, students, and alumni of the University," *id.* at p. 19. Petitioners have also shown that, as supported by Petitioners' attorney's declaration and webpage printout of Respondent's Facebook page, Respondent has alleged on his Facebook page to have a "contract" with the University, *id.* at p. 22.

Having carefully considered the materials and arguments offered by the parties in connection with Respondent's summary judgment motion, we

conclude that there are genuine disputes of material fact as to, at a minimum, whether Petitioners own proprietary rights in a trademark consisting of a houndstooth pattern; whether Respondent's mark, as used on his goods, so resembles such mark or any other mark pleaded by Petitioners as to cause confusion, mistake, or deception as to the source of Respondent's goods;¹¹ and whether Respondent's registered mark falsely suggests a connection with Petitioners, namely whether Respondent's registered mark is a close approximation of Petitioners' identities (or one of them), and whether Respondent's registered mark points uniquely and unmistakably to Petitioners (or one of them) and would lead to a presumption of a connection with Petitioner(s).¹² In view thereof, Respondent's motion for summary judgment is **denied**.¹³

¹¹ 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.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

¹² In order to prove a ground of false suggestion of a connection under Trademark Act § 2(a), 15 U.S.C. § 1052(a), petitioner must establish that (1) respondent's mark is the same or a close approximation of petitioner's previously used name or identity; (2) that the mark would be recognized as such, in that it points uniquely and unmistakably to petitioner; (3) that petitioner is not connected with the goods sold by respondent under the mark; and (4) that petitioner's name or identity is of sufficient fame or reputation that when respondent's mark is used on its goods or services, a connection with petitioner would be presumed. *See Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581 (TTAB 2008); and *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985).

¹³ The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *Am. Meat Inst. v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB

Proceedings herein are resumed. Respondent is allowed until **November 15, 2014** to file an amended answer or to otherwise respond to the second amended petition to cancel. The parties are allowed until thirty days from the mailing date set forth in this order to serve responses to any outstanding written discovery requests. Remaining dates are reset as follows:

Discovery Closes	12/28/2014
Plaintiffs' Pretrial Disclosures Due	2/11/2015
Plaintiffs' 30-day Trial Period Ends	3/28/2015
Defendant's Pretrial Disclosures Due	4/12/2015
Defendant's 30-day Trial Period Ends	5/27/2015
Plaintiffs' Rebuttal Disclosures Due	6/11/2015
Plaintiff's 15-day Rebuttal Period Ends	7/11/2015

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.

1981). In addition, the parties should not infer that what we have identified as genuine disputes of material fact are the only issues remaining for trial.