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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92059412
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE
THE TRADEMARK TRIAL AND APPEAL BOARD**

Weber-Stephen Products LLC,
Petitioner,
v.
Pro-Iroda Industries, Inc.,
Registrant.

Cancellation No.: 92059412

Registration No.: 3,927,731

Mark: I-GRILL

PUBLIC REDACTED VERSION

PETITIONER'S REPLY BRIEF

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I. INTRODUCTION

Pro-Iroda Industries, Inc.'s ("Pro-Iroda" or "Registrant") brief confirms that the Board should grant Weber-Stephen Products LLC's ("Weber" or "Petitioner") Petition to Cancel. In its brief, Pro-Iroda does not dispute that Petitioner has standing and is the senior user. (Registrant's Trial Brief, 44 TTABVUE 6-7). Thus, the sole issue before the Board is whether Petitioner has shown, by a preponderance of the evidence, that a likelihood of confusion exists between the parties' marks. As set forth herein and in Petitioner's Main Trial Brief (Confidential Version, 42 TTABVUE; Public Version, 43 TTABVUE), Petitioner has established that there is a high likelihood of confusion between Petitioner's and Pro-Iroda's legally identical marks that are targeted to the same consumers in the same industry.

Pro-Iroda produced minimal documentation in this proceeding, and did not take any discovery or testimonial depositions. Thus, Petitioner's substantial evidence of likelihood of confusion stands un rebutted. Petitioner respectfully requests that the Board cancel Pro-Iroda's infringing mark.

II. THERE IS A STRONG LIKELIHOOD OF CONFUSION BETWEEN THE IGRILL AND I-GRILL MARKS

Pro-Iroda criticizes Petitioner for allegedly "limit[ing] its argument to 9 of the *DuPont* factors" (44 TTABVUE 8), disregarding the Federal Circuit's clear instruction that: "[n]ot all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered." *In re Viterra Inc.*, 671 F.3d 1358, 1361, 101 U.S.P.Q.2d 1905 (Fed. Cir. 2012). Worse, in its brief, Pro-Iroda does not cite or rely on *any* additional *duPont* factors beyond those analyzed by Petitioner in its Main Trial Brief (42 TTABVUE; 43 TTABVUE), incorporated herein by reference. Thus, Pro-Iroda's claim that it "more thoroughly address[ed]

other *DuPont* factors not fully evaluated by” Petitioner is wholly without merit. (44 TTABVUE 8).

Notwithstanding, as discussed below, Pro-Iroda’s misapplication of the relevant *duPont* factors reinforces the fact that a clear likelihood of confusion exists between the parties’ marks. As such, the Board should cancel Pro-Iroda’s registration of the I-GRILL mark.

A. The IGRILL and I-GRILL Marks are Legally Identical

The marks at issue are *identical* in sound, meaning, and commercial impression. Pro-Iroda contends that the parties’ marks are not “sufficiently similar” due to the “inclusion of a hyphen” (44 TTABVUE 13), an argument consistently rejected by the Board.¹ *See Mag Instrument, Inc. v. The Brinkmann Corp.*, 2010 WL 3253200 at *10, 96 U.S.P.Q.2d 1701 (T.T.A.B. July 28, 2010) (finding likelihood of confusion and recognizing that the terms “MAG-NUM” and “MAGNUM” are “essentially identical; the hyphen in [plaintiff’s] mark does not distinguish them.”); *Charrette Corp. v. Bowater Communication Papers Inc.*, 1989 WL 274417 at *2, 13 U.S.P.Q.2d 2040 (T.T.A.B. Sept. 28, 1989) (PRO-PRINT is confusingly similar to PROPRINT – “the marks are identical except for the division of registrant’s mark by a hyphen between the syllables.”); *Barnhardt Mfg. Co. v. Wildwood Gin, Inc.*, 92053237, 2013 WL 5407304 at *7 (June 17, 2013) (non-precedential decision, attached hereto as Exhibit A) (finding ULTRACLEAN and ULTRACLEAN marks “identical in sound, meaning and commercial impression and virtually identical in appearance. The presence of a hyphen between the words ... is an insignificant difference that is not likely to be noticed or remembered by purchasers when encountering these marks at separate times”).

¹ Notably, Pro-Iroda’s actual products do not use the hyphen depicted in its registered I-GRILL mark. (See 43 TTABVUE 12).

Likewise, contrary to Pro-Iroda’s suggestion in its brief, the “use of capital and lower case lettering” in the parties’ marks does not serve to distinguish the marks (44 TTABVUE 13) – both marks consist of standard characters without claim to any particular font style, size, or color. *See In re Viterra*, 671 F.3d at 1363-1364, 101 U.S.P.Q.2d 1905 (a standard character mark is not limited to any particular font, size, or style); *Mattel, Inc. v. Funline Merchandise Co., Inc.*, 2006 WL 3252818 at *3, 81 U.S.P.Q.2d 1372 (T.T.A.B. Nov. 7, 2006) (recognizing that because petitioner’s “mark is registered in typed drawing or standard character form, the depiction thereof is not limited to a particular manner of display”); Trademark Manual of Examining Procedure (“TMEP”) § 1207.01(c)(iii) (“If a mark ... is presented in standard characters, the owner of the mark is not limited to any particular depiction of the mark.”).

Pro-Iroda also contends that the “dominant feature” of the parties’ marks is the “I” prefix. (44 TTABVUE 9). This is unfounded and unsupported by the record. Pro-Iroda relies on *In re Dixie Restaurants, Inc.*, but omits the critical distinguishing fact that the mark at issue in *In re Dixie* was composed of three independent words – THE DELTA CAFE – as well as a specialized design, wherein DELTA was the dominant portion and CAFE was disclaimed. 105 F.3d 1405, 1407, 41 U.S.P.Q.2d 1531 (Fed. Cir. 1997). In contrast, Petitioner’s and Pro-Iroda’s marks consist of one word with standard characters and no stylized design or disclaimer. Pro-Iroda impermissibly dissects the parties’ marks and disregards the plain language of the first *duPont* factor – i.e., that marks must be viewed “in their entirety” *Application of E.I. DuPont deNemours & Co.*, 476 F.2d 1357, 1361, 177 U.S.P.Q. 563 (C.C.P.A. 1973). Pro-Iroda admits as much later in its brief by recognizing that “[i]n a likelihood of confusion analysis the marks must be considered *in their entirety*.” (44 TTABVUE 13) (emphasis added). In any event, even if the “I” prefix is the dominant feature of the parties’ marks, that weighs in favor of likelihood of confusion because *both* marks include this prefix.

The near identity of the IGRILL and I-GRILL marks “strongly favors a finding of likelihood of confusion.” *Barnhardt Mfg.*, 2013 WL 5407304 at *7 (citing *In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 U.S.P.Q.2d 1687, 1688 (Fed. Cir. 1993) (“The identity of words, connotation, and commercial impression weighs heavily against the applicant.”)).

B. Pro-Iroda’s Third-Party Evidence has No Probative Value

Pro-Iroda’s claim that it has presented “significant third party use of similar marks” is legally incorrect. (See 44 TTABVUE 8-11). Although Pro-Iroda submitted third-party trademark *registrations* (see Registrant’s Notice of Reliance (“RNOR”) B-003 – B-052; 34 TTABVUE 111-175), Pro-Iroda did not obtain any testimony or documentary evidence establishing the nature and extent of *actual use* of these marks in the marketplace. Accordingly, Pro-Iroda’s trademark registrations have no probative value.² *Charrette Corp.*, 1989 WL 274417 at *3, 13 U.S.P.Q.2d 2040 (“It has long been settled that third party evidence ... is of no probative value in connection with a question of likelihood of confusion in the absence of evidence of actual use of those marks. Unless registrant establishes that the third-party marks as shown in the cited applications and registrations are being used, there is no way an assessment can be made as to what, if any, impact those marks may have made in the marketplace.”); *In re Thor Tech, Inc.*, 2009 WL 1098997 at *6, 90 U.S.P.Q.2d 1634 (T.T.A.B. Apr. 22, 2009) (“[A]bsent evidence of actual use, third-party registrations have little probative value because they are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them.”).

² In fact, according to the Trademark Electronic Search System (“TESS”) database, over a dozen of the third-party registrations cited by Pro-Iroda are “dead,” and thus have no fundamental value for this reason also. See *Action Temp. Servs., Inc. v. Labor Force, Inc.*, 870 F.2d 1563, 1566, 10 U.S.P.Q.2d 1307 (Fed. Cir. 1989) (“[A] canceled registration does not provide constructive notice of anything.”).

Importantly, Pro-Iroda’s reliance on the third-party registrations hinges on the inclusion of an “I” prefix in the marks; however, unlike the parties’ IGRILL and I-GRILL marks, *none* of these registrations include the word “GRILL” or bear any relation to grills or grilling accessories/activities. Pro-Iroda does not (and cannot) dispute this critical fact.³ It is well established that third-party registrations directed to *unrelated goods* – like those cited by Pro-Iroda – are of limited probative value. *See In re Thor Tech*, 2009 WL 1098997 at *6-*7, 90 U.S.P.Q.2d 1634 (affirming refusal to register the mark WAVE directed to recreational vehicles and trailers):

Applicant submitted copies of numerous registrations for marks comprising or containing the word “Wave” for a variety of goods and services, none of which is for trailers. Applicant submitted these third-party registrations to show that registrant’s mark THE WAVE is a weak mark entitled to only a narrow scope of protection or exclusivity of use. Applicant’s argument is unpersuasive.

While third-party registrations may be considered to show that a registered mark is weak because it is descriptive or suggestive, *the indiscriminate citation of third-party registrations without regard to the goods involved cannot be indicative of descriptive or suggestive connotations*. In this case, *the third-party registrations are of limited probative value because the goods identified in the registrations appear to be in fields which are far removed from trailers and recreational vehicles*.

Id. (citation omitted; emphasis added). *See also Charrette Corp.*, 1989 WL 274417 at *3, 13 U.S.P.Q.2d 2040 (“[T]here are arguable differences between the goods indicated in the third party evidence and the goods of the instant parties. Thus, even if there were proof of use, *any uses on unrelated goods or in unrelated fields would be irrelevant*.”) (emphasis added).

For these reasons, Pro-Iroda’s reliance on *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.* and *Juice Generation, Inc. v. GS Enterprises LLC* is entirely misplaced. In *Jack Wolfskin* and *Juice Generation*, the third-party evidence involved

³ Indeed, Petitioner introduced *unrebutted* evidence in its Main Trial Brief that Petitioner and Pro-Iroda are the only entities that currently use the term IGRILL or have any live, registered trademarks/applications directed to the term IGRILL. (*See* 43 TTABVUE 24-25).

marks distinctly similar in appearance to the parties' marks on goods or services *identical* to the parties' goods or services. See *Jack Wolfskin*, 797 F.3d 1363, 1373-1374, 116 U.S.P.Q.2d 1129 (Fed. Cir. 2015); *Juice Generation*, 794 F.3d 1334, 1337-1338, 115 U.S.P.Q.2d 1671 (Fed. Cir. 2015). Here, however, Pro-Iroda's cited third-party registrations bear no remote similarity to the parties' marks and are directed to goods or services "far removed" from grills or grilling accessories/activities. Further, unlike Pro-Iroda, the parties in *Jack Wolfskin* and *Juice Generation* introduced *evidence* of third-party *use* in the marketplace. See *Jack Wolfskin*, 797 F.3d at 1373, n.2, 116 U.S.P.Q.2d 1129; *Juice Generation*, 794 F.3d at 1337, n.1, 115 U.S.P.Q.2d 1671. Pro-Iroda's own case law completely undermines its position.

Accordingly, Pro-Iroda's evidentiary failure supports Petitioner's claim that its IGRILL mark is strong, entitling Petitioner to a greater scope of protection in its mark.⁴ *Schering-Plough Healthcare Prod., Inc. v. Ing-Jing Huang*, 2007 WL 1751193 at *5, 84 U.S.P.Q.2d 1323 (T.T.A.B. June 18, 2007) ("[T]he record is devoid of any properly introduced evidence relating to third-party uses or registrations of marks the same as or similar to opposer's marks. The lack of this type of evidence ... adds support to opposer's claim that its marks are strong."). (See also Petitioner's Main Trial Brief, 42 TTABVUE 12-18, 43 TTABVUE 17-23 (detailing the extensive sales, marketing, and advertising of Petitioner's IGRILL products, as well as Petitioner's substantial policing efforts to enforce its IGRILL mark).) The strength of Petitioner's IGRILL mark strongly weighs in favor of likelihood of confusion. See *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*,

⁴ Pro-Iroda contends (for a *second* time) that the date of first use claimed in Petitioner's application is allegedly inconsistent with the testimony of iDevices, LLC's ("iDevices") founder and CEO, Mr. Christopher Allen. (Registrant's Confidential Trial Brief, 45 TTABVUE 15; 44 TTABVUE 16). The Board previously rejected this *exact same allegation* brought by Pro-Iroda on the grounds that it was untimely and "legally insufficient on its face." (Sept. 29, 2016 Order, 36 TTABVUE 1-5). Pro-Iroda's argument does not get better with repetition.

963 F.2d 350, 352-353, 22 U.S.P.Q.2d 1453 (Fed. Cir. 1992) (“Famous or strong marks enjoy a wide latitude of legal protection. . . . As a mark’s fame increases, the Act’s tolerance for similarities in competing marks falls.”).

C. The Goods Offered Under the Parties’ Marks are Closely Related and Target the Same Consumers

Pro-Iroda asks the Board to ignore a fundamental principle of trademark law that where, as in this case, the parties’ marks are “virtually identical,” “there need only be a *viable relationship* between the goods to find that there is a likelihood of confusion.” *In re Thor Tech*, 2009 WL 1098997 at *2, 90 U.S.P.Q.2d 1634 (emphasis added) (“[T]he greater the degree of similarity between the applicant’s mark and the registered mark, the lesser the degree of similarity between the applicant’s goods and registrant’s goods that is required to support a finding of likelihood of confusion.”) (citing *In re Shell Oil*, 992 F.2d at 1207, 26 U.S.P.Q.2d at 1689 (“It is relevant to consider the degree of overlap of consumers exposed to the respective” goods or services because “even when goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source.”).)

Likewise, Pro-Iroda is wrong in arguing that the classification of the parties’ marks is germane to the question of likelihood of confusion:

Applicant is . . . mistaken in its belief that the classification system within the Patent and Trademark Office has some bearing on the question of likelihood of confusion. This is simply not so. The classification system was established for the convenience of the Office rather than to indicate that goods in the same class are necessarily related or that classification in different classes indicates that they are not related.

Nat’l Football League v. Jasper Alliance Corp., 1990 WL 354523 at *4, n.5, 16 U.S.P.Q.2d 1212 (T.T.A.B. Aug. 13, 1990) (citing *In Re Leon Shaffer Golnick Advert., Inc.*, 185 U.S.P.Q. 242 (T.T.A.B. Nov. 18, 1974)).

Pro-Iroda incredulously argues that there is “no evidence in the record” that a customer interested in purchasing Petitioner’s IGRILL product “would be confused with the source of a grill” or that the “relevant public would be likely to believe” that the parties’ goods “emanate from the same source.” (44 TTABVUE 12-13). As discussed in detail in Petitioner’s Main Trial Brief, Petitioner submitted *unrebutted* testimony that its IGRILL product and Pro-Iroda’s I-GRILL product are offered at similar price points, marketed to the same customers, and located in the grilling section of retail stores. (See 43 TTABVUE 12-13). Pro-Iroda also disregards the plethora of additional evidence Petitioner introduced showing that the IGRILL product has been frequently advertised as a grill accessory, or that Weber recently purchased the IGRILL product and markets it as an essential grilling accessory.⁵ (See 43 TTABVUE 14). Notably, the IGRILL product has been sold not only in the same sections of the same stores, but also inside of an actual grill itself at retail:



⁵ Pro-Iroda’s assertion that Weber – the world’s premier manufacturer of grills and grilling accessories – “does not sell grills” (44 TTABVUE 9) borders on the absurd and underscores the glaring weaknesses in Pro-Iroda’s position.

(See 43 TTABVUE 15).

Pro-Iroda's reliance on *Coach Servs., Inc. v. Triumph Learning LLC* is misguided. In *Coach*, the goods offered under the parties' marks were wholly unrelated – appellee's applications identified “computer software and printed materials for use in preparing students for standardized exams,” and appellant's registrations included “handbags, fashion accessories, luggage, and clothing.” 668 F.3d 1356, 1369-70, 101 U.S.P.Q.2d 1713 (Fed. Cir. 2012). In this case, however, the goods in Petitioner's and Pro-Iroda's registrations are both directed to grilling and cooking activities, and thus are closely related and complementary. Further, appellant in *Coach* submitted *no* evidence regarding any sales or marketing of goods that overlapped with appellee's goods. *Id.* at 1370, n.4. By contrast, Petitioner has submitted overwhelming and un rebutted evidence that the parties' closely-related products are offered to and encountered by the *same* consumers in the grilling industry. This factor strongly favors a finding of likelihood of confusion. *See Mag Instrument*, 2010 WL 3253200 at *11, 96 U.S.P.Q.2d 1701 (to support a holding of likelihood of confusion, it “is sufficient that the respective goods are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originated from the same producer.”).

D. The Parties' Goods Travel in the Same Channels of Trade

Pro-Iroda's arguments with respect to this factor are virtually identical to its arguments regarding the “similarity of goods” factor, and thus should be rejected for the reasons already discussed. Notably, because Pro-Iroda did not take *any* testimonial depositions in this proceeding, Pro-Iroda's *only* recourse is to attack the credibility of Petitioner's witnesses. (See 45 TTABVUE 13-15; 44 TTABVUE 12-14). Notwithstanding, Pro-Iroda disregards the mountain of un rebutted

evidence showing that the parties' products (bearing the nearly-identical marks) are targeted to the same consumers in the same industry, *supra*. (See also 43 TTABVUE 11-16).

Pro-Iroda also impermissibly dismisses the undisputed evidence that the parties attend the same trade shows to market and sell their products. (See 44 TTABVUE 15; 43 TTABVUE 16). Indeed, this evidence further establishes that the parties' goods travel through identical channels of trade. See, e.g., *Trak Inc. v. Traq Inc.*, 1981 WL 40472 at *5, 212 U.S.P.Q. 846 (T.T.A.B. Aug. 20, 1981) ("There is substantial evidence in the record that the channels of trade (principally, sporting goods outlets and *trade shows*) through which the respective goods are marketed are identical.") (emphasis added). Further, because there are no restrictions in the parties' registrations regarding channels of trade and targeted consumers, "the channels of trade must be presumed to be the same." *Id.*; *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 U.S.P.Q.2d 1001 (Fed. Cir. 2002).

This factor also weighs in favor of likelihood of confusion.

E. The Parties' Goods are Impulse Purchases

Petitioner submitted un rebutted testimony that impulse purchases are a significant aspect of the sale of Petitioner's IGRILL products, which cost \$79.00. (See 43 TTABVUE 12-13, 16). Petitioner also introduced undisputed evidence that Pro-Iroda's I-GRILL products are similarly priced at \$89.00, and thus may be subject to impulse purchases. (See 43 TTABVUE 12-13). Pro-Iroda has not produced any rebuttal evidence thereto, or introduced any evidence to support its contention that the price of its I-GRILL product "is well in excess of any unplanned impulse purchase." (45 TTABVUE 14; 44 TTABVUE 15). Accordingly, this factor weighs in favor of Petitioner.

F. Petitioner’s Enforcement Efforts Weigh in Favor of Likelihood of Confusion

Pro-Iroda erroneously claims that Petitioner’s rights in its IGRILL mark are “necessarily narrow” due to the alleged “multitude of other holders of similar marks.” (44 TTABVUE 16). As discussed, Pro-Iroda’s exclusive reliance on third-party registrations has no evidentiary value: Pro-Iroda’s “evidence” fails to establish the nature and extent of any *actual* third-party use; and none of the cited registrations are remotely similar in appearance or commercial impression or directed to similar goods, *supra*. As such, in light of Petitioner’s extensive sales, marketing, and advertising of its IGRILL products, Petitioner’s IGRILL mark squarely falls in the “strong” category. (42 TTABVUE 12-18; 43 TTABVUE 17-23).

Further, as Pro-Iroda recognizes, Petitioner does not contend that it has “exclusive rights to all marks utilizing ‘I’ or ‘I’ as a prefix in any goods or service area” (44 TTABVUE 11). Rather, Petitioner has only enforced its IGRILL mark against parties using confusingly similar marks in the grilling industry. (See 42 TTABVUE 17-18, 43 TTABVUE 22-23 [REDACTED])

[REDACTED]

[REDACTED]

[REDACTED] Notably, Petitioner and Pro-Iroda are the only entities currently using the term IGRILL. (See 43 TTABVUE 24-25).

Petitioner’s extensive (and successful) efforts to police the IGRILL mark, and its continuous use of the mark in commerce since at least July 2009, strongly weigh in favor of likelihood of confusion.

G. An Absence of Actual Confusion Does Not Support Pro-Iroda

It is well established that “proof of actual confusion is not necessary to establish likelihood of confusion.” *Mag Instrument*, 2010 WL 3253200 at *11, 96 U.S.P.Q.2d 1701. Indeed, evidence of actual confusion is “notoriously difficult to come by and, in any event, the test under Section

2(d) of the Trademark Act is likelihood of confusion rather than actual confusion.” *Gillette Canada Inc. v. Ramir Corp.*, 1992 WL 215312 at *6, 23 U.S.P.Q.2d 1768 (T.T.A.B. June 24, 1992).

Relying on *Citigroup Inc. v. Capital City Bank Grp., Inc.*, Pro-Iroda contends that it is “extremely significant” that Petitioner allegedly “cannot point to a single instance of confusion.” (44 TTABVUE 11). In *Citigroup*, however, the Federal Circuit – which affirmed the Board’s factual determinations regarding the absence of actual confusion – found it compelling that the parties’ marks had coexisted in the marketplace for ***over 30 years*** without any instances of actual confusion. 637 F.3d 1344, 1354, 98 U.S.P.Q.2d 1253 (Fed. Cir. 2011). As the Board emphasized in *Citigroup*:

The absence of any reported instances of confusion is meaningful only if the record indicates ***appreciable and continuous use*** by applicant of its mark for a ***significant period of time*** in the same markets as those served by opposer under its marks. *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992). In other words, ***for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred.***

Citigroup Inc. v. Capital City Bank Grp., Inc., 2010 WL 595586 at *17, 94 U.S.P.Q.2d 1645 (T.T.A.B. Feb. 17, 2010) (emphasis added). Clearly, it is misleading for Pro-Iroda to suggest that *Citigroup* holds that “[a]ny instances of actual confusion are ‘extremely significant’ in determining a likelihood of confusion.” (44 TTABVUE 11).

Further, *Citigroup* is inapposite to this case, where the products bearing the IGRILL and I-GRILL marks coexisted in the market for a negligible amount of time. As discussed above and in Petitioner’s Main Trial Brief, in response to Petitioner’s lawsuit, [REDACTED]

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing **PETITIONER'S REPLY BRIEF** has been served via email by agreement of the parties, on March 3, 2017, upon the following counsel for Registrant:

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/s/ Raymond P. Niro, Jr. _____

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Exhibit A

 KeyCite Yellow Flag - Negative Treatment

Declined to Follow by [Seal Shield, LLC v. Otter Products, LLC](#), S.D.Cal., November 4, 2014

2013 WL 5407304 (Trademark Tr. & App. Bd.)

THIS OPINION IS NOT A PRECEDENT OF THE TTAB

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

BARNHARDT MANUFACTURING COMPANY

v.

WILDWOOD GIN, INC.

Cancellation No. 92053237

June 17, 2013

*1 [Kathryn A. Gromlovits](#) of Shumaker, Loop & Kendrick, LLP for Barnhardt Manufacturing Company
[Ernest B. Lipscomb, III](#) and [B. Craig Killough](#) of Barnwell Whaley Patterson & Helms LLC for Wildwood Gin, Inc.

Before [Holtzman](#), [Zervas](#) and [Shaw](#)

Administrative Trademark Judges

Opinion by [Holtzman](#)

Administrative Trademark Judge:

Barnhardt Manufacturing Company (petitioner) has filed a petition to cancel a registration on the Principal Register owned by Wildwood Gin, Inc. (respondent) for the mark ULTRACLEAN for “raw cotton,” in Class 22.¹

As its ground for cancellation, petitioner alleges that it has continuously used the mark ULTRACLEAN in commerce in connection with “specially cleaned raw cotton” since March 2006, over two years prior to the May 9, 2008 filing date of respondent's underlying application; and that respondent's mark when applied to respondent's goods so resembles petitioner's previously used mark as to be likely to cause confusion. Petitioner further alleges that it is the owner of application Serial No. 85072021 filed on June 25, 2010, for the mark ULTRACLEAN for “raw cotton that has been optimally cleaned to be purified or used as an unbleached raw material”; and that registration to petitioner has been refused on the basis of the registration involved herein.

To the extent that petitioner also intended to assert dilution as a ground for cancellation, the claim was not properly pleaded since petitioner did not allege prior fame of its ULTRACLEAN mark, or fame at all. Furthermore, the claim was neither tried by the parties such that the pleading could be deemed amended to conform with the evidence nor argued by petitioner its brief. Ordinarily, in accordance with the Board's usual practice we would find this claim to have been waived by petitioner. However, respondent devoted a considerable portion of its brief to argument on the merits this claim, and has requested that judgment be entered against petitioner on the claim. Accordingly, the dilution claim is dismissed as improperly pleaded and because it is unsupported by any evidence. Cf. [Rolex Watch U.S.A. Inc. v. AFP Imaging Corp.](#), 101 USPQ2d 1188, 1189 (TTAB 2011).

Respondent, in its answer, admits that petitioner filed an application for the mark and goods identified in the petition to cancel, and denies the remaining salient allegations.

*2 As a preliminary matter, we note that petitioner attached exhibits to its pleading. These materials consist of portions of the file history of petitioner's pleaded application, including the Office action refusing registration together with

specimen labels and photographs of its product (Exhs. 1, 4); a document titled “Bleach Process Specifications,” dated March 28, 2006, and three invoices of sale, each dated December 12, 2006 (Exh. 3).²

While attaching exhibits to a pleading does not ordinarily make them of record ([Trademark Rule 2.122\(c\)](#)), respondent has not objected to these exhibits, and moreover has treated them as of record in its brief by expressly acknowledging the exhibits in its description of the record and/or addressing them on the merits. Accordingly, these exhibits are all deemed to have been stipulated into the record and they will be considered for whatever probative value they may have. See [TBMP 702.02](#) (3d ed. rev. 2012) (improperly offered or otherwise noncomplying evidence may nevertheless be deemed stipulated into the record where no objection to the evidence is raised and/or the nonoffering party treats the evidence as being of record); and, e.g., [Coach Services Inc. v. Triumph Learning LLC](#), 96 USPQ2d 1600, 1603, n.3 (TTAB 2010), aff’d in relevant part, 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012).

Record

The record includes the pleadings, with exhibits, and the file for the involved registration. In addition, petitioner submitted the testimony, with exhibits, of petitioner's president and chief operating officer, Lewis Barnhardt,³ and a notice of reliance on the discovery deposition, with exhibits, of respondent's president, Lawson Gary and responses to petitioner's interrogatories.

Respondent did not take any testimony, but submitted a notice of reliance on petitioner's responses to interrogatories along with responses to respondent's requests for admissions.⁴

Both parties have filed briefs.

Standing

The record shows that petitioner is owner of an application that has been refused registration as a result of the registration herein. Thus, petitioner's standing, that is, its real interest in this proceeding, has been established. See [Lipton Industries, Inc. v. Ralston Purina Co.](#), 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

Distinctiveness and Priority

In order for a plaintiff to prevail on a claim of likelihood of confusion based on its ownership of common law rights in a mark, the mark must be distinctive, inherently or otherwise, and plaintiff must show priority of use. See [Otto Roth & Co. v. Universal Foods Corp.](#), 640 F.2d 1317, 209 USPQ 40 (CCPA 1981).

*3 Respondent has not questioned the distinctiveness of petitioner's ULTRACLEAN mark nor are there any other circumstances in the case which would have put petitioner on notice of this defense, and we therefore find that the mark is distinctive. See [Wet Seal Inc. v. FD Management Inc.](#), 82 USPQ2d 1629, 1634 (TTAB 2007); [The Chicago Corp. v. North American Chicago Corp.](#), 20 USPQ2d 1715 (TTAB 1991). See also [Shalom Children's Wear Inc. v. In-Wear A/S](#), 26 USPQ2d 1516 (TTAB 1993). Cf. [Otto Roth](#), 209 USPQ at 44 (CCPA 1981) (“Neither the board nor appellee has questioned the inherent distinctiveness of ESPRIT NOUVEAU, and we therefore assume it functions as a trademark”).

As to priority,⁵ we note that although petitioner pleaded rights in the mark ULTRACLEAN as a single term, it is clear that the issue of priority was tried by implied consent with respect to slight variations of that mark, that is, as to the separate terms, ULTRA-CLEAN or ULTRA CLEAN, with or without a hyphen. Accordingly, the pleadings are considered amended to conform with the evidence. [Fed. R. Civ. P. 15\(b\)](#).

Petitioner is a supplier of cleaned (bleached) raw cotton to the nonwovens industry. Barnhardt Test., p. 4, 5. The raw material is used in the manufacture of feminine hygiene products, baby wipes, swabs, cotton balls and other similar types of products for consumer and medical use. Id., pp. 4, 13, 23; Exh. 3. Mr. Barnhardt testified that petitioner first used the mark ULTRA-CLEAN on cleaned raw cotton in March 2006, and that the mark has been in continuous use since that time. Id., pp. 6; 15-16; 19-21; Respondent's NOR, Exh. 1 (Resp. No. 2). The record shows that petitioner manufactures the ULTRA-CLEAN product primarily for the company, Spuntech Ind. Ltd. N.R. ("Spuntech"), located in Israel. Respondent's NOR, Exh. 1 (Resp. No. 2).

Petitioner's cotton product is sold in bale form, with each bale weighing approximately 500 pounds. The bale is strapped, and wrapped in polypropylene packaging, and labels bearing the mark ULTRA-CLEAN are affixed to the packaged product in three places. Barnhardt Test., p. 18; Exh. 6; Respondent's NOR, Exh. 1 (Resp. No. 2). Petitioner has submitted examples of labels that are placed on the bales, and Mr. Barnhardt testified that the mark has been used on such labels since March 2006. Id., pp. 17-18, 20; Exh. 6.

The record shows that on March 27, 2006, petitioner sent an email to Spuntech regarding the cleaning and labeling requirements for the product; and that petitioner prepared a bleach process specification sheet for Spuntech on March 28, 2006, referring to the "product description" as BCC ULTRA CLEAN ("BCC" identifying "Barnhardt commodity comber") and specifying the certification and labeling requirements for the product. Id., pp. 16-18; Exhs. 5, 6; Pldg. Exh. 3. The three invoices of sale submitted by petitioner all bear the ULTRA-CLEAN mark and show, as respondent admits, that the product was ultimately shipped to Spuntech, in three separate prepaid shipments, on December 12, 2006. Pldg. Exh. 3; Resp.'s Br., pp. 4, 8. Each invoice lists 60 bales of cotton (which weigh roughly 512 pounds per bale), and a total cost, per shipment, of approximately \$30,000.

*4 We find that the evidence as a whole is clearly sufficient to demonstrate petitioner's use of the mark ULTRA-CLEAN at least as of December 12, 2006.

According to respondent's president, Mr. Gary, respondent began actual use of its ULTRACLEAN mark in June 2008. Gary Test., pp. 10, 16. Thus, the May 9, 2008 filing date of respondent's underlying intent-to-use application is the earliest date upon which respondent can rely for purposes of priority. Petitioner has established use of its ULTRA-CLEAN mark prior to such date, and therefore has priority.

Respondent argues that petitioner's evidence is insufficient to establish petitioner's prior use of the ULTRA-CLEAN mark. We have considered those arguments and find them unpersuasive.

While respondent acknowledges petitioner's sales of its ULTRA-CLEAN product to Spuntech in December 2006, respondent argues that petitioner has provided no evidence of labeling of the product "prior to [respondent's] trademark filing for the mark on May 9, 2008." Br., p. 8. However, it is clear from Mr. Barnhardt's testimony that the packaging in which the cotton product is shipped includes a label bearing the ULTRA-CLEAN mark, and that the labels reflect the mark as it was used in 2006. Furthermore, although the particular labels shown in Barnhardt Exh. 6 (as well as those in Pldg. Exh. 1) may not have been "made" or printed before May 9, 2008, as respondent contends, it is clear from the record that this label is of the type that has been used by petitioner. It is obvious from the face of the various labels of record, that each label has been individually prepared according to the specifications (weight, moisture, etc.) for the particular bale of cotton.

Respondent further argues that petitioner made no bona fide use of the mark prior to respondent's application filing date. Respondent relies on [Lucent Information Management Inc. v. Lucent Technologies Inc.](#), 186 F.3d 311, 51 USPQ2d 1545, 1555 (3d Cir. 1999) (applying the "market penetration" test formulated by the Court in [Natural Footwear Ltd. v. Hart, Schaffner & Marx](#), 760 F.2d 1383, 225 USPQ 1104 (3rd Cir. 1985)) which, according to respondent, "raised the threshold of 'use' required to establish priority." Arguing that "trademark rights are not created unless there is a shipment or sale

exposed to the public in the United States,” respondent contends that petitioner's “one time sale” of bleached cotton under the mark in December 2006 “to a *single* customer” which was “located outside the United States” establishes only a token use of the mark; and that petitioner's “failure to continue sales” under the mark between December 2006 and the filing of respondent's application in May 2008 “makes [petitioner's] use a de minimis use of the mark.” Br., pp. 4, 9, 13, 16 (*italics in original*).

*5 To begin with, respondent cites to no authority for its contention that the sale of products to a single customer is not sufficient to establish priority of use. Furthermore, to the extent that respondent is arguing that in order for a sale to be bona fide, it must be made to customers within the United States, respondent is mistaken. As defined in Section 45 of the Trademark Act, “use” of a mark means use “in commerce.” The word “commerce” means “all commerce which may lawfully be regulated by Congress.” Commerce between the United States and a foreign country is a type of commerce that is regulable by Congress. See [Person's Co. Ltd. v. Christman](#), 900 F.2d 1565, 14 USPQ2d 1477, 1479 (Fed. Cir. 1990). Thus, petitioner's shipment of its product to the company in Israel was clearly a sale of the product in commerce.

In addition, respondent's reliance on *Lucent* is misplaced. The “market penetration” test, as articulated in *Natural Footwear*, was used for the purpose of determining the geographic extent of common law rights. The Court in *Lucent* extended the reach of this test, using it to determine common law rights as an initial matter, based on the extent of use in commerce. The test does not apply here. Our precedent does not require use in commerce or any particular degree of market penetration in order to establish priority. See, e.g., [National Cable Television Ass'n v. American Cinema Editors, Inc.](#), 937 F.2d 1572, 19 USPQ2d 1424, 1429 n.4 (Fed. Cir. 1991) (“Section 14 [through Section 2(d)] requires only prior use; ‘in commerce’ is noticeably absent.”). See also [First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc.](#), 476 F.3d 867, 81 USPQ2d 1375, 1378 (Fed. Cir. 2007) (“...the plain language of the statute...merely requires the prior mark to have been ‘used in the United States by another.’”); and, e.g., [E.I. du Pont de Nemours and Co. v. Big Bear Stores, Inc.](#), 161 USPQ 50, 51 (TTAB 1969) (bona fide test marketing and experimental sales in small volumes are sufficient to show use of a mark).

It is only necessary for petitioner to show that it made a bona fide use of the mark in the ordinary course of trade, and not merely to reserve a right in the mark. Section 45 of the Trademark Act. The record, in this case, shows an arms-length, legitimate commercial transaction, and there is nothing to show that this transaction was anything other than a genuine commercial use.

Respondent's arguments regarding petitioner's alleged lack of continuous use of the mark are unavailing. As noted earlier, Mr. Barnhardt attested to continuous use of the ULTRA-CLEAN mark since 2006. Moreover, respondent has expressly acknowledged that there were subsequent sales of the ULTRACLEAN product to Spuntech in March 2009, stating: “...Barnhardt has provided no evidence of sales using the UltraClean mark from December 2006 until March 30, 2009”; and “[Respondent] understands that [Spuntech] resumed purchasing bleached cotton under the Ultra-Clean name from Barnhardt in 2009.” Resp.'s Br., p. 9.

*6 In any event, in order to establish priority, a plaintiff is only required to show prior use, not continuous use of its mark, unless the defendant has asserted the affirmative defense of abandonment. See [West Florida Seafood Inc. v. Jet Restaurants Inc.](#), 31 F.3d 1122, 31 USPQ2d 1660 (Fed. Cir. 1994). Respondent has not asserted the defense of abandonment in this case,⁶ and even if it had, this time period is insufficient to support a prima facie case of abandonment inasmuch as it is less than three years.

We find that petitioner has met its burden of establishing its priority by a preponderance of the evidence by showing use of the ULTRA-CLEAN mark in shipments to Israel at least as early as December 12, 2006.

Likelihood of Confusion

Respondent has not discussed the merits of petitioner's issue of likelihood of confusion in its brief, taking the position that there can be no likelihood of confusion "because [respondent] is the proper owner of the [mark]." Nevertheless, the question of likelihood of confusion must be determined from the record, and we find based on the record, that confusion is likely.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re [E.I. du Pont de Nemours & Co.](#), 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. See [Federated Foods, Inc. v. Fort Howard Paper Co.](#), 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Petitioner, in its brief, argues that it owns a family of "ULTRA" prefixed marks, including such marks as ULTRAWHITE, ULTRASORB and ULTRASCENT. However, petitioner did not plead a family of marks, and to the extent that it could be said that the issue was tried by the parties with implied consent, a family of marks clearly has not been proven. See [Marion Laboratories v. Biochemical/Diagnostics](#), 6 USPQ2d 1215, 1218 (TTAB 1988).

Petitioner attempted to introduce certain promotional literature relating to these marks during the discovery deposition of Mr. Gary (Exhs. 6-9), but among other problems with this evidence, petitioner provided no foundation for its introduction. Mr. Gary stated that he had never seen any of these materials; nor had he ever heard of the marks shown therein. Furthermore, there is no evidence that any of the marks allegedly comprising the family have ever been promoted together, or that any promotion occurred prior to the filing date of respondent's underlying application.

We turn then to a comparison of petitioner's mark ULTRA-CLEAN with respondent's mark ULTRACLEAN, and a consideration of the marks in their entireties in terms of sound, appearance, meaning and commercial impression. See [Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Fondée En 1772](#), 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005).

*7 The marks are identical in sound, meaning and commercial impression and virtually identical in appearance. The presence of a hyphen between the words in petitioner's mark is an insignificant difference that is not likely to be noticed or remembered by purchasers when encountering these marks at separate times. See [In re Sears, Roebuck and Co.](#), 2 USPQ2d 1312, 1313 (TTAB 1987) (CROSS-OVER and CROSSOVER "identical in appearance but for the inclusion in applicant's mark of a hyphen, which, for purposes herein, is of no legal significance"); [Goodyear Tire & Rubber Co. v. Dayco Corp.](#), 201 USPQ 485, 489 n.4 (TTAB 1978) (FAST-FINDER with a hyphen is "in legal contemplation" substantially identical to the mark FASTFINDER without a hyphen).

The near identity of the marks strongly favors a finding of likelihood of confusion. See [In re Shell Oil](#), 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) ("The identity of words, connotation, and commercial impression weighs heavily against the applicant.").

While ULTRA-CLEAN has a suggestive meaning in relation to petitioner's cotton product, that suggestive meaning is the same in both marks. Furthermore, there is no evidence that the term has been commonly used by others for similar goods or, for that matter, that it has been used by anyone other than petitioner. We recognize that ULTRA-CLEAN, as a suggestive mark, is not entitled to the broadest scope of protection. However, the mark is at least entitled to protection against the registration of a virtually identical mark, if such mark is used on related goods. See [King Candy Co. v. Eunice King's Kitchen, Inc.](#), 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974) (likelihood of confusion is to be avoided as much between weak marks as between strong marks).

We turn then to a consideration of the goods. Respondent's goods are identified in the registration as "raw cotton." Petitioner's product, as the evidence shows, is raw cotton that has been cleaned by a bleaching process. Barnhardt Test.,

p. 6; Resp.'s NOR, Exh. 1 (Resp. Nos. 2, 3, 9). The respective goods on their face are similar, and this similarity is confirmed by Mr. Gary's testimony which indicates that respondent's raw cotton product is also cleaned, albeit through a mechanical process. Gary Dep., pp. 19, 20. Notwithstanding any differences in the cleaning processes, however, these similar products are alternatives to one another for use in the very same end products, including healthcare and feminine hygiene products, wet wipes and dry wipes. Barnhardt Test., pp. 13, 23; Gary Dep., pp. 20, 21, 30. Indeed, the parties are competitors in the nonwovens industry. Barnhardt Test., p. 13; Gary Dep., p. 8, 21.

*8 There is no question that the parties' highly similar products would come to the attention of the same purchasers in the same industry under circumstances that would cause them naturally to assume, in view of the near identity of the marks, that the goods emanate from the same source or that there is otherwise some connection between them. See, e.g., [Luzier Inc. v. Marlyn Chemical Co., Inc.](#), 442 F.2d 973, 169 USPQ 797 (CCPA 1971). See also [In re Mitsubishi Jidosha Kogyo Kabushiki Kaisha](#), 19 USPQ2d 1633 (TTAB 1991); [In re International Telephone & Telegraph Corp.](#), 197 USPQ 910 (TTAB 1986). Accordingly, we find that a likelihood of confusion exists.

Decision: The petition to cancel is granted, and Registration No. 3670482 will be cancelled in due course.

Footnotes

- 1 Registration No. 3670482; issued August 18, 2009 from an application filed May 9, 2008, alleging dates of first use and first use in commerce on June 2, 2008.
- 2 The exhibits also include a printout of the subject registration (Exh. 2) which is automatically of record.
- 3 The entire transcript of Mr. Barnhardt's testimony was designated as ““confidential” although there are clearly non-confidential portions and moreover the parties have openly discussed the contents in their briefs. To that extent, the confidentiality of the testimony is considered waived.
- 4 The notice of reliance also includes what respondent refers to as the 30(b)(6) deposition of Lewis Barnhardt. However, this is actually petitioner's testimony deposition of Mr. Barnhardt.
- 5 Respondent's claim that “prior rights were not the subject of [the] pleadings” (Brief, p. 1, fn.2) is not understood. The petition clearly and specifically alleges prior rights in the mark.
- 6 Respondent's passing reference in its brief to an alleged “lapse of about three years before a further sale was made” is insufficient.

2013 WL 5407304 (Trademark Tr. & App. Bd.)