

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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September 20, 2022

Cancellation No. 92078240

Dreams to Reality

v.

Dreams to Reality Foundation

**Before Shaw, Adlin and Johnson,
Administrative Trademark Judges.**

By the Board:

I. Background

Dreams to Reality (“Petitioner”) seeks to cancel the registration of the standard-character mark DREAMS TO REALITY FOUNDATION, with a disclaimer of FOUNDATION, for “Charitable foundation services, namely, providing financial support to people in need, who may include, but are not limited to, the homeless, families, the vulnerable, victims of circumstance, victims of crimes, veterans, youth, and others, for general relief, food, shelter, scholarships, education, and other financial, and volunteer assistance” in International Class 36.¹

¹ Registration No. 5067798, issued on October 25, 2016, based on an underlying used-based application filed March 16, 2016 and claiming a date of first use anywhere and in commerce of May 25, 1993. Section 8 affidavit filed.

The cancellation petition relies on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on Petitioner's alleged prior common law rights in the mark DREAMS TO REALITY used in connection with "charitable services for providing clothing to women in transition and operating a resale shop to support its charitable work."² Petitioner pleads that its "first use in 2000 of [its] Mark precedes the underlying application filing date, March 16, 2016, of [Respondent's] Registration No. **5067798**."³ Petitioner does not plead that its use predates Respondent's claimed date of first use of the mark anywhere and in commerce of May 25, 1993.

In its amended Answer, Respondent Dreams to Reality Foundation ("Respondent" or "Registrant"), denies the salient allegations in the Petition to Cancel and claims it "has continuously used the mark DREAMS TO REALITY FOUNDATION long prior to any use of DREAMS TO REALITY by Plaintiff."⁴

This case now comes before the Board for consideration of Respondent's motion, filed May 6, 2022, for summary judgment on the issues of priority and likelihood of confusion.⁵ The motion has been fully briefed and is contested.

Petitioner argues that Respondent's motion for summary judgment is premature, and that there are genuine disputes as to material facts regarding priority and

² Petition to Cancel, p. 2, 1 TTABVUE 4.

³ *Id.* at 3, 1 TTABVUE 5.

⁴ 12 TTABVUE 2-3.

⁵ 15 TTABVUE 2.

likelihood of confusion.⁶ We deny the motion for summary judgment for the following reasons.

II. Motion for Summary Judgment Denied

A. Applicable Legal Principles

Summary judgment may be used to dispose of cases in which there are no genuine disputes as to material facts, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(a); *Odom's Tenn. Pride Sausage, Inc. v. FF Acquisition, L.L.C.*, 600 F.3d 1343, 93 USPQ2d 2030, 2031 (Fed. Cir. 2010); *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992). “Because a trademark owner’s certificate of registration is ‘prima facie evidence of the validity of the registration’ and continued use of the registered mark, the burden of proof is placed upon those who seek cancellation.” *Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1201, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989) (internal citation omitted).

The Board may not resolve disputes as to material facts on summary judgment, and instead may only ascertain whether genuine disputes exist. The evidence must be viewed in the light most favorable to the non-movant, in this case Petitioner, and we draw all justifiable inferences in Petitioner’s favor. *Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993).

Respondent, as the party moving for summary judgment, bears the burden on summary judgment to establish that there is no genuine dispute of material fact, and

⁶ Petitioner’s Br., p. 1-2, 17 TTABVUE 4-5.

that it is entitled to judgment as a matter of law. *See generally Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). Petitioner, as the nonmoving party, may not rest on mere allegations, but must designate specific portions of the record showing the existence of a genuine dispute of material fact for trial. *See Venture Out Props. LLC v. Wynn Resort Holdings LLC*, 81 USPQ2d 1887, 1890 (TTAB 2007); *see also* Fed. R. Civ. P. 56(c)(1).

B. Timeliness of Respondent’s motion for summary judgment

Petitioner first argues that the motion for summary judgment is premature because Petitioner needs to conduct additional discovery: “Registrant’s motion for summary judgment is premature. Discovery has been suspended, in accordance with Trademark Rule 2.127(d), when Registrant moved for summary judgment thereby denying Petitioner the opportunity to discover information that is essential to its [cancellation].”⁷

We do not find Respondent’s motion for summary judgment to be premature. The motion was timely filed inasmuch as it was filed on May 6, 2022, well after January 23, 2022, the date on which initial disclosures were due. 37 C.F.R. § 2.127(e)(1) (“A party may not file a motion for summary judgment until the party has made its initial disclosures[.]”).

If Petitioner believed it could not effectively oppose the motion for summary judgment without taking additional discovery, it needed to file a motion with the Board for time to take additional discovery. Fed. R. Civ. P. 56(d); TRADEMARK TRIAL

⁷ Petitioner’s Br., p. 2, 17 TTABVUE 5.

AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 528.06 (2022). Petitioner did not do so within the required time period, and may not do so now. 37 C.F.R. § 2.127(e)(1) (“A motion under Rule 56(d) of the Federal Rules of Civil Procedure, if filed in response to a motion for summary judgment, shall be filed within thirty days from the date of service of the summary judgment motion. The time for filing a motion under Rule 56(d) will not be extended or reopened.”).

C. Priority and likelihood of confusion

To prevail on summary judgment on the likelihood of confusion claim, Respondent must demonstrate that there is no genuine dispute of material fact as to its priority and that the contemporaneous use of the parties’ respective marks in connection with their respective services would be likely to cause confusion, mistake or to deceive consumers regarding the source thereof. *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001). Likelihood of confusion depends on an analysis of all of the probative facts in evidence that are relevant to the thirteen factors set forth in *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) (“*DuPont* factors”).

As noted above, Petitioner bases its likelihood of confusion claim on prior common law use of its DREAMS TO REALITY mark since 2000, which predates the March 16, 2016 filing date of the application underlying Respondent’s registration:

At least as early as 2000, which is long before the filing date of Registrant’s application, Petitioner adopted and commenced common law use of the mark DREAMS TO REALITY (“Petitioner’s Mark”) in the United States in connection with charitable services for providing

clothing to women in transition and operating a resale shop to support its charitable work.⁸

Respondent contends that “the undisputed summary judgment evidence establishes conclusively that Registrant has continuously used its mark since 1993, well before Petitioner’s claimed date of first use within each of the states in the United States and indeed globally.”⁹ In support, Respondent introduced two testimony declarations from individuals affiliated with Respondent, Carmelita Burns¹⁰ (“Burns Decl.”) and Christopher Matthew Spencer¹¹ (“Spencer Decl.”). The Spencer declaration included supporting documents purporting to establish prior and continuous use of Respondent’s mark. Respondent also introduced a testimony declaration from its attorney, Molly Buck Richard¹² (“Richard Decl.”), regarding Petitioner’s discovery responses.

In her declaration, Ms. Burns testified that in 1993 she became “a vendor of the Dreams to Reality Foundation’s fundraising program in which donated items are evaluated, restored, repaired and resold on ecommerce sites including eBay. Later on those sites included Etsy, Facebook, Craigslist and Shopify.” Ms. Burns further testified that “[a]s early as 1999 and continuing until the present, I consigned merchandise to Dreams to Reality Foundation for resale on eBay[.]”¹³ Notably, Ms.

⁸ Petition to Cancel ¶ 4, 1 TTABVUE 4.

⁹ Respondent’s Br., p. 6, 15 TTABVUE 9.

¹⁰ 15 TTABVUE 13-14.

¹¹ 15 TTABVUE 15-50.

¹² 15 TTABVUE 51-94.

¹³ *Id.* at 15 TTABVUE 13.

Burns did not provide any testimony regarding how the DREAMS TO REALITY FOUNDATION mark was used, whether or not Respondent made any money from its sales, or what was done with any money raised.

In his declaration, Mr. Spencer testified that:¹⁴

- In 1993, he helped co-found Respondent, Dreams to Reality Foundation, he filed its's articles of incorporation with the State of California, and he filed numerous tax documents. Mr. Burns testified further about fundraising events in 1993, 1994 and 1995.
- Between 2000-2007, "representatives of Dreams to Reality Foundation spoke at internationally promoted events for nonprofit leaders organized by The Points of Light Institute."
- "On June 4, 1999, Dreams to Reality Foundation began actively selling on eBay, a global ecommerce marketplace that reaches 195 countries. Dreams to Reality Foundation's eBay stores receive hundreds of millions of global impressions each year. Dreams to Reality Foundation continues to operate ten eBay Stores to this day."
- "Dreams to Reality Foundation also actively sells donated goods under its Mark on Craigslist, Etsy, Facebook and Shopify; each of which has exposure to every country with audiences in the millions (for Facebook, in the billions)."
- "At any one time, Dreams to Reality Foundation has, on aggregate, more than 18,000 product ads running in 195 countries online in all of the ecommerce stores it operates."
- In 2007, 2009 and 2010, Respondent partnered with other groups to fundraise.
- In 2016, Respondent again partnered with other groups to fundraise.

¹⁴ 15 TTABVUE 15-20.

- “Dreams to Reality Foundation has been continuously using its Mark from 1993 to the present day.”

Notably, although Mr. Spencer and Ms. Burns testified that Respondent sells numerous articles via the ecommerce stores it operates, they do not say how the money raised is used to support Respondent’s charitable foundation services, particularly, what kind of financial support is provided to people in need. In addition, there are gaps in the testimony as to periods of use, particularly between 2010 and 2016, and between 2017 and 2021. Neither Mr. Spencer nor Ms. Burns say what activities, if any, Respondent conducted during these time periods. No evidence was submitted demonstrating how Respondent’s mark is used on any of the ecommerce sites.

In response, Petitioner alleges that genuine disputes as to material facts exist regarding priority because Respondent’s use has not been continuous: “While Registrant may content [sic] that it began using Registrant’s Mark in 1993, there exists [sic] issues of fact as to whether that mark was continuously used in commerce.”¹⁵ According to Petitioner, “[t]here is significant evidence, as well as a lack of evidence, that indicates Registrant was not using the mark in commerce for a significant number of years and didn’t start using the mark again until after 2000 which would give Petitioner priority.”¹⁶ Despite its claim that additional discovery is needed, Petitioner introduced some evidence, including:¹⁷

¹⁵ Petitioner’s Br., p. 1, 17 TTABVUE 4.

¹⁶ Petitioner’s Br., pp. 5-6, 17 TTABVUE 8-9.

¹⁷ Heller decl. ¶ 9, Ex. B, 17 TTABVUE 12, 32-38.

- Internal Revenue Service documentation which suggest there are gaps in Respondent's provision of its charitable services.
- Excerpts from the internet archive, www.archive.org, suggesting that the history of Respondent's website dates back to only 2015.
- Excerpts from the eBay web page showing one of Respondent's stores has only been a "Member since: Oct 25, 2014."

In addition, we note that in response to Petitioner's request for production of documents, Respondent refused to produce any documents relating to its revenues or advertising expenses, as follows:¹⁸

REQUEST FOR PRODUCTION NO. 14

All Documents showing the total revenues of Registrant on an annual basis under any mark including DREAMS TO REALITY.

RESPONSE:

Based on the fact that Petitioner refuses to produce such documents, Registrant will not produce such documents.

REQUEST FOR PRODUCTION NO. 15

All Documents showing the total advertising expenses of Registrant on an annual basis under any mark including DREAMS TO REALITY.

RESPONSE:

Based on the fact that Petitioner refuses to produce such documents, Registrant will not produce such documents.

Petitioner's has served a second set of discovery requests which are pending due to the suspension of discovery following the filing of Respondent's Motion for Summary Judgment.¹⁹

¹⁸ *Id.* at ¶ 5, Ex. A, 17 TTABVUE 11, 30.

¹⁹ 16 TTABVUE; Heller decl. ¶¶ 7-8, 17 TTABVUE 11-12.

In determining priority, “one should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use.” *West Fla. Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994). The testimony of a single witness with personal knowledge of the facts, if sufficiently probative, may establish priority of use if it is clear, convincing, consistent, uncontradicted and sufficiently circumstantial, to convince the Board of its probative value. *Powermatics, Inc. v. Globe Roofing Prods. Co.*, 341 F.2d 127, 144 USPQ 430, 432 (CCPA 1965); *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at *26-27 (TTAB 2021).

Looking at the parties’ testimony and exhibits as a whole, we find that there are genuine disputes as to material facts regarding Respondent’s use of its mark in connection with the identified services. The Burns and Spencer testimony regarding the use of Respondent’s mark in connection with “providing financial support to people in need” is vague and undetailed, particularly as to how the money raised is spent and whether the services were continuous. Neither declaration provides any evidence as to how Respondent uses its mark. The Burns testimony addresses only the consignment of items to eBay and does not support any other aspects of Respondent’s charitable foundation services. Nor is the Burns testimony supported by any corroborating documents.

Petitioner’s evidence, although fragmentary, combined with Respondent’s refusal to produce any documentation regarding its revenues or advertising expenditures,

also suggests there are genuine disputes as to material facts regarding Respondent's continuous use of its mark.

Accordingly, we find that the record has significant gaps regarding the use of Respondent's mark in the provision of its charitable services. Respondent's testimony and evidence, therefore, do not carry with them the "conviction of ... accuracy and applicability" with respect to its prior use of the DREAMS TO REALITY FOUNDATION mark. *B.R. Baker Co. v. Lebow Bros.*, 150 F.2d 580, 66 USPQ 232, 236 (CCPA 1945) (oral testimony "should be most carefully scrutinized" for "conviction of its accuracy and applicability"). Respondent's refusal to produce documents relating to revenues or advertising expenses suggests material facts relating to Respondent's continuity of use remain in dispute as well.

Regarding the claim of a likelihood of confusion, Respondent argues that "Petitioner has admitted that Petitioner does not claim that there is a likelihood of confusion between Registrant's mark DREAMS TO REALITY FOUNDATION and Petitioner's mark DREAMS TO REALITY."²⁰ For support, Respondent points to the following interrogatory response by Petitioner:²¹

²⁰ Respondent's Br., p. 4, ¶ 13, 15 TTABVUE 7.

²¹ Petitioner's Response to Registrant's Interrogatories, 15 TTABVUE 82.

INTERROGATORY NO. 15:

Does Petitioner claim that there is a likelihood of confusion between Registrant's Mark and any mark used by Petitioner that includes DREAMS TO REALITY?

ANSWER:

No due to the type of services offered by Petitioner. However, due to the fact that [Respondent] has used its registration to shut down Petitioner's web site, it has alleged that claim in its petition to cancel Registrant's registration. Especially since Petitioner's use predates Registrant's filing for federal registration [sic] in 2016.

Respondent also relies on similar admissions deemed admitted by way of Petitioner's failure to respond to Respondent's second set of requests for admission.²²

Respondent's position relies on the first sentence of Petitioner's response regarding whether there is a likelihood of confusion: "No due to the type of services offered by Petitioner." But Respondent ignores the second sentence of Petitioner's response which explains that Petitioner has filed the cancellation proceeding because Respondent has shut down Petitioner's web site.²³ We interpret Petitioner's statement that there is not a likelihood of confusion as nothing more than a desire to co-exist with Respondent, rather than a conclusion of law.

Moreover, Petitioner's admission that there is no of likelihood of confusion is not dispositive because likelihood of confusion is a question of law and "opinions of law [are] not admissions of fact and thus cannot serve ... as admissions against interest

²² Respondent's Br., p. 6, ex. C, 15 TTABVUE 9, 90-94.

²³ See Petition to Cancel, ¶ 12, 1 TTABVUE 5.

....” *Brooks v. Creative Arts By Calloway, LLC*, 93 USPQ2d 1823, 1826 (TTAB 2009); *see also Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 USPQ 151, 153-54 (CCPA 1978) (opposer’s prior statement “that confusion is unlikely to occur” was a legal conclusion that could not be an admission). *See also* TBMP § 309.03(c)(2)(B) (“A plaintiff may plead likelihood of confusion directly or hypothetically.”); *Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 USPQ 48, 49 (TTAB 1971) (in seeking to cancel on ground of abandonment, plaintiff asserted proper hypothetical pleading of likelihood of confusion as its basis for standing).

Upon careful consideration of the arguments and evidence presented by the parties, and drawing all inferences with respect to the motion in favor of Petitioner as the non-movant, we find Respondent has failed to demonstrate the absence of any genuine dispute of material fact as to priority and likelihood of confusion. Accordingly, Respondent’s motion for summary judgment is DENIED.²⁴

III. Accelerated Case Resolution

The parties may take advantage of their filings made in connection with the present motion for summary judgment and pursue the Board’s Accelerated Case Resolution (ACR) procedure.²⁵ As explained at TBMP §§ 702.04 and 705, the parties

²⁴ The fact that we have identified certain genuine disputes of material fact as sufficient bases to deny Respondent’s motion should not be construed as a finding that these are necessarily the only disputes that remain for trial.

²⁵ However, absent such agreement, the parties should note that the evidence submitted in connection with a motion for summary judgment or opposition thereto is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss*, 28 USPQ2d 1464; *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983). The parties may, however, stipulate that any or all of the summary judgment evidence be treated as properly of record

may stipulate that materials submitted with their summary judgment briefing be considered at trial as evidence, with or without supplementation. *See, e.g., Freeman v. Nat'l Ass'n of Realtors*, 64 USPQ2d 1700 (TTAB 2002) (parties agreed that evidence and arguments submitted with Opposer's motion for summary judgment and Applicant's response could be treated as the final record and briefs); *see also* TBMP § 528.05(a)(2) and authorities cited therein.

IV. Proceedings Resumed – Schedule

Proceedings are RESUMED. Remaining dates are reset as follows:

Expert Disclosures Due	10/2/2022
Discovery Closes	11/1/2022
Plaintiff's Pretrial Disclosures Due	12/16/2022
Plaintiff's 30-day Trial Period Ends	1/30/2023
Defendant's Pretrial Disclosures Due	2/14/2023
Defendant's 30-day Trial Period Ends	3/31/2023
Plaintiff's Rebuttal Disclosures Due	4/15/2023
Plaintiff's 15-day Rebuttal Period Ends	5/15/2023
Plaintiff's Opening Brief Due	7/14/2023
Defendant's Brief Due	8/13/2023
Plaintiff's Reply Brief Due	8/28/2023
Request for Oral Hearing (optional) Due	9/7/2023

for purposes of final decision. *See, e.g., Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998).

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, matters in evidence, the manner and timing of taking testimony, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).