

THIS DISPOSITION IS NOT
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THE TTAB 8/5/98

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Bottorff

Opposition No. 106,990

No Fear, Inc.

v.

Wallace Martin Eggert

Before Cissel, Hairston and Walters, Administrative
Trademark Judges. By the Board.

This case now comes up on applicant's October 15, 1997
motion for summary judgment. Opposer has filed a brief in
opposition to applicant's motion as well as an alternative
request for discovery under Fed. R. Civ. P. 56(f).

Applicant has filed a reply brief in support of his summary
judgment motion which the Board, in its discretion, has
considered. The Board has carefully considered all of the
parties' arguments and submissions, and decides as follows.

Applicant has applied to register the mark NOSFERATU
for goods identified in the application as "men's, women's,
and children's wearing apparel, namely, shirts, T-shirts,
sweatshirts, jackets, coats, vests, dresses, skirts, pants,

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shorts, jeans, underwear, scarves, bandannas, ties, caps, hats, belts, caps¹, footwear and headwear." The application was filed on October 3, 1996, and is based on the intent-to-use provisions of Trademark Act Section 1(b), 15 U.S.C. §1051(b).

Opposer filed a timely notice of opposition to registration of applicant's mark. As grounds therefor, opposer alleges that it is the owner of the mark NO FEAR; that it has used that mark since at least as early as August 1990 on a variety of goods, including clothing items essentially identical to those identified in applicant's application; that it owns numerous registrations² of the mark NO FEAR, depicted both in typed form and in various stylized forms, covering a variety of goods including the types of clothing items identified in applicant's application; that its NO FEAR mark is well-known; and that applicant's mark, NOSFERATU, as applied to applicant's goods, is confusingly similar to opposer's previously-used

¹ The word "caps" appears twice in the application's identification of goods.

² Opposer has attached to its notice of opposition copies of fifteen registrations, cumulatively covering goods including Class 25 clothing, Class 16 decals, Class 14 jewelry, Class 28 sporting goods, toys and video games, Class 3 fragrance products, Class 5 bandages, Class 10 compression bandages and wraps for medical use, Class 12 bicycles, Class 9 sunglasses and eyeglasses, and Class 42 retail store services. The copies are not status and title copies, but applicant, for purposes of his summary judgment motion, has conceded opposer's ownership of the registrations.

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NO FEAR mark, and thus is barred from registration under

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Trademark Act Section 2(d), 15 U.S.C. §1052(d).

Applicant filed a timely answer, by which he has denied the allegations of the notice of opposition which are essential to opposer's Section 2(d) claim. Applicant subsequently filed a timely motion for summary judgment, which is supported by applicant's declaration and attached exhibits.

For purposes of his motion for summary judgment, applicant has conceded that priority rests with opposer in this case, and that various of the *du Pont*³ likelihood of confusion evidentiary factors would weigh in favor of a finding of likelihood of confusion. Thus, for purposes of applicant's motion for summary judgment, it is undisputed that applicant's goods, as identified in the application, are, in part, identical to the goods covered by some of the registrations pleaded by opposer; that these goods would travel through the same trade channels and be marketed to the same classes of purchasers; that opposer has continuously used its NO FEAR marks throughout the United States since at least as early as August 1990 in connection with clothing products; that opposer's NO FEAR clothing products are well-known and recognized among the purchasing public and that opposer's NO FEAR mark has come to be known

³ *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1356, 177 USPQ 563 (CCPA 1973).

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to the trade and to the consuming public to refer to products originating with opposer; and that there are no third-party marks which are identical to or similar to those of opposer in the clothing products field such that any "weak mark" defense could be raised by applicant.

Applicant argues, however, that it also cannot be reasonably disputed in this case that the parties' respective marks, i.e., NOSFERATU and NO FEAR, are completely dissimilar in terms of appearance, sound, connotation and commercial impression, under the first *du Pont* likelihood of confusion evidentiary factor. NOSFERATU and NO FEAR do not look alike or sound alike, argues applicant, nor are their respective connotations similar.

Regarding the connotation of his mark, applicant has presented evidence establishing that "nosferatu" is a synonym for "vampire" and is a well-known term in vampire literature and mythology, not least as a result of the 1922 classic silent film "Nosferatu, Eine Symphonie des Garuens" ("Nosferatu, a Symphony of Horror"), and the 1979 remake of that film, "Nosferatu the Vampyre." Applicant, in his declaration in support of his motion for summary judgment, asserts that he is interested in vampire lore and mythology and that he selected and adopted the mark NOSFERATU because of the term's "vampire" connotation. Applicant also argues

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that to purchasers who are not aware of the "vampire" connotation of the term NOSFERATU, the term would have no particular meaning but would be viewed simply as an unknown foreign word. By contrast, applicant argues, opposer's mark NO FEAR does not connote vampires, nor would it be viewed as an unfamiliar foreign term. Rather, opposer's mark is a phrase comprised of two commonly recognized English words, connoting an absence of apprehension, anxiety or dread.

Applicant argues that this indisputable dissimilarity between the parties' respective marks, under the first *du Pont* evidentiary factor, is dispositive of the likelihood of confusion analysis in this case, outweighing all of the other undisputed facts of record which would otherwise support a finding of likelihood of confusion. That is, applicant argues, the parties' marks are so dissimilar that no confusion is likely, notwithstanding the undisputed identity of the parties' respective goods, trade channels, and classes of customers, and notwithstanding the undisputed fame of opposer's mark and the absence of similar third-party marks.

Opposer has not submitted any affidavits or other evidence in opposition to applicant's motion for summary judgment. However, opposer has filed a twenty-page brief, the first sixteen pages of which are devoted to opposer's arguments on the substantive merits of applicant's motion,

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and the last four pages of which comprise opposer's arguments in support of its alternative request for discovery under Fed. R. Civ. P. 56(f). Opposer also has submitted the Rule 56(f) affidavit of its counsel, Darren S. Rimer.

On the merits, opposer argues that, as applicant has conceded for purposes of its motion, many of the *du Pont* evidentiary factors, i.e., the similarity of goods, similarity of trade channels and classes of purchasers, the strength of opposer's mark, and the absence of similar third-party marks, all favor a finding of likelihood of confusion in this case and accordingly are sufficient to defeat applicant's motion for summary judgment. Opposer further argues that its NO FEAR mark is a strong and famous mark, entitled to a wide scope of protection, and also that there is a genuine issue of material fact as to applicant's intent in adopting his mark, issues of intent generally being unsuitable for determination on summary judgment.

Opposer also argues that there are genuine issues of material fact in this case as to the similarity or dissimilarity of the parties' respective marks, under the first *du Pont* evidentiary factor. Specifically, opposer argues that applicant's analysis of the similarity of the marks is based on an improper and overly simplistic side-by-side comparison of the marks, and that there is no evidence

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that the relevant purchasing public for applicant's goods is aware of the "vampire" connotation of NOSFERATU asserted by applicant. According to opposer, opposer's NO FEAR mark and applicant's NOSFERATU mark actually are similar in terms of appearance and potential connotation, in that:

[t]he first two letters of Applicant's mark are the letters "NO" followed by the letters "FER" in close proximity thereto. Thus, the mark NOSFERATU could be associated with Opposer and Opposer's family of NO FEAR trademarks, depending upon the actual usage of the mark and the commercial impression created thereby, which are issues of fact.

Opposer's brief, at pp. 12-13. Opposer argues that the commercial impression of applicant's mark depends on the totality of circumstances surrounding how the mark is used by applicant and perceived by the purchasing public, including whether applicant uses a type style or font which is substantially similar to one used by Opposer, and that there is no evidence of record with respect to those circumstances.

Opposer argues, alternatively, that in the event that the Board finds that opposer has failed, by the arguments made in its brief, to demonstrate the existence of a genuine issue of material fact sufficient to defeat applicant's summary judgment motion, then summary judgment nonetheless should not be granted to applicant because opposer is entitled to discovery under Fed. R. Civ. P. 56(f). Opposer

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asserts, in this regard, that it has not received applicant's responses to opposer's previously-served discovery requests, and that additional discovery will be needed as well, including interrogatories, requests for production of documents, requests for admissions, discovery depositions, and, possibly, consumer surveys.

Opposer's Rule 56(f) affidavit includes a recitation of the thirteen *du Pont* factors and an assertion that opposer seeks discovery as to those factors. More specifically, opposer's counsel (at paragraph 10 of his affidavit) asserts as follows:

Additional issues of fact which may be discovered will relate to visual and phonetic similarities between the marks, the nature and extent of use of NOSFERATU by Applicant and whether such use is in any particular channels of trade, as well as discovery regarding other issues relevant to a finding of a likelihood of confusion between marks. With respect to the latter, such discovery would involve the strength of Applicant's [sic] marks, in light of alleged third party usages, as well as the intent of Applicant in selecting and adopting its trademark.

Turning first to opposer's alternative request for Rule 56(f) discovery, we find that opposer has failed to show that it is entitled to such relief. Initially, we doubt the procedural propriety of opposer's attempt to use Rule 56(f) as a "fallback position" in case its (sixteen pages of) arguments on the merits of applicant's summary judgment motion fail. *Cf. Dyneer Corp. v. Automotive Products plc,*

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37 USPQ2d 1251 (TTAB 1995). More fundamentally, however, we find that opposer has failed to establish its entitlement to Rule 56(f) discovery in any event.

Opposer's Rule 56(f) affidavit essentially consists of a recitation of certain of the *du Pont* evidentiary factors, a statement of the proposition that those factors generally "are relevant to a finding of a likelihood of confusion between marks," and a conclusory assertion that opposer therefore is entitled to discovery pertaining to those factors prior to responding to applicant's summary judgment motion. This mere recitation of *du Pont* factors, without an identification of any specific facts that opposer believes it will be able to prove if it is permitted to take the requested discovery, is not a sufficient Rule 56(f) showing. *See Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736, 1738 (Fed. Cir. 1989) ("We do not imply that a mere mention of intent and actual confusion in Keebler's affidavits would have rendered them adequate under Rule 56(f)"); *Strang Corp. v. The Stouffer Corp.*, 16 USPQ2d 1309 (TTAB 1990). *Distinguish Opryland USA, Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). *See also Fennell v. First Step Designs, Ltd.*, 83 F.3d 526, 531 (1st Cir. 1996) (party seeking Rule 56(f) discovery must articulate a plausible basis for its belief

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that discoverable materials pertaining to trialworthy facts actually exist).

In addition to the fatal lack of specificity in opposer's Rule 56(f) affidavit, the Board notes that the particular evidentiary factors identified in opposer's Rule 56(f) affidavit appear to consist, for the most part, of issues upon which opposer would not need to have discovery in order to respond to applicant's motion for summary judgment. Opposer has not explained why it needs discovery to present evidence as to the "visual and phonetic similarities between the marks." Such similarities, *vel non*, are apparent from the face of the marks. Likewise, because applicant's application is based on intent-to-use, it is not clear what sort of discovery opposer is seeking regarding the "nature and extent" of applicant's use of his mark. Finally, applicant already has conceded, for purposes of summary judgment, that the parties' goods move in identical trade channels and that opposer's mark is a strong mark, not weakened by third party usage of similar marks on similar goods. Opposer therefore has no need for Rule 56(f) discovery on those issues.

The only other issue specifically identified by opposer in its Rule 56(f) affidavit is the issue of applicant's intent in adopting his mark. Opposer, citing *Dunkin' Donuts of America Inc. v. Metallurgical Exoproducts Corp.*, 840 F.2d

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917, 6 USPQ2d 1026 (Fed. Cir. 1988), argues that intent is relevant to Section 2(d) claims, and that opposer accordingly is entitled to discovery on that issue before it can be required to respond to applicant's summary judgment motion.⁴ However, we do not read *Dunkin' Donuts* to stand for the blanket proposition that a defendant's intent is always a material issue in every Section 2(d) case, or that a Section 2(d) plaintiff is always entitled to Rule 56(f) discovery on the issue of intent.

Opposer's mere mention of applicant's intent in its Rule 56(f) affidavit does not establish opposer's entitlement to discovery on that issue. See *Keebler Co.*, *supra*, 9 USPQ2d at 1738. It is not enough that the issue of intent is potentially relevant in Section 2(d) cases, in general. Rather, the determination to be made under Rule 56(f) is whether applicant's intent in adopting his mark is a material issue in this particular case. Opposer has not asserted that it believes, or has any reasonable basis for believing, that applicant adopted his NOSFERATU mark in bad faith and that discovery would uncover evidence of such bad faith. Nor is there anything else in the record which

⁴ Opposer also cites *Copelands' Enterprises, Inc. v. CNV, Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991) for the proposition that "the factual question of intent is particularly unsuited to disposition on summary judgment where the issue is whether misuse of the registration symbol was caused by an honest mistake or by an intent to deceive." Opposer's brief, page 7.

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suggests that evidence of bad faith adoption might be found through discovery. Distinguish the *Dunkin' Donuts* case, wherein the nature of the defendant's mark itself, DUNKING DONUT, when compared to the plaintiff's DUNKIN' DONUTS mark, provided a plausible basis for believing that the intent issue was material to that particular case and that discoverable materials relating to possible bad faith adoption might exist.

Opposer's Rule 56(f) motion amounts to nothing more than a request for discovery for discovery's sake, by which opposer seeks to satisfy its speculative hope of finding some evidence that might tend to support its complaint. See *Keebler Co. v. Murray Bakery Products, supra; Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984). The Court's characterization of the Rule 56(f) affidavit involved in *Keebler Co.*, *supra*, is equally applicable to this case: "Indeed, it is difficult to interpret Keebler's affidavit support for its discovery motions as saying anything more than, 'We have no factual basis for opposing summary judgment, but, if you stay proceedings, we *might* find *something*'." 9 USPQ2d at 1738 (emphasis in original). Opposer's Rule 56(f) motion is denied.

However, whether applicant has misused the registration symbol is not an issue in this case.

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We turn next to the merits of applicant's motion for summary judgment. Summary judgment is appropriate in cases where the moving party establishes that there are no genuine issues of material fact which require resolution at trial and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). An issue is material when its resolution would affect the outcome of the proceeding under governing law. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A fact is genuinely in dispute if the evidence of record is such that a reasonable factfinder could return a verdict in favor of the nonmoving party. *Id.* The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, *supra*; *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Applicant has conceded, for purposes of its summary judgment motion, that opposer has priority in this case, leaving only the issue of likelihood of confusion for determination on summary judgment. The question of whether a likelihood of confusion exists in a particular case is a legal one, the resolution of which is based on underlying

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factual determinations with respect to each of the *du Pont* evidentiary factors for which evidence has been made of record. See *Opryland USA, Inc., supra*, 23 USPQ2d at 1473.

In this case, we find that there is no genuine issue of material fact that opposer's NO FEAR marks and applicant's NOSFERATU mark are completely dissimilar in terms of appearance, sound, connotation and commercial impression, under the first *du Pont* evidentiary factor. Contrary to opposer's argument, no reasonable factfinder could conclude that, because the word NOSFERATU contains the letters NO and FER, NOSFERATU and NO FEAR are similar in terms of appearance or sound. Furthermore, applicant has presented persuasive evidence establishing that, just as applicant intended in adopting the mark, the purchasing public is likely to perceive NOSFERATU as connoting "vampire." Opposer has presented absolutely no evidence upon which a reasonable factfinder might base any other conclusion regarding the connotation of applicant's mark, nor any evidence from which it might reasonably be inferred that NOSFERATU and NO FEAR have similar connotations.

Opposer argues that there is a genuine issue of material fact as to the similarity of the commercial impressions of the respective marks, inasmuch as applicant might display his mark in a typestyle similar to the typestyle used by opposer. We disagree. Regardless of the

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manner in which applicant's mark is displayed, and even if applicant's mark were to be displayed in a typestyle similar to the typestyle in which opposer's marks appear, the commercial impression of applicant's mark would be dominated by the word NOSFERATU itself, a word which is highly distinctive, unusual, and evocative. The word NOSFERATU is so dissimilar to the words NO FEAR in terms of appearance, sound and connotation that, even if they were to appear in the same typestyle, the commercial impressions of the two marks, when viewed in their entireties, would be dissimilar as a matter of law.

In short, we find that there is no genuine issue of material fact as to the dissimilarity of the marks under the first *du Pont* evidentiary factor.

Furthermore, in view of applicant's evidentiary concessions (made for purposes of his summary judgment motion), we find that there is no genuine dispute that applicant's goods are identical to opposer's goods, that the parties' goods move through the same trade channels and are marketed to the same classes of purchasers, that opposer's mark is famous, and that there are no third-party marks which are identical to or similar to those of opposer in the clothing products field which might dilute the strength of opposer's mark.

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Because there are no genuine issues of material fact as to opposer's priority or as to any of the *du Pont* evidentiary factors for which there is evidence in the record, the issue to be determined is whether, on the basis of those undisputed facts, applicant is entitled to judgment as a matter of law in its favor on opposer's Section 2(d) claim. See Fed. R. Civ. P. 56(c). We find that it is.

It is settled that, in a particular case, a single *du Pont* evidentiary factor may be dispositive of the likelihood of confusion determination. See *Kellogg v. Pack'em Enterprises, Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *Pure Gold v. Syntex (U.S.A.), Inc.*, *supra*. This is such a case. The utter dissimilarity between the parties' respective marks, under the first *du Pont* evidentiary factor, is a sufficient basis, in itself, to warrant summary dismissal of opposer's likelihood of confusion claim.

In reaching this conclusion, we are mindful that when, as we presume to be the case here, the parties' respective goods are identical in kind and are marketed in the same trade channels to the same classes of purchasers, the degree of similarity required between the marks to sustain a claim of likelihood of confusion is less than that otherwise needed in situations involving dissimilar, non-competing products. See *Jules Berman & Associates, Inc.*, v. *Consolidated Distilled Products, Inc.*, 202 USPQ 67 (TTAB

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1979). We also have taken into account that opposer's NO FEAR mark is entitled to a relatively broad scope of protection in view of its presumed strength and fame. See *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

However, as a matter of law, the scope of protection to which opposer's mark is entitled, even though expanded due to the fame of the mark and the identity of the parties' goods, does not extend so far as to warrant a finding that applicant's use of the totally dissimilar mark NOSFERATU is likely to cause confusion. Applicant's NOSFERATU mark is so dissimilar to opposer's NO FEAR mark that purchasers who encounter clothing items bearing the NOSFERATU mark, and who are aware that opposer uses its various NO FEAR marks on similar sorts of clothing items, are not likely to be confused, mistaken or deceived into thinking that there is any source, sponsorship, approval, or other connection between opposer and applicant's goods bearing the mark NOSFERATU.

No genuine issues of material fact exist for trial, and applicant is entitled to judgment as a matter of law. Accordingly, applicant's motion for summary judgment is

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granted. See Fed. R. Civ. P. 56(c). The opposition is dismissed with prejudice.

R. F. Cissel

P. T. Hairston

C. E. Walters

Administrative Trademark Judges
Trademark Trial and Appeal Board