

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB FEB 12, 98
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Trek Bicycle, Corp.
v.
Alyx Fier

Opposition No. 94,948
to application Serial No. 74/365,185
filed on March 8, 1993

David C. Brezina of Lee, Mann, Smith, McWilliams, Sweeney &
Ohlson for Trek Bicycle Corp.

Alyx Fier, pro se.

Before Cissel, Hanak and Hohein, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Alyx Fier (applicant) seeks registration of TREKNOLOGY
and design in the form shown below for "travel bags and all
purpose athletic bags." The intent-to-use application was
filed on March 8, 1993.

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Trek Bicycle, Corp. (opposer) filed a notice of opposition on June 14, 1994 alleging that long prior to March 8, 1993, opposer had used the mark TREK on bicycles, travel bags and all purpose athletic bags, and further alleging that "applicant's trademark is [so] similar in sound, spelling, appearance and meaning to opposer's trademark TREK, and appropriates the whole of opposer's mark, so that when applied to the goods of applicant, as described in the application, which goods are actually sold by opposer, there is a likelihood of confusion." (Notice of opposition paragraphs 2, 3 and 8). In its notice of opposition, opposer also noted that it owns Registration No. 1,168,276 for the mark TREK depicted in typed capital letters for "bicycles and bicycle frames." This registration issued on September 8, 1981 with a claimed first use date of March 10, 1977. (Notice of opposition paragraph 5).

Applicant filed an answer which, among other things, denied that the allegations of paragraphs 2, 3 and 8 of the notice of opposition. As for paragraph 5 of the notice of opposition, applicant stated that it lacked sufficient knowledge to admit or deny said allegation.

On May 23, 1996 opposer filed a motion for leave to amend its notice of opposition along with a proposed amended

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notice of opposition. The proposed amended notice of opposition set forth Count I (which essentially reiterated the allegations of the original opposition) and Count II which set forth a new claim, namely, that "since August 1991 ... opposer used and promoted TREKNOLOGY as a trade identity designation in its catalogs and sales literature in connection with its sales of bicycles and related products to its dealers." (Amended notice of opposition paragraph 7). Opposer further alleged that applicant's mark "is essentially identical in sound, spelling, appearance and meaning to opposer's TREKNOLOGY, and appropriates the whole of opposer's mark, so that when applied to the goods of applicant, as described in the application, there is a likelihood of confusion." (Amended notice of opposition paragraph 14).

In a order dated September 4, 1996 this Board noted that opposer's motion to amend its notice of opposition was uncontested and granted the motion to amend. At page 2 of its order, the Board made the following comments:

"Applicant is allowed thirty days from the mailing of this order to file an answer to the amended notice of opposition. Furthermore, in order to mitigate any possible prejudice to applicant, applicant is allowed forty-five days from the mailing date of this order in which to take discovery on the

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added allegations." The Board's order concluded by resetting the trial dates.

Applicant never filed an answer to opposer's amended notice of opposition. However, opposer did not move for a default judgment and instead filed its trial brief on March 21, 1997. (Opposer took the trial testimony of its three witnesses in June 1996, after filing its motion to amend on May 23, 1996, but prior to the Board's order of September 4, 1996.) With regard to applicant's failure to file an answer to the amended notice of opposition, opposer makes the following comments at page 2 of its trial brief: "Because no answer to the amended notice of opposition has been filed within the time set, opposer is entitled to a default judgment under 37 CFR 2.106(a). However, opposer believes that it is also entitled to a judgment on the merits, and respectively requests such."

At page 2 of its trial brief dated May 12, 1997, applicant explained its failure to file an answer to the amended notice of opposition in the following fashion: "When applicant received notice of opposer's motion to amend, applicant called the [interlocutory attorney] of record to inquire about opposer's motion. Applicant was informed that the bar to granting such a motion was very low and that it was likely that opposer's motion would be granted. Applicant stated to the [interlocutory attorney]

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that such being the case applicant would not oppose the motion. Applicant was not told, and did not know, that it was still necessary to file a response to the motion to avoid a potential default judgment. Applicant assumed that not filing a response would only mean that the motion was uncontested, thereby expediting the process of allowing opposer's motion, and having the overall effect of shortening the length of time it would take to conclude these proceedings. Applicant apologizes to this Board for this misunderstanding. However, opposer has requested judgment on the merits, and have prepared their case in anticipation of this. Therefore, applicant submits that opposer has not been unduly prejudiced by applicant's failure to file an answer."

Trademark Rule 2.106(a) provides that "if no answer is filed within the time set, the opposition may be decided as a case of default." (Emphasis added). By not filing a motion for a default judgment after the time had lapsed for applicant to file an answer pursuant to this Board's order of September 4, 1996, opposer has created a situation where applicant, operating pro se, has gone to the considerable effort of preparing a 31 page trial brief. In addition, applicant filed with this Board on September 3, 1996 his notice of reliance with exhibits attached thereto. Under such circumstances, the Board will not enter a default

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judgment in favor of opposer. Instead, this case will be decided on the merits. Moreover, it is clear from applicant's brief that he would have denied the pertinent allegations of Count II of the amended notice of opposition. At page 27 of its brief, applicant contends that he coined the term TREKNOLOGY in April 1991 and first used this term in June 1991, prior to opposer's alleged first use of said term in August 1991. Moreover, at page 26 of his brief, applicant alleges that opposer's use of the word TREKNOLOGY "does not qualify as trademark usage."

Opposer's record in this case consists of the testimony depositions (with exhibits) of Jerry Norquist, Pat Sullivan and Howard Gordon. In addition, by means of a notice of reliance, opposer has also made of record, among other things, applicant's responses to certain of opposer's interrogatories and requests for admissions, and a certified status and title copy of opposer's pleaded Registration No. 1,168,276 for the mark TREK for "bicycles and bicycles frames." In a second notice of reliance, opposer has made of record certified status and title copies of its registrations for the marks TREK 100 and TREKKING. Neither of these marks were even mentioned in opposer's notice of opposition or amended notice of opposition. Hence, in our likelihood of confusion analysis, we will give no consideration to these two registrations.

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Applicant has attempted to make of record by means of a notice of reliance what it characterizes as "printed publications and official records." Presumably, applicant is attempting to rely upon Trademark Rule 2.122(e) entitled "Printed publications and official records." However, the majority of the documents attached to applicant's notice of reliance are simply not printed publications or official records, and thus, do not form part of the evidentiary record. Many of applicant's documents are what applicant characterizes as "sales catalogs." It has been held that such sales catalogs do not constitute publications "available to the general public," and hence are not admissible by means of a notice of reliance. Glamorene Products Corp. v. Earl Grissmer, 203 USPQ 1090, 1092 (TTAB 1979). In addition, applicant has attempted to make of record by means of its notice of reliance a list of third-party trademark registrations. Such a list does not constitute either a printed publication or an official record, and thus is not admissible. See Trademark Trial and Appeal Board Manual of Procedure (1st ed. 1995) at Section 703.02(b). Finally, applicant seeks to make of record by means of its notice of reliance a letter from applicant to IBM dated June 28, 1991, and a response from IBM to applicant dated September 14, 1991 (applicant's exhibits 14b and 14c). It is clear that "letters [are] not properly

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submitted into evidence under a notice of reliance pursuant to Trademark Rule 2.122(e) since they are neither printed publications nor official records." Cadence Industries Corp. v. Kerr, 225 USPQ 331, 332 (TTAB 1980). The exclusion of these letters is of particular pertinence inasmuch as applicant relies upon these letters to attempt to demonstrate that it was applicant who first used the term TREKNOLOGY.

On the other hand, applicant has properly made of record by means of its notice of reliance advertisements and an article from newspapers and magazines. Moreover, by means of a supplemental notice of reliance, applicant has properly made of record third-party trademark registrations. While opposer notes at page 7 of its brief that these third-party registrations were "not submitted in the form of status copies showing title," it is clear that third-party registrations need not be in the form of certified status and title copies. See Trademark Trial and Appeal Board Manual of Procedure (1st ed. 1995) at Section 703.02(b).

Turning to the merits of this case, we note at the outset that priority of use rests with opposer. Of course, in addition, opposer has properly made of record its Registration No. 1,168,276 for TREK depicted in typed capital letters for "bicycles and bicycle frames." As previously noted, this registration issued on September 8,

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1981 with a claimed first use date anywhere and in commerce of March 10, 1977.

Indeed, applicant has admitted that opposer first used its TREK mark on bicycles "at least as early as March 10, 1977." (Applicant's responses to opposer's requests for admission nos. 41 and 42.). In 1988, opposer first used its TREK mark on bags. (Norquist deposition 31). Opposer first promoted its TREK bags in its TREK catalog of 1989. The bags appearing in this 1989 catalog bearing the TREK trademark included not only bags or packs designed specifically for use on bicycles, but also fanny packs, packs designed to hold water bottles and larger, general purpose athletic bags. (Opposer's exhibit no. 12 at page entitled TREK GEAR).

In September 1991, opposer first introduced its TREKNOLOGY program to its dealers. Opposer's TREKNOLOGY program "was a way for Trek Bicycle dealers to bring in the highly technical and generally higher priced bicycle products that Trek offered to the marketplace." (Norquist deposition 36). Opposer's TREKNOLOGY program was introduced to bicycle purchasers in March 1992 in a multi-page "pullout" appearing in Bicycle magazine. (Opposer's exhibit 21). This pullout advertisement has as its title, in large letters, the following: "Introducing The Revolutionary Modern Art Of High Treknology." On most pages of this

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pullout, there appears the word TREKNOLOGY within a circular design device. Opposer has demonstrated that it has continuously used the term TREKNOLOGY in connection with the promotion of its products since 1991. (Sullivan deposition 7).

In view of the fact that many of applicant's exhibits were not properly made of record, and in particular exhibits 14b and 14c, applicant's earliest priority date is the filing date of its application for TREKNOLOGY and design, namely, March 8, 1993. By that time, opposer had long since been making use of TREK on bicycles and various types of bags/packs including specifically athletic bags. In addition, while opposer did not make technical trademark use of the term TREKNOLOGY, opposer had long prior to March 8, 1993 used this term to promote its entire line of products including bicycles and bags. We should also note that even if applicant's exhibits 14b and 14c had properly been made of record, these exhibits do not demonstrate that applicant used the term TREKNOLOGY in a public fashion. Exhibit 14b is letter dated June 28, 1991 from applicant to IBM wherein applicant talks of its Treknology Security System. Exhibit 14c is a response from IBM to applicant dated September 14, 1991 wherein IBM states that "we have no interest in pursuing your offer of a license to the [personal security system] invention." Thus, not only was applicant's June

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1991 use of TREKNOLOGY not exposed to be public, but in addition, said use was not in connection with bags or packs of any type. Rather, it was in connection with a personal security system for computers.

Turning to the issue of likelihood of confusion, we note that applicant's mark TREKNOLOGY and design is depicted in a manner such that the design feature separates the TREK portion of applicant's mark from a NOLOGY portion of applicant's mark. Stated somewhat differently, the TREK portion of applicant's mark clearly stands out by itself. Obviously, the TREK portion of applicant's mark is identical to opposer's TREK mark.

Moreover, we note that long prior to applicant's filing date of March 8, 1993, opposer had made very extensive use of its mark TREK on bicycles since 1977 and had made significant use of its mark TREK on athletic bags and other bags/packs since at least 1988. Indeed, opposer's use of TREK in connection with higher priced bicycles has been so long standing and so extensive that applicant has acknowledged that, at least with regard to such higher priced bicycles, opposer's mark TREK "is very well known." (Applicant's brief page 16). Based on a complete review of the record, we concur with applicant's assessment that is applied to higher priced bicycles, the mark TREK is very well known. Indeed, at least with regard to this particular

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product category (i.e. higher priced bicycles), we find that opposer's mark is a famous mark.

Of course, in support of its Section 2(d) claim, opposer relies not only upon its rights in the mark TREK for bicycles, but also upon its rights in the mark TREK for athletic bags and other bags/packs. In this regard, we note that the goods of the parties are identical. That is to say, applicant's chosen description of goods for its TREKNOLOGY and design application includes athletic bags, the very same type of bags on which opposer has continuously used its TREK mark since 1988.

Based upon the foregoing, we find there exists a likelihood of confusion resulting from applicant's use of TREKNOLOGY and design in connection travel bags and athletic bags and opposer's use of its famous mark TREK in connection with bicycles. We also find there exists a likelihood of confusion resulting from applicant's use of its mark for the aforementioned goods and opposer's prior use of its mark TREK for legally identical goods (i.e. athletic bags). In making these two separate determinations, we have taken into account that applicant has chosen to depict its mark TREKNOLOGY and design in a manner such that the design feature splits the TREK portion of applicant's mark from the NOLOGY portion of applicant's mark. Moreover, we have also taken into account that long prior to applicant's filing

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date, opposer had made use of the identical term TREKNOLOGY, not as a technical trademark, but rather as a term to promote its bicycles and bags/packs. In our view, opposer's prior use of TREKNOLOGY to promote opposer's TREK bicycles and TREK bags simply enhances the likelihood that consumers will assume that applicant's TREKNOLOGY and design bags emanate from opposer. In light of our finding that there exists a likelihood of confusion as to Count I of opposer's amended notice of opposition, we elect not to consider whether or not there exists a likelihood of confusion as to Count II of opposer's amended notice of opposition. That is to say, we elect not consider whether opposer's prior use of TREKNOLOGY as a promotional term in and of itself and of itself and applicant's subsequent "use" of TREKNOLOGY and design for bags is likely to cause confusion.

In arguing that there is no likelihood of confusion, applicant has alleged that TREK is a widely used term by third parties; that TREK is "relatively weak because of its generic and descriptive nature" (applicant's brief page 24); and that there have been no instances of actual confusion. Suffice it to say, there simply is no evidence that the term TREK has been used extensively by others. The third-party registrations made of record by applicant do not show that the marks containing the term TREK are in use, and they certainly do not show the extent of use of TREK by others.

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Moreover, again because of applicant's failure of proof, we have no way of knowing the extent of applicant's use of TREK in connection with bags so as to make a judgment as to whether there has been the opportunity for actual confusion to have occurred. Finally, applicant's contention that TREK is "generic and descriptive" is simply not supported by any evidence of record. Moreover, with regard to opposer's TREK mark for bicycles, given the fact that opposer has a registration for this mark for bicycles, applicant's allegation that TREK is descriptive and generic for bicycles constitutes an impermissible collateral attack on opposer's registration. See 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition, Section 20:22 at page 20-46 (4th ed. 1997) and cases cited therein.

In conclusion, we wish to reiterate that our finding of likelihood of confusion is based, in part, on the fact that opposer's TREK mark is famous for higher priced bicycles and on the fact that certain of opposer's goods for which it is the prior user of TREK (i.e. athletic bags) are absolutely identical to certain of applicant's goods as set forth in the application. As our primary reviewing in Court as stated, it is beyond dispute that "more protection against confusion [should be afforded] for famous marks." Kenner Parker Toys v. Rose Art, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Likewise, our primary reviewing Court has

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stated that "when marks would appear on virtually identical goods or services, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." Century 21 Real Estate v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Decision: The opposition is sustained.

R. F. Cissel

E. W. Hanak

G. D. Hohein
Administrative Trademark
Judges, Trademark Trial
and Appeal Board