

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

ls

Opposition No. 107,354

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB
FEB. 14, 00

S Industries, Inc.

v.

Duron, Inc.

Before Simms, Cissel and Seeherman, Administrative Trademark
Judges.

An application has been filed by Duron, Inc. for the
mark TERMINATOR for "house paint primers for covering
stains" in International Class 2¹. The application has been
opposed by S Industries, Inc.², claiming priority of use and
ownership of a federal registration for TERMINATOR for
sporting goods³. Opposer alleges that applicant's use of

¹ Serial No.75/149,015, filed August 8, 1996, alleging a bona fide intent to use the mark in commerce.

² It is noted that S Industries, Inc. has assigned many of its intellectual property rights to Central Mfg. Co. See U.S. Patent and Trademark Office Assignment Records at Reel 1708, Frame 0554.

³ The specific items identified in the registration are "Sports racquets, including tennis rackets, racquetball racquet, squash, badminton, golf clubs, golf balls, tennis balls, sports balls, including basketball, baseball, football, soccerball, volleyballs, tennis racquet string, and shuttlecocks" in International Class 28. Opposer also claims ownership of U.S.

Opposition No. 107,354

TERMINATOR in connection with the identified goods is likely to cause confusion, mistake, or to deceive. Applicant denied all the salient allegations.

This case now comes up on opposer's motion for summary judgment filed May 1, 1998⁴. As grounds for the motion, opposer states that it has used TERMINATOR for paints prior to applicant's filing date; has been in the paint business prior to applicant's filing date; that the marks are identical and that the goods are sold in the same channels of trade. Opposer has also filed "Opposer's Request for Judicial Notice."⁵

Applicant responds contending that opposer's verified memorandum in support of the motion and a request for judicial notice reference items which are not attached; that

Reg. No. 2,140,524, issued on March 3, 1998, for SENTRA, for various types of paints; U.S. Reg. No. 2,128,798, issued on January 13, 1998, for DARK STAR for various types of paints; and U.S. Reg. No. 1,717,010, issued on September 15, 1992, for STEALTH for "microwave absorbing automobile paint". U.S. Reg. No. 1,717,010 was cancelled under Section 8 on March 22, 1999.

⁴ It is noted, and opposer acknowledges, that its motion for summary judgment was filed after opposer's testimony period opened, which, pursuant to 37 C.F.R. § 2.127(e)(1), provides the Board the authority to deny the motion as untimely.

⁵ Federal Rule of Evidence 201 provides that judicial notice may be taken of an adjudicative fact which is not subject to reasonable dispute because it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned. Judicial notice is mandatory if requested by a party and the court is supplied with the necessary information. In that all of the items set forth in opposer's request for judicial notice are not items which are appropriate for judicial notice, and any necessary information has not been supplied, the request is hereby denied.

Opposition No. 107,354

the allegations in the motion are unsupported; and that because opposer has not yet responded to any discovery, applicant submits that all of the issues raised are genuine issues of material fact.

On May 1, 1998 opposer filed its motion for summary judgment. As evidence in support of its motion, opposer submitted a declaration from Leo Stoller, president of opposer; some computer-generated labels; a list of names, addresses, and telephone numbers in the midwest, followed by other random numbers; photocopies of items it identifies as applicant's catalog or advertisements; and a statement that it wishes to incorporate the photocopies of the status and title copies of its pleaded registration⁶ for the mark TERMINATOR, owned by S Industries, Inc. filed with the notice of opposition.

The burden is on the party moving for summary judgment to demonstrate the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. Fed. R. Civ. P. 56(c). See also, Celotex Corp. v. Catrett, 477 U.S. 317 (1986). The evidence of record and any inferences which may be drawn from the underlying undisputed facts must be viewed in the light most

⁶ The alleged "current status and title" copy of opposer's registration, does not accurately reflect current title, and bears a preparation date of 1996, thereby not being current as the time of filing.

Opposition No. 107,354

favorable to the non-moving party. See, Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). In considering the propriety of summary judgment, the Board may not resolve issues of material fact against the non-moving party; it may only ascertain whether such issues are present. See, Opryland USA, Inc. v. Great American Music Show, Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993); and Lloyd's Food Products Inc. v. Eli's Inc., 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

In certain cases, however, even though disputes remain with respect to certain material facts, summary judgment may be granted, so long as all factual disputes are resolved in favor of the non-moving party and inferences drawn from the undisputed facts are viewed in the light most favorable to the non-moving party. See, Larry Harmon Pictures Corp. v. The William's Restaurant Corp., 929 F.2d 662, 18 USPQ2d 1292, 1293 (Fed. Cir. 1991); Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 255 (1986) ("The evidence of the non-movant is to be believed, and all justifiable inferences are to be drawn in his favor"); and Bishop v. Wood, 426 U.S. 341, n.11 (1976) ("In granting summary judgment for applicants, the District Court was required to resolve all genuine disputes as to material facts in favor of opposer.").

Opposition No. 107,354

In determining whether there is a likelihood of confusion between marks, there are thirteen evidentiary factors, when of record, which the Board must consider. See, E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In this case, the factors which are of record are the marks themselves, which are identical, and the goods upon which they are used. It is the second du Pont factor, "(2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use", 177 USPQ at 567, which is determinative here. See, Kellogg Co. v. Pack'em Enterprises Inc., 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (one factor can outweigh all the others which may be pertinent).

There is no genuine issue as to the goods involved in this case. Opposer's pleaded goods are all sporting goods, racquets and balls and related items.⁷ On the other hand, applicant's goods are house paint primers. Considering the substantial differences between these goods, we find that there is no likelihood that the contemporaneous use of the same mark to identify these goods by different parties will result in a likelihood of confusion. This would be the

⁷ See footnote 2 supra, for a verbatim listing of opposer's goods. It is noted that throughout its motion papers, opposer states that it applies its mark to similar goods, but the absence of any evidence detracts from the probative value of that

Opposition No. 107,354

result at trial even if opposer was able to establish that it had licensed its mark, that its mark was strong and well known as applied to its goods, or that it had used its mark on its goods prior to applicant's use.

The Board, thus, finds that while opposer, the moving party, is not entitled to summary judgment, applicant, the nonmoving party, is so entitled on the issue of likelihood of confusion. In such circumstances, the Board has the power to enter the proper judgment, although a cross-motion therefor was not made. Rule 54(c) of the Federal Rules gives the Board the power to enter final judgment to which the prevailing party is entitled, even if the party has not demanded such relief. See, Missouri Pacific Railroad Co. v. National Milling Co., Inc., 409 F.2d 882, 13 FR Serv2d 1231 (3rd Cir. 1969). Therefore, because the Board finds that there is no genuine issue as to any fact that would be material to the issue of likelihood of confusion, and that applicant is entitled to judgment on this issue as a matter of law, opposer's motion for summary judgment is denied, and summary judgment in favor of applicant is hereby entered on the issue of a likelihood of confusion.

statement, in that opposer is the moving party on the basis of a likelihood of confusion.