

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

CBG

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB JUNE 2, 00

Cancellation Nos. 26,186  
26,663

Ben Davis Company

v.

Topwin Corporation

Before Hairston, Walters and Wendel, Administrative  
Trademark Judges.

Opinion by the Board:

Ben Davis Company has filed petitions to cancel U.S.  
Registration Nos. 1,710,154 and 2,016,682 for the marks  
PLENTY TOUGH and PLENTY TOUGH SPORT and Design,  
respectively, for various items of clothing, including  
coats, jackets, pants, shorts, jeans, mufflers, and shirts.<sup>1</sup>  
As grounds for cancellation, petitioner alleges that  
respondent's marks, as used on respondent's goods, so  
resemble petitioner's previously used mark, PLENTY TOUGH,

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<sup>1</sup> U.S. Registration 1,710,154 issued on August 25, 1992, claiming  
May 1, 1991 as the date of first use, and September 1, 1991 as  
the date of first use in commerce. Section 8 affidavit was filed  
on July 29, 1998 and accepted on January 6, 1999. U.S.  
Registration No. 2,016,682 issued on November 19, 1996, claiming  
October 1, 1993 as the date of first use and first use in  
commerce.

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for various clothing items, including pants, coveralls, overalls, aprons, shop coats, shirts and jackets, as to be likely to cause confusion. Petitioner also alleges that respondent fraudulently obtained the involved registrations because, by virtue of its prior customer relationship with petitioner, respondent knew that petitioner was using the PLENTY TOUGH mark when respondent filed its applications for PLENTY TOUGH and PLENTY TOUGH SPORT and Design.

In its answer, respondent denied the salient allegations of the petition to cancel, and affirmatively asserted that: (1) petitioner failed to state a claim upon which relief may be granted; (2) petitioner is barred by the doctrines of laches and/or acquiescence; and (3) respondent has prior rights to the mark.

This case now comes up on petitioner's motion for summary judgment on its claims of priority and likelihood of confusion.<sup>2</sup> Respondent filed an opposition to the motion, and petitioner filed a reply thereto, which we have considered.

In support of the motion, petitioner claims prior and continuous use of a mark identical to respondent's mark, PLENTY TOUGH, and virtually identical to respondent's mark, PLENTY TOUGH SPORT and Design, for identical or otherwise

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<sup>2</sup> We note respondent's motion (filed September 25, 1998) for discovery pursuant to FRCP 56(f), and respondent's withdrawal of the motion on October 13, 1998.

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highly related goods. As evidence thereof, petitioner submitted two declarations of its counsel, Margaret McHugh, and the declaration of its president, Frank Davis.

The first McHugh declaration makes of record petitioner's three sets of interrogatories and document requests and two sets of requests for admissions, and respondent's answers thereto, and a portion of the discovery deposition of respondent's president, Tom Yoshimura. This evidence contains, among other things, respondent's admissions that there is a likelihood of confusion as to the source of the parties' respective goods because the respective marks are either identical or virtually identical, and the goods are identical or closely related and move through the same trade channels.

In his declaration, Mr. Davis attests to petitioner's continuous use in commerce of the mark PLENTY TOUGH since 1945 on various clothing items. The Davis declaration makes of record various corroborating documents, including: a copy of a label bearing the PLENTY TOUGH mark, which petitioner attaches to jeans and overalls, among other things; newsclippings and advertisements about petitioner and its goods, including goods that bore the PLENTY TOUGH trademark, from 1954 through 1965, when petitioner stopped keeping a file of these records; select pages of petitioner's ledgers which show continuous sales from 1952 to 1994 of various

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items bearing the PLENTY TOUGH mark;<sup>3</sup> select pages of a report indicating the price for particular items over time, including a particular lot which bore the PLENTY TOUGH mark;<sup>4</sup> pages from price lists that show, by lot numbers, the products that petitioner offered for sale from 1962 to 1997, including various products which had a PLENTY TOUGH label directly affixed to them; various catalogs of petitioner's products, including use of the PLENTY TOUGH mark on various goods in 1971 and 1978-79;<sup>5</sup> and pages from a report generated by accounts, invoices and shipping documents, which show that petitioner sold various items to respondent from 1990 to 1994, including items that bore the PLENTY TOUGH mark directly on labels.

The second McHugh declaration makes of record a portion of the discovery deposition of Frank Davis, a copy of catalogs produced by petitioner during discovery, select pages from the Yoshimura deposition and a copy of a T-shirt bearing the words "PLENTY TOUGH."

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<sup>3</sup> Mr. Davis notes that petitioner made sales of products bearing the mark PLENTY TOUGH every year since 1954 although records from a few years are missing from petitioner's files.

<sup>4</sup> Mr. Davis avers that this evidence corroborates his testimony that petitioner sold this particular lot from at least 1962 to 1991.

<sup>5</sup> Mr. Davis testified in his deposition that petitioner did not produce catalogs every year.

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In response to the summary judgment motion,<sup>6</sup> respondent claims: (1) that petitioner's use of PLENTY TOUGH does not constitute trademark use because it is merely descriptive and/or because it does not function as a trademark; (2) that petitioner abandoned use of its mark five years before respondent began to use the term as a trademark in 1985, and petitioner only resumed its use of the mark after it learned of respondent's use of its mark; and (3) that petitioner failed to establish priority.

In support of respondent's opposition to the summary judgment motion, respondent submitted the declaration of respondent's counsel, Kevyan Davoudian, and the declaration of respondent's president, Tom Yoshimura. The Davoudian declaration makes of record a copy of the file history of petitioner's application for the mark PLENTY TOUGH,<sup>7</sup> select pages from the Davis deposition, and a copy of a third-party registration for a mark which incorporates the disclaimed phrase PLENTY TOUGH. The Yoshimura declaration makes of record copies of respondent's trademark registrations for PLENTY TOUGH and PLENTY TOUGH SPORT and Design, an example of one of respondent's catalogs bearing the PLENTY TOUGH

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<sup>6</sup> The Board approves the parties' stipulations, filed October 16, 1998 and December 4, 1998, to extend the time for respondent to file an opposition to the summary judgment motion.

<sup>7</sup> Serial No. 75/125,447, filed June 25, 1996, for "clothing, namely, pants, work pants, jeans, work jeans, trousers, overalls, coveralls, aprons, shirts, work shirts, shop coats, jackets and work jackets," claiming 1945 as the date of first use and first use in commerce.

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SPORT and Design mark, and copies of two invoices showing the dates of respondent's first uses of PLENTY TOUGH in both intrastate and interstate commerce.

Inasmuch as respondent did not plead descriptiveness, failure to function as a trademark or abandonment as affirmative defenses, and has not amended its pleading to assert these defenses, the Board will not address these arguments. See *Blansett Pharmaceutical Co. v. Carmrick Laboratories, Inc.*, 25 USPQ2d 1473, 1475 n.4 (TTAB 1992); *Perma Ceram Enterprises, Inc. v. Preco Industries, Ltd.*, 23 USPQ2d 1134, 1135 (TTAB 1992). Further, because respondent has admitted that the marks are confusingly similar, the goods on which the parties' use their respective marks are related and the channels of trade are similar, priority is the only issue remaining for our adjudication.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A dispute as to a material fact issue is genuine only if a reasonable fact finder viewing the entire record could resolve the dispute in favor of the nonmoving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). In deciding a motion for summary judgment, the Board must view the evidence in the light most favorable to

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the nonmovant, and must draw all reasonable inferences from underlying facts in favor of the nonmovant. *Id.*

A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), and *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely disputed facts which must be resolved at trial. The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional affidavit evidence showing the existence of a genuine issue of material fact for trial. If the nonmoving party does not so respond, summary judgment, if appropriate, shall be entered in the moving party's favor. Fed. R. Civ. P. 56(c).

Respondent's answers to petitioner's discovery requests and the select pages of the Yoshimura deposition that both parties made of record make it clear that respondent first used the mark PLENTY TOUGH on April 10, 1985, first used the

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mark PLENTY TOUGH in commerce on May 5, 1985, and first used the mark PLENTY TOUGH SPORT and Design in 1993.

As noted above, the Davis declaration establishes that petitioner has used PLENTY TOUGH as a trademark on labels and hang tags attached to its clothing, and/or in catalogs or sales invoices pertaining to its clothing, continuously since at least 1945 in the United States. According to Mr. Davis, the representation of the mark has not changed substantially over time.

Respondent's objections to the admissibility of Mr. Davis' testimony regarding petitioner's continuous use of the mark since before 1985 are not well-taken. First, Mr. Davis testified that he worked at petitioner since approximately 1965. Therefore, Mr. Davis is competent to testify to the continuous use of the mark since at least 1965, and the testimony is not hearsay. Second, respondent completely misunderstands the "best evidence" rule which, contrary to respondent's demands, does not require petitioner to produce tags, catalogs or sales documents for every year that it sold products under the PLENTY TOUGH mark. The evidence that petitioner submitted is more than sufficient to show continuous use of the mark since a time before respondent began to use its marks. Third, as respondent admits, it is well-settled that a party may prove priority by the oral testimony of a single witness. See

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*Octocom Systems, Inc. v. Houston Computers Services, Inc.*,  
16 USPQ2d 1783 (Fed. Cir. 1990); *4U Company of America, Inc.*  
*v. Naas Foods, Inc.*, 175 USPQ 251, 253 (TTAB 1972); *C & G*  
*Corporation v. Baron Homes, Inc.*, 183 USPQ 60 (TTAB 1974).

We find that there is no genuine issue of material fact that petitioner is the prior user of a mark that is identical to one of respondent's marks, and substantially identical to the other of respondent's marks, for identical or closely related goods. Petitioner therefore is entitled to judgment as a matter of law on its claims of priority and likelihood of confusion.

In view of the foregoing, the consolidated petition to cancel is granted, and U.S. Registration Nos. 1,710,154 and 2,016,682 will be cancelled in due course.

P. T. Hairston

C. E. Walters

H. R. Wendel

Administrative Trademark  
Judges, Trademark Trial and  
Appeal Board