

1/16/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

**United States Patent and Trademark Office
Trademark Trial and Appeal Board**
2900 Crystal Drive
Arlington, Virginia 22202-3513

BAC

Cancellation No. 26,872

Noah's Ark Family Park, Inc.

v.

Lyle Henry Mortimore

Before Hairston, Chapman and Holtzman, Administrative
Trademark Judges.

By the Board:

Registration No. 1,831,606 issued to Lyle Henry
Mortimore (an individual, citizen of New Zealand) on the
Principal Register for the mark NOAH'S ARK for
"entertainment in the nature of a theme park" in
International Class 41.¹

On October 14, 1997 Noah's Ark Family Park, Inc. filed
a petition to cancel the registration alleging that the mark
NOAH'S ARK has been used continuously in connection with
amusement park services since May 1979 by petitioner or

¹ Registration No. 1,831,606, issued April 19, 1994, under
Section 44 of the Trademark Act based on registrant's ownership
of New Zealand Registration No. 212244, Section 8 affidavit
accepted. (The Board notes that registrant's Section 8 affidavit
of use was a "declaration of non-use in commerce under §8.")

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petitioner's predecessor; that petitioner has priority over respondent; that through extensive use of the mark NOAH'S ARK, it has become well and favorably known to the public as signifying services originating with petitioner; that petitioner's application Serial No. 75/072,459² has been refused registration based on respondent's Registration No. 1,831,606; and that respondent's mark, when used in connection with his services, so resembles petitioner's mark as to be likely to cause confusion, mistake, or deception. Petitioner also included an allegation that "[u]pon information and belief, Respondent is not currently using its (sic - his) registered mark in commerce."

In his answer, respondent admitted that "the mark NOAH'S ARK is identical in appearance to Petitioner's claimed mark"; and he otherwise denied the salient allegations of the petition to cancel.

This case now comes up on petitioner's motion for summary judgment (filed January 7, 1999) on priority, likelihood of confusion and abandonment. In support of its motion for summary judgment, petitioner submitted the affidavit of Thomas J. Gantz, petitioner's vice president and secretary. Mr. Gantz avers, inter alia, that

² Application Serial No. 75/072,459, filed March 14, 1996 for the mark NOAH'S ARK for "amusement park services" in International Class 41. Petitioner recited a claimed date of first use of May 1979. Action on petitioner's application is suspended in Law Office 112.

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petitioner's predecessor-in-interest opened an amusement park in 1979 and the mark NOAH'S ARK was first used in connection with the park that same year; that in 1994 petitioner purchased the park, including all of the seller's trade names, service marks and trademarks; that the mark NOAH'S ARK was originally adopted because the amusement park "is a water park, has rides and other amusements involving water, and the general theme of the park revolves around the Biblical story of Noah's Ark" (paragraph 6); that for each of the last ten years petitioner has spent approximately \$2 million annually on advertising; that petitioner advertises through television, radio, magazines, mass direct mailings, etc.; that the mark NOAH'S ARK has become "extremely well known to the general public and the trade" and it signifies "services originating exclusively with [petitioner]" (paragraph 8); and that petitioner's application was refused registration based on respondent's registration.

Petitioner also submitted the declaration of Joseph F. Nicholson, one of petitioner's lawyers, in which he avers, inter alia, regarding true and correct copies of several documents attached to his declaration, including respondent's answers to petitioner's first sets of interrogatories, document requests and requests for admission.

In his response to petitioner's motion for summary judgment, respondent argued that "while priority is not an issue, likelihood of confusion is" (brief, p. 2); that "[f]or a decision concerning likelihood of confusion to be meaningful, the matter should first proceed to judgment, thereby allowing the parties to fully develop the record in support of arguments therein made" (brief, p. 2); that the services provided by each party are unique and distinct, petitioner's being a water park while respondent offers a theme park; that "[t]he Board's decision, of course, will depend upon the facts that are fully developed and submitted during the testimony period of each party during this proceeding" (brief, p. 3.); and that contrary to petitioner's argument, the extent of actual confusion and the time of concurrent use are relevant in this case. Respondent submitted a photocopy of a power of attorney and designation of domestic representative, as well as a photocopy of the Section 8 affidavit he filed with the USPTO.

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). The burden is on the party moving for summary judgment to show the absence of a genuine issue of material fact, and that it is entitled to

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judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548 (1986). The Board may not resolve issues of material fact against the non-moving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993); and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

The party responding to the summary judgment motion may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by affidavit or otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine issue of material fact for trial. That is, the responding party may not withhold evidence until trial, nor can the responding party demand a trial because of the speculative possibility that a genuine issue of material fact may appear at trial. See Fed. R. Civ. P. 56(e); and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). Further, a dispute is "genuine" only if, on the entire record, a reasonable jury could resolve a factual matter in favor of the non-movant. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1999); and *Sweats Fashions*, supra.

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Based on the record before us, we find that there is no genuine issue of material fact and that petitioner is entitled to judgment as a matter of law.

The evidence regarding (i) petitioner's use (through its predecessor) of the mark NOAH'S ARK, and (ii) the USPTO's refusal to register petitioner's pending application based on respondent's registration establishes that there is no genuine issue of material fact as to petitioner's standing. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Petitioner (through its predecessor) has clearly established its prior and continuous use of the mark NOAH'S ARK since 1979; and in his response to petitioner's request for admission No. 4 respondent admitted that he did not use the mark in the United States prior to August 15, 1991 (his priority filing date under Section 44 of the [Trademark Act](#)). Thus, there is no genuine issue of material fact as to petitioner's priority.

Turning to the issue of likelihood of confusion, it is obvious that the parties' marks are identical, and respondent has so admitted in his responses to petitioner's request for admission Nos. 9-11.

Respondent argues, without any evidence in support thereof, that the parties' respective services are different. This argument does not raise a genuine issue of

material fact. In any event, determining the issue of likelihood of confusion (at trial, or as here, on summary judgment) the Board must look to the services (or goods) as identified in the application(s) or registration(s). See *Octocom Systems, supra*; and *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). In this case the identification of services in petitioner's pending application is "amusement park services" and in respondent's registration the identification of services is "entertainment in the nature of a theme park." Because "amusement park services" encompasses "a theme park," we find that the parties' respective services are overlapping, closely related services.

Inasmuch as the respective services are overlapping and closely related, they would be offered through the same, normal channels of trade to all the same, usual purchasers for such services. See *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994).

Respondent's argument that the extent of actual confusion is relevant in this case is misplaced. Respondent filed a declaration of non-use of his mark under Section 8 of the **Trademark Act**, and the record is clear that he has not established a theme park in the United States. Because respondent has not used his mark in the United States, there

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has been no opportunity for actual confusion to occur. Further, petitioner need not prove actual confusion, rather the test is likelihood of confusion. See *The West End Brewing Co. of Utica, N.Y. v. The South Australian Brewing Co., Ltd.*, 2 USPQ2d 1306 (TTAB 1987).

For the foregoing reasons, we find that there is no genuine issue of material fact as to petitioner's priority and likelihood of confusion, and we find that petitioner is entitled to judgment as a matter of law on those issues. We note that all reasonable inferences have been drawn in respondent's favor.³

Petitioner's motion for summary judgment is granted on priority and likelihood of confusion.⁴

Accordingly, the petition to cancel is granted, and Registration No. 1,831,606 will be cancelled in due course.

³ See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Specifically, we do not find that petitioner has established that its mark is "widely known." However, the "fame" of petitioner's mark, or lack thereof, is not a genuine issue of material fact which would alter the result of this case.

⁴ In view of our entry of summary judgment on petitioner's ground of likelihood of confusion, we need not reach petitioner's motion for summary judgment on the issue of abandonment. In any event, we question whether the petition to cancel includes a legally sufficient abandonment pleading in order for petitioner to obtain summary judgment thereon. See TBMP §528.07, and cases cited therein.