

2/27/02

**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

GOODMAN

Opposition No. 115,862

National Paintball  
Supply, Inc.

v.

Quebec, Inc. d/b/a  
Procaps

Before Simms, Hairston and Rogers, Administrative  
Trademark Judges.

By the Board:

Quebec, Inc. d/b/a/ Procaps ("applicant") seeks to  
register the mark DIABLO for paintballs for leisure  
sports in International Class 28.

Registration has been opposed by National Paintball  
Supply, Inc. of Mantua, New Jersey, ("opposer") on the  
grounds that opposer has prior common law use of the mark  
DIABLO for paintball guns, accessories, and supplies and  
that there is a likelihood of confusion when the parties'  
marks are used contemporaneously.

In its answer, applicant has admitted that the marks  
are similar in sound, appearance, and connotation but

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otherwise denies the salient allegations of the notice of opposition. Applicant has pleaded no affirmative defenses.

This case now comes up on opposer's motion for summary judgment on the grounds of priority and likelihood of confusion, filed August 7, 2000. On September 7, 2000, applicant filed a motion under Fed. R. Civ. P. 56(f) for discovery to respond to opposer's motion for summary judgment. The Board granted applicant's motion on May 22, 2001, allowing applicant to depose opposer's president regarding statements made in opposer's supporting declaration accompanying opposer's motion for summary judgment. Applicant filed its response to the motion for summary judgment on October 12, 2001, and opposer filed its reply in support of the motion for summary judgment on November 5, 2001.

Opposer's evidence in support of the motion for summary judgment includes, among other things, the declaration of Gino Postorivo, president of opposer, and accompanying exhibits (including copies of catalog advertisements, applicant's answers to opposer's interrogatory requests, and applicant's responses to opposer's production requests), website printouts, a second declaration of, Gino Postorivo, and accompanying

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exhibits (including sales invoices from opposer), declaration of Susan Evans, one of opposer's attorneys, and an accompanying exhibit, and portions of applicant's 56(f) deposition testimony of Gino Postorivo.

Applicant's evidence in opposition to the motion for summary judgment includes, among other things, the declaration of its president Richmond Italia, opposer's responses to applicant's requests for admissions, copies of opposer's magazine advertisements, and testimony from applicant's 56(f) deposition of opposer's president, Gino Postorivo.

To the extent that applicant has argued that the Board should not consider additional evidence submitted by opposer with its reply brief, we find this argument without merit. Fed. R. Civ. P. 56(e) specifically provides, that the Board "may permit affidavits to be supplemented or opposed by depositions, answers to interrogatories, or further affidavits." We exercise our discretion under the rule in favor of considering the **additional evidence** offered with opposer's **reply** brief.

In support of its motion, opposer argues that the parties' marks are identical in sound, appearance, connotation and commercial impression, are used on highly related products, and are sold in the same channels of

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trade to the same customers. To establish its priority, opposer relies on a declaration wherein its president states that opposer has been continuously using the DIABLO mark in connection with paintball guns since 1994 and has promoted its products through monthly magazine and catalog advertisements. As supporting exhibits to the declaration, opposer has attached copies of catalog advertisements displaying opposer's DIABLO mark published at various times in the years 1995, 1996, 1997, 1999 (exhibits 3 and 4). Opposer, in anticipation of applicant's response to the motion, also argued that even if it may be viewed as having acquiesced in applicant's use of DIABLO for paintballs, the inevitable confusion that would result from coexistence of the parties' DIABLO marks "overcome[s] this defense."

In its response to the motion for summary judgment, applicant has indicated that the only issues of material fact in dispute are whether opposer is the owner of the mark on which it relies and whether opposer has acquiesced in applicant's adoption and use of its own DIABLO mark. Applicant's "ownership" argument essentially acknowledges prior use of the DIABLO mark for paintball guns but asserts that any prior use of the DIABLO mark should not be attributed to opposer but,

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rather, to either a joint venture involving opposer and National Paintball Supply of South Carolina, or alternatively, to National Paintball Supply of South Carolina alone. Applicant also argues that opposer has not submitted "actual documentary proof" that [opposer] has "sold, used, and advertised a paint [sic] gun bearing the mark DIABLO." In this regard, applicant has pointed to either the copyright legend on the advertisements submitted by opposer in support of its motion for summary judgment (opposer's exhibit 4, document nos. 000100-00013), or to opposer's advertisements which list the address and telephone number of the three different locations involved in the joint venture (applicant's exhibit E, opposer's discovery responses to applicant's document production requests, document nos. 266-269 and 271-279). Applicant further argues that triable issues remain regarding opposer's acquiescence in applicant's use of the DIABLO mark; and that opposer has not submitted any "hard, objective evidence of confusion" that demonstrates that confusion is inevitable between the parties' marks.

In reply, opposer argues that the evidence shows that opposer "uses and has continuously used" the DIABLO mark since 1994, and that confusion between the parties'

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marks is inevitable. As further support for its position, opposer's second declaration of its president, Gino Postorivo, introduces numerous invoices evidencing sales of its DIABLO paintball gun by opposer from 1997 through 2001. Opposer also relies on excerpts from applicant's 56(f) deposition of Mr. Postorivo, in which Mr. Postorivo testified that he created the DIABLO gun, named it, sold it through his company in New Jersey, supplied South Carolina National Paintball Supply with the DIABLO paintball gun, and explains the listing of South Carolina National Paintball Supply on opposer's advertising as the result of joint advertising arrangements. See second declaration of Gino Postorivo and accompanying exhibit 1, opposer's reply in support of its motion for summary judgment; and Postorivo 56(f) deposition at pp. 39-47.

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 party moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), and *Sweats Fashions Inc. v. Pannill Knitting*

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Co., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable finder of fact could resolve the matter in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992), and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993), and *Opryland USA, supra*.

After carefully reviewing the arguments and supporting papers of the parties and viewing all evidence in the light most favorable to applicant, we find that opposer has established that there is no genuine issue of material fact in dispute and that opposer is entitled to judgment as a matter of law.

We turn first to the consideration of whether there is any genuine issue of material fact with regard to the question of likelihood of confusion. Applicant has not conceded that there is no dispute with regard to likelihood of confusion. On the other hand, applicant

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has not provided any arguments or evidence with regard to this question in its response in opposition to opposer's motion for summary judgment.

To determine whether there is a genuine issue with regard to likelihood of confusion, the marks are compared for similarities in appearance, sound, connotation and commercial impression; the goods or services are compared to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely; the trade channels for the goods are compared, and other factors, such as purchaser sophistication, may also be examined. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

With regard to the marks, we find that the parties' DIABLO marks are identical marks with identical pronunciation and connotation. DIABLO is the Spanish word for devil, and although a design is not part of the mark applicant seeks to register, nevertheless, the record reveals that both parties use similar trade dress including symbols of the devil such as devil's ears, tails, or pitchforks in connection with their marks. See first declaration of Gino Postorivo and accompanying exhibits 3-5, opposer's motion for summary judgment;

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applicant's response to opposer's first set of requests for admissions no. 1, opposer's exhibit F, opposer's motion for summary judgment; applicant's answer, paragraph no. 8; and opposer's exhibit G, opposer's motion for summary judgment. The use of similar trade dress enhances the likelihood of confusion. Moreover, because applicant has applied to register DIABLO in typed form, we must presume that it could be presented in any reasonable format, including the exact form of presentation employed by opposer. In sum, the marks are identical in sight, sound and meaning.

Similarly, with regard to the relatedness of the goods, channels of trade, and class of purchasers, we find that the goods are closely related and the channels of trade and class of purchasers are identical. We note that applicant's channels of trade are unrestricted in its application, and it is presumed that applicant's goods move in all channels of trade and reach all classes of purchasers. In this case, opposer is the manufacturer of paintball guns, and applicant manufactures paintballs which can be used in the guns. As evidenced by the magazine advertisements and catalog advertisements submitted by the parties, applicant's responses to opposer's interrogatories and the first declaration of

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opposer's president, Gino Postorivo, both parties market their goods in the same channels of trade to the same classes of purchasers, namely, distributors, and both parties plan to sell their goods to mass retailers such as Wal-Mart or K-mart. See first declaration of opposer's president, Gino Postorivo, opposer's motion for summary judgment; applicant's responses to interrogatories nos. 5, 12, and 20, opposer's exhibit B, opposer's motion for summary judgment; and opposer's exhibit G, opposer's motion for summary judgment. Additionally, the relatedness of the goods is evidenced by opposer's sale of both paintball guns and paintballs in its catalog advertisements and on its website. See declaration of Gino Postorivo and accompanying exhibit D, opposer's motion for summary judgment; declaration of Susan Evans and accompanying exhibit 1, opposer's reply in support of its motion for summary judgment.

For the foregoing reasons, we find that applicant has not identified, with any evidentiary support, a genuine issue of material fact as to any of the probative du Pont factors and that opposer is entitled to judgment as a matter of law on that issue. Accordingly, we find that there is no genuine issue of material fact with regard to likelihood of confusion because the parties' DIABLO marks

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are identical, the goods are related, and the presumptive channels of trade and classes of purchasers are the same.

We now turn to the issue of priority. Applicant has attempted to raise a genuine issue by arguing that opposer's evidence fails to establish that opposer is the prior user of the DIABLO mark for paintball guns. We find, however, that applicant has not countered opposer's proof and established a genuine issue of material fact regarding opposer's priority, and therefore, to the extent that applicant has attempted to show that prior use of DIABLO for paintball guns is not a prior use by opposer, it has failed. We find Mr. Postorivo's testimony on the issue persuasive. See Postorivo 56(f) deposition at pp. 39-47. It is not characterized by contradiction or inconsistency and applicant has not shown why the testimony should be disregarded or discounted. Additionally, the documentary evidence establishes that since 1994 opposer has used the DIABLO mark in connection with paintball guns and that opposer continues to use the DIABLO mark in connection with paintball guns. See second declaration of Gino Postorivo and exhibit 1 thereto, and opposer's discovery responses to applicant's document production requests, document nos. 266-269 and 271-279 (magazine advertisements),

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(applicant's Exhibit E). Based on the evidence submitted, we find that opposer has met its burden of proof with regard to priority and that there is no genuine issue of material fact as to opposer's prior use of the DIABLO mark.

We now turn to the parties' arguments regarding acquiescence and whether confusion is inevitable, questions which are fully briefed by the parties. We note that no affirmative defenses have been pleaded by applicant in its answer, and that applicant has filed no motion to amend its answer concurrently with its response in opposition to opposer's motion for summary judgment.

A motion for summary judgment must be determined only on the issues joined by the pleadings. See Fed. R. Civ. P. 56(a) and 56(b). A party may not defend against a motion for summary judgment by asserting the existence of genuine issues of material fact as to an unpleaded claim or defense. See *Blansett Pharmaceutical Co. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473, 1475 n. 4 (TTAB 1992), and TBMP Section 528.07.

Inasmuch as applicant's answer does not plead acquiescence, the affirmative defense of acquiescence cannot raise a genuine issue. Moreover, even if there was a motion to amend the answer to assert the defense of

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acquiescence, such a motion would be denied, because the amendment would be futile. *See Foman v. Davis*, 371 U.S. 178, 182 (1962); and *Sunnen Products Company v. Sunex International, Inc.* 1 USPQ2d 1744, 1745-1746 (TTAB 1987).

Acquiescence in registration of a mark is an equitable defense which requires the proof of three elements: (1) that opposer actively represented that it would not assert a right or a claim; (2) that the delay between the active representation and assertion of the right or claim was not excusable; and (3) that the delay caused applicant undue prejudice. *Coach House Restaurant Inc. v. Coach and Six Restaurants, Inc.*, 934 F.2d 1551, 1564, 19 USPQ2d 1401, 1409 (11th Cir. 1991). In the context of a trademark opposition or cancellation proceeding, this defense must be tied to a party's registration of a mark rather than to its use of the mark. *Id.* *See also, National Cable Television Assoc., Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1580, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991).

Applicant has argued that opposer's purchase and resale of applicant's DIABLO paintballs constitutes acquiescence by opposer to applicant's use of the mark DIABLO. Applicant's brief in opposition to opposer's motion for summary judgment at 9. However, amendment to

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add the ground of acquiescence on this basis is futile because the facts as described by applicant do not constitute acquiescence to registration in the context of an opposition proceeding which must be based upon opposer's knowledge and failure to object to applicant's registration of the DIABLO mark. *See National Cable, supra; Lincoln Logs Ltd. v. Lincoln Pre-cut Log Homes, Inc.*, 971 F.2d 732, 734, 23 USPQ2d 1701, 1703 (Fed. Cir. 1992). Thus, the absence here of one of the three required elements of acquiescence to registration as set forth above (i.e., no facts described by applicant which establish opposer's acquiescence to applicant's registration of the DIABLO mark), would be sufficient to deny the equitable relief requested under that defense. *Coach House Restaurant Inc. v. Coach and Six Restaurants, Inc.*, 934 F.2d at 1559, 19 USPQ2d at 1405.

Finally, even if the defense of acquiescence could properly be raised in this case, it would not preclude a judgment for opposer if confusion is not merely likely but inevitable. *See Coach House, supra*. As stated above, likelihood of confusion is not in doubt, given the use of identical marks by the parties, the relatedness of the goods and the identical channels of trade. It is well established that equitable defenses such as

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acquiescence will not be considered and applied where, as here, the marks of the parties are identical and the goods are substantially similar since confusion in such cases is inevitable. See *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1131 (TTAB 1990); *CBS v. Man's Day Publishing Company, Inc.*, 205 USPQ 470, 475 (TTAB 1980) and cases cited therein. Therefore, confusion between identical marks used for substantially similar goods, as in this case, is inevitable. See, e.g., *Turner v. Hops Grill & Bar Inc.*, 52 U.S.P.Q.2d 1310 (TTAB 1999).

Accordingly, we find that opposer has carried its burden of proof that no genuine issues of material fact remain as to **opposer's priority or the statutory ground of likelihood of confusion** and that opposer is entitled to judgment as a matter of law. In view thereof, opposer's motion for **summary judgment is granted and judgment is entered against applicant**. The opposition is accordingly sustained, and registration to applicant is refused.