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

Opposition No. 120,682

**Monster Cable Products and
Monster Cable International,
Ltd.**

v.

**Schmoller, Henry dba Hula
Monster Music**

**Before Simms, Chapman and Drost, Administrative Trademark
Judges.**

By the Board:

Applicant has filed to register the mark HULA MONSTERS for "compact discs and cassette tapes with recorded music" in Class 9.¹ As grounds for the opposition, opposers allege that applicant's mark, when used on the identified goods, so resembles opposers' previously used and registered MONSTER and MONSTER formative marks, said marks comprising a family of MONSTER marks, as to be likely to cause confusion, mistake or deception; and that applicant's use of his mark will tend to

¹ Application Serial No. 75/847,237 was filed on November 12, 1999, claiming use in commerce since April 1985. Applicant has disclaimed the exclusive right to use HULA apart from the mark as shown.

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dilute opposers' MONSTER and family of MONSTER marks, which "... are entitled to famous mark protection."²

In answering paragraph nos. 3-27 of the notice of opposition, wherein opposers plead their registered marks,³ applicant states, "I except (sic - accept) the information given and therefore agree. However, these trademarks do not affect my mark. My mark is unique onto (sic - unto) itself." Applicant has otherwise denied the salient allegations of the notice of opposition.

Discovery closed on August 18, 2001. This case now comes up on opposers' motion for summary judgment, filed October 4, 2001. Applicant has filed a response and opposers have

² Two of opposers' pleaded marks are particularly noteworthy. They are Registration Nos. 1,537,306 and 1,665,277, both for the mark MONSTER MUSIC, MUSIC disclaimed; and the goods and services are "compact discs"; and "production of compact discs, audio tapes and phonographic records" and "distribution services in the field of prerecorded compact discs, audio tapes and phonographic records of various artists," respectively.

Opposers' other pleaded registered marks include: MONSTER STYLE, MONSTER CABLE, MONSTER CABLE SPECIAL, MONSTER HOME THEATRE, MONSTER DESIGN, MONSTER POWER, MONSTER SOUND, MONSTER VIDEO, MONSTER TIPS, MONSTER CONNECTION, I AM A MONSTER, MONSTER CENTRAL, MONSTER COMPUTER, MONSTER MICROPHONE, MONSTER MULTIMEDIA, MONSTER NETWORKING, and MONSTER INTERNET. Opposers' registrations are for a variety of goods and services summarized as follows: speaker wire in Class 6; a wide range of electronics hardware products and compact discs in Class 9; newsletters, magazines, catalogs, and newspapers providing entertainment industry and cable industry news, and newsletters about consumer electronics in Class 16; t-shirts and jackets in Class 25; and conducting classes and seminars in the field of audio systems in Class 41.

³ In each of paragraph nos. 3-27, opposers state the registration number, date of registration, mark, and goods, including international classification, for each of their numerous pleaded registrations.

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replied thereto objecting to the admissibility of applicant's "expert opinion."⁴

In support of their motion for summary judgment, opposers argue that applicant failed to respond to their requests for admissions and, thus, the admissions are deemed admitted under Fed. R. Civ. P. 36. Opposers contend that, by virtue of applicant's judicial admissions, there are no genuine issues of material fact and they are entitled to judgment as a matter of law. In particular, opposers argue that applicant has admitted (1) that opposers have priority in their MONSTER marks; (2) that opposers' marks, both registered and at common law, are valid and enforceable; (3) that applicant's use of his HULA MONSTERS mark on his goods would be likely to cause confusion with opposers' registered MONSTER marks for similar goods as well as with opposers' common law mark MONSTER for various goods; and (4) that applicant's use of his HULA MONSTERS mark would likely cause confusion with opposers' family of marks.

In response, applicant argues that opposers have not produced any evidence of their claims; that he has answered all "charges" against him, "one by one on the record"; and,

⁴ Applicant's notice of typographical error (regarding a date) in his response to opposers' motion for summary judgment is noted. It does not appear that applicant served a copy of the notice on opposers. See Trademark Rule 2.119. As a courtesy, in the circumstances, the Board includes a copy herewith for opposers.

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"regarding the admissions sent to me by plaintiff, I have already admitted in my answer, (Items 3-27) that the word MONSTER appears in the plaintiffs' trademark documents." Applicant contends that the parties have different customers, fans, stores, products, intent and motivation. He argues that the commercial impressions of the marks differ with opposers using the term MONSTER as an adjective meaning something large or bigger than life, and, in his own use of HULA MONSTER, the term HULA is the adjective.

In reply, opposers object to the admissibility of the "expert opinion" submitted by applicant. In particular, they argue that applicant submitted only a letter, not a declaration or affidavit, from Barry Squires.⁵ (Applicant also submitted his own statement entitled "affidavit and declaration by an expert witness in support of Defendant" which accompanied the Squires' letter. However, this was also simply in letter form and was not in affidavit or declaration form.)

Opposers' objection to the admissibility of the Squires' letter is well taken. Affidavits may be submitted in support of, or in opposition to, a motion for summary judgment provided that they (1) are made on personal knowledge; (2) set forth such facts as would be admissible in evidence; and (3)

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show affirmatively that the affiant is competent to testify to the matters stated therein. See Fed. R. Civ. P. 56(e). In lieu of an affidavit, a party may submit a declaration meeting the requirements of Trademark Rule 2.20. See TBMP Section 528.05(b). Mr. Squires' letter is not accompanied by an affidavit or declaration from him in conformance with Fed. R. Civ. P. 56(e). Applicant's own letter stating that Mr. Squires is an expert cannot be substituted for the requirement that Mr. Squires' letter, or contents therein, be introduced by Mr. Squires' own declaration or affidavit. Even if we were to consider the Squires' letter, however, it would not change the outcome of our decision.

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56. A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question 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). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party.

⁵ In his October 17, 2001 letter, Barry Squires identifies himself as

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See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ 1542 (Fed. Cir. 1992).

Opposers primarily base their assertion that there remain no genuine issues of material fact as to likelihood of confusion on applicant's failure to respond to opposers' first requests for admissions, which are thereby deemed admitted. Opposers' position is well taken. Specifically, opposers served their first request for admissions on applicant on November 29, 2000. To date, according to opposers, applicant has not responded to these requests and has not requested an enlargement of time in which to respond. Applicant appears to contend that the requests for admission were redundant with applicant's answer to the notice of opposition, and that he admits the statements propounded in the requests for admissions, by providing the following explanations: (1) opposers were "... asking for answers that I already provided in my answer to opposition";⁶ (2) "[r]egarding the admissions sent to me by the plaintiff, I have already admitted in my answer (Items 3 through 27) that the word MONSTER appears in the plaintiffs' trademark documents";⁷ (3) "I have made the admissions and can agree that Plaintiff does have trademarks

"Columbia A&R Manager - A Division of Sony Music."

⁶ See page 2 of applicant's brief in opposition to opposers' motion for summary judgment.

⁷ *Id.* at page 3.

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that contain the word monster";⁸ and (4) "[p]laintiff has my admissions and discovery and 'answer to Opposition'."⁹

Because applicant never responded to opposers' requests for admissions, the requests are deemed admitted. See Fed. R. Civ. P. 6(b) and 36(a). See also *Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc.*, 14 USPQ2d 2064 (TTAB 1990)(if a party upon whom requests for admission have been served fails to timely respond thereto, the requests will stand admitted unless the party is able to show that its failure to timely respond was the result of excusable neglect; or unless a motion to withdraw or amend the admissions is filed pursuant to Fed. R. Civ. P. 36(b), and granted by the Board).

In determining the issue of likelihood of confusion and, in this case, whether there is any genuine issue of material fact relating to the ultimate legal question, we must consider the pertinent evidentiary factors listed in *In re E.I. du Pont de Nemours & Co.*, 476 F. 2d 1357, 177 USPQ 563 (CCPA 1973). As explained earlier herein, applicant, by his own admission, has conceded the most significant factors of the likelihood of confusion analysis, i.e., that: (1) all of opposers' pleaded marks are valid and enforceable and have priority over the involved mark; and (2) that confusion is likely.

⁸ See page 2 of applicant's memorandum of points and authorities in opposition to opposers' motion for summary judgment.

⁹ *Id.* at Point #3 and Point #6.

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We are mindful of applicant's assertion that, notwithstanding his admissions, he believes there still exist genuine issues of material fact as to the relatedness of the parties' respective goods and markets. That assertion, however, is inconsistent with the controlling authority regarding the relatedness of the parties' goods and trade channels, in the likelihood of confusion analysis in Board proceedings. It is well established that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to whom sales of the goods are directed. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Here, applicant's goods are identified as "compact discs and cassette tapes with recorded music." At least one of opposers' registrations, Registration No. 1,537,306 for the mark MONSTER MUSIC, is for "compact discs." In addition, opposers' Registration No. 1,665,227 covers the related services of "production of compact discs, audio tapes and phonographic records" and "distribution services in the field

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of prerecorded compact discs, audio tapes and phonographic records of various artists." Opposers' registrations do not reflect any limitations as to subject matter or channels of trade. Accordingly, the Board must presume that the goods identified by applicant in his application and the goods and services in opposers' two above-identified pleaded registrations encompass all goods and services of the type described, move in all normal channels of trade and under all normal methods of distribution, and are available to all classes of purchasers. See also *In re Diet Center, Inc.*, 4 USPQ2d 1975 (TTAB 1987); and *In re Americor Health Services*, 1 USPQ2d 1670 (TTAB 1986).

As to applicant's argument that the Trademark Examining Attorney conducted a search of his mark and found no conflict, it is well settled that the decisions of Examining Attorneys allowing registration "are not binding upon the agency [PTO] or the Board." See *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 641 (TTAB 1984).

With regard to the marks, applicant's HULA MONSTERS and opposers' MONSTER MUSIC, as discussed in more detail above, applicant admitted likelihood of confusion, which encompasses an admission that the marks are similar. In addition, we note that the marks are similar in sound, appearance and connotation inasmuch as they share the common, non-descriptive

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term MONSTER. To the extent that there may have been genuine issues of material fact in the likelihood of confusion analysis, particularly in the area of the similarity of the marks, we reiterate that applicant, by admitting likelihood of confusion, has eliminated these issues.

In sum, we find on this record that no genuine issues of material fact remain as to likelihood of confusion and that opposers are entitled to judgment as a matter of law. In view thereof, opposers' motion for summary judgment is granted; the opposition is sustained and registration to applicant is refused.¹⁰

¹⁰ In light of our decision granting opposers' motion for summary judgment on the issue of likelihood of confusion, there is no need to consider opposers' dilution claim.