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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Wellington

Mailed: May 15, 2003

Opposition No. 151,757

Columbia Insurance Company
and H. H. Brown Shoe
Company, Inc.

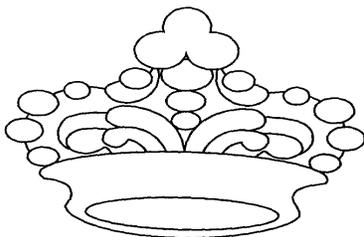
v.

Hyatt, Lenworth Alexander

Before Seeherman, Hanak and Hairston, Administrative Trademark
Judges.

By the Board:

Applicant Lenworth A. Hyatt filed an application to
register the following mark:



for "clothing for men, women, children and infants, namely;
footwear, pants, headwear, underwear, swimwear, lingerie,
shirts, jackets, socks, dresses, blouses, stockings, sweaters,
blazers, pajamas, robes, trench coats, sports jerseys, gloves,

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overall (sic), skirts, jump-suits, leotards, tank-tops, neck-ties, bow-ties, shorts, suits, scarves, handkerchiefs, vest, shawls, blazers" in International Class 25.¹

On February 13, 2001, opposers, Columbia Insurance Company and H. H. Brown Shoe Company, Inc., filed a notice of opposition opposing registration of applicant's mark. As grounds for the opposition, opposers allege that applicant's mark, when used on the identified goods, so resembles opposers' previously used and registered mark, as to be likely to cause confusion, mistake or deception. Opposers' pleaded registration is for the following mark:



for "footwear" in International Class 25.²

¹ Application Serial No. 76/242,606, filed on April 17, 2001, and based on a bona fide intention to use the mark in commerce pursuant to Trademark Act Section 1(b).

² Registration No. 1,981,495, registered on June 18, 1996, and claiming use in commerce since March 5, 1994. Original registrant and opposer, H. H. Brown Shoe Company, Inc., assigned the registration to opposer Columbia Insurance Company on June 27, 1998 (assignment recorded with the Trademark Office on April 27, 1999 at Reel/Frame 1922/0063).

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On August 29, 2002, applicant filed an answer denying all of opposers' allegations in the notice of opposition.

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This case now comes up on the following motions:

(1) opposers' motion (filed December 23, 2002) for summary judgment, and (2) applicant's motion (filed January 7, 2003) for involuntary dismissal under Trademark Rule 2.132.

We turn first to the latter motion. When applicant filed his motion for involuntary dismissal, the testimony period for opposers had not yet opened.³ Because the motion was filed before opposers' testimony period, it is hereby denied as untimely. Trademark Rule 2.132; see also TBMP § 535 and authorities cited therein.

We now turn to opposer's motion for summary judgment on the issue of priority and likelihood of confusion. The motion is accompanied by the declaration of Mark J. Speciner, counsel for opposers, and accompanying exhibits.

Opposers also assert that on July 22, 2002, they served interrogatories, requests for production of documents and requests for admissions on applicant; and that applicant has not responded to these discovery requests and, therefore, the requests for admissions are to be deemed admitted by applicant, including an admission that applicant's proposed mark is confusingly similar to opposers' relied on mark.

³ Pursuant to the Board's June 4, 2002 order, opposers' testimony period was scheduled to open on February 20, 2003 and close on March 21, 2003.

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In response to opposers' motion, applicant filed one paper which contains his motion for involuntary dismissal (denied by the Board herein) and interspersed arguments regarding why he believes opposers' motion for summary judgment should be denied. Specifically, applicant argues, *inter alia*, that opposers' current counsel of record "could not legally serve interrogatories, request[s] for production of documents and request[s] for admission" because said counsel did not file a notice of appearance prior to service of the discovery requests; that opposers have "failed to prove by United States Postal Confirmation" that said discovery requests were served on applicant; that opposers have admitted in their brief in support of the motion for summary judgment that "there is no confusion between the parties' products, and therefore no infringement" [applicant quoting from opposers' brief]; and that a genuine issue of material fact exists "regarding the un-pleaded claim of the service of [opposers' discovery requests]."

Attached as exhibits to applicant's response are copies of the following: the notice of opposition, applicant's request to produce documents and things (certificate of service dated December 12, 2002), a certified mail receipt, opposers' motion for summary judgment, former counsel for opposers' withdrawal of representation (certificate of mailing

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dated September 20, 2002) and counsel for opposers' notice of appearance (dated August 14, 2002).

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. Fed. R. Civ. P. 56(c). See also, *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). 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 nonmoving party may not rest on mere denials or conclusory assertions, but rather must offer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. See Fed. R. Civ. P. 56(e), and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). In a motion for summary judgment, the evidentiary record and all reasonable inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the nonmoving party. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

We have carefully considered the parties' arguments and evidentiary submissions. For the reasons discussed below, we find that no genuine issues of material fact exist as to the

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factors bearing on priority and likelihood of confusion, and that opposer is entitled to judgment as a matter of law on its Section 2(d) claim.

Preliminarily, we turn to opposers' request to deem its requests for admission as admitted based on applicant's failure to respond to said requests. In particular, opposers rely on its first request for admission, wherein opposers request that applicant "admit that applicant's mark is confusingly similar to opposers' mark."

Fed. R. Civ. P. 36 provides that if a party upon which requests for admission have been served fails to file a timely response thereto, the requests will stand admitted (automatically), and may be relied upon by the propounding party pursuant to 37 CFR § 2.120(j)(3)(i), unless the party upon which the requests were served 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 FRCP 36(b), and granted by the Board. See also TBMP § 527.04.

Based on the record before us, we find that applicant failed to respond to opposers' first set of requests for admission (served on July 22, 2002). We also find that applicant has not shown that his failure to respond was the result of excusable neglect. Indeed, applicant's argument

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that counsel for opposers could not legally serve discovery requests, including the requests for admission, prior to filing a notice of appearance is without legal basis and lacks logic. A notice of appearance is a device for a party's counsel to inform the Board, and opposing counsel, of the proper address of record for the party. See, generally, TBMP Sections 114, 116-117 regarding representation. However, a formal notice of appearance is not required in order for the Board to accept a paper filed by an attorney. See TBMP Section 114.03. Furthermore, applicant does not explain why, if there was any concern about the discovery requests, he did not simply contact either the Board or opposing counsel.

Applicant's second argument, that opposers must prove "by United States Postal Confirmation" that the discovery requests were actually served on applicant, is not well taken. Opposers' discovery requests contained a certificate of service stating that said discovery requests were placed in the U.S. Mail and addressed to applicant on July 22, 2002. The Board accepts opposers' certificate of service as *prima facie* proof of service. Trademark Rule 2.119(a). Applicant has not submitted any evidence to the contrary. The Board notes applicant does not contest that he received the discovery requests.

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In view of the above, the requests for admissions served on applicant stand admitted, including applicant's admission that his mark is confusingly similar to opposers' mark.

We find that no genuine issues of material fact exist as to the factors bearing on priority and likelihood of confusion, and that opposer is entitled to judgment as a matter of law on its Section 2(d) claim.⁴

First, as to priority, there is no genuine issue that opposer Colombia Insurance Company owns the pleaded Registration No. 1,981,495, claiming dates of first use in commerce since 1994. Opposers have submitted a TESS database status copy of the registration, by way of the declaration of Mr. Speciner, who has attested to the status and title copy of this registration. Thus, priority is not in issue. *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Turning to the issue of likelihood of confusion, we find no genuine issue as to the similarity of the parties' respective marks in this case. The parties' respective marks are highly similar designs of crowns. While opposers' design mark contains the letter "H" and cross design and applicant's mark does not, these features do not distinguish the parties'

⁴ We would reach this conclusion even if we did not treat the requests for admission as admitted.

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respective marks in a significant manner nor do they overcome the otherwise substantial similarity of the marks.⁵

Furthermore, there is no genuine issue that the goods of the parties are in part identical, opposers' registration being for footwear and footwear being one of the items listed in applicant's identification. Such goods as the stockings and socks listed in applicant's application are closely related to opposers' footwear. If the goods of the respective parties are closely related or identical, as is the case here, the degree of similarity between the marks required to support a finding of likelihood of confusion is not as great as would apply with diverse goods. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *HRL Associates v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, 14 USPQ2d 1840 (Fed. Cir. 1990); and *ECI Division of E. Systems, Inc. v. Environmental Communications, Inc.*, 207 USPQ 443 (TTAB 1980).

In response, applicant has not submitted any evidence at all to demonstrate that there is a genuine issue of fact. As stated previously, 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

⁵ And, as noted, applicant has been deemed to have admitted that the marks are confusingly similar.

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is entitled to judgment, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must offer countering evidence. Applicant has failed to do this.

Finally, we are not persuaded by applicant's argument that opposers' typographical errors in their moving brief constitute an admission that there is no likelihood of confusion. In the introductory paragraph of their moving brief, opposers state that "there is not confusion between the parties' products, and therefore, no infringement." However, a full reading of opposers' brief removes any possible confusion as to opposers' intentions. In the conclusion of the brief, opposers' state that they have "clearly demonstrated that *there is* a likelihood of confusion." (emphasis provided). Also, in their reply brief, opposers clarified that they made a typographical mistake and, as plaintiffs herein, it would make no sense to seek summary judgment against themselves.

Accordingly, opposers' motion for summary judgment is granted, the opposition is sustained, and registration of applicant's mark is refused.

* * *

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