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Paper No. 12
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Sharp Kabushiki Kaisha a/t/a Sharp Corporation
v.
Micro Sharp, Inc.

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Opposition No. 91125257
to application Serial No. 76010222
filed on March 27, 2000

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Robert W. Adams of Nixon & Vanderhye, P.C. for Sharp Kabushiki Kaisha a/t/a Sharp Corporation.

Kevin S. Costanza of Seed Intellectual Property Law Group PLLC for Micro Sharp, Inc.

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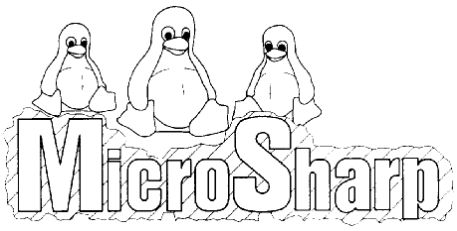
Before Quinn, Bucher and Bottorff, Administrative Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

This opposition proceeding involves applicant's application to register the mark depicted below



on the Principal Register for services recited in the application (as amended) as "distributorship, retail store, and online retail services for computer hardware and software products, computer systems, and audio-video equipment" in Class 35.[1] The application is based on applicant's asserted bona fide intent to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).

Opposer has opposed registration on the ground that applicant's mark, as used in connection with the recited services, so resembles opposer's previously-used and registered mark SHARP as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).[2]

Applicant filed an answer in which it denied the salient allegations of the notice of opposition. At trial,

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[1] The application includes the following lining statement: "The drawing is lined for shading only. Color is not claimed as part of the mark."

[2] Opposer also mentions "dilution" in its notice of opposition, but we find that opposer has not sufficiently pleaded dilution as a separate ground of opposition. Although opposer has alleged that its mark is famous, opposer has failed to allege specifically that its mark became famous prior to the filing date of applicant's application, which is applicant's constructive first use date. Absent such an allegation, the pleading fails to state a claim for dilution. *See Enterprise Rent-A-Car Company v. Advantage Rent-A-Car, Inc.*, 330 F.3d 1333, 66 USPQ2d 1811 (Fed. Cir. 2003); *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718 (TTAB 2003); *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164 (TTAB 2001). Accordingly, we have given no consideration to the references to "dilution" in opposer's notice of opposition.

opposer submitted evidence,[3] but applicant did not. Opposer and applicant filed trial briefs, and opposer filed a reply brief. No oral hearing was requested.

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[3] We note, however, that opposer has failed to make its pleaded registrations of record. On the last day of opposer's testimony period (February 24, 2003), opposer filed a notice of reliance in which it identified seventeen registrations (including three registrations which had not been pleaded in the notice of opposition), and asserted that "[a]n order for certified copies of the above-identified registrations identified in items 1 through 17 was placed with the United States Patent and Trademark Office on February 24, 2003. The certified copes [sic] will be submitted as soon as they are received." On March 4, 2003, after the close of opposer's testimony period, opposer filed a "supplemental notice of reliance" to which status and title copies of the registrations were attached. These status and title copies are untimely, because they were submitted after the close of opposer's testimony period. "A party's submission, with a notice of reliance on its registration, of an *order* for status and title copies of the registration is not sufficient to make the registration of record. Although that procedure was once permitted, it is no longer allowed. The status and title copies themselves must accompany the notice of reliance." TBMP §704.03(b)(1)(A)(2d ed. June 2003). *See* Trademark Rule 2.122(d)(2), 37 C.F.R. §2.122(d)(2); *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072, 1075 (TTAB 1990); *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530, 531 n.3 (TTAB 1986). Indeed, the rule which allowed registrations to be made of record by timely submission of an order for status and title copies has not been in effect for over twenty years. *See* Trademark Rule 2.122(d), 37 C.F.R. §2.122(d); Notice of Final Rulemaking published in the *Federal Register* on May 23, 1983 at 48 FR 23122, and in the Patent and Trademark Office *Official Gazette* of June 21, 1983 at 1031 TMOG 13; and *In re Inter-State Oil Co.*, 219 USPQ 1229, 1230 n.1 (TTAB 1983).

Thus, the only evidence properly of record in this case is opposer's first set of Requests for Admissions, which were submitted with the timely-filed first notice of reliance. (The remainder of the items submitted with the notice of reliance, i.e., copies of the notice of opposition, the Board's institution order, opposer's interrogatories and document production requests (to which applicant did not respond), and a Board decision in another case to which applicant was not a party, have no evidentiary value in this case.) Because applicant failed to answer or object to the Requests for Admissions, the requested admissions are deemed admitted (*see* Fed. R. Civ. P. 36(a)), and are conclusively established for purposes of this proceeding only (*see* Fed. R. Civ. P. 36(b)). *See also* Trademark Rule 2.116(a), 37 C.F.R. §2.116(a). Applicant's argument to the contrary is

Trademark Rule 2.135, 37 C.F.R. §2.135, provides as follows:

> **§2.135 Abandonment of application or mark.**
>
> After the commencement of an opposition, concurrent use, or interference proceeding, if the applicant files a written abandonment of the application or of the mark without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant. The written consent of an adverse party may be signed by the adverse party or by the adverse party's attorney or other authorized representative.
> [48 FR 23141, May 23, 1983, as amended at 54 FR 34900, Aug. 22, 1989]

In applicant's trial brief and in the accompanying declaration of its counsel, applicant expressly states that it has abandoned the mark it seeks to register. Specifically, applicant asserts as follows:

> On September 12, 2002, Applicant offered to drop the present application and not to seek registration because Applicant was no longer

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without merit. We note, however, that opposer's Requests for Admissions (from the second page on) appear to pertain not to this opposition proceeding but to Opposition No. 113,274, an unrelated case involving opposer and a third party and involving goods that appear to be different than those pleaded in the notice of opposition in this case. Moreover, these admissions establish status, but not title, of opposer's pleaded registrations, and the registrations therefore are not of record by virtue of the admissions.

Opposer's counsel would be well-advised to take more care in the submission of evidence in proceedings before the Board. It is only because of the special circumstances of this case (i.e., applicant's abandonment of its mark; see discussion *infra*) that opposer's counsel fortuitously is able to escape the consequences of his sloppy and deficient practice. A different result is likely to obtain in a case in which these special circumstances are not present.

> using and was not interested in using or registering the mark MICROSHARP & PENGUIN DESIGN. (Costanza Declaration, ¶2.)
>
> On May 21, 2003, as part of a pleading in that related case, Applicant advised the Board that it was not using and no longer claimed any rights in the MICROSHARP & PENGUIN DESIGN mark. (Costanza Declaration, ¶6.)
>
> Opposer failed to advise the Board in its trial brief that Applicant had affirmatively abandoned its rights in the MICROSHARP & PENGUIN DESIGN mark. Opposer does not even argue abandonment, an undisputed issue of fact that resolves the entire controversy between the parties. (Brief, at 2.)
>
> Accordingly, applicant has no objection to the Board sustaining Opposer's opposition solely on the basis of abandonment. Applicant, however, submits that the Board should not reach the merits of issues that are rendered moot by Applicant's abandonment. (*Id.*)
>
> Here, Micro Sharp no longer has a personal interest or stake in the outcome [of this proceeding], as Micro Sharp has affirmatively abandoned any rights in the MICROSHARP & PENGUIN DESIGN mark. (*Id.*)
>
> Applicant previously requested that the Board consolidate the related cases, but did not request consolidation of the present case because Applicant had abandoned its interest in the MICROSHARP & PENGUIN DESIGN mark. (Brief, at 3.)

These written statements in applicant's brief and in counsel's accompanying declaration, by which applicant expressly asserts and admits that it has abandoned the mark depicted in its application, constitute "a written abandonment of the application or of the mark," for purposes

of Trademark Rule 2.135.[4] Applicant's abandonment occurred after commencement of this opposition proceeding.[5] Opposer's written consent to such abandonment is not of record, and it is apparent from opposer's reply brief that opposer does not consent to such abandonment.

In view thereof, and in accordance with Trademark Rule 2.135, we enter judgment against applicant on opposer's pleaded Section 2(d) ground of opposition.[6]

Decision: The opposition is sustained.

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[4] Usually, Trademark Rule 2.135 is triggered by the applicant's filing of an express abandonment of the application without the opposer's written consent. *See* Trademark Rule 2.68, 37 C.F.R. §2.68. Applicant has not filed an express abandonment of the application in this case. However, the wording of Trademark Rule 2.135 is disjunctive – it clearly provides that a written abandonment "of the application or of the mark" without opposer's written consent is sufficient to trigger application of the rule.

[5] The opposition proceeding commenced on August 7, 2001 with the filing of the notice of opposition. *See* Trademark Rule 2.101(a).

[6] Applicant's argument that its abandonment of the mark renders opposer's Section 2(d) likelihood of confusion ground of opposition moot is not well-taken. Indeed, the purpose of Trademark Rule 2.135 is to preclude an applicant from attempting to moot the opposer's pleaded claim (and thereby avoid entry of judgment thereon) by unilaterally abandoning the application after commencement of the opposition proceeding. Opposer is entitled to a decision on the merits of its pleaded claim. *See generally* TBMP §602.01 (2d ed. June 2003). Likewise without merit is applicant's argument that its abandonment of its mark eliminates any "case or controversy" between the parties and thus deprives the Board of subject matter jurisdiction. The Board has subject matter jurisdiction in this opposition proceeding by virtue of Trademark Act Section 13, 15 U.S.C. §1063.