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THE TTAB

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PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Giocar America, Inc. d/b/a Galfer, Galfer USA and Galfer
Braking Systems
v.
Braking Italia, s.r.l.

Opposition No. 91159338
to application Serial No. 78164297
filed on September 16, 2002

Thomas J. Daly of Christie, Parker & Hale, LLP for Giocar
America, Inc.

Michael J. Hughes of Intellectual Property Law Offices for
Braking Italia, s.r.l.

Before Hairston, Bucher and Grendel, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Braking Italia, s.r.l. (an Italian corporation) has
filed an application to register the mark WAVE for "brake
discs for land vehicles."¹

Giocar America, Inc. d/b/a Galfer, Galfer USA and
Galfer Braking Systems has opposed registration of

¹ Serial No. 78164297, filed September 16, 2002, which alleges a
date of first use anywhere and in commerce of October 31, 2000.

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applicant's mark on the ground that for many years it has been engaged in the manufacture and sale of brake products for vehicles; that prior to applicant's priority date opposer has continuously used the mark WAVE in commerce in the manufacture and sell of brake products for vehicles; and that applicant's mark, as applied to the goods identified in applicant's application, so resembles opposer's WAVE mark, as to be likely to cause confusion.

Applicant, in its answer, "admits that the goods are identical and asserts that the circumstances go beyond this, as the goods upon which Opposer claims usage are indeed Applicant's goods" and "admits that the marks are identical and asserts that the circumstances go beyond this, as the mark which Opposer claims to have used is indeed Applicant's mark on Applicant's goods." (Answer, paragraph nos. 5 and 6). Applicant otherwise denies the salient allegations of the notice of opposition. In addition, applicant asserts as "affirmative defenses" that it created, developed and used the WAVE mark in connection with its brake products in Italy long before any use of the mark by opposer; that opposer was aware of applicant's use; that opposer obtained the brake products it sold in the U.S. from applicant and effectively acted as applicant's U.S. sales operation; and that all use of the WAVE mark by opposer inured to the benefit of applicant.

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The record includes the pleadings; the file of the involved application; and the testimony (with exhibits) of opposer's General Manager, Allesandro Milesi. Applicant did not take testimony or submit any other evidence.

Only opposer filed a brief. An oral hearing was not requested.

At the outset, in view of applicant's admissions in its answer that the marks and goods are identical, there is no dispute that contemporaneous use of the parties' marks on their respective goods would be likely to cause confusion. Further, because applicant did not present any evidence or argument directed to its affirmative defenses, we deem them waived and haven given them no consideration. Thus, the sole issue to be decided in this proceeding is priority.

Where, as here, opposer does not own a registration and is relying on common law rights in its mark, opposer must establish by competent evidence that it has used its mark prior to the earliest date on which applicant may rely for priority purposes. Because the applicant herein did not present evidence of use which predates the application filing date, the earliest use date on which applicant can rely for priority purposes is its application filing date, September 16, 2002. See *David Crystal, Inc. v. Estee Lauder, Inc.*, 167 USPQ 411 (TTAB 1970), aff'd, 476 F.2d

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1373, 177 USPQ 461 (CCPA 1973); and Levi Strauss & Co. v. R. Josephs Sportswear, Inc., 36 USPQ2d 1328 (TTAB 1994).

Opposer maintains that it first used the WAVE mark in connection with brake products, specifically brake rotors, in early 1999. In support thereof, opposer offered the testimony of its General Manager, Alessandro Milesi. Mr. Milesi testified that he is responsible for all marketing, sales, and internal operations of opposer. (Milesi dep., p. 8). According to Mr. Milesi, opposer purchases most of the brake products it sells from its parent company, Industrias Galfer of Barcelona Spain. (Milesi dep., pp. 9-10). In 1998, opposer began hearing about a new type brake rotor with an irregular outer surface. (Milesi dep., p. 11). In late 1998 opposer purchased these brake rotors from Industrias Galfer for sale in the United States. (Milesi dep., p. 13). Mr. Milesi acknowledges that the brake rotors were manufactured by applicant, Braking Italia, s.r.l., who in turn supplied them to Industrias Galfer. (Milesi dep., p. 15).

With respect to the adoption of the WAVE mark, Ms. Allesandro testified that:

Q. And whose idea was it to use "Wave rotor" as the designator for this product in the United States?

A. Well, we caught on to the idea right away. It was my father and myself that called it Wave rotor. And again, Umberto, my uncle,

who also thought that was a great name, you know.

Q. And as far as you know, were you the first ones to use that name in connection with rotors in the United States?

A. As far as I know, yes.
(Milesi dep., p. 19)

In early 1999 opposer began promoting the WAVE brake rotors at its website and by direct mail to existing customers to encourage them to attend an industry trade show in Indianapolis to see the new type brake rotor. (Milesi dep., pp. 16-17). Mr. Milesi testified that opposer displayed a WAVE rotor at this industry trade show in February 1999 (Milesi dep., p. 19), and on February 17, 1999 opposer shipped a WAVE brake rotor to one of its customers, a motorcycle shop in Bellevue Washington. (Milesi dep., p. 23 and Exhibit 3). Mr. Milesi identified an invoice for this sale and eleven additional invoices dated from February 1999 to April 2002 for sales of WAVE brake rotors to different customers. (Exhibits 3 and 4). In each of these invoices, the brake rotors are referred to as "WAVE." Mr. Milesi testified that opposer has continued to sell brake rotors under the WAVE mark. (Milesi dep., p. 78).

Oral testimony, even of a single witness, if "sufficiently probative," can suffice to prove priority. *Powermatics, Inc. v. Global Roofing Products Co., Inc.*, 341 F2d. 127, 144 USPQ 430 (CCPA 1965). In this case, Mr.

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Milesi's testimony with respect to opposer's first uses of the WAVE mark was clear and consistent. Further, Mr. Milesi's pertinent testimony was accompanied by documentary evidence which was consistent with the testimony.

Applicant has not challenged or rebutted any of opposer's evidence pertaining to opposer's first uses of its WAVE mark on brake rotors. We find the evidence sufficient to establish that opposer has used the WAVE mark since February 1999. This date is earlier than applicant's priority date, and therefore, priority lies with opposer.

In view thereof, and there being no dispute regarding the identity of the marks and goods, contemporaneous use of the marks on the respective goods is likely to cause confusion.

Decision: The opposition is sustained.