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Mailed: September 22, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

AAI Motorsports Co.
v.
Express Auto Options, Inc.

Cancellation No. 92043113
to Registration No. 2750329

Charles R. Sutton and Gary F. Wang of Law Offices of Roger C. Hsu for AAI Motorsports Co.

Vitaly I. Dimov, President, Pro Se for Express Auto Options, Inc.

Before Walters, Holtzman and Walsh, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

AAI Motorsports Co. filed a petition to cancel the registration of Express Auto Options, Inc. for the mark shown below for "new ground effects, namely automobile bumpers and side skirts," in International Class 12.[1]

[1] Registration No. 2750329, issued August 12, 2003, was filed as an application on April 25, 2002, and asserts a date of first use as of April 1, 2002 and a date of first use in commerce as of April 15, 2002.

In its petition to cancel, petitioner alleges, *inter alia*, that it manufactures and distributes “automobile after-market accessories and modification kits, including bumpers and side skirts” (paragraph no. 2); that it has a pending application for its mark BUDDY CLUB that has been refused registration under Section 2(d) of the Trademark Act based on the subject registration (paragraph nos. 3 & 5); that “in or about 2001, petitioner started to develop its product market in the United States using the mark BUDDY CLUB” (paragraph no. 8); that respondent learned of petitioner’s use of the mark BUDDY CLUB and started to use the mark BUDDY CLUB 2 “in direct competition with petitioner and petitioner’s product market” (paragraph no. 9); that respondent’s “adopting and using the mark BUDDY CLUB 2 falsely suggests a connection with petitioner, its identity and its products” (paragraph no. 10); that respondent’s mark will “dilute the distinctive quality of petitioner’s famous mark BUDDY CLUB” (paragraph no. 11); that petitioner is and will continue to be damaged by respondent’s registration; and that respondent’s registration is “an obstacle for petitioner’s application for registration … or at the very

least, … will remain as a cloud on petitioner's legal right to use the mark BUDDY CLUB" (paragraph no. 11).

To the extent that petitioner is alleging a claim of dilution, under Section 43(c) of the Trademark Act, 15 U.S.C. §1125(c), we find that such claim is legally insufficient inasmuch as there is no allegation that its mark became famous prior to the filing date of the involved applications. *See Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000). *See also, Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164 (TTAB 2001). Therefore dilution is not an issue before us in this case.

While petitioner's pleading is far from a model of clarity, we find the allegations sufficient to assert a claim of a false suggestion of a connection with petitioner, under Section 2(a) of the Trademark Act, 15 U.S.C. §1052(a); and a claim that respondent's mark, when applied to respondent's goods so resembles petitioner's mark BUDDY CLUB, previously used in connection with a variety of aftermarket car parts, as to be likely to cause confusion, under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

Respondent, in its answer, denied the salient allegations of the petition.

The Record

The record consists of the pleadings; the file of the involved registration; a copy of the domain name

registration by respondent of buddyclub2.com; responses of respondent to petitioner's first set of interrogatories, all made of record by petitioner's notice of reliance; and the testimony deposition by petitioner of Robert Shan, petitioner's general manager, with accompanying exhibits. Respondent did not submit testimony or any other evidence. Only petitioner filed a brief on the case.

Factual Findings and Analysis

Through the deposition of Robert Shan and the exhibits thereto, petitioner has established that petitioner manufactures and distributes a variety of after-market automobile parts and accessories, including, wheel rims, lug nuts, dampers, mufflers, race car use batteries, and aerodynamic body kits, all identified by the trademark BUDDY CLUB; and that petitioner licenses the mark from a Japanese company, First, Ltd., and, in turn, licenses the mark to Super High Technology, Inc. for the promotion and distribution of its goods under the mark. Mr. Shan stated that the mark has been in use in Japan for at least ten years and has become famous; and that petitioner has used the mark on goods sold in the United States since 2001. The exhibits to Mr. Shan's deposition include excerpts from the website of Super High Technology, Inc., showing some of the above-noted products under the BUDDY CLUB mark and copies of

March and June 2002 invoices from Primedia, a company providing petitioner's advertising in magazines.

Mr. Shan stated that The BUDDY CLUB mark is famous for the above-noted products in Japan and the United States. However, there is absolutely no evidence in the record in support of this contention and Mr. Shan's opinion is self-serving for petitioner and of little probative value. Therefore, we conclude that petitioner has not established the fame of its mark.

What information we have about respondent is from its answers to petitioner's interrogatories, properly submitted at trial by petitioner. Petitioner has not challenged the truth of respondent's responses and, therefore, we consider these responses as true for the purposes of this proceeding. Respondent stated that it manufactures and sells front bumpers, rear bumpers, and side skirts for a variety of automobiles; and that it first used its mark in the sale of such goods in June 1998 and that such sales have been continuous throughout the United States to the date of the interrogatory responses. In 1998 through 2000, applicant bartered its goods for advertising; in 2001, applicant advertised on its own website; and in 2002 through 2004, respondent advertised in magazines and at trade shows, spending approximately $2000 per month for such advertising. Respondent is unaware of any instances of actual confusion.

Exhibits to Mr. Shan's deposition include copies of advertisements for respondent's goods sold under the BUDDY CLUB 2 and design mark and an excerpt from respondent's website showing the mark.

First, because neither of petitioner's claims are frivolous, we find that petitioner has established its standing to petition to cancel respondent's registration. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Section 2(a) Claim

A Section 2(a) false suggestion of a connection claim is not merely an alternative likelihood of confusion claim. In *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), the Court of Appeals for the Federal Circuit stated that to succeed on a Section 2(a) false suggestion of a connection ground, the plaintiff must demonstrate that the name or equivalent thereof claimed to be appropriated by another must be unmistakably associated with a particular personality or "persona" and must point uniquely to the plaintiff. The Board, in *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985), in accordance with the principles set forth in *Notre Dame*, required that a plaintiff asserting a claim of a false suggestion of a connection demonstrate 1)

that the defendant's mark is the same or a close approximation of plaintiff's previously used name or identity; 2) that the mark would be recognized as such; 3) that the plaintiff is not connected with the activities performed by the defendant under the mark; and 4) that the plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used on its goods or services, a connection with the plaintiff would be presumed.

First, we find that petitioner has not established that BUDDY CLUB is unmistakably associated with a particular personality or "persona" that points uniquely to the plaintiff. Even if petitioner had met this criteria, petitioner has not submitted any evidence from which we can conclude that BUDDY CLUB is of sufficient fame that a connection with petitioner would be presumed by use of a mark that is the same or a close approximation of BUDDY CLUB. Thus, it is unnecessary to proceed further with an analysis of the remaining factors. We conclude that petitioner has not met its burden of establishing its claim of a false suggestion of a connection with petitioner, under Section 2(a) of the Trademark Act.

Section 2(d) Claim

With respect to any likelihood of confusion claim under Section 2(d), the threshold question is priority.

Petitioner does not have, or has not made of record, a United States trademark registration for its BUDDY CLUB trademark and, thus, petitioner must establish priority of use of its mark in commerce lawfully regulated by Congress. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). The record establishes petitioner's first use in the United States of its BUDDY CLUB mark in connection with its goods as of 2001. Use of the mark in Japan or anywhere outside of the United States is not relevant in this proceeding. The registration that is subject to this petition to cancel was issued on August 12, 2003, based on an application filed on April 25, 2002. Neither of these dates precedes petitioner's date of first use; however, the record establishes petitioner's first use of its mark in the United States as of 1998. In view of petitioner's failure to establish priority, the determination of likelihood of confusion is moot.

Decision: The petition to cancel is denied.