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**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451**

Cataldo

Mailed: September 16, 2005

Opposition No. 91124776

Kmart of Michigan, Inc.

v.

Millyon Marketing Concepts

Before Quinn, Chapman and Zervas,
Administrative Trademark Judges.

By the Board:

Kmart of Michigan, Inc. has opposed the application of
Millyon Marketing Concepts (pro se) to register the mark
shown below in stylized form

2K-MART

for

retail store, wholesale distributorships, and
discount store services featuring electronic
appliances of all types, household appliances,
furniture, clothing and footwear, jewelry and
watches, home improvement products, tools and
hardware items, carpeting and other floor
coverings, audio-visual equipment, electronics,
batteries of all types, cars, trucks, Suva [sic],
and van vehicles and accessories, tires, gasoline,
luggage, handbags, purses, wallets, toys and games
for all ages, personal hygiene products, cleaning
supplies and detergents, prescription and over-
the-counter pharmaceutical goods, boating
equipment and accessories, alcoholic and non-
alcoholic beverages, lamps, lighting equipment and
supplies, gardening supplies, flowers and plants,
stationary and offices, computer hardware,

software, and peripherals, music instruments, records, tapes, compact discs, and DDS, films, videos, DDS, books, periodicals, magazines, and other forms of literature, sporting goods, arts and crafts supplies, original artwork, commercial artwork, picture frames, party supplies and cards, antiques and collectibles, home, vehicle, property and personal security systems and devices, window and wall coverings, pet food supplies, and accessories; retail grocery store services.¹

As grounds for the notice of opposition, opposer asserts, in pertinent part of its amended notice of opposition,² that it made prior use of numerous K MART and K MART formative marks for retail store services and as a house mark for a variety of goods; that it owns numerous registrations for K MART and K MART formative marks, including Registration No. 743,912 for the mark K MART for "retail variety store services"³; that applicant adopted its mark with full knowledge of opposer's use and registration of its marks; that opposer's marks are famous; that opposer's marks became famous prior to any use by applicant of its mark; and that applicant's mark, when used in

¹ Application Serial No. 75589511 was filed on November 27, 1998 based upon applicant's assertion of its bona fide intent to use the mark in commerce in connection with the recited services.

² Opposer's amended notice of opposition, filed prior to applicant's original answer and accepted in a Board order dated January 13, 2003, is opposer's operative pleading herein. Applicant filed an answer to the amended notice of opposition.

³ Registration No. 743,912 was issued to S.S. Kresge Company on January 15, 1963, with a disclaimer of "MART." Assignment of the mark to opposer is recorded with the Assignment Branch of the USPTO at Reel 2255/Frame 0851. Section 8 affidavit accepted; Section 15 affidavit acknowledged, renewed.

connection with its services, so resembles opposer's marks as to be likely to cause confusion, mistake or deception, and to dilute the distinctive quality of opposer's marks.

Applicant, in its answer to the amended notice of opposition, denies the salient allegations thereof. In addition, applicant asserts the affirmative defenses of laches, acquiescence and unclean hands.⁴

This case now comes before the Board for consideration of opposer's motion for summary judgment on the ground of priority and likelihood of confusion under Trademark Act Section 2(d). Applicant filed a brief in opposition thereto.⁵

In support of its motion for summary judgment, opposer essentially argues there is no genuine issue of material fact that the mark 2K-MART (as shown above) in the application at issue includes opposer's K MART marks; that opposer made use of its marks prior to the earliest date

⁴ Applicant's additional defense that the notice of opposition was untimely filed was stricken in a Board order dated January 13, 2003.

⁵ In addition, opposer filed a reply brief. The reply brief is not necessary to clarify the issues herein and, as such, it has not been considered. See Trademark Rule 2.127(e)(1). Moreover, applicant's "motion for summary judgment," filed as a sur-reply to opposer's reply brief seeking summary judgment, is procedurally improper and will be given no consideration. In consequence thereof, (i) opposer's motion to strike applicant's motion for summary judgment is moot; and (ii) the parties' briefs on applicant's motion for summary judgment have not been considered. See TBMP §502.02(b) (2d ed. rev. 2004). (We hasten to add that if applicant's motion for summary judgment were considered it would be denied.)

upon which applicant may rely for purposes of priority of use; that opposer's K MART marks are famous and, accordingly, are entitled to a broad scope of protection; that opposer's K MART marks are strong marks as a result of opposer's billions of dollars in annual sales and millions of dollars spent annually in advertisements under its marks; that applicant's services are nearly identical to those of opposer and related to opposer's goods; and that the parties' services are marketed in the same channels of trade to the same classes of purchasers.

Opposer submitted printouts of pages from its web site containing information regarding opposer's corporate history; a list of its registered K MART and K MART formative marks; photographs of signage depicting opposer's marks; a status and title copy of opposer's pleaded Registration No. 743,912; a list of opposer's international trademark registrations for its K MART and K MART formative marks; copies of opposer's advertisements; copies of three court decisions in infringement suits brought by opposer against users of various K MART formative marks; and a copy of an August 19, 1999 letter from an officer of applicant to opposer regarding, *inter alia*, the mark at issue herein. In addition, opposer submitted the affidavit of Mark Shaffer, Vice-President, Secretary, and intellectual property counsel for opposer, in support of the foregoing.

In response to the motion for summary judgment, applicant argues that it sent a letter to opposer on August 19, 1999, informing opposer of its intention, *inter alia*, to register the mark at issue herein, requesting opposer's position with regard thereto, and inquiring whether opposer would be interested in entering into a business relationship with applicant; that opposer did not respond to applicant's letter; that, as a result of its inaction, opposer is barred from bringing the current opposition under the doctrines of acquiescence, implied consent, estoppel, and laches. In addition, applicant maintains that there are disputed material facts relative to the similarity between the parties' marks; the nature of applicant's services and the relatedness to opposer's goods and services; and the existence of third-party uses of similar marks.

In support of its position, applicant submitted printed copies of the August 19, 1999 letter; portions of the record from this opposition proceeding; copies of opposer's written responses to certain of applicant's discovery requests and documents produced therewith; copies of correspondence between opposer and third parties regarding infringement of opposer's marks; printouts of the USPTO's Trademark Electronic Search System (TESS) records of third-party "MART" formative applications and registrations; printouts of TESS records of several of opposer's trademark

applications and registrations as well as those of applicant; and copies of Internet searches regarding ownership of the parties' Internet domain names.

As has often been stated, summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine, if, on the evidence of record, a reasonable finder of fact could resolve the matter 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); and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and *Opryland USA*, *supra*.

After a careful review of the record in this case, we find that there is no genuine issue of material fact and

that opposer is entitled to judgment as a matter of law.⁶

Priority of use is not at issue in this proceeding inasmuch as opposer has proven ownership of Registration No. 743,912 and introduced a status and title copy thereof. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 182 USPQ 108 (CCPA 1974).

Turning to the question of likelihood of confusion, we find that there is no genuine issue of material fact for trial.

It is well established that the test for determining likelihood of confusion is not whether the marks are distinguishable upon side-by-side comparison, but rather whether they so resemble one another as to be likely to cause confusion. See *Visual Information Institute, Inc. v. Vicon Industries Inc.*, 209 USPQ 179 (TTAB 1980). In the instant case, applicant has appropriated in its entirety opposer's K MART mark. See *Philips Petroleum Company v. Jet-Aer Corporation*, 157 USPQ 98 (TTAB 1968). The presence of a hyphen in applicant's mark does not serve in any way to distinguish it from opposer's registered mark. Furthermore, because the mark depicted in Registration No. 743,912 is in

⁶ As a preliminary matter, we find that there is no genuine issue of material fact as to opposer's standing. Opposer attached to its motion for summary judgment a status and title copy of pleaded Registration No. 743,912. See 15 U.S.C. §1063(a). See also *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

standard character form, opposer's use of the K MART mark is "not limited to the mark depicted in any special form." See *Phillips Petroleum v. C.J. Webb*, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971). Accordingly, in any likelihood of confusion analysis, we "must consider all reasonable manners in which [the mark K MART] could be depicted." See *Squirtco v. Tomy Group*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983); and *INB National Bank v. Metrohost*, 22 USPQ2d 1585 (TTAB 1992).

Thus, opposer's standard character drawing of the mark K MART affords opposer a scope of protection which encompasses all reasonable manners in which K MART could be depicted, including depicting the mark in an identical manner to that in applicant's minimally stylized 2K-MART mark.

In addition, the record reflects that as a result of opposer's long use and extensive efforts at advertisement and promotion thereof, opposer's K MART mark is a strong and widely recognized mark in the discount retail store field. Thus, while applicant argues that there are differences in the parties' marks, applicant has offered no evidence of a genuine issue of material fact as to whether the public's perception of the involved marks differs as a result thereof. Further, applicant's reliance upon third-party registrations of essentially unrelated marks fails to address the similarities between the parties' marks involved herein. In any event, we find that there is no genuine

issue of fact that the marks are similar in sound, appearance, meaning and commercial impression.

Turning next to the relatedness of the parties' services, the services of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); and *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

In this case, opposer's "retail variety store services" are nearly identical to applicant's "retail store, wholesale distributorships, and discount store services" featuring a wide variety of goods. The record reflects that opposer promotes and markets its goods and services in all available trade channels to all classes of consumers. Moreover, there are no restrictions in applicant's recitation of services as to particular channels of trade or classes of purchasers. Thus, on the face of the instant application and registration, the intended trade channels and classes of consumers of applicant's services and those of opposer are the same, i.e., the general public. *See Octocom Systems*

Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). We find therefore that there is no genuine issue of material fact that the retail store services of the parties are virtually identical.

Applicant's assertions that opposer's claims are barred by the doctrines of laches, acquiescence, implied consent and estoppel are unavailing. First, in Board opposition proceedings, the defenses of laches and acquiescence run from the time a party obtains knowledge of application for registration of a mark, not from the time of knowledge of its use. See *National Cable Television Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991). Thus, for purposes of opposing the registration of applicant's involved mark, laches and acquiescence cannot start to run prior to July 10, 2001, that is, the date upon which application Serial No. 7589511 was published for opposition. See *Id.* The record reflects that opposer timely filed its notice of opposition on October 18, 2001 after timely obtaining extensions of time in which to oppose. Thus, we find no genuine issue of material fact that opposer's claim is not barred by laches or acquiescence.

In addition, we find that applicant failed to plead implied consent and estoppel in its answer to opposer's amended notice of opposition. It is well settled that a party may not defend against a summary judgment motion by asserting the existence of genuine issues of material fact regarding an unpleaded defense. See *Blansett Pharmacal Co. v. Camrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992); and *Perma Ceram Enterprises Inc. v. Presco Industries Ltd.*, 23 USPQ2d 1134 (TTAB 1992). To the extent that applicant's assertions with regard to implied consent and estoppel are intended as amplifications of its arguments regarding laches and acquiescence, they still do not raise a genuine issue of material fact.

In sum, applicant has failed to disclose any evidence that points to the existence of a genuine issue of material fact on the issue of likelihood of confusion, and opposer has established that there is no genuine issue of material fact and that opposer is entitled to judgment as a matter of law.

Accordingly, opposer's motion for summary judgment is granted, the opposition is sustained, and registration to application Serial No. 75589511 is refused.