

THIS OPINION IS NOT  
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Mailed:  
Sept. 14, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

DC Shoes, Inc.  
v.  
John Melnicki

Opposition No. 91162564  
to application Serial No. 76516347  
filed on May 22, 2003

Niky Economy Syrengelas of Crockett & Crockett, PC for DC Shoes, Inc.

Thomas F. Bergert of Williams Mullen for John Melnicki.

Before Quinn, Grendel and Cataldo, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

**INTRODUCTION**

In the above-referenced application, John Melnicki, applicant herein, seeks registration on the Principal Register of the mark **DC N ME** (in standard character form) for the following goods and services in ten International Classes:

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metal key chains and attachments, namely metal key rings; metal novelty license tags, in Class 6;

jewelry, necklaces, earrings, finger and toe rings, bracelets and watches, in Class 14;

paper goods, namely writing paper, stationery, address books, paper weights, file folders, ball point pens, in Class 16;

travel gear, namely travel bags, umbrellas, business card cases, duffle bags, in Class 18;

drinking glassware and housewares, namely cups, mugs, plates, drinking glasses, in Class 21;

cloth flags, in Class 24;

clothing, namely t-shirts, sweatshirts, running wear, namely running suits, shorts, skirts, tank tops, hats, visors, socks, footwear, headgear, namely hats and caps, in Class 25;

toys, namely stuffed animals, toy flying saucers for playing toss games, footballs, baseballs, hockey pucks, soccer balls, games, namely board games, playing cards, in Class 28;

promotional advertising services, namely promoting the services of tourism, restaurant and social club businesses through the distribution of printed and audio promotional materials and by rendering sales promotion advice, chamber of commerce services, namely promoting business and tourism in the Washington, D.C. metropolitan area, in Class 35;

educational services in the nature of conducting exhibitions, displays and interactive exhibits in the fields of American history, culture and politics; guided tours of museums and historical sites in Washington, D.C.; entertainment services in the nature of live music concerts, live motivational and educational speakers and theater productions; organizing and conducting community festivals, in Class 41; and

association services, namely, promoting the interests of Washington, D.C. community residents

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in volunteerism and community service, in Class 42.

The application is based on applicant's asserted bona fide intention to use the mark in commerce. Trademark Act Section 1(b), 15 U.S.C. §1051(b).

DC Shoes, Inc., opposer herein, filed a notice of opposition to registration of applicant's mark as to all ten classes of goods and services. In paragraphs 1-10 of the notice of opposition, opposer alleged that

Opposer, for several years and since long prior to any date of first use upon which Applicant can rely, has adopted and continuously used the trade name "DC" in connection with sale and distribution of key chains... sale and distribution of jewelry and watches... sale and distribution of paper goods... sale and distribution of travel bag [sic] and duffel bags... sale and distribution of drinking clothing sketchers and drinking glasses... sale and distribution of sleeping bags, towels, handkerchiefs and sports towels... sale and distribution of action skill games, arcade type electronic video games, bags for skateboards and bags for sports equipment... computerized on-line retail store services in the field of sports related shoes, apparel and equipment, and computerized on-line ordering services in the field of sports related shoes, apparel and equipment... film distribution, fan clubs, instruction in the field of sports production of video disks for others and publication of magazines... association services.

In paragraph 21 of the notice of opposition, opposer alleged that "Applicant's mark so resembles Opposer's manufactured and sold 'DC' products as to be likely, when applied to the goods set forth in applicant's application, to cause

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confusion, mistake or deception within the meaning of Section 2(d) of the Trademark Act." In paragraph 22 of the notice of opposition, opposer alleged that "Applicant's use of the mark is likely to dilute Opposer's 'DC' trade name."

Applicant filed an answer by which he denied all of the salient allegations of the notice of opposition.

After close of trial, opposer and applicant filed their main appeal briefs, and opposer filed a reply brief. No oral hearing was requested.

**EVIDENTIARY MATTERS**

Initially, certain evidentiary matters require resolution.

**Opposer's registrations.**

Applicant, in its brief, has objected to opposer's September 23, 2005 notice of reliance<sup>1</sup> on status and title copies of three registrations assertedly owned by opposer, i.e., Registration Nos. 2317622, 2340040 and 2427124. Applicant argues that these registrations should be stricken because (a) they were not pleaded in the notice of

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<sup>1</sup> The notice of reliance bears a certificate of mailing dated September 23, 2005, but it includes no certificate of service. Opposer subsequently filed a certificate of service stating that the notice of reliance on the three registrations was served on applicant's counsel on September 29, 2005.

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opposition, and (b) they were not timely submitted during opposer's testimony period, which closed on August 16, 2005.

In its reply brief, opposer argues against applicant's objection, contending that the three registrations should be deemed of record because: (a) they "were initially pleaded in its [opposer's] Notice of Opposition"; (b) the notice of reliance "was filed before the close of its [opposer's] rebuttal testimony period. 37 C.F.R. §2.122(b)(2) requires that a Notice of Reliance be filed to provide for the introduction of status and title copy of Registrations. However, the rule does not specifically distinguish between filing them during the main testimony period or the rebuttal period. Therefore, Opposer's filing should be considered timely"; and (c) "In the alternative, Opposer's registrations should be judicially noted as an official USPTO record. Applicant is not biased by introduction of the registrations and had full notice of the registrations as of the date of the filing of the Notice of Opposition. Therefore, Opposer's registrations should not be stricken from the record."

Applicant's objection to consideration of opposer's three registrations is well-taken and accordingly is sustained. First, and contrary to opposer's counsel's statement in opposer's reply brief, the registrations clearly were not pleaded in the notice of opposition.

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Second, even if the registrations had been pleaded, opposer's submission of the registrations via notice of reliance on September 23, 2005, over a month after the August 16, 2005 close of opposer's main testimony period, is manifestly untimely. See *Jean Patou Inc. v. Theon Inc.*, 18 USPQ2d 1072 (TTAB 1990). Trademark Rule 2.121(a)(1) provides, in pertinent part, that "[n]o testimony shall be taken except during the times assigned, unless by stipulation of the parties approved by the Board, or, upon motion, by order of the Board." Third, even if opposer's proposed construction of Trademark Rule 2.122(b)(2) were correct (and it is not), opposer's September 23, 2005 notice of reliance on the registrations clearly cannot be deemed to have been submitted during opposer's rebuttal testimony period, which opened on November 15, 2005 and closed on November 29, 2005. (The registrations would constitute improper rebuttal in any event.) Finally, the Board denies opposer's request that we take judicial notice of opposer's registrations. The Board does not take judicial notice of registrations residing in the Patent and Trademark Office. See *Corporate Fitness Programs Inc. v. Weider Health and Fitness Inc.*, 2 USPQ2d 1682 n.3 (TTAB 1987); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290 (TTAB 1986). Thus, opposer's attempted reliance on its registrations

fails both as a matter of pleading and of proof, and we have given the registrations no consideration.

**Internet evidence (Exhibit 1 to Wright deposition).**

Exhibit 1 to the testimony deposition on written questions of Brian Allen Wright, opposer's vice president and general counsel, consists of printouts from various Internet websites, all apparently downloaded on August 12, 2005. In his brief, applicant has objected to this evidence on the ground that it is not properly authenticated and is without foundation, and on the ground that it is hearsay. Opposer has argued against the objection.

As part of his answer to Cross-Question No. 3 of his testimony deposition on written questions (at pages 17-18), Mr. Wright testified as follows with respect to these Internet printouts: "I have made copies of a few web pages that we have marked as Exhibit 1 that shows number one, that we as a company use the term 'DC' by itself to refer to us. And not only do we use it, but the trade also uses it by itself to refer to us."<sup>2</sup>

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<sup>2</sup> In its entirety, Cross-question No. 3 of the deposition on written questions reads as follows:

With respect to your response to Interrogatory No. 6, identify and describe each instance that opposer has used "DC" in conjunction with the terms "film" and "music" and/or by itself. Include in your answer a statement of all facts which support your denial of Request for Admission No. 8, which asked you to admit that you do not use "DC" by itself without a design

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Internet evidence is not self-authenticating. It must be authenticated by the person with first-hand knowledge who searched for and downloaded the information. *Starbucks U.S. Brands LLC v. Ruben*, 78 UPSQ2d 1741, 1748 (TTAB 2006); *Raccioppi v. Apogee, Inc.*, 47 USPQ2d 1368 (TTAB 1998). Contrary to opposer's assertions in its reply brief, we find that Mr. Wright's testimony, i.e., "I have made copies of a few web pages that we have marked as Exhibit 1...", simply does not establish that he was the person with first hand knowledge who searched for and downloaded the information.<sup>3</sup>

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component, as a trademark, service mark, or trade name in connection with the goods and services identified in Paragraphs 1-10 of the notice of opposition.

The witness' answer to Question No. 3 in its entirety is as follows:

We actually - other than a trademark application, we've never really used DC Music. DC Films, there is a web site [www.dcfilms.com](http://www.dcfilms.com). We have sold one video under the trademark DC Films. We have another video coming out shortly that's going to be sold under the trademark DC Films. And DC Films, I think it's impossible, really, to talk about each instance because we use that a lot. That has - part of what we do is take videos of the various athletes that we sponsor, use those videos in either commercials or just post them on the web. And the vehicle that we have branded for doing that is DC Films. And I think if you do an Internet search for DC Films, you will probably come up with a number of different uses. With respect to the second part of that question, it says a statement of facts which support my denial of Admission No. 8, we use DC by itself a lot. I have made copies of a few web pages that we have marked as Exhibit 1 that shows number one, that we as a company use the term "DC" by itself to refer to us. And not only do we use it, but the trade also uses it by itself to refer to us.

<sup>3</sup> In its reply brief, opposer asserts: "Mr. Wright clearly testifies to the fact that he printed out the web pages and then identifies the content of those web pages. This testimony

This evidence therefore lacks foundation and has not been authenticated, and we give it no consideration. We need not reach applicant's hearsay objection to this evidence.

**"Actual confusion" evidence (Exh. 2-3 of Wright deposition).**

Exhibit 2 to the Wright deposition is asserted to be a printout of an Internet page, the text of which is reproduced exactly below:

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**DCNME**

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**Clothing, namely t-shirts, sweatshirts, running wear, namely running suits, shorts, skirts, tank tops, hats, visors, socks, footwear, headgear, namely hats and caps.**

**>> Are you looking for DC Shoes?"**

**Yes  No  Submit**

**0018**

Exhibit 3 to the Wright deposition is asserted to be a printout of an e-mail, the text of which is reproduced exactly below:

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clearly identifies that Mr. Wright recognized the items in Exhibit 1 because he was the one to print them out and introduce them in response to the cross-examination question." Reading the testimony itself, we cannot agree that it clearly establishes that it was Mr. Wright who downloaded and printed out the information.

Niky Economy Syrenge

Tue, Aug 12, 2005 7:28 AM

Subject: DC Shoes

Date: Thursday, June 16, 2005 7:34 PM

From: nikysyrenge@crockett-crockett.com

To: nikysyrenge@crockett-crockett.com

Are you looking for DC Shoes? : yes

These exhibits were introduced in response to Question 20 of Mr. Wright's deposition on written questions, which asked: "Can you provide any evidence of actual confusion?" Mr. Wright answered this question as follows (at pp. 15-16):

I'm familiar with the web site <http://www.crockett-crockett.com/testdc.htm>. I instructed Crockett & Crockett [opposer's attorneys herein] to create this website for purposes of this opposition. The printout of the web site has been marked as Exhibit 2. This is a true and correct copy of computer printout from the web site <http://www.crockett-crockett.com/testdc.htm>. The printout was printed out on August 16, 2005. The printout is an e-mail response that responds in the affirmative to a question, "Are you looking for DC Shoes?" when applicant's trademark was used. ... Exhibit 2 is the web site, Exhibit 3 is a response from an unknown party on the Internet that indicated that they were looking for DC Shoes. ... The web site received 18 hits in total.

In his brief, applicant has objected to Exhibit Nos. 2 and 3, and the accompanying testimony, on the ground that this evidence constitutes hearsay. In its reply brief, opposer responds to the objection by arguing that "[t]hese

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exhibits are not hearsay because they are statements of consumer confusion. Such statements in the trademark context fall under the 'state of mind' exception to the hearsay rule. See Fed. R. Evid. 803(3)."

We have considered Exhibits 2 and 3 for what they show on their face. What they show on their face, however, is incomprehensible and of no probative value. It is not clear how Exhibit 2 was generated, or by whom. Is it the result of a consumer searching on the Internet for "DCNME," or is it a page accessed only by going first to opposer's counsel's website? Whatever it is, it certainly does not establish, on its face, the "actual confusion" for which opposer has offered it. Of even less probative value is Exhibit 3, which appears to be an e-mail from opposer's counsel to herself.

Thus, we overrule applicant's hearsay objection to Exhibits 2 and 3, but we find that this evidence is of no probative value on its face.

**Wright deposition, Question No. 9**

Question No. 9 of the Wright deposition on written questions was: "How do consumers refer to DC Shoes, Inc. products?" After applicant's written objection to the question (on the grounds of hearsay, vagueness and ambiguity, and on the ground that it calls for speculation)

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was read into the record, Mr. Wright answered the question as follows: "I think it's primarily referred to as 'DC' and sometimes as 'DC Shoes.'"

In its brief, applicant maintains its hearsay objection to this testimony, arguing that "[c]ertainly Mr. Wright cannot testify as to the thoughts or state of mind of consumers." In its reply brief, opposer does not offer any response or argument regarding applicant's objection to this testimony.

We agree with applicant's contention that this testimony is hearsay and of no probative value.

**SUBSTANTIVE ISSUES**

Having ruled on the evidentiary issues, we turn now to consideration of the substance of opposer's claims.

**Standing.**

Opposer's current trade name appears to be DC Shoes, Inc. We find that this fact, coupled with the fact that opposer's likelihood of confusion claim is not patently frivolous, suffices to satisfy the minimal requirements for standing in this case. *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).

**Opposed classes.**

In opposer's notice of opposition, opposer opposed registration of applicant's mark in all ten classes covered by applicant's application. However, in its brief, opposer presented argument only as to the Class 25 goods. (Brief at 11: "Opposer uses the DC and DC SHOES marks for a wide range of footwear and apparel. Applicant's services as described in the application are: 'clothing, namely t-shirts, sweatshirts, running wear, namely running suits, shorts, skirts, tank tops, hats, visors, socks, footwear, headgear, namely hats and caps.' Therefore, the goods and services are identical.") Opposer presented no argument or evidence pertaining to the other classes of goods and services in the application. We therefore deem opposer to have waived its claims as to Classes 6, 14, 16, 21, 24, 28, 35, 41 and 42, and we dismiss the opposition as to those classes.

**Section 2(d).**

To prevail on its Section 2(d) ground of opposition, opposer must prove priority and likelihood of confusion. We need not reach the likelihood of confusion issue in this case, because we find that opposer has failed to establish its Section 2(d) priority.

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First, we note that priority of use is an issue in this case, because opposer failed to plead and prove ownership of any registration which would bar registration of applicant's mark under Section 2(d). See discussion *supra*. *Distinguish King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974)(priority not at issue where opposer's registration is of record). We also note that applicant, in his answer to the notice of opposition, denied opposer's allegations of prior use of the trade name "DC," thereby leaving opposer to prove priority at trial.

The earliest date upon which applicant may rely for priority purposes in this case is May 22, 2003, the filing date of his intent-to-use application. To establish priority under Section 2(d), therefore, opposer must prove use which predates May 22, 2003. We find that the evidence of record fails to establish such prior use by opposer. That is, we find that the evidence of record fails to establish that opposer used any particular mark or trade name on any particular goods or services prior to May 22, 2003.

The evidence of record includes the deposition on written questions of opposer's witness Brian Allen Wright.<sup>4</sup>

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<sup>4</sup> As discussed *supra*, we have sustained applicant's objections to most of the exhibits attached to the Wright deposition. We note, however, that even if those exhibits had been properly made of record, they would not suffice as proof of opposer's priority. None of the exhibits, including the Internet pages downloaded on

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Testimony, even of a single witness, can suffice to prove priority if that testimony is "sufficiently probative." *Powermatics, Inc. v. Global Roofing Products Co., Inc.*, 341 F.2d 127, 144 USPQ 430 (CCPA 1965). In this case, we find that the witness' testimony is not "sufficiently probative" to establish opposer's priority. At no point in the deposition did the witness testify with specificity that opposer had used any particular mark on any particular goods prior to applicant's filing date of May 22, 2003. Instead, the witness' testimony is vague and ambiguous on this point.

The only reference in the deposition to opposer's activities prior to May 22, 2003 comes in the witness' answer to Cross-Question No. 4:<sup>5</sup>

Question: For each of the goods and services identified in paragraphs 1 through 10 of opposer's notice of opposition, what is the annual dollar volume of opposer's sales and revenues in the United States of products and services bearing or sold under the opposer's mark, and the annual advertising and promotional expenditures for each year (or for each month for periods of less than a year) associated with opposer's mark, from the

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August 12, 2005, demonstrates any use by opposer prior to May 22, 2003.

<sup>5</sup> This answer, which opposer deemed confidential, was apparently bound separately by the court reporter. It was not submitted by opposer with the rest of the deposition transcript. The Board left a telephone message with opposer's counsel requesting submission of the missing transcript, but opposer's counsel did not respond to the message. The Board then contacted applicant's counsel, who furnished a copy of the transcript. The Board notes that this confidential portion of the transcript, which applicant apparently received from opposer after the deposition, is not signed by the witness.

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first sale of each product or goods or each type of service to the present.

Answer (under seal pursuant to protective agreement): Worldwide sales of DC products - and I don't have that information by product class, I have it for all goods - in fiscal year 2004, worldwide sales were [amount confidential]; [amount confidential] within the United States. Advertising, I can't go before 1997 because we changed our software package in '97 and I can't access the information prior to that date. But in 1997, the marketing budget - we don't necessarily market individual products, we market the brand, but we spent [amount confidential] in '97, [amount confidential] in '98, [amount confidential] in '99, [amount confidential] in 2000, [amount confidential] in 2001, [amount confidential] in 2002, [amount confidential] in 2003, and [amount confidential] in 2004.

We agree with applicant's contention that this testimony does not suffice to establish opposer's priority. It refers only to sales of "DC products," without specifying those products or the marks (if any) under which they were sold; it refers in any event only to sales in the year 2004, subsequent to applicant's May 22, 2003 filing date. The advertising figures go back to 1997, but refer only in a general manner to "the brand," without specifying the products and the mark or marks being used.

In short, we find that opposer has failed to prove its priority, and therefore that opposer has failed to establish its Section 2(d) ground of opposition to registration of applicant's mark.

**Dilution.**

We also find that opposer has failed to plead and prove its dilution claim. Opposer's allegation in the notice of opposition that applicant's mark is likely to dilute opposer's "trade name" does not state a claim of dilution under Trademark Act Section 43(c). Only a trademark may be diluted, not a trade name. In any event, the evidence of record simply fails to establish opposer's ownership of a famous mark, much less that any such fame was achieved prior to applicant's May 22, 2003 application filing date.

**CONCLUSION**

It was incumbent upon opposer, as plaintiff herein, to prove its case. We find that opposer has failed to do so.

Decision: The opposition is dismissed.