

6/25/02

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Greenbaum

Opposition No. 121,364

Dunkin' Donuts USA, Inc.

v.

Jerry Ucci

Before Simms, Bottorff and Rogers, Administrative
Trademark Judges.

By the Board.

Jerry Ucci has applied to register the mark U-DUNK-IT-DONUTS-PLUS for use in connection with restaurant and carry-out food services.¹ Dunkin' Donuts USA, Inc. ("Dunkin' Donuts") has opposed registration on the grounds that applicant's mark, when used on the identified services, is likely to cause confusion with opposer's previously registered and used DUNKIN' DONUTS marks for restaurant services, doughnuts, doughnut flour, fruit fillings for doughnuts, cookies, cakes and pies, vegetable oil, shortening and coffee.² As the second ground for opposition, opposer claims that applicant's

¹ Serial No. 75/867,239, filed December 9, 1999, alleging a bona fide intent to use the mark in commerce.

² See Attachment "A" hereto for the complete list of opposer's relied-upon marks.

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mark, when used on the identified services, dilutes opposer's famous, earlier-used, DUNKIN' DONUTS marks.

In his answer, applicant denied the salient allegations of the notice of opposition.

This case now comes up on opposer's motion for summary judgment on the Section 2(d) issues of priority and likelihood of confusion, and on the dilution claim under Sections 13(a) and 43(c). The parties have fully briefed the issues, and we have considered opposer's reply brief. See Trademark Rule 2.127(c)(1).

As an initial point, we note that opposer's motion for summary judgment largely rests on applicant's effective admissions. In this regard, we note that opposer served on applicant opposer's first requests for admissions on August 24, 2001, and that applicant's responses thereto were untimely. Applicant did not file a motion to withdraw the effective admissions, or explain why his responses were late. Therefore, opposer's requests for admissions stand admitted by operation of Fed. R. Civ. P. 36(a).

We now turn to opposer's summary judgment motion. A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material facts, and that it is entitled to judgment as a

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matter of law. Fed. R. Civ. P. 56(c). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

Inasmuch as opposer submitted with its summary judgment motion status and title copies of 10 of its relied-upon registrations, priority is not an issue.³ See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In any event, the record shows that opposer has used the mark DUNKIN' DONUTS in connection with the sale of coffee and donuts since at least 1950, which precedes the December 9, 1999 constructive use and filing date of applicant's intent-to-use application. This evidence also suffices to establish opposer's standing to bring this opposition proceeding.

In addition, applicant has admitted the fame of opposer's mark. Specifically, in response to opposer's interrogatories, applicant stated that "the mark DUNKIN DONUTS is ubiquitous" and that he "has been aware of the mark for many years." Further, by failing to timely respond to opposer's requests for admission, applicant

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admitted that the mark DUNKIN' DONUTS is well-known and famous in the United States in connection with the manufacture and sale of coffee and donuts, and that the DUNKIN' DONUTS mark is used throughout the United States. See Opposer's Requests for Admissions Nos. 4-7.

In further support of the fame of opposer's mark, opposer submitted the affidavit of Maura Rearden, opposer's Director of Advertising, which establishes that: today, there are over 5000 Dunkin' Donuts shops worldwide, making opposer the largest donut, bagel and coffee shop in the world; opposer largely attributes the huge success of its marks to the extensive advertising campaign opposer runs through various media, including the "Fred the Baker" campaign; opposer has a very large advertising budget, and spent more than \$60 million in advertising its mark in the most recent fiscal year; in the United States alone, opposer sells approximately 2.3 billion donuts each year, and approximately 20 cups of coffee every second; opposer's sales revenues in fiscal year 2000 were approximately \$2.4 billion; and opposer owns nine incontestable marks and a pending application.⁴

³ We note that in the notice of opposition, opposer also relied on Registration No. 692,491, but opposer did not submit status and title copies of that registration.

⁴ Serial No. 76/035,918, which matured into Registration No. 2,465,531. See footnote 2 herein.

Our primary reviewing court, the Court of Appeals for the Federal Circuit, recently reaffirmed the importance of fame as a DuPont factor in the likelihood of confusion analysis.⁵ See *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000). Specifically, the Court in *Recot* stated that “[t]he fifth DuPont factor, fame of the prior mark, when present, plays a ‘dominant’ role in the process of balancing the DuPont factors,” that “the fame of the mark must always be accorded full weight when determining the likelihood of confusion,” and that “[w]hen a famous mark is at issue, a competitor must pause to consider carefully whether the fame of the mark, accorded its full weight, casts a ‘long shadow which competitors must avoid,’” citing *Kenner Parker Toys Inc. v. Rose Art Indus., Inc.*, 963 F.2d 350, 353, 22 USPQ2d 1453, 1457 (Fed. Cir. 1992).

The weight of the evidence persuades us that opposer has established the fame of its DUNKIN’ DONUTS marks for purposes of its Section 2(d) claim in this proceeding.

In addition, because applicant failed to timely respond to opposer’s requests for admissions, applicant

⁵ In *In re E.I. DuPont DeNemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973), the court enumerated factors that may be considered when relevant evidence is of record.

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also has admitted that the parties' respective marks are visually and phonetically similar, and the parties' respective goods will be sold through identical channels, will be advertised through the same channels, and will directly compete with each other. See Opposer's Requests for Admissions Nos. 13-30.

In response to the summary judgment motion, applicant argues there is no likelihood of confusion. However, applicant has failed to identify any genuine issue which would require resolution at trial. As noted above, applicant has admitted the most pertinent factors in the likelihood of confusion analysis, and opposer has provided independent evidence regarding the fame of its DUNKIN' DONUTS marks.

In short, given opposer's clear priority of use of its DUNKIN' DONUTS marks, the undisputed similarities between the parties' marks, the obviously similar nature of the goods and services, and because opposer established the fame of its pleaded marks for purposes of this proceeding, we believe that there is no genuine issue of material fact which would require a trial for its resolution. We further believe that opposer has shown that it is entitled to judgment as a matter of law. Accordingly, opposer's motion for summary judgment

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is granted, judgment is entered against applicant, the opposition is sustained, and registration to applicant is refused.

Finally, inasmuch as we find in favor of opposer on the issues of priority and likelihood of confusion, and because the application accordingly will be abandoned, opposer's dilution claim is moot.

Attachment "A"

1. Registration No. 748,901 for DUNKIN'DONUTS for restaurant services, registered April 30, 1963, claiming May 15, 1950 as the date of first use and July 7, 1956 as the first use in commerce, renewed April 30, 1983, Section 8 & 15 affidavits accepted and acknowledged, respectively.
2. Registration 976,137 for DUNKIN' DONUTS and Design for restaurant services, registered January 1, 1974, claiming January 9, 1967 as the date of first use and March 9, 1967 as the date of first use in commerce, renewed January 1, 1994, Section 8 & 15 affidavits accepted and acknowledged, respectively.
3. Registration 976,136 for DUNKIN' DONUTS (stylized) for restaurant services, registered January 1, 1974, claiming January 9, 1967 as the date of first use and March 9, 1967 as the date of first use in commerce, renewed January 1, 1994, Section 8 & 15 affidavits accepted and acknowledged, respectively.
4. Registration 907,303 for DUNKIN' DONUTS (stylized) and Design, for restaurant services, registered February 2, 1971, claiming January 9, 1967 as the date first use and first use in commerce, second renewal February 2, 2001, Section 8 & 15 affidavits accepted and acknowledged, respectively.
5. 897,088 for DUNKIN' DONUTS and Design, for restaurant services, registered August 18, 1970, claiming January 9, 1967 as the date of first use and March 9, 1967 as the date of first use in commerce, second renewal August 18, 2000, Section 8 & 15 affidavits accepted and acknowledged, respectively.
6. Registration 888,360 for DUNKIN' DONUTS (stylized) and Design for doughnuts and doughnut flour, fruit fillings for doughnuts, cookies, cakes and pies, vegetable oil, shortening, and coffee, registered March 24, 1970, claiming January 9, 1967 as the date of first use and March 9, 1967 as the date of first use in commerce, second renewal March 24, 2000, Section 8 & 15 affidavits accepted and acknowledged, respectively.

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7. Registration 1,159,354 for DUNKIN' DONUTS for plain, glazed, coated and filled fried cakes, muffins and coffee for consumption on or off the premises, registered June 30, 1981, claiming June 20, 1976 as the date of first use and August 15, 1976 as the date of first use in commerce, renewed June 30, 2001, Section 8 & 15 affidavits accepted and acknowledged, respectively.
8. Registration 1,567,400 for DUNKINS for filled pastry, namely, hot-dog-shaped pastry with apple filling for consumption on or off the premises, registered November 21, 1989, claiming March 26, 1974 as the date of first use and first use in commerce, renewed November 21, 1999, Section 8 & 15 affidavits accepted and acknowledged, respectively.
9. Registration 1,154,129 for DUNKIN' for fruit-flavored non-carbonated punches for consumption on or off the premises, registered May 12, 1981, claiming June 17, 1977 as the date of first use and first use in commerce, Section 8 & 15 affidavits accepted and acknowledged, respectively.
10. Registration 2,465,531 for DUNKIN' DONUTS for bakery goods and desserts, doughnuts, cookies, cakes and pies, registered July 3, 2001, claiming November 1999 as the date of first use and first use in commerce.
11. Registration 692,491 for DUNKIN' DONUTS for doughnuts and doughnut flour, fruit fillings for doughnuts, cookies, cakes and pies, vegetable oil, shortening and coffee, registered February 2, 1960, claiming May 1952 as the date of first use and first use in commerce. Office records show that this registration was cancelled on February 17, 2001.