

**THIS DISPOSITION
IS NOT CITABLE AS
PRECEDENT OF
THE TTAB**

Mailed: December 16, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

HBP, Inc.
v.
Becker Designs, Inc.

Opposition No. 91154068
to Application No. 76295465
filed on August 7, 2001

Martin J. Elgison and Andrew J. Wilson of Alston & Bird for
HBP, Inc.

Herbert L. Allen of Allen, Dyer, Doppelt, Milbrath &
Gilchrist for Becker Designs, Inc.

Before Walters, Holtzman and Kuhlke, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

HBP, Inc. filed its opposition to the application of
Becker Designs, Inc. to register the mark DAYTONA
THUNDERWEAR, in standard character form, for "clothing,

namely women's blouses and shorts," in International Class 25.¹

As grounds for opposition, opposer asserts that it is a wholly owned subsidiary of International Speedway Corporation ("ISC"); that ISC owns "an entire 'family' of marks comprised in whole or in part of the term DAYTONA" (Notice of Opposition, paragraph 1); that opposer is the exclusive licensee of this family of marks; and that applicant's mark, when applied to applicant's goods so resembles ISC's previously used and registered DAYTONA marks for promoting, organizing and conducting motorsports racing events and for a wide variety of goods as to be likely to cause confusion, under Section 2(d) of the Trademark Act.²

Applicant, in its answer, denies the salient allegations of the claim; and asserts that "the word 'Daytona' is primarily geographically descriptive as applied to applicant's mark DAYTONA THUNDERWEAR" (Answer, paragraph

¹ Application Serial No. 76295465, filed August 7, 2001, based upon use of the mark in commerce, alleging a date of first use as of January 26, 1996, and a date of first use in commerce as of February 28, 1997. The application includes a disclaimer of DAYTONA apart from the mark as a whole.

² Additionally, opposer alleges that ISC's family of DAYTONA marks are famous, and opposer asserts a claim of dilution. The Board notes, however, that opposer's allegation of dilution is legally insufficient, inasmuch as there is no allegation that its marks became famous prior to the filing date of the involved application. See *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000). See also, *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164 (TTAB 2001). Further, opposer presents no evidence in this regard or arguments regarding its dilution claim in its brief. Therefore, opposer's dilution claim has not been considered because it is not properly pled and it has not been tried by either the express or implied consent of the parties.

13); and that "the word 'Daytona' is in such widespread use as a prefix for business names in the Daytona area, as to afford no distinctiveness to any party when "Daytona" is used alone, instead of as a part of a composite mark such as Opposer's DAYTONA SPEEDWEEK mark" (Answer, paragraph 15).

The record consists of the pleadings; the file of the involved application; excerpts from a dictionary and an encyclopedia, and excerpts from various publications, all made of record by opposer's notice of reliance; and the testimony deposition by opposer of Susan Becker, applicant's president, with accompanying exhibits. The case was fully briefed, but a hearing was not requested.³

Opposer has established by its evidence⁴ that Daytona Beach is a Florida city formed in 1926 by the consolidation of the municipalities of Seabreeze, Daytona Beach and Daytona (notice of reliance exhibit nos. 1 and 2, *Webster's New Geographical Dictionary*, 1988, and *The New Encyclopaedia Britannica*, vol. 3, 1988); that Daytona Beach is noted for, *inter alia*, the Daytona International Speedway, a motorsports race track located therein (*id.*); that the Daytona 500 is a NASCAR race conducted at the Daytona International Speedway (notice of reliance exhibit nos. 3-7,

³ Confidential Exhibit A to opposer's reply brief was stricken by the Board's order of September 21, 2005. Thus, the exhibit has not been considered.

⁴ Whether applicant has made admissions regarding opposer in its answer and brief are discussed *infra*.

excerpts from various publications); and that the Daytona 200 is a motorcycle race conducted at the Daytona International Speedway (*id.*). The aforementioned various publications contain references to "Daytona 500" and "Daytona International Speedway" in connection with motorsports races as early as 1959.

Opposer did not submit status and title copies of the pleaded registrations; rather, opposer asserts that applicant's admissions make the registrations of record. Therefore, we must determine whether the asserted registrations may be considered to be part of the record in this proceeding. In paragraph 6 of its notice of opposition, opposer stated "HBP is the exclusive licensee of the following subsisting U.S. Service mark and Trademark Registrations issued by the [USPTO] and registration applications currently pending before the [USPTO] for the marks set forth below" and opposer listed thirty-one registrations, noting the marks, goods and other information. In corresponding paragraph 6 of its answer, applicant stated "applicant acknowledges that some of the registrations referred to in paragraph 6 have been issued, but is without knowledge as to the allegations in paragraph 6 and therefore denies same."

In paragraph 7 of its notice of opposition, opposer stated "the federal registrations for the foregoing DAYTONA

Marks are valid and subsisting in law, were duly and legally issued" In corresponding paragraph 7 of its answer, applicant stated "applicant denies the allegations of paragraph 7."

In paragraph 1 of its notice of reliance, opposer listed the same thirty-one registrations and stated its intention to rely thereon. In a footnote to paragraph one, opposer stated the following:

In its answer, respondent (*sic*) admitted that these registrations were issued by the [USPTO]. See Answer, paragraph 6. This admission is sufficient to make these registrations of record. [TBMP] §703.02(a) ("A federal registration owned by a plaintiff ... will be deemed by the Board to be of record in an inter partes proceeding if the defendant's answer to the complaint contains admissions sufficient for that purpose.")

In its brief, opposer alleges that applicant, in its answer, made sufficient admissions to make the claimed registrations of record in this proceeding.

In its brief (pp. 16-17), applicant makes the following statement about the registrations pleaded in the notice of opposition:

In the Notice of Reliance, 31 issued federal registrations are cited in support of the assertion of a likelihood of confusion. Two of these registrations (2,010,602 and 2,119,441) have been cancelled. Most significantly, however, Opposer's Registration No. 1,445,066 for the mark DAYTONA in a stylized form for wearing apparel issued only after the word "Daytona" was specifically disclaimed.

The following chart lists the nine cited "live" registrations that make any reference to wearing

apparel; of these registrations, only two are directed to the word DAYTONA alone for clothing (Registration Nos. 1,445,066 and 1,827,196), and of these, No. 1,445,066 contains a specific disclaimer of the word "Daytona." It is also noteworthy that the date of first use for the clothing listed in Registration No. 2,564,163 (DAYTONA AT THE SPEED OF LIGHT) is about five years *after* Mrs. Becker began utilizing her DAYTONA THUNDERWEAR mark as a sole proprietor.

Additionally, applicant specifically states in its brief (p. 20) that the nine above-noted registrations are owned by International Speedway, Inc.; and that opposer "has had ample opportunity during the two and a half years that this opposition has been pending to establish its standing as an exclusive licensee, and has failed to do so; simply put, there is not a scrap of evidence before the Board that [opposer] has standing to bring this opposition proceeding, other than the unsubstantiated allegations in its notice of opposition, which were denied by applicant."

In addition to meeting the broad requirements of Section 13 of the Trademark Act, an opposer must meet two judicially-created requirements in order to have standing -- the opposer must have a "real interest" in the proceedings and must have a "reasonable" basis for his belief of damage. *Ritchie v. Simpson*, 170 F.3d 1092; 50 USPQ2d 1023 (Fed. Cir. 1999).⁵

⁵ In its reply brief (pp. 6-7), opposer states that "standing has never been an issue in this proceeding, and applicant has offered no evidence to refute [opposer's] allegations of standing" and that "[opposer] presumed that [applicant] was satisfied with [opposer's] showing of standing." Opposer appears to be under the mistaken impression that

Thus, in order to establish standing in this case, not only must opposer establish the status and title of the pleaded registrations, but, if it is not the owner of record of the pleaded registrations, it must establish a viable relationship to that record owner. There is no question that neither applicant's vague assertions in paragraph 6 of its answer that "some of the registrations have been issued" nor applicant's unambiguous denial, in paragraph 7 of its answer, of the ownership and status of those registrations, constitutes an admission by applicant sufficient to make the pleaded registrations of record in this proceeding or to establish opposer's standing.

However, applicant listed in its brief nine of opposer's pleaded registrations, and discussed them in a manner that we deem to be an admission that these nine referenced registrations are valid and subsisting and, thus, of record.

While applicant treated these nine registrations as being of record, we do not find applicant's statements in either its answer or, as quoted above, in its brief to constitute an admission that opposer is the owner of these registrations or that opposer is otherwise entitled to rely

mere allegations of standing are sufficient at trial and that the burden is on applicant to contest opposer's standing. However, while opposer's allegations in its notice of opposition may be sufficient to withstand a motion to dismiss on the ground of lack of standing, the burden is on opposer to establish to the satisfaction of the Board, not applicant, that opposer, in fact, has standing as claimed.

on these registrations, as alleged in the notice of opposition. Furthermore, applicant expressly stated in its brief, as quoted above, that opposer has not established its relationship to the record owner of the registrations.⁶ Opposer has not introduced any evidence or testimony to establish any relationship to the record owner of the registrations or its right to rely on such registrations. We, therefore, conclude that opposer has not established its standing herein and, thus, cannot prevail on its claim of priority and likelihood of confusion.

Moreover, even if opposer had established its standing, there is absolutely no evidence of opposer's use of the pleaded registered marks in connection with the identified goods and services. Inasmuch as opposer is not the owner of the registrations, and hence cannot rely on them herein, it was incumbent upon opposer to prove priority of use in order to prevail upon its claim under Section 2(d). See *Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139 (TTAB 1986); and *Yamaha International Corp. v. Stevenson*, 196 USPQ 701 (TTAB 1977), affirmed in unpublished opinion, Appeal No. 78-525 (CCPA June 8, 1978), and cases cited therein. While it may well be that opposer used some or all of the DAYTONA marks in connection with various of the

⁶ We find that any further arguments by applicant against the claim of likelihood of confusion must be considered to have been made by applicant in the alternative.

specified goods and services prior to applicant's application filing date or prior to an earlier alleged date of first use, there is no specific evidence of such priority of use, or any use by opposer, in the record. Accordingly, we would be constrained to conclude that, in addition to failing to establish its standing, opposer has failed to prove a critical element of its ground for opposition, namely, the element of priority of use, and, thus, could not prevail herein.

Decision: The opposition is dismissed.