

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

Lykos

Mailed: August 26, 2008

Opposition No. 91164080

Omega SA

v.

Richard J. Oldenburg

Before Grendel, Taylor and Ritchie de Larena, Administrative
Trademark Judges.

By the Board:

On December 5, 2003, Richard J. Oldenburg ("applicant")
applied to register the mark OMEGA for "golf clubs, golf bags,
golf gloves, divot repair tools, golf ball markers, golf tees,
golf balls and non-motorized golf carts" in International Class
28, alleging a bona fide intent to use the mark in commerce.¹
Omega S.A. ("opposer") has opposed registration on the ground
that applicant's applied-for mark so resembles opposer's
previously used and registered marks that it is likely to cause
confusion, mistake, or deceive prospective consumers under
Section 2(d) of the Lanham Act. In its notice of opposition,
opposer pleaded

¹ Application Serial No. 78337297.

ownership of several registrations for goods involving watches, timepieces, and precision sport timing equipment. Opposer also pleaded ownership of an application (filed January 31, 2001) which, during the course of this proceeding matured into Registration No. 3146117 on September 19, 2006. The registration is for the mark displayed below:



for "retail store services featuring telephones, portable telephones, spectacles, sunglasses, magnifying glasses, watches, clocks, horological and chronometric instruments and their accessories, goods of precious metal or coated herewith [sic], precious stones, jewelry, articles of leather and imitation leather and morocco-dressing, traveling bags, umbrellas, pins not of precious metal, key rings of metal, knives, mirrors, stationary [sic], pens and pencils, bags and boxes of paper, clothing, head gear, textile goods, **golf equipment and accessories**, smoker's articles," in International Class 35, and alleges March 23, 2006 as the date of first use anywhere and in commerce (emphasis added).

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

On December 14, 2006, opposer filed a motion for summary judgment. The Board denied the motion on July 16, 2007, finding that opposer failed to sustain its burden on summary judgment. In its order, the Board noted that "[a]t a minimum, opposer has not established the absence of a genuine issue of material fact regarding the issue of priority" because it failed to establish both the current status of and title to its newly matured Registration No. 3146117. The Board also found that "opposer . . . failed to establish the absence of a genuine issue of material fact that it made common law usage of its mark in connection with the services identified in Registration No. 3146117 prior to applicant's constructive use date (that is, the filing date of applicant's application)." Lastly, the Board determined that "with regard to opposer's remaining pleaded registrations, genuine issues of material fact exist as to the relatedness of opposer's goods identified therein vis-à-vis the goods identified in applicant's application."

This case now comes before the Board for consideration of opposer's renewed motion for summary judgment (filed August 23, 2007). The motion is fully briefed.

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). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548 (1986). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial. The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial.

Based on the submissions of the parties, we find that opposer has met its burden of demonstrating that there are no

genuine issues of material fact, and that opposer is entitled to judgment as a matter of law.

A plaintiff moving for summary judgment in its favor on a Section 2(d) claim must establish that there is no genuine dispute that (1) it has standing to maintain the proceeding; (2) it is the prior user of its pleaded mark or marks or the owner of a previously used valid and subsisting federally registered mark; and (3) contemporaneous use of the parties' respective marks on their respective goods or services would be likely to cause confusion, mistake or to deceive consumers. See *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733 (TTAB 2001); *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

A. **Standing**

With regard to whether opposer has standing to maintain this proceeding, we note that applicant has not challenged opposer's standing to oppose the involved application. In view of opposer's pleaded Registration No. 3146117 which has now been properly made of record, we find that there is no genuine issue that opposer has a direct commercial interest in this proceeding, and that opposer has demonstrated its standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir.(2000); see also *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA).

B. **Priority**

As noted above, opposer has now properly made of record a status and title copy of its pleaded Registration No. 3146117. Thus, there is no genuine issue that opposer owns this registration, and that it is valid and subsisting. Accordingly, opposer's priority is not in issue. See *King Candy Co., supra*.

C. **Likelihood of Confusion**

Turning to the issue of likelihood of confusion, we are guided by the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Our determination of likelihood of confusion is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion.² In this case, the key factors are the degree of similarity between the parties' marks and respective goods and services, as well as trade channels. In conducting our analysis, we have concentrated our discussion on opposer's pleaded Registration No. 3146117, identified above, since it is the closest in terms of the mark and the services to applicant's mark and goods.

Considering first the marks, there is no genuine issue that both applicant's mark and opposer's mark share the term OMEGA.

² Our primary reviewing Court has held that only those *du Pont* factors shown to be material or relevant in the particular case and which have evidence submitted thereon are to be considered. See *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

The only difference between the marks is the addition of the Greek letter "Omega" to opposer's mark. Contrary to applicant's assertions, we find that the addition of the "Omega" symbol reinforces the word OMEGA in the mark. Accordingly, when the marks are compared in their entireties, the marks are similar in appearance, pronunciation, connotation and commercial impression. This *du Pont* factor favors a finding of likelihood of confusion.

We next turn to a consideration of the services. It is well settled that the question of likelihood of confusion must be determined based on an analysis of the goods identified in applicant's application vis-à-vis the services identified in opposer's pleaded registration. *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993). It is also well recognized that confusion is likely to occur from the use of the same or similar marks for goods, on the one hand, and for services involving those goods on the other. See *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE (stylized) for retail women's clothing store services and clothing held likely to be confused with CREST CAREER IMAGES (stylized) for uniforms). There is no genuine issue that, as identified, opposer's services include retail store services featuring golf equipment and accessories,

and that applicant's goods, as identified, consist of golf equipment. This *du Pont* factor also favors a finding of likelihood of confusion.

Lastly, regarding the channels of trade, the involved application is unrestricted. Thus, the Board must presume that the goods are marketed or will be marketed in all the normal channels of trade for the identified goods and to all the usual classes of purchasers of such goods, including those channels of trade and classes of purchasers targeted by opposer. *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981). Normal trade channels for golf equipment and accessories include retail stores. This *du Pont* factor therefore favors a finding of likelihood of confusion.

We have concentrated our discussion on the *du Pont* factors which the parties have discussed and/or on which we have evidence. To the extent that any other factors are applicable, we must treat them as neutral.

Inasmuch as opposer has demonstrated that there is no genuine issue of material fact, and that it is entitled to judgment as a matter of law, opposer's motion for summary judgment is granted; the opposition is sustained, and registration of applicant's mark is refused.