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Mailed:
August 24, 2007
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Volack
v.
The Enterprise Foundation, Inc.

Opposition No. 91168576
to Application Serial No. 78551444
filed on 1/21/2005

Wayne Volack, Pro Se.

Carole R. Klein of Morgan, Lewis & Bockius, and Gregory
Bedward, Esq. for The Enterprise Foundation, Inc.

Before Quinn, Kuhlke and Walsh, Administrative Trademark
Judges.

Opinion by Walsh, Administrative Trademark Judge:

Wayne Volack (opposer) has opposed the application by
The Enterprise Foundation, Inc. (applicant) to register the
mark shown below on the Principal Register for services
identified as "housing construction financing" in
International Class 36 and "planning, laying out, and
construction of environmentally-conscious housing
communities" in International Class 37.



The application was filed on January 21, 2005. Applicant has disclaimed the exclusive right to use "GREEN COMMUNITIES" in the application. Applicant entered the disclaimer in response to a requirement to do so based on a finding that GREEN COMMUNITIES was merely descriptive of the identified services. Applicant claims first use of the mark anywhere in both classes on February 23, 2004 and first use of the mark in commerce in both classes on September 29, 2004.

The Claims

Apparently opposer drafted the notice of opposition without the help of counsel. Consequently the claims are difficult to construe. We construe the notice liberally and afford opposer the benefit of the doubt where possible in our construction. According to our construction, the notice asserts claims of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), and dilution under Trademark Act Section 1125(c), 15 U.S.C. § 1125(c). Notice of Opposition at unnumbered pages 1 and 3. Opposer also appears to assert unfair-competition and infringement

claims, claims which we have no authority to consider. *Id.* at unnumbered page 4. See Trademark Act Section 1 *et seq.*, 15 U.S.C. § 1051 *et seq.* Accordingly, we give no further consideration to opposer's unfair competition and infringement claims.

As the basis for his claims opposer appears to assert that he used the GREEN COMMUNITIES word mark prior to the filing of the opposed application in conjunction with services he identified in his abandoned Application Serial No. 76099278 as "community of environmentally built friendly structures utilizing green building codes involving like minded individuals concerning green/environment related issues." Notice of Opposition at 1 and attached "fig 1." In the notice of opposition opposer also states, "Petitioner's distinctness (sic) capable of distinguishing from other marks (sic) are the words 'Utilizing Green Building Codes.'" (Emphasis in the original.)

In its answer applicant has denied the salient allegations in the notice of opposition.

Both opposer and applicant have filed briefs.

The Record

The record in this case consists of the file of the opposed application, the pleadings, opposer's notice of reliance and opposer's testimonial deposition of Mr. Volack with exhibits. We will discuss certain problems with

opposer's evidence below. Applicant did not submit any evidence, nor did applicant object to any of opposer's evidence.

Standing

Although applicant has not challenged opposer's standing, opposer's standing is a threshold inquiry we must consider in every inter partes case. In *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999), the Federal Circuit has enunciated a liberal threshold for determining standing, i.e., whether one's belief that one will be damaged by the registration is reasonable and reflects a real interest in the case. See also *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987); and *Lipton Industries, Inc. v. Ralston Purina Company*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

In our discussion above we construe opposer's notice of opposition liberally to include a pleading which is sufficient for standing purposes. Opposer has submitted evidence he apparently believes would suffice to show his use of and senior rights in the GREEN COMMUNITIES mark in connection with certain goods or services. While the evidence is problematic to say the least for reasons discussed below, under the liberal standard for standing we will accept opposer's evidence as sufficient for this

limited purpose and proceed to our consideration of priority.

Likelihood of Confusion - Priority

Because applicant failed to offer any evidence during its testimony period, the earliest date of first use upon which applicant can rely is the filing date of its application, that is, January 21, 2005. *Lone Star Manufacturing Co., Inc. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (CCPA 1974). On the other hand, in the absence of pleading and showing current ownership of a relevant registration, opposer must show through competent evidence that he established rights in his pleaded mark prior to applicant's filing date to prevail on his likelihood of confusion claim. *Floralife, Inc. v. Floraline International Inc.*, 225 USPQ 683, 684 (TTAB 1984). If opposer fails to show priority, his likelihood of confusion claim fails. Opposer bears the burden of establishing his priority, and other elements of his case, by a preponderance of the evidence. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002). We conclude that opposer has failed to establish his priority.

In considering opposer's evidence regarding priority we have reviewed the entire record, and in particular, any evidence which might bear on priority, that is, opposer's use of the GREEN COMMUNITIES mark prior to applicant's

filing date. We will discuss only the specific evidence which appears to relate most directly to the issue of opposer's use of the GREEN COMMUNITIES mark prior to the filing date of the opposed application. As our discussion indicates, even that evidence falls far short of what is required to show prior use and priority.

First, we will consider evidence which is in any way relevant to opposer's use of the mark in Mr. Volack's testimonial deposition. Mr. Volack proceeded here without assistance from counsel. Mr. Volack presented his testimony by answering questions posed to him by the court reporter. Applicant did not take part in the testimonial deposition. Therefore, no objections were raised, and there was no cross examination. Thus, applicant waived its rights to object both to the testimony and the exhibits presented during the testimony. *See CareFirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1500 (TTAB 2005).

The testimony most relevant to the issue of opposer's prior use and priority follows:

Q. - Please tell the Court all marketing efforts with regards to plaintiff's use of the mark Green Communities since July 31, 2000.

A. - I have used primarily the channels of trade of the Internet with all five related Green Communities suffixes. Examples of the suffixes are .com, .net, .info, .org, and .us. I have been advertising green communities built by third parties and utilizing third-party verifiable green building codes. I have an exhibit also to submit to the Court.

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(Discussion off the record.) (Deposition exhibits A through E, 2, 4, 6, 8, 10, F, 43, 54, 55, 58 through 60, 64, 13 through 25, and 28 through 33 were marked.)
...

Q. - Plaintiff's mark appears to be descriptive. Please tell the Court why Green Communities is not descriptive.

A. - The text word "Green Communities" has become suggestive and distinctive with plaintiff over the last five years with continuous Internet use with third parties relating to construction and financing utilizing state green building codes. State green building codes are the distinctive element to Plaintiff's mark. And I would like to submit Exhibit C to the Court to show the distinctiveness of Plaintiff's mark Green Communities.

Q. - Please tell the Court if Plaintiff is aware if Green Communities Internet suffixes, i. e., .com, .net, .org, .us, and .info have any relevant significance to this case.

A. - Yes, they do. I monitor and own all suffixes with this domain, Green Communities. I would like to submit Exhibit D to the Court.

Volack Test. at 5-7.

Throughout his testimony, as evidenced by this excerpt, Mr. Volack fails to lay a foundation for, or otherwise discuss, his exhibits. Therefore, we consider the specific exhibits without the benefit of any information with regard to their origin or significance. Here again, we have considered any exhibit which could in any way arguably relate to opposer's use of the GREEN COMMUNITIES mark. The exhibits filed with Mr. Volack's testimony appear to bear additional markings which do not correspond precisely to the letters and numbers he identifies in his testimony. Under

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the circumstances, it is not possible to ascertain whether all of the exhibits under the numbers referenced in his testimony were filed.

An exhibit marked Exhibit 1 and "fig 1" consists of a copy of a USPTO automated record from the TESS data base showing certain information regarding Application Serial No. 76099278, referenced above. This appears to be the application opposer filed on July 31, 2000 for the GREEN COMMUNITIES mark for "community of environmentally built friendly structures utilizing green building codes involving like minded individuals concerning green/environment related issues." The application was apparently amended to the Supplemental Register on July 30, 2001 and became abandoned on November 22, 2002. This abandoned application has no probative value with regard to opposer's use of the GREEN COMMUNITIES mark or priority. Even if the application were active, it would not serve as evidence of the facts alleged in the application, but only of the fact that the application was filed. *Lasek & Miller Assoc. v. Rubin*, 201 USPQ 831, 833 n.3 (TTAB 1978). *Cf. Bonomo Culture Institute, Inc. v. v. Mini-Gym, Inc.*, 188 USPQ 415, 416 (TTAB 1976) (expired registration is not evidence of rights in a mark).

An exhibit marked as Exhibit A and "fig A" consists of a single page showing use of the GREEN COMMUNITIES mark at

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the top with a TM symbol. It appears to be a copy of an Internet web page, though it does not include a URL line. It includes the statement "Welcome - Green communities are energy efficient communities constructed utilizing established green building codes." It also includes what appear to be "buttons" linked to additional pages and links to related sites, a list of states and news items. The only dated item on the page states, "Congress members call for support of State Global Warming Clean Car Efforts (9/26/06)." There is no mention of opposer. This page has no probative value with regard to opposer's use of the phrase GREEN COMMUNITIES as a mark or priority.

An exhibit marked as Exhibit D and "fig D" consists of copies of what appear to be Internet pages associated with GO DADDY.com, again without URL lines, with the notation "Search the whois database." at the top of each. The pages appear to reflect domain name registrations for the GREENCOMMUNITIES.COM, GREENCOMMUNITIES.NET, GREENCOMMUNITIES.ORG, GREENCOMMUNITIES.INFO, and GREENCOMMUNITIES.US Internet domain names. Each shows only an address after "Registrant" with no name, with the exception of the GREENCOMMUNITIES.INFO page which shows Wayne Volack as registrant with the same address as listed in the other records. Each page identifies "volack, wayne" as both the administrative and technical contacts. These

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pages have no probative value with regard to opposer's use of the phrase GREEN COMMUNITIES as a mark or priority.

The mere registration of a term as a domain name does not establish any trademark rights. *Brookfield*

Communications Inc. v. West Coast Entertainment Corp., 174 F.3d 1036, 50 USPQ2d 1545, 1555 (9th Cir. 1999).

Furthermore, the mere use of a domain name, only as a domain name, likewise does not establish trademark use. *In re Eilberg*, 49 USPQ2d 1955, 1956 (TTAB 1998).

Turning to opposer's notice of reliance, we note at the outset that many of the documents opposer submitted under his notice of reliance are not the types of documents which the rules permit to be filed in this manner. Trademark Rule 2.122), 37 C.F.R. § 2.122. Nonetheless, in the absence of any objection, we have exercised our discretion and considered all of the documents opposer filed under the notice of reliance.

The first set of documents opposer submits under the notice consists of copies of applicant's responses to opposer's interrogatories. We have considered all of the responses. We find nothing in these responses which in any way constitutes evidence of opposer's use of its mark, let alone use prior to applicant's filing date.

Secondly, in his notice of reliance opposer refers to a group of documents he submitted previously attached to his

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notice of opposition, but opposer does not include copies of those documents with the notice of reliance. Opposer apparently expected that we would simply refer to the notice of opposition for this purpose.

We note that, subject to certain exceptions not relevant here, "... an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony." 37 C.F.R. § 2.122(c). Again, in the absence of any objection, we will exercise our discretion and we will consider the exhibits attached to opposer's notice of opposition as if they had been submitted with its notice of reliance.

We also note for the record that most of the exhibits are not proper subject matter for submission under a notice of reliance. The rule, in relevant part, limits documents filed in this manner to:

(e) *Printed publications and official records.* Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the

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official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Patent and Trademark Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.

37 C.F.R. § 2.122(e).

Opposer has neither identified the specific documents nor explained their relevance. Again, we will not enforce this formality here. We will consider the documents to the extent we are able to do so without the usual foundation. The documents consist of: a copy of the USPTO TESS automated record related to opposer's abandoned application for GREEN COMMUNITIES, discussed above; similar records related to other abandoned applications filed by opposer for marks other than GREEN COMMUNITIES; a series of what appear to be email messages from third parties to opposer; and a series of what appear to be copies of pages obtained from various Internet sites and similar documents. While certain of these documents would be excluded under the rules, in the absence of objection from applicant we have considered them. We find no evidence in these documents which in any way establishes opposer's use of the phrase GREEN COMMUNITIES as a mark prior to the filing date of the opposed application.

Lastly, with his notice of reliance opposer submitted, under a claim of confidentiality, what appear to be recent

reports with statistics regarding "views" and "clicks" related to certain "greencommunities" domain names, and other domain names. Exhibits XXX and ZZZ. Some of the reports bear 2006 dates, others are undated. Here too, we have no foundation for the consideration of these documents. And again, the documents generally do not appear to be among the types we would consider proper under a notice of reliance. However, in the absence of an objection, we have considered them. We find no evidence in these documents which supports opposer's use of GREEN COMMUNITIES as a mark prior to the filing date of the opposed application.

In sum, we have considered all of the evidence opposer submitted in this proceeding and find no evidence to support his claim that he used the phrase GREEN COMMUNITIES as a mark prior to the filing date of the opposed application with regard to any goods or services. Accordingly, we dismiss opposer's likelihood of confusion claim.

Dilution

Under Section 43(c) of the Trademark Act the threshold requirement for a party asserting dilution in a Board proceeding is a showing that the mark at issue is both distinctive and famous. 15 U.S.C. § 1125(c). Dilution is an extraordinary remedy which applies to only a select class of marks which are highly distinctive and which have achieved the ultimate in fame. *Toro Co. v. ToroHead Inc.*,

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61 USPQ 1164, 1173 (TTAB 2001). A party claiming dilution must show that its mark became famous before the defendant, here applicant, filed the opposed application. *Id.* at 1174 n.9. The Board applies a rigorous test in evaluating whether the mark is sufficiently distinctive and famous. *Id.* at 1176.

In this case opposer has neither pleaded that his mark is famous nor submitted any evidence to show that he used the mark prior to the filing date of the opposed application nor that his mark became distinctive and famous before the filing date of the opposed application.

In sum, we find that opposer has failed to make the necessary claims to properly plead dilution and that opposer has failed to show either prior use or the distinctiveness and fame required to maintain a dilution claim.

Accordingly, we dismiss opposer's dilution claim.

Decision: The opposition is dismissed.