

**THIS OPINION
IS NOT A PRECEDENT
OF THE TTAB**

Mailed: May 30, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

RWI Resources, LLC
v.
Matt Erlich and Shlomo Fried

Opposition No. 91173658
to application Serial No. 78784098
filed on January 3, 2006

Molly B. Markley of Young Basile Hanlon MacFarlane & Helmholdt, P.C. for RWI Resources LLC.

Matt Erlich and Shlomo Fried, pro se.

Before Taylor, Mermelstein and Bergsman, Administrative
Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Matt Erlich and Shlomo Fried, a partnership organized under the laws of the state of New York, have filed an application to register on the Principal Register the mark ZIPCAL (in standard character form) for "drinking water, flavored water, carbonated and non-carbonated," in Class 32.¹

¹ Serial No. 78784098, filed on January 3, 2006, based on an allegation of a bona fide intention to use the mark in commerce.

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Registration has been opposed by RWI Resources LLC on the ground of a likelihood of confusion with its mark ZIPTIDE. Opposer specifically alleges, in pertinent part, that since at least as early as August 24, 2006, it has used the mark ZIPTIDE in connection with the sale of beverages; that it is the owner of pending Application Serial No. 78453223 for the mark ZIPTIDE, filed on July 20, 2004, for "beverages, namely, flavored and non-flavored sparkling water, spring water, caffeinated and non-caffeinated drinks with or without fruit flavoring, smoothies and caffeinated and non-caffeinated tea"; and that applicant has not used the ZIPCAL mark on its goods prior to opposer's filing date of July 20, 2004, which is well before the January 3, 2006 filing date of applicant's involved application. Opposer further alleges that "[i]f applicant is permitted to use and register the ZIPCAL mark for its goods as specified in the opposed application, confusion in trade resulting in damage and injury to Opposer would be caused and would result by reason of the fact that Applicant's mark is confusingly similar to Opposer's mark." (Notice of Opposition, ¶ 11).²

² Opposer also pleaded ownership of Application Serial No. 77000651 for the mark ZIPTEA for use in connection with beverages. (Notice of opposition, ¶ 7). However, we note that opposer did not plead a likelihood of confusion with respect to the mark in that application and only referenced this application in its brief when describing the record, as explained *infra*.

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Applicant's answer is in the nature of a general denial of the essential allegations of the notice of opposition.

Neither opposer nor applicant took testimony. Rather, during the testimony period, opposer sought to make of record, by notice of reliance, four exhibits labeled Appendixes A through D. Specifically, opposer seeks to rely on: (A) a "soft" copy and a TESS copy of Registration No. 3177913 which issued from opposer's pleaded Application Serial No. 78453223; (B) a Notice of Allowance for application Serial Number 77000651; (C) a "label of use of Opposer's mark on water as listed in ingredients shown on the label" (Notice of reliance, p. 2); and (D) a copy of opposer's first set of requests for admissions which opposer maintains applicant failed to respond to.³ However, the exhibits referenced as Appendix A and Appendix C are not appropriate for introduction under a notice of reliance.

Trademark Rule 2.122(d) provides the manner in which an opposer may properly make its registration of record. While subsection (d)(1) of the rule was amended to permit submission of information from databases of the United States Patent and Trademark Office (USPTO) pertaining to current status and title of a pleaded registration as an alternative to the submission of a formal status and title

³ The two admission requests pertain to applicant's intention to use the mark ZIPCAL on water and that such mark had not been used prior to July 20, 2004.

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copy of such registration, that amendment is applicable only to proceedings commenced on or after August 31, 2007. See Trademark Rule 2.122(d)(1) as amended, effective August 31, 2007, Miscellaneous Changes to Trademark Trial and Appeal Board Rules, 72 Fed. Reg. 42,242 (Aug. 1, 2007).

Accordingly, the text of Trademark Rule 2.122(d) as quoted below is applicable to this case:

- (1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies (originals or photocopies) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. For the cost of a copy of a registration showing status and title, see §2.6(b)(4).
- (2) A registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification during the taking of testimony or by filing a notice of reliance, which shall be accompanied by a copy (original or photocopy) of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. The notice of reliance shall be filed during the testimony period of the party that files the notice.

With regard to the soft copy of Registration No. 3177913, it is not a copy prepared by the Office showing current status

of and current title to the registrations. With regard to the TESS copy of that registration, it may not be submitted as an alternative to a formal status and title copy of such registration. Accordingly, opposer's registration is not properly of record.

As regards opposer's product label, inasmuch as it is neither a printed publication available to the general public nor an official record, it may not be made of record by notice of reliance. See Trademark Rule 2.122(e); 37 C.F.R. § 2.122(e). See also, TBMP sections 704.02 and 704.07 (2d ed. rev. 2004).

Thus, Appendix A and C have not been considered in this decision.

In addition to Appendixes B and D of opposer's Notice of Reliance, the record includes the pleadings⁴ and the file of opposed Application Serial No. 78784098. Only opposer filed a brief on the case.

Section 13 of the Trademark Act, 15 U.S.C. Section 1063, provides that an opposition may be brought by "[a]ny

⁴ While opposer attached to its notice of opposition printouts from the TESS data base concerning its pleaded Application Serial Nos. 78453223 (ZIPTIDE) and 77000651 (ZIPTEA), under Trademark Rule 2.122(c), exhibits attached to pleadings generally are not evidence on behalf of the party to whose pleading such are attached unless they are identified and introduced in evidence during the period for taking testimony. The sole exception, not applicable in this case, is a current status and title copy, prepared by the USPTO, of a plaintiff's pleaded registration. See Trademark Rule 2.122(d)(1); and TBMP §§ 317, 704.03(b)(1)(A) and 704.05(a)(2d ed. rev. 2004). Accordingly, the exhibits have not been considered in this decision.

person who believes that he would be damaged by the registration of a mark....” The party opposing the registration of the mark must prove two elements: (1) that it has standing, and (2) that there is a valid ground to prevent the registration of the opposed mark. *Young v. AGB Corp.*, 153 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998).

The standing question is a threshold inquiry made by the Board in every inter partes case. That is, standing is an essential element of an opposer’s case which, if not proved at trial, will defeat an opposer’s claims. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); and *No Nonsense Fashions, Inc. v. Consolidated Foods Corp.*, 226 USPQ 502 (TTAB 1985). See also: *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000); and *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999).

In this case, the notice of opposition includes a proper allegation of opposer’s standing. More specifically, as noted previously, opposer has alleged that since at least as early as August 24, 2006, it has used the mark ZIPTIDE in connection with the sale of beverages, including water. Allegations alone, however, do not establish standing. See *Richie v. Simpson, supra* at 1029. First, applicant did not make any admissions in its answer that would excuse opposer from having to prove, as part of its case in chief, its

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standing in this proceeding. Indeed, opposer, in describing the record, acknowledged that "the response [to the notice of opposition] does not clearly admit or deny any of Opposer's allegations." (Brief, p. 2). Second, opposer failed, at trial, to take any testimony or properly introduce any other evidence to prove its standing to bring this opposition (e.g., a copy of its registration prepared by the Office showing current status and current title to the registration, or testimony that opposer has used the mark ZIPTIDE for beverages). As noted earlier, opposer did not plead likelihood of confusion with respect to the mark in application Serial No. 77000651. Even if it did so, the notice of allowance issued in connection therewith would not give opposer standing. In addition, opposer's request for admissions does not relate to opposer's standing. Under the circumstances, we find that opposer has failed to prove its standing.

Since opposer has not established its standing to maintain this proceeding, opposer has shown no right to relief on its claim of likelihood of confusion.

Decision: The opposition is dismissed with prejudice for opposer's failure to prove its standing.