

THIS OPINION IS NOT  
PRECEDENT OF THE  
TTAB

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

Mailed: September 17, 2008

Skoro

Opposition No. 91178614

Fifth Third Bancorp

v.

Hopkins, J Nathan

**Before Grendel, Kuhlke and Cataldo,  
Administrative Trademark Judges.**

By the Board:

An application has been filed by J. Nathan Hopkins to register the mark 5TH3RD for "musical instruments" in Class 15.<sup>1</sup>

Registration has been opposed by Fifth Third Bancorp on the grounds of a likelihood of confusion, dilution and no bona fide use of the mark by applicant for the identified goods.<sup>2</sup>

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<sup>1</sup> Application Serial No. 78832594, filed on March 8, 2006, claiming a date of first use and first use in commerce of February 14, 2000.

<sup>2</sup> In support of these grounds opposer has claimed ownership of numerous registrations containing the mark FIFTH THIRD and states that "opposer adopted and has continuously used since that adoption, the inherently distinctive marks FIFTH THIRD BANK and FIFTH THIRD" for banking and other financial products and services. (Notice ¶ 4). Opposer also is the registered owner of numerous domain names that incorporate the terms "FIFTH THIRD". (Notice ¶ 6).

This case now comes up on opposer's motion for summary judgment solely on the ground that applicant has not made a bona fide use of his mark in commerce. The motion has been fully briefed.

Opposer argues that applicant's only use of his mark is as a web site "shell" with the domain name 5th3rd.com which links customers to other websites of unrelated vendors; that he has never offered and does not offer for sale any goods or services under the mark; that he has no proof of any sale under his mark; and that the sole use of the mark is as a web site. Opposer states that applicant has failed to produce any evidence that actually demonstrates sale of a musical instrument under the mark, thereby rendering the application *void ab initio*. Opposer supports his motion with the affidavit of John C. Greiner, counsel for opposer, with accompanying exhibits including applicant's responses to its discovery requests, business records from Net Music Deals produced by applicant, and printouts from applicant's web site, all showing use of applicant's mark in connection with a web site that links customers to the sale of music-related books and videos, not musical instruments.

Applicant responds (pro se)<sup>3</sup> stating the "Net Music Deals" is the legal name for his retail music supply

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<sup>3</sup> It is recognized that applicant is proceeding pro se. However, strict compliance with the Trademark Rules of Practice, and where applicable, the Federal Rules of Civil Procedure, is expected of

company; and that his 5TH3RD.com web site is "used to promote and sell [] 'musical goods' and services since its creation in February, 2000". (Resp. Br. at 2; Interrogatory responses to numbers 1, 3, 4 and Request for Admission No. 18).<sup>4</sup>

In a motion for summary judgment, the moving party has the burden of establishing the absence of any genuine issues of material fact and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). Once the moving party has satisfied this burden, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by affidavit or as otherwise provided in Fed. R. Civ. P. 56, showing that there is a genuine factual dispute for trial. See TBMP §528.01 and cases cited therein. In considering the propriety of summary judgment, all evidence must be viewed in a light favorable to the nonmovant, and all justifiable inferences are to be drawn in the nonmovant's favor. The Board may not resolve issues of material fact; it may only ascertain whether such issues are present. See *Lloyd's Food Products*

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all parties before the Board, whether or not they are represented by counsel. It is recommended that applicant review or obtain a copy of the latest edition of Title 37 of the Code of Federal Regulations, which includes the Trademark Rules of Practice, and is available on our website at [www.uspto.gov](http://www.uspto.gov).

<sup>4</sup> Pertinent documents that applicant attached as exhibits to his response, although not supported by an affidavit, are documents showing his ownership of the domain name, and the use of the mark on the web site in connection with music-related books and videos.

Opposition No. 91178614

*Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

The record shows that opposer uses the mark Fifth Third in connection with, inter alia, banking and investment consultation services and has established its standing to bring this opposition.<sup>5</sup>

An application filed under Section 1(a) of the Trademark Act must include a statement specifying when the mark was first used in commerce with the identified goods, and that the mark is in use in commerce as of the filing of the application. "Use in commerce" is defined as "the bona fide use of a mark in the ordinary course of trade, and not

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<sup>5</sup> Applicant submitted drafts of a licensing agreement proffered by opposer, a copy of a decision by WIPO discussing who opposer is, and correspondence between the two parties. It is noted that in its reply, opposer moved to strike these documents as irrelevant and immaterial. While that motion is uncontested, these materials provide sufficient evidence to demonstrate opposer's use of FIFTH THIRD for banking services and establishes its standing, so the motion to strike is denied. The better practice would have been for opposer to provide proof of status and title of its pleaded registrations by filing copies of records from USPTO electronic databases. See Trademark Rule 2.122(d)(1).

Further, although opposer's pleaded claim of a likelihood of confusion is not before us, it is not wholly without merit, providing an additional ground for standing. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982)

made merely to reserve a right in a mark." Trademark Act Section 45, 15 U.S.C. § 1127.

On the record before us applicant has provided no evidence upon which the Board can make a determination that a genuine issue of material fact exists. The subject application is for musical instruments. The mark must be shown to be used on the sale or manufacture of musical instruments, not a web site.<sup>6</sup> Applicant has not provided any evidence of use of the mark on musical **instruments** to support an application based on use under Section 1(a). See also *Linville v. Rivard*, 41 USPQ2d 1731 (TTAB 1996). Thus, opposer has carried its burden on summary judgment and applicant has not rebutted it.

After careful review of the record before us, we find that there is no genuine issue of material fact as to applicant's failure to make bona fide use of the mark in commerce on musical instruments, thereby rendering the application *void ab initio*. Opposer's motion for summary

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<sup>6</sup> During the prosecution of the application, when applicant provided a printout of its web site, the examining attorney refused the same as a specimen of actual use of the mark for musical instruments. When applicant then attempted to amend his identification of goods to providing sales over the internet, that was refused in that it exceeded the scope of the original identification of goods. It is noted, however, that applicant happened upon the submission of acceptable specimens when he took a photograph of guitars and a keyboard with stickers of the mark on them. We further note that allegations and documents in an application file are not evidence unless and to the extent they have been identified and introduced in evidence. *Omega SA v. Compucorp.*, 229 USPQ 191, 195 (TTAB 1985).

Opposition No. 91178614

judgment is hereby granted, registration is refused and the  
opposition is sustained.