

ESTTA Tracking number: **ESTTA1270213**

Filing date: **03/06/2023**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	91213597
Party	Plaintiff Caterpillar, Inc.
Correspondence address	NARESH KILARU FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE NW WASHINGTON, DC 20001 UNITED STATES Primary email: docketing@finnegan.com Secondary email(s): laura.johnson@finnegan.com , ttab-legal-assistants@finnegan.com , naresh.kilaru@finnegan.com 202-408-4000
Submission	Rebuttal Brief
Filer's name	Naresh Kilaru
Filer's email	laura.johnson@finnegan.com , ttab-legal-assistants@finnegan.com , naresh.kilaru@finnegan.com , docketing@finnegan.com
Signature	/Naresh Kilaru/
Date	03/06/2023
Attachments	2022.03.06 REDACTED Opposer's Reply Trial Brief - PUBLIC.pdf(924692 bytes) Exhibit A - Cases REDUCED.pdf(5114443 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

CATERPILLAR INC., Opposer, v. TIGERCAT INTERNATIONAL, INC., Applicant.	Opposition No. 91213597 Application No. 85/814,584 Mark: TIGERCAT Filing Date: January 3, 2013
--	---

OPPOSER'S REPLY TRIAL BRIEF

REDACTED

Date: March 6, 2023

Naresh Kilaru
Laura K. Johnson
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
901 New York Avenue, NW
Washington, DC 20001-4413
Telephone: 202-408-4000

docketing@finnegan.com
naresh.kilaru@finnegan.com
laura.johnson@finnegan.com
TTAB-Legal-Assistants@finnegan.com

Attorneys for Caterpillar Inc.

TABLE OF AUTHORITIES

Cases	Page(s)
<i>Allen v. Zavaras</i> , No. 10-cv-01510, 2011 WL 386668 (D. Colo. Feb. 2, 2011)	17
<i>Amazon Techs., Inc. v. Foxconn Interconnect Tech. Ltd.</i> , 2020 TTAB LEXIS 159 (TTAB Apr. 9, 2020)	7
<i>AMF Inc. v. Am. Leisure Prods.</i> , 474 F.2d 1403 (CCPA 1973)	14
<i>Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.</i> , 115 USPQ2d 1816 (TTAB 2015)	5
<i>Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.</i> , 123 USPQ2d 1844 (TTAB 2017)	17, 18, 20
<i>In re Bed & Breakfast Registry</i> , 791 F.2d 157, 229 USPQ 819	8
<i>Bleck v. City of Alamosa Colo.</i> , No. 10-cv-03177, 2012 WL 695138 (D. Colo. Mar. 5, 2012)	19
<i>Blue Cross & Blue Shield Ass'n v. Harvard Cmty. Health Plan, Inc.</i> , 17 USPQ2d 1075 (TTAB 1990)	7
<i>Blue Man Prods., Inc. v. Tarmann</i> , 75 USPQ2d 1811 (TTAB 2005),	8
<i>In re Bose Corp.</i> , 580 F.3d 1240 (2009)	7
<i>Bose Corp. v. Hexavave, Inc.</i> , 88 USPQ2d 1332 (TTAB 2007)	7
<i>Bose Corp. v. QSC Audio Prods. Inc.</i> , 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002)	5, 7
<i>Broadcasting Network Inc. v. ABS-CBN Int'l</i> , 84 USPQ2d 1560 (TTAB 2007)	6
<i>Brooklyn Brewery Corp. v. Brooklyn Brew Shop</i> , 17 F.4th 129, 2021 USPQ2d 1069 (Fed. Cir. 2021)	21
<i>Carril v. United States</i> , No. 19-cv-24561, 2021 WL 3556385 (S.D. Fla. July 14, 2021)	17
<i>Caterpillar Inc. v. Kelly</i> , 2015 TTAB LEXIS 21 (TTAB Sept. 30, 2015)	4, 12, 15
<i>Caterpillar Inc. v. Pave Tech, Inc.</i> , Cancellation No. 92041776, TTAB Order at p. 14 (Mar. 12, 2007)	3, 7
<i>Caterpillar Tractor Co. v. Gehl Co.</i> , 177 USPQ 343 (TTAB 1973)	12
<i>CDOC, Inc. v. Liberty Bankers Life Ins. Co.</i> , 844 F. App'x 357 (Fed. Cir. 2021)	7
<i>Champagne Louis Roederer, S.A. v. Delicato Vineyards</i> , 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998)	7
<i>Coach Servs. Inc. v. Triumph Learning LLC</i> , 101 USPQ2d 1713 (Fed. Cir. 2012)	8
<i>Cont'l Nat'l Bank of Miami v. Morgan</i> , 2007 TTAB LEXIS 247 (TTAB Mar. 23, 2007)	22
<i>In re Copeland-Smith</i> , 791 F. App'x. 898, 2019 USPQ2d 433159 (Fed. Cir. 2019)	11, 14
<i>Data Packaging Corp. v. Morning Star, Inc.</i> , 212 USPQ 109 (TTAB 1981)	19
<i>Dena Corp. v. Belvedere Int'l, Inc.</i> , 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991)	5
<i>Double Coin Holdings LTD. v. Tru Dev.</i> , Canc. No. 92063808, 2019 WL 4877349 (TTAB Oct. 1, 2019)	17
<i>Downs v. River City Grp., LLC</i> , No. 11-cv-00885, 2014 WL 814303 (D. Nev. Feb. 28, 2014)	18
<i>In re FCA US LLC</i> , 126 USPQ2d 1214, 1217 (TTAB 2018)	10, 14, 15
<i>Flex Ltd. v. Spireon, Inc.</i> , 2022 TTAB LEXIS 38 (TTAB Feb. 10, 2022)	7
<i>G&W Labs., Inc. v. G W Pharma Ltd.</i> , 2010 TTAB LEXIS 80 (TTAB Feb. 16, 2010)	9
<i>Glass Dimensions, Inc. v. State Street Bank & Trust Co.</i> , 290 F.R.D. 11 (D. Mass. 2013)	18
<i>GTFM, Inc. v. Fresh Body, LLC</i> , No. 91209621, 44 TTABVUE 8 (TTAB March 4, 2016)	22
<i>In re Guild Mortg. Co.</i> , 2020 USPQ2d 10279 (TTAB 2020)	16
<i>In re Guild Mortg. Co.</i> , 912 F.3d 1376 (Fed. Cir. 2019)	16
<i>Haggar Co. v. Hugger Corp.</i> , 172 USPQ 253 (TTAB 1971)	21, 23
<i>In re Hearst Corp.</i> , 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992)	8
<i>Helene Curtis Indus. Inc. v. Suave Shoe Corp.</i> , 13 USPQ2d 1618 (TTAB 1989)	19

<i>In re i.am.symbolic, LLC</i> , 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017).....	16
<i>Industria de Diseno Textil, S.A. v. Benzara Inc.</i> , 2022 TTAB LEXIS 163 (TTAB Apr. 13, 2022)	7
<i>Jack Wolfskin Ausrustung v. New Millennium Sports, S.L.U.</i> ,797 F.3d 1363 (Fed. Cir. 2015)	14
<i>Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC</i> , 857 F.3d 1323, (Fed. Cir. 2017)	1
<i>Kicking Horse Coffee Co. v. Critchley</i> , 2019 WL 982905 (TTAB Feb. 28, 2019).....	14
<i>In re Kysela Pere et Fils, Ltd.</i> , 98 USPQ2d 1261 (TTAB 2011)	11
<i>Made in Nature, LLC v. Pharmavite LLC</i> , 2022 TTAB LEXIS 228 (TTAB June 15, 2022)	22
<i>Mag Instrument, Inc. v. The Brinkmann Corp.</i> , 96 USPQ2d 1701 (TTAB 2010)	17, 21
<i>In re Majestic Distilling Co.</i> , 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003)	16
<i>Mariah Media, Inc. v. Carnahan</i> , 2002 WL 31528569 (TTAB Nov. 13, 2002)	8
<i>Monster Energy Co. v. Monster Towel LLC</i> , 2020 479 (TTAB Nov. 2, 2020).....	11
<i>Monster Energy Co v. Pimmonster LLC</i> , 2022 TTAB LEXIS 6 (TTAB Jan. 6, 2022).....	7
<i>Mr. Hero Sandwich Sys., Inc. v. Roman Meal Co.</i> , 781 F.2d 884, 228 USPQ 364 (Fed. Cir. 1986)	8
<i>N.Y. Yankees P'ship v. IET Prods. & Servs., Inc.</i> , 114 USPQ2d 1497 (TTAB 2015).....	21
<i>Nat'l Cable Television Ass'n v. Am. Cinema Editors, Inc.</i> , 937 F.2d 1572 (Fed. Cir. 1991)	11
<i>New Era Cap Co. v. Pro Era, LLC</i> , 2020 U.S.P.Q.2D (BNA) 10596 (TTAB May 29, 2020).....	16
<i>Newegg Inc. v. Schoolhouse Outfitters, LLC</i> , 118 USPQ 1242 (TTAB 2016)	18
<i>Olivero v. Trek Bicycle Corp.</i> , No. 2018 WL 3459424 (D. Colo. July 18, 2018).....	18, 19
<i>Omaha Steaks Int'l v. Greater Omaha Packing Co.</i> , 908 F.3d 1315, 128 USPQ2d 1686 (Fed. Cir. 2018).....	10, 11
<i>Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772</i> , 396 F.3d 1369, 1375 (Fed. Cir. 2005).....	1, 2, 10
<i>Pierce-Arrow Soc'y v. Spintek Filtration, Inc.</i> , 2019 USPQ2d 471774 (TTAB 2019)	15
<i>Principle Bus. Enterprises, Inc. v. DML Marketing Group, Ltd.</i> , 2018 WL 3756534 (TTAB Aug. 6, 2018)	14
<i>Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana, Inc.</i> , 98 USPQ2d 1921 (TTAB 2011).....	12
<i>Pure & Simple Concepts, Inc. v. I H W Mgmt.</i> , 857 F. App'x 652, 656-657 (Fed. Cir. 2021)	7, 14
<i>In re Scandinavian Frames AB</i> , Serial No. 87926087, 2019 TTAB LEXIS 89 (TTAB Apr. 9, 2019)	8
<i>In Re Sears, Roebuck & Co.</i> , 2 USPQ2d 1312 (TTAB 1987).....	8
<i>Shay v. County of Los Angeles</i> , No. 15-CV-04607, 2019 WL 5420262 (C.D. Cal. Oct. 21, 2019).....	19
<i>Sheetz of Del., Inc. v. Doctors Assocs., Inc.</i> , 108 USPQ2d 1341 (TTAB 2013)	19
<i>Spotify AB v. Software Inc.</i> , 2022 USPQ2d 37 (TTAB 2022).....	20
<i>Stoncor Grp., Inc. v. Specialty Coatings, Inc.</i> , 2012 WL 2588576 (TTAB June 22, 2012).....	4
<i>Sw. Mgmt., Inc. v. Ocinomled, Ltd.</i> , 115 USPQ2d 1007 (TTAB 2015).....	8
<i>Tao Licensing, LLC v. Bender Consulting Ltd.</i> , 125 USPQ2d 1043 (TTAB 2017)	13
<i>Teledyne Technologies, Inc. v. Western Skyyways, Inc.</i> , 78 USPQ2d 1203 (TTAB 2006)	21
<i>Thomas v. Auxcier</i> , 2019 TTAB LEXIS 356 (TTAB Sept. 27, 2019)	8
<i>TiVo Brands LLC v. Tivoli, LLC</i> , 129 USPQ2d 1097 (TTAB 2018)	21
<i>Toro Co. v. ToroHead Inc.</i> , 61 USPQ2d 1164 (TTAB 2001)	5
<i>In re Toshiba Med. Sys. Corp.</i> , 91 USPQ2d 1266 (TTAB 2009).....	6
<i>Vonrosenberg v. Lawrence</i> , 412 F. Supp. 3d 612 (D.S.C. 2019)	13
<i>Zheng Cai v. Diamond Hong, Inc.</i> , 901 F.3d 1367 (Fed. Cir. 2018).....	10

I. INTRODUCTION

To attack the distinctiveness and strength of the CAT mark¹, Tigercat relies upon three distinguishable third-party registrations, which cannot diminish the fame of the seventy-year-old CAT word and logo mark with billions in sales and advertising, widespread recognition that it is one of the strongest brands in the world in the relevant market and among the general public, and Board and federal court decisions finding the mark to be famous based on less evidence than has been submitted in this case. Tigercat contorts the standards for analyzing the relatedness of the parties' goods and trade channels, while ignoring the clear overlap in Caterpillar's registrations and the TIGERCAT Application, marketplace uses, and trade channels. Tigercat's urging of the Board to downplay the marks' shared dominant element, CAT, and focus on the "TIGER" (which conveys the same meaning—a type of cat) does little to deemphasize that the parties' marks are highly similar. And Tigercat's prior registration defense—which should have been pled almost 10 years ago in Tigercat's Answer (4 TTABVUE) or at many points before submitting Tigercat's trial brief—fails because Tigercat falls far short of its burden to establish that Caterpillar implicitly consented to this defense.² It was not Caterpillar's obligation to flag or object to the deficiencies in Tigercat's case and it raised objections to this defense and supporting testimonial evidence in a timely manner.

II. CATERPILLAR HAS ESTABLISHED A LIKELIHOOD OF CONFUSION

A. Factor Five - Tigercat's Attempts to Undercut Caterpillar's Fame Evidence Fail

1. Caterpillar Has Proven Fame in the Relevant Market

To assess fame for likelihood-of-confusion purposes, the correct standard is to evaluate a mark's fame within the relevant market. *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1735 (Fed. Cir. 2017) (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1375, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005)) ("Fame for confusion purposes arises as long as a significant portion of the relevant consuming public . . . recognizes the mark as a source indicator," and "a mark's renown within a specific product market is the proper standard."). The "relevant market" consists of purchasers of Opposer's asserted goods and services. *Palm Bay Imps., Inc.*, 396 F.3d at 1375, 73 USPQ2d at 1694.

¹ While Caterpillar asserted its distinct CATERPILLAR and CAT marks and corresponding registrations in the Notice of Opposition (1 TTABVUE), its trial briefs focus only on the CAT marks.

² Tigercat does not contest that Caterpillar's has a statutory cause of action and priority over Tigercat's Application. Caterpillar's response to Tigercat's evidentiary objections is attached as Appendix A. Even if the Board were to sustain Tigercat's objections, the testimony and evidence on fame to which Tigercat has not

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.