Oral Hearing:
October 20, 2011

Mailed:
May 14, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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PRL USA Holdings, Inc.
v.
Thread Pit, Inc.

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Cancellation No. 92047436

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Scott Gelin, G. Roxanne Elings and Anna Dalla Val of Greenberg Traurig, LLP for PRL USA Holdings, Inc.

Howard A. Caplan of Lewis Longman & Walker PA for Thread Pit, Inc.

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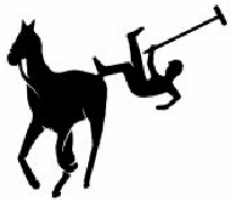
Before Kuhlke, Bergsman and Wolfson, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

PRL USA Holdings, Inc. (petitioner) has petitioned to cancel Registration No. 3180680 owned by Thread Pit, Inc. (respondent) for the mark shown below for goods identified as "t-shirts and collared polo shirts," in International Class 25.[1]

[1] The registration issued on December 5, 2006 from the underlying application filed on January 19, 2006.



As grounds for cancellation petitioner asserts the claim of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) and dilution under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125. In connection with these claims, petitioner alleges that it owns several registrations for the Polo Player mark shown below and several marks incorporating the word POLO for a variety of clothing and accessory items and that its marks have become famous prior to respondent's use of its mark.

Respondent filed an answer by which it admitted to petitioner's ownership of the pleaded registrations, that its goods are "the same as some of the goods contained in [petitioner's pleaded] registrations" but otherwise denied the salient allegations. In addition, respondent asserted as an affirmative defense that its "use of its mark is a parody of certain of [respondent's] marks." The remaining

"affirmative defenses" simply serve to amplify its general defense that there is no likelihood of confusion.

THE RECORD

The evidence of record consists of the pleadings; the file of the subject registration; petitioner's testimony by declaration[2] with accompanying exhibits A-G of Ellen Brooks, Director, U.S. Trademark Enforcement for respondent's parent company Polo Ralph Lauren Corporation; petitioner's notices of reliance on respondent's responses to certain discovery requests, excerpts from the discovery deposition of Nicholas Lynn Moskowitz, printed publications, its pleaded registrations, and court decisions wherein the Polo Player design mark was found inherently distinctive and famous; respondent's testimony by declaration with accompanying exhibits A-D of Nicholas Moskowitz, respondent's President and owner; respondent's notices of reliance on its subject registration[3] and certain of petitioner's discovery responses. Petitioner also submitted a rebuttal declaration from Ellen Brooks which is the subject of an objection from respondent addressed below.

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[2] Upon stipulation of the parties, filed January 21, 2010, testimony was submitted by declaration.

[3] For future reference, respondent is advised that this was unnecessary inasmuch as the subject registration "forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose." Trademark Rule 2.122(b).

In addition, the parties submitted under stipulation several documents including excerpts from petitioner's and respondent's websites, articles from printed publications, petitioner's advertising, and petitioner's annual reports.

Both parties filed briefs; however, respondent did not attend the oral hearing.

EVIDENTIARY ISSUE

As a preliminary matter, we take up for consideration respondent's objection, made in its main trial brief, to the rebuttal declaration of Ellen Brooks. Respondent states that it was never served with a copy of this declaration. The filing with the Board does not include a certificate of service. In addition, petitioner did not submit any argument in response; therefore, respondent's assertion that the declaration was not served stands unrebutted. Every paper filed with the Board must be served upon the other parties and proof of service must be made before a paper will be considered. Trademark Rule 2.119(a). In view thereof, the May 24, 2010, declaration of Ellen Brooks is hereby stricken from the record.

PRIORITY/STANDING

Because petitioner has made its pleaded registrations of record and has shown that the registrations are valid and subsisting and owned by petitioner, petitioner has established its standing to cancel respondent's registration

and its priority is not in issue. See King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Accordingly, we turn to the question of likelihood of confusion.

LIKELIHOOD OF CONFUSION

Petitioner only made some of its pleaded registrations of record by notice of reliance.[4] The most relevant are set forth as follows:

> Registration No. 2823094 for the mark shown below for "tote bags" in International Class 18 and "wearing apparel, namely, sweaters and t-shirts" in International Class 25, issued March 16, 2004, Section 8 and 15 affidavit accepted and acknowledged;

> Registration No. 3199839 for the mark shown below for "wearing apparel, namely, jackets,

[4] The printouts of registrations from TESS, the USPTO electronic database, attached to the pleading are not sufficient to make the remaining registrations of record because the petition for cancellation was filed on April 25, 2007, prior to the November 1, 2007 Trademark Rules amendments. Moreover, respondent's answer only serves as an admission to petitioner's ownership and not to the status of the pleaded registrations. In addition, petitioner introduced into the record certain of its registrations that it did not plead. With regard to these registrations, we only consider them in connection with petitioner's allegation of fame and not for priority or reliance on other Section 7(b) presumptions.

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