

This Opinion is not a
Precedent of the TTAB

Mailed: January 12, 2017

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Ennis, Inc.
v.
Joel L. Beling d/b/a Supa Characters Pty Ltd

Opposition No. 91203884
to application Serial No. 85324443

Daniel J. Chalker of Chalker Flores LLP for Ennis, Inc.

Joel L. Beling, pro se.

Before Cataldo, Bergsman and Adlin,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Ennis, Inc. (“Opposer”) has opposed Joel L. Beling’s (“Applicant”) application to register COLOR WARS (in standard characters) for the following goods in International Class 16:¹

¹ Application Serial No. 85324443 was filed on May 18, 2011 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), with a claim of priority under Section 44(d), 15 U.S.C § 1126(d), subsequently amended to seek registration under Trademark Act Section 44(e), 15 U.S.C. § 1126(e), based upon Applicant’s assertion of ownership of Australian Registration Nos. 1408389 (Registered on February 11, 2011); 1414546 (Registered on March 16, 2011); and 1411544 (Registered on March 16, 2011). The application also recites goods in International Class 28 that were never opposed and services in International Class 41 that are no longer at issue as a result of Opposer’s withdrawal of the notice of opposition thereto.

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Adhesive bands for stationery or household purposes; Adhesive foils stationery; Adhesive tape dispensers for household or stationery use; Adhesive tapes for stationery or household purposes; Adhesive tapes for stationery purposes; Adhesives for stationery and household use; Adhesives for stationery or household purposes; Adhesives for stationery purposes; Adhesives in the form of tape for stationery; Art prints; Automatic paper clip dispensing machines for office or stationery use; Books in the field of superhero and cartoon characters; Brochures about superhero and cartoon characters; Cartoon prints; Cartoon strips; Color pencils; Color prints; Colorboard; Colored craft and art sand; Coloring books; Comic books; Comic magazines; Comic strips; Comic strips appearing in newspapers and other media; Comic strips' comic features; Comics; Desk mounted stationery cabinets; Desktop stationery cabinets; Dispensers for adhesive tapes for stationery or household purposes; Educational publications, namely, educational learning cards, flash cards, activity cards, workbooks, textbooks, activity books, story books, puzzle books, printed puzzles, teacher guides, manuals, posters and educational booklets in the field of superhero and cartoon characters; Envelopes for stationery use; File pockets; Glitter glue for stationery purposes; Glitter pens for stationery purposes; Glue for stationery or household purposes; Glue for stationery or household use; Glue pens for stationery purposes; Glue sticks for stationery or household use; Graphic fine art prints; Graphic prints and representations; Gummed tape for stationery or household use; Liquid paint felt tip marking and coloring applicators; Magazine columns about superhero and cartoon characters; Magazine sections in the field of superhero and cartoon characters; Magazine supplements to newspapers in the field of superhero and cartoon characters; Magazines in the field of superhero and cartoon characters; Newsletters in the field of superhero and cartoon characters; Newspaper cartoons; Newspaper comic strips; Office paper stationery; Office stationery; Organizational kit used in planning the design and apparel for special events containing color selection sample sheets, planning folders and fabric swatches; Organizational kits containing calendars, stationery, planning folders, templates and printed guidelines for planning social events; Organizers for stationery use; Packaged kits comprising printed instructional, educational, and teaching materials for educational activities in the field of superhero and cartoon characters; Paper stationery; Paper stationery with inspirational messages imprinted thereon; Partially printed forms; Paste for handicraft, for stationery or household purposes (banjaku-nori); Paste for stationery or household purposes; Pastes and other adhesives for stationery or household purposes; Pencil ornaments; Personalized coloring books for children; Photographic prints; Pictorial prints; Polyester film for use as a paper substitute for dry toner

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xerographic imaging, namely, laser printing, color copier printing, dry toner printing, screen printing, and offset printing; Print engravings; Print letters and blocks; Printed art reproductions; Printed calendars; Printed certificates; Printed certificates for sports and/or entertainment fans; Printed certificates in the field of sports and/or entertainment; Printed children's coloring pages; Printed collector cards made primarily of paper and also including metal; Printed collector cards made primarily of paper but also including metal; Printed emblems; Printed forms; Printed graphs; Printed greeting cards with electronic information stored therein; Printed holograms; Printed material in the nature of color samples; Printed materials, namely, curricula in the field of superhero and cartoon characters; Printed materials, namely, journals featuring superhero and cartoon characters; Printed materials, namely, novels and series of fiction books and short stories featuring scenes and characters based on video games; Printed materials, namely, press releases featuring superhero and cartoon characters; Printed materials, namely, written articles in the field of superhero and cartoon characters; Printed matter, namely, paper signs, books, manuals, curriculum, newsletters, informational cards and brochures in the field of superhero and cartoon characters; Printed music books; Printed news releases in the field of superhero and cartoon characters; Printed pamphlets, brochures, manuals, books, booklets, leaflets, flyers, informational sheets and newsletters, adhesive backed stickers, and kits comprising one or more of the foregoing materials in the field of superhero and cartoon characters; Printed paper labels; Printed paper signs; Printed patterns; Printed periodicals in the field of movies; Printed periodicals in the field of music; Printed periodicals in the field of plays; Printed periodicals in the field of tourism; Printed wine and beer bottle labels incorporating a feature that changes color in response to fluctuation in temperature of the contents of the bottle to which the label is affixed; Prints; Prints in the nature of superhero and cartoon characters; Protractors; Publications, namely, brochures, booklets, and teaching materials in the field of superhero and cartoon characters; Publications, namely, books, journals, magazines and comic books in the fields of superhero and cartoon characters; Red algae gelatine glue, for stationery or household purposes (funori); Reinforced stationery tabs; Seals; Self-adhesive tapes for stationery and household purposes; Souvenir programs concerning superhero and cartoon characters; Stationery; Stationery boxes; Stationery cases; Stationery folders; Stationery writing paper and envelopes; Stationery-type portfolios; Stickers; Syndicated columns dealing with superhero and cartoon characters; Syndicated magazine sections dealing with superhero and cartoon characters; Syndicated newspaper columns dealing with

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superhero and cartoon characters; Workbooks directed to superhero and cartoon characters.

The Pleadings.

The sole ground for opposition is likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).² Opposer pleaded ownership of Registration No. 3372884 for the mark displayed below, in connection with “printing services” in International Class 40:³



Applicant’s answer denied the salient allegations contained in the Notice of Opposition and asserted amplifications of his denials as “affirmative defenses.”⁴ Applicant also filed a separate petition to cancel Opposer’s pleaded registration on various grounds which the Board treated as a counterclaim. Opposer denied the salient allegations in the counterclaims.

² 1 TTABVUE.

³ Registration No. 3372884 issued on January 22, 2008. Section 8 affidavit accepted; Section 15 affidavit acknowledged. “Color is not claimed as a feature of the mark.”

⁴ 4 TTABVUE.

Procedural History.

On September 30, 2013, the Board issued a decision addressing the parties' cross-motions for summary judgment on Applicant's counterclaim, which dismissed Applicant's counterclaim petition to cancel Opposer's pleaded registration.⁵

On February 27, 2015, the Board issued a decision addressing: Opposer's motion for summary judgment on its pleaded claim of likelihood of confusion or, in the alternative, to amend the opposed application; Applicant's motion for leave to amend its answer to add as "affirmative defenses" Opposer's lack of standing and that Opposer is a trademark bully; and Applicant's motion for summary judgment on its proposed new defenses.⁶ In that decision, the Board:

- denied Applicant's motion to add his proposed affirmative defenses on the basis that standing is an element of Opposer's claim and not an affirmative defense, and that as Applicant acknowledges, trademark bullying is not recognized as an affirmative defense;
- held that, in view thereof, Applicant's summary judgment motion on its proposed defenses was moot;
- dismissed the opposition with prejudice as to Applicant's Class 41 services based upon Opposer's withdrawal thereof without Applicant's written consent after answer was filed;

⁵ 103 TTABVUE.

⁶ 122 TTABVUE.

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- granted Opposer’s summary judgment motion with regard to its standing and priority as to the mark and services identified in its pleaded registration;
- denied Opposer’s summary judgment motion with regard to likelihood of confusion; and
- denied Opposer’s unconsented motion in the alternative to amend the involved application.

With regard to Opposer’s motion to amend, we stated:

Opposer contends (Motion for Summary Judgment, p. 15) that it is “entitled to judgment as a matter of law that a likelihood of confusion between Opposer’s mark COLOR WORX and design for printing services and Applicant’s mark COLOR WARS in International Class 16 for a multitude of goods will be minimized if the Board enters an order amending Applicant’s identification of goods... .” This was not a pleaded allegation in the notice of opposition. Moreover, Opposer cites to no rule or case law, and the Board is aware of none, for the proposition that, in lieu of Opposer meeting its burden of proving likelihood of confusion, Opposer may simply assert that confusion is likely and the Board will order an amendment of the opposed application without applicant’s consent. *See* Trademark Rule 2.133.

Opposer is advised that the Board will exercise its authority under Trademark Act Section 18 to “modify the application or registration by limiting the goods or services specified therein ... as the rights of the parties under this chapter may be established in the proceedings” only where the issue of possible restriction has been raised by the pleadings and/or is tried by the parties. *Eurostar, Inc. v. “Euro-Star” Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1272 (TTAB 1995).⁷

Opposer’s Motions to Amend its Pleading.

Section 18 Modification of Involved Application

Opposer argues in its brief that

Ennis did not plead a Section 18 remedy in its Notice of Opposition. (TTABVUE #122, pg. 13). But such an issue can be tried by express or

⁷ *Id.* at 13.

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implied consent of the parties. *See* TMBP § 507.03(b). “Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue” *Id.*; *see e.g., UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1872 n.3 (TTAB 2011). In this case, the Section 18 remedy to amend some of the goods in Mr. Beling’s application to specify “in the field of superhero and cartoon characters” was argued in Ennis’ Motion for Summary Judgment. (TTABVUE #107, pg. 3). Although Mr. Beling rejected any amendment of his application, he did not object to it as a non-pleaded issue. Moreover, the issue was raised during discovery. (ONR Exh. 6, Interrogatory No. 22). Furthermore, the USPTO required Applicant to amend some of its goods and services to recite the limitation of “in the field of superhero and cartoon characters.” (TTABVUE #107, pg. 3). As a result, Mr. Beling raised no objection to the introduction of evidence on the issue and was fairly apprised of the issue. Accordingly, Ennis’ alternative remedy under Section 18 to amend Mr. Beling’s description of goods in International Class 16 was and is being tried by implied consent.⁸

Ennis requests the Board to consider this as a motion to amend the pleadings pursuant to Fed. R. Civ. P. 15(b) and TBMP § 507.03(b) since there is no doubt that Mr. Beling is aware the issue is being tried.⁹

Opposer acknowledges that it did not plead a request to modify the identification of goods in the involved application under Section 18 of the Trademark Act, 15 U.S.C. § 1068. Thus, we must determine whether the issue was tried by implied consent. As noted above, Opposer first raised the issue of its proposed amendment in its motion for summary judgment.¹⁰ Applicant addressed Opposer’s request to amend the involved application in his response and cross-motion for summary judgment, arguing that “opposer’s demand that applicant further amend his application to settle

⁸ 147 TTABVUE 34-5.

⁹ *Id.* at 35, n.4.

¹⁰ 107 TTABUVE 16-21; 122 TTABVUE 13.

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this proceeding are inappropriate and improper.”¹¹ Further, in his objections to Opposer’s evidence, filed contemporaneously with his main brief in the opposition, Applicant

objects to Opposer’s untimely and prejudicial attempt to restrict applicant’s description of goods pursuant to § 18 of the Lanham Act, (147 TTABVUE 33-39), on the basis that it was not pleaded in opposer’s notice of opposition and applicant had no notice whatsoever that opposer would attempt to introduce it in his final brief as a pleaded issue.¹²

Applicant further argues that Opposer did not amend its pleading to assert a § 18 restriction after the Board’s denial thereof in our February 27, 2015 order¹³ “despite a period of at least eight months within which to do so,” and that Applicant’s express or implied consent “are *denied* and have been *denied* from the first time opposer raised the attempted resolution.”¹⁴ Applicant did not address Opposer’s proposed restriction to Applicant’s recited goods on the merits.

Opposer essentially argues that while Applicant objected to Opposer’s proposed amendment of his application in his response to Opposer’s summary judgment motion, he did not object on the basis that such amendment was an unpleaded issue. Opposer also argues that because the issue of amendment was raised during discovery, and Applicant was required to amend its identification of Class 16 goods during examination, he was apprised that the issue was being tried and consented thereto. However, Applicant argued in his summary judgment response and cross-

¹¹ 110 TTABVUE 14-15.

¹² 151 TTABVUE 4-5.

¹³ 122 TTABVUE 13.

¹⁴ 151 TTABVUE 5 (emphasis in original).

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motion that the proposed amendment was “inappropriate and improper,” and strenuously objects to the proposed amendment in his objections accompanying his brief on the ground that it is “untimely and prejudicial,” that Applicant “had no notice whatsoever” that the issue of the amendment was being tried, and that any asserted consent to trial of the issue was repeatedly denied.

We disagree with Opposer’s contention that Applicant raised no objection to the introduction of evidence on Opposer’s proposed restriction of the involved application. To the contrary, Applicant objected to Opposer’s interjection of its motion to amend when it was first raised at summary judgment and in Opposer’s brief. We will not infer from Applicant’s failure to specifically object on the basis that the issue was untried that he somehow waived that objection or otherwise consented to trial thereof. Clearly, Applicant objected to the introduction of evidence on this issue. Therefore, the issue was not tried by implied consent and will be given no further consideration.

Common Law Rights in Colorworx Mark

In a footnote in its brief, Opposer also moved to amend its pleading to assert common law rights as to the word mark, Colorworx.¹⁵

Ennis has asserted its common law rights in its COLORWORX word mark and provided evidence of same at least in its Motion for Summary Judgment and the Declarations and Deposition of Steven Osterloh. (TTABVUE #107). In the event the Board determines that this is an unpleaded issue, Ennis requests the Board to consider this as a motion to amend the pleadings pursuant to Fed. R. Civ. P. 15(b) and TBMP § 507.03(b) since there is no doubt that Mr. Beling is aware the issue is

¹⁵ Clearly, the better practice would have been to make such a request by way of separate motion identified as such, rather than in a footnote to Opposer’s brief.

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being tried. Mr. Beling's challenges to the evidence based on estoppel have been repeatedly denied. (*See e.g.*, TTABVUE #44, 83, 103 at 4-5).¹⁶

In his objections to Opposer's evidence, Applicant

objects to the sixth and seventh paragraphs on page 2 of the affidavit of Mr. Steven Osterloh dated May 16, 2015, concerning opposer's reliance on its common law rights to the mark COLORWORX (word only) (128 TTABVUE 6), to all other evidence submitted by opposer showing the mark COLORWORX (word only), and to all references in opposer's brief to opposer's common law rights to the mark COLORWORX (word only) (147 TTABVUE 19-21, 24-25, 29-31, 34, 39), on the basis that these rights were not pleaded by opposer in its notice of opposition and in fact cause significant prejudice and surprise to applicant. TTABVUE #1. Opposer cannot obtain judgment on an unpleaded issue. TBMP § 528.07(a). Similarly, opposer's untimely and prejudicial motion to amend pleadings, buried in a footnote, should also be denied. 147 TTABVUE 20-21 n. 3.¹⁷

In reply, Opposer argues

Mr. Beling objected to Ennis' reliance on its common law rights to the COLORWORX word mark because "these rights were not pleaded by opposer in its notice of opposition and in fact cause significant prejudice and surprise to applicant." (TTABVUE #151 at 1; TTABVUE #150 at 7n.2). The phrase "common law rights" was not used in the Notice of Opposition, but Ennis defined the term "Opposer's Mark" to refer its trademark registration (design plus words), and also used the undefined term "COLORWORX Mark." (*See e.g.*, TTABVUE #1 at 6). Even if the use of the two terms in the Notice of Opposition is not found to provide proper notice of Ennis' common law rights to the COLORWORX word mark, Mr. Beling was aware of the issue, has tried the issue before the Board and will not be prejudiced by amending the pleadings to conform to the evidence.¹⁸

In this case, Mr. Beling has not been disadvantaged in presenting his case because he deposed Ennis' witness on the issue and argued the issue at trial. Mr. Beling asked, during the deposition of Mr. Osterloh,

¹⁶ 147 TTABVUE 21-2, n.3.

¹⁷ 151 TTABVUE 2.

¹⁸ 154 TTABVUE 8.

whether Ennis was claiming rights to the separate portions of the mark (i.e., the word COLORWORX separately from the design element) in addition to the registered mark (i.e., the design plus words):

Q. Okay. So you're not claiming – like, you are claiming, obviously, rights to the mark as a whole, but you are also claiming rights to the two distinct portions?

A. I -- We claim the rights to the word, "COLORWORX," all one word, as well as to the design mark itself. Separately, yes.

(TTABVUE 132 at 4 (deposition page 11)). In response to Ennis' Motion for Summary Judgment, Mr. Beling objected to the use of common law rights to show standing (TTABVUE #110 at 10), but argued no likelihood of damage or harm based on an analysis of the words in the respective marks.¹⁹

Based on the foregoing, Mr. Beling conducted discovery regarding Ennis' claim to rights in its COLORWORX word mark, and argued both before and during trial that the words were allegedly dissimilar and not likely to cause confusion. As a result, Mr. Beling had notice of the issue before trial, and has presented evidence and arguments at trial to prove his case. Mr. Beling has not and cannot show the Board that: (a) the evidence of Ennis' common law rights to the COLORWORX word mark would prejudice his defense on the merits pursuant to Fed. R. Civ. P. 15(b)(1); or (b) the issue has not been tried by the parties' express or implied consent pursuant to Fed. R. Civ. P. 15(b)(2). Accordingly, the Board should: (a) overrule Mr. Beling's objections to Ennis' evidence and arguments relating to its common law rights in the COLORWORX word mark; (b) treat the issue in all respects as if raised in the pleadings; and (c) permit the Notice of Opposition to be amended.²⁰

We address Opposer's arguments in turn. In its notice of opposition, Opposer alleges

Opposer is the owner of U.S. Trademark Registration No. 3,372,884 for the mark COLORWORX® ("Opposer's Mark"). Opposer's Mark is valid, subsisting, and in full force and effect. Since as early as August, 2002, Opposer, its predecessors, or its related companies have continuously

¹⁹ *Id.* at 9-10.

²⁰ *Id.* at 12-13.

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used the COLORWORX Mark in interstate commerce as a trademark for a variety of printing goods and printing services including, but not limited to, business cards, letterhead, sell sheets, rack cards, postcards, brochures and posters (“Opposer’s Goods”). Opposer’s Mark has also continuously appeared in substantial advertising and promotion of Opposer’s printing goods and printing services, such that the mark is closely identified with Opposer’s Goods and has gained very valuable public recognition. Opposer has established an outstanding reputation as to the quality of its products sold under the COLORWORX Mark.²¹

Opposer’s allegations regarding its “COLORWORX Mark” in this paragraph relate to “the mark COLORWORX® (‘Opposer’s Mark’)” in its pleaded registration. We find nothing in this allegation, or in the other allegations comprising the notice of opposition, to indicate that Opposer also asserted common-law rights to the word mark Colorworx or another mark consisting in part of Colorworx. Similarly, it is not clear from Opposer’s assertions regarding use of its “COLORWORX Mark” in connection with “a variety of printing goods and printing services” that it is asserting use of such mark in connection with printed goods separate from its printing services that create such goods. Nor do we find that Applicant’s answer or any of its filings recognize such assertions.

Mr. Osterloh states in his testimony affidavit that Opposer “is the owner of the common law mark COLORWORX (word only)” in connection with various printed goods and printing services.²² This appears to be the first clear indication that Opposer asserts ownership of such a mark. During his deposition by Applicant, Mr. Osterloh somewhat ambiguously states that Opposer is claiming rights to the term

²¹ 1 TTABVUE 9.

²² 128 TTABVUE 6-7.

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Colorworx and the design element in its pleaded registration “separately.”²³ However, there is no indication, prior to a footnote in Opposer’s brief, that Opposer intended to rely upon common law rights in a Colorworx word mark as a basis for its pleaded claim of likelihood of confusion. While it is clear Opposer claims, and pleads, the mark COLORWORX and design, it was not clear during trial whether Opposer also claims rights in the term Colorworx separate from the design and/or the design separate from the wording. The remainder of Mr. Osterloh’s affidavit and discovery deposition sheds little further light on the issue. Similarly, we do not infer from Applicant’s argument at summary judgment directed toward differences in the wording in Opposer’s mark and Applicant’s mark that Applicant acknowledged Opposer’s common-law rights in a Colorworx word mark. Indeed, such an inference is inconsistent with Applicant’s arguments in its summary judgment response and cross motion that “Opposer cannot rely on its common law rights to show standing because these were not pleaded in its Notice of Opposition.”²⁴ Again, in addition to Applicant’s objections to the introduction of evidence on this issue, there is considerable doubt on the record regarding Applicant’s awareness that Opposer intended to rely upon common law rights in a Colorworx word mark. *See Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1927 (TTAB 2011), *on appeal*, No. 1:11-cv-01623-RC (D.D.C.); *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d at 1034-35.

²³ 132 TTABVUE 5.

²⁴ 110 TTABVUE 11.

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“Fairness dictates whether an issue has been tried by consent – there must be an absence of doubt that the nonmoving party is aware that the issue is being tried.” TBMP § 507.03, *citing Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d at 1927 (petitioner’s “family of marks” claim, raised for the first time in its brief not considered because it was neither pleaded nor tried by the parties), *on appeal*, No. 1:11-cv-01623-RC (D.D.C.); *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031, 1034-35 (TTAB 2010) (applicant was not aware opposer intended to rely on registration to prove likelihood of confusion until opposer filed rebuttal notice of reliance). In this case, Opposer first asserts its reliance upon common-law rights in a Colorworx word mark in a footnote in its brief and did not fully articulate its position until its reply brief. In view of the foregoing, Opposer’s motion to amend its pleading to assert its alleged common law rights is denied, Opposer’s proposed amendment will be given no further consideration and Opposer’s arguments in its brief directed toward its putative word mark will not be further considered.²⁵

Applicant’s Motion for Reconsideration.

In his brief, Applicant requests renewed reconsideration of several interlocutory orders issued in this proceeding, relating to his proposed affirmative defense of trademark bullying. We agree with Opposer that because the interlocutory decisions complained of all issued more than one month prior to Applicant’s filing of his motion,

²⁵ We note nonetheless that even if we had granted Opposer’s motion to amend its pleading, the result, as discussed below, would be the same.

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it is untimely. Trademark Rule 2.127(b); 37 C.F.R. § 2.127(b). *See Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Manufacturing Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000). *See also* TBMP § 518 and authorities cited therein. We further agree with Opposer that because Applicant's previous requests for reconsideration of these orders were denied, and Trademark Rule 2.127(b) does not contemplate a second request for reconsideration of the same basic issue, Applicant's renewed motion for reconsideration is improper. *See Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 631 n.11 (TTAB 1986); *Avedis Zildjian Co. v. D.G. Baldwin Co.*, 181 USPQ 736, 736 (Comm'r 1974). In view thereof, Applicant's renewed motion for reconsideration will be given no further consideration.

Trademark Bullying or "Overenforcement."

As discussed above, in an interlocutory decision the Board previously denied Applicant's motion to add this proposed affirmative defense.²⁶ Nonetheless, Applicant devotes a considerable portion of his brief²⁷ to arguing what he acknowledges is his novel theory of trademark bullying or "overenforcement" "for the purposes of creating a new affirmative defense aimed at protecting trademark applicants by preventing overenforcement of rights held in a mark and discouraging abusive litigation tactics."²⁸ However, as we previously held, trademark bullying or "overenforcement" is not a cognizable affirmative defense in inter partes proceedings before the Board.

²⁶ 122 TTABVUE 4-6.

²⁷ 150 TTABUVE 14-45.

²⁸ *Id.* at 14.

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Accordingly, Applicant's arguments directed toward trademark bullying and overenforcement will be given no consideration.

Evidentiary Issues.

Opposer filed a motion to strike²⁹ Applicant's June 19, 2015 notice of reliance on 64 putative "facts" and the documents upon which they are based³⁰ on several grounds, including that the facts in question are not adjudicative facts of which the Board takes notice. In response, Applicant consented to strike the notice of reliance as to alleged "facts" 1-59.³¹ Alleged "fact" 60 is based upon a page from Opposer's 2015 Annual Report. This document is sufficiently identified; however, it is relevant only to Applicant's claim of trademark bullying, and as such will be given no consideration. Alleged "facts" 61-64 are based upon documents that appear to have been created by Applicant from an underlying Internet dictionary, although the documents indicate a URL and access date. Because it is not clear from Applicant's notice of reliance whether documents 61-64 are copies of Internet web pages or documents created by Applicant based upon those web pages, they will be given no consideration. Accordingly, Opposer's motion to strike is moot as to "facts" 1-59 and the documents upon which such facts are based, and granted as to "facts" 60-64 and the documents upon which they are based.

²⁹ 142 TTABVUE.

³⁰ 135 TTABVUE.

³¹ 143 TTABVUE.

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In its reply brief,³² Opposer moves to strike Applicant's notice of reliance upon dictionary definitions of "color," "work," "war," and "bully,"³³ on the ground that it is untimely. The motion is granted because this notice of reliance was filed after the close of testimony and is untimely. Trademark Rule 2.122(e). We further observe that the Board has previously taken judicial notice of the terms "color" and "work" comprising the word portion of Opposer's pleaded mark.³⁴ The notice of reliance accordingly will be given no consideration.

The parties' remaining evidentiary objections are largely rendered moot as a result of our determination above to not consider Applicant's proposed affirmative defense of trademark bullying, or Opposer's proposed restriction to the involved application or assertion of common law trademark rights in a "Colorworx" mark. The parties' remaining evidentiary objections are not outcome determinative; we thus find no reason to discuss them in detail. Suffice it to say that the parties' testimony and evidence will be considered for its probative value.

Evidence of Record.

The record includes the pleadings, and by operation of Trademark Rule 2.122(b), 37 CFR § 2.122(b), the application file of the opposed application. In addition, the parties introduced testimony as well as notices of reliance.

Opposer's testimony and evidence:

³² 154 TTABVUE 17.

³³ 153 TTABVUE.

³⁴ 103 TTABVUE 19-20 n.6.

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The testimony affidavit of Mr. Steven Osterloh, Opposer's Vice President of Marketing, with attachments.³⁵

Notice of reliance on printouts showing the status and title of Opposer's pleaded registration and pending application Serial No. 76698743; printouts of the record for Opposer's pleaded registration; copies of certain of Opposer's written discovery requests and Applicant's objections and responses thereto.³⁶

Rebuttal notice of reliance on Opposer's supplemental responses to certain of Applicant's written discovery requests.³⁷

Applicant's Testimony and Evidence.

The confidential testimony declaration of Applicant, Joel E. Beling, and exhibits thereto.³⁸

Notice of reliance on portions of Mr. Osterloh's discovery deposition.³⁹

Notice of reliance on certain of Opposer's responses to Applicant's written discovery requests.⁴⁰

Both parties filed briefs.⁴¹

³⁵ 128 TTABVUE. The parties stipulated to the submission of testimony by affidavit or declaration. 68 TTABVUE 1-3.

³⁶ 127 TTABVUE.

³⁷ 146 TTABVUE.

³⁸ 137 TTABVUE.

³⁹ 131, 132 TTABVUE.

⁴⁰ 133, 134 TTABVUE.

⁴¹ 147 TTABVUE, 150 TTABVUE, 154 TTABVUE.

Standing and Priority.

Standing is a threshold issue that must be proven by the plaintiff in every *inter partes* case. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1061-62 (Fed. Cir. 2014) cert. denied, 135 S. Ct. 1401, 191 L. Ed. 2d 360 (2015); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187-89 (CCPA 1982). In order to meet the standing requirement, a plaintiff need only show that it has a real interest, *i.e.*, a personal stake, in the outcome of the proceeding. See *Ritchie v. Simpson*, 170 F.3d 1092, 1095, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999); *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012). A belief in likely damage can be shown by establishing a direct commercial interest. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

Applicant acknowledges in his brief that Opposer is the owner of its pleaded registration.⁴² Applicant argues nonetheless that it “does not follow that opposer has a real interest in the outcome of the proceeding, that opposer has discharged its burden, and that, as particularized below, opposer would be damaged by applicant’s registration.”⁴³ Applicant is incorrect.

As discussed above, we previously found as a matter of law on summary judgment that because Opposer’s pleaded registration is properly of record, is valid and

⁴² 150 TTABVUE 11-12.

⁴³ *Id.* at 12.

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subsisting and owned by Opposer, Opposer's standing is established.⁴⁴ Further, because the registration is properly of record, priority is not in issue as to the services identified therein. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion.

The issue before us is whether Applicant's applied-for mark so resembles Opposer's registered mark as to be likely, when used on or in connection with the goods identified in Applicant's application, to cause confusion, mistake, or deception. 15 U.S.C. § 1052(d). In determining this issue, based on the evidence and arguments presented, we consider the relevant factors bearing on likelihood of confusion enunciated in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*") (cited in *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 135 S.Ct.1293, 113 USPQ2d 2045, 2049 (2015)) and in *In re Majestic Distilling Co. Inc.*, 315 F.3d 1311, 1314-15, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We have considered each *DuPont* factor that is relevant and for which there is evidence of record. *See M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1947 (Fed. Cir. 2006); *ProMark Brands Inc. and H.J. Heinz Co. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) ("While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant."). We treat as neutral any *DuPont* factors for which there is no evidence or argument of record.

⁴⁴ 122 TTABVUE 8.

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In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Mr. Recipe, LLC*, 118 USPQ2d 1084, 1086 (TTAB 2016).

Opposer bears the burden of proving likelihood of confusion by a preponderance of the evidence. *Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1844. As detailed below, we conclude that Opposer has not met its burden.

Goods and Services, Channels of Trade and Classes of Consumers.

We evaluate the relatedness of the parties' respective goods and services based on their identification in the subject application and registration. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014), quoting *Octocom Sys., Inc. v. Houston Computers Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). *See also Paula Payne Prods. v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods").

The services recited in Opposer's pleaded registration are "printing services." Opposer argues that the involved application "includes goods that result from printing services."⁴⁵ Opposer's witness, Mr. Osterloh, testified in his affidavit that

The identification of goods in International Classification 016 of U.S. Trademark Application Serial No. 85/324,443 for the mark COLOR WARS lists numerous items that are printed goods and are not restricted to the 'field of superhero and cartoon characters.' Ennis

⁴⁵ 147 TTABVUE 27.

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produces many of these non-field restricted printed goods as part of its printing services provided under its mark ... COLORWORX and design.... Moreover, many of these non-field restricted printed goods fall within the target market of Ennis and its distributors under the mark ... COLORWORX and design....⁴⁶

Mr. Beling's non-filed restricted printed goods are so related to the printed goods provided by Ennis' printing services under its mark COLORWORX and design ... that they are likely to be encountered by the same people under circumstances that will likely give rise to confusion as to the source of the goods.⁴⁷

With his affidavit, Mr. Osterloh introduced pages from Opposer's Internet website showing that Opposer's services include printing business cards, bookmarks, card holders, envelopes, gift cards, greeting cards and photo cards, pocket folders, postcards, posters, folders and brochures.⁴⁸

Applicant argues that the printed materials produced by Opposer's printing services "are for the most part different and dissimilar"⁴⁹ from Applicant's goods. Applicant further argues that "opposer has produced no evidence of record concerning any actual sales of printed goods or services in fact sold under its COLORWORX mark and design, which renders the respective similarity or dissimilarity and nature of the goods or services moot."⁵⁰

Opposer's argument regarding the relatedness of the parties' goods and services is grounded in its position that certain of Applicant's goods are produced by printing

⁴⁶ 128 TTABVUE 8.

⁴⁷ *Id.*

⁴⁸ *Id.* at 12-159, 195-396.

⁴⁹ 150 TTABVUE 47.

⁵⁰ *Id.* at 48.

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services such as those provided by Opposer. Opposer's only support for this position is Mr. Osterloh's affidavit and documentary evidence showing that Opposer's services produce printed goods that are similar to some of the goods identified in the involved application. However, Opposer has not included any evidence that its services and Applicant's goods emanate from a common source. For instance, Opposer has introduced no evidence of use or registration by third parties of a common term as a mark to identify its services and Applicant's goods. Nor has Opposer introduced any testimony or evidence to support a finding that it is typical industry practice to identify its services and Applicant's goods under a single mark. Mr. Osterloh's opinion and examples of printed goods produced by Opposer are not sufficient to demonstrate the relatedness of the parties' goods and services for purposes of our likelihood of confusion determination. *Cf. In re Peebles, Inc.*, 6 USPQ2d 1795, 1796 (TTAB 1992) ("the mere fact that an applicant's goods are of a type sold in a registrant's outlet is, in itself, insufficient to support a holding of likelihood of confusion if the marks are dissimilar."); *Harvey Hubble Inc. v. Tokyo Seimitsu Co.* 188 USPQ 517, 520 (TTAB 1975) ("In determining whether products are identical or similar, the inquiry should be whether they appeal to the same market, not whether they resemble each other physically or whether a word can be found to describe the goods of the parties."). The mere fact that Opposer offers printing services and that certain of Applicant's goods are printed materials falls short of demonstrating that the parties' goods and services are related.

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Opposer's "printing services" do not recite any limitations as to their trade channels or the classes of consumers to which they are offered. *See Octocom Systems, Inc. v. Houston Computers Services Inc.*, 16 USPQ2d at 1787. As a result, and in accordance with our established case law, we must presume that Opposer's services move in all channels of trade that are normal therefor and are available to all the usual purchasers thereof.

However, and as discussed above, Opposer has failed to introduce sufficient evidence to support a finding that its services under its mark are related to Applicant's goods in his involved application. As such, we cannot presume that the channels of trade for its services are the same as or overlapping with those in which Applicant's goods may be encountered. *Cf. Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade."). Further, neither the nature of the goods and services themselves nor the evidence of record supports a finding that such goods and services travel in common trade channels or are made available to the same customers.

We find, as a result, that the *du Pont* factors of the similarity of the goods and services, and their channels of trade and classes of consumers favor a finding of no likelihood of confusion.

Comparison of the Marks.

We next consider the similarity or dissimilarity of the parties' marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. *Palm Bay Imports*, 73 USPQ2d at 1692.

Applicants' mark, COLOR WARS in standard characters, and the mark



in Opposer's registration are similar to the extent that the first word in Applicant's mark, namely COLOR, forms the first term in the COLORWORX word portion of Opposer's mark. This results in similarity in sound, especially if the marks are not articulated clearly so that the differences in the second word are not noted.

We are mindful, however, that our analysis cannot be based on a dissection of the involved marks into their various components. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1134 (Fed. Cir. 2015). As the Federal Circuit has declared:

The relevant *DuPont* factor requires examination of "the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression." *DuPont*, 476 F.2d at 1361. As is apparent from the plain language of this factor, marks must be viewed "in their entireties," and it is improper to dissect a mark when engaging in this analysis, including when a mark contains both words and a design. *In re Shell Oil Co.*, 992 F.2d 1204, 1206 [26 USPQ2d 1687] (Fed. Cir. 1993) ("The marks are considered in their entireties, words and design."). Although the court may place more weight on a dominant

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portion of a mark, for example if another feature of the mark is descriptive or generic standing alone, the ultimate conclusion nonetheless must rest on consideration of the marks in total.

In re Viterra, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).

The marks differ in appearance as a result of the crosshair design in Opposer's mark, as well as the dissimilarities between WARS and WORX. Overall, there are clear differences in how the marks look.

Most importantly, the marks are distinctly different in meaning. The term COLOR is defined as "a quality such as red, blue, green, yellow, etc., that you see when you look at something; something used to give color to something: a pigment or dye."⁵¹ WORK, which appears to be a form of the term called to mind by WORX, is defined as "a job or activity that you do regularly especially in order to earn money; the place where you do your job; the things that you do especially as part of your job."⁵² WAR is defined as "a conflict carried on by force of arms, as between nations or between parties within a nation."⁵³ COLORWORX, a stylized spelling of "color works," suggests that the job of Opposer's printing services is to create color printed objects. This meaning is quite different from COLOR WARS, which suggests fighting between groups of colors such as red, blue, green and yellow, or a fight in which the participants are dressed in different colors. Thus, the plain meaning of Applicant's

⁵¹ 103 TTABVUE 20, n. 6. *Merriam-Webster.com. Merriam-Webster, n.d. Web. 29 Sept. 2014.*

⁵² *Id.*

⁵³ We hereby take judicial notice of this definition of "war" from Random House Dictionary (2017). The Board may take judicial notice of dictionary definitions, including online dictionaries which exist in printed format. *See, e.g., In re Cordua Rests. LP*, 110 USPQ2d 1227, 1229 n.4 (TTAB 2014).

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mark is clearly different from any meaning that may be ascribed to Opposer's mark. As a result, the marks are highly dissimilar in connotation.

Overall, the significant dissimilarity in the meanings of the marks outweighs the fact that the marks begin with the same word. The marks convey dissimilar commercial impressions. We agree with Opposer that the word portion of its mark is more significant than the design in our evaluation of the similarity or dissimilarity of the marks. *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (holding that "if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services"); *see also In re Viterra Inc.*, 101 USPQ2d at 1911 ("the verbal portion of a word and design mark likely will be the dominant portion"). However, we are not persuaded by Opposer's argument that the differences between the marks do not "alter the overall commercial impression of the marks sufficiently to avoid similarity and confusion."⁵⁴

In sum, the parties' marks are dissimilar in their entireties as to connotation, appearance and commercial impression. This weighs against Opposer's claim of likelihood of confusion. *Palm Bay Imports*, 73 USPQ2d at 1692.

Consumer Sophistication.

Opposer argues that Applicant's goods and the printed products produced through its printing services "are not expensive, luxury goods requiring consumers to exercise

⁵⁴ 147 TTABVUE 26.

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great care or expertise in their purchase.”⁵⁵ Applicant, on the other hand, argues that Opposer’s witness, Mr. Osterloh, testified that Opposer produces customized printed goods in accordance with its customers’ specifications and that, as a result, “a high degree of purchasing care, planning and choice is undertaken before a printed product, such as a customized postcard or calendar, is purchased.”⁵⁶

There is nothing in the identification of Applicant’s goods to indicate that these are purely custom-made products, offered at only high prices and purchased only by consumers with specialized knowledge. Similarly, there is nothing inherent in Opposer’s services to indicate that it provides only high cost printing services for discerning purchasers. Furthermore, there is nothing in the record beyond Mr. Osterloh’s testimony that Opposer offers customized printing services to the order and specification of its customers to support a finding that Opposer’s services and their purchasing process are of such a nature that purchasers are necessarily careful. *See, e.g., Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992) (record confirms that opposer’s services are expensive and are purchased only by experienced corporate officials after significant study and contractual negotiation and that the evaluation process used in selecting applicant’s products requires significant knowledge and scrutiny). Moreover, the applicable standard of care is that of the least sophisticated consumer. *Alfacell Corp.*

⁵⁵ 147 TTABVUE 32.

⁵⁶ 150 TTABVUE 49.

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v. Anticancer, Inc., 71 USPQ2d 1301, 1306 (TTAB 2004). As noted above, both parties market to the general public. We find this fourth *du Pont* factor to be neutral.

Third Party Use.

The sixth *DuPont* factor concerns the number and nature of similar marks in use on similar goods. *E. I. DuPont*, 177 USPQ at 567. *See also Lloyd's Food Prods., Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993). Evidence of third-party use or registration bears on the commercial or conceptual strength of an opposer's mark, respectively. "The weaker an opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection." *Jack Wolfskin*, 116 USPQ2d at 1136 (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015)). *See also Palm Bay Imports.*, 73 USPQ2d at 1693 ("Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection.").

Applicant argues that the number and nature of similar marks in use on similar goods or services mitigates against a finding of likelihood of confusion. Applicant relies upon the following third-party registrations in support of his contention:

Reg. No. 2373935 for COLOR WORKSHOP for artists' materials, namely, arts and craft paint kits comprising paint boxes; paint brushes; pens, pencils, crayons and drawing instruments; stencils, drawing pads; pictures, posters;

Reg. No. 2476288 for the mark COLOR WORKS for paint color cards;
and

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Reg. No. 3632494 for COLORWORKS for storage and organization systems comprising binders, folders, colored stickers, labels, adhesive notes and tabs for organizing, sorting, storing, and acting upon documents and the like.⁵⁷

It has often been said that the “existence of [third party] registrations is not evidence of what happens in the market place or that customers are familiar with them.” *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). *See also Jack Wolfskin Ausrustung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 116 USPQ2d at 1136. Nonetheless, third-party registrations can be used to “show the sense in which a mark is used in ordinary parlance.” *Juice Generation, Inc. v. GS Enters. LLC*, 115 USPQ2d at 1674; *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006). In this case, Applicant has introduced evidence of three third-party registrations, one of which is for a mark, COLOR WORKSHOP, that is arguably less similar to Opposer’s mark than Applicant’s mark. The existence of two registrations for COLOR WORKS for paint color cards and COLORWORKS for binders, folders, stickers and notes is insufficient to persuade us that Opposer’s mark is conceptually weak and entitled to such a narrow scope of protection as to permit registration of a confusingly similar mark for related goods or services. *Cf. Jack Wolfskin*, 116 USPQ2d at 1136 (third-party

⁵⁷ 139 TTABVUE 38-73.

Applicant further relies upon an additional cancelled registration, as well as one pending and six abandoned applications. However, expired registrations and pending and abandoned applications possess no probative value. *See Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) (“[A] cancelled registration does not provide constructive notice of anything”); *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463 (TTAB 2003) (applications show only that they have been filed).

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weakness evidence characterized as “voluminous”).

Applicant has failed to demonstrate extensive registration or use of COLOR WORX-formative marks by third parties for goods or services related to Opposer’s “printing services.” In view thereof, this factor is neutral.

Balancing the Factors.

We have considered all of the arguments and evidence of record, including those not specifically discussed herein, and all relevant *DuPont* factors. Opposer has failed to show that the marks are so similar in appearance, sound, connotation, and commercial impression as to be likely to cause confusion. Similarly, Opposer has failed to show that its printing services are sufficiently related to Applicant’s various printed goods, or that such goods and services move in common channels of trade and are offered to the same classes of consumers. On balance, and taking into account the totality of the evidence of record, we find that Opposer has failed to prove by a preponderance of the evidence that the parties’ marks so resemble one another as to be likely to cause confusion, or to cause mistake, or to deceive under Section 2(d) of the Trademark Act.

Decision: The opposition is dismissed.