

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
February 26, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

Teresa H. Earnhardt
v.
Kerry Earnhardt, Inc.

Opposition Nos. 91205331 (parent) and 91205338
Serial. Nos. 85383910 and 85391456
—

Larry C. Jones and Carla Clements of Alston & Bird LLC
for Teresa H. Earnhardt.

D. Blane Sanders, Cary B. Davis, and Matthew F. Tilley of Tobinson, Bradshaw &
Hinson, P. A.
for Kerry Earnhardt, Inc.

—
Before Bergsman, Wellington, and Gorowitz,
Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

Kerry Earnhardt, Inc. (“Applicant”) filed applications to register the mark
EARNHARDT COLLECTION for

“Furniture,” in Class 20;¹ and

—
¹ Application Serial Number 85383910, filed July 28, 2011 on the basis of intent-to-use,
pursuant to Section 1(b) of the Trademark Act.

Opposition Nos. 91205331 and 91205338

“Custom construction of homes,” in Class 37.²

Applicant disclaimed the exclusive right to use the word “Collection” in both applications.

Teresa H. Earnhardt (“Opposer”) has filed notices of opposition to the applications which, as amended, assert priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) and that the mark is primarily merely a surname under Section 2(e)(4) of the Trademark Act, 15 U.S.C. § 1052(4).³ The allegations of likelihood of confusion are based on Opposer’s ownership of Registration No. 1644237 for the mark DALE EARNHARDT (in typed form)⁴ for goods and services in Classes 6, 8, 16, 25, 28, and 41; and on common law rights in both EARNHARDT and DALE EARNHARDT acquired by use “nationwide (directly or through her licensee) on and in conjunction with various goods and services.”⁵

In response to the amended notices of opposition, Applicant admitted the allegations in Notice of Opposition paragraphs 1 and 3 regarding the background of

² Application Serial Number 85319456, filed August 6, 2011 on the basis of intent-to-use, pursuant to Section 1(b) of the Trademark Act.

³ Opposer also alleged false suggestion of a connection under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a) and dilution under Sections 13 and 43(c) of the Trademark Act, 15 U.S.C. §§ 1063(a) and 1025(c). Opposer neither tried nor argued these claims and thus, the claims are considered waived. *See Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1426 n. 4 (TTAB 2013).

⁴ Prior to November 2, 2003, “standard character” drawings were known as “typed” drawings. The mark on a typed drawing had to be typed entirely in capital letters. A typed mark is the legal equivalent of a standard character mark.

⁵ Amended Notice of Opposition No. 91205331, ¶11, 19 TTABVUE 9. Citations to TTABVUE refer to the Board’s electronic case file database, by entry and page number.

Opposition Nos. 91205331 and 91205338

Dale Earnhardt⁶ and the allegations in paragraph 5 regarding Opposer's sales of "certain licensed merchandise" totaling millions of dollars around the time of Dale Earnhardt's death in 2001. All other salient allegations in the notice of opposition were denied.⁷ Proceedings were consolidated on consent of the parties, after the answers were filed in the respective applications.

The record.

The record includes the application files and the pleadings. The record also includes the following testimony and evidence introduced by the parties:

Opposer's testimony and evidence:

1. Testimony deposition of Carla Clements, attorney for Opposer (51 TTABVUE);
2. Testimony deposition of Mary Becker, Vice President of Sales and Marketing of Schumacher Homes Operations, Inc. (50 TTABVUE);
3. Opposer's pleaded registration showing current status and title (1st Notice of Reliance - 45 TTABVUE):

Registration No. 1644237 for the mark DALE EARNHARDT (in typed form) for goods and services in Classes 6, 8, 16, 25, 28, and 41;

⁶ Dale Earnhardt (Dale) was a professional race car driver. He was "perhaps the best known driver on the NACSAR (National Association for Stock Car Auto Racing) circuit [and] is credited with helping popularize the sport ... [Dale] was killed in an accident on the final lap of the 2001 Daytona 500." ⁹ Encyclopedia Americana International Edition, © Scholastic Library Publishing 2004, 47 TTABVUE 28.

⁷ Applicant also asserted seven "affirmative defenses," some of which are amplifications of its denials, and others of which it failed to pursue or prove at trial and which are accordingly waived. *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2002 n. 3 (TTAB 2015), *Miller v. Miller*, 105 USPQ2d 1615, 1616 n.3 (TTAB 2013); *Baroness Small Estates Inc. v. American Wine Trade Inc.*, 104 USPQ2d 1224, 1225 n.2 (TTAB 2012). Therefore, none requires separate discussion.

Opposition Nos. 91205331 and 91205338

4. Copies of unpleaded registrations owned by Opposer, showing current status of and title to the respective registrations (1st Notice of Reliance - 45 TTABVUE):⁸

Registration No. 2035107 for the mark DALE EARNHARDT (in script) for goods and services in Classes 6, 8, 14, 16, 21, 24, 25, 28, and 41;

Registration No. 3436512 for the mark THE DALE EARNHARDT FOUNDATION (and design) for goods and services in Classes 9, 16, 25, and 41; and

Registration No. 3441113 for the mark DALE EARNHARDT (in script with design) for goods and services in Classes 6, 9, 14, 16, 20, 21, 24, 25, 28, 36, and 41;

5. Portions of the discovery deposition of Rene Earnhardt, President of Applicant - (1st Notice of Reliance - 45 TTABVUE) and confidential exhibits thereto (2nd Notice of Reliance - 46 TTABVUE);
6. Printed publications relating to Dale Earnhardt, including, articles, dictionary and encyclopedia entries, and references in books (3rd Notice of Reliance – 47 and 48 TTABVUE);
7. Testimony deposition of George Taulbee, Partner of Alston & Bird, offered as rebuttal evidence (63-65 TTABVUE); and
8. Testimony deposition of Judy Queen, Vice President of Operations of Dale Earnhardt Inc., offered as rebuttal evidence (66 TTABVUE).

Applicant's testimony and evidence:

1. Testimony deposition of Rene Earnhardt, President of Applicant (56 TTABVUE);
2. Testimony deposition of Kelley Earnhardt Miller, General Manager of JR Motorsports (56 TTABVUE);

⁸ As discussed infra, we find the pleadings amended by implied consent of the parties, thus these registrations have been considered.

Opposition Nos. 91205331 and 91205338

3. Testimony deposition of Kerry Dale Earnhardt, Co-founder and CEO of Applicant (56 TTABVUE);
4. Testimony deposition of Stephanie Nance, Library Director at Applicant's law firm (56 TTABVUE);
5. Testimony deposition of Mary Becker, Vice President of Sales and Marketing for Schumacher Homes (60 TTABVUE)
6. Testimony deposition of Amy L. Hallman, of Roush Yates Racing Engines (61 and 62 TTABVUE);
7. Printed publications consisting of articles regarding Dale Earnhardt, Jr., son of Dale Earnhardt, and other members of the Earnhardt family (1st Notice of Reliance - 52 TTABVUE);
8. Portions of the discovery deposition of Judy Queen (2nd and 3rd Notice of Reliance – 53 and 54 TTABVUE);
9. Printouts from the Dale Earnhardt Incorporated Store website <http://www.daleearndhardtinc.com/store/index.php> (2nd Notice of Reliance – 53 TTABVUE); and
10. Opposer's Responses to Applicant's First Set of Interrogatories (2nd Notice of Reliance – 53 TTABVUE).

Background.

As previously noted (see footnote 5), Dale Earnhardt was a professional race car driver who died in 2001. Opposer is the widow of Dale Earnhardt. Opposer's Brief, 68 TTABVUE 9. Applicant's co-founder and CEO, Kerry Dale Earnhardt (Kerry Earnhardt), is the son of Dale Earnhardt and stepson of Opposer (Kerry Earnhardt Test., 58 TTABVUE 98). *Id.* at 104. Kerry Earnhardt raced professionally in NASCAR from 1992 – 2006. Kerry Earnhardt Test., 58 TTABVUE 16. He expanded his reputation outside of the racing arena where for approximately fifteen years,

Opposition Nos. 91205331 and 91205338

Kerry Earnhardt made numerous television appearances on “outdoor shows.” *Id.* at 18.

Standing.

Opposer has made Registration No. 1644237 for the mark DALE EARNHARDT (in typed form), and her other registrations consisting of or containing the mark DALE EARNHARDT in stylized form, of record. She has established common law rights by virtue of the introduction of evidence of use of the mark DALE EARNHARDT in connection with other goods and services. Accordingly, she has a stake in the outcome of this proceeding and we find that Opposer has established her standing. *See Coach Services Inc. v. Triumph Learning LLC*, 101 USPQ2d 1713, 1727 (Fed. Cir. 2012); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Priority.

Priority is not at issue as to the goods and services covered by the pleaded registration for the mark DALE EARNHARDT (in typed form) in view of Opposer's introduction into evidence of this registration. *See Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1167 (TTAB 2001); and *King Candy Co. v. Eunice King's Kitchen*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). As discussed, *infra*, Opposer may also rely on her other registrations of record because they were tried by implied consent. Fed. R. Civ. P. 15(b)(2). Likewise, priority is not at issue with respect to the marks and the goods and services covered by these registrations. However, priority

Opposition Nos. 91205331 and 91205338

must be established with respect to any goods or services that are not covered by Opposer's registrations of record.

Opposer did not plead with specificity in the notices of opposition the goods and services upon which she was using the marks DALE EARNHARDT and EARNHARDT and for which she claims common law rights in these marks.⁹ Further, Opposer did not introduce evidence establishing use of these marks on any goods or services, other than those identified in the registrations, during her testimony in-chief. However, Applicant did introduce such evidence. Applicant introduced portions of the discovery deposition of Judy Queen, Vice President of Operations of Dale Earnhardt Inc., in which Ms. Queen introduced and authenticated royalty reports for the years 2010 – 2012,¹⁰ evidencing sales of goods sold under the mark DALE EARNHARDT. Thereafter, during the rebuttal testimony period, Opposer introduced the testimony of George Taulbee, Opposer's attorney and Judy Queen to bolster the evidence introduced by Applicant.¹¹

Although the goods and services for which Opposer claims rights accrued through use of her marks were not specifically identified in the pleadings, the claim and sales of the goods and services may be deemed tried by implied consent. "When

⁹ Paragraph 9 of the amended notices, filed on October 23, 2013, states:

"Moreover, since at least as early as 1975, the designations EARNHARDT and DALE EARNHARDT have been used continuously in this country as both trademark and service marks by Dale Earnhardt and his successor-in-interest and their licensees, on and in conjunction with a wide array of goods and services."

¹⁰ In the confidential portion of her discovery deposition, Judy Queen, Vice President of Operations of Dale Earnhardt Inc. introduced license royalty reports for the years 2010, 2011, and 2012. Confidential Exhibits to Queen Dep., 54 TTABVUE 96-106. Due to the confidential nature of these reports, we decline to discuss specifics thereof.

¹¹ Applicant did not object to this evidence as being improper rebuttal.

Opposition Nos. 91205331 and 91205338

issues not raised by the pleadings are tried by the express or implied consent of the parties, the Board will treat them in all respects as if they had been raised in the pleadings.” *Conolty v. Conolty O’Connor NYC LLC*, 111 USPQ2d 1302, 1306 (TTAB 2014) (nonownership claim tried by implied consent under Fed. R. Civ.P. 15(b)(2)); *Embarcadero Technologies Inc. v. RStudio Inc*, 105 USPQ2d 1825, 1828-29 (TTAB 2013)(answer deemed amended to include a Section 18 affirmative defense); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1138 (TTAB 2009).

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. *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1872 n.3 (TTAB 2011) (although opposer did not properly plead its fame for purposes of dilution, the Board deemed the dilution claim amended by implied consent); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d at 1138; *Kasco Corp. v. Southern Saw Service Inc.*, 27 USPQ 2d 1501, 1504 (TTAB 1993) (defendant raised no objection to evidence on unpleaded issue and was fairly apprised of its purpose). Fairness dictates whether an issue has been tried by implied consent – there must be an absence of doubt that the nonmoving party is aware that the issue is being tried. *Cf. 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

Opposition Nos. 91205331 and 91205338

likelihood of confusion until opposer filed rebuttal notice of reliance); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d at 1139.

In this case, not only did Applicant not object to the introduction of information about the unpleaded registrations and specific goods and services not covered by the registrations, but, as discussed above, Applicant, itself, introduced evidence of sales of specific goods. As such, Applicant was aware that the issue was being tried. Accordingly, we deem the evidence regarding the unpleaded registrations and specific goods and services offered by Opposer to have been tried by implied consent. We now consider the testimony related to goods and services not covered by the registrations.

Mr. Taulbee testified about DALE EARNHARDT-licensed products reported by licensees. There were no custom built homes listed and the only furniture item included was “beanbag chairs.” Taulbee Test. 63 TTABVUE 64. Other goods that he categorized as “home furnishings” included items such as, “plates, figurines, ornaments, ornament plates, clocks, and tabletop figurines” Taulbee Test., 63 TTABVUE 65. These goods appeared in the 2010 license royalty reports.¹² While the reports did not break down sales or royalties by individual items, they are evidence that the goods were sold in 2010, which is prior to the constructive use dates for Applicant’s mark, established by the filing dates of Applicant’s applications (July 28, 2011 and August 6, 2011). Therefore, with respect to “beanbag chairs,” “plates,” “figurines,” “ornaments,” “ornament plates,” “clocks,” and “tabletop figurines,”

¹² The license royalty reports for the years 2010, 2011, and 2012 were also introduced by Opposer in the confidential portion of Opposer’s attorney, George Taulbee’s Testimony Confidential Exhibits to Taulbee Rebuttal Test., 65 TTABVUE 65-74.

Opposition Nos. 91205331 and 91205338

Opposer has established priority based on use of the mark DALE EARNHARDT since at least as early as 2010.

Mr. Taulbee also testified in regard to use of the mark EARNHARDT, specifically, that it was used in connection with license plate frames, stuffed animals, apparel items and die-cast cars. *Id.*, at 19. He testified that “those are the [sic] several that I spotted off the top of my head, but I will say I’m sure this is not an exhaustive [list] of every product that was ever produced bearing Mr. Earnhardt’s rights from 1990 until 2014.” *Id.*, at 54. Examples of use of the mark EARNHARDT are depicted in photographs of the following products: apparel (sweatshirt, t-shirts, caps), license plate frame, stuffed animal, and die-cast car.¹³ Taulbee Test. 64 TTABVUE 117, 119, 121, 127, 129, and 132. Opposer has not, however, established priority in the mark EARNHARDT based on use, because did not testify as to which, if any, products were sold prior to 2011.

With respect to use of EARNHARDT in connection with real estate, Judy Queen testified that two of Teresa Earnhardt’s companies relate to real estate: Earnhardt Rental Properties, LLC “holds residential properties that we lease to others” and Earnhardt Real Properties, LLC “holds business properties that we lease to others.” Queen Test., 66 TTABVUE 9. No evidence was submitted to prove service mark use of either “Earnhardt Rental Properties, LLC” or “Earnhardt Real Properties LLC.” Ms. Queen also testified about the use of “Dale Earnhardt Inc. The Venues” for property rented for special events. *Id.* at 85-94. However, she did not testify about

¹³ Most of these photographs included other indicia of Dale Earnhardt, i.e., the number 3.

Opposition Nos. 91205331 and 91205338

when the mark was first used. Amy Hallman¹⁴ testified that while she was familiar with Opposer leasing out The Trophy Room and The Showroom, she was not familiar with “The Venue” or the brochure therefor bearing the mark DALE EARNHARDT INC. THE VENUE because “[t]he Venue was not in existence” while she was employed by Opposer’s company. Hallman Test., 61 TTABVUE 38. No evidence was introduced establishing service mark use of “Earnhardt Rental Properties, LLC,” “Earnhardt Real Properties LLC” or “Dale Earnhardt Inc. The Venues” prior to the constructive use dates of Applicant’s mark, established by the filing dates of Applicant’s applications (July 28, 2011 and August 6, 2011). Accordingly, Opposer has not established priority with respect to use of any of the referenced EARNHARDT formative marks in connection with services.

Likelihood of Confusion.

Our determination of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

Fame of Opposer’s Mark.

We start our analysis with the fifth *du Pont* factor, the fame of the prior mark. “Fame for confusion purposes arises as long as a significant portion of the relevant consuming public ... recognizes the mark as a source indicator.” *Palm Bay Imports*

¹⁴ Ms. Hallman worked for Opposer’s company from 1995 through March 2013 and handled licensing issues. Hallman Test., 61 TTABVUE 8-10. During her last years at Opposer’s company, her title was “Licensing Coordinator.” Queen Test., 66 TTABVUE 28.

Opposition Nos. 91205331 and 91205338

Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1695 (Fed. Cir. 2005). Each of Opposer's registered marks contains the name "DALE EARNHARDT." It is uncontested that Dale was "perhaps the best known driver on the NASCAR (National Association for Stock Car Auto Racing) circuit [and was] credited with helping popularize the sport ... [Dale] was killed in an accident on the final lap of the 2001 Daytona 500." 9 Encyclopedia Americana International Edition, © Scholastic Library Publishing 2004. 47 TTABVUE 28.

Opposer characterizes the licensed merchandise sold under the DALE EARNHARDT mark as "collectibles"¹⁵ and states that the "clothing and memorabilia¹⁶ continue to be the biggest sellers," with the most popular products being apparel, die-cast cars, and trading cards. *Id.*

The only evidence relevant to establishing the fame of Opposer's DALE EARNHARDT trademark consists of statements in the publication, SPORT MARKETING.¹⁷ Opposer testified that before Dale Earnhardt's death, sales of

¹⁵ We take judicial notice that "collectible" is defined as "good for collection: considered valuable by collectors" and "suitable for being collected" in Merriam-Webster On-line Dictionary, <http://www.merriam-webster.com/dictionary/collectible>, © Merriam-Webster Incorporated.

The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions. *In re Red Bull GmbH*, 78 USPQ2d 1375, 1377 (TTAB 2006).

¹⁶ We take judicial notice that "memorabilia" is defined in Merriam-Webster On-line Dictionary as "objects or materials that are collected because they are related to a particular event, person, etc.: things collected as souvenirs." <http://www.merriam-webster.com/dictionary/memorabilia>, © Merriam-Webster Incorporated.

¹⁷ BERNARD J. MULLEN, ET AL., SPORT MARKETING (3d. Ed. 2007) 201, 47 TTABVUE 10

Opposition Nos. 91205331 and 91205338

DALE EARNHARDT brand licensed merchandise totaled \$50-million annually and reached \$60-million after his death. The statements in the publication regarding these figures constitute hearsay and their truth or veracity were not corroborated or otherwise verified by Opposer with additional evidence. Moreover, Applicant notes that since 2001 (the year of Dale Earnhardt's death), sales of Dale Earnhardt-licensed merchandise have declined. Applicant's Brief 73 TTABVUE 16. Applicant's statements are supported by the record.¹⁸

Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). In this case, while Opposer has established the renown of Dale Earnhardt, the former race car driver, there is no evidence that Opposer has established the fame of the mark DALE EARNHARDT with respect to any goods. Moreover, even if we were to find that the mark DALE EARNHARDT is famous, such finding does not extend to Opposer's rights in the name EARNHARDT, by itself. Simply put, Opposer has not demonstrated fame, for purposes of likelihood of confusion, for either of its DALE EARNHARDT and EARNHARDT marks.

¹⁸ As indicated in n. 8, in the confidential portion of his testimony, Mr. Taulbee introduced license royalty reports for the years 2010, 2011, and 2012. Without discussing the specifics thereof, it is noted that the sales and royalties were not sufficient to establish that the DALE EARNHARDT mark is famous. Confidential Exhibits to Taulbee Test., 65 TTABVUE 65-74.

Opposition Nos. 91205331 and 91205338

Similarity/Dissimilarity of the goods and services.

The combined goods and services currently covered by Opposer's registrations are:

Metal goods, namely, key rings, key chains, metal novelty license plates and metal license plates and metal tag holders in Class 6;

Pocket knives in Class 8;

Pre-recorded compact disks, all featuring sports; magnets in Class 9;

License plate holders; license plate frames; novelty license plate holders; novelty license plate frames; non-metal license plate holders, non-metal license plate frames in Class 12;

Jewelry, namely lapel pins and charms; and belt buckles in Class 14;

Stickers; bumper stickers; window stickers; decals; paper goods and printed material, namely, brochures, pamphlets; paper goods and printed material, namely, trading cards, posters, trading cards, commemorative stamps featuring sports, note cards, calendars, and mounted photographs; wall calendars, card sets, and brochures and books directed to automobile racing in Class 16;

Non-metal key rings; non-metal key chains; non-metal novelty license plates; non-metal license plates; plaques of bone, ivory, plaster, plastic, resin or wood; seat cushions and cushions in Class 20;

Housewares and glass, namely, drinking glasses, cups, mugs; rubber, plastic or foam insulating beverage holders and water bottles sold empty in Class 21;

Afghans, towels, fabric flags, and cloth pennants in Class 24;

Clothing, namely, shirts, sport shirts, golf shirts, polo shirts, T-shirts, tank tops, jackets, coats, caps and hats;

Opposition Nos. 91205331 and 91205338

sweatshirts, sweat pants, shirts, jerseys, shorts, pants, jackets, coats, hats, caps, visors, raincoats, and pajamas, warm-up sets, headbands, straw hats, socks and infant sets in Class 25;

Toys and sporting goods, namely, miniature automobiles and trucks; radio controlled cars, sports table top games; stuffed toys; stuffed toy animals; and Christmas tree ornaments, except confectionery or illumination articles in Class 28;

Charitable fund raising; charitable fund raising services; charitable services, namely, providing financial assistance in the fields of education, children, human services, environmental, and wildlife in Class 36; and

Entertainment services in the nature of conducting, sponsoring and participating in automobile related exhibitions; charitable services, namely, providing books to needy persons; entertainment services in the nature of participating in professional automobile races and related exhibitions in Class 41.

Opposer's First Notice of Reliance, 45 TTABVUE 7-21. These goods and services are primarily memorabilia/novelty items, clothing, and professional automobile racing services. None of the registrations cover furniture or custom home building and Opposer did not proffer any testimony or evidence to prove that the goods and services in the pleaded registrations were related to Applicant's goods and services. Instead, Opposer relied on asserted common law use of the DALE EARNHARDT mark to prove that her goods are similar or related to Applicant's proposed goods and services.

To establish Opposer's common law use on goods, three witnesses testified about licenses that were granted by Opposer. Those witnesses were Amy Hallman, Judy Queen, and George Taulbee.

Opposition Nos. 91205331 and 91205338

Ms. Hallman testified that the goods licensed under the DALE EARNHARDT mark were “apparel, die-cast, key chains. Just different novelty items,”¹⁹ and that while Opposer did not do any business in custom homes or home building, there was one licensee, Klaussner Home Furnishing, who manufactured a recliner chair; the duration of the license was one or two years and it terminated in 2002 or 2003.²⁰

Judy Queen confirmed Amy Hallman’s testimony that neither Teresa Earnhardt nor DEI [Dale Earnhardt Incorporated] is engaged in the furniture business.”²¹ Mr. Taulbee testified that the DALE EARNHARDT mark was licensed for use on “adult furniture, youth furniture, Afghans, wall hangings, tapestries, floor décor, bathroom items, everything from items to towels, bedroom items, including bedding items, lamps, glassware, houseware, and I mean on and on.”²² However, with the exception of bean bag chairs, there was no evidence submitted of use of the DALE EARNHARDT mark in connection with adult furniture or youth furniture.²³ Further, the royalty reports do not reflect the building or sale of custom built homes. *Id.*

Mr. Taulbee also testified that the mark EARNHARDT alone was used in connection with various goods.²⁴ However, little evidence was submitted supporting

¹⁹ Hallman Test., 61 TTABVUE 11.

²⁰ *Id.* at 11 – 12.

²¹ Queen Testimony 66 TTABVUE 35.

²² Taulbee Test., 63 TTABVUE 19.

²³ With the exception of what appears to be a small amount of bean bag chairs, the royalty reports do not reflect sales of any furniture items. See n. 8 and reference to Confidential Exhibits to Taulbee Test., 65 TTABVUE 65-74.

²⁴ *Id.*

Opposition Nos. 91205331 and 91205338

such use and most of that evidence included other established indicia of Dale Earnhardt, such as the number 3 or a depiction of Dale Earnhardt.²⁵ Moreover, no evidence was submitted establishing use of the mark EARNHARDT with or without indicia of Dale Earnhardt, on or in connection with furniture.

Based on the record, we find that Applicant's goods and services are not related to Opposer's goods and services.

Channels of trade and sophistication of customers.

Looking next at the third and fourth *du Pont* factors, we note that there are no restrictions on the channels of trade in the identifications of goods and services in the applications. Accordingly, it is presumed that Applicant's furniture and custom construction of homes will move in all channels of trade that would be normal for furniture and custom construction of homes, and that the goods and services would be purchased by all potential customers thereof. See: *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (“[W]here the goods in a cited registration are broadly described and there are no limitations in the identification of goods as to their nature, type, channels of trade or classes of purchasers it is presumed that the scope of the registration encompasses all goods of the nature and type described, that the identified goods move in all channels of trade that would be normal for such goods, and that the goods would be purchased by all potential customers.”).

With respect to the custom construction of homes, Rene Earnhardt, President of Applicant, testified that to purchase one of the custom designed houses of interest, a

²⁵ See n. 13.

Opposition Nos. 91205331 and 91205338

customer must have his/her own land and go to one of the builder's brick and mortar design centers to meet with a sales representative for the purpose of picking and choosing a specific home plan. *Rene Earnhardt Test.*, 56 TTABVUE 30. While there is no evidence that ownership of land is ordinarily required to purchase a custom designed house, it is logical that the consumer would have a site on which to build the home, that purchasers would, at a minimum, need to meet with representatives of the builder to pick and choose a specific home plan and specific features of the home, and that consumers would have to have the financial wherewithal to afford to build a custom designed house

With respect to Applicant's furniture, no evidence was introduced regarding the channels of trade, however, it is common knowledge that furniture is sold to consumers in all walks of life in both brick and mortar and on-line furniture stores, as well as in furniture departments in both brick and mortar and on-line department stores.

The goods and services in Opposer's registrations are broadly identified and as such are not restricted to racing souvenirs and memorabilia. While these types of goods and services can be sold through various channels of trade, they are not likely to be encountered by the same consumers under circumstances likely to give rise to the mistaken belief that the products and services of the parties emanate from a single source. In other words, the goods and services are not sold in the same marketing milieu.

Opposition Nos. 91205331 and 91205338

The rights claimed by Opposer with respect to other goods, for example, bean-bag chairs (manufactured under license by The Northwest Company), figurines and plates (manufactured under license by Hamilton/Bradford EX), and clocks (licensed to DE Village), are common law rights and thus there is no presumption about channels of trade, and we must look to the channels of trade established by the evidence. The record establishes that the channels of trade consist of sales at chain stores, online marketing, Opposer's retail store and track side trailers. *Queen Test.*, 66 TTABVUE 13. These channels of trade do not overlap with the current and proposed channels of trade for Applicant's goods and services.

Further, the customers differ. Opposer asserted that:

[p]urchasers of Opposer's licensed merchandise are likely to be impulse buyers of Dale Earnhardt apparel and memorabilia. This merchandise is typically sold at a low price point.

Opposer's Brief, 68 TTABVUE 29. Opposer's customers were also described as "core race fans." *Hallman Test.*, 61 TTABVUE 19. Customers purchasing inexpensive merchandise at low prices are not sophisticated customers. In contrast, purchasers of Applicant's furniture and custom homes are

likely to consider their choices longer and are thus less susceptible to confusion as to source. For one, tradition furniture is expensive, and building a home is dramatically more so. The price of Schumacher's custom homes range from \$100,000 to \$450,000.²⁶

Applicant's Brief, 72 TTABVUE 40. As such, these customers are sophisticated customers.

²⁶ *Becker Test.*, 60 TTABVUE 15-16.

Opposition Nos. 91205331 and 91205338

Based on the evidence of record, we conclude both that Opposer's and Applicant's goods and services travel in different channels of trade and are sold to both different customers, as well as different classes of customers (non-sophisticated v. sophisticated).

Similarity or dissimilarity of the marks at issue.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). Applicant's mark is EARNHARDT COLLECTION (in standard character form). Opposer's marks are DALE EARNHARDT (in typed form), EARNHARDT, and DALE EARNHARDT (in stylized form) alone and in conjunction with other verbiage and designs as depicted below:



While “the similarity or dissimilarity of the marks is determined based on the marks in their entireties ... there is nothing improper in stating that, for rational

Opposition Nos. 91205331 and 91205338

reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties.” *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant’s mark consists of the name EARNHARDT and the word COLLECTION. EARNHARDT is the dominant part of the mark because the other portion of the mark, COLLECTION is descriptive and has been disclaimed. Descriptive matter may have less significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) (“Regarding descriptive terms, this court has noted that the ‘descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.’”) (quoting *In re Nat’l Data Corp.*, 224 USPQ at 752); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) (disclaimed matter is often “less significant in creating the mark’s commercial impression”).

Further reinforcing the importance of the name EARNHARDT as the dominant portion of Applicant’s mark EARNHARDT COLLECTION is the fact that the name EARNHARDT is the first part of the mark. The first part of a mark is the portion most likely to be impressed upon the mind of a purchaser and remembered. *See Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988).

Opposition Nos. 91205331 and 91205338

Comparing Applicant's mark, EARNHARDT COLLECTION, as a whole to the registered mark DALE EARNHARDT, we find that consumers encountering Applicant's and Registrant's marks are more likely to focus on the dominant surname in both marks. *See, e.g., Chatham Int'l*, 380 F3d 134-, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) (JOSE GASPAR GOLD confusingly similar to GASPAR'S ALE); *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1139 (TTAB 2015); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1446-47 (TTAB 2014) (BRUCE WINSTON confusingly similar to WINSTON and also to HARRY WINSTON).

Accordingly, we find that the Opposer's marks DALE EARNHARDT and EARNHARDT and Applicant's mark EARNHARDT COLLECTION are similar in appearance, sound, connotation and commercial impression. *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Family relationship between the parties.

Opposer argues that under the thirteenth *du Pont* factor, we need to consider the family relationship between the parties because it is an additional factor which supports a finding of likelihood of confusion." Opposer's Brief, 68 TTABVUE 30. Opposer relies on the *Harry Winston* case to support this argument. Opposer's reliance is misplaced. In *Harry Winston*, not only was Applicant's Chairman, Bruce Winston the son of Harry Winston, the man who founded Opposer, but both parties were in the jewelry business. *Harry Winston* at 1440 – 1441. The Board stated:

Opposition Nos. 91205331 and 91205338

[T]his direct family relationship interacts with the fame of the mark HARRY WINSTON in a way that is significant in this case. The evidence shows that the father-son relationship between Harry Winston and Bruce Winston has been discussed in the press, whether accurately or inaccurately.

Because Harry Winston was a well-known figure and HWI's mark HARRY WINSTON is famous in the field of jewelry, the relationship between Harry Winston and Bruce Winston creates a higher degree of public excitement than would a relationship that did not involve a famous name. Bruce Winston has acknowledged that his relationship to his father is part of his public identity.

In the current case, Opposer's family business is car racing. Applicant's principal's sister, Kelley Earnhardt Miller testified that members of the Earnhardt family consider themselves to be a racing family because:

[W]e have been racing since my papaw Ralph was on the dirt tracks back in the '50s.

Since them pretty much every member of our family races, my dad, my brothers, myself, my aunt Kathy, both of my daughters race today, Bobby and Jeffrey, Kerry and Rene's sons.

Kelley Earnhardt Miller Test., 56 TTABVUE 77. Kerry Earnhardt raced professionally in NASCAR for different racing companies, including Opposer's company from 1992 – 2006. Kerry Earnhardt Test. 58 TTABVUE 21. Kerry Earnhardt established his own reputation and, in 2004, he registered his name as used in connection with automobile racing and souvenirs and memorabilia therefor. Nance Test., Exhibit 18, 60 TTABVUE 78-80. Opposer was aware of Kerry Earnhardt's use and registration of his name in connection with car racing. Further,

Opposition Nos. 91205331 and 91205338

Opposer's company managed the licensing of Kerry Earnhardt's name and image to sponsors. Kerry Earnhardt Test. 58 TTABVUE 23.

The goods and services at issue are not related to car racing. The purchasers are not necessarily racing fans. While the EARNHARDT COLLECTION custom home design services were "launched at the NASCAR Hall of Fame on October the 12th, 2011,"²⁷ Applicant required promotional material to include Kerry Earnhardt's name, image, or likeness "or something to that effect in order to connote that Kerry is the sponsor of [the] enterprise."²⁸ Thus, while using the background of both his and his family's business to launch his new venture, Kerry Earnhardt took steps to associate the EARNHARDT COLLECTION mark for home design services with him, his immediate family and his company, rather than with his father or Opposer; thus minimizing the possibility of likelihood of confusion.

Thus, we find that the relationship between the parties does not affect a determination of likelihood of confusion.

Absence of actual confusion.

With respect to the seventh *du Pont* factor, Applicant argues that Opposer's failure to provide evidence of actual confusion favors a finding that there is no likelihood of confusion. However, while a showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion, the opposite is not true. The lack of evidence of actual confusion carries little weight,

²⁷ Rene Earnhardt Dep., 45 TTABVUE 113

²⁸ *Id.* at 109.

Opposition Nos. 91205331 and 91205338

J.C. Hall Co. v. Hallmark Cards, Inc., 340 F.2d 960, 964, 144 USPQ 435, 438 (CCPA 1965).

Conclusion.

In weighing the *du Pont* factors, we find the factors against finding a likelihood of confusion, in particular, the second factor regarding the differences in the goods and services, outweigh the factors which support such holding, primarily the first factor regarding the similarity between the marks. This is primarily because the marks are not going to be encountered by the same consumers under circumstances likely to give rise to the mistaken belief that the goods and services emanate from the same source. Therefore, after considering all of the evidence and argument on the relevant *du Pont* factors, whether specifically discussed herein or not, we conclude that Applicant's mark EARNHARDT COLLECTION for furniture and custom construction of homes is not likely to cause confusion with Opposer's marks DALE EARNHARDT and EARNHARDT for its goods and services.

Surname.

Applicant's mark is EARNHARDT COLLECTION. Opposer argues that the term EARNHARDT is primarily merely a surname and that the addition of the word COLLECTION does not make the mark registrable.

Section 2(e)(4) of Trademark Act precludes registration of a mark which is "primarily merely a surname" on the Principal Register without a showing of acquired distinctiveness under §2(f) of the Act, 15 U.S.C. §1052(f). The Board has identified five factors to consider in determining whether a mark is primarily

Opposition Nos. 91205331 and 91205338

merely a surname: (1) the degree of the surname's "rareness"; (2) whether anyone connected with applicant has the mark as a surname; (3) whether the mark has any recognized meaning other than as a surname; (4) whether the mark has the "look and feel" of a surname; and (5) whether the mark is presented in a stylized form distinctive enough to create a separate non-surname impression. *In re Benthin Management GmbH*, 37 USPQ2d 1332-1333 (TTAB 1995). Since the mark EARNHARDT COLLECTION is in standard character form, the fifth *Benthin* factor is irrelevant here.

(1) The degree of the surname's "rareness."

We turn to the first *Benthin* factor, which is the degree of the surname's "rareness." Opposer's attorney, Carla Clements accessed the U.S. Census database by conducting a search of the Google database. Clements Test. 51 TTABVUE 8 - 10. She introduced several pages from the census, including one that ranked "Earnhardt" as number 16,852 among common surnames, with 1559 appearances in the census data. *Id.* at 130. While 1559 appearances do not establish that "Earnhardt" is a common surname, it is not so rare that it would not be regarded as a surname. *Cf. In re Binion*, 93 USPQ2d 1531, 1537 (TTAB 2009) (1516 listings of the surname found not to be a rare surname).

Thus, under the first *Benthin* factor, EARNHARDT is not considered a rare surname.

Opposition Nos. 91205331 and 91205338

(2) Whether anyone connected with applicant has the mark as a surname?

“Earnhardt” is the surname of both of Applicant’s principals, Kerry Earnhardt and Rene Earnhardt.

(3) Whether the mark has any recognized meaning other than as a surname?

Opposer conducted a search of the Merriam-Webster Online Dictionary, which revealed no entries for the term EARNHARDT. Clements Test. at 9-10, 132. No evidence was submitted contradicting the search results.

(4) Whether the mark has the “look and feel” of a surname?

There is no dispute that the name EARNHARDT has the “look and feel” of a surname.

Accordingly, under the *Benthin* test, if the mark consisted solely of the name EARNHARDT, it would not be registrable without a showing of acquired distinctiveness. But the mark does not consist solely of the name and we must evaluate the mark EARNHARDT COLLECTION as a whole. “The test for determining whether a mark is primarily merely a surname is the primary significance of the mark as a whole to the purchasing public.” *In re Hutchinson Technology Inc.*, 852 F2d 552, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988). We must determine, therefore, whether the addition of the word “Collection” diminishes the surname significance of the name “Earnhardt” in the mark EARNHARDT COLLECTION.

Opposer correctly asserts that it is settled law “that combining a surname with the generic name for the goods or services does not overcome a mark's surname

Opposition Nos. 91205331 and 91205338

significance.”²⁹ *Miller* at 1622. Opposer contends that “[c]ollection’ is a generic designation for both furniture and the custom construction of homes” because the word “collection” is “used often to identify a group of homes or home furnishings.”

Opposer’s Brief 60 TTABVUE 18-19.

To determine whether the term is generic, the critical issue is “whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question.”³⁰ *H. Marvin Ginn Corp. v. International Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). Making this determination “involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?” *Ginn*, at 530. The genus of Applicant’s goods is “furniture” and the genus of Applicant’s services is “custom construction of homes.”

Opposer introduced webpages from various sites to establish that “collections” is generic for furniture. Examples are: Thomasville Furniture Collections, Horchow Furniture, Crate&Barrel, and Ashley Furniture Home Store. Clements Test. at 13, 26, 29, and 32-24. In each example, the word “collection” is used to describe either a grouping of brands of furniture (Thomasville Furniture AMERICAN ANTHEM) or a grouping of furniture by use (Horchow Dining Collections). *Id.* at 26, 29. The word, “collection,” does not refer to any class or category of furniture, and therefore, while

²⁹ Opposer’s Brief, 68 TTABVUE 18.

³⁰ Opposer correctly refers to the genus of the goods and services as “the class or category of goods or services.” Opposer’s Reply Brief, 74 TTABVUE 8.

Opposition Nos. 91205331 and 91205338

it may be descriptive of the manner in which some furniture is marketed or sold, namely by groupings of brands or groupings of uses, it is not generic.

With respect to the use of the word “collection” in connection with the “housing industry,” Mary Becker, Vice President of Sales and Marketing of Shumacher Homes testified that her company uses the term “collection to describe the architectural style of the EARNHARDT COLLECTION homes and that other companies use the term “collection” to indicate that their homes have certain features. Becker Test, 50 TTABVUE 50. Ms. Becker also testified that in the housing industry the term collection could be used to identify a portfolio or group of homes or home designs. *Id.* at 52. The term “collection” does not refer to any class or category of “home design,” but rather describes a manner in which the services are offered, namely grouped by features or by type of architecture.

Since the term “collection” is neither the name of Applicant’s furniture nor the name of Applicant’s custom construction services, it does not refer to the genus of the goods and services and thus, is not generic.

Opposer also argues the “if [] a composite designation is comprised of a surname coupled with a term that is merely descriptive of the relevant goods or services, it must be determined whether the inclusion of that descriptive term diminishes the primary significance of the composite designation as a surname.” Reply Brief, 74 TTABVUE 8. Opposer’s conclusion is based on the *Miller* case, which Opposer has misinterpreted. The question posed in *Miller* is whether upon a finding that the surname portion of the mark is primarily merely a surname, does the combination

Opposition Nos. 91205331 and 91205338

with other wording diminish the surname significance. The Board then determined that the surname significance is not diminished if the added wording is generic.³¹ *Miller* at 1622. Conversely, in the current matter, since the term “collection” is not generic, the addition of the term to the surname EARNHARDT does diminish the surname significance.

In *In re Hutchinson Technology, Inc.*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988), the Court of Appeals for the Federal Circuit addressed the issue of whether the addition of a commonly used term (TECHNOLOGY) that is not generic alters the significance of a surname (HUTCHINSON). The Court noted the Board’s finding in the initial appeal that

‘technology’ is not the common descriptive or generic name for Hutchinson’s product. However, ... the term ‘technology’ is commonly used in connection with goods similar to those listed in Hutchinson’s application [“etched metal electronic components; flexible circuits; actuator bands for disk drives; print bands; increment discs; and flexible assemblies for disk drives”].

Id. at 1491.

The Court equated the common use of the term, “technology,” with descriptiveness and determined the fact that the term ‘technology’ is used in connection with computer products does not mean that the term is descriptive of them. Although the issue of descriptiveness was discussed, the Court did not change

³¹ There was no discussion in the *Miller* case about the addition of a merely descriptive term to a surname. Further, Opposer provided no evidence of the refusal of such marks. However, Applicant provided evidence of several registrations for marks consisting of terms that are primarily merely surnames combined with the word COLLECTION. Appeal Brief, 72 TTABVUE 21, n. 5.

Opposition Nos. 91205331 and 91205338

the test for determining whether adding language to a surname alters the significance of the surname.³²

The issues in the case at bar are similar to those in *Hutchinson Technology*. In categorizing the term “technology,” the Court noted that

Many other goods possibly may be included within the broad term ‘technology,’ but that does not make the term descriptive of all of those goods. At most, all that may be concluded from Hutchinson’s concession is that a mark including the term ‘technology,’ which mark is used on computer products, is a weak mark for those goods.

A mark is merely descriptive of a product if it would immediately convey to one seeing or hearing it the thought of appellant’s product. --- The term technology does not convey an immediate idea of the ingredients, qualities or characteristics of the goods listed in Hutchinson’s application. Therefore, the term ‘technology’ is not merely descriptive of Hutchinson’s goods and we conclude that the finding that the term ‘technology,’ standing alone is merely descriptive of Hutchinson’s goods is clearly erroneous.

Hutchinson Technology at 1492-1493. As discussed *supra*, Opposer has submitted evidence establishing that the term “collection” is commonly used in connection with both “custom homes” and “furniture.” Opposer argues that such common usage renders the term generic. Opposer’s Brief, 68 TTABVUE 18. It does not. The term “collection” is not the common descriptive or generic name for Applicant’s furniture or its custom building of homes. When the wording (in this case, “Collection”)

³² Specifically, the Court found that, while the term “technology” is commonly used and so should be disclaimed, it did not convey an immediate idea of the ingredients, qualities or characteristics of the furniture or the custom building of homes and thus was not merely descriptive. The Federal Circuit remanded the case to the Board “to give Hutchinson time to file the required disclaimer,” 7 USPQ2d at 1493, and not for application of the proper test for descriptiveness as asserted by Opposer in her Reply Brief, 74 TTABVUE 10.

Opposition Nos. 91205331 and 91205338

combined with the surname (in this case, “Earnhardt”) is capable of functioning as a mark, the mark (in this case, EARNHARDT COLLECTION) is not considered to be primarily merely a surname. TMEP § 1211.01(b)(vi) (July 2015).

Accordingly, we find that the mark EARNHARDT COLLECTION for furniture and custom building of homes is not primarily merely a surname.

Conclusion.

Based on the evidence submitted, we find: (1) there is no likelihood of confusion between Opposer’s marks DALE EARNHARDT and EARNHARDT for various goods and services, primarily categorized as racing memorabilia or souvenirs and Applicant’s mark EARNHARDT COLLECTION for furniture and custom construction of homes; and (2) the mark EARNHARDT COLLECTION is not primarily merely a surname.

Decision: The opposition is dismissed.