

TTAB



I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO THE COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VA 22203-3512 ON THE DATE INDICATED BELOW

10-21-2002

U.S. Patent & TMOfc/TM Mail RcptDt. #70

BY Cherise J. Jones

DATE: 10-17-02

BOX TTAB - NO FEE

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

MICHAEL GLOSTER and VICTORIA
GLOSTER t/a GLOSTER MARKETING

Opposer,

v.

Opposition No. 113,487

RELIOS, INC.
(formerly Carlisle Jewelry Company, Inc.),

Applicant.

02 OCT 29 PM 9:30
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OPPOSER'S REPLY IN SUPPORT OF ITS MOTION TO SUSPEND

Opposer Michael Gloster and Victoria Gloster t/a Gloster Marketing are compelled to file this reply to address the complete mischaracterization of the actions to date before this Board and the lawsuit brought by Gloster in the Eastern District of Pennsylvania.

Relios accuses Gloster of having done nothing to carry its burden of proof to the Trademark issue pending before the Board. This statement is untrue. To the contrary Gloster filed a Motion for Summary Judgment with the Board. Although the Board denied this Motion, the Opinion written by the Board stated: "We note, however, there will be no issue as to priority if opposer amends its pleadings to rely on its registrations and appropriately introduces them into the record. Also, we do not see likelihood of confusion as an issue which can be seriously disputed. Accordingly, the parties' focus at trial should be on the distinctiveness, or lack thereof,

of opposer's pleaded marks." (Board's Opinion, September 25, 2001, p. 6, n.8). A true and correct copy of the Board's Opinion is attached. Gloster did not bring this Motion to Suspend to "cut its losses" – Gloster expects that were this action to proceed, Relios' mark would be cancelled. Rather Gloster brought this Motion because the Board's more limited scope will not allow this proceeding to resolve all of the issues between the parties.

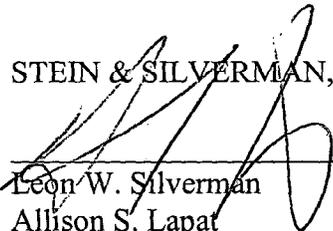
The lawsuit which Gloster has filed in Federal Court concerns Gloster's copyright in its sculptural designs, which Relios stole, Gloster's copyright in its informational materials, which Relios copied, as well as Gloster's trademarks "Loving Family" and "Togetherness" which Relios is wrongfully seeking to appropriate. Gloster is seeking injunctive relief and damages as a result of Relios' infringement on and theft of its intellectual property. None of this relief is available in the pending proceeding before the Board, nor are any of the copyright issues before the Board. Gloster did not file the Federal lawsuit for any improper purpose, but for the very legitimate purpose of having all of the issues between the parties resolved in one forum.

Gloster is seeking to suspend this proceeding to avoid having to litigate in two separate forums. The District Court is the more logical forum now because copyright issues must also be decided and because Gloster is seeking an injunction and damages as a result of Relios' infringement. Were this action to proceed, and the Board to reject Relios' marks, Relios would be entitled to seek a new trial in the District Court. 15 U.S.C. §1701(b).

Gloster thus respectfully requests that the Board suspend these proceedings pursuant to 37 C.F.R. § 2.117. Such a suspension will benefit both parties by allowing all issues between the parties to be resolved in one forum, saving both parties time and money.

Dated: October 17, 2002

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CERTIFICATE OF SERVICE

I, Claudia Givens, Legal Assistant, hereby certify that I served upon the following individual a true and correct copy of the following document: **Opposer's Reply In Support Of Its Motion** on October 17, 2002 via U.S. mail postage prepaid upon the following individual:

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Patent Counsel for Relios


CLAUDIA GIVENS

EXHIBIT



10-21-2002

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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513**

Greenbaum

MAILED

Opposition No. 113,487

SEP 25 2001

Michael Gloster and
Victoria Gloster, t/a
Gloster Marketing

PAT. & T.M. OFFICE

v.

Relios, Inc.

Before Cissel, Hairston and Rogers, Administrative Trademark
Judges.

By the Board.

This case now comes up on opposer's motion (filed May 14,
2001) for summary judgment on the issues of priority and
likelihood of confusion. The parties have fully briefed the
issues.¹

Applicant seeks to register the mark LOVING FAMILY for
jewelry, claiming November 6, 1995 as its date of first use.
In the notice of opposition, opposer alleges that it has used
the marks LOVING FAMILY, DANCING FAMILY and LOVING/DANCING
FAMILY in commerce for statues and statuary since October
1992; that the marks LOVING FAMILY, DANCING FAMILY and
LOVING/DANCING FAMILY are inherently distinctive when used on
statuary; that the marks LOVING FAMILY, DANCING FAMILY and

¹ We have exercised our discretion and have considered opposer's
reply brief. See Trademark Rule 2.127(e)(1).

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LOVING/DANCING FAMILY have achieved a degree of fame for statuary; and that consumers are likely to be confused as to the source of the goods because the goods move in the same trade channels, are sold to the same purchasers and the figures depicted in applicant's jewelry and opposer's statues and statuary, sold under their respective marks, are substantially identical.²

Applicant denied the salient allegations in its answer.

In the summary judgment motion, opposer alleges that a likelihood of confusion exists because the marks are identical, the goods, trade channels and purchasers are similar, and applicant's pendants are miniatures and "admitted copies" of opposer's copyrighted LOVING FAMILY sculptures.³

Opposer further alleges that priority is not an issue because opposer owns Registration No. 2,318,876 for the mark LOVING FAMILY for "sculptures, busts, figures and figurines made of cement, marble or stone." Opposer alleges that this registration issued on February 15, 2000, claiming August 1992

² On October 29, 1999, we denied applicant's motion for summary judgment because there were genuine issues of fact at least with respect to opposer's ownership and prior use of the mark LOVING FAMILY; whether that mark and the marks DANCING FAMILY and LOVING/DANCING FAMILY comprise a family of marks; whether there is a likelihood of confusion among consumers; and whether "loving family" is used in a generic or descriptive sense for Shona sculpture.

³ Whether applicant "copied" opposer's designs, and whether applicant "admitted" that it "copied" opposer's designs, are matters beyond our limited jurisdiction, and will not be addressed herein. We note, however, applicant's categorical denial of both issues.

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as the date of first use and first use in commerce. Opposer also claims that it owns Registration No. 2,316,416 for the mark LOVING/DANCING FAMILY for "sculptures, busts, figures and figurines made of cement, marble or stone," and claims November 1992 as the date of first use in commerce. In addition, opposer claims that it owns pending application Serial No. 75/611,072 for the mark LOVING FAMILY for jewelry.⁴

In response, applicant argues that the facts relevant to the similarities and/or differences of the goods, the purchasers of the goods, and the trade channels through which the goods move, constitute material facts that are subject to dispute. In addition, applicant maintains that there is extensive third-party use of the LOVING FAMILY mark for sculptures. We address this latter issue below.

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material facts, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

⁴ Opposer has not yet filed a motion for leave to amend the notice of opposition to include any of this information. In addition, opposer did not indicate whether it filed the pending application based on actual use of the mark in commerce, or on an intent-to-use basis.

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Upon careful consideration of the arguments and evidence presented by the parties, and drawing all inferences with respect to the summary judgment motion in favor of the nonmoving party, we find that opposer has not demonstrated the absence of a genuine issue of material fact and that it is entitled to judgment as a matter of law. Although opposer established, through the declaration of Michael Gloster, that opposer's use of LOVING FAMILY for sculptures is clearly prior to applicant's use for jewelry, it is not clear that such use vested enforceable common law trademark rights on opposer.⁵ We find that the evidence regarding third-party uses of the mark LOVING FAMILY for Shona sculptures, that applicant attached as Exhibit F to its response to opposer's motion, raises an issue of material fact that cannot be resolved by summary judgment.⁶ Specifically, this evidence reveals that a material issue for trial exists in regard to whether LOVING

⁵ The Gloster declaration was attached as an exhibit to opposer's summary judgment motion. Exhibit A to the Gloster declaration includes a computer printout of this registration from the Trademarkscan database, and indicates that the mark was first used for sculptures in August 1992, and was first used in commerce in September 1992. The Gloster declaration also establishes that opposer owns Registration Nos. 2,318,876 and 2,316,416.

⁶ Exhibit F comprises printouts of articles downloaded from the Internet. Despite our explicit warning to applicant regarding the proper introduction of third-party evidence in our October 29, 1999 order, applicant failed to properly submit the third-party evidence herein. See *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998). We cannot consider improperly introduced evidence in determining whether or not to grant summary judgment in favor of either party. We can, however, consider whether this material indicates that a material issue of fact remains for trial.

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FAMILY is a term in which opposer has, by virtue of its use, acquired trademark rights, or whether it is descriptive of a type of sculpture. Similarly, while we consider opposer's briefing of the motion for summary judgment to include an implicit request for leave to amend its pleading to rely on its registrations, we assume that applicant will counterclaim for cancellation on the ground that LOVING FAMILY and LOVING/DANCING FAMILY are descriptive. This, too, is a material issue requiring trial.⁷

In view thereof, the motion for summary judgment is denied.

Opposer is allowed until October 31, 2001 to file an amended notice of opposition that includes claims of ownership of Registration No. 2,318,876, Registration No. 2,316,416 and/or application Serial No. 75/611,072. If opposer files such notice within the allotted time, applicant has until November 30, 2001 to file an answer thereto, including any counterclaims (with the requisite fees) and/or affirmative defenses. If opposer does not file an amended notice within the allotted time, opposer may seek to add any or all of these claims in the future, but must do

⁷ We recognize that opposer's registrations are entitled to presumptions of validity, and do not mean to imply that we believe the Office erred in allowing the registrations to issue. We merely anticipate that the validity of opposer's registrations will be in issue if opposer amends its notice of opposition to rely on the registrations and applicant amends its pleading to assert a counterclaim to cancel said registrations.

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so by a new motion, rather than by this grant of leave by the Board. If opposer does not file an amended notice by October 31, 2001, the opposition shall proceed to trial on the current pleadings.⁸

This case remains otherwise suspended. Upon resumption, appropriate dates will be set or reset.

⁸ We have not, by this order, entered even partial summary judgment. Thus, all issues raised by the pleadings, or any amended pleadings, remain subject to proof at trial. We note, however, that there will be no issue as to priority if opposer amends its pleading to rely on its registrations and appropriately introduces these into the record. Also, we do not see likelihood of confusion as an issue which can be seriously disputed. Accordingly, the parties' focus at trial should be on the distinctiveness, or lack thereof, of opposer's pleaded marks.