

**THIS OPINION IS NOT
CITABLE
AS PRECEDENT OF
THE TTAB**

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3514**

Greenbaum

Mailed: March 10, 2004

Opposition No. 91119899

DURAMAX MARINE, L.L.C.

v.

R.W. FERNSTRUM & COMPANY

Before Hairston, Rogers and Drost, Administrative Trademark
Judges.

By the Board.

This case now comes up on the parties' cross-motions
for summary judgment. The parties have fully briefed the
issues, and we have considered both reply briefs.¹

For purposes of this order, we presume the parties'
familiarity with the pleadings, the history of the
proceeding and the arguments and evidence submitted with
respect to each motion.

¹ Opposer did not file a response to applicant's motion to strike
opposer's reply in support of its summary judgment motion, or
applicant's motion to strike opposer's response to the cross-
motion for summary judgment insofar as the response pertains to
the issue of equitable estoppel. However, we choose not to grant
the motions as conceded pursuant to Trademark Rule 2.127(a).
Instead, given the convoluted history of this proceeding, we have
reviewed the briefs in their entirety, and have considered them
to the extent that they have helped us to understand the issues
raised on summary judgment.

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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).

Upon careful consideration of the arguments and evidence presented by the parties, and drawing all inferences with respect to the motions in favor of the nonmoving party, we find that neither party has demonstrated the absence of a genuine issue of material fact for trial.

At a minimum, opposer has failed to show the absence of a genuine issue as to whether applicant's mark is descriptive, functional and/or lacking in acquired distinctiveness,² and applicant has failed to show the absence of a genuine issue as to opposer's standing to maintain this proceeding, and whether opposer is estopped from bringing this proceeding. These are issues for trial.

² In this regard, we have interpreted the amended complaint as asserting claims of descriptiveness and functionality, and as including an implicit claim of lack of acquired distinctiveness. See *M. Polaner Inc. v. The J.M. Smucker Co.*, 24 USPQ2d 1059, 1060 (TTAB 1992)("[w]here a petitioner seeks to cancel a registration which has issued under Section 2(f) of the Trademark Act and the petitioner alleges that the respondent's mark is merely descriptive, we believe it is implicit in such allegation that the mark has not acquired distinctiveness (because if it had, it would no longer be merely descriptive.)")

In view thereof, the cross-motions are denied.³ The Board will not entertain any further motions for summary judgment in this proceeding.

Proceedings are resumed. Trial dates are reset as follows:

DISCOVERY PERIOD TO CLOSE: **CLOSED**

Thirty-day testimony period for party in position of plaintiff to close: **May 15, 2004**

Thirty-day testimony period for party in position of defendant to close: **July 14, 2004**

Fifteen-day rebuttal testimony period to close: **August 28, 2004**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

³ The parties should note that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced during the appropriate trial period. *See, for example, Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).