UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: May 28, 2003

Opposition No. **91151109**

MARK D. TANNEN

v.

JAY MACK

Before Simms, Rogers and Drost, Administrative Trademark Judges.

By the Board:

On February 27, 2002, Mark D. Tannen ("opposer") filed a notice of opposition against Jay Mack ("applicant"), alleging that applicant's mark INTELLIWEAR for computer hardware and software[1] so resembles opposer's previously used and registered mark AI AMERICAN INTELLIWARE and Design for computer software[2] and opposer's previously used mark

---

[1] Application No. 75/845,350 for the mark INTELLIWEAR for "wearable computer hardware and computer software, namely, wearable micro processor-powered computers and associated software used for hands free data entry, data storage, data retrieval and data processing, and used for electronic messaging and for connecting to the internet"; filed December 1, 1999 on the basis of applicant's bona fide intent to use the mark in commerce.

[2] Registration No. 1,347,429 for the mark AI AMERICAN INTELLIWARE and Design for "computer software programs and user manuals sold as a unit"; registered July 9, 1985; Section 8 and 15 affidavit accepted and acknowledged.

AMERICAN INTELLIWARE for computer hardware and software[3] as to be likely to cause confusion, mistake or to deceive prospective customers. Applicant has denied the salient allegations contained in the notice of opposition, and asserted that opposer does not own the marks.

Together with his answer, applicant filed (on April 26, 2002) a combined motion to dismiss the opposition on the ground that opposer is not the real party in interest and for summary judgment on opposer's pleaded Section 2(d) claim. Opposer responded to applicant's combined motion to dismiss and for summary judgment, and cross-moved for summary judgment in opposer's favor. Applicant filed a reply brief in support of his combined motion, and moved to strike the declaration submitted by opposer in support of opposer's cross-motion (the “Tannen declaration”). Opposer moved to strike applicant's reply brief as being overly-long, and applicant filed a response to opposer's motion to strike.

Proceedings were suspended on January 22, 2003 to allow consideration of the parties’ dispositive motions. Because the Board, under these circumstances, would normally consider the suspension to have retroactive effect dating back to the filing of the original cross-motions, opposer's

[3] Opposer has not pleaded ownership of a pending application or registration for this mark.

motions (filed October 7, 2002 and December 23, 2002) to extend trial dates are moot.

Applicant also filed a letter, on April 29, 2002, correcting typographical errors in his combined motion, which we have considered. Opposer also filed a "corrected declaration" of Mark D. Tannen on May 28, 2002 and a supplemental corrected declaration on June 26, 2002.

As discussed *infra,* we have treated the supplemental corrected declaration as having replaced the two previously-filed declarations and have considered the supplemental corrected declaration. We have not, however, considered opposer's *Declaration Of Paul J. Reilly In Further Support Of Opposer's Memorandum In Opposition To Applicant's Motion For Summary Judgment* (filed November 20, 2002); *Applicant's Objection To The Declaration Of Paul J. Reilly In Further Support Of Opposer's Memorandum In Opposition To Applicant's Motion For Summary Judgment* (filed December 10, 2002); or *Opposer's Response To Applicant's Objection To Declaration Of Paul J. Reilly Filed November 20, 2002* (filed December 26, 2002). *See* Trademark Rule 2.127(a)("no further papers [filed after the moving party's reply brief] in support of or in opposition to a motion will be considered by the Board.")

This case is now ready for consideration of applicant's combined motion for summary judgment and to dismiss; of

opposer's cross-motion for summary judgment; of applicant's motion to strike the Tannen declaration; and of opposer's motion to strike applicant's reply brief.

We first address opposer's motion to strike applicant's reply brief and applicant's motion to strike the Tannen declaration, as both these motions must be decided prior to consideration of applicant's combined motion to dismiss and for summary judgment as well as opposer's cross-motion for summary judgment.

OPPOSER'S MOTION TO STRIKE APPLICANT'S REPLY BRIEF

Opposer contends that applicant's reply brief should not be considered because it is over length. Reply briefs in support of a motion may not exceed 10 pages in length. *See* Trademark Rule 2.127(a). However, applicant's reply brief is also applicant's motion to strike the Tannen declaration, i.e., a response to opposer's cross-motion for summary judgment. As such, it did not exceed the general page limit (25 pages) for motions and papers responsive to motions. Accordingly, opposer's motion to strike applicant's reply brief is denied.

APPLICANT'S MOTION TO STRIKE THE TANNEN DECLARATION

Applicant contends that the declaration of Mark D. Tannen, submitted by opposer in support of its cross-motion for summary judgment, “asserts claims and facts which are

obviously not within the personal knowledge of the declarant, to wit: legal conclusions, predictions of the future, and in some cases are just simply too fantastic to believe." *Applicant's Reply and Objection,* p. 6. Applicant also contends that the Tannen declaration contains an improper attestation, one not conforming either to Trademark Rule 2.20 or 28 U.S.C. §1746. For these reasons, applicant urges the Board not to consider the Tannen declaration.

In response, opposer submitted a "corrected declaration" on May 28, 2002. The corrected declaration was not accompanied by a brief or other covering letter, and is considered superseded (together with the original Tannen declaration) by the "supplemental corrected declaration," which accompanied opposer's motion to strike applicant's reply brief on June 26, 2002. Therein, opposer has deleted some of the language found objectionable by applicant, but has retained certain assertions regarding his marks, and has amended the attestation to comply with 28 U.S.C. §1746.

Federal Rule 56 requires affidavits submitted with a motion for summary judgment to be based on personal knowledge. A court may consider statements in an affidavit only if they are made on personal knowledge and are sworn to be true and correct. *See* Fed. R. Civ. P. 56(e); *Brady v. Blue Cross & Blue Shield of Tex., Inc.,* 767 F. Supp. 131, 135 (N.D. Tex. 1991). However, if an affidavit fails to

meet the technical requirements of Rule 56(e), a court may nevertheless consider its contents so long as the record as a whole demonstrates that the evidence meets the requirements of Rule 56. *See Brady*, 767 F. Supp. at 135.

Here, Mr. Tannen declares that he is the owner of American Intelliware, which he has operated and managed as a sole proprietorship since the early 1990's; that American Intelliware has sold computer hardware and software under the pleaded marks either through American Intelliware Corporation (allegedly Mr. Tannen's predecessor) or "myself or through my business American Intelliware." Most of the remaining allegations are declarative statements, although some have been made "on information and belief." Exhibits, including a copy of the corporate minutes of a March 2, 1990 Board of Directors meeting of American Intelliware Corporation (over which Mark Tannen, as corporate president, presided), have been introduced through opposer's statement that he is attaching a "copy" of such exhibits to his declaration. To the entire declaration, Mr. Tannen attests: "Pursuant to 28 U.S.C. §1746, I, Mark D. Tannen, further declare under penalty of perjury that the foregoing is true and correct."

Overall, the declaration meets the statutory requirements of Rule 56, and the Board has considered its

contents and exhibits thereto, according due weight to all statements as appropriate.

Accordingly, applicant's motion to strike the Tannen declaration is denied.

APPLICANT'S COMBINED MOTION FOR SUMMARY JUDGMENT AND TO DISMISS; OPPOSER'S CROSS-MOTION FOR SUMMARY JUDGMENT – ON THE ISSUE OF OPPOSER'S STANDING

Applicant's combined motion, insofar as it seeks to dismiss the opposition based on opposer's alleged lack of standing, will be treated as a motion for summary judgment, because matters outside the pleadings (e.g., the 1995 assignment, the 1990 corporate minutes) have been presented. *See* Fed. R. Civ. P. 12(b).

Summary judgment is appropriate where the movant has established that there is no genuine issue of material fact in dispute, thus leaving the case to be resolved as a matter of law. Fed. R. Civ. P. 56(c). In considering whether to grant or deny a motion for summary judgment, the Board may not resolve issues of material fact, but can only ascertain whether genuine disputes exist regarding such issues. A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed.

Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc*., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Applicant seeks judgment on the ground that opposer lacks a real interest in this proceeding. Applicant asserts that the pleaded marks were purportedly assigned to Mark Tannen in 1995 (as is shown by the information contained in the Assignment Branch of the Patent and Trademark Office[4]) but that in 1994, Mr. Tannen's predecessor, American Intelliware Corporation, had had its corporate status suspended and was thus prohibited by state law from transferring any property. Applicant has submitted a certified copy of a "Domestic Corporation Certificate of Filing And Suspension" allegedly showing American Intelliware Corporation's status as suspended on June 1, 1994. Applicant argues that because American Intelliware Corporation has not used the marks since then, they have become abandoned.[5]

Opposer contends that the pleaded marks were actually transferred to him in 1990 during a meeting of the Board of Directors of American Intelliware Corporation and that

---

[4] An assignment of Registration No. 1,347,429 from American Intelliware Corporation to Mark D. Tannen was recorded on July 28, 1995 at Reel/Frame 1372/0192.

[5] Although applicant has not pleaded abandonment as an affirmative defense, we will consider it herein. Should we be inclined to grant summary judgment to applicant on this ground, we would do so only after a suitable amendment to applicant's answer had been made. *See* Fed. R. Civ. P. 56; and TBMP §528.07.

either he or American Intelliware Corporation has used the marks continuously since 1984 and has not abandoned the marks. Opposer has submitted a copy of the March 2, 1990 corporate minutes which indicate that during the meeting "the three (3) following acts were taken and approved, and authorities and licenses were thereby officially granted:

> …
>
> (3) American Intelliware Corporation (CA) hereby officially approves the transfer of title of all American Intelliware Corporation (CA) trademarks … to Mark D. Tannen …."

Minutes of Meeting of Board of Directors of American Intelliware Corporation, a California Corporation, p. 2.

Opposer contends that, at the least, the action taken by the Board of Directors in 1990 raises genuine issues of material fact regarding the date that ownership of the pleaded marks transferred to Mark Tannen, and that the allegations in the Tannen declaration regarding ownership and use of the marks, at the least, raise genuine issues regarding ownership, transfer and abandonment.

We agree. Applicant has not shown that it is entitled to summary judgment as a matter of law. *See* Fed. R. Civ. P. 56(c). Accordingly, applicant's motion for summary judgment on the ground that opposer is not the real party in interest

and does not own the mark, and that the “real” owner of the mark has abandoned it, is denied.[6]

APPLICANT'S COMBINED MOTION FOR SUMMARY JUDGMENT AND OPPOSER'S CROSS-MOTION FOR SUMMARY JUDGMENT – ON THE ISSUE OF LIKELIHOOD OF CONFUSION

Applicant further moves the Board for an order granting summary judgment on opposer's pleaded Section 2(d) claim. Opposer cross-moves for summary judgment on the claim. Both parties assert that there is no genuine issue of material fact as to likelihood of confusion and, therefore, this issue may be decided as a matter of law.

Where both parties have moved for summary judgment, the mere fact that they have done so does not establish that there is no genuine issue of material fact, and that judgment should be entered in favor of one of them. *See* TBMP §528.01 and authorities cited in that section.

In support of its motion for summary judgment, applicant asserts that the marks are not confusingly similar, and in reliance on a printout from its search of the Office’s TESS records (which allegedly “revealed 622 references with 280 registrations which include the letters INTELLI as part of the marks in the computer field”), applicant asserts that “[t]he mere sharing of the prefix

[6] The fact that we have identified and discussed only a few genuine issues of material fact as sufficient bases for denying applicant's motion for summary judgment on the issue of ownership

INTELLI is wholly insufficient to create a likelihood of confusion." *Applicant's Memorandum of Law in Support of Applicant's Motion to Dismiss Opposition for Lack of Subject Matter Jurisdiction, or in the Alternative for Summary Judgment (FRCP 12(b)(1), FRCP 56(c)),* p. 13. Applicant further contends that opposer should not be allowed to "pre-empt the entire field of computer program and computer software products" by virtue of the broad scope in the identification of goods of opposer's registration, and that the goods in connection with which opposer actually uses its marks are "completely unrelated." *Ibid.* at p. 16. Finally, applicant contends that purchasers of computer hardware and software programs are sophisticated consumers; that the parties target different markets; and that opposer's marks are not famous.

Opposer, on the other hand, contends that "the Board may conclude that there is no question … that there is a strong likelihood of confusion due to the similarity of Applicant's and Opposer's marks, the similarity of the goods and services provided by Applicant and Opposer, the evident overlap in the target consumer markets for the two markets and the strength of Opposer's mark." *Opposer's Memorandum in Opposition to Applicant's Motion to Dismiss for Lack of*

---

should not be construed as a finding that these are necessarily the only issues which remain for trial on this defense.

Subject Matter Jurisdiction or in the Alternative for Summary Judgment, p. 22.

In support of his motion for summary judgment on the Section 2(d) claim, applicant has submitted print-outs from the TESS (Trademark Electronic Search System) database that lists marks allegedly owned by unrelated third parties containing the term “intelli” as part thereof; copies of opposer's marks and a copy of opposer’s web site. Applicant did not submit an affidavit or declaration verifying the copies.

In support of its cross-motion, opposer has submitted the Tannen declaration and exhibits thereto. In his supplemental corrected declaration, Mr. Tannen states that “[c]ontinuously since [1984] either through a predecessor American Intelliware Corporation or through my own business American Intelliware, I have advertised marketed and sold AMERICAN INTELLIWARE and AI AMERICAN INTELLIWARE and Design computer hardware and software systems and related goods and services” (Tannen Declaration, ¶3); that “I have sold under the marks AMERICAN INTELLIWARE and/or AI AMERICAN INTELLIWARE and Design hundreds of computer hardware and software systems and related products and services amounting to hundreds of thousands of dollars in sales” (Tannen Declaration, ¶4); that “tens of thousands of dollars have been expended advertising” the products and services (Tannen

Declaration, ¶5); and that “in particular, I developed and market under the AMERICAN INTELLIWARE marks … two software products….” (Tannen Declaration, ¶12).

Exhibits to the Tannen Declaration include copies of a page entitled “American Intelliware’s Sales” that appears to list gross and annual income for the years 1997-2001; a plain paper copy of Reg. No. 1,347,429; undated copies of Internet print-outs from American Intelliware’s web site showing that at one time American Intelliware offered two software programs (under the marks STORYBOARDER and SCRIPTWRITER); undated copies of four advertisements for opposer's STORYBOARDER and SCRIPTWRITER software programs; undated copies of a STORYBOARDER demonstration guide and a SCRIPTWRITER “software demonstration diskette guide”; copies of two undated publicity releases; and copies of two emails (one from 1995 and the other from 1997) listing opposer's two software products as being available for sale.

Applicant, responding to opposer's cross-motion for summary judgment on the issue of likelihood of confusion, contends that opposer cannot claim priority because opposer’s marks have been “destroyed” by virtue of the purported assignment “in gross” that resulted from the alleged transfer in 1990 during the Board of Directors’ meeting. *Applicant’s Reply And Objection To Opposer’s Memorandum In Opposition To Applicant’s Motion To Dismiss*

For Lack Of Subject Matter Jurisdiction Or In The Alternative For Summary Judgment And Declaration In Support Of Opposer's Memorandum In Opposition To Applicant's Motion For Summary Judgment, pp. 11-12. Applicant further contends that, assuming the 1990 assignment was valid, opposer is nonetheless limited to the goods claimed in the registration; that "this registration is significantly narrower than what Opposer is now claiming, and assuming arguendo that the mark was valid would obviously not cross over with every mark that was in any way related to computer hardware or software and would certainly not be confused with Applicant's [application] … which is even narrower in scope than Opposer's alleged registration." *Ibid.,* p. 14.

Having carefully considered the materials and arguments presented by the parties in connection with opposer's cross-motion for summary judgment, and applying the standards of review for summary judgment motions as stated above, we conclude that neither party has met his burden to show that he is entitled to summary judgment as a matter of law. See Fed. R. Civ. P. 56(c). Insofar as applicant's evidence is concerned, the unverified copies of TESS print-outs listing marks that include the term "Intelli" as part thereof do not indicate which marks are no longer in use and which marks may have been based on Section 44 of the Trademark Act and thus may not have ever been used in commerce, and do not

indicate what the goods or services are; moreover, many of the listed marks are simply irrelevant to the question of likelihood of confusion presented in this case because the "Intelli" component in the third-party mark creates an entirely different commercial impression than either applicant's or opposer's marks.[7] As for opposer's evidence, the plain paper copy of opposer's pleaded registration for the mark AI AMERICAN INTELLIWARE and Design does not allow opposer any right to claim the benefit of the statutory presumption under Section 7(b) of the Trademark Act that opposer is the owner of the mark;[8] the undated sales and advertising materials are insufficient to raise a presumption that opposer presently uses the marks; the emails at best only show that opposer, trading as American

---

[7] As the print-outs have not been verified, we have not considered them in support of applicant's motion for summary judgment. We have only considered them for the purpose of testing whether a genuine issue has been raised sufficient to deny opposer's cross-motion for summary judgment.

[8] Had opposer submitted a status and title copy of his registration, opposer could have claimed the benefits of Section 7(b) of the Trademark Act, which include a presumption of validity of the registered mark and its registration, of the registrant's ownership of the mark and registrant's exclusive right to use the mark in commerce on the goods specified in the registration certificate, subject to any conditions or limitations stated in the certificate. In that case, unless applicant were to file a counterclaim to cancel opposer's pleaded registration, applicant would be precluded from alleging opposer's lack of standing or that opposer abandoned the registered mark. Moreover, the issue of priority would not arise with respect to the goods recited in the pleaded registration. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.,* 35 USPQ2d 1125 (TTAB 1995); *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212 (TTAB 1990).

Intelliware, offered two software programs in 1995 and in 1997; and the undated Internet print-outs show only that at one time, American Intelliware offered software products on the web.

Genuine issues of material fact exist, at a minimum, regarding the similarity of the marks; the relatedness of the goods; and the established channels of distribution. Accordingly, neither party is entitled to summary judgment as a matter of law. *See* Fed. R. Civ. P. 56(c).

CONCLUSION

Applicant's combined motion to dismiss and motion for summary judgment is denied. Opposer's cross-motion for summary judgment is denied.

Opposer's motion to strike applicant's reply brief is denied. Applicant's motion to strike the Tannen declaration is denied.

Trial dates, including the close of discovery, are reset as indicated below.

DISCOVERY PERIOD TO CLOSE:	**September 1, 2003**
30-day testimony period for party in the position of plaintiff to close:	**November 30, 2003**
30-day testimony period for party in the position of the defendant to close:	**January 29, 2004**
15-day rebuttal period for party in the position of the plaintiff to close:	**March 14, 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.

-o0o-