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

In the Matter of Application Serial No. 76/229,239
Published in the Official Gazette on July 16, 2002



04-17-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

TOHO CO., LTD.,

Opposer,

v.

CARLTON AND MCGRAW
PARTNERSHIP,

Applicant.

Opposition No. 91155020

CERTIFICATE OF MAILING

I hereby certify that on April 17, 2003, this paper is being deposited with the U.S. Postal Service by "Express Mail Post Office to Addressee" service with Express Mail Label No. EL123675777US for delivery to the Commissioner for Trademarks, Box TTAB NO FEE, 2900 Crystal Drive, Arlington, VA 22202-3513.

Eleanor Elko

**OPPOSER'S NOTICE OF MOTION AND MOTION FOR PARTIAL
SUMMARY JUDGMENT STRIKING APPLICANT'S AFFIRMATIVE
DEFENSES OF LACHES, WAIVER, AND ESTOPPEL**

TO APPLICANT AND ITS COUNSEL OF RECORD:

PLEASE TAKE NOTICE that pursuant to Rule 56 of the Federal Rules of Civil Procedure, Opposer Toho Co., Ltd. ("Toho") hereby moves the Trademark Trial and Appeal Board for an Order granting Toho partial summary judgment striking the Fifth, Sixth, and Seventh Affirmative Defenses pleaded in the answer of applicant Carlton and McGraw Partnership ("Applicant") on the ground that there is no genuine issue of material fact regarding these affirmative defenses, and that Toho is entitled to judgment as a matter of law on all of them.

This motion will be based upon this Notice, the accompanying Declaration of Joan Kupersmith Larkin, Esq., the pleadings in this action, the attached brief in support of the Motion, and such other arguments and evidence as may be presented to the Board on this Motion.

Dated: April 17, 2003

Respectfully submitted,

SEYFARTH SHAW

By:  _____

Christopher C. Larkin
Joan Kupersmith Larkin
Attorneys for Opposer
TOHO CO., LTD.

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**OPPOSER'S BRIEF IN SUPPORT OF ITS MOTION
FOR PARTIAL SUMMARY JUDGMENT**

Introduction and Background

In the opposed application, Applicant seeks registration of the mark "MOMZILLA" for goods identified as "motion picture films featuring animated cartoons, prerecorded videotapes featuring animated cartoons, motion pictures featuring live action characters, prerecorded videotapes featuring live action characters and animated cartoon characters, prerecorded video discs featuring live action characters and animated cartoon characters, and video game cartridges featuring animated cartoon characters, and video game software featuring animated cartoon characters," in Class 9, and "toy figures, dolls, cartoon character dolls stuffed plush toys, and board games," in Class 28, on the basis of Applicant's alleged bona fide intention to use the mark.

Toho has opposed the application under § 2(d) of the Lanham Act on the basis of its long prior use of various "GODZILLA" marks in connection with motion pictures and a wide variety of entertainment-related goods and services, and the existence of a likelihood of confusion.

Applicant's Answer asserts eight affirmative defenses. Applicant's Fifth, Sixth, and Seventh Affirmative Defenses are at issue on this motion. The Fifth Affirmative Defense alleges that this opposition "is barred by the Equitable Doctrine of Latches (sic)," the Sixth Affirmative Defense alleges that this opposition "is barred by the Equitable Doctrine of Waiver," and the Seventh Affirmative Defense alleges that this opposition "is barred by the Equitable Doctrine of Estoppel."

As shown below, these defenses are all insufficient as a matter of law and partial summary judgment striking them should be granted.

ARGUMENT

TOHO IS ENTITLED TO SUMMARY JUDGMENT ON THE THREE AFFIRMATIVE DEFENSES

“Summary judgment is appropriate where the movant has established that there is no genuine issue as to any material fact and that the movant is entitled to judgment as a matter of law.” *Nat’l Cable Television Ass’n Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1427 (Fed. Cir. 1991) (granting summary judgment on equitable defenses of laches, estoppel, and acquiescence). Toho is entitled to summary judgment on Applicant’s Fifth, Sixth, and Seventh Affirmative Defenses.

I.

THERE IS NO GENUINE ISSUE OF MATERIAL FACT ON APPLICANT’S LACHES DEFENSE AND TOHO IS ENTITLED TO JUDGMENT AS A MATTER OF LAW STRIKING THAT DEFENSE.

Applicant’s Fifth Affirmative Defense of laches is insufficient as a matter of law. The opposed application was filed on the basis of Applicant’s alleged bona fide intention to use the “MOMZILLA” mark in commerce, and was never amended to allege actual use. But even if Applicant had used the mark, “[i]n the context of a trademark opposition or cancellation proceeding, [the laches] defense must be tied to a party’s registration of a mark rather than to its use of the mark.” *Turner v. Hops Grill & Bar Inc.*, 52 USPQ2d 1310, 1312 (TTAB 1999). In *Nat’l Cable, supra*, the Federal Circuit held that a laches defense is unavailable in an opposition as a matter of law: “[L]aches begins to run from the time action could be taken against the acquisition by another of a set of rights to which objection is later made . . . Under the view that laches runs from knowledge of use, a trademark owner would be obligated to bring suit to stop use upon learning of a possible conflicting mark or suffer the possibility of being barred by the passage of time from later opposing or canceling *registration* of the mark. We see nothing in

logic or the statute which requires this expansive view of laches.” 19 USPQ2d at 1432 (emphasis in original).

Under *Nat'l Cable*, the laches period began to run in this case when Applicant's mark was published for opposition in the Official Gazette on July 16, 2002. Toho timely filed this opposition on January 9, 2003 after obtaining extensions of time to oppose pursuant to § 2.102 of the Trademark Rules of Practice, including one extension with the consent of Applicant's counsel. Larkin Decl. ¶ 3. Applicant's laches defense is insufficient as a matter of law and should be stricken.

II.

THERE IS NO GENUINE ISSUE OF MATERIAL FACT ON APPLICANT'S WAIVER DEFENSE AND TOHO IS ENTITLED TO JUDGMENT AS A MATTER OF LAW STRIKING THAT DEFENSE.

Applicant's Sixth Affirmative Defense alleges that Toho has waived the right to oppose registration. As set forth in the Declaration of Joan Kupersmith Larkin, Esq., Toho protested Applicant's application shortly after it was filed, and subsequently engaged in settlement negotiations with Applicant's counsel of record herein in an effort to resolve the dispute without filing an opposition. Unfortunately, those discussions did not result in settlement, and Toho commenced this opposition prior to the expiration of its last consented extension of time to oppose. Larkin Decl. ¶¶ 2-3. In the course of those negotiations, Toho never agreed that it would waive the right to oppose this application, either orally or in writing, unless a negotiated settlement included such a provision. Larkin Decl. ¶ 4. *Cf. M-5 Steel Mfg., Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086, 1094-94 (TTAB 2001) (no waiver or estoppel defense established on the basis of negotiations leading up to written settlement of prior civil litigation between the parties). Applicant's waiver defense is insufficient as a matter of law and should be stricken.

III.

THERE IS NO GENUINE ISSUE OF MATERIAL FACT ON APPLICANT'S ESTOPPEL DEFENSE AND TOHO IS ENTITLED TO JUDGMENT AS A MATTER OF LAW STRIKING THAT DEFENSE.

Applicant's Seventh Affirmative Defense alleges that Toho is estopped from opposing this application. "[E]stoppel require[s] some affirmative act by opposer which led applicant to reasonably believe that opposer would not oppose applicant's registration of its mark." *DAK Indus. Inc. v. Daiichi Kosho Co. Ltd.*, 25 USPQ2d 1622, 1625 (TTAB 1993). As set forth in the Larkin declaration, in pre-opposition settlement negotiations, Toho never stated or implied that Toho would not oppose Applicant's registration of its alleged mark if the matter could not be resolved, Larkin Decl. ¶ 4, and Applicant could not have reasonably believed that Toho would not oppose if a settlement could not be reached. There is an absence of evidence to support Applicant's proof of its estoppel defense, and Toho has carried its burden under Rule 56 of showing that the defense is meritless. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986); *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991). Applicant's estoppel defense is insufficient as a matter of law and should be stricken.

CONCLUSION

For all of the foregoing reasons, Toho's motion for partial summary judgment striking Applicant's Fifth, Sixth, and Seventh Affirmative Defenses should be granted in its entirety.

Dated: April 17, 2003

Respectfully submitted,

SEYFARTH SHAW

By: Ch. C. L.

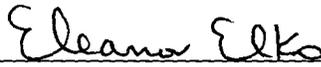
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TOHO CO., LTD.

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Telephone: (310) 277-7200
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CERTIFICATE OF SERVICE

I hereby certify that on April 17, 2003, I served the foregoing Opposer's Notice of Motion and Motion for Partial Summary Judgment Striking Applicant's Affirmative Defenses of Laches, Waiver, and Estoppel, on the applicant by depositing a true copy thereof in a sealed envelope, postage prepaid, in First-Class U.S. mail addressed to applicant's counsel as follows:

Thomas I. Rozsa, Esq.
Rozsa & Chen LLP
15910 Ventura Blvd., Suite 1601
Encino, CA 91436-2815



Eleanor Elko

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Eleanor Eiko

**DECLARATION OF JOAN KUPERSMITH LARKIN IN SUPPORT OF OPPOSER'S
MOTION FOR PARTIAL SUMMARY JUDGMENT STRIKING APPLICANT'S
AFFIRMATIVE DEFENSES OF LACHES, WAIVER, AND ESTOPPEL**

I, JOAN KUPERSMITH LARKIN, hereby declare:

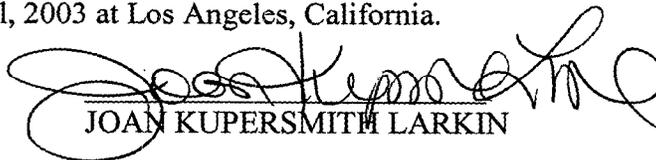
1. I am an attorney licensed to practice in the State of California and am a member of the firm of Seyfarth Shaw, counsel of record for Opposer Toho Co., Ltd. ("Toho"). I make this Declaration on the basis of my own personal knowledge and in support of Toho's Motion for partial summary judgment striking the Fifth, Sixth, and Seventh Affirmative Defenses pleaded in the Answer of Applicant Carlton and McGraw Partnership ("Applicant").
2. Applicant's Application Serial No. 76/229,239 to register "MOMZILLA" (the "Opposed Application") was filed on March 22, 2001. Less than two months after the Opposed Application was filed, I sent a protest letter on behalf of Toho to Applicant, in care of Applicant's counsel, Rozsa & Chen, objecting to the Opposed Application.
3. Correspondence ensued between me on behalf of Toho and Thomas Rozsa on behalf of Applicant, and we negotiated for many months in any effort to resolve this matter without the filing of an opposition. Toho obtained several extensions of time to oppose the

Opposed Application, including one with the consent of Mr. Rozsa, while the parties continued negotiating toward a settlement. Unfortunately, however, the parties were unable to reach agreement. In December, 2002, during the pendency of the consented extension of time to oppose, I reminded Mr. Rozsa of the deadline to oppose and requested a response to Toho's last settlement correspondence in November, 2002. When I did not receive any response, I filed this opposition on Toho's behalf.

4. At no time during the negotiations between Toho and Applicant did Toho state, imply, or agree, orally or in writing, that it would not oppose the Opposed Application if a settlement including such a provision could not be reached. To the contrary, I advised Mr. Rozsa that Toho would oppose if the matter could not be resolved prior to the expiration of Toho's last consented extension of time to oppose.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

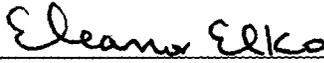
Executed this 16th day of April, 2003 at Los Angeles, California.


JOAN KUPERSMITH LARKIN

CERTIFICATE OF SERVICE

I hereby certify that on April 17, 2003, I served the foregoing Declaration of Joan Kupersmith Larkin in Support of Opposer's Motion for Partial Summary Judgment Striking Applicant's Affirmative Defenses of Laches, Waiver, and Estoppel, on the applicant by depositing a true copy thereof in a sealed envelope, postage prepaid, in First-Class U.S. mail addressed to applicant's counsel as follows:

Thomas I. Rozsa, Esq.
Rozsa & Chen LLP
15910 Ventura Blvd., Suite 1601
Encino, CA 91436-2815



Eleanor Elko