

ESTTA Tracking number: **ESTTA33180**

Filing date: **05/16/2005**

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

Proceeding	91161754
Party	Defendant Krause, Antoinette K. Krause, Antoinette K. 143 Tynebourne Place Alameda, CA 94502
Correspondence Address	Michael James Cronen Law Offices of Harris Zimmerman 1330 Broadway, Suite 710 Oakland CA U, SA 94612-2506
Submission	Motion for Summary Judgment
Filer's Name	Paul J. Krause
Filer's e-mail	mcronen@zimpatent.com
Signature	/Paul J. Krause/
Date	05/16/2005
Attachments	Krause Not Mo Summary Judgment.pdf (1 page) Krause Brief Supp Mo Summ Jdgmt.pdf (5 pages)

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

7 - Eleven, Inc.,

Opposer,

vs.

Antoinette K. Krause and Paul J. Krause,

Applicants.

Opposition No.: 91161754

Serial No. : 78/225628

Mark: MIRACLE 7 and Design

APPLICANTS' NOTICE OF MOTION FOR SUMMARY JUDGMENT

TO: Opposer, 7 - Eleven, Inc., and its attorneys of record,

PLEASE TAKE NOTICE that the undersigned Applicant hereby moves for summary judgment, pursuant to Rule 56 of the Federal Rules of Civil Procedure, on the grounds that there is no genuine issue of material fact that the registration of Applicant's mark, MIRACLE 7 & Design, upon the principal register will not damage Opposer or its cited registration of the mark 7-ELEVEN WEEKEND REWARDS, and that, therefore, Applicant is entitled to a judgment as a matter of law. PLEASE TAKE FURTHER NOTICE that in support of this motion, the undersigned shall rely upon the pleadings of record, the Brief filed in support of this motion, and upon such other evidence that may submitted to the Board in connection with the present motion.

Respectfully submitted,

May 15, 2005

/s/Paul J. Krause

Paul J. Krause

For Applicants Antoinette K. Krause
and Paul J. Krause

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

7 - Eleven, Inc.,

Opposer,

vs.

Antoinette K. Krause and Paul J. Krause,

Applicants.

Opposition No.: 91161754

Serial No. : 78/225628

Mark: MIRACLE 7 and Design

APPLICANTS' BRIEF IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT

I INTRODUCTION

At the outset, Applicants Antoinette K. Krause and Paul J. Krause point out that this opposition proceeding by the 7 - Eleven corporation appears designed to harass and over-extend any legitimate exercise of rights the corporation may have to the number "7". There is simply no basis for Opposer's contention that the registration of Applicants' mark, MIRACLE 7 & Design, upon the principal register, is likely to damage Opposer, or the mark of Opposer's cited registration, 7-ELEVEN WEEKEND REWARDS. Therefore, Applicant respectfully request the Board to dismiss this opposition proceeding, and enter judgment on the pleadings in Applicants' favor under Fed. R. Civ. P. Rule 12(c) or, alternatively, if the Board deems it appropriate to consider matters outside the pleadings on this motion, then the Board should enter summary judgment in Applicants' favor under Fed. R. Civ. P. Rule 56.

II BACKGROUND

Opposer has served extensive discovery and is attempting to inflict further expensive legal proceedings against Applicants in this entirely unfounded *inter partes* opposition proceeding. Opposer's asserted mark in this proceedings is 7-ELEVEN WEEKEND REWARDS for convenience stores featuring soft drinks. This is not even remotely similar to Applicants' mark, MIRACLE 7 & Design, for chemical stain removers.

Presently, the Trademark Office's TARR server lists almost one thousand (1000) current federal applications and registrations that include the numeral "7 or the word "SEVEN". Since the only similarity between Applicants' and Opposer's marks is the number seven, and since Opposer has no exclusive rights to this number, as a matter of law, Opposer is not entitled to judgment in its favor.

Moreover, Applicant's goods fall in International Class 3. Opposer's registration(s), apparently, do not cover any goods in International Class 3. This distinction in goods is also sufficient to show that Opposer will not be damaged by registration of Applicants' mark on the principal register.

III DISCUSSION

A. The Board Should Dismiss For Failure To State A Claim Upon Which Relief Can Be Granted

Pursuant to the Federal Rules of Civil Procedure, Rule 12(b)(6), the Court has the power to dismiss a claim or defense for "failure to state a claim upon which relief can be granted."

Pursuant to Federal Rule 12(c), "[a]fter the pleadings are closed but within such time as not to delay the trial, any party may move for judgment on the pleadings."

The legal standards under Rules 12(b)(6) and 12(c) are "virtually interchangeable" in that

“under either provision, a court must determine whether the facts alleged” entitle a party “to a legal remedy”. *Raines v. Switch Mfg.*, 44 USPQ2d 1195, 1197 (N.D. Cal. 1997). See, *Patel v. Contemporary Classics of Beverly Hills*, 259 F.3d 123, 125-127 (2nd Cir. 2001)(Because failure to state a claim may be raised at any time court should treat Rule 12(b)(6)motion as motion for judgement on the pleadings). If a claim or defense fails to provide a sufficient legal basis, then it “should be dismissed, or judgment entered on the pleadings.” *Raines v. Switch Mfg.*, 44 USPQ2d at p. 1197 (Applying “accepted rule” set forth in *Conley v. Gibson*, 355 U.S. 41, 45-46 (1957)).

In the present case, Opposer’s asserted mark is 7-ELEVEN WEEKEND REWARDS for convenience stores featuring soft drinks. Applicants’ mark is MIRACLE 7 & Design for chemical stain removers. Because the only similarity between Applicants’ and Opposer’s marks is the number seven, and because Opposer has no exclusive rights to this number in view of almost 1000 current applications/registrations including the number seven, as a matter of law, Applicants are entitled to a judgment on the pleadings. The fact that Applicant’s goods fall in International Class 3, while Opposer’s goods do not, is further reason to enter judgment in favor of Applicants.

B. The Board Should Grant Summary Judgment In Favor Of Applicants

Pursuant to Federal Rule 12(c), the Board may treat the present motion as a motion for summary judgment under Fed. R. Civ. P. Rule 56 if the Board relies upon matters outside the pleadings. Under Fed. R. Civ. P. Rule 56(c), summary judgement is proper where there is no genuine issue as to any material fact and the moving party is entitled to a judgment as a matter of law. *Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986). As the moving party, Applicants bear the initial burden to show they are entitled to judgment as a matter of law. *Celotex*, 477 U.S. at

pp. 324-25. The burden then shifts to Opposer to provide evidence sufficient to establish a genuine issue of material fact. “To create a genuine issue of fact, the non-moving party must do more than present *some* evidence on an issue it asserts is disputed.” *Avia Group International v. L.A. Gear*, 853 F.2d 1557, 1560 (Fed. Cir. 1988) (emphasis in original).

As explained by the Supreme Court:

There is no issue for trial unless there is sufficient evidence favoring the non-moving party for a jury to return a verdict for that party ... if the evidence [of the non-movant] is merely colorable, ... or is not significantly probative summary judgment may be granted. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249-50 (1986).

The Board does not hesitate to dispose of cases on summary judgment when appropriate. *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). In *Sweats Fashions*, the Federal Circuit Court of Appeals affirmed the dismissal of an opposition proceeding by the Board where the only basis for similarity, the word “sweats”, was common to other, third-party registrations. Noting that “the issue of likelihood of confusion is one of law” and, therefore, appropriate for summary judgment, the Court in *Sweats Fashions* found the opposer had no proprietary rights in the word “sweats”, and held “that there is no likelihood of confusion between [the parties’] marks within the meaning of section 2(d) despite the commonality of the word ‘sweats’ in both marks.” *Sweats Fashions v. Pannill*, 4 USPQ2d at p. 1798.

In the present case, Opposer’s asserted mark is 7-ELEVEN WEEKEND REWARDS and Applicants’ mark is MIRACLE 7 & Design. The only similarity between Applicants’ and Opposer’s marks is the number seven. This sole similarity between the parties’ marks is shared by almost 1,000 other current applications/registrations, i.e. the marks of these other applications/registrations also include the word seven. Moreover, the parties’ goods/services fall

in different International Classifications. Applicant's goods, i.e. chemical stain removers, fall in International Class 3, while Opposer's goods/services, i.e. convenience stores featuring soft drinks, do not fall in International Class 3. Therefore, since "the issue of likelihood of confusion is one of law", and since Opposer can establish no exclusive rights to the number seven, the Board should find "there is no likelihood of confusion between [the parties'] marks within the meaning of section 2(d) despite the commonality of the" number seven in both marks. *Sweats Fashions v. Pannill*, 4 USPQ2d at p. 1798.

III CONCLUSION

For the foregoing reasons the Board should dismiss this opposition proceeding for Opposer's failure to state a claim under Rule 12(b), or enter judgment on the pleadings in Applicants' favor under Rule 12(c). Alternatively, if the Court considers matters outside the pleadings, the Court should enter summary judgment dismissing this opposition proceeding.

Respectfully submitted,

May 15, 2005

/s/Paul J. Krause
Paul J. Krause
For Applicants Antoinette K. Krause
and Paul J. Krause