

ESTTA Tracking number: **ESTTA224348**

Filing date: **07/15/2008**

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

Proceeding	91178943
Party	Plaintiff Corporacion Cimex S.A.
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Date	07/15/2008
Attachments	Opposer SJ Reply and Opp.pdf ( 15 pages )(199306 bytes )

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

CORPORACION CIMEX, S.A.,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91178943
	)	Serial No. 75/697908
DM ENTERPRISES & DISTRIBUTORS, INC.,)	)	
	)	
Applicant.	)	
	)	

CORPORACION CIMEX, S.A.'S REPLY IN SUPPORT OF MOTION FOR SUMMARY  
JUDGMENT AND OPPOSITION TO APPLICANT'S SUMMARY JUDGMENT MOTION

CORPORACION CIMEX, S.A. ("Opposer" or "CIMEX") hereby files its Reply in support of its motion for summary judgment sustaining the Opposition and refusing registration of Application Serial No. 75/697908. CIMEX also opposes herewith Applicant DM Enterprises & Distributors, Inc.'s ("Applicant" or "DM") untimely motion for summary judgment.

I. APPLICANT CONCEDES THE MERITS OF CIMEX'S ARTICLE 7 CLAIM UNDER  
THE INTER-AMERICAN CONVENTION

CIMEX moved for summary judgment under Article 7 of the General Inter-American Convention for Trade Mark and Commercial Protection, 46 Stat. 2907 ("IAC"). DM has now conceded every material fact for relief under Article 7. See Applicant's Memorandum of Law ("App. Mem.") at 2-3; Opposer's Memorandum of Law ("Opp. Mem.") at 2-13, and evidence cited therein; *id.* at 17 (quoting *Diaz v. Servicios De Franquicia Pardo's S.A.C.*, 83 U.S.P.Q.2d 1320, 1328 (TTAB 2007), for the elements needed to establish a claim under Article 7). DM makes no legal argument addressing the merits of CIMEX's IAC claim. DM only challenges Opposer's standing and claims abandonment and acquiescence, which challenges are completely meritless.

II. APPLICANT'S CLAIMS OF USE OF THE MARK AND OTHER FACTUAL  
ASSERTIONS ARE UNSUPPORTED BY THE RECORD

DM has submitted no *evidence* at all in connection with its opposition to, or its motion for, summary judgment. Instead, DM's *attorneys* make several factual assertions that have no evidentiary

support. DM's attorneys claim that DM has sold a CUBITA coffee brand "openly and conspicuously throughout the United States .... investing significant time, money and effort in building brand loyalty [and] customer trust," App. Mem. at 1-2, and refer to "Applicant's use of the CUBITA mark for over a decade," *id.* at 2, "continuous use since 1999," *id.* at 2-3 n.1, and "burgeoning business," *id.* at 14. In fact, DM has submitted no documentary evidence that it has *ever* used or promoted the CUBITA mark, and cites no evidence of *any* use after 2000. DM cites only the Board's finding in *DM Enter. & Distrib., Inc. v. Ruta Maya Royalty, Ltd.*, Canc. No. 92029327, at 5 (TTAB May 28, 2004) ("DM Opp."), of minor use in 1999 and 2000, based on DM's principal's *testimony, not* documents. App. Mem. at 3; Opp. Mem. at 8 & n.4. Opposer expressly pointed out that DM had produced *no evidence*, in response to discovery requests, of *any* use of the mark (it still has not). Certainly, if DM had used or promoted the mark, it would have submitted *some* evidence in response, rather than non-evidentiary attorney assertions.

The Board *did not* "consider the issue of misdescriptivness [sic] with regard to *Applicant's* packaging and *use* of the CUBITA mark," and *did not* "h[o]ld that Applicant's use of the mark was not descriptive" in *In re Timothy J. Sheehan*, 1998 WL 611625 (TTAB September 10, 1998) ("*Sheehan*"). App. Mem. at 3 (emphasis added). That non-precedential decision did not involve *DM* or *use* of the mark, and is not binding on the parties here.

DM's *attorney* disclaims any intent by DM to exploit the goodwill in the United States of CIMEX's CUBITA mark, and asserts that DM did not participate in a trademark scam with Alonzo and Angel regarding Cuban marks. Tellingly, however, DM fails to submit a *sworn* affidavit from DM, or *any* other evidence, supporting these attorney assertions.

### III. CIMEX HAS NOT "ABANDONED" THE MARK OR "ACQUIESCED" IN APPLICANT'S REGISTERING OR USING THE MARK

DM's claim that CIMEX has "abandoned" the mark, or "acquiesced" in DM's registration or use of the mark, in sole reliance on a March 23, 2000 letter written by *DM's* own attorney, Sampedro Decl. Ex. 3, which does not remotely state what DM asserts, is meritless. First, DM never pleaded either defense. A party may not defend against a motion for summary judgment by asserting an unpleaded

defense, unless the party also moves to amend the pleading to assert the defense, which DM has not done. TBMP § 528.07(b); *Perma Ceram Enter. Inc. v. Preco Ind. Ltd.*, 23 U.S.P.Q.2d 1134, 1135 n.2 (TTAB 1992) (refusing to consider unpleaded abandonment defense to summary judgment).<sup>1</sup>

Second, acquiescence requires that “the trademark owner ... by *affirmative* word or deed,” conveys its consent to another; silence is not consent. 6 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 31.41, at 31-106 (2008) (emphasis added); *Carl Zeiss Stiftung v. VEB Carl Zeiss Jena*, 433 F.2d 686, 704 (2d Cir. 1970).

DM’s attorney’s letter contains *only* the attorney’s self-serving comment, on behalf of DM, that “we understand” that CIMEX does not have an interest in the U.S. rights in the mark, followed by the attorney’s erroneous legal opinion. Nothing in the letter identifies what, if anything at all, any Cuban lawyer at CJI stated to DM’s attorney. There is nothing in the record from CJI or CIMEX to DM’s counsel.

The letter contains no suggestion of any conversation between CJI and DM’s counsel; and DM’s attorney’s descriptions of such “conversations” are invented: DM’s attorney was “recalling a conversation it had with Cimex’s attorneys”; CIMEX “unequivocally conveyed its position to [DM’s attorney] that Cimex had voluntarily abandoned any rights” in the mark; DM’s attorney “was actively involved in discussions with Cimex regarding the CUBITA trademark”; “Cimex told [DM’s attorney] that it had no intention of pursuing any rights in the U.S.” App. Mem. at 13-14. Particularly revealing is DM’s failure to submit an affidavit from its prior counsel, also located in Miami, in support of its current attorney’s claims of what supposedly transpired.

Third, the *first* opportunity CIMEX had to bring its IAC challenge to DM’s USPTO application was when it was published for opposition, which Opposer did. DM’s novel argument that a party who fails to object to an application *before* it is published for opposition has thereby abandoned its rights in

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<sup>1</sup> Applicant does not claim it was unaware of, or unable to obtain, this letter from its prior attorney when it filed its Answer. In any event, Opposer produced the letter in discovery almost three months before Applicant filed its brief, yet Applicant never moved to amend its Answer to assert these defenses.

the mark and acquiesced in its registration would work a radical restructuring of PTO procedure. Likewise, DM nowhere explains why the abandoned Sheehan registration, or Sheehan's victory in DM's cancellation petition constitutes CIMEX's acquiescence in *DM's application*. See *In re Nett Designs, Inc.*, 236 F.3d 1339, 1342 (Fed. Cir. 2001) ("PTO's allowance of [similar] prior registrations does not bind the Board or this court").

Fourth, DM's claim of acquiescence in DM's *use* of the mark is not before the Board. In any event, because there is no evidence of *any* use by DM of the mark since 2000, CIMEX could not have acquiesced in DM's "use."

#### IV. CIMEX HAS STANDING TO BRING THIS OPPOSITION PROCEEDING

Settled TTAB jurisprudence forecloses DM's challenge to standing. Opposer owns an application to register CUBITA on the basis of its Cuban registration, pursuant to section 44(e) of the Act. The Examiner cited Applicant's prior application against Opposer's application, under Section 2(d) of the Act, and has suspended further proceedings pending the outcome of the instant opposition proceeding, after CIMEX satisfied the only two other issues raised by the Examiner. See Goldstein Declaration ¶ 4 & Ex. 2, filed with Opposer's Motion for Summary Judgment.

The Board has repeatedly and consistently held that standing is established by these circumstances. See, e.g., *Great Seats Ltd. v. Great Seats, Inc.*, 84 U.S.P.Q.2d 1235 (TTAB 2007) (precedent); *Cerveceria Modelo S.A. de C.V. v. R.B. Marco & Sons Inc.*, 55 U.S.P.Q.2d 1298, 1299 (TTAB 2000) (precedent); *The Hartwell Co. v. Shane*, 17 U.S.P.Q.2d 1569 (TTAB 1990) (precedent); *Wade Oney v. Twistee Treat Corp., Inc.*, 2006 WL 3249196, at \* 1 (TTAB Nov. 2, 2006) (attached); *Winsor Grain, Inc. v. Turf-Seed, Inc.*, Opp. No. 91162188, at 6-7 (TTAB August 17, 2006); *Target Bands, Inc. v. Alan Russ Gottlieb*, Opp. No. 91171714, at 3-4 (TTAB May 13, 2008); *Jet Enter. Pvt. Ltd. v. Jet Airways, Inc.*, Canc. No. 92044201, at 2-3 (TTAB March 31, 2008); *Houdini, Inc. v. Metrokane, Inc.*, Canc. No. 92044725 (TTAB May 1, 2008); see also TBMP § 309.03(b). Once standing is established, a party may raise any ground for opposition or cancellation. See, e.g., *M. Aron Corp. v. Remington Prod., Inc.*, 222 U.S.P.Q. 93, 95 (TTAB 1984).

The Board recently applied these well-established principles unhesitatingly to a Cuban party in a precedential decision, *Corporacion Habanos, S.A. v. Guantanamera Cigars Co.*, 86 U.S.P.Q.2d 1473 (TTAB 2008). There, the Board held a Cuban cigar company had standing to oppose a U.S. company's prior application because the Examiner had cited the prior application under § 2(d) against the Cuban party's application. *Id.* at 1475. The circumstances are indistinguishable here.<sup>2</sup>

DM argues that the Cuban Assets Control Regulations, 31 C.F.R. Part 515 ("CACR") preclude standing. Dispositively, the CACR were considered in *Guantanamera*, and the Board held that there was standing. *Id.*

DM attempts to distinguish *Guantanamera* on the basis of the letter from the Office of Foreign Assets Control ("OFAC"), which promulgates and administers the CACR, referred to by the Board there. *See id.* Contrary to DM's erroneous and repeated assertion, Opposer has placed into the record here the very same OFAC letter:<sup>3</sup> an OFAC ruling, issued in 1996 long before the *Guantanamera* case, that CACR § 515.527, the general license authorizing Cuban parties to register trademarks, licenses Cuban parties to oppose a trademark application, and to obtain cancellation of a trademark registration, when the opposition or the cancellation "relate to the protection of a trademark in which Cuba or a Cuban national has an interest." Goldstein Dec. Ex. 3; *Guantanamera*, 86 U.S.P.Q.2d at 1475 (quoting letter). In *Guantanamera*, the Board correctly held that the OFAC ruling confirms that a Cuban party not only has standing to oppose an application that has been cited against its own application, but that "opposer, as a Cuban entity, is not restricted from pursuing this opposition" by the CACR. The OFAC ruling, and the Board's decision, apply here: as appears on its face, the OFAC ruling is not specific to any particular proceeding, but is of universal application.

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<sup>2</sup> In *Guantanamera*, the Cuban party asserted that registration should be denied because the applicant's mark was primarily geographically deceptively misdescriptive under § 2(e)(3) and because of fraud on the PTO. In accordance with *M. Aron Corp, supra*, the Board did not inquire into whether Opposer had standing to assert these particular grounds for opposition.

<sup>3</sup> *See* Opposer's Notice of Reliance Ex. 5 (Dkt No. 61) in *Guantanamera*, available on TTABVue, and Goldstein Dec. ¶ 5, Ex. 3, here. The OFAC letter was issued in response to a request by counsel for the

DM cites several TTAB and Federal Circuit standing cases, but the Board, of course, was fully conversant with these decisions in adhering in *Guantanamera* to the dispositive line of authority that there is standing when an Examiner has cited a prior application against an opposer's application. Indeed, in *Guantanamera* itself, the Board noted and quoted the leading cases DM cited: "[t]o establish standing, opposer must show that it has a 'real interest' in the outcome of the proceeding; that is, that it has a direct and personal stake in the outcome of the opposition," 86 U.S.P.Q.2d at 1475, citing and quoting *Ritchie v. Simpson*, 170 F.3d 1092 (Fed. Cir. 1999); and *Jewelers Vigilance Comm., Inc. v. Ullenberg Corp.*, 823 F.2d 490 (Fed. Cir. 1987). Even upon independent examination, it is clear there is nothing at all in the cases cited by DM at variance with the dispositive TTAB line of cases conferring standing on Opposer.

Applicant's reliance on the non-precedential decision, *Havana Club Holding, S.A. v. Jimmy Buffett*, 2003 WL 1423117 (TTAB March 13, 2003), is no less ill-conceived. Applicant would read *Buffett* to be in conflict with the Board's decision in *Guantanamera*; even if there were a conflict, *Guantanamera* would necessarily prevail: it is later decided and is precedential, unlike *Buffett*.

However, there is no conflict at all. In *Buffett*, the Board first noted that "Opposer's standing may be rooted in enforceable rights despite the existence of the strictures of the Cuban embargo." *Id.* at \*4. The Board then found that prior federal court litigation had determined that a purported assignment to the opposer, a Cuban national, of the registration for HAVANA CLUB was null and void and, therefore, the opposer could not establish standing on the basis of that void registration. *Id.* The opposer argued that its two pending § 44(e) applications for HAVANA CLUB (made on the basis of Luxembourg registrations) nonetheless gave it standing to oppose registration of the mark HAVANAS AND BANANAS. The Board ruled that legislation concerning confiscated trademarks precluded the opposer from maintaining

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the undersigned law firm, which firm was counsel in *Guantanamera* for the Cuban party, and for the Cuban party here.

those applications.<sup>4</sup> Since Opposer was barred by statute from pursuing the applications, the Board ruled, it could not ground standing on them. *Id.* at \*5. In contrast, CIMEX does own an application upon which to ground standing, not subject to the strictures of section 211.

After finding there was no application upon which to ground standing, and although not argued by the opposer, the Board in *Buffett* also concluded that the opposer's future intention of selling HAVANA CLUB-labelled rum in the U.S. when the embargo ends, standing alone, was not by itself sufficient to establish standing, because the embargo made it too remote and uncertain whether opposer would suffer commercial injury from the registration of HAVANAS AND BANANAS. *Id.* at \*6.

This latter ruling has no import here, because, *inter alia*, CIMEX *does* own an application for registration that it may pursue, and against which the opposed application has been cited. This point is illustrated by *Guantanamera*. As in *Buffett*, the Cuban opposer challenged the mark under section 2(e)(3). In *Guantanamera* – *unlike* in *Buffett* – the opposer owned an application that it was not barred by statute from pursuing, and against which the applicant's pending application had been cited. Expressly for that reason, the Board held that the Cuban party had standing, including to assert its section 2(e)(3) claim.

Applicant's reliance on the federal court litigation concerning section 43(a) false advertising claims for HAVANA CLUB rum, *Havana Club Holding, S.A. v. Galleon, S.A.*, 62 F. Supp. 2d 1085 (S.D.N.Y. 1999), *aff'd.*, 203 F.3d 116 (2d Cir. 2000), brought by the same Cuban national that was the opposer in *Buffett*, fares no better: among other things, the Cuban party did not own an application for registration of HAVANA CLUB upon which to ground standing (and did not own a registration, because the federal courts held that assignment of the registration to the plaintiff was null and void).

Applicant suggests that the CACR bars Opposer's application for registration of CUBITA, App. Mem. 6-7, but cites no authority for this astonishing proposition, and there is none. To the contrary, the

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<sup>4</sup> Section 211 of the Department of Commerce Appropriations Act 1999, provides that “[n]o U.S. court shall recognize, enforce or otherwise validate any assertion of treaty rights by a designated national...for a mark...that is the same or substantially similar to a mark ... that was used in connection with a business or assets that were confiscated....” The Board held this provision, which has no application here, barred the opposer's registration of HAVANA CLUB. *Id.* at \*5.

CACR expressly authorize Cuban parties to register trademarks, 31 C.F.R. § 515.527, and, in its 1996 letter ruling, OFAC determined that this authority extends to circumstances where another party already has obtained a registration for the same trademark or filed a prior application. Exceptional deference is due OFAC's construction of its own embargo regulations, not only because of the deference due an agency's construction of its own regulations, but because of the deference due the Executive in its conduct of foreign affairs. *See, e.g., Paradissiotis v. Rubin*, 171 F.3d 983, 988 (5th Cir. 1999); *Consarc Corp. v. Iraqi Ministry*, 27 F.3d 695 (D.C. Cir. 1994); *Semetex Corp. v. UBAF Arab American Bank*, 51 F.3d 13, 14 (2d Cir. 1995); *Comet Enter. Ltd. v. Air-A-Plane Corp.*, 128 F.3d 855, 859 (4th Cir. 1997); *De Cuellar v. Brady*, 881 F.2d 1561, 1565 (11th Cir. 1989).

Moreover, denial of standing here would violate United States' treaty obligations, both its obligation to allow a Cuban party's registration on the basis of its Cuban registration, and its obligation to deny or cancel another's registration in the circumstances specified in Articles 7 and 8 of the IAC, which the Board recognizes and applies as a binding treaty obligation. *See* Opp. Mem. at 13-17; *Diaz, supra*, 83 U.S.P.Q.2d 1320; *British-American Tobacco Co. v. Phillip Morris Inc.*, 55 U.S.P.Q.2d 1585 (TTAB 2000). There is no indication in the CACR or otherwise that the United States has determined to dishonor its treaty obligation that controls here.<sup>5</sup>

Applicant cites *Empresa Cubana del Tabaco v. Culbro Corp.*, 399 F.3d 462 (2d Cir. 2005), but, there, the Second Circuit considered the Cuban party's claim under Articles 7 and 8 of the IAC *on the merits, id.* at 481-83, even though the Circuit held, in a prior part of its opinion, that the CACR barred a different claim. *Id.* at 474-76. Moreover, the Circuit found the CACR barred that claim because it necessarily was premised on the Cuban party's acquisition of trademark rights by operation of law under the well-known marks doctrine, not by registration, and there is no authorization in the CACR for

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<sup>5</sup> Further, the Board is not to construe domestic law – here, the CACR – as inconsistent with U.S. treaty obligations where possible, or as implicitly repealing or superseding those obligations. *See, e.g., Sale v. Haitian Centers Council, Inc.*, 509 U.S. 155, 178 n. 35 (1993); *Trans World Airlines, Inc. v. Franklin Mint Corp.*, 466 U.S. 243 (1984); *Weinberger v. Rossi*, 456 U.S. 25 (1982); *Clark v. Allen*, 331 U.S. 503 (1947); *Murray v. The Charming Betsy*, 6 U.S. (2 Cranch) 64, 118 (1804).

acquiring U.S. trademarks in that way. In contrast, CIMEX here asserts the right to obtain registration pursuant to section 44(e), which is authorized by the CACR, § 515.527, and standing to oppose the prior application that blocks it from obtaining that registration, as authorized by CACR § 515.527, pursuant to the authoritative construction in OFAC's 1996 ruling.

V. APPLICANT'S UNTIMELY SUMMARY JUDGMENT MOTION IS MERITLESS

DM's motion for summary judgment, filed June 30, 2008, should be denied as untimely. The deadline for filing the motion was June 10, 2008, as CIMEX's testimonial period was scheduled to commence on June 11. *See* 37 CFR § 2.127(e)(1); TBMP § 528.02 (describing limited circumstances, none applicable here, when Board will consider untimely summary judgment motion). Even if the Board generally were inclined to leniency when another party's timely filing has suspended the testimonial periods, here, every single document that DM has filed in this proceeding (five of five) has been untimely, as the Board found in its July 3, 2008 Order, at 2. Having specifically warned Applicant "that the timeliness of future filings with the Board is dependent on applicant's compliance with the Trademark Rules of Practice," *id.*, the Board should deny DM's summary judgment motion as untimely.

On the merits, DM's motion based on standing, acquiescence and abandonment should be denied for the same reasons addressed above. Further, if the Board finds a fact dispute that precludes summary judgment to CIMEX, such should also preclude summary judgment to DM.

DM has submitted no argument or evidence that DM is entitled to summary judgment on CIMEX's section 2(e)(3) claim, relying solely on a citation to the non-precedential, non-binding, unrelated *Sheehan* decision. App. Mem. at 3. *Sheehan* addressed only whether the primary significance of the mark is a known geographical location. *Sheehan*, 1998 WL 611625, at \*2. In finding that it was not, the Board relied on Sheehan's misrepresentation that *he* had creatively invented the mark by combining "Cuba" with "ita" "to create an unusual resulting term," *id.*, without revealing that he had in fact simply appropriated the Cuban CUBITA mark. In addition, Sheehan's mark and his specimen, upon which the Board specifically relied, *id.* at \*2-3, is different from DM's. DM Op. at 10-11 & n.8; Goldstein Decl. Ex. 4. The record now contains evidence that "CUBITA" was specifically chosen

because it does refer to Cuba, Bernaza Decl. ¶¶ 13-14, and that DM understood that the mark specifically referred to Cuba, and specifically promoted the mark based on the geographic significance of the mark. *See* Opp. Mem. at 6-7; *see also Guantanamera Cigars*, 86 U.S.P.Q.2d at 1479-80 (citing specimens false association with Cuba in section 2(e)(3) analysis). Finally, DM's claim that DM is entitled to summary judgment on CIMEX's section 2(e)(3) claim because CIMEX did not move for summary judgment on that claim is frivolous. App. Mem. at 10.

#### CONCLUSION

For the reasons stated herein, and on the prior papers submitted herein, Opposer's motion for summary judgment refusing registration of Applicant's mark, CUBITA, Serial No. 75/697908, should be granted, and Applicant's motion for summary judgment should be denied.

Dated: New York, New York  
July 15, 2008

Respectfully submitted,

/David B. Goldstein/

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*Attorneys for Opposer Corporation CIMEX, S.A.*

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing Corporacion Cimex, S.A.'S Reply In Support Of Motion For Summary Judgment And Opposition To Applicant's Summary Judgment Motion was served by electronic mail by agreement of the parties and by Unites States first class mail, postage prepaid, on July 15, 2008, upon:

Mitchell Mandler  
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*Attorneys for Applicant DM Enterprises & Distributors, Inc.*

/David B. Goldstein/  
\_\_\_\_\_  
DAVID B. GOLDSTEIN

**ATTACHMENT**

2006 WL 3249196 (Trademark Tr. & App. Bd.)

THIS DECISION IS NOT CITABLE AS A PRECEDENT OF THE TRADEMARK TRIAL AND APPEAL BOARD.

Trademark Trial and Appeal Board  
Patent and Trademark Office (P.T.O.)

WADE ONEY  
v.  
TWISTEE TREAT CORPORATION, INC.

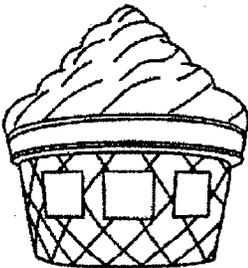
OPPOSITION 91167270

November 2, 2006

Before Hairston, Grendel and Zervas  
Administrative Trademark Judges

By the Board:

Twistee Treat Corporation, Inc. ("applicant") seeks to register the following miscellaneous design:



for "restaurant services" in International Class 43.<sup>[FN1]</sup>

Wade Oney ("opposer") filed a notice of opposition to registration of such building design. As grounds for opposition, opposer alleges that: (1) applicant has abandoned use of the building design as a mark based on applicant's nonuse of the involved building design for more than three consecutive years and failure to control use of the building design by third parties; and (2) registration of applicant's mark is likely to cause confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d) with the mark which is the subject of his application Serial No. 76619569, that is, the same mark for the same services. Applicant, in its answer, denied the salient allegations of the notice of opposition and asserted various affirmative defenses.

This case now comes up for consideration of applicant's motion (filed March 23,

2006) for summary judgment on the ground that opposer lacks standing to maintain this proceeding because applicant has prior rights in the involved building design. The motion for summary judgment has been fully briefed.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). Applicant, as the party moving for summary judgment, has the initial burden of establishing that there is no genuine issue of material fact, and that it is entitled to judgment as a matter of law.<sup>[FN2]</sup> See Celotex Corp. v. Catrett, 477 U.S. 317 (1987); Sweats Fashions Inc. v. Pannill Knitting Co. Inc., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

With regard to applicant's motion for summary judgment on the issue of standing, standing requires only that a party opposing a registration have a good faith belief that it is likely to be damaged by the registration. See Trademark Act Section 14, 15 U.S.C. Section 1064; Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). The fact that an applicant's mark was cited as a potential basis for a refusal of registration to opposer's pending application is sufficient to confer upon opposer standing to oppose registration of that applicant's mark. See Hartwell Co. v. Shane, 17 USPQ2d 1569 (TTAB 1990); TBMP Section 309.03(b) (2d ed. rev. 2004).

\*2 Applicant's contention that its prior rights in the involved mark defeat opposer's abandonment claim is incorrect. A party who would be injured by registration of an abandoned mark may oppose registration of that mark or seek cancellation of a registration for that mark. See 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, Section 17:4 (4th ed. 2001) (citing Sunbeam Corp. v. Merit Enterprises, Inc., 451 F. Supp. 571, 203 USPQ 494 (S.D.N.Y. 1978)).

Herein, applicant included, as an exhibit in support of its motion for summary judgment, a copy of the office action in which applicant's involved mark was cited as a potential basis for a refusal of registration to opposer's application Serial No. 76619569 for the identical mark for identical services. This office action provides a sufficient basis for us to find that there is no genuine issue of material fact that opposer has a good faith belief that he is likely to be damaged by the registration and that therefore opposer has standing to bring this petition to cancel. Based on the foregoing, we find that entry of summary judgment in opposer's, not applicant's, favor on the issue of standing is appropriate.

In view thereof, applicant's motion for summary judgment based on opposer's alleged lack of standing to maintain this proceeding is denied. Rather, we hereby enter partial summary judgment *sua sponte* in opposer's favor with regard to the issue of opposer's standing to maintain this proceeding. See Tonka Corp. v. Tonka Tools, Inc., 229 USPQ 857 (TTAB 1986); TBMP Section 528.08 (2d ed. rev. 2004).

Proceedings herein are resumed. The parties are allowed until thirty days from the mailing date set forth in the caption of this order to serve responses to any outstanding discovery requests. Discovery and testimony periods are reset as follows.

DISCOVERY PERIOD TO CLOSE: 1/12/07

Plaintiff's 30-day testimony period to close: 4/12/07

Defendant's 30-day testimony period to close: 6/11/07

Plaintiff's 15-day rebuttal testimony period to close: 7/26/07

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.

\*3 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.

FN1. Application Serial No. 78113982, filed March 11, 2002 based on an assertion of use in commerce under Trademark Act Section 1(a), 15 U.S.C. Section 1051(a), and alleging July 1, 1983 as the date of first use and date of first use in commerce. The application includes the following description: "The mark consists of a three dimensional building design in the shape of an ice cream cone with three service windows in the cone portion of the building and a soft serve ice cream swirl on top comprising the roof of the building design."

FN2. If the Board concludes, upon motion for summary judgment, that there is no genuine issue of material fact, but that it is the nonmoving party, rather than the moving party, which is entitled to judgment as a matter of law, the Board may, in appropriate cases, enter summary judgment *sua sponte* in favor of the nonmoving party. See TBMP Section 528.08 (2d ed. rev. 2004).

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