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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

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Mailed: August 11, 2011

Opposition No. 91179480
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PLASTI-FAB LTD.

v.

KOBELCO CONSTRUCTION MACHINERY CO., LTD.

Before Seeherman, Holtzman and Cataldo, Administrative Trademark Judges.

By the Board:

Applicant seeks to register the marks **Geospec**, in standard characters, and

(hereinafter, "ACERA GEOSPEC"), both for "power shovels and cranes."[1] As grounds for the oppositions, opposer alleges priority and likelihood of confusion with its mark GEOSPEC. Opposer asserts a pending application, Serial No. 78431217, for the mark GEOSPEC, in standard characters, for "molded expanded polystyrene (EPS) blocks and boards designed to act as a

[1] Application Serial Nos. 79023935 and 79023934, respectively. Both applications were filed on March 30, 2006, seeking an extension of protection to the United States under Trademark Act § 66(a).

lightweight fill material used in geotechnical applications and compressible inclusion against structures; expanded polystyrene (EPS) foundation drainage boards designed to provide insulation and drainage to hydrostatic pressure on foundations; and insulation for walls, pipes, utility lines and vessels."[2]

In its answers, applicant denies the essential allegations of the notices of opposition.

The discovery period closed on August 30, 2010. This case now comes up on opposer's fully briefed motion, filed October 28, 2010, for summary judgment in its favor.[3]

In a motion for summary judgment, the moving party has the burden of establishing that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(a). A genuine dispute with respect to a material fact exists if sufficient evidence is presented such that a reasonable fact finder could decide the question 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). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. *See Olde Tyme*

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[2] Such application was filed on June 7, 2004, claiming a priority date of May 6, 2004. *See* Paragraph No. 2 of the notice of opposition.

[3] This motion for summary judgment was filed in accordance with the Board's order dated June 3, 2010. In such order, as a sanction against applicant, the Board granted opposer leave to file a summary judgment motion prior to the opening of its reset testimony period.

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

By way of the declaration of Kara E. Fielder, a paralegal with the law firm representing opposer, opposer introduces a copy of the original certificate of registration (issued February 19, 2008) for the registration which issued from the pleaded application (Registration No. 3385301). Ms. Fielder asserts that she downloaded the document on October 27, 2010 from the USPTO's website. Bruce M. Carruthers, chief operating officer of opposer, states in his declaration that opposer is "the owner of the mark GEOSPEC®"; that "the GEOSPEC® has been used … in the United States since 2005"; and that "[t]he GEOSPEC® mark is used on products such as lightweight fill materials for geotechnical constructions projects, including road embankments, soil stabilization, lightweight fill material for landscaping over structural slabs."

Trademark Rule 2.122(d)(1) provides as follows:

> A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by an original or photocopy of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration, or by a current printout of information from the electronic database records of the USPTO showing the current status and title of the registration. For the cost of a copy of a registration showing status and title, see § 2.6(b)(4).

Opposer has not made its registration of record. The "soft" copy of the original registration certificate, introduced by Ms.

Fielder, was not prepared and issued by the Office, with the current status of the registration noted thereon. Nor does it qualify as a printout from the electronic database records of the USPTO showing current status and title.[4] *See also* TBMP § 703.03(h)(1)(A) (3d ed. 2011). Nor has Mr. Carruthers testified as to the current status of the registration.

Therefore, opposer may, for purposes of this motion, rely only on its common law rights, and specifically for its rights in GEOSPEC for lightweight fill materials for use in certain types of geotechnical constructions projects.

Considering the goods for which opposer has shown common law rights in its mark, we find that a genuine dispute of material fact exists with respect to the relatedness of the parties' involved goods, the channels of trade, and the intended consumer.[5] There is also a genuine dispute with respect to the strength of the term GEOSPEC.[6]

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[4] The TARR database, a "status" database, is most frequently used to obtain printouts of registrations showing current status and title. The TESS database may also be used. Otherwise, a party must order a copy of the original registration, to be prepared and issued by the Office, showing the current status and title of the registration. Alternatively, a party may introduce evidence that the registration is valid, subsisting and owned by the introducing party by way of the deposition (at trial or on summary judgment) or declaration (on a summary judgment motion only) of its witness. *See* Trademark Rule 2.122(d)(2).

[5] The fact that the Board has identified and discussed only a few genuine issues of material fact as sufficient bases for denying the motion for summary judgment should not be construed as a finding that these are necessarily the only issues which remain for trial. The parties should note that the evidence submitted in support of and in opposition to the motion for summary judgment is of record only for consideration in connection with such motion. To be considered at

In view thereof, opposer's motion for summary judgment is denied.

Proceedings are resumed and dates are reset as follows:

30-day testimony period for party in position of plaintiff to close:	**10/10/2011**
30-day testimony period for party in position of defendant to close:	**12/9/2011**
15-day rebuttal testimony period to close:	**1/23/2012**

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.l25.

Briefs shall be filed in accordance with Trademark Rules 2.l28(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

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final hearing, any such evidence must be properly introduced into evidence during the assigned trial period for the submitting party. *See Levi Strauss & Co. v. R. Josephs Sportswear, Inc.*, 28 USPQ2d 1464, 1465 fn.2 (TTAB 1993); *Pet, Inc. v. Bassetti*, 219 USPQ 911 (TTAB1983); and *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

[6] Contrary to opposer's position, applicant is not precluded from introducing evidence concerning the terms "geo" and "spec," only the term "geospec." The sanctions imposed by the Board on June 3, 2010 construe Document Request No. 22 narrowly (or any other request that is subject to the sanction).