ESTTA Tracking number: **ESTTA334152**
Filing date: **02/25/2010**

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

Proceeding	91186986
Party	Plaintiff LOEST & McNAMEE, INC.
Correspondence Address	Paulette R. Carey Buchman Law Firm, LLP 510 Thornall Street Suite 200 EDISON, NJ 08837 UNITED STATES prcarey@buchmanlaw.com
Submission	Motion for Summary Judgment
Filer's Name	Paulette R. Carey
Filer's e-mail	prcarey@buchmanlaw.com
Signature	/Paulette R. Carey/
Date	02/25/2010
Attachments	2-25-2010 Loest & McNamee Opposition & Request for Admission.pdf (9 pages)(564304 bytes)

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

In the Matter of Application Serial No. 77-247611
Published in the Official Gazette of January 26, 2010

LOEST & McNAMEE, INC.	)	Opposition No. 91186986
Opposer,	)	
vs.	)	
Shaun Roberts Allen	)	
Applicant,	)	

Assistant Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313, 1451

OPPOSER'S MOTION FOR SUMMARY JUDGMENT OR, IN THE ALTERNATIVE FOR SUSPENSION OF THE PROCEEDING

Pursuant to FRCP 56 and TBMP §528 Opposer hereby moves for an Order of Summary Judgment sustaining the opposition and refusing registration of the mark shown in application Serial No. 77-061301.

In the alternative, Opposer requests that the proceeding be suspended pending disposition of a revocation action in New Zealand against the registration on which the opposed application is based.

BACKGROUND

1. Opposer served discovery requests, including a First Request For Admissions, on applicant dated November 18, 2009. A copy of the Admission Requests together with the Certificate of Service are annexed hereto as Exhibit A.

2. The requests were sent by first class mail to Applicant's Attorneys at the address on record with the Board.

3. Applicant Responses were due on December 23, 2009.

4. Applicant has failed to respond to the Requests, seek an extension of time in which to respond to the Requests, or move for a protective order.

ARGUMENT

I. THE REQUESTS FOR ADMISSIONS ARE DEEMED ADMITTED

Applicant has failed to respond to the discovery requests nor has Applicant contacted Opposer's attorney requesting an extension of time in which to respond to the discovery requests. Further Applicant has failed to move the Board for an order extending the time in which to respond to the discovery requests nor for a protective order pursuant to FRCP 26(c).

Therefore, pursuant to FRCP 36(b) and TBMP §411, the requests for admissions are automatically deemed admitted. Accordingly, applicant has admitted:

1. The term Silver, in the applied-for mark is laudatory (admission nos. 2 and 3);

2. The word Fern is the dominant portion of Applicant's mark (admission no. 4);

3. The dominant term Fern in the applied-for mark is identical to Opposer's registered mark (admission no. 5);

4. The respective goods are identical (admission no. 6) will travel through the same retail outlets (admission no. 7) and will be bought by the same consumers (admission no. 8);

5. Use of the respective marks is likely to create consumer confusion (admission no. 9);

6. Opposer has priority (admission no. 12);

7. Registration no. 2906981 is evidence of Opposer's exclusive right to use the mark Fern of good in international Class 33 (admission no. 13);

8. The New Zealand registration which is the basis of the opposed registration under Section 44(d) is the subject of a revocation action in New Zealand (admission no. 14).

II. NO GENUINE ISSUE OF FACT EXISTS

Summary Judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute. FRCP 56(c). A factual dispute is genuine if, on the record, a reasonable fact finder could resolve the matter in favor of the non-moving party. Opryland USA Inc. v. Great American Music Show Inc. 23 USPQ 2d 1471 (Fed. Cir. 1992).

The Notice of Opposition alleges that the applied-for mark is confusingly similar to Opposer's registered mark and is therefore unregistrable under §2(d) of the United States Trademark Act. The only issue to be determined under a §2(d) claim is likelihood of confusion. Applicant has admitted likelihood of consumer confusion (admission no. 9); thus the only issue is this case must be determined in favor of Opposer

Moreover, applicant has admitted the salient elements of the DuPont test necessary to establish likelihood of confusion.

Applicant has admitted the first DuPont factor, that the dominant portion of its mark is identical to Opposer's mark (admission no. 5); the second DuPont factor that the respective goods are identical (admission no. 4); the third DuPont factor that the channels of distribution and consumers overlap (admission no. 6 and 7); applicant has admitted priority of Opposer's mark which tips the fifth DuPont factor in Opposer's favor (admission no. 12); and Opposer has admitted that the eleventh DuPont factor is established in favor of Opposer (admission no. 13). The remaining DuPont factors are not applicable in this case. Therefore, a reasonable fact finder must determine that the applied-for mark is not registrable under section 2(d) of the Trademark Act.

Accordingly, no genuine issue of material fact is in dispute and Opposer is entitled to summary judgment.

III. ALTERNATIVELY, OPPOSER MOVES THAT THIS PROCEEDING BE SUSPENDED PENDING THE DISPOSITION OF NEW ZEALAND REGISTRATION NO. 707364.

Application no. 77247611 was filed on the basis of Section 44(e) claiming New Zealand Registration no. 707364. TMEP§1004(1) specifies that a 44(e) application requires a *valid* registration in applicant's country of origin. The underlying New Zealand Registration is the subject of a revocation action in the Intellectual Property office of New Zealand (admission no. 14). In the event that the New Zealand Registration no. 707364 is revoked, the filing basis of the pending Application no. 77247611 will be invalid and the subject proceeding will be moot.

Accordingly, Opposer requests that the current opposition proceeding be suspended pending disposition of the proceeding in the New Zealand Intellectual Property office against New Zealand Registration no. 707364.

CONCLUSION

For the foregoing reasons Opposer requests an Order of Summary Judgment sustaining the Opposition and refusing registration of the mark shown in application serial no. 77-247611.

In the alternative, Opposer requests that the current proceeding be suspending pending disposition of the revocation proceeding in the New Zealand Intellectual Property office against New Zealand Registration no. 707364.

Dated: February 25, 2010

Respectfully Submitted,

BUCHMAN LAW FIRM, LLP
Attorneys for Opposer

By: _____
Paulette R. Carey
510 Thornall Street, Suite 200
Edison, NJ 08837
(732) 632-6060

Certificate of Service

I hereby certify that on February 25, 2010, I served the foregoing OPPOSER'S MOTION FOR SUMMARY JUDGMENT by delivery a copy to the United States Postal Service, as first class mail postage prepaid in an envelope addressed to:

James. B. Astrachan
Astrachan Gunst & Thomas, P.C.
217 East Redwood Street, 21st Floor
Baltimore, MD 21202

_____
Linda Johnson

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

In the Matter of Application Serial No. 77247611
Published in the Official Gazette of March 4, 2008

LOEST & McNAMEE, INC. Opposer, vs. Shaun Roberts Allen Applicant,	)	OPPOSER'S FIRST REQUEST FOR ADMISSIONS

Assistant Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Opposer, Loest and McNamee, through its undersigned attorneys, hereby requests that applicant, Shaun Roberts Allen, admit under oath or declaration pursuant to Rule 35 of the Federal Rules of Civil Procedure and C.F.R. §2.120, the truth of the following facts:

1. Applicant filed application serial no. 77247611 to register the mark SILVER FERN for use on wines, spirits, liqueurs and alcoholic beverages other than beer.

2. The word SILVER is often used on consumer goods such as alcoholic beverages to indicate quality.

3. The term SILVER is laudatory.

4. The word FERN is the dominant portion of applicant's mark.

5. The word FERN in the applied for mark is identical to Opposer's mark in registration no. 2906981.

6. The goods wines listed in application no. 77247611 are identical to the goods in registration no. 2906981.

7. The goods sold under the applied for mark are sold through the same retail outlets as goods sold under Opposer's mark.

8. Consumers who purchase wine also purchase spirits, liqueurs and other alcoholic beverages in class 33.

9. Consumers familiar with registrant's mark FERN are likely to believe that the mark SILVER FERN is a line extension of Opposer's brand and that Opposer is the source or origin of applicant's goods.

10. Registration no. 2406981 issued on November 30, 2004.

11. Registration no. 2906981 is valid and subsisting.

12. Opposer's priority in its mark predates any priority which may be claimed by applicant in the mark SILVER FERN and in application no. 77247611.

13. Registration no. 2906981 is *primae facae* evidence of Opposer's exclusive right to use the mark of Opposer's exclusive right to use the mark FERN on goods in international class 33.

14. New Zealand registration no. 707364 is the subject of a revocation action in the Intellectual Property Office of New Zealand.

Dated: November 18, 2009

Respectfully Submitted,

BUCHMAN LAW FIRM, LLP
Attorneys for Opposer

By: _____
Paulette R. Carey
510 Thornall Street, Suite 200
Edison, NJ 08837
(732) 632-6060

CERTIFICATE OF SERVICE

I hereby certify that on November 18, 2009, I served the foregoing Opposer's First Request for Admissions by delivering a copy to the United States Postal Service, as first class mail postage prepaid in an envelope addressed to:

James B. Astrachan
Astrachan Gunst & Thomas, P.C.
217 East Redwood Street, 21st Floor
Baltimore, MD 21202

Linda Johnson