

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

Baxley

Mailed: May 18, 2011

Opposition No. 91190169

Susino Umbrella Co., Ltd.

v.

Susino USA, LLC

Before Kuhlke, Wellington, and Wolfson,  
Administrative Trademark Judges.

By the Board:

In the above-captioned proceeding, Susino Umbrella Co., Ltd., a Chinese corporation, ("opposer") opposes registration of Susino USA, LLC's ("applicant") application to register the mark SUSINO in stylized form for various types of umbrellas in International Class 18<sup>1</sup> on the ground of likelihood of confusion with its previously used mark SUSINO for umbrellas under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).

In a March 18, 2011 order, the Board: (1) granted opposer's motion to vacate the Board's June 8, 2010 order in which applicant's motion (filed March 12, 2010) for summary judgment was granted as conceded; and (2) reset time for

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<sup>1</sup> Application Serial No. 77355544, filed December 19, 2007, based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. Section 1051(a), and alleging June 1, 2007 as the date of first use and December 10, 2007 as the date of first use in commerce.

**Opposition No. 91190169**

briefing of that motion for summary judgment. In that order, the Board stated that, in view of the acceptable service of, and opposer's failure to timely respond to, the requests for admission that applicant served on January 11, 2010, such requests stand admitted by operation of applicable rules.

This case now comes up for consideration of: (1) applicant's motion for summary judgment based on opposer's admission that opposer does not have prior rights in the SUSINO mark; and (2) opposer's motion to withdraw its admissions under Fed. R. Civ. P. 36(b). The motions have been fully briefed.

As an initial matter, we note that opposer's twenty-page brief in response to the motion for summary judgment and opposer's twenty-page brief in support of its motion to withdraw its admissions contain many overlapping arguments.<sup>2</sup> The better practice under the circumstances would have been for opposer to file a single combined brief in response to the motion for summary judgment and in support of the motion to withdraw admissions that did not exceed twenty-five pages. See Trademark Rule 2.127(a); TBMP Section 502.02(b)

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<sup>2</sup> Indeed, opposer included its proposed responses to applicant's requests for admission as an exhibit to its brief in response to the motion for summary judgment, but did not include a copy of those responses as an exhibit to its brief to withdraw its admissions.

**Opposition No. 91190169**

(3d ed. 2011). Nonetheless, the Board will consider both of opposer's briefs.

The Board will first determine opposer's motion for leave to withdraw its admissions. Upon motion under Fed. R. Civ. P. 36(b), the Board may permit withdrawal or amendment of an admission (1) when the presentation of the merits of the proceeding will be subserved thereby, and (2) the propounding party fails to satisfy the Board that withdrawal or amendment will prejudice said party in maintaining its action or defense on the merits. See *Giersch v. Scripps Networks, Inc.*, 85 USPQ2d 1306, 1308-09 (TTAB 2007); TBMP Section 525 (3d ed. 2011).

The first prong of the test is satisfied "when upholding the admissions would practically eliminate any presentation of the merits of the case." *Hadley v. United States*, 45 F.3d 1345, 1348 (9th Cir. 1995). That is, the proposed withdrawal or amendments must "facilitate the development of the case in reaching the truth." *Farr Man & Co., Inc. v. M/V Rozita*, 903 F.2d 871, 876 (1st Cir. 1990).

Regarding the second prong, "'prejudice' is not simply that the party who initially obtained the admission will now have to convince the fact finder of its truth, but rather, relates to the special difficulties a party may face caused by the sudden need to obtain evidence upon withdrawal or amendment of admission." *Kerry Steel, Inc. v. Paragon*

**Opposition No. 91190169**

*Industries, Inc.*, 106 F.3d 147 (6th Cir. 1997). Mere inconvenience does not constitute prejudice. See *Hadley v. U.S.*, *supra*. The test is whether the propounding party is now any less able to obtain the evidence required to prove the matter which was admitted than it would have been at the time the admission was made. See *Rabil v. Swafford*, 128 F.R.D. 1, 2 (D.D.C. 1989).

With respect to the first prong, the Board finds that the merits of the action will be subserved by allowing withdrawal of the admissions which resulted from opposer's failure to timely respond. As an exhibit to its brief in response to the motion for summary judgment, opposer has submitted a response to applicant's requests in which many of the previously admitted facts are denied, thereby demonstrating that many of the supposedly admitted matters are in fact disputed, particularly with regard to the issue of priority. Indeed, applicant's motion for summary judgment is based largely upon its requests for admission, which stand admitted as a result of opposer's failure to respond thereto.<sup>3</sup> See Fed. R. Civ. P. 36(a)(3); TBMP

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<sup>3</sup> In addition to the unanswered requests for admissions, applicant submitted with its main brief copies of its unanswered interrogatories and documents requests and the pleadings herein in support of its motion for summary judgment. Unanswered interrogatories and document requests have no evidentiary value. See Trademark Rule 2.120(j)(3)(i) and (j)(5) and 2.127(e)(2); TBMP Sections 528.05(c) and 704.10 (3d ed. 2011). Further, pleadings provide fair notice of the claims or defenses asserted in a case and do not constitute evidence, except under limited

**Opposition No. 91190169**

Section 407.03(a). If withdrawal thereof were not permitted, opposer would be held to have admitted critical elements of this case. As to the second prong, we find that, even if applicant is required to take discovery from foreign individuals and entities, applicant will not be prejudiced by allowing the withdrawal of opposer's effective admissions and the replacement thereof with the later-served responses. Applicant has failed to demonstrate that it is now any less able to obtain the evidence necessary to prove the matter which was admitted than it would have been in February 2010, when the admission was made. Further, applicant filed its motion for summary judgment with roughly two months remaining in the discovery period. The case is therefore in the pre-trial stage, and any potential prejudice can be mitigated by extending the discovery period as necessary to permit applicant to take any additional follow-up discovery based on opposer's amended admissions. See *Johnston Pump/General Valve, Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719 (TTAB 1989). Based on the foregoing, opposer's motion to withdraw its admissions is granted.

We now turn to the motion for summary judgment on the issue of priority. The Board shall grant summary judgment where a movant establishes that there is no genuine dispute

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circumstances not at issue herein. See Trademark Rule 2.122(d)(1).

**Opposition No. 91190169**

as to any material fact and the movant is entitled to judgment as a matter of law. In deciding motions for summary judgment, the Board must follow the well-established principles that, in considering the propriety of summary judgment, all evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the nonmovant's favor. The Board may not resolve disputes of material fact; it may only ascertain whether such disputes are present. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

We note initially that opposer has only sufficiently pleaded a claim under Trademark Section 2(d).<sup>4</sup> That is,

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<sup>4</sup> Although the electronic cover sheet of the notice of opposition lists fraud as a ground for opposition, it is insufficient for purposes of setting forth a fraud claim and we further note that the text of the attached notice of opposition does not even mention a fraud claim. Fraud in procuring or maintaining a trademark registration requires an allegation that an applicant for registration or a registrant in a declaration of use or a renewal application knowingly made specific false, material representations of fact in connection with an application to register or in a post-registration filing with the intent of obtaining or maintaining a registration to which it is otherwise not entitled. See *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009). Moreover, while certain allegations appear to imply nonuse and nonownership, to the extent opposer seeks to pursue such claims, opposer would need to file a motion to amend the notice of opposition accompanied by a proposed amended complaint that clearly sets forth such claims. See Fed. R. Civ. P. 15(a)(2); TBMP Section 507.02 (3d ed. 2011).

**Opposition No. 91190169**

notwithstanding the allegations raised in response to the motion for summary judgment regarding the nature of the parties' previous business relationship and the substitute specimen that applicant submitted in support of its application, the notice of opposition does not include claims that applicant is not the owner of the mark sought to be registered, that applicant did not use the mark in commerce prior to filing the involved application under Trademark Act Section 1(a), 15 U.S.C. Section 1051(a), or that applicant committed fraud upon the USPTO in prosecuting its involved application by knowingly and willfully making false, material statements regarding the specimen of use in support thereof. See *Hurley International LLC v. Volta*, 82 USPQ2d 1339, 1346 (TTAB 2007).

With regard to the issue of priority, applicant, who is appearing *pro se*, did not submit any specific evidence establishing sales of umbrellas or parts thereof bearing its involved mark prior to its application filing date with its brief in support of the motion for summary judgment and relies solely on applicant's now amended admissions in support thereof.

In response to the motion for summary judgment, opposer contends that it first used the SUSINO mark in the United States in August 2007, when it displayed umbrellas bearing that mark at a trade show in Las Vegas, Nevada. Opposer

**Opposition No. 91190169**

further contends that it first sold umbrellas under the SUSINO mark on October 9, 2008.

In applicant's combined reply brief in support of its motion for summary judgment and brief in opposition to the motion to withdraw admissions, contends that opposer merely provided low cost labor; that applicant controlled the specification and design of orders placed with opposer; that opposer does not allege any use which predates the June 1, 2007 date of first use set forth in its involved application; and that applicant used the SUSINO trade name at the same August 2007 trade show in Las Vegas, Nevada.

The Board notes initially that a mark is in use in commerce on goods when that mark

is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and ... the goods are sold or transported in commerce.

Trademark Act Section 45, 15 U.S.C. Section 1127. Thus, use of a trade name and/or a display at a trade show, by themselves, does not constitute use of that mark.<sup>5</sup> However,

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<sup>5</sup> Although opposer refers in the notice of opposition to application Serial No. 79001855 that it filed on March 26, 2004 under Trademark Act Section 66(a), 15 U.S.C. Section 1141f, for the mark SUSINO and design for various umbrellas and parts thereof, such application was abandoned on June 7, 2005 and cannot be relied upon herein. See also the Board's December 10, 2009 order at 4.

To the extent that opposer relies upon any foreign use of the SUSINO mark, trademark rights are territorial in nature; a party's foreign use of a mark generally creates no rights in that

**Opposition No. 91190169**

applicant's alleged trade name use and/or opposer's display at the same trade show could conceivably support an assertion of analogous use of the involved mark, provided that the analogous use is of such a nature and extent as to create public identification of the SUSINO mark with the claiming party's goods. See *Herbko Int'l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002); *T.A.B. Systems v. PacTel Teletrac*, 77, F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996).

Contrary to applicant's apparent belief, the dates of use set forth in applicant's involved application are not evidence of use. See Trademark Rule 2.122(b)(2). Because applicant has not provided specific evidence of sales of umbrellas under the SUSINO mark that predate the December 19, 2007 filing date of the involved application, applicant must rely upon the December 19, 2007 constructive use filing date of its involved application as its date of first use herein. See Trademark Act Section 7(c), 15 U.S.C. Section 1057(c).

Viewing the evidence of record in a light most favorable to opposer as the nonmovant, we find that disposition of this proceeding by summary judgment is

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mark in the United States. See *Johnson & Johnson v. Salve S.A.*, 183 USPQ 375, 376 (TTAB 1974); TBMP Section 414(13) (3d ed. 2011). But see *Mastic Inc. v. Mastic Corp.*, 230 USPQ 699, 702 (TTAB 1986).

**Opposition No. 91190169**

inappropriate. At a minimum, there is a genuine dispute as to whether either party undertook activities in the United States with regard to umbrellas bearing the SUSINO mark that were sufficient to constitute an analogous use sufficient to create prior proprietary rights in that mark.<sup>6</sup> In view thereof, applicant's motion for summary judgment is hereby denied.<sup>7</sup>

Proceedings herein are resumed. Opposer is allowed until thirty days from the mailing date set forth in this order to serve responses to the interrogatories and document requests that applicant served on December 23, 2009.

Remaining dates are reset as follows.

Expert Disclosures Due	7/20/11
Discovery Closes	8/19/11
Plaintiff's Pretrial Disclosures Due	10/3/11
Plaintiff's 30-day Trial Period Ends	11/17/11
Defendant's Pretrial Disclosures Due	12/2/11
Defendant's 30-day Trial Period Ends	1/16/12
Plaintiff's Rebuttal Disclosures Due	1/31/12

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<sup>6</sup> The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *Am. Meat Inst. v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

In addition, the parties should not infer that the genuine dispute that we have identified is the only such dispute remaining for trial.

<sup>7</sup> Applicant asserts that the notice of opposition was improperly filed because opposer's president stated in his declaration that opposer's foreign attorney engaged opposer's former United States attorney to file the notice of opposition without first consulting opposer. This assertion is unpleaded and is otherwise not well-taken. See TBMP Section 314 (3d ed. 2011).

**Opposition No. 91190169**

Plaintiff's 15-day Rebuttal Period Ends

3/1/12

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.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.