

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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

coggins

Mailed: June 20, 2012

Opposition No. 91196412

Mr. Dennis Kearney

v.

Rim Yatim and Najib Yatim

Before Seeherman, Taylor, and Lykos,
Administrative Trademark Judges.

By the Board:

This case comes up on opposer's motion (filed July 15, 2011) for summary judgment on the ground of priority and likelihood of confusion. The motion is fully briefed.¹

Background

On June 26, 2008, Rim Yatim and Najib Yatim filed, as joint applicants, application Serial No. 77509239 to register the mark at right for "chocolate and chocolates; chocolate bars;



¹ Applicants' brief in opposition to the motion was signed by Najib Yatim, only. Applicants, as joint owners, are individual parties and must therefore both sign all documents filed in this proceeding. See TMEP § 611.06(a), and TBMP § 106.02 (3d ed. 2011). Applicants also failed to use page numbers in their brief, as required by Trademark Rule 2.126(a)(5). Notwithstanding these minor issues, we have considered applicants' brief.

chocolate candies; chocolate truffles; chocolates and chocolate based ready to eat candies and snacks."² The application is based on Sections 1(a) and 44(e) of the Trademark Act, and applicants claim a priority filing date of December 27, 2007, under Section 44(d) of the Trademark Act, based on a Canadian registration.

On September 8, 2012, Dennis Kearney filed a notice of opposition alleging priority and likelihood of confusion with his mark COCO DÉLICE, and opposer pleaded ownership of application Serial No. 77402783 for the mark COCO DÉLICE (in standard characters) for "chocolates, candy, chocolate candies, chocolate confections, filled chocolate, chocolate truffles, chocolate covered nuts."³ The application was filed on February 21, 2008, under Section 1(a) of the Trademark Act, and claims November 2005 as the date of first use anywhere and date of first use in commerce.

² No claim is made to the exclusive right to use COCOA or CHOCOLATERIE apart from the mark as shown. The foreign wording in the mark translates into English as DELIGHTS. The mark consists of "Cocoa Delices Chocolaterie" in stylized font appearing beneath a stylized depiction of a leaning cocoa tree with cocoa pods and leaves. Color is not claimed as a feature of the mark. For their Section 1(a) basis, applicants claim July 1, 2007, as the date of first use anywhere, and December 20, 2008, as the date of first use in commerce.

³ No claim is made to the exclusive right to use COCOA apart from the mark. The English translation of the word DÉLICE in the mark is DELIGHT.

Motion for Summary Judgment

By way of his motion, opposer seeks summary judgment in his favor on the ground pleaded in the notice of opposition, namely, priority and likelihood of confusion.

Summary judgment is appropriate where there are no genuine disputes of material fact, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(a). The party seeking summary judgment bears the burden of demonstrating the absence of any genuine dispute as to any material fact, and that it is entitled to a judgment under the applicable law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). The Board may not resolve issues of material fact, but can only ascertain whether genuine disputes exist regarding such issues. The evidence on summary judgment must be viewed in a light most favorable to the non-movant and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 767, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993).

Opposer's motion for summary judgment is supported by, *inter alia*, a declaration from Dennis Kearney, with accompanying exhibits; a declaration from Lindsey Furtado, an attorney for opposer, with accompanying exhibits; and a

printout from the TARR electronic database⁴ for opposer's pleaded application, along with an Office action related thereto. Applicants' brief in opposition to the motion for summary judgment is supported by, *inter alia*, printouts of third-party applications and registrations from TESS (the USPTO's public trademark search system) and TARR, and copies of printouts from many third-party Internet websites.

Standing

Before we consider the merits of the motion for summary judgment, we must first consider the question of whether a genuine dispute exists as to opposer's standing to bring this opposition proceeding. Standing is a threshold issue that must be proven by a plaintiff in every *inter partes* case. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999) and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

As Exhibit 2 to his motion for summary judgment, opposer made of record his application for the mark COCO DÉLICE (Serial No. 77402783), as well as an Office action that issued for that application, in which the examining attorney cited applicants' application, and stated that if applicants' application were to be registered, the examining attorney may refuse registration to opposer's mark on the

⁴ TARR, now known as TSDR, is the USPTO's electronic database for document retrieval.

basis of likelihood of confusion with applicants' mark. Opposer has therefore shown that he has a personal stake in this proceeding, and there is no genuine dispute as to his standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Fiat Group Automobiles S.p.A. v. ISM Inc.*, 94 USPQ2d 1111, 1112 (TTAB 2010) (the filing of opposer's application and the Office's action taken in regard to that application provides opposer with a basis for pleading its standing). In view thereof, opposer's motion for summary judgment is granted as to opposer's standing.

Priority and Likelihood of Confusion

In order for opposer to prevail on his priority claim, opposer must prove that he has a proprietary interest in the mark COCO DÉLICE and that the interest was obtained prior to the priority filing date of applicants' application, or prior to any date of use on which applicants may rely. *Herbko International Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Otto Roth & Co., Inc. v. Universal Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *L. & J.G. Stickley Inc. v. Cosser*, 81 USPQ2d 1956, 1966 (TTAB 2007); *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1714 (TTAB 1993).

The subject application was filed July 26, 2008, with a priority date of December 27, 2007. Applicants appear to

argue in their brief that they are entitled to rely on July 2007 as their date of priority since they began using their mark in Canada in July 2007; however, such foreign use cannot form the basis for a holding that applicants have priority in the United States. See *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477 (Fed. Cir. 1990). It is clear that applicants may rely on December 27, 2007, as their priority date based on their Canadian registration, and opposer concedes this in his motion. See 15 U.S.C. §§ 1126(d)(1) and 1141(g); and Trademark Rules 2.34(a)(4)(i) and 7.27(c), 37 CFR §§ 2.34(a)(4)(i) and 7.27(c). Opposer must, therefore, on this motion for summary judgment, establish that he acquired common law rights prior to December 27, 2007, since he is relying on use, and not a registration.

Although opposer has submitted a declaration stating that he made his first sale of "chocolates" in November 2005, a date that is prior to applicants' priority filing date, there are genuine disputes as to the nature and extent of his common law rights. At a minimum, opposer has not demonstrated the lack of a genuine dispute as to when he actually acquired common law rights in his mark and for which goods, with which of his goods he made prior use of the mark, and his channels of trade and classes of customers.

With respect to the issue of likelihood of confusion, we find, at a minimum, that genuine disputes exist as to the strength of opposer's mark, the scope of protection to which the mark is entitled, and the number and nature of similar marks in use on similar goods.

In view thereof, opposer's motion for summary judgment is denied as to priority and likelihood of confusion.

Summary

Opposer's motion is granted as to opposer's standing, but is denied as to priority and likelihood of confusion.⁵

Schedule

Proceedings are resumed, and dates are reset on the following schedule.

Plaintiff's 30-day Trial Period Ends	8/21/2012
Defendant's Pretrial Disclosures	9/5/2012
Defendant's 30-day Trial Period Ends	10/20/2012
Plaintiff's Rebuttal Disclosures	11/4/2012
Plaintiff's 15-day Rebuttal Period Ends	12/4/2012

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

⁵ The parties are reminded that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced during the appropriate trial period. *See, for example, Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

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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.