

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

Goodman

Mailed: September 13, 2011

Opposition No. 91197393<sup>1</sup>  
(parent)

Sandra Ellis

v.

Beyond The Box, Inc.

Opposition No. 91197395

TSDC, LLC

v.

Beyond the Box, Inc.

Before Bucher, Zervas and Bergsman, Administrative Trademark  
Judges.

By the Board:

Applicant, Beyond the Box, Inc., seeks to register the  
mark FIGHT LIKE A CAROLINA GIRL for "athletic apparel,  
namely, shirts, pants, jackets, hats and caps, athletic  
uniforms excluding footwear" in International Class 25.<sup>2</sup>  
Opposers Sandra Ellis and TSDC, LLC (hereinafter TSDC)

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<sup>1</sup> For administrative convenience, we have consolidated these proceedings. Both opposers are represented by the same counsel, and the pleadings filed in both proceedings are identical, involving the same issues and facts and the same involved application. We note that the parties are identified as joint opposers in each notice of opposition.

<sup>2</sup> Application Serial No. 77900545 filed under Section 1(b).

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oppose registration on the ground of priority and likelihood of confusion.<sup>3</sup>

On February 15, 2011, applicant filed a motion for judgment on the pleadings in Opposition Nos. 91197393 and 91197395. Proceedings were suspended in Opposition No. 91197393 on February 17, 2011. Although no suspension order issued in Opposition No. 91197395, we deem proceedings suspended as of the filing date of the motion for judgment on the pleadings in that case, February 15, 2011. *See Leeds Technologies Ltd v. Topaz Communications Ltd.*, 65 USPQ2d 1303 (TTAB 2002) (considering proceedings suspended retroactive to filing of motion for judgment on the pleadings). Opposers filed, on July 7, 2011, in both proceedings, supplemental responses or cross-motions for judgment on the pleadings which were accompanied by exhibits in the form of dictionary definitions. We consider opposers' cross-motions as motions for summary judgment. TBMP Section 503.04 (3d ed. 2011).

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<sup>3</sup> Opposers identified the additional grounds of Section 2(a) deceptiveness, Section 2(a) false suggestion of a connection, and Section 43(c) dilution on their ESTTA cover sheets. However, the factual bases for these grounds were not alleged in the notices of opposition, and the ESTTA coversheet alone is insufficient to assert these claims under Fed. R. Civ. P. 8(a). We also note that, as we stated in Opposition No. 91197395, the "counterclaim" alleged in applicant's answer in Opposition No. 91197393 "will be given no consideration . . . . because '[t]he only type of counterclaim that may be entertained by the Board is a counterclaim for cancellation of a registration owned by an adverse party.'"

We turn first to consideration of opposers' supplemental filing or cross motion for summary judgment.

To the extent that opposers seek leave to file supplemental responses to applicant's motions for judgment on the pleadings, the motions are denied. To the extent that opposers' filings are motions for summary judgment, the motions are denied as premature inasmuch as opposers' initial disclosures have not been served in either opposition proceeding. Trademark Rule 2.127(e)(1) and TBMP Sections 504 and 528.02.<sup>4</sup> The cross-motions are also denied as untimely inasmuch as the motions were not filed within the response period for filing a cross-motion. Trademark Rule 2.127(a)(1); *see e.g., Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1734 n.2 (TTAB 2001) (finding applicant's response and cross-motion untimely filed as response was due on February 10, 2001 but the filing was not received by the Office until February 15, 2001). Lastly, the motions for summary judgment are also denied as being based on an unpleaded issue, namely, that the involved application is void ab initio. TBMP Section

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<sup>4</sup> As stated *supra*, we consider proceedings suspended in Opposition No. 91197395 as of the February 15, 2011 filing of the motion for judgment on the pleadings, which was prior to the due date for service of initial disclosures in Opposition No. 91197395. In their July 7, 2007 filing, opposers have not indicated that initial disclosures have been served on applicant in either opposition proceeding.

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528.07(a) (party may not obtain summary judgment on an issue that is not pleaded).

We now turn to consideration of applicant's motion for judgment on the pleadings.

A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice. For purposes of the motion, all well pleaded factual allegations of the non-moving party must be accepted as true, while those allegations of the moving party which have been denied (or which are taken as denied, pursuant to Fed. R. Civ. P. 8(b)(6), because no responsive pleading thereto is required or permitted) are deemed false. Conclusions of law are not taken as admitted and all reasonable inferences are drawn in favor of the nonmoving party. *Baroid Drilling Fluids Inc. v. SunDrilling Products*, 24 USPQ2d 1048 (TTAB 1992). Further, a motion for judgment on the pleadings may be granted only where, on the facts as deemed admitted, there is no genuine dispute of material fact to be resolved, and the moving party is entitled to judgment on the substantive merits of the controversy, as a matter of law. *Id.*

To prevail on a Section 2(d) ground of opposition, the movant must prove priority and likelihood of confusion. A party that has filed an intent-to-use application may rely

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on the filing date of its application to establish priority. *See Zirco Corp. v. American Telephone & Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991). Therefore, opposers' argument that applicant may not rely on the filing date of its application to establish priority is not well taken.

The filing date of the involved application is December 23, 2009. Opposers have pleaded TSDC's ownership of application Serial No. 85022163 for the mark FIGHT LIKE A GIRL CLUB - CLAIM YOUR POWER and alleged a date of first use in commerce of "at least as early as May 12, 2010."<sup>5</sup> Opposers have pleaded TSDC's ownership of application Serial No. 85082681 for the mark FIGHT LIKE A GIRL CLUB, alleging a filing date of July 12, 2010 and a date of first use of May 12, 2010 for Class 45 services and a date of first use of July 9, 2010 for its Class 14 goods. (Paragraphs 3, 4, 5, 6 and 7 notices of opposition). In its answers, applicant has admitted paragraphs 3, 4, 6 and 7, and "[a]dmitted regarding 'alleged' use date of at least as early as May 12, 2010" for paragraph 5 of the notices of opposition.

Although applicant has denied opposers' allegations of valid and continuous use of TSDC's FIGHT LIKE A GIRL CLUB

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<sup>5</sup> The notices of opposition allege that TSDC "is operated by Ellis." Opposers do not allege the filing date of application Serial no. 85022163 in the notices of opposition, but the notices of opposition are accompanied by TARR printouts of the pleaded applications. We may look to Office records for the filing date of TSDC's pleaded applications to determine if opposers' well

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mark since May 12, 2010 for services and July 9, 2010 for goods in paragraphs 12 and 13 of the notices opposition, applicant states in its motion for judgment on the pleadings, that for purposes of the motion, it accepts as true opposers' factual allegations relating to its application Serial Nos. 85022163 and 85082681. Applicant further acknowledges in its motion the filing date of TSDC's application Serial No. 85022163 as April 23, 2010, the filing date of TSDC's application Serial No. 85082681 as July 12, 2010, and the date of first use in commerce of TSDC's FIGHT LIKE A GIRL CLUB mark of "at least as early as May 12, 2010 for some goods and services."

In view thereof, the filing date of TSDC's application Serial No. 85022163 (April 23, 2010) for the mark FIGHT LIKE A GIRL CLUB - CLAIM YOUR POWER and TSDC's date of first use in commerce (May 12, 2010) for some goods and services with respect to the FIGHT LIKE A GIRL CLUB mark are not in dispute.

Accordingly, we find that it is undisputed that applicant's filing date is December 23, 2009, and that the earliest dates upon which opposers can rely for purposes of priority are the April 23, 2010 filing date for TSDC's application Serial No. 85022163, FIGHT LIKE A GIRL CLUB -

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pleaded allegations are true. *Compagnie Gervais Danone v. Precision Formulations LLC*, 89 USPQ2d 1251, 1256 (TTAB 2009).

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CLAIM YOUR POWER mark and May 12, 2010 with regard to common law use for TSDC's FIGHT LIKE A GIRL CLUB mark. In view thereof, we find there is no genuine dispute of material fact that opposers do not have prior actual or constructive use, and opposers' priority claims fail as a matter of law.

Because opposers have failed to plead any facts by which they can establish priority of use, they cannot prevail, and we need not reach the question of likelihood of confusion concerning the parties' marks. See *Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477, 1479 n.4 (TTAB 1998) ("although an opposition cannot be sustained under Section 2(d) on the basis of opposer's prior use without proof of likelihood of confusion, the opposition can be defeated by applicant's proof of prior use alone").

In view of the foregoing, applicant's motion for judgment on the pleadings is granted on the issue of priority. Opposition nos. 91197393 and 91197395 are hereby dismissed, contingent on issuance of a registration to applicant.<sup>6</sup>

The time for filing an appeal or for commencing a civil action will run from the date of this decision. Trademark Rules 2.129(d) and 2.145. Once applicant's application

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<sup>6</sup> Any judgment entered in favor of applicant is contingent upon the ultimate issuance of the registration. *Compagnie Gervais Danone*, 89 USPQ2d at 1251.

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registers or, in the event it abandons, the interested party should inform the Board so that appropriate action will be taken in this case.