United States Patent And Trademark Office
Trademark Trial and Appeal Board
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WINTER

Mailed: February 18, 2015

Opposition No. 91204462

Jeanette K. Daniels

v.

TGN Services, LLC

Before Quinn, Mermelstein, and Lykos,
Administrative Trademark Judges.

By the Board:

Applicant seeks registration of the mark "ProGenealogists" in standard characters for a variety of services in International Classes 41 and 42, including, *inter alia*, "providing online publications in the nature of newsletters, reports and magazines" and "providing research services" in the field of genealogical historical data, family history data, census data, birth, marriage and death records."[1] In her amended notice of opposition (filed September 9, 2013), Opposer opposes registration of the applied-for mark on

[1] Application Serial No. 85331574 filed May 26, 2011, under Section 1(a) of the Trademark Act, claiming November 30, 1988, as its first date of use anywhere, and January 31, 1999, as its first date of use in commerce. Applicant seeks registration under Section 2(f) of the Trademark Act and, in support thereof, claims that the mark has become distinctive of the identified services through its substantially exclusive and continuous use of the mark in commerce for at least the five years preceding the filing date of the application. Applicant also claims ownership of U.S. Reg. No. 3051870 for "ProGenealogists" on the Supplemental Register for related services.

the grounds that the mark is merely descriptive of applicant's services and has not acquired distinctiveness (amended notice of opp., ¶¶ 5, 9), and that the mark is generic (*Id.* at ¶ 8). Opposer also alleges that she is a professional genealogist, has common-law rights in the terms "professional genealogist" and "pro genealogist" (*Id.* at ¶¶ 1, 4, 9), and that she has used the terms "pro" and "genealogist" (and other similar terms) descriptively longer than Applicant has used the designation sought to be registered. (*Id.* at ¶4). Applicant has denied the salient allegations in the amended notice of opposition. This case now comes up for consideration of Applicant's fully briefed motion (filed September 11, 2014) for summary judgment on the ground that Opposer lacks the requisite standing to bring this case.

Decision

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute with respect to any material fact, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c)(1). A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute as to a material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great American Music*

Show Inc., 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). Additionally, the evidence of record and all justifiable inferences that may be drawn from the undisputed facts must be viewed in the light most favorable to the non-moving party. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and *Opryland USA,* 23 USPQ2d at 1472.

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, 1025-26 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). The Court of Appeals for the Federal Circuit has enunciated a liberal threshold for determining standing, namely, whether a plaintiff's belief in damage has a reasonable basis in fact and reflects a real interest in the case. *See Ritchie v. Simpson,* 50 USPQ2d at 1030. *See also Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988). Further, when a plaintiff challenges a registration on the ground of descriptiveness or genericness, as is the case here, the plaintiff may establish its standing by pleading and proving that it is engaged in the sale of the same or closely related products or services (or that the product or service in question is within the normal expansion of the plaintiff's business), and that the plaintiff has a competitive need or equal right to use the term in a descriptive manner, that is, that plaintiff is in a

position to use the term descriptively. *See, e.g., Nobelle.Com, LLC v. Qwest Comm. Int'l, Inc.*, 66 USPQ2d 1300 (TTAB 2003); *Binney & Smith Inc. v. Magic Marker Industries, Inc.,* 222 USPQ 1003, 1010 (TTAB 1984); and *Mars Money Systems v. Coin Acceptors, Inc.*, 217 USPQ 285 (TTAB 1983). "All that is necessary is that petitioner be in a position to have a right to use of" the mark in question. J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 20:50 (2014).

Having carefully considered the arguments and evidence submitted by the parties and drawing all inferences with respect to the motion in favor of Opposer, the nonmoving party, we find that there is no genuine dispute of material fact that Opposer has standing to oppose registration of Applicant's applied-for mark. Specifically, Opposer alleges that she is a professional genealogist and is an instructor at a genealogy college, which assists students to become professional genealogists (amended notice, ¶¶ 1, 3). As a professional genealogist, Opposer asserts that she has done genealogical research work for clients since 1977 (*Id.*), and uses the words "pro," "professional," "genealogy," "genealogists," and "genealogist" in her genealogic business (*Id.* at ¶ 4). In support of these allegations, Opposer has submitted a copy of her certification as an "Accredited Genealogist," issued by The Genealogical Department of The Church of Jesus Christ of Latter-day Saints (TTABVUE #69 at 8, Opposer's Exh. CC).[2] In addition, during

[2] We note that Opposer submitted numerous documents on August 28, 2014 (TTABVUE nos. 35-54) entitled "P notice of reliance." These documents were not

Opposer's discovery deposition, a copy of which was submitted by Applicant, Opposer states that she was president of the local Association for Professional Genealogists (TTABVUE #55 at 66; Applicant's Exh. E, Daniels dep. 65:25-66:2); and that she has done genealogical research for students (TTABVUE #55 at 59; *Id.* at 40:14-42:6). Further, Opposer (through the Heritage Genealogical College, which she owns and operates[3]) submitted evidence that she uses the phrases "Where Genealogists Become Professionals," "Professional Genealogy," and "Professional Genealogical Research Courses" on the college website (TTABVUE #55 at 86, Applicant's Exh. G). In view of the foregoing evidence, Opposer has demonstrated a real interest, that is to say, "a direct and personal stake" in the outcome of this proceeding, and a reasonable basis for belief that she may be damaged by registration of the applied-for mark. *See Ritchie v. Simpson,* 50 USPQ2d at 1027.

In view of the foregoing, we find that there are no genuine disputes of material fact as to the issue of standing, and that Opposer has standing as a matter of law. Therefore, Opposer's standing will be treated as established in the case.

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submitted in connection with any motion and were submitted outside of Opposer's testimony period. Accordingly, they will not be considered. *See* Trademark Rules 2.122 and 2.123(l). However, Opposer's notices of reliance filed on October 12, 2014, during her testimony period and before the proceeding was suspended, may be considered by the Board at final hearing.

[3] See TTABVUE #55 at 59-60, Daniels dep. 40:6-8.

Accordingly, Applicant's motion for summary judgment is denied. This proceeding shall thus move forward solely with respect to Opposer's claims that the mark is merely descriptive and generic.[4]

Proceeding Resumed; Trial Dates Reset

This proceeding is resumed. Trial dates are reset as shown in the following schedule:[5]

Defendant's Pretrial Disclosures Due	**3/6/2015**
Defendant's 30-day Trial Period Ends	**4/20/2015**
Plaintiff's Rebuttal Disclosures Due	**5/5/2015**
Plaintiff's 15-day Rebuttal Period Ends	**6/4/2015**

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. *See* Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

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[4] The parties are reminded that, absent the parties' stipulation that the evidence submitted in connection with the motion for summary judgment is to be considered of record for trial, said evidence is of record only for consideration of the motion for summary judgment. *See* TBMP § 501 (2014) and authorities cited therein. *See also* TBMP § 702.04(d). Any such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial periods. *See Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

[5] It is noted that Opposer submitted evidence on the last day of the previously reset testimony period, October 12, 2014.