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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
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Faint

Mailed: June 12, 2013

Opposition No. 91204620

Pacific Poultry Company, Limited

v.

George D. Stirling, Jr.

Before Kuhlke, Wellington and Gorowitz, Administrative Trademark Judges.

By the Board:

George D. Stirling, Jr. ("applicant") seeks to register the mark SWEET G'S HULI CHICKEN MARINADE, SAUCE, GLAZE in standard character form for "retail grocery stores" in Class 35.[1]

Pacific Poultry Company, Limited ("opposer") has opposed registration of applicant's mark on the grounds of priority and likelihood of confusion,[2] and that applicant lacks a bona

[1] Application Serial No. 85247221, filed Feb. 21, 2011 based on Trademark Act § 1(b). A disclaimer of "HULI CHICKEN MARINADE, SAUCE, GLAZE" is of record.

[2] Opposer pleads ownership of two registrations which were attached to the amended notice of opposition: (1) Registration No. 958668 for the mark "HULI-HULI" in special form for "sauces for meat and poultry" in Class 30, registered May 8, 1973. The statement, "The term 'Huli-Huli' in the Hawaiian language may be translated as 'turn turn'," is of record. Section 8 & 9 renewals were filed Jan. 4, 1993 May 5, 2003, and May 8, 2013; and (2) Registration No. 1639223 for the mark HAWAII'S FAMOUS HULI-HULI SAUCE in typed form for, "sauces excluding cranberry and

fide intent to use the subject mark in commerce “as a service mark for retail grocery stores,” rendering the mark void ab initio.[3]

On May 29, 2012, applicant filed an amended answer to opposer’s amended notice of opposition, by which applicant admitted that opposer owns Registration No. 958668 for the mark "HULI-HULI" and Registration No. 1639223 for the mark HAWAII’S FAMOUS HULI-HULI SAUCE, both for sauces. Applicant also admitted the allegation that,

> [n]either applicant nor any predecessor or entity related to applicant has any constructive or actual right in the mark SWEET G’S HULI CHICKEN MARINADE, SAUCE, GLAZE prior to February 21, 2011, the filing date of the 221 application.

Applicant otherwise denied the salient allegations of the amended notice of opposition. In “further answering” the opposition, applicant asserted that his “product,”

> is intended for use not only as a marinate [sic] but as an injectable solution to enhance the flavor of not only poultry but other meats, … [and] is further intended for use as a topping for all consumable food products….

(Amended answer at ¶ 17).

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applesauce” in Class 30, registered Mar. 26, 1991. A disclaimer of "HAWAII'S FAMOUS" AND "SAUCE", and a translation statement, “The English translation of the words ‘HULI-HULI in the mark is ‘turn, turn’ or ‘to turn repeatedly,’ are of record. Section 8 & 9 renewals were filed May 29, 1996, July 11, 2000 and Mar. 28, 2011.

[3] Opposer filed its amended notice of opposition on May 17, 2012 to add the ground that applicant lacked a bona fide intent to use the mark in commerce.

Motion for Summary Judgment

This case now comes up for consideration of opposer's motion, filed December 5, 2012, for summary judgment on its claim that applicant does not have, and never has had, a bona fide intent to use his mark in commerce for the services recited in the application, namely "retail grocery stores." Opposer requests that the Board sustain this opposition proceeding because there is no genuine dispute of material fact that applicant did not have a bona fide intent to use the mark in commerce for "retail grocery stores" when the application was filed.

In support of its motion for summary judgment, opposer has submitted applicant's written responses to opposer's discovery requests. Opposer maintains that by his discovery responses applicant specifically states that he did not have a bona fide intent to use his mark in commerce for the services identified in the application when the application was filed, that he does not presently have a bona fide intent to use his mark for those same services, and that applicant cannot produce any documents supporting an intention to use the mark. Opposer further contends, that while the original application includes a verified statement that applicant had a bona fide intent to use his mark in commerce for "retail grocery stores" that statement is contradicted by applicant's discovery

responses. To support its claims, opposer has introduced copies of applicant's responses to opposer's first set of interrogatories, first request for the production of documents and things, and first requests for admissions. In particular, in response to Interrogatory No. 21 asking applicant to explain what is meant by the term "retail grocery stores" in his application, applicant stated that,

> [a]pplicant presumes the attorney that filed the application meant that applicant would be selling his sauces to "retail grocery stores." Applicant does not now nor does he plan on operating a retail grocery store.

In response to opposer's document Request Nos. 23 and 24 seeking documents concerning applicant's bona fide intent to use its mark, applicant stated, "applicant shows there are no documents that would be responsive to these requests." In response to opposer's admission Request Nos. 5-6, 13-14 and 17-18, applicant admitted that it did not have at the time of filing his application, and does not now have, a bona fide intention to use the mark for retail grocery store services.

In his brief in opposition, applicant's counsel states he has "on many occasions indicated" that applicant does not have any intention of operating a "retail grocery store," but does intend to "sell his products to retail grocery stores for the distribution of his products at retail." Applicant contends opposer has "misconstrued" applicant's discovery responses,

and that the sale of applicant’s products to retail grocery stores is, “in fact, a ‘retail grocery store’ service.” Further, counsel states, applicant does not now nor has he ever had a bona fide intent to use the mark for the operation of a retail grocery store to sell products to the general public, but rather his intent has always been to provide a wholesale service by providing his products for purchase to retail grocery stores.

In reply, opposer argues that the term “retail grocery stores” used by applicant to identify his services has a clear meaning. Opposer also provides printouts from the *U.S. Acceptable Identification of Goods and Services Manual (ID Manual*) for retail grocery store services and wholesale services. Further opposer argues that it is not clear applicant would be offering a service for others by the sale or promotion of his own goods.

Legal Standard

Summary judgment is only appropriate when there is no genuine dispute as to any material facts and the moving party is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(a). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant’s favor. *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471,

1472 (Fed. Cir. 1992). The Board may not resolve issues of material fact; it may only ascertain whether such issues are present. *See Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

When the moving party has supported its motion with sufficient evidence which, if unopposed, indicates there is no genuine dispute of material fact, the burden then shifts to the non-moving party to demonstrate the existence of a genuine dispute of material fact to be resolved at trial. *Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1540 (TTAB 2009).

First, we find that no genuine dispute of material fact exists as to opposer's standing to oppose registration of the involved registration. Opposer has pleaded ownership of two registrations for the marks, "HULI-HULI" and HAWAII'S FAMOUS HULI-HULI SAUCE and made the TARR printouts for these registrations of record with its amended notice of opposition, showing that opposer is the owner of these valid and subsisting registrations. Also, applicant has admitted by his answer that opposer is the owner of the registrations. Thus, opposer's standing has been established. *See Lipton*

Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

An applicant for registration of a mark under Trademark Act § 1(b) must have a bona fide intent to use the applied-for mark in commerce on or in connection with the identified goods or services. Trademark Act § 1(b)(1). In determining whether an applicant possesses a bona fide intent, the Board focuses on the entirety of the circumstances, as revealed by the evidence of record. *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994).

Opposer has proffered applicant's discovery responses, which opposer asserts demonstrate that applicant has not had, and does not have, plans to operate retail grocery stores, and applicant does not dispute this point. Instead, applicant argues that providing his sauces to a retail grocery store is a retail grocery store service. In applicant's view, all of the suppliers to a retail grocery store are engaged in retail grocery store services, but such is not the case. By its nature, a service must be performed primarily for the benefit of others, and promoting the sale of one's own goods is not a service. *See* TMEP § 1301.01(a)(ii) (Apr. 2013 ver.) ("To be a service, an activity must be primarily for the benefit of someone other than the applicant" (i.e., for others)); *see also In re Reichhold Chemicals, Inc.*, 167 USPQ 376, 377 (TTAB

1970) (finding it "well-settled" that promoting the sale and use of one's own goods is not a registrable service). As applicant's potential sale of his sauces to retail grocery stores is promoting the sale of his own goods, it is not a registrable service, and not a grocery store service.

Opposer has established that there is no genuine dispute of material fact that applicant lacked the bona fide intent to use his mark in commerce for retail grocery store services when he filed his application.

Accordingly, opposer's motion for summary judgment is hereby granted on the ground of lack of bona fide intent to use the mark. Having reached this conclusion, the claim of priority and likelihood of confusion is rendered moot, and we need not reach it in this case.

In view thereof, the opposition is sustained and registration to applicant is refused.

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