

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

CME

Mailed: December 5, 2013

Opposition No. 91207808

Patterson Enterprises d/b/a  
Suncare Distributors

v.

Denise R. Selk d/b/a Coco-Jo's

**Before Quinn, Cataldo and Masiello,  
Administrative Trademark Judges.**

**By the Board:**

Applicant<sup>1</sup> seeks to register the mark HAFADA, in standard characters, for "Chocolate confections; Cookies."<sup>2</sup> As grounds for opposition, opposer alleges prior common law rights in the mark HAFADA for confectionary products, a later-filed application for the mark HAFADA, in standard characters, for "Chocolate confections,"<sup>3</sup> and that

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<sup>1</sup> Applicant is identified in the involved application as a sole proprietorship, and therefore, when referring to applicant herein, we use the pronoun "it" as opposed to "she."

<sup>2</sup> Application Serial No. 85546646, filed on February 18, 2012, under Section 1(b); amended to Section 1(a) on May 16, 2012, claiming a date of first use anywhere and first use in commerce of March 8, 2012. The English translation of the mark is "hello".

<sup>3</sup> Application Serial No. 85563577, filed on March 8, 2012, under Section 1(a), claiming a date of first use anywhere and first use in commerce of February 1, 2012. Opposer also alleges

applicant's involved mark is likely to cause confusion with opposer's pleaded mark. Opposer also alleges that applicant "is estopped from registering [the involved] mark under the doctrine of unclean hands." Notice of Opposition, ¶ 11. Applicant, in its answer, has denied the salient allegations of the notice of opposition.

Now before the Board are the parties' cross-motions for summary judgment both on the ground of priority and likelihood of confusion, filed June 17, 2013 (opposer), and July 22, 2013 (applicant), respectively.

***Pleadings***

A decision on summary judgment necessarily requires a review of the operative pleadings in the proceeding. Thus, before turning to the merits of the motions, the Board must examine the claims in the notice of opposition and applicant's answer thereto.

With respect to the notice of opposition, unclean hands is an affirmative defense and not a ground for opposition. *See Seculus Da Amazonia S/A v. Toyota Jidosha Kabushiki Kaisha*, 66 USPQ2d 1154, 1157 (TTAB 2003).

Accordingly, paragraph 11 of the notice of opposition is

**STRICKEN.**

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ownership of Guam Trademark Registration No. TPC8000351916 for the mark HAFADA for goods sold and advertised in International Class 30; registered on February 15, 2012.

Turning to the answer, applicant has not pleaded any affirmative defenses, but in denying the salient allegations in the notice of opposition, applicant has alleged that opposer's use of the mark HAFDA ADAI is "illegal," Answer, ¶ 11, and "deceive[s] consumers geographically by making their foreign-made products appear to be of local origin." Answer, ¶ 10. Defenses, like claims in a notice of opposition, must be supported by enough factual background and detail to fairly place the opposer on notice of the basis for the defenses. See *IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999) (noting that the primary purpose of pleadings "is to give fair notice of the claims or defenses asserted"); see also TBMP § 311.02(b) (3d. ed. rev.2 2013) and the cases cited therein. Applicant's "defenses" have not been properly pleaded because they are conclusory in nature and are not supported by any facts. Accordingly, no consideration will be given to these insufficiently pleaded defenses or to applicant's cross-motion for summary judgment to the extent that it addresses such arguments.<sup>4</sup> See Fed. R. Civ. P.

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<sup>4</sup> Moreover, applicant's argument implying that the pleaded mark is geographically deceptive or primarily geographically

56(a); see also TBMP 528.07(a) ("A party may not obtain summary judgment on an issue that has not been pleaded."). In addition, because applicant did not assert opposer's lack of standing as an affirmative defense, we will consider applicant's arguments with respect to standing only to the extent that they respond to opposer's assertions and evidence on the issue.<sup>5</sup>

**Summary Judgment**

Summary judgment is appropriate only where there are no genuine disputes as to any material facts, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(a). The party seeking summary judgment bears

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deceptively misdescriptive is futile. Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), prohibits the registration of geographically deceptive marks while Section 2(e)(3) of the Lanham Act, 15 U.S.C. § 1052(e)(3), prohibits the registration of marks that are primarily geographically deceptively misdescriptive. Neither statutory provision prohibits the use of such marks and opposer's registration of the mark Hafa ADAI is not at issue in this proceeding. In addition, the viability of an unlawful use defense is questionable. The Board has determined that "the better practice [is] to hold that a use in commerce is unlawful" only where a court or agency of competent jurisdiction has previously and finally determined the issue finding noncompliance or where there has been a per se violation of the statute. *Santinine Societa v. P.A.B. Produits*, 209 USPQ 958, 964 (TTAB 1981); see also *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1273-74 (TTAB 1992); *Kellogg Co. v. New Generation Foods, Inc.*, 6 USPQ2d 2045, 2047 (TTAB 1988). Here, applicant has not alleged that opposer's use of the Hafa ADAI mark has been finally determined by a court or agency to be unlawful or that such use is a per se violation of any statute.

<sup>5</sup> Alternatively, applicant could have raised opposer's alleged lack of standing in a motion to dismiss under Fed. R. Civ. P. 12(b)(6).

the burden of demonstrating the absence of any genuine dispute of 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); *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 Am. 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). 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. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA, supra*. The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. See *Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1542. When cross-motions for summary judgment are presented, the Board evaluates each motion on its own merits and resolves all doubts and inferences against the

party whose motion is being considered. *Mingus Constructors, Inc. v. United States*, 812 F.2d 1387, 1390-91 (Fed. Cir. 1987).

***Standing***

There are no genuine disputes of material fact regarding opposer's standing to bring the notice of opposition as opposer has made of record an Office action and two Suspension Notices indicating that opposer's pleaded application may be refused registration if applicant's involved application matures to registration. See Motion for Summary Judgment, Exhibit D, copy of opposer's pleaded application, Exhibit I, June 27, 2012 Office action, and Exhibit J, August 13, 2012 and October 18, 2012 Suspension Notices;<sup>6</sup> see also *Weatherford/Lamb Inc. v. C&J Energy Services Inc.*, 96 USPQ2d 1834, 1837 (TTAB 2010) ("Inasmuch as petitioner has made of record the USPTO Office action suspending its pleaded application pending the possible refusal to registration under Section 2(d) of the Lanham Act based on an alleged likelihood of confusion with respondent's registration, there is no question that petitioner has standing to bring this petition for cancellation.").

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<sup>6</sup> Exhibits D, I and J to opposer's motion for summary judgment are admissible as official records pursuant to Trademark Rule 2.122(e).

***Likelihood of Confusion***

The parties agree that there is a likelihood of confusion between applicant's mark and the pleaded mark as used in connection with their respective goods. See Motion for Summary Judgment, pp. 9-12 and Cross-Motion, p. 12. Accordingly, we find that there is no genuine dispute of material fact that the parties' contemporaneous use of their marks on their respective goods is likely to cause confusion.

***Priority***

Priority is the sole remaining issue. To establish priority on a likelihood of confusion claim brought under Trademark Act Section 2(d), a party must prove that, vis-à-vis the other party, it owns "a mark or trade name previously used in the United States ... and not abandoned...." Trademark Act § 2(d), 15 U.S.C. § 1052(d). Opposer does not own an existing registration upon which it can rely for purposes of priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In addition, opposer cannot rely on the filing date of its pleaded application as a constructive use date for purposes of priority because its pleaded application has a later filing date (March 8, 2012) than

applicant's involved application, which has a filing and constructive use date of February 18, 2012. Therefore, in order for opposer to prevail on its priority claim, opposer must prove that it has a proprietary interest in the mark HAFA ADAI and that the interest was obtained prior to the filing date of applicant's involved application, February 18, 2012, or prior to any date of use on which applicant may rely. See *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); *Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251, 1254 (TTAB 1995).

The only admissible and relevant evidence that opposer has submitted in support of its allegation of priority in the pleaded mark is the declaration of William Ymesei, opposer's operations manager (the "Ymesei Declaration"), and the declaration of Qichun Liang, aka Sophia Liang, president of Senocean Industrial Company, Ltd., opposer's chocolate and confections manufacturer (the "Liang Declaration").<sup>7</sup> In his declaration, Mr. Ymesei states that

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<sup>7</sup> The photographs and e-mails attached to opposer's motion for summary judgment are not authenticated, and therefore, are inadmissible. In addition, applicant's responses to opposer's interrogatories cannot be considered because opposer did not submit the interrogatories themselves as required by Trademark

(i) “[i]n January of 2012 [he] approached [opposer’s] manufacturer about changing the package design for a line of [opposer’s] confectionery products. This change involved adding the HAFA ADAI mark to [opposer’s] chocolates and confections”; (ii) “[o]n or about January 11, 2012, we decided on a design. The product was shipped to Guam on January 15, 2013”; (iii) “[o]n February 1, 2012, [opposer’s] chocolates and confections bearing the mark ‘HAFA ADAI’ were first sold in commerce by retailers in Guam”; and (iv) “[opposer] prominently uses the ‘HAFA ADAI’ mark on product packaging and related promotional materials. Consumers associate [opposer’s] ‘HAFA ADAI’ mark with [opposer’s] confectionary products.” Ymesei Declaration, ¶¶ 4-6 and 9. In her declaration, Ms. Liang states that (i) Mr. Ymesei approached her in January 2012 about a package redesign to add the pleaded mark to the packaging for opposer’s chocolates and confections; (ii) opposer’s “chocolates and confections bearing the mark ‘HAFA ADAI’ were first shipped to Guam on January 15, 2012”; (iii) “[f]rom at least January 31, 2012 through February 2, 2012, [she] corresponded with [Mr. Ymesei]

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Rule 2.127(e)(2). Opposer’s sealed and signed Guam Registration is admissible as an official record under Trademark Rule 2.122(e), but “a state [or U.S. territory] registration is incompetent to establish that the mark shown therein has ever been used, or that the mark is entitled to federal registration.” TBMP § 704.03(b)(1)(A) and cases cited in footnote 25 therein.

regarding the newly shipped product packaging bearing the mark 'HAFA ADAI.' These discussions involved comments and feedback on [opposer's] products bearing the mark 'HAFA ADAI.' As a result, slight changes in the packaging design were made but the products continued bearing the mark 'HAFA ADAI.'" Liang Declaration, ¶¶ 3-5.

We find that this evidence is insufficient to satisfy opposer's burden of demonstrating the absence of any genuine disputes of material fact regarding its priority based on alleged use in commerce of the mark HAFA ADAI since February 1, 2012. The declarations discuss a single shipment and a single sale over the period of two weeks. They say nothing of the quantity of product sold or the number of customers, and opposer did not submit any documentary evidence (e.g., sales figures, invoices) to demonstrate continuing use of its mark on its goods. Neither did opposer submit authenticated photographs of products demonstrating the manner in which the mark appeared on the goods. Moreover, the Ymesei and Liang Declarations are, in part, vague with respect to the nature of the goods on which the mark was used. In the absence of any documentary evidence regarding actual use of the pleaded mark prior to applicant's priority date, opposer's declarations fall short of establishing that there are no

genuine disputes of material fact regarding whether opposer's use of its mark constitutes use in commerce as defined in 15 U.S.C. 1127 and that opposer's mark is "a mark... previously used... and not abandoned." 15 U.S.C. § 1052(d).

Applicant also has failed to satisfy its burden of demonstrating the absence of any genuine dispute of material fact regarding its alleged priority in the HAFA ADAI mark. Applicant has not submitted any evidence or even attempted to argue that it commenced use of its mark prior to opposer's date of first use, as alleged in the Ymesei and Liang Declarations. Instead, applicant has argued that it has priority based on its "first legal use" of the mark HAFA ADAI in commerce on March 8, 2012, and "status as first to file." Cross-Motion for Summary Judgment, pp. 5 and 8. Although applicant may rely upon its filing date as its constructive date of first use, opposer's declarations raise a genuine dispute as to priority which applicant has not addressed. As previously discussed, applicant's unlawful use argument has not been properly pleaded, and therefore, it will be given no consideration. For these reasons, applicant too has fallen short of meeting its burden on summary judgment.

In view of the foregoing, opposer's motion for summary judgment is **GRANTED, in part**, on the issues of opposer's standing and likelihood of confusion, and **DENIED, in part**, on the issue of priority. Applicant's cross-motion for summary judgment is **DENIED**.<sup>8</sup>

***Accelerated Case Resolution***

Because the only remaining issue for trial is priority, the parties may wish to consider utilizing Accelerated Case Resolution ("ACR") efficiencies for entering evidence. Such efficiencies may include submitting testimony by declaration or affidavit, subject to the right of either party to live cross examination, expanding the types of documents admissible through notices of reliance, agreeing to the authenticity of documents produced during discovery, or foregoing trial and attaching evidence to the trial briefs. See, e.g., *Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774 (TTAB 2013) (stipulating to numerous procedures and facts, including submitting briefs

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<sup>8</sup> The parties should note that the evidence submitted in connection with the cross-motions for summary judgment is of record only for consideration of those motions. 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); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981). Furthermore, the fact that we have identified genuine disputes of material fact should not be construed as a finding that these are necessarily the only disputes which remain for trial.

accompanied by evidence, submitting testimony in the form of declarations or affidavits, and foregoing trial and an oral hearing); *Kistner Concrete Products Inc. v. Contech Arch Technologies Inc.*, 97 USPQ2d 1912, 1915 (TTAB 2011) (parties stipulated to the authenticity of produced documents); *see also*, TBMP §§ 528.05(a)(2), 702.04 and 705. In the event that the parties agree to forego trial and submit evidence as attachments to their trial briefs, they will need to stipulate that the Board may determine any genuine disputes of material fact that the Board may find to exist. *See* TBMP § 528.05(a)(2). The parties are encouraged to jointly contact the Board's interlocutory attorney responsible for this proceeding if they are interested in utilizing ACR efficiencies.

***Schedule***

Proceedings herein are resumed and discovery, disclosure, trial and other dates are reset as follows:

Discovery Closes	12/28/2013
Plaintiff's Pretrial Disclosures	2/11/2014
Plaintiff's 30-day Trial Period Ends	3/28/2014
Defendant's Pretrial Disclosures	4/12/2014
Defendant's 30-day Trial Period Ends	5/27/2014
Plaintiff's Rebuttal Disclosures	6/11/2014
Plaintiff's 15-day Rebuttal Period Ends	7/11/2014

In each instance, a copy of the transcript of any testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of that testimony.

Trademark Rule 2.125.

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

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