

This Decision is not a
Precedent of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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coggins

Mailed: July 18, 2014

Opposition No. 91209617

Xikar, Inc.

v.

Debra Wiseberg

Before Bucher, Wolfson, and Hightower,
Administrative Trademark Judges

By the Board:

Now before the Board are the parties' cross-motions (filed March 13, 2014, by Opposer; and April 16, 2014, by Applicant) for summary judgment.¹

Motions for Summary Judgment

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to any material facts, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(a). The party moving for summary judgment has the initial burden of demonstrating that there is no genuine dispute of material fact remaining for trial and that it is

¹ To the extent that Applicant seeks summary judgment in her favor, Applicant's brief in opposition is construed as including a cross-motion for summary judgment.

entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1987); and *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine disputes of material fact exist; and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. *See Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). 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., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993).

When cross-motions for summary judgment are presented, the moving party in each motion has the burden as to its own motion, and the Board evaluates each motion on its own merits and resolves all doubts and inferences against the party whose motion is being considered. *See Mingus Constructors, Inc. v. United States*, 812 F.2d 1387, 1391 (Fed. Cir. 1987); and *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1437 (TTAB 2007). Additionally, the mere fact that cross-motions for summary judgment are presented does not necessarily mean that there are no genuine disputes of material fact, or that a trial is unnecessary. *See Amazon Technologies Inc. v. Wax*, 95 USPQ2d 1865, 1871 (TTAB 2010).

The pleadings

Generally, only well pleaded issues may be the basis for grant of summary judgment. *See Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1480 (TTAB 2009), citing *Intermed Communications, Inc. v. Chaney*, 197 USPQ 501, 503 n.2 (TTAB 1977) (“If a claim has not been properly pleaded, one cannot obtain summary judgment thereon”); *Consolidated Foods Corp. v. Berkshire Handkerchief Co., Inc.*, 229 USPQ 619, 621 (TTAB 1986). In view thereof, the Board must examine the notice of opposition and counterclaim to determine if the parties’ claims are well pleaded.

Notice of Opposition

In the notice of opposition, Opposer alleges, *inter alia*, that it has used the trademark XIKAR in connection with smoking accessories since at least as early as 1997 (para. 5), it is the owner of Registration No. 2200215 for the mark XIKAR covering cigar cutters (para. 6), the registration is incontestable under Trademark Act § 15, 15 U.S.C. § 1065 (para. 8)², Opposer has used the XIKAR mark from a date which precedes Applicant’s first use by over 13 years (para. 12), the parties’ marks are similar in appearance and sound

² Registration No. 2200215 is incontestable. The TSDR record for the registration, submitted with the notice of opposition, indicates that the mark registered October 27, 1998, a combined declaration of use and incontestability under Sections 8 (six-year) and 15 (incontestability) was accepted on May 25, 2004, and a combined declaration of use in commerce and application for renewal under Sections 8 (ten-year) and 9 (renewal) was accepted and granted June 3, 2008. Inasmuch as the registration is in evidence under Trademark Rules 2.122(d)(1) (registration as exhibit to pleading) and 2.122(b)(1) (registration against which a counterclaim is filed), it was unnecessary for Opposer to attach a TSDR print-out of the registration as Exhibit 1 to the motion for summary judgment.

(para. 14), the parties' goods are related (para. 15), and consumers are likely to believe Applicant's goods originate with Opposer, resulting in a likelihood of confusion (para. 16). These allegations are sufficient to allege a claim of priority and likelihood of confusion.

Counterclaim

By way of the counterclaim to cancel Registration No. 2200215, Applicant alleges that Opposer's XIKAR mark is generic (para. 1), deceptive (para. 2), and falsely suggests a connection (para. 2); and, if cancellation is not otherwise granted, the registration should be restricted by a disclaimer stating that "no claim is made or implied as to the names 'sikar' and 'cigar,' nor their characteristics" (para. 3).

Genericness

In order to plead a proper counterclaim of genericness under Trademark Act § 14(3), 15 U.S.C. § 1064(3), Applicant must plead that Opposer's involved mark is or has become the generic name for Opposer's goods. Applicant has not done so. In the counterclaim, Applicant alleges that XIKAR "originated from and is a twisted form of the generic names [sic] 'sikar' and thus 'cigar.' The Mayan word 'sikar' is the origin of the word 'cigar.' The opposer engages in the sale of such products." *See* counterclaim para. 1. Such allegations are insufficient to allege that XIKAR is the generic name for cigar cutters (i.e., the goods at issue in the registration subject to the counterclaim). Applicant's theory that the word "sikar" gave rise to the word

“cigar” and also served as inspiration for Opposer’s XIKAR mark does not state a claim that XIKAR is generic for cigar cutters. Instead, it appears that Applicant makes a multi-step connection between XIKAR and cigars, because the word “cigar” was allegedly derived from the Mayan word “sikar,” which Mayan word also inspired Opposer’s mark XIKAR. Inasmuch as paragraph 1 of the counterclaim is not sufficient to state a claim that the mark is generic, we *sua sponte* strike this paragraph from the answer. See Fed. R. Civ. P. 12(f)(1); and TBMP § 506.01 (2014).

Deceptiveness and false suggestion of a connection

In order to plead a proper counterclaim of deceptiveness under Trademark Act § 2(a), 15 U.S.C. § 1052(a), Applicant must plead that (1) Opposer’s involved mark misdescribes the identified goods, (2) consumers would be likely to believe the misrepresentation, and (3) the misrepresentation would materially affect potential purchasers’ decision to purchase the product. See *In re Bulge*, 857 F.2d 773, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988). Applicant has not alleged any of these elements or any facts that might support these elements. Instead, Applicant bases her deceptiveness claim on allegations that XIKAR is based on the Mayan word “sikar” which itself is the basis of the word “cigar,” that Opposer’s website claims XIKAR has a strong affiliation with Mayan culture, and that XIKAR deceptively contains the word “sikar,” thus giving Opposer “rights and claims to words it could not otherwise trademark.” See counterclaim para. 2. Applicant makes no

allegation as to how use of the XIKAR mark by Opposer actually misdescribes Opposer's cigar cutters (i.e., the goods at issue in the registration subject to the counterclaim). Moreover, there is nothing in the counterclaim pleading that alleges facts supporting the plausibility or materiality factors for a § 2(a) deceptiveness claim.

In order to plead a proper counterclaim of false suggestion of a connection under Trademark Act § 2(a), Applicant must plead that (1) Opposer's mark is the same or a close approximation of Applicant's previously used name or identity, (2) that the mark would be recognized as such, in that it points uniquely and unmistakably to Applicant, (3) that Applicant is not connected with the goods offered by Opposer under the mark, and (4) that Applicant's name or identity is of sufficient fame or reputation that when Opposer's mark is used on its goods, a connection with Applicant would be presumed. *See Petróleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1405 (TTAB 2010); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008). Applicant makes no allegation in the counterclaim as to any of the necessary elements of this claim. Instead, Applicant alleges that the mark XIKAR falsely suggests a connection "to the Mayan culture and some deeper connection to the cigar industry and its creation" *See* counterclaim para. 2. Applicant should note that a false suggestion of a connection claim must involve Applicant's name or identity; however, as pleaded, the false

suggestion of a connection counterclaim involves not Applicant but the Mayan culture or civilization.

Inasmuch as paragraph 2 of the counterclaim is not sufficient to state a claim that the mark is deceptive or that it falsely states a connection with Applicant, we *sua sponte* strike this paragraph from the answer. *See* Fed. R. Civ. P. 12(f)(1); and TBMP § 506.01.

Restriction by disclaimer

Although Applicant did not specifically refer to Trademark Act § 18, 15 U.S.C. § 1068, in her counterclaim, she asks that the registration “be restricted and the register be rectified by” entry of a disclaimer “stating that ‘no claim is made or implied as to the name ‘sikar’ and ‘cigar,’ nor their characteristics.” *See* counterclaim para. 3. Moreover, Applicant references § 18 in her brief in opposition to and cross-motion for summary judgment. *See* Brief, p. 17. We note, however, that a disclaimer under § 18 is not available for Registration No. 2200215, which is more than five years old. *See Montecash LLC v. Anzar Enter., Inc.*, 95 USPQ2d 1060 (TTAB 2010). Applicant also states in her brief that she is “asking the Board to expand and modify § 18 or to establish a new law as it pertains to the facts of this case ...” *See* Brief, p. 3. However, the “Board, being a creature of the Congress, is bound to apply the statute as it was enacted, subject only to such amendments as have been made since by that body.” *In re ETA Systems Inc.*, 2 USPQ2d 1367, 1370 n.4 (TTAB 1987). It is not within the Board’s

jurisdiction to establish a new law. Inasmuch as paragraph 3 of the counterclaim is not sufficient to state a claim that the registration should be restricted, we *sua sponte* strike this paragraph from the answer. See Fed. R. Civ. P. 12(f)(1); and TBMP § 506.01.

Applicant may replead

Inasmuch as we have stricken the counterclaim in its entirety (i.e., paragraphs 1-3), Applicant is allowed until August 14, 2014, to file and serve an amended counterclaim in which Applicant sets out a valid ground for cancelling the subject registration, if she has a reasonable basis therefor; failing which, the counterclaim will be dismissed with prejudice. See *Musical Directions v. McHugh*, 104 USPQ2d 1157, 1160 (TTAB 2012) (party allowed to replead after Board *sua sponte* struck claims). Opposer is allowed until September 4, 2014, in which to file and serve its answer or otherwise respond to the amended counterclaim, if an amended counterclaim is filed.

Summary judgment moot, in part

As stated above, only well pleaded issues may be the basis for grant of summary judgment. Inasmuch as Applicant's counterclaim is not properly pleaded, is insufficient to state any claim, and has been stricken in its entirety, the cross-motions for summary judgment are deemed moot as to the counterclaim. *Asian and Western Classics B.V.*, 92 USPQ2d at 1480.

Objection to evidence

Applicant objects “to all of the exhibits submitted by the Opposer ... that are not self-authenticating and have not been properly introduced as evidence”; but, at the same time - indeed, in the same paragraph - applicant asks the Board to “hold the Opposer accountable for all of the statements made within [the exhibits] that go towards proving the Applicant’s case” Brief, p. 3. Arguing for such contradictory positions is unacceptable. Applicant may not seek to exclude consideration of the exhibits for purposes of Opposer’s motion and simultaneously seek to have consideration of the exhibits for purposes of Applicant’s cross-motion. Inasmuch as Applicant has not unequivocally objected to Opposer’s exhibits, we have considered the exhibits in our determination of the parties’ cross-motions.³

Determination of the cross-motions

Turning to the remaining issues in the cross-motions, each party moves for summary judgment on Opposer’s claim of priority and likelihood of confusion. For purposes of this order, we presume the parties’ familiarity with the arguments and evidence submitted with respect to the cross-motions for summary judgment. Therefore, for the sake of efficiency, this order does not summarize the parties’ arguments or the evidence submitted with the parties’ respective briefs.

³ Although Opposer provided a list of its exhibits in the motion, Opposer failed to label the exhibits with their respective numbers, thereby making it difficult for the Board to determine where one exhibit ends and another begins.

Upon careful consideration of the evidence and arguments presented by the parties, and drawing all inferences in favor of each non-movant, we find that neither party has met its burden of establishing that there is no genuine dispute as to any material fact remaining for trial and that, therefore, neither party is entitled to entry of judgment as a matter of law. At a minimum, genuine disputes of material fact exist as to the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression, and the fame of Opposer's mark. In view thereof, the parties' cross-motions for summary judgment are **denied**.

The fact that we have identified genuine disputes as to material facts as a sufficient basis for denying the cross-motions for summary judgment should not be construed as a finding that these are necessarily the only issues which remain for trial. *See, e.g., Am. Express Mktg. & Dev. Corp. v. Gilad Dev. Corp.*, 94 USPQ2d 1294, 1301 n.5 (TTAB 2010).

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

Schedule

Proceedings are resumed. Dates are reset on the following schedule.

Plaintiff's responses to applicant's second set of interrogatories, request for production of documents, and requests for admission due ⁴	Ten days
Defendant/Counterclaim Plaintiff's amended counterclaim due, if filed	August 14, 2014
Plaintiff/Counterclaim Defendant's answer to counterclaim due, if an amended counterclaim is filed	September 4, 2014
Plaintiff's Pretrial Disclosures	September 25, 2014
30-day testimony period for Plaintiff's testimony to close	November 9, 2014
Defendant/Counterclaim Plaintiff's Pretrial Disclosures Due	November 24, 2014
30-day testimony period for defendant and plaintiff in the counterclaim to close	January 8, 2015
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	January 23, 2015
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	March 9, 2015
Counterclaim Plaintiff's Rebuttal Disclosures Due	March 24, 2015
15-day rebuttal period for plaintiff in the counterclaim to close	April 23, 2015
Brief for plaintiff due	June 22, 2015
Brief for defendant and plaintiff in the counterclaim due	July 22, 2015
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	August 21, 2015
Reply brief, if any, for plaintiff in the counterclaim due	September 5, 2015

⁴ Inasmuch as Opposer filed its motion for summary judgment four days prior to deadline, as extended, to respond to Applicant's 2nd set of interrogatories, request for production of documents, and requests for admission (*see* Board order dated March 12, 2014, granting Opposer's motion to extend time to respond until March 17, 2014), Opposer is allowed until ten days from the mailing date of this order in which to respond to the discovery requests, if it has not already done so. This is not an order compelling discovery, merely a scheduling matter.

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 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.

Counsel Recommended

While Patent and Trademark Rule 11.14 permits applicant to represent herself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in a Board proceeding to secure the services of an attorney who is familiar with such matters. The Board recommends that applicant retain trademark counsel.