

ESTTA Tracking number: **ESTTA736940**

Filing date: **03/31/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212231
Party	Plaintiff Dragon Bleu (SARL) and VTEC Limited LLC, by assignment
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Date	03/31/2016
Attachments	20160331 reply to venm opposition to msj.pdf(139924 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Dragon Bleu (SARL) and  
VTEC Limited,

Opposers and Counterclaim  
Respondents,

v.

VENM, LLC,

Applicant and Counterclaim  
Petitioner.

Opposition No. 91212231

Application Serial No. 85/848,528

**REPLY IN SUPPORT OF OPPOSERS AND COUNTERCLAIM  
RESPONDENTS' MOTION FOR SUMMARY JUDGMENT**

Opposers and Counterclaim Respondents Dragon Bleu SAS<sup>1</sup> and VTEC Limited (collectively referred to hereafter as “VTEC”), pursuant to 37 C.F.R. § 2.127, hereby reply to Applicant and Counterclaim Petitioner Venm, LLC’s (“Venm”) Opposition to Motion for Summary Judgment (the “Opposition to MSJ”). Venm’s Opposition to MSJ does not provide the Board with any adequate basis to deny VTEC’s Motion for Summary Judgment. Venm’s primary argument is based upon a faulty legal premise, namely, “file-wrapper estoppel,” seeking to use counsel’s statements in an unrelated prosecution matter as statements against interest. Moreover, Venm fails to provide any sworn statement to support the factual assertions on which it bases its arguments. Finally, the Opposition to MSJ does not contest the granting of summary judgment against Venm on its counterclaim for abandonment.

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<sup>1</sup> Dragon Bleu (SARL) underwent a corporate conversion to be organized as a French Société par actions simplifiée and is now known as Dragon Bleu SAS. (*See* TTABVUE 27 at 1 n.1.)

## I. Argument

### A. File-Wrapper Estoppel Is Not a Valid Legal Argument.

It is well settled that the Board does not apply “file-wrapper estoppel,” *i.e.*, positions taken during the prosecution of a trademark application are not an admission against interest, in subsequent *inter partes* proceedings. See *Meier’s Wine Cellar, Inc. v. Meyer Intellectual Props. Ltd.*, Cancellation No. 92044883 at \* 18 (T.T.A.B. Mar. 4, 2008) (citing *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 198 U.S.P.Q. 151, 154 (C.C.P.A. 1978)), available at <http://ttabvue.uspto.gov/ttabvue/v?pno=92044883&pty=CAN&eno=18>; see also *Anthony’s Piz̄za & Pasta Int’l, Inc. v. Anthony’s Piz̄za Holding Co.*, 95 U.S.P.Q.2d 1271 (T.T.A.B. 2009) [precedential] (“The doctrine of ‘file wrapper estoppel’ does not apply in trademark cases.”) (citing *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 U.S.P.Q. 955, 963 (T.T.A.B. 1986)), *aff’d* Appeal No. 2010-1191 (Fed. Cir. Nov. 18, 2010) [not precedential]. Such positions taken during the prosecution of a trademark do not raise a genuine issue of material fact. See *Maier’s Wine Cellar Inc.*, Cancellation No. 92044883 at \*18. “Under no circumstances may a party’s opinion [regarding likelihood of confusion], earlier or current, relieve the decision maker of the burden of reaching his own ultimate conclusion on the entire record.” *Interstate Brands Corp.*, 198 U.S.P.Q. at 154.

Throughout the Opposition to MSJ, Venm relies on a “file-wrapper estoppel” theory to support its argument that there is a genuine issue of material fact regarding likelihood of confusion. Specifically, Venm points to statements made by VTEC during the prosecution of Registration No. 3,927,787 to the effect that there is no likelihood of confusion between its VENUM Mark and the mark VENOM for use in connection with certain Class 25 goods. (TTABVUE 31 at 18–19.) Venm concludes that these “admissions” establish that “[Venm’s] goods and [VTEC’s] goods are sufficiently distinct to avoid confusion in the marketplace.

(TTABVUE 31 at 19.) Venm’s argument misstates the law — VTEC’s statements are neither an admission against interest nor do they establish a genuine issue of material fact regarding likelihood of confusion.

B. Venm Does Not Dispute Priority.

In its Motion for Summary Judgment, VTEC argues that VTEC has established priority in the VENUM Mark. Specifically, VTEC writes that Venm “has not alleged a first use date earlier than the constructive use date created by filing its intent-to-use application [. . . and] has not asserted an affirmative defense or counterclaim alleging priority.” (TTABVUE 27 at 9.) Curiously, Venm’s Opposition to MSJ includes a heading titled “Opposer is not Entitled to Summary Judgment on the Issue of Priority,” however, the section provides no discussion on priority at all, nevermind provide any facts refuting VTEC’s plainly established priority. Instead, Venm uses the section to make an irrelevant attack on the distinctiveness of VTEC’s mark. (*See* TTABVUE 31 at 6–8.) Therefore, Venm clearly fails to establish that VTEC is not entitled to summary judgment on the issue of priority.

C. Venm Provides No Support for Its Statements of Fact.

“A party asserting that a fact cannot be or is genuinely disputed must support the assertion by [. . .] citing to particular parts of materials in the record, including depositions, documents, electronically stored information, affidavits or declarations, stipulations (including those made for purposes of the motion only), admissions, interrogatory answers, or other materials.” Fed. R. Civ. P. 56(c)(1)(A); *see also* TBMP § 528.01. Despite this express directive, all of Venm’s factual statements are unsupported. (*See, e.g.*, TTABVUE 31 at 4 (“All of Applicant’s products are eco-friendly and directed to eco-conscious consumers interested in various styles of dance.”); *Id.* at 12 (“Applicant seeks registration for the mark

‘VENM’ which plays off the widely used environmental acronym VENM or Virgin Excavated Natural Resources.”)<sup>3</sup> Such a deficiency is unacceptable, as Venm fails to provide the Board with any basis for the factual statements made in the Opposition to MSJ.

## II. Conclusion

The Board encourages resolving matters on summary judgment especially in cases such as this one, where no additional material facts will be uncovered at trial. *See Barmag Barmer Maschinenfabrik AG v. Murata Mach., Ltd.*, 731 F.2d 831, 221 U.S.P.Q. 564 (Fed. Cir. 1984); *Pure Gold, Inc. v. Syntex (USA), Inc.*, 739 F.2d 624, 627 n.2, 222 U.S.P.Q. 741 (Fed. Cir. 1984) (summary judgment “is to be encouraged in *inter partes* cases before the Trademark Trial and Appeal Board”). Accordingly, VTEC respectfully urges the Board to grant summary judgment in VTEC’s favor on Venm’s counterclaim for abandonment, as no genuine issues of material fact exist as to abandonment, and the issue was not even addressed in the Opposition to MSJ. Because no genuine issues of material fact exist as to likelihood of confusion, VTEC also respectfully requests that summary judgment be granted in its favor.

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<sup>3</sup> In one particularly troublesome naked assertion Venm completely mischaracterizes VTEC’s approach to settlement as “disingenuous,” “inapplicable,” and “offensive.” (TTABVUE 31 at 1.) Quite to the contrary, VTEC made several earnest attempts to amicably resolve this matter, while Venm insisted on a large monetary payment to withdraw its counterclaim.

Respectfully submitted,

Dragon Bleu SAS  
VTEC Limited

Dated: March 31, 2016

By their attorneys,

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**CERTIFICATE OF SERVICE**

I hereby certify that on March 31, 2016, this **Reply in Support of Opposers and Counterclaim Respondents' Motion for Summary Judgment**, all exhibits thereto, was served on Applicant by delivering a true and correct copy thereof to Applicant by Priority Mail, postage pre-paid, addressed to:

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Roger Moore  
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/s/Aaron Y. Silverstein  
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