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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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General Contact Number: 571-272-8500

WINTER

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Opposition No. 91212231

Dragon Bleu SAS, formerly Dragon Bleu (SARL)[1] *and VTEC Limited LLC, by assignment*

v.

VENM, LLC

Before Mermelstein, Bergsman, and Kuczma, Administrative Trademark Judges.

By the Board:

Background

Opposers/Counterclaim-Respondents, Dragon Bleu SAS[2] and VTEC Limited LLC ("Opposer"), oppose registration of the mark VENM in standard characters for use in connection with "dance costumes."[3] As grounds for opposition, Opposer sets forth a claim of likelihood of confusion and in support thereof, originally pleaded ownership

[1] Opposer Dragon Bleu (SARL) mentions that it underwent a corporate conversion to be organized as a French *Société par actions simplifiée* and is now known as Dragon Bleu SAS (27 TTABVUE 1, n. 1).

[2] Dragon Bleu SAS assigned its rights in the pleaded trademark registrations to VTEC Limited LLC on January 10, 2014, and VTEC Limited was joined as a party plaintiff by order of the Board on February 17, 2016 (25 TTABVUE 3).

[3] Application Serial No. 85848528, filed February 13, 2013, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b).

of three trademark registrations for the two VENUM & design marks (shown below)[4] and one pending trademark application[5] for which a trademark registration has since issued:

[6]

and

[4] U.S. Reg. No. 3896673, issued December 28, 2010, for various fabrics and textile goods in International Classes 24 and 26, based on a request for extension of protection of International Registration No. 0988214, registered November 24, 2008, filed under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), and cancelled on April 25, 2016;

U.S. Reg. No. 3927787, issued March 8, 2011, for "martial arts and boxing clothes, namely, martial arts uniforms, shorts, kimonos; sport shoes, especially for the practice of martial arts," based on a request for extension of protection of International Registration No. 0988214, registered November 24, 2008, filed under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a); and

U.S. Reg. No. 4017907, issued August 30, 2011, for "protective equipment for sports, namely, boxing gloves and gloves for randori, shin guards, elbow guards, knee guards; protective padding for engaging in combat sports and martial arts," based on a request for extension of protection of International Registration No. 1060684, registered October 15, 2010, filed under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a).

[5] Application Serial No. 79124129, filed November 16, 2012, based on a request for extension of protection of International Registration No. 1145120, registered November 16, 2012, under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a); U.S. Reg. No. 4574014, issued July 29, 2014, for "protective helmets for combat sports."

[6] U.S. Reg. Nos. 3896673 and 3927787 describe the mark as follows: "The mark consists of the stylized wording 'VENUM' under a design of a snake's head within a circle."

[7]

Applicant/Petitioner, VENM, LLC ("Applicant") denies the salient allegations of the notice of opposition.

By its amended pleading filed December 29, 2014, Applicant seeks to cancel Opposer's U.S. Reg. No. 3896673 and to partially cancel U.S. Reg. No. 3927787, on the ground of abandonment.[8] Opposer denies the salient allegations of the counterclaim. However, on February 18, 2016, Opposer surrendered U.S. Reg. No. 3896673 without the consent of Applicant and that registration was cancelled on April 25, 2016.[9] Therefore, Applicant's abandonment counterclaim now involves only U.S. Reg. No. 3927787 and seeks partial cancellation of that registration with respect to only kimonos and sports shoes, especially for the practice of martial arts.

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[7] U.S. Reg. Nos. 4017907 and 4574014 describe the mark as follows: "The mark consists of the stylized wording 'VENUM' under a design of a snake's head."

[8] VENM's counterclaims of fraud and non-use were dismissed in our order mailed on December 1, 2014 (11 TTABVUE 10, 12).

[9] A corrective order regarding the registrations sought to be cancelled was issued on May 26, 2016, but did not affect the cancellation order of March 29, 2016.

Opposer's Motion for Summary Judgment

This case now comes up for consideration of Opposer's fully briefed motion (filed February 19, 2016) for summary judgment on its claim of likelihood of confusion and on Applicant's counterclaim of partial abandonment.

We presume the parties' familiarity with the pleadings, arguments and materials submitted in connection with the subject motion.

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. Further, in considering whether summary judgment is appropriate, the Board may not resolve

genuine disputes as to material facts and, based thereon, decide the merits of the opposition. Rather, the Board may only ascertain whether any material fact cannot be disputed or is genuinely disputed. *See Lloyd's Food Products*, 25 USPQ2d at 2029; and *Olde Tyme Foods*, 22 USPQ2d at 1542.

Based on our review of the parties' arguments and supporting evidence, and drawing all inferences in favor of Applicant, the non-movant, we find that Opposer has not met its burden of establishing that there is no genuine dispute as to material facts and that it is entitled to judgment as a matter of law on its likelihood of confusion claim under 15 U.S.C. § 1052(d), Section 2(d) of the Trademark Act. At a minimum,[10] there exist genuine disputes as to the commercial impressions evoked by the parties' respective marks, as to the strength of Opposer's marks, and as to the relatedness of the parties' identified goods. Accordingly, Opposer's motion for summary judgment on its likelihood of confusion claim is **denied**.[11]

Although Opposer moves for summary judgment dismissing the counterclaim to partially cancel U.S. Reg. No. 3927787, it is Applicant which bears the ultimate burden of proof at trial on the ground of abandonment. In this situation, Opposer need not support its motion for summary judgment with affidavits or other similar

[10] The fact that we have identified in this order only particular material facts that are genuinely in dispute should not be construed as a finding that these are necessarily the only issues that remain for trial.

[11] The parties are reminded that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial period. *See, e.g., Levi Strauss & Co. v. R. Joseph Sportswear Inc.,* 28 USPQ2d 1464 (TTAB 1993); TBMP § 528.05(a).

materials *negating* Applicant's claim. Opposer need only point out a lack of evidence in the record necessary to support Applicant's claim. Opposer's motion for summary judgment "may and should, be granted so long as whatever is before the district court demonstrates that the standard for the entry of summary judgment, as set forth in Rule 56(c), is satisfied." *Celotex Corp. v. Catrett*, 477 U.S. at 323.

We find that Opposer has failed to show the absence of a genuine dispute as to whether its has abandoned use of the mark in U.S. Reg. No. 3927787 in connection with those two goods. As noted above, the Supreme Court explained that when the non-movant bears the ultimate burden of proof on an issue, the movant may discharge its initial burden on summary judgment by merely "showing — that is, pointing out to the district court — that there is an absence of evidence to support the nonmoving party's case."[12] *Celotex*, 477 U.S. at 325 (quotation marks omitted). Nonetheless, although Opposer was not required to submit evidence or affidavits with its motion for summary judgment, we must decide the motion based on all of the evidence of record, including that offered by Opposer.

With its motion for summary judgment, Opposer submitted a considerable number of illustrated invoices, Dupuis Deposition, Exh. A and C, 28 TTABVUE 9-141, 174-272, a photograph of three kimonos, *Id.*, Exh. B, 28 TTABVUE 172, and a photograph of three pairs of sport shoes, *Id.*, Exh. D, 28 TTAVUE 274. Mr. Dupuis'

[12] Once the movant "point[s] out" the lack of evidence to support the non-movant's claim, the burden shifts to the non-movant to show a genuine dispute of material fact, *i.e.*, that it has evidence which arguably establishes a prima facie case on the relevant issue. Because Applicant failed to respond to Opposer's motion in support of its abandonment claim, the issue before us is whether the record — including the affidavit and evidence submitted by Opposer — shifted that burden to Applicant.

declaration repeatedly refers to Opposer's use of "the VENUM mark" on kimonos and sport shoes. Nonetheless, none of these photographs of Opposer's goods shows use of the mark *as it is registered* (the 3927787 Registration) on kimonos and sport shoes. Opposer's evidence clearly shows the word VENUM (in the same stylization as shown in the 3927787 Registration) on those goods, but in each case, the word appears *without* the snake-head design element, which is a part of Opposer's registered mark. Although Mr. Depuis' declaration refers to Opposer's use of "the VENUM & Design trademark," *Id.* 28 TTABVUE 3, he also refers to the attached exhibits as examples of how that mark is used. *See id.* 28 TTABVUE 4-5. This evidence clearly infers that the uses depicted in the exhibits to the Dupuis Declaration show the mark under which Opposer sells its kimonos and sport shoes. And because we must resolve all inferences in favor of Applicant, we must consider Opposer's evidence to depict the only way those goods have been or are now branded. The only use of the registered mark shown in Opposer's exhibits is on the heading of the invoices for the sales of Opposer's various goods. However, there is no evidence in the record indicating that those invoices function as point-of-sale displays or are included with the packaged products. *See Lands' End Inc. v. Manbeck,* 24 USPQ2d 1314 (E.D. Va. 1992); *In re MediaShare Corporation*, 43 USPQ2d 1304 (TTAB 1997). In sum, because Opposer's evidence raises an inference that Opposer is not using the registered mark on kimonos and sport shoes, we find that there is, at a minimum, a genuine dispute as to whether Opposer has abandoned use of the registered mark. Accordingly, Opposer's motion for summary judgment on Applicant's counterclaim is **denied**.

Accelerated Case Resolution

The parties are prohibited from filing any further motions for summary judgment. However, in view of the straightforward nature of the parties' claims in this proceeding, it is recommended that the parties consider using the Board's Accelerated Case Resolution (ACR) procedure. The parties may wish to stipulate to resolution of this proceeding by ACR either on the summary judgment record, or because we have noted certain deficiencies in the types of evidence submitted in support of Opposer's motion and Applicant's response thereto,[13] the parties may stipulate to supplementation of this record. The parties are encouraged to jointly contact the assigned Interlocutory Attorney to discuss the possibility of ACR, any desire to supplement the record and an agreed schedule for proceeding under ACR. The Board's ACR procedures can be tailored to the parties' needs, positions and schedules. In the event the parties agree to ACR using the summary judgment briefs and evidence, along with any supplementation they may agree would be appropriate, 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), 702.04 and 705 (2016).

[13] For instance, Applicant submitted a list of third-party registrations printed from the TESS database. *See* 31 TTABVUE 32-35. The mere submission of a list of registrations does not make the listed registrations of record, and therefore, we have not considered any information regarding the listed registrations. *See Black & Decker Corp. v. Emerson Elec.*, 84 USPQ2d 1482, 1494 (TTAB 2007); *Nat'l Fidelity Life Ins. Nat'l Ins. Trust*, 199 USPQ 691, 694 n.5 (TTAB 1978) (mere listing of third-party registrations with no other information is of limited probative value).

Proceeding Resumed; Trial Dates Reset

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

Expert Disclosures Due	**7/27/2016**
Discovery Closes	**8/26/2016**
Plaintiff's Pretrial Disclosures Due	**10/10/2016**
Plaintiff's 30-day Trial Period Ends	**11/24/2016**
Defendant's Pretrial Disclosures Due	**12/9/2016**
Defendant's 30-day Trial Period Ends	**1/23/2017**
Plaintiff's Rebuttal Disclosures Due	**2/7/2017**
Plaintiff's 15-day Rebuttal Period Ends	**3/9/2017**

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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