

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Baxley

Mailed: January 5, 2015

Opposition No. 91212640

Buffets, Inc.

v.

Starts CC, Inc.

Andrew P. Baxley, Interlocutory Attorney:

In the above-captioned proceeding, Buffets, Inc. (“Opposer”) opposes registration of Starts CC, Inc.’s (“Applicant”) mark J.J. NORTH’S COUNTRY BUFFET and design for “Restaurant services”¹ on the ground of likelihood of confusion with Opposer’s previously used and registered marks COUNTRY BUFFET and OLD COUNTRY BUFFET for “Restaurant services.”²

¹ Application Serial No. 85802394, filed December 13, 2012, and alleging November 1, 2012 as the date of first use anywhere and date of first use in commerce. The application includes a disclaimer of COUNTRY BUFFET.

² Opposer’s pleaded registrations include:

Registration No. 2987516 for the mark COUNTRY BUFFET in standard character form, issued August 23, 2005 and alleging November 1992 as the date of first use anywhere and date of first use in commerce. Section 8 affidavit accepted, Section 15 affidavit acknowledged. The registration includes a disclaimer of BUFFET.

Registration No. 1343558 for the mark OLD COUNTRY BUFFET in typed form, issued July 18, 1985 and alleging March 21, 1984 as the date of first use anywhere and date of first use in commerce. Renewed. The registration includes a disclaimer of BUFFET.

Opposer can establish its standing, and priority will not be an issue herein, provided that Opposer properly makes its pleaded registrations of record by “appropriate identification and introduction during the taking of testimony or by filing a notice of reliance, which shall be accompanied by a copy (original or photocopy) of the registration[s] prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration[s].”

Applicant, in its answer, denies the salient allegations of the notice of opposition and asserts an affirmative defense that the pleaded marks are merely descriptive and “lack secondary meaning,” i.e., that the marks have not acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. § 1052(f).

Applicant’s affirmative defense is a collateral attack on the validity of the pleaded registrations, which can only be raised by way of a compulsory counterclaim. *See* Trademark Rules 2.106(b) and 2.114(b). Because all of the pleaded registrations were issued more than five years prior to the

Trademark Rule 2.122(d)(2). *See Cunningham v. Laser Golf Corp.*, 222, F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, the Board notes that the services in the involved application and the pleaded registrations are identified as “restaurant services.” Likelihood of confusion is determined on the basis of the services as they are identified in the application and registrations at issue. *See Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

The electronic cover sheet of the notice of opposition indicates that Opposer also intends to allege grounds of deceptiveness and false suggestion of a connection with Opposer under Trademark Act Section 2(a), 15 U.S.C. § 1052(a). However, neither of those grounds are sufficiently pleaded in the text of the notice of opposition.

A claim of deceptiveness requires an allegation of “facts that, if proved, would establish that purchasers would be deceived in a way that would affect materially their decision to purchase applicant's goods.” *Miller Brewing Co. v. Anheuser-Busch Inc.*, 27 USPQ2d 1711, 1712 (TTAB 1993). When a plaintiff's allegation is that consumers are deceived into buying defendant's goods under the mistaken belief that they originate from the same source as plaintiff's, or vice versa, the sort of deception at issue is the basis for a Section 2(d), not a Section 2(a), claim. *See Springs Industries, Inc. v. Bumblebee Di Stefano Ottina & C.S.A.S.*, 222 USPQ 512 (TTAB 1984).

A claim of false suggestion of a connection requires an allegation of facts from which it may be inferred that: (1) the defendant’s mark points uniquely to the plaintiff as the plaintiff’s identity or persona; (2) purchasers would assume that goods bearing the defendant’s mark are connected with the plaintiff; and (3) either (a) the plaintiff previously used the mark at issue or the equivalent thereof as a designation of its identity or persona, or (b) there is an association of the mark at

commencement of this proceeding, they cannot be cancelled on the ground that they are merely descriptive and have not acquired distinctiveness.³ *See* Trademark Act Section 14(3), 15 U.S.C. § 1064(3). Accordingly, the Board *sua sponte* strikes the affirmative defense from Applicant's answer. *See* Fed. R. Civ. P. 12(f); TBMP § 506.01 (2014).

The following motions are pending before the Board: (1) Opposer's motion (filed September 12, 2014) to compel discovery; and (2) Opposer's motion (filed October 14, 2014) for leave to amend the notice of opposition to add an abandonment claim. The motion to compel has been fully briefed.

The Board turns first to Opposer's motion for leave to amend the notice of opposition. Although Applicant did not file a brief in response thereto, the Board, in its discretion, elects to decide that motion on the merits. *See* TBMP § 502.04.

Because Applicant filed an answer herein, Opposer may file an amended notice of opposition only with Applicant's consent or by leave of the Board. Fed. R. Civ. P. 15(a)(2); TBMP § 507.02. As a general policy, the Board liberally grants leave to amend pleadings at any stage of a proceeding when

issue with the plaintiff that precedes the defendant's use. *See Miller Brewing Co., supra* at 1712-13.

³ Although a registration can be cancelled on the basis of genericness more than five years after the issuance thereof, a claim of mere descriptiveness without acquired distinctiveness is untimely after the fifth anniversary of the issuance of a registration. *See* Trademark Act Section 14(3). Mere descriptiveness without acquired distinctiveness and genericness are different claims in that merely descriptive terms could conceivably become distinctive, whereas generic terms cannot. *See H. Marvin Ginn Corp. v. Int'l Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party. *See* TBMP § 507.02. However, where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion for leave to amend. *See id.*

Opposer seeks to add a claim of abandonment. However, the pleading of the proposed abandonment claim is insufficient because Opposer has pleaded no “facts that show a period of non-use less than three years coupled with an intent not to resume use.”⁴ *Otto Int’l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007). *See* Trademark Act Section 45, 15 U.S.C. § 1127. Accordingly, the motion for leave to file an amended notice of opposition is denied.

Consideration of the motion to compel is deferred pending resolution of the following. The responses to interrogatory nos. 1(g) and 2(d) of Opposer’s second set of interrogatories that Applicant served on September 4, 2014

⁴ Opposer’s brief in support of the motion for leave to file an amended notice of opposition indicates that the abandonment claim is based on Applicant’s responses to discovery requests in which Applicant states that it ceased use of its involved mark in June 2013. The Board notes, however, that following publication of the involved mark for opposition on May 28, 2013, Opposer, on June 13, 2013, sought and was granted a ninety-day extension of time to oppose and that Opposer commenced this proceeding by filing the notice of opposition on September 24, 2013. Thus, Applicant’s cessation of use of its involved mark appears to coincide with Opposer’s commencement of activities in opposition to the registration of Applicant’s mark. Nonuse of a mark pending the outcome of litigation relating to that mark constitutes excusable nonuse sufficient to overcome any inference of abandonment of that mark. *See Visa Int’l Service Ass’n v. Life-Code Systems, Inc.*, 220 USPQ 740 (TTAB 1983); *Blackstone Corp. v. Allied Paper Inc.*, 176 USPQ 211 (TTAB 1972).

indicate that Applicant is involved in a bankruptcy proceeding. Applicant further indicated in its response to interrogatory no. 2(a) that its parent company is also “in bankruptcy.”⁵ When a defendant in a Board *inter partes* proceeding is involved in a Federal bankruptcy proceeding, the Board suspends the case before it under the automatic stay provisions of United States Bankruptcy Code Section 362, 11 U.S.C. § 362, pending final determination of that bankruptcy proceeding. *See In re Checkers of North America Inc.*, 23 USPQ2d 1451 (Comm'r 1992); TBMP § 510.03(a).

Applicant is allowed until thirty days from the mailing date set forth in this order to file with the Board a copy of Applicant’s bankruptcy petition and a report as to the status of any bankruptcy proceeding involved Applicant and its parent company. Proceedings herein otherwise remain suspended.

⁵ The record herein is not clear as to whether or not Applicant is a wholly owned subsidiary of its parent company.