

THIS ORDER 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
General Contact Number: 571-272-8500

GCP

Mailed: February 17, 2016

Opposition No. 91212768

INTS It Is Not The Same, GmbH

v.

Disidual Clothing, LLC

Before Greenbaum, Adlin and Pologeorgis,
Administrative Trademark Judges:

By the Board:

This proceeding now comes before the Board for consideration of: (1) INTS It Is Not The Same, GmbH's ("Opposer) motion for summary judgment on its claim of likelihood of confusion; and (2) Disidual Clothing, LLC's ("Applicant") cross-motion for summary judgment on the same claim. The motions are fully briefed.

Background

Applicant seeks to register the mark DISIDUAL, in standard characters, for "Apparel, namely, t-shirts, tank-tops, shorts, hats, jackets, sweatshirts, hooded sweatshirts, beanies, socks, pants, dresses, swimsuits, knit face masks, gloves, belts" in International Class 25.¹

¹ Application Serial No. 85836544, filed on January 30, 2013, based on an allegation of use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging June 1, 2010 as both the date of first use and the date of first use in commerce.

On October 2, 2013, Opposer filed a notice of opposition opposing the registration of Applicant's mark on the ground of likelihood of confusion under Section 2(d) of the Trademark Act. In support of its asserted claim, Opposer pleads ownership of numerous registrations for the marks DESIGUAL and DESIGUAL and design, as displayed below, that are used in association with various goods and services, including clothing and retail shops for clothing, fashion and home design accessories.



In its answer, Applicant denies the salient allegations in the notice of opposition and counterclaims to cancel Opposer's pleaded Registration No. 2088319 for the

mark  on the ground of abandonment.

² Registration No. 2088319, registered on August 12, 1997. Section 8 and 15 affidavits accepted on August 12, 2007.

³ Registration No. 3737499, registered on January 12, 2010. Section 8 and 15 affidavits accepted on July 29, 2015. Registration No. 4113640, registered on March 20, 2012. Registration No. 4269396, registered on January 1, 2013.

⁴ Registration No. 3982329, registered on June 21, 2011.

Parties' Motions For Summary Judgment

For purposes of this order, we presume the parties' familiarity with the pleadings, the history of the proceeding and the arguments and evidence submitted with respect to the parties' respective motions for summary judgment.

A party is entitled to summary judgment when it has demonstrated that there are no genuine disputes as to any material facts, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

When the moving party has supported its motion with sufficient evidence which, if unopposed, indicates there is no genuine dispute of material fact, the burden then shifts to the non-moving party to demonstrate the existence of a genuine dispute of material fact to be resolved at trial. *Enbridge, Inc. v. Excelebrate Energy LP*, 92 USPQ2d 1537, 1540 (TTAB 2009). Further, merely because both parties have moved for summary judgment does not necessarily mean that there are no genuine disputes of material fact, and does not dictate that judgment should be entered. *See University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994).

Upon careful consideration of the arguments and evidence presented by the parties, and drawing all inferences with respect to each motion in favor of each nonmoving party, we find that neither Opposer nor Applicant has demonstrated the

absence of a genuine dispute of material fact for trial and that neither is entitled to judgment under applicable law. Based upon the present record, we find, at a minimum, a genuine dispute of material fact exists as to the similarities of the parties' respective marks.

Accordingly, Opposer's motion for summary judgment on its asserted claim of likelihood of confusion and Applicant's cross-motion for summary judgment on the same claim are **DENIED**.⁵

Because this proceeding is at the verge of trial, the parties are *precluded* from filing any further motions for summary judgment in this matter.

Trial Schedule

Proceedings are hereby resumed. Discovery is closed. Remaining trial dates are reset as follows:⁶

30-day testimony period for plaintiff's testimony to close	April 2, 2016
Defendant/Counterclaim Plaintiff's Pretrial Disclosures Due	April 17, 2016

⁵ The parties should note that the evidence submitted in connection with a motion for summary judgment or opposition thereto 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 Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); and *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983). Additionally, the issues for trial are not limited to those identified by the Board in explaining the denial of the cross-motions for summary judgment. Rather, the issues for trial are framed by the pleadings and any issues not pleaded but which may yet be tried by express or implied consent of the parties.

⁶ The Board notes that Opposer filed its motion for summary judgment subsequent to the deadline to serve its pretrial disclosures on Applicant. The Board assumes, therefore, that Opposer has already served its pretrial disclosures. If Opposer has not yet served its pretrial disclosures on Applicant, Opposer must do so immediately and no later than **five (5) business days** from the mailing date of this order.

30-day testimony period for defendant and plaintiff in the counterclaim to close	June 1, 2016
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	June 16, 2016
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	July 31, 2016
Counterclaim Plaintiff's Rebuttal Disclosures Due	August 15, 2016
15-day rebuttal period for plaintiff in the counterclaim to close	September 14, 2016
Brief for plaintiff due	November 13, 2016
Brief for defendant and plaintiff in the counterclaim due	December 13, 2016
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	January 12, 2017
Reply brief, if any, for plaintiff in the counterclaim due	January 27, 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. Trademark Rule 2.125.

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