

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

Faint

Mailed: June 13, 2016

Opposition No. 91223574

Los Santos, LLC¹

v.

Johnny D. Gabrie and Rosalie Gabriel

By the Trademark Trial and Appeal Board:

On April 20, 2016, Opposer filed a combined motion to substitute party plaintiff and to amend the pleadings. There was no response to the motion. On June 3, 2016, Opposer filed a motion for summary judgment.

Motion to Substitute

Opposer seeks to substitute Los Santos, LLC (“Los Santos”) as party plaintiff. In support of its motion, Opposer has attached a copy of an assignment agreement between itself and Los Santos, executed January 13, 2016, after the institution of this Board proceeding. The assignment has been recorded by the PTO Assignment Branch at reel/frame number 5765/0075. Opposer’s marks appear to be based on intent to use applications and the assignment document appears to include the relevant language from Section 10 of the Trademark Act, 15 U.S.C. § 1060, to the effect that the

¹ Substituted as party plaintiff for Mas Cantinas LLC.

assignment includes the portion of the business of the assignor to which the mark pertains. *See* 37 C.F.R. §3.16.

When a mark that is the subject of a federal application or registration has been assigned in accordance with Trademark Act § 10, 15 U.S.C. § 1060, any action with respect to the application or registration which may or must be taken by the applicant or registrant may be taken by the assignee, provided that the assignment has been recorded or proof of that assignment has been submitted.² If a mark pleaded by a plaintiff is assigned, and a copy of the assignment is filed with the Board, the assignee ordinarily will be joined if the assignment occurred after institution of the proceeding. TBMP § 512.01 (2015). However, where the defendant raises no objection to substitution, the Board will normally substitute the assignee as party plaintiff. *Societe des Produits Nestle S.A. v. Basso Fedele & Figli*, 24 USPQ2d 1079, 1079-80 (TTAB 1992) (opposer's motion to substitute granted where copy of assignment was filed and applicant did not object).

As Joint Applicants have not objected to substitution, Opposer's motion to substitute is **granted**, and Los Santos is hereby substituted as party plaintiff,

Motion to Amend the Pleadings

Opposer seeks to amend the notice of opposition to add claims of lack of bona fide intent to use the mark in commerce and that Joint Applicant's mark is used with the goods it is geographically deceptively misdescriptive and/or deceptively misdescriptive. In support of the motion, Opposer argues that information to support

² *See* 37 C.F.R. §§ 3.72(d) and 3.73(b).

the additional claims came to light during the discovery with discovery responses and discovery deposition of Applicant Mr. Gabriel. Joint Applicants filed no response to the motion.

Motions to amend pleadings in inter partes cases are governed by Federal Rule of Civil Procedure 15. Trademark Rules 2.107, 2.115, and 2.116(a). Motions to amend pleadings are liberally granted unless the amendment would violate settled law or be prejudicial to another party. *Commodore Elecs. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993).

The Board has reviewed the first amended notice of opposition and finds it sufficiently alleges Opposer's standing and counts of a lack of bona fide intent to use the applied for mark in commerce, and that Applicant's mark when used with the goods is deceptively misdescriptive, geographically deceptively misdescriptive, misdescriptive without acquired distinctiveness and/or generic pursuant to Trademark Act § 2(e).

Accordingly, Opposer's motion to amend the notice of opposition is **granted**. The amended notice of opposition filed April 20, 2016 is the pleading of record.

For purposes of the motion for summary judgment, Joint Applicant's denial of the claim of lack of a bona fide intent to use the mark in commerce in the first amended notice of opposition will be presumed. *See Hollywood Casino, LLC v. Chateau Celeste, Inc.*, 116 USPQ2d 1988, 1992 (TTAB 2015). The time for Joint Applicant's to file an answer will be set upon disposition of the motion for summary judgment, if appropriate.

Motion for Summary Judgment

Opposer's motion for summary judgment seeks summary judgment on its claim that at the time of filing the application, Joint Applicant lacked a bona fide intent to use the mark.

Opposer also alleges that the application is void ab initio because it was filed under the name of the wrong entity. At present, this claim is not properly before the Board on Opposer's motion for summary judgment because the claim is unpleaded. Neither did a motion to amend the notice of opposition to assert this separate claim accompany Opposer's motion for summary judgment.

The Board may not grant summary judgment on an unpleaded claim. *See Paramount Pictures Corp. v. White*, 31 USPQ2d 1768 (TTAB 1994); *see also American Express Mktg. & Dev. Corp. v. Gilad Dev. Corp.*, 94 USPQ2d 1294, 1297 (TTAB 2010) ("the Board will not hesitate to deny any motion for summary judgment on an unpleaded claim or defense unless the motion for summary judgment is accompanied by an appropriate motion to amend or is withdrawn and refiled with such a motion to amend"). Further, it is well settled that a party may not obtain summary judgment on an issue which has not been pleaded. *See* Fed. R. Civ. P. 56(a) and 56(b) and authorities cited in TBMP § 528.07(a).

Accordingly, that portion of Opposer's motion which seeks summary judgment on a claim that the application is void ab initio because it was filed in the name of the wrong applicant **is denied**. *See Am. Express Mktg.*, 94 USPQ2d at 1297.

Proceedings Are Suspended

Proceedings are **otherwise suspended** pending disposition of Opposer's motion for summary judgment on the claim that at the time of filing its application, Joint Applicants lacked a bona fide intent to use the mark in commerce. Any paper filed during the pendency of this motion which is not relevant thereto will be given no consideration. *See* Trademark Rule 2.127(d).

In addition to tolling the time to respond to outstanding discovery requests, suspension of proceedings tolls the time for parties to make required disclosures. *See* TBMP § 528.03.

The motion for summary judgment will be decided in due course.
