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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: May 4, 2016

Opposition No. 91224268 (Parent)
Opposition No. 91224272

AFAB Industrial Services, Inc.

v.

Pac-West Distributing NV LLC

Before Richey, Deputy Chief Administrative Trademark Judge, Bergsman, and Wolfson, Administrative Trademark Judges.

By the Board:

By way of background, AFAB Industrial Services, Inc. ("Opposer") filed separate notices of opposition on October 8, 2015, opposing registration of the following applications: Serial No. 86690099 for the mark NEVER FAKE IT! in standard characters, and Serial No. 86599421 for the mark SUPER RUSH in standard characters.[1] Each application states that the applied-for mark is in use in commerce on "all-purpose cleaners; cleaning preparations" in International Class 3. As grounds for opposition, Opposer alleges that Pac West Distributing NV LLC ("Applicant") has

[1] Serial No. 86690099 was filed on July 10, 2015 based on use in commerce under Section 1(a) of the Trademark Act, 15 U.S.C., 1051(a), and published for opposition on September 15, 2015. Serial No. 86599421 was filed on April 28, 2015 under Section 1(a) of the Trademark Act and published for opposition on September 15, 2015.

not lawfully used the marks in commerce and that Applicant committed fraud in the prosecution of the applications for registration.[2]

On December 30, 2015, prior to the opening of the discovery period as reset by the Board, Applicant filed similar motions for summary judgment in each of the opposition proceedings. On January 5, 2016, the Board consolidated the proceedings in view of the common issues in the oppositions and suspended the consolidated proceedings pending determination of the motions for summary judgment. In response to Applicant's motions for summary judgment, Opposer filed a motion for discovery pursuant to Fed. R. Civ. P. 56(d). Opposer's motion is fully briefed.[3]

Turning first to Applicant's motions for summary judgment, the Board notes that Applicant has not submitted any evidence in support of its motion. Instead, Applicant relies on the identification of goods in the application and states that "it is undisputed" that Applicant is seeking registration of its marks for "all-purpose cleaners; cleaning preparations" and not for any other goods. 9 TTABVUE at 6. Applicant argues that these products are not *per se* unlawful according to 15 U.S.C.

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[2] In support of its claims of unlawful use, Opposer alleges that Applicant uses its mark on consumer products containing chemicals that may be inhaled or otherwise introduced into the human body in violation of 15 U.S.C. §§2057a and b, as opposed to the cleaning products identified in the application. Opposer's fraud claim is also based on allegations that Applicant knowingly misrepresented to the USPTO that it was using the mark on the goods identified in the applications at the time of filing the applications and that its use was lawful. *See* Notice of Opposition, ¶¶ 8-12, 29-32.

[3] On November 16, 2015, Applicant filed a motion to dismiss under Fed. R. Civ. P. 12(b)(6) in each of the opposition proceedings. The Board construed the motions as motions for summary judgment and denied the motions as premature inasmuch as the motions were filed prior to the service of initial disclosures. In addition, the Board, *sua sponte*, reviewed Opposer's claims and found the claims of unlawful use in commerce and fraud sufficiently pleaded.

§§ 2057a and b and that "there is no evidence to support Opposer's contention that cleaning products which contain isobutyl nitrites and/or alkyl nitrites are *per se* unlawful under federal law." 9 TTABVUE at 6.

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(a). In reviewing a motion for summary judgment, the evidentiary record and all justifiable inferences to 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, 2029-30 (Fed. Cir. 1993); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1546 (Fed. Cir. 1992).

A party moving for summary judgment has the burden of demonstrating the absence of evidence to support the nonmoving party's case, and that it is entitled to judgment as a matter of law. *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2D 1793, 1795-96 (Fed. Cir. 1987), *citing Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548, 2554 (1986). A defendant moving for summary judgment may not rely on a mere recitation of the conclusory statement that the record contains no evidence of the elements of a claim. *See, e.g., Ashe v. Corley*, 992 F.2d 540, 543 (5th Cir. 1993) ("it is not enough for the moving party to merely make a conclusory statement that the other party has no evidence to prove its case."). The moving party must first satisfy its obligation of demonstrating that there are no factual issues warranting trial. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). *See also, Royal*

Surplus Lines Ins. Co. v. Brownsville Indep. Sch. Dist., 404 F. Supp.2d 942, 948 (S.D. Tex. 2005) ("the concept of a 'no evidence' summary judgment [i.e., listing the elements of a claim and stating that there is no evidence to support the elements] neither accurately describes federal law nor has any particular import in . . . federal summary judgment procedure.").

In order to demonstrate that use of a mark in commerce is unlawful in a proceeding before the Board, a party must show that a court or government agency having competent jurisdiction under the involved statute has previously made a finding of non-compliance *or* that there has been a *per se* violation of the statute at issue. *See Santinine Societa v. P.A.B. Products*, 209 USPQ 958, 964 (TTAB 1981); *see also, General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1274 (TTAB 1992); *Kellogg Co. v. New Generation Foods, Inc.*, 6 USPQ2d 2045, 2047 (TTAB 1988).

Pursuant to 15 U.S.C. § 2057a and b, it is not unlawful to manufacture for sale, offer for sale, distribute in commerce, or import into the U.S. butyl nitrite or volatile alkyl nitrite for any commercial purpose. 15 U.S.C. § 2057a(b) and 2057b(b). For purposes of these sections "commercial purpose" is defined as "any commercial purpose other than for the production of consumer products containing [butyl nitrite or volatile alkyl nitrites] that may be used for inhaling or otherwise introducing [the chemicals] into the human body for euphoric or physical effects." 15 U.S.C. § 2057a(c)(2) and 2057b(c).

In this case, Applicant, as the party moving for summary judgment, has failed to carry its initial burden of demonstrating the absence of any genuine disputes of

material fact, or that it is entitled to judgment as a matter of law on the claims of unlawful use in commerce and fraud. Applicant has provided no evidence that the goods identified in its application comply with the "commercial purpose" requirement of 15 U.S.C. § 2057a(b) and 2057b(b). Specifically, Applicant has neither alleged nor averred a dearth of court or government agency findings of non-compliance with 15 U.S.C. §§ 2057a and b or that the goods identified in the applications are intended solely for lawful commercial purposes and not for unlawful consumer use. Applicant's conclusion that it is entitled to summary judgment because there is no evidence that the goods identified in the application are *per se* unlawful is misplaced. The subject application and the allegations therein are not evidence of anything on behalf of applicant except that the application was filed. *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 396 n.10 (TTAB 1979); *see, e.g., Omega SA v. Compucorp*, 229 USPQ 191, 195 (TTAB 1985) (allegations and documents bearing on applicant's goods are not evidence unless they have been identified and as exhibits during testimony period).

In view thereof, the Board finds that Applicant has not met its burden to show the absence of genuine disputes of material facts and that it is entitled to judgment as a matter of law. Genuine disputes exist, at a minimum, as to the precise nature and purpose of Applicant's goods; whether the goods may be lawfully sold in commerce;

and whether Applicant knowingly made material misrepresentations regarding the identified goods in the involved applications.[4]

Accordingly, Applicant's motions for summary judgment are **DENIED**. In addition, the parties are precluded from filing any further motions for summary judgment without first obtaining permission from the Board.

In view of the Board's decision denying Applicant's motions for summary judgment, Opposer's motion for discovery under Rule 56(d) is **moot**.

Proceedings are resumed. Discovery and trial dates are reset as follows:

Deadline for Discovery Conference	**6/3/2016**
Discovery Opens	**6/3/2016**
Initial Disclosures Due	**7/3/2016**
Expert Disclosures Due	**10/31/2016**
Discovery Closes	**11/30/2016**
Plaintiff's Pretrial Disclosures	**1/14/2017**
Plaintiff's 30-day Trial Period Ends	**2/28/2017**
Defendant's Pretrial Disclosures	**3/15/2017**
Defendant's 30-day Trial Period Ends	**4/29/2017**
Plaintiff's Rebuttal Disclosures	**5/14/2017**
Plaintiff's 15-day Rebuttal Period Ends	**6/13/2017**

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

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[4] The fact that we have identified only certain genuine disputes as to material facts should not be construed as a finding that these are necessarily the only disputes which remain for trial.