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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91224595
Party	Defendant BOL ENTERPRISE (PVT.) LIMITED
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Ref. No. 30417.002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

INDEPENDENT MEDIA CORPORATION (PVT.) LTD.,	
Opposer,	Opposition No.: 91224595
v.	
BOL ENTERPRISE (PVT.) LIMITED,	
Applicant.	

REQUEST FOR EXTENSION OF TIME TO RESPOND TO NOTICE OF DEFAULT

Applicant BOL Enterprise (Pvt.) Limited ("BOL") ("Applicant"), by and through its undersigned attorneys, hereby respectfully requests an extension of thirty (30) days to respond to the notice of default issued by the Board in the above-referenced matter on January 8, 2016. [Dkt. 4].

Applicant's counsel only became aware of the instant opposition proceeding after the Board issued the above-referenced notice of default and immediately brought it to the attention of Applicant. Applicant's counsel is currently awaiting further instructions from Applicant, who is based in Pakistan.

Furthermore, Applicant has meritorious defenses to the Notice of Opposition filed by Opposer Independent Media Corporation (Pvt.) Ltd. ("Opposer"). On January 14, 2016, the Board granted Applicant's motion for summary judgment dismissing a related consolidation opposition proceeding commenced by Opposer, Consol. Opp. No. 91216909, upon finding that Opposer was precluded as a matter of law from establishing prior trademark rights in the mark BOL necessary to sustain its claims for likelihood of confusion and fraud. *See* Consol. Opp.

91216909, Dkt. 29 (attached hereto). Because the instant opposition proceeding involves identical parties, a similar BOL-formative mark and the same asserted grounds of priority that the Board has already found to be legally unsustainable, the Board's prior summary judgment decision is potentially dispositive of the instant proceeding.

For the foregoing reasons, Applicant respectfully requests a 30-day extension of the deadline to respond to the Board's notice of default.

Dated: New York, New York
February 4, 2016

Respectfully submitted,
COWAN, LIEBOWITZ & LATMAN, P.C.

By: /Richard S. Mandel/

Joel Karni Schmidt
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Attorneys for Applicant BOL Enterprise (Pvt.) Limited

CERTIFICATE OF SERVICE

The undersigned does hereby certify that the foregoing REQUEST FOR EXTENSION OF TIME TO RESPOND TO NOTICE OF DEFAULT was served on Opposer Independent Media Corporation (Pvt.) Ltd. by mailing copies by First Class Mail, postage prepaid, on February 4, 2016, to Opposer's Attorney and Correspondent of Record, Harold L. Novick, Esq., Novick, Kim & Lee, PLLC, 1604 Spring Hill Road, Suite 320, Vienna, VA 22182.

/Scott P. Ceresia/
Scott P. Ceresia

THIS OPINION 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

AJZ

Mailed: January 14, 2016

Opposition Nos. 91216909
91216942
91219384

Independent Media Corporation (PVT.) Ltd.

v.

BOL Enterprise (PVT.) Ltd.

Before Quinn, Zervas and Wolfson, Administrative Trademark Judges.

By the Board:

BOL Enterprise (PVT.) Ltd. ("Applicant") is the owner of the following applications for registration on the Principal Register, which have been opposed by Independent Media Corporation (PVT.) Ltd. ("Opposer" or "IMC"):

- Serial No. 85966100[1] for the mark

for the following International Class 41 services:

> Audio production services, namely, creating and producing ambient soundscapes, and sound stories for museums, galleries, attractions, podcasts, broadcasts, websites and games; Education services, namely,

[1] Filed June 21, 2013 based on a *bona fide* intention to use the mark in commerce, pursuant to Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b). A translation statement entered into the application record states, "The English translation of the word 'BOL' in the mark is 'speak'."

providing hands-on opportunities for children in the field of intuitive engineering through live, broadcast, and on-line classes, seminars, workshops, training and curriculum development for children, parents and educators; Entertainment in the nature of an ongoing special variety, news, music or comedy show featuring politics, social issues, current affairs, drama and news broadcast over television, satellite, audio, and video media; Entertainment services, namely, an ongoing series featuring variety and news provided through satellite television; Entertainment services, namely, providing continuing musical, comedy and variety stage shows, dramatic shows, and news shows broadcast over television, satellite, audio, and video media.

● Serial No. 86003454[2] for the mark

for the following services:

"Audio and video broadcasting services over the Internet; Broadcast of cable television programmes; Broadcasting of radio programmes; Broadcasting of television programmes; Broadcasting services and provision of telecommunication access to films and television programmes provided via a video-on-demand service; Broadcasting services, namely, transmission of advertising programs and media advertising communications via digital communications networks; Electronic transmission of voice, data and images by television and video broadcasting; Internet broadcasting services; Satellite television broadcasting; Satellite transmission services, television and radio broadcasting services; Simulcasting broadcast television over global communication networks, the Internet and wireless networks; Subscription television broadcasting; Video broadcasting and transmission services via the Internet, featuring films and movies; Video broadcasting services via the Internet; Wireless broadcasting" in International Class 38; and

[2] Filed July 6, 2013, pursuant to Section 1(b) of the Trademark Act. A transliteration statement in the application record states, "The non-Latin characters in the mark transliterate to 'BOL' and this means 'SPEAK' in English."

> Audio production services, namely, creating and producing ambient soundscapes, and sound stories for museums, galleries, attractions, podcasts, broadcasts, websites and games; Education services, namely, providing hands-on opportunities for children in the field of intuitive engineering through live, broadcast, and on-line classes, seminars, workshops, training and curriculum development for children, parents and educators; Entertainment in the nature of an ongoing special variety, news, music or comedy show featuring current affairs broadcast over television, satellite, audio, and video media; Entertainment services, namely, organizing and conducting an array of athletic events rendered live and recorded for the purpose of distribution through broadcast media; Entertainment, namely, a continuing variety show broadcast over television, satellite, audio, and video media; News syndication for the broadcasting industry" in International Class 41;

● Serial No. 86165686[3] for the mark BOL (in standard characters) for the following services:

> "Broadcast of cable television programmes; Broadcasting of radio programmes; Broadcasting of television programmes; Broadcasting of video and audio programming over the Internet; Broadcasting programs via a global computer network; Broadcasting services and provision of telecommunication access to films and television programmes provided via a video-on-demand service; Satellite television broadcasting; Satellite transmission services, television and radio broadcasting services; Subscription television broadcasting" in International Class 38; and
>
> "Entertainment in the nature of television news shows; News agencies, namely, gathering and dissemination of news; News reporter services in the nature of news analysis and news commentary; News syndication for the broadcasting industry; Providing current event news via a global computer network; Providing information, news

[3] Filed January 15, 2014, pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming first use and first use in commerce on March 1, 2013.

> and commentary in the field of entertainment; Providing news and information in the field of sports" in International Class 41.

Opposer alleges (i) prior use of the mark BOL for, *inter alia*, movies and films, and pre-recorded CDs, video tapes, laser disks and DVDs featuring social drama, and for audio production services, educational services and entertainment services; and (ii) likelihood of confusion with its alleged mark.[4] In addition, Opposer alleges:

> 18. Applicant has applied for registration of its mark in bad faith and its declaration supporting its application is false and fraudulent because Applicant knew of Opposer's prior rights when Applicant executed its application's declaration.
>
> 19. Opposer brought a suit against Applicant in Pakistan for, inter alia, trademark infringement of Opposer's Pakistani registered mark BOL, and was granted a world-wide preliminary injunction against Applicant.[5]

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[4] In Opposition No. 91216942, Opposer alleges prior use of BOL in the Urdu language in connection with additional services. 1 TTABVUE 4 (Opposition No. 91216942).

Citations are to the record in Opposition No. 91216909, unless otherwise noted.

[5] 1 TTABVUE 4. Applicant further explains in the complaint filed in Opposition No. 91219384:

> 18. As a result of a temporary injunction decree granted in a law suit in Pakistan on November 19, 2013 between the present parties prior to the filing date of Applicant's application on January 15, 2014, Applicant was restrained from setting up, owning, establishing, operating and/or running [sic]TV station involving the use of satellite, internet, etc. in or outside of Pakistan using the BOL mark. Consequently the Applicant's official executing the application was unable to truthfully state in the declaration that he "believes the applicant to be the owner of the trademark/service mark sought to be registered, … to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce … ." As a result of such untruthful declaration, Applicant has applied for registration of its mark in bad faith and has committed fraud on the Patent and Trademark Office.

1 TTABVUE 4 (Opposition No. 91219384).

Applicant has denied the salient allegations of the Notices of Opposition in Answers filed in each opposition.

This case now comes up on Applicant's motions for summary judgment filed in Opposition Nos. 91216909 and 91216942 on the grounds of likelihood of confusion and fraud.[6] On August 18, 2015, after Applicant had filed its motions for summary judgment, the Board consolidated the later-filed Opposition No. 91219384 with the earlier two opposition proceedings. No summary judgment motion appears in Opposition No. 91219384. Because Opposer's three Notices of Opposition are highly similar, the arguments raised in the two filed summary judgment motions apply to the claims asserted in all three oppositions, and the parties have treated the summary judgment motions as applying to all three oppositions. Therefore, we consider the summary judgment motions to be directed to the claims asserted in all three oppositions.

Applicant asserts that Opposer's claim of priority of use is premised solely upon its exploitation and promotion of a Pakistani motion picture entitled "Bol" which was briefly released in theaters in the United States in the fall of 2011 (hereafter, the "BOL Film"). According to Applicant, "[i]n response to its Initial Disclosures requirements and BOL's document requests seeking all documents supporting any claim by IMC of rights in the BOL Mark prior to June 21, 2013 [the filing date of application Serial No. 85966100], IMC produced documents depicting its use of the term 'BOL' solely as the title of the BOL Film in connection with the

[6] Applicant's summary judgment motion is accompanied by the declaration of Scott Ceresia, attorney for Applicant, and exhibits.

release and sale of the film, promotional activities and an associated movie soundtrack."[7] In addition, "in sworn interrogatory responses, [Opposer] admitted that its exploitation and promotion of the BOL Film comprises the sole basis upon which it claims rights in the term 'BOL' prior to June 21, 2013."[8]

Applicant relies on Opposer's verified interrogatory responses to the following interrogatories:

> ● *Interrogatory No. 7*
>
> State whether Opposer claims rights in the mark BOL in the United States prior to June 21, 2013 for any goods or services, and if so, identify each such good or service and explain the basis for each such claim.
>
> > *Response*:
> > … Opposer claims rights in the mark BOL in the United States prior to June 21, 2013.
> >
> > Opposer launched a website on July 23, 2010 that has a world-wide audience, including the United States on which it promoted the film BOL and copies of the film were viewed in the US and are currently obtainable on DVD's in the US. Associated with the showing of such movies, promotional services were provided. The basis of claims is the use of the mark.
>
> ● *Interrogatory No. 15*
>
> State whether, prior to June 21, 2013, you made any use of Opposer's BOL Mark in the United Sates other than in connection with the BOL Film, and if so, identify all such uses.
>
> > *Response*
> > Opposer states that the mark was used in promotion of the movie, on signs and posters. The mark was also used on music which was separately promoted.
>
> ● *Interrogatory No. 23*
>
> State all facts and identify all documents that support Paragraph 1 of Opposer's Notice of Opposition stating that, "Opposer

[7] Ceresia Decl. ¶¶ 10-11; Exs. C-D, 14 TTABVUE 21, 90-115.
[8] Applicant's Brief at 5, 14 TTABVUE 6.

since prior to Applicant's filing date of its Intent To Use application of June 21, 2013 adopted and continuously used in commerce the mark BOL in standard character and in fanciful lettering (individually and collectively, "BOL Mark") for, inter alia, movies and films, and pre-recorded CD's, video tapes, laser disks and DVDs featuring social drama (Class 9 Products)."

Response
… Opposer states that the mark was used in promotion of the movie, on signs and posters. The mark was also used on music which was separately promoted.

● *Interrogatory No. 24*
State all facts and identify all documents that support Paragraph 2 of Opposer's Notice of Opposition stating that, "Opposer since prior to Applicant's filing date of its Intent To Use application of June 21, 2013 adopted and continuously used in commerce the BOL Mark for audio production services, education services, and entertainment and entertainment services (Class 41 Services)."

Response
… Opposer states that the provision of Class 41 services was done through the distribution of the BOL film. Also, see above responses.[9]

According to Applicant's motion, Opposer is claiming rights in the title of a single work, which, according to Federal Circuit and Board precedent, does not accord Opposer any trademark rights to assert against Applicant, and therefore Opposer does not have priority of use in connection with its likelihood of confusion claims.

Applicant also seeks summary judgment on Opposer's fraud claims, arguing that there can be no fraud in connection with Applicant's representation to the Office in its applications that Applicant had exclusive rights to BOL, because Opposer has no rights to BOL as a trademark.

[9] Ceresia Decl. Ex. E., 14 TTABVUE 116.

Opposer responded to Applicant's motion, arguing that Opposer does not solely use BOL as a title of a movie, but also on soundtracks of the movie, and "on independent songs and [a] collection of songs,"[10] and that Opposer has acquired secondary meaning in the BOL Film and its music. Opposer submitted (i) the declaration of Sulaiman Lalani, Executive Director of Opposer, with exhibits, (ii) the declaration of Angela Dai, an attorney for Opposer, with exhibits, and (iii) the declarations of various individuals testifying to the renown of the movie. With regard to Applicant's motion on the ground of fraud, Opposer states, without elaboration, that Applicant knew that Opposer had a right to use the mark when it signed its declarations. Opposer refers us to what appears to be a complaint for a Pakistani action and a three-page order from a Pakistani court which Opposer attached to the Notices of Opposition. The complaint and order, however, are not part of the summary judgment record; except as provided in Trademark Rule 2.122(d), 37 C.F.R. § 2.122(d), regarding trademark registrations, exhibits attached to pleadings do not form part of the record. Trademark Rule 2.122(c). In addition, the submission of the complaint and order with Ms. Dai's declaration does not make them of record; the declaration does not specifically identify the complaint and order. Documents not specifically identified in a declaration cannot be considered as exhibits to the declaration. *See Missouri Silver Pages Directory Publishing Corp. Inc. v. Southwestern Bell Media, Inc.*, 6 USPQ2d1028, 1030 n.9 (TTAB 1988) ("opposers have submitted various documents … . [T]hey were not specifically identified in the affidavit and cannot be considered as exhibits to the affidavit.");

[10] Opposer's Brief at 8-9, 14 TTABVUE 9-10.

Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 528.05(b) (June 2015) ("Documents submitted with a summary judgment affidavit, but not identified therein, cannot be considered as exhibits to the affidavit."). [11]

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).

When the moving party has supported its motion with sufficient evidence that, 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. Excelerate Energy LP*, 92 USPQ2d 1537, 1540 (TTAB 2009). All evidence must be viewed in a light favorable to the nonmovant, and all justifiable inferences are to be drawn in the

[11] Applicant also submitted Opposer's complaint and attachments (including the Pakistani order) with Mr. Ceresia's declaration, but did not identify the order; Applicant only identified the complaint.

nonmovant's favor. *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA Inc.*, 23 USPQ2d at 1472. Further, in considering whether summary judgment is appropriate, the Board may not resolve any genuine disputes of material fact necessary to 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; *Olde Tyme Foods*, 22 USPQ2d at 1542.

Priority

We turn now to Applicant's contention that Opposer's claim of priority is based only on the title of a single work and that Opposer's contention that it has a series due to the use of the BOL mark on a soundtrack for the BOL Film and "on independent songs and collection of songs."[12]

In *Mattel Inc. v. Brainy Baby Co.*, 101 USPQ2d 1140, 1142 (TTAB 2011), the Board stated:

> The title of a single creative work is not considered a trademark, and is therefore unregistrable on the Principal Register under Trademark Act Sections 1, 2, and 45, 15 U.S.C. Sections 1051, 1052, and 1127. *See In re Cooper*, 254 F.2d 611, 117 USPQ 396 (CCPA 1958) ("*Cooper*"). The title of a single creative work is, of necessity, descriptive of the work and does not function as a trademark. *See In re Scholastic Inc.*, 223 USPQ 431, 431 (TTAB 1984) ("*Scholastic I*"). On the other hand, if a term has been used to identify the source of a series of creative works, it functions as a trademark, and the fact that it may also be included in the title of each work does not destroy its source-originating function. *See In re Scholastic Inc.*, 23 USPQ2d 1774, 1776 (TTAB 1992) ("*Scholastic II*"); TMEP Section 1202.08 (8th ed. 2011).

[12] Opposer's Brief at 8-9, 14 TTABVUE at 9-10.

The Board and the Federal Circuit, our primary reviewing court, consistently have found that the title of a single creative work is not a trademark. *See, e.g., Herbko Int'l Inc. v. Kappa Books, Inc.,* 308 F.3d 1156, 64 USPQ2d 1375, 1379 (Fed. Cir. 2002) (no proprietary rights in CROSSWORD COMPANION until publication of the second volume of a series of crossword puzzle books); *In re Posthuma*, 45 USPQ2d 2011, 2014 (TTAB 1998) (title of live theater production unregistrable, notwithstanding variations necessarily arising because the performances were live).

The name of a series of works, however, can be registered as a trademark even though the title of a single work cannot. The *Cooper* court explained this different treatment:

> The name for a series, at least while it is still being published, has a trademark function in indicating that each book of the series comes from the same source as the others. The name of the series is not descriptive of any one book and each book has its individual name or title. A series name is comparable to the title of a periodical publication such as a magazine or newspaper. While it may be indicative either specifically or by association in the public mind, of the general nature of the contents of the publication, it is not the name or title of anything contained in it. A book title, on the other hand[,] especially one which is coined or arbitrary, identifies a specific literary work, of whatever kind it may be, and is not associated in the public mind with the publisher, printer or bookseller--the "manufacturer or merchant" referred to in the Trademark Act (Sec. 45, definition of Trademark). If a title is associated with anything, it is with the author for it is he who has produced the literary work which is the real subject of purchase.

In re Cooper, 117 USPQ at 400.

Applicant points out that the Board in the past has looked to see if the second work is based on or derived from the same creative work in determining whether the second work is part of a series. Applicant cites to *In re Author Servs.*, Serial No.

76227464 (TTAB Aug. 8, 2003), a decision designated as not citable, wherein the applicant argued that the title BATTLEFIELD EARTH should be registrable as a "series" based upon its use of the term on various different goods, including a compact disc containing the musical soundtrack from a film that was made into a movie, the DVD and videotape versions of the film, audio tapes of the book, and a magazine article devoted to the film.[13] The Board agreed with the assigned Examining Attorney that all such uses of the term BATTLEFIELD EARTH were "simply the title of essentially a single creative work":

> All of the goods for which applicant seeks registration of the designation "BATTLEFIELD EARTH" plainly appear to be based on or derived from the same creative work, namely, the science fiction book by L. Ron Hubbard which is entitled "BATTLEFIELD EARTH."
>
> . . .
>
> [T]he fact that the book entitled "BATTLEFIELD EARTH" has been . . . made into a motion picture, with a separately available soundtrack recording, all of which bear the title "BATTLEFIELD EARTH," does not show that a series of audio tapes, video tapes and compact discs featuring science fiction books exists, much less that the designation "BATTLEFIELD EARTH" is a trademark for such goods rather than simply the title of what is essentially a single creative work as recorded therein.[14]

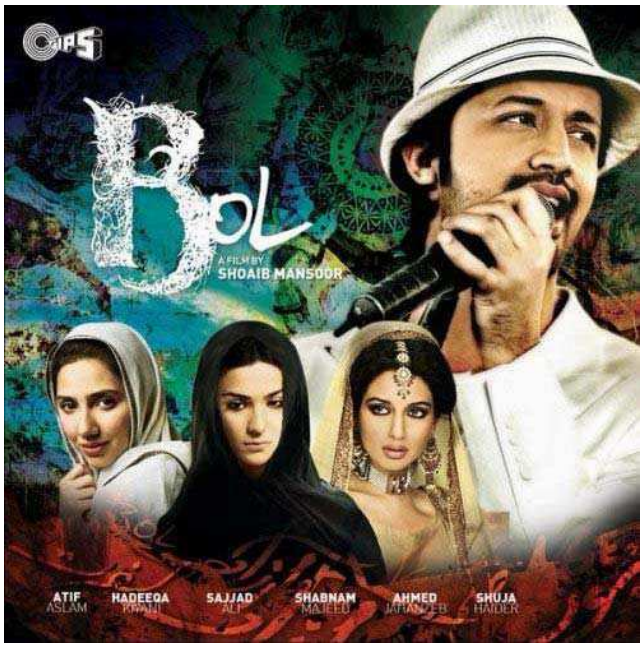
In the present case, there is no genuine dispute that the designation BOL was used on the BOL Film, which was distributed in the United States in 2011, and

[13] We do not base our decision on this non-citable case, but discuss it merely as an example of a similar Board ruling and because Applicant has relied on it in its Brief. The Board no longer designates decisions as citable or not citable. Rather, it designates decisions as "a precedent" or as "not a precedent" of the TTAB. Decisions issued as "not citable" or as "not a precedent" are not binding authority.
[14] *Id*. at *14.

that no additional movie under the BOL designation has been distributed in the United States.

Opposer states in its Brief that it has distributed "independent songs and a collection of songs," but provides no evidence that such songs exist, beyond the songs of the soundtrack. Opposer has not raised a genuine issue of disputed fact as to the existence of "independent songs and a collection of songs."

With regard to the soundtrack, there is no genuine dispute that a soundtrack from the BOL Film, was distributed in the United Stated in 2011. The cover of the sound track uses the term BOL to refer to the BOL Film; the words "A FILM BY SHOAIB MANSOOR" appear directly underneath the title "BOL":



Also, the record shows that iTunes refers to the soundtrack as the "Original Motion Picture Soundtrack." Because of the soundtrack's association with the BOL Film, and because only songs from the BOL Film are in the soundtrack or compilation of

songs, Applicant has established that the soundtrack or compilation of songs is based on or derived from the same creative work, namely, the BOL Film.

In the absence of evidence demonstrating that BOL is used on at least two different creative works, we conclude as a matter of law that BOL is simply the title of essentially a single creative work. *Cf.*, *In re Arnold*, 105 USPQ2d 1953, 1956 (TTAB 2013) (requiring evidence that a title is used on at least two different creative works). *See also*, *Trademark Manual of Examining Procedure* ("TMEP") § 1202.08(c) (October 2015).

Opposer also asserted that it has acquired secondary meaning in the term BOL and hence has trademark rights in BOL. However, there is an absolute bar to registration of the title of a single creative work on the Principal or Supplemental Registers. Titles of single creative works are incapable of any trademark significance and, therefore, unprotectable and unregistrable, even if the applicant submits proof of acquired distinctiveness. See *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 64 USPQ2d at 1378 ("the title of a single book cannot serve as a source identifier"); TMEP § 1202.08 ("The title of a single creative work is not registrable on either the Principal or Supplemental Register.").

In view of the foregoing, Applicant has established that Opposer has no trademark rights in the term BOL and that Opposer cannot demonstrate priority. Because Opposer cannot demonstrate priority, Opposer cannot prevail on its claim of likelihood of confusion under Section 2(d) of the Trademark Act.

Fraud

We now turn to Applicant's motion insofar as it pertains to Opposer's claim of fraud. Opposer maintains that Applicant "applied for registration of its marks in bad faith and its declaration supporting its applications are each false and fraudulent because [Applicant] knew of Opposer's prior rights when the application's declaration was executed."[15] Because Opposer had no such prior rights in the mark BOL in the United States, Applicant's statements in its application declarations attesting to its exclusive right to use the applied-for marks were not false.

In addition, even if the order from the Pakistani court, mentioned above, were properly made of record, the order does not raise a genuine issue of disputed fact because (i) the Pakistani order, which comprises three pages (two of which form the long case caption identifying numerous parties), merely states, "Urgency granted" without any description of what is being granted; (ii) we will not assume the "Urgency granted" in the order refers to the prayer for relief in the complaint; (iii) Opposer has not authenticated the Pakistani order - it merely submitted the complaint and its exhibits; and (iv) the order states that it is an "interim order." Further, Opposer also has not addressed why we should recognize the Pakistani order under principles of international comity. *See Pilkington Brothers P.L.C. v. AFG Industries Inc.,* 581 F.Supp. 1039 (Del. 1984) ("an American court will under principles of international comity recognize a judgment of a foreign nation if it is convinced that the parties in the foreign court received fair treatment by a court of

[15] Opposer's brief at 7, 14 TTABVUE 8.

competent jurisdiction 'under a system of jurisprudence likely to secure an impartial administration of justice between the citizens of its own country and those of other countries... .'" (Citations omitted.)

Conclusion

Applicant has established that there are no genuine disputes of any material fact that Opposer has no prior trademark rights in the term BOL and that Applicant has not made any false statement in its application declarations. Summary judgment therefore is granted to Applicant on Opposer's claims of likelihood of confusion and fraud in each opposition.

Decision: All three Oppositions are dismissed.

Opinion by Wolfson, Administrative Trademark Judge, in dissent.

I respectfully dissent from the decision dismissing the three consolidated oppositions.

In my opinion, the "title of a single work" doctrine should be applied only where there is a single creative work, and not where there exists an original creative work and a derivative work that substantially varies in content from the original. In such case, the owner of the purported mark does not have "essentially" one single creative work but multiple works, and should be given the opportunity to show that the title has acquired distinctiveness and no longer merely describes the work itself but functions to designate source.

Once there are two or more works called by the same name, and these works are not adaptations of each other, even if one is a unique derivation of the other, the doctrine should not apply.[16] In such case, the party claiming ownership, such as Opposer herein, should be allowed to show that its use of the title on these multiple works, together with other indicia of association-creating activities (e.g., use of the mark as a trade name) and evidence of secondary meaning (such as length of use of the mark, advertising expenditures, sales, survey evidence, affidavits asserting source-indicating recognition), has given rise to proprietary rights based on a showing of acquired distinctiveness in the term. *See Herbko International Inc. v. Kappa Books Inc.,* 308 F3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002) ("Because sales of a single book title are insufficient to create proprietary rights and because Kappa provided no other evidence of association creating activities (e.g., use of mark as trade name), the Board erred in holding Kappa established priority to the mark.").

In other words, while the title of a single creative work is incapable of functioning as a mark, once there are multiple works with the same title, the term cannot be said to automatically fail to function and it is error to hold as a matter of law that the owner cannot establish priority to the mark.[17] In this case, Opposer has submitted evidence of consumer recognition of its mark that is sufficient, albeit

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[16] Naturally, this is a fact-based inquiry that requires consideration of the content of each work. In some cases, the works will be so similar that they will not qualify as unique derivations but remain "essentially" the same work.

[17] We have long held that if the two works were of the same type, they would constitute a "series" and their common title would thereby fall outside the absolute bar created by application of the title of a single work doctrine. Instead, as with other allegedly descriptive marks, the title's owner would be allowed to show that the title had acquired distinctiveness.

slight, to raise a genuine dispute of material fact as to whether the term BOL serves a trademark function. At trial, Opposer will be required to meet an extremely high evidentiary standard because as a title, BOL is the ultimate in descriptiveness for the works involved. However, I would not summarily preclude Opposer from being allowed to make this showing, if it can.

I would also not summarily dismiss Opposer's fraud claim. Opposer has shown that it has a real interest in this case and alleged that Applicant is enjoined from using the mark BOL (and presumably, its Urdu equivalent) in the United States under a temporary injunction order issued by a Pakistani court. The order was made of record as part of the evidence attached to the motion for summary judgment and to Opposer's response.[18] Based on principles of international comity

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[18] The majority states that the Pakistani complaint and injunction order were not made part of the record, but I disagree. Exhibits 6 and 7 to the Dai Declaration are the Notices of Opposition in Opp. Nos. 91216909 and 91216942 (against Serial Nos. 85966100 and 86003454) and include several attachments, one of which is the Pakistani complaint and another of which is the injunction order. 26 TTABVUE 37 and 65. Ms. Dai identifies both the Notices of Opposition and the attachments in her declaration by the following statements:

> 7. A true and correct copy of IMC's Notice of Opposition *and attachments thereof*, filed on June 18, 2014, against the mark BOL (stylized/design) in the '100 application is hereby attached as Exhibit 6.
>
> 8. A true and correct copy of IMC's Notice of Opposition *and attachments thereof*, filed on June 18, 2014, against the mark BOL (Urdu) in the '454 application is hereby attached as Exhibit 7."

(emphasis supplied) 26 TTABVUE 3.

As for Opp. No. 91219384 (against Serial No. 86165686), Exhibit 10 to the Dai declaration is identified only as "Notice of Opposition." Although within the body of the Notice is a claim that a copy of the complaint and injunction order are attached as Exhibits 1 and 2 thereof, the record copy of the Notice does not include any attachments. 1 TTABVUE (in Opp. No. 91219384); 26 TTABVUE 103 (in Opp. No. 91216909). Nonetheless, in my opinion, the Pakistani documents are in the record in all three cases based on the statements made by Ms. Dai in the other consolidated oppositions, as elaborated above.

Further, to say that specifically identified documents such as the notices of opposition are in the record but their attachments are not in the record in my view is an incorrect reading

this Board may give weight to an order from a foreign jurisdiction under appropriate circumstances. Accordingly, I would find that there exists a genuine dispute as to the effect to be accorded this injunction and whether it has been vacated as argued by Applicant or remains in effect and has a bearing on the disposition of this case. At the least I would suspend proceedings in light of this apparent ongoing civil action, pending further information as to its status.

In sum, for the above reasons, I would find that there are genuine disputes of material facts sufficient to deny the motion for summary judgment.

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of *Missouri Silver Pages* and the TBMP, which refer to non-specification of "documents," not attachments to any such documents. To hold otherwise would mean that while Applicant's submission of the Office Action that issued on 3/19/15 in Opposer's '807 application could be considered as part of the motion for summary judgment evidence, none of the attachments to that Action could be, because Applicant merely stated "See Exhibit I" and did not specify the attachments to Exhibit I. Such result appears contrary to the spirit of the evidentiary requirement that documents, not documents and any attachments thereto, be identified.