

**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

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Mailed: August 4, 2017

Opposition No. **91225722**

Steve Jackson Games Incorporated

v.

inXile Entertainment, Inc.

**Before Taylor, Masiello and Hightower,
Administrative Trademark Judges**

By the Board:

Pursuant to the Board's institution order of January 7, 2016, discovery in this matter closed on September 13, 2016, and Opposer's pretrial disclosures were due on October 28, 2016. On October 28, Opposer moved to amend the notice of opposition to add a claim of no bona fide intent to use the subject mark in commerce. On November 11, 2016, Opposer moved for summary judgment on its originally pleaded claim of priority and likelihood of confusion, its newly proposed claim of no bona fide intent, and on Applicant's affirmative defenses of unclean hands and abandonment. On November 15, 2016, the Board suspended this matter, including briefing on the summary judgment motion, pending disposition of Opposer's motion for leave to amend. On February 14, 2017, the Board granted

Opposer leave to amend the notice of opposition and resumed briefing on Opposer's motion for summary judgment. Briefing concluded on April 5, 2017.

This matter now comes up for disposition of Opposer's motion for summary judgment which has been fully briefed. The Board presumes the parties' familiarity with the issues herein. Therefore, for the sake of efficiency, this order will not summarize the parties' arguments raised in the briefs except as necessary.

Decision

A motion for summary judgment is a pretrial device intended to save the time and expense of a full trial when the moving party is able to demonstrate, prior to trial, that there is no genuine dispute of material fact, and that it is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(a); *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The evidence must be viewed in a light most favorable to the non-moving party, and all reasonable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA, supra*.

As a threshold matter, we find no genuine dispute of material fact that Opposer has standing to bring this opposition proceeding. In its amended notice of opposition, Opposer has pleaded the suspension of its own application¹ for AUTODUEL based on the application opposed herein which was cited as a potential bar to registration and has submitted a copy of the examining attorney's suspension

¹ Application Serial No. 86806802.

notice. *See Amended Notice of Opposition*, 5 TTABVUE 9; *Motion for Summary Judgment*, Declaration of Brandon M. Ress, Exhibit 48, 7 TTABVUE 123, 348. This is sufficient to demonstrate Opposer's standing. *See Life Zone Inc. v. Middleman Group, Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008).

As to the merits of Opposer's motion, we first consider Applicant's defense of abandonment. A showing of three consecutive years of non-use sets forth a *prima facie* case of abandonment; otherwise, a showing must be made of a period of non-use less than three years coupled with an intent not to resume use. *See Otto Int'l, Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007). As pleaded in its answer, Applicant alleges "that Opposer has abandoned any rights it may have had to the mark 'AUTODUEL.'" *Answer to Amended Notice of Opposition*, 13 TTABVUE 4. In other words, it is Applicant's position that Opposer has abandoned the AUTODUEL mark as to all of the goods upon which use of the mark is asserted.

However, upon consideration of the evidence submitted by the parties, we find on the record before us that Opposer has not abandoned its rights to the AUTODUEL mark vis-à-vis all of Opposer's asserted goods. In particular, Opposer submitted probative evidence that it has used the mark in commerce by offering for sale digital versions of Opposer's "Autoduel Quarterly" continuously since 2005. Although Applicant characterizes these digital offerings as mere efforts to "archive" or "warehouse" the print versions of these publications and contends that Opposer's making these back issues available in digital form "does not constitute the deliberate and continuous use that is required under trademark law," *Applicant's*

Opposition to Motion for Summary Judgment, 15 TTABVUE 4, we do not find such use to be so insignificant as to warrant a finding of abandonment. Applicant cites *Kusek v. Family Circle, Inc.*, 894 F. Supp. 522 (D. Mass. 1995), for the proposition that the availability of back magazine issues is a “nominal or residual use” that is too inconsequential to forestall a finding of abandonment. However, the circumstances in *Kusek* are distinguishable from those herein.

In *Kusek*, the mark at issue (“Speed Cooking”) was not utilized as the name of the periodical (“Family Circle”) and had appeared in only two issues six months apart and only as part of an article in the magazine. Back issues of the periodical (including those that did not contain the mark) were made generally available upon request “if available” rather than as part of any effort “to market the trademarked product” or any “ongoing program to exploit the mark.” *Id.* at 533. Moreover, the defendant publisher of the magazine made manifest its intention to abandon the disputed mark. *Id.* at 526.

Such circumstances are in contrast to those in this proceeding relating to the 2005 use asserted by Opposer. Here, the subject mark was displayed on the cover of the periodical as part of the title, and past issues of the periodical were made available for sale as a digital download on Opposer’s own retail website since 2005, with each issue having a separate product page, description and order button, which clearly reflect an affirmative effort on the part of Opposer to market and sell the goods under the mark. *See Motion for Summary Judgment*, Declaration of Phil Reed, ¶¶ 13-14 and 19-22, Exhibits 13 (confidential), 18-19, 7 TTABVUE 34, 36-37,

84-89. We do not consider this a residual use intended merely to wind down physical inventory of Opposer's periodicals on an "as requested" basis. *Cf. Oshman's Sporting Goods Inc. v. Highland Imp. Corp.*, 16 USPQ2d 1395, 1397 (TTAB 1990) (stating that the selling off of remaining inventory without intent to resume use is deemed abandonment).

Accordingly, we find an absence of a genuine dispute of material fact on Applicant's claim of abandonment as to all of the goods asserted by Opposer and therefore **GRANT** Opposer's motion for summary judgment on this defense.

As to Applicant's defense of unclean hands, Applicant has failed to allege any facts in support thereof. Since Applicant's pleading fails to provide adequate notice of the grounds therefor, the defense is insufficiently pleaded and is hereby **STRICKEN** from the answer. In view thereof, Opposer's motion for summary judgment is deemed **MOOT** as to this defense. *See Intermed Commc'ns, Inc. v. Chaney*, 197 USPQ 501, 503 n.2 (TTAB 1977) ("If a claim has not been properly pleaded, one cannot obtain summary judgment thereon.").

On the other hand, as to Opposer's claims of priority and likelihood of confusion and no bona fide intent to use, we find that Opposer has failed to demonstrate the absence of a genuine dispute of material fact for trial. Since Opposer relies on its common law use to support its claim of priority and likelihood of confusion, we find, at a minimum, genuine disputes of material fact concerning the goods for which Opposer can demonstrate priority, the relatedness of the parties' goods, the fame of Opposer's mark and whether there has been actual confusion in the marketplace.

We similarly find a genuine dispute as to whether Applicant had a bona fide intent to use its mark in commerce at the time it filed its application notwithstanding the lack of documentary evidence on the part of Applicant that pre-dates the application. *See Lane Ltd. v. Jackson Int'l Trading Co.*, 33 USPQ2d 1351, 1356 (TTAB 1994) (documentary evidence corroborating applicant's bona fide intent need only be sufficiently contemporaneous to filing of application and need not pre-date application filing date).

In view thereof, Opposer's motion for summary judgment on its asserted claims is hereby **DENIED**.² Proceedings are **RESUMED** and dates are **RESET** as follows:

Plaintiff's Pretrial Disclosures Due	8/18/2017
Plaintiff's 30-day Trial Period Ends	10/2/2017
Defendant's Pretrial Disclosures Due	10/17/2017
Defendant's 30-day Trial Period Ends	12/1/2017
Plaintiff's Rebuttal Disclosures Due	12/16/2017
Plaintiff's 15-day Rebuttal Period Ends	1/15/2018
Plaintiff's Opening Brief Due	3/16/2018
Defendant's Brief Due	4/15/2018
Plaintiff's Reply Brief Due	4/30/2018

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, matters

² The parties are reminded that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced during the appropriate trial period. *See, e.g., Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

in evidence, the manner and timing of taking testimony, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence.

Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).

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