

**UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451**

Greenbaum

Mailed: October 27, 2005

Cancellation No. 92043152

Cancellation No. 92043160

Cancellation No. 92043175

ARTURO SANTANA GALLEGO

v.

SANTANA'S GRILL, INC.

Before Hohein, Rogers and Zervas, Administrative Trademark Judges.

By the Board:

This case now comes up on the parties' cross-motions for summary judgment on the issues of likelihood of confusion, fraud, and ownership of the marks in the involved registrations, and on petitioner's motion to strike respondent's summary judgment motion as untimely. The parties have fully briefed the issues, and we have considered respondent's reply in support of its motion for summary judgment.<sup>1</sup>

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<sup>1</sup> The Board approves the parties' stipulation (filed March 15, 2005) to extend petitioner's time to respond to respondent's discovery requests, and for respondent to respond to petitioner's summary judgment motion. The Board has considered petitioner's Notice of Errata (filed March 9, 2005), in which petitioner addressed or "corrected" several statements made in the original summary judgment motion, in a successful effort to avoid a Rule 11 motion from respondent.

We turn first to petitioner's motion to strike respondent's summary judgment motion. As grounds therefor, petitioner erroneously contends that respondent's summary judgment motion is untimely because the deadline for filing such motions coincides with the close of discovery, and respondent filed the motion approximately two weeks thereafter. In fact, the motion is timely because it was filed before the first testimony period opened. See Trademark Rule 2.127(e)(1). Moreover, the parties' summary judgment motions are related in that they raise the same issues, albeit from opposite points of view. See Trademark Rule 2.127(d). In view thereof, petitioner's motion to strike respondent's summary judgment motion is denied.

We now turn to the parties' cross-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 each motion.

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material facts, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). 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

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favor. *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

As an initial point, we note that petitioner did not include a claim of priority and likelihood of confusion in the petition for cancellation. A party may not obtain summary judgment on an unpleaded claim. See Fed. R. Civ. P. 56(a) and 56(b); *S Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997). Accordingly, we will not further consider this claim.

Upon careful consideration of the arguments and evidence presented by the parties regarding the pleaded claims, and drawing all inferences with respect to each motion in favor of the nonmoving party, we find that neither party has demonstrated the absence of a genuine issue of material fact for trial. We find that there are genuine issues of material fact at least with respect to whether respondent owned the involved marks when it filed the subject applications, whether respondent currently is the owner of the involved marks, and whether respondent committed fraud on the PTO in the procurement of the involved registrations. In view thereof, the parties' cross-motions for summary judgment are denied, and proceedings are resumed.<sup>2</sup>

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<sup>2</sup> The parties should note that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for purposes of the motion. Any such evidence to be

We note that the nature of (1) petitioner's transfer of the restaurant located at 1480 Rosencrans Street, San Diego, California (Point Loma restaurant), to respondent's predecessor in interest in 1991, and specifically whether the transfer was a gift or sale, and what, if any, asset of the business petitioner retained, and (2) petitioner's sale of the restaurant located at 56547 29 Palms Highway, Yucca Valley, California (Yucca Valley restaurant), to Arturo Castenada in 1999, and what, if any, asset of the business petitioner retained, are integral to the resolution of the other issues herein. We further note that the issues of the transfer and/or sale of the two restaurants can be determined separately from the remaining issues in this case. Moreover, once the effects of the transfer and/or sale have been established, the parties can reassess their respective claims and defenses, and consider whether filing cross-motions for summary judgment, with stipulations of fact, would be an efficient way to resolve the issues without a trial.

For these reasons, we believe the issues regarding the transfer and/or sale of the Point Loma and Yucca Valley restaurants are particularly well suited to alternative

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considered at final hearing must be properly introduced during the appropriate trial period. *See, for example, Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

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dispute resolution (ADR).<sup>3</sup> Many district courts have local rules or programs that offer parties various alternatives to litigation. We recommend that the parties contact the court in which their civil action is pending to determine what options that district court may offer. Alternatively, the parties may wish to contact INTA (the International Trademark Association) at [www.inta.org/adr/](http://www.inta.org/adr/) and/or the American Arbitration Program at [www.adr.org](http://www.adr.org).

In view thereof, if the parties choose to utilize ADR to resolve these issues, the Board will suspend proceedings when the parties so notify the Board.

Inasmuch as the parties appear to have treated this proceeding as if it already included a claim of priority and likelihood of confusion, and to clarify the grounds for cancellation, petitioner is allowed until FORTY-FIVE days from the mailing date of this order to file an amended pleading that clearly alleges the grounds that were discussed in the cross-motions for summary judgment, but were not previously asserted in the original petition for cancellation, including a well pleaded claim of priority and likelihood of confusion, if applicable. Respondent is

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<sup>3</sup> If the parties pursue ADR to resolve the issue of the effect of the transfer and/or sale of the two restaurants, we encourage the parties to utilize ADR to resolve any other, or all, claims raised by this case and in their civil action.

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allowed until THIRTY DAYS after the date of service of the amended petition for cancellation to file an amended answer.

The parties must comply with the foregoing dates, and the trial schedule set forth below, unless they seek and are granted a suspension for ADR or settlement negotiations.

Trial dates are reset as follows:

DISCOVERY PERIOD TO CLOSE: **CLOSED**

Thirty-day testimony period for party in position of plaintiff to close: **March 30, 2006**

Thirty-day testimony period for party in position of defendant to close: **May 29, 2006**

Fifteen-day rebuttal testimony period to close: **July 13, 2006**

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