

**THIS DISPOSITION  
IS NOT PRECEDENT  
OF THE TTAB**

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

Lykos

Mailed: May 11, 2007

Cancellation No. 92044040

KARIN MODELS, S.A.R.L.

v.

BRUNEL, JEAN LUC

Before Bucher, Rogers, and Kuhlke, Administrative Trademark Judges.

By the Board:

This case now comes up for consideration of (1) petitioner's motion (filed March 16, 2006 by certificate of mailing) for summary judgment, and (2) respondent's cross-motion (filed April 17, 2006 by certificate of mailing) to compel which the Board construes as a motion to take discovery pursuant to Fed. R. Civ. P. 56(f).<sup>1</sup>

Petitioner has moved for summary judgment on claims of fraud, arguing that respondent submitted fraudulent

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<sup>1</sup> Respondent's consented motion (filed January 18, 2006) to extend the discovery and testimony periods in this case is granted. In accordance therewith, the discovery period in this case closed March 20, 2006.

assignments with the USPTO of the two registrations<sup>2</sup> at issue in this proceeding as well as fraudulent Section 8 and 15 affidavits. More specifically, petitioner contends that a third party, Models Management Group, Inc. ("MMG"), assigned the marks to petitioner on December 12, 1996 and petitioner granted MMG a license to use the marks in the assigned registrations.<sup>3</sup> Petitioner further alleges that in 2004, a person purportedly acting on behalf of MMG fraudulently executed assignments of the marks to respondent, and respondent recorded the assignments with the USPTO.<sup>4</sup> As relief, petitioner has requested cancellation of respondent's registrations or, alternatively, that petitioner's Section 8 and 15 declarations filed concurrently with its motion for summary judgment be accepted and deemed timely filed *nunc pro tunc* as of May 18, 2004. As a final alternate basis for relief, petitioner has requested that the Board withdraw the assignments wrongfully

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<sup>2</sup> Registration No. 2114051, registered November 18, 1997, Sections 8 and 15 affidavits, acknowledged and accepted on July 12, 2004, and Registration No. 2115957, registered November 25, 1997, Sections 8 and 15 affidavits, acknowledged and accepted on June 25, 2004.

<sup>3</sup> Recordation thereof at Reel 1563, Frames 0132 and 0141 of the Assignment Division of the USPTO.

<sup>4</sup> Recordation thereof at Reel 2778, Frame 0231.

recorded by respondent, which we consider as a request that the assignments be expunged from USPTO records.<sup>5</sup>

Respondent, in lieu of filing a responsive brief to petitioner's motion for summary judgment, filed a cross-motion to compel responses to respondent's first set of interrogatories and first set of requests for production of documents and things. Respondent maintains that petitioner's motion for summary judgment is "premature," given that petitioner had yet to respond to respondent's outstanding discovery requests.<sup>6</sup> As per the parties' agreement, the responses thereto were not due until a date after both the filing of petitioner's motion for summary judgment, and the close of discovery. Respondent also maintains that the parties had tentatively agreed to take the oral discovery deposition of Mr. Etienne de Roys in the

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<sup>5</sup> The Board lacks the authority to grant as relief in this proceeding respondent's requests that petitioner's Section 8 and 15 declarations be deemed timely filed *nunc pro tunc* and the assignments be expunged from USPTO records. Such requests fall within the purview of respectively, Post Registration and the Assignment Division of the USPTO. These requests are evocative of a claim under Section 18 seeking a determination of ownership. As highlighted by the Board in *Sigrune Marlene Chapman v. Mill Valley Cotton*, 17 USPQ2d 1414, fn.2 (TTAB 1990), citing the United States Trademark Association's Trademark Review Commission Report and Recommendations, the purpose of amending Section 18 was to grant to the Board the "statutory authority to determine trademark ownership rights where they are at variance with the register." Petitioner, however, has not pleaded such a claim.

<sup>6</sup> The due dates for petitioner to respond to respondent's first set of document production requests and first set of interrogatories were March 29, 2006, and March 31, 2006, respectively.

United States (the principal of petitioner who resides in France), and that his deposition is crucial to defending against petitioner's motion for summary judgment.

Shortly thereafter, on May 8, 2006, petitioner filed responses to respondent's first set of interrogatories and first set of requests for production of documents and things. On this basis, petitioner contends that respondent's motion to compel is moot, and that respondent should now be ordered to file a responsive brief to petitioner's motion for summary judgment.<sup>7</sup>

Respondent filed a response thereto on May 22, 2006, challenging the completeness of many of petitioner's discovery responses, and reiterating the necessity of deposing Mr. Etienne de Roys.

The Board first considers petitioner's motion for summary judgment. Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of

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<sup>7</sup> Petitioner also contends that it should not be deemed to have waived its objections to respondent's discovery requests. Although petitioner's responses were served after the due date, because of the filing of petitioner's motion for summary judgment and respondent's motion to compel, the responses are not considered late. For this reason, petitioner is not deemed to have automatically waived its right to object to respondent's discovery requests.

demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548 (1986). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely-disputed facts that must be resolved at trial.

We find that petitioner, as the moving party for summary judgment, has failed to meet its burden of demonstrating that there are no genuine issues of material fact regarding its allegations of fraud. In support of its motion for summary judgment, petitioner submitted the declaration of Mr. Etienne de Roys, essentially authenticating as true copies the documents attached thereto, namely (1) copies of the December 12, 1996 assignment of the marks from MMG to petitioner and the

license back agreement, and (2) the assignment records of the USPTO regarding both sets of recorded assignments. This evidence falls short of that which would be necessary to allow entry of summary judgment. While the assignment records of the USPTO do show two distinct assignments of each of the involved registrations,<sup>8</sup> this evidence alone does not mean that it is undisputed that the second assignment of the registrations at issue was fraudulent, and by logical extension, that the Section 8 and 15 declarations are fraudulent. We also note that even if the second set of assignments is eventually shown to have been a fraudulent conveyance by the assignor, it does not necessarily follow that the assignee was aware of the impropriety of the conveyance and that the subsequent recordation was therefore a fraud on the USPTO.

Accordingly, petitioner's motion for summary judgment is denied.<sup>9</sup>

In light of our denial of petitioner's motion for summary judgment, respondent's constructive motion under

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<sup>8</sup> According to the assignment history of the two registrations, the first assignment took place from MMG to petitioner, with the subsequent assignment of the mark from MMG to respondent.

<sup>9</sup> The parties should note that all evidence submitted in support of and in opposition to the motion for summary judgment is of record only for consideration of said motion. Any such evidence to be considered in final hearing must be properly introduced in evidence during the appropriate trial periods. See *Levi Strauss & Co. v. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); and *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983).

Rule 56(f) is denied as moot.<sup>10</sup>

Lastly, we note that embedded in respondent's reply brief filed May 22, 2006 is an alternative request to reopen discovery by 120 days. Because the request was not separately filed or captioned and may have been overlooked, petitioner is allowed until twenty (20) days from the mailing date of this order to respond to respondent's request to reopen the discovery period in this case, failing which it will be granted as conceded.

Proceedings are otherwise suspended pending possible response by petitioner, failing which proceedings will be resumed and necessary deadlines, including time for discovery, will be reset.

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<sup>10</sup> Notwithstanding that we considered respondent's motion to compel as a motion under Rule 56(f), we note that respondent failed to comply with the formal requirements set forth in Rule 56(f), namely, that such a request must be supported by an affidavit showing that the nonmoving party cannot present by affidavit facts essential to justify its opposition to the motion for summary judgment. See Fed. R. Civ. P. 56(f); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Keebler Co. v. Murray Bakery Products*, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989).

Alternatively, if we were to treat respondent's motion as a motion to compel, it would be denied. Respondent's motion is completely devoid of any statement that it attempted to make a good faith effort to resolve the discovery dispute herein prior to seeking the Board's intervention. See Trademark Rule 2.120(e). Further, a motion to compel is neither a proper response to nor germane to a motion for summary judgment.