

**THIS OPINION IS NOT
A PRECEDENT OF
THE T.T.A.B.**

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

WINTER

Mailed: March 13, 2008

Cancellation No. 92047262

Roast of the Town, Inc.

v.

The Smith Agency, Ltd.

**Before Bucher, Zervas and Wellington,
Administrative Trademark Judges.**

By the Board:

This case now comes up on petitioner's fully briefed motion (filed August 6, 2007) for summary judgment in its favor on its claims of priority and likelihood of confusion.

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 demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986). Additionally, the

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evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993).

As a preliminary matter, we note that respondent argues that there are material facts in dispute that need to be resolved by discovery, such as by deposition of petitioner's employees and its former trademark counsel. To the extent that respondent is seeking discovery under Fed. R. Civ. P. 56(f), such motion is denied because it is not properly supported. *Sweat Fashions Inc. v. Pannill Knitting Co.*, 83 F.2d 1560, 4 USPQ2d 1793, 1799 (Fed. Cir. 1987) (mere assertion in brief of need for discovery insufficient). See also TBMP § 528.06 (2d ed. rev. 2004).

Turning to petitioner's motion for summary judgment, based on our review of the evidence¹ and arguments² submitted

¹ In reviewing the record in association with the motion, the Board noted that page 4 of the declaration of Hannah Romberg was missing from the electronic records of this proceeding. Petitioner's counsel has advised the Board that respondent's counsel was served with a complete copy of the declaration on August 6, 2007 (in accordance with the certificate of service with the motion) and has provided the Board with a facsimile copy of the missing page.

² We note respondent's assertion that the cancellation of petitioner's registration (U.S. Reg. No. 1601195) and abandonment of its application Serial No. 76494546 "has caused the mark to become abandoned" (respondent's brief, page 4). Respondent is advised that there is a distinction between the expiration of a

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by the parties, we find that, at a minimum, there are genuine issues as to the similarity of the marks and as to the strength of petitioner's mark.³ Accordingly, petitioner's motion for summary judgment is **denied**.⁴

Proceedings are **resumed**. Discovery and trial dates are reset as shown in the following calendar:

DISCOVERY PERIOD TO CLOSE:	May 14, 2008
Thirty-day testimony period for party in position of plaintiff to close:	August 12, 2008
Thirty-day testimony period for party in position of defendant to close:	October 11, 2008
Fifteen-day rebuttal testimony period to close:	November 25, 2008

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**

registration/abandonment of an application, and the abandonment of the trademark itself.

³ Although we have mentioned two genuine issues of material fact in this decision that is not to say that these are the only issues of material facts in dispute.

⁴ The parties should note 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 in evidence during the appropriate trial period. See, e.g., *Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993). See TBMP § 528.05(a) (2d ed. rev. 2004).

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after completion of the taking of testimony. See Trademark Rule 2.125, 37 C.F.R. §2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b), 37 C.F.R. §§2.125(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. §2.129.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>