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

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

MBA

Mailed: December 18, 2008

Cancellation No. 92047581

Actibiol, S.A.

v.

Mor-Nutech, Inc.

Before Grendel, Mermelstein and Ritchie, Administrative Trademark Judges

By the Board:

Mor-Nutech, Inc. ("respondent") owns a registration of the mark CAPSOL-T, in standard characters, for "nutritional supplement" (the "Registration").[1] Actibiol, S.A. ("petitioner") seeks to cancel the Registration alleging in its petition for cancellation that: (1) respondent's mark is likely to cause confusion with petitioner's alleged mark CAPSIBIOL-T, and that petitioner has priority of use; (2) respondent's predecessors in interest committed fraud when they stated in the application which matured into the Registration that "no other person … has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when

[1] Registration No. 3149821, issued September 26, 2006, based on an alleged date of first use in commerce of June 5, 2006.

used on or in connection with the goods/services of such other person, to cause confusion …;" (3) respondent's predecessors in interest committed fraud by claiming in the application which matured into the Registration that they had a bona fide intention to use the mark; (4) the statement of use of respondent's mark was "invalid;" and (5) respondent's predecessors in interest assigned the intent to use application which matured into the Registration in violation of 15 U.S.C. § 1060(a)(1). Respondent denies the salient allegations in the petition for cancellation and raises several affirmative defenses.

This case now comes up for consideration of: (1) petitioner's motion, filed December 20, 2007, for summary judgment on its claims that the statement of use was "invalid" and the application was improperly assigned; (2) respondent's cross-motion, filed January 24, 2008, for summary judgment in its favor on its affirmative defense that petitioner lacks standing; and (3) respondent's motion, filed September 9, 2008, to suspend this proceeding in favor of related Opposition No. 91179324. Each of the parties' motions is fully briefed and ready for decision.

Turning first to respondent's motion to suspend, respondent alleges that if it prevails in the related opposition proceeding, "then the request for cancellation of the mark 'Capsol-T' has no viable basis for objection." In

fact, however, as petitioner points out, "the final determination in Opposition No. 91179324 will not have a bearing on the issues raised in [petitioner's] pending motion for summary judgment in this proceeding." Furthermore, in its order of November 14, 2008, the Board suspended the related opposition proceeding pending a ruling on the parties' cross-motions in this proceeding. Accordingly, respondent's motion for suspension is **DENIED**.

Turning next to the cross-motions for summary judgment, summary judgment is only appropriate where there are no genuine issues of material fact in dispute, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(c). The party seeking summary judgment bears the initial burden of demonstrating the absence of any genuine issue of material fact. See, Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986); Sweats Fashions, Inc. v. Pannill Knitting Co. Inc., 833 F.2d 1560, 1563, 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, 850, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); Olde Tyme Foods, Inc. v. Roundy's, Inc., 961 F.2d 200, 202, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

The evidence on summary judgment must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. Lloyd's Food Products, Inc. v. Eli's, Inc., 987 F.2d 766, 767, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); Opryland USA, supra. The Board may not resolve issues of material fact; it may only ascertain whether issues of material fact exist. See, Lloyd's Food Products, 987 F.2d at 766, 25 USPQ2d at 2029; Olde Tyme Foods, 961 F.2d at 200, 22 USPQ2d at 1542.

On the record presented, we find that there are many genuine issues of material fact which preclude summary judgment in either party's favor. Accordingly, petitioner's motion and respondent's cross-motion are both **DENIED**.[2]

Proceedings herein are resumed. Discovery and trial dates are reset as follows:

Discovery Period to Close:	May 17, 2008
30-day testimony period for party in position of plaintiff to close:	August 15, 2008
30-day testimony period for party in position of defendant to close:	October 14, 2009
15-day rebuttal testimony period to close:	November 28, 2009

[2] The parties should note that the evidence submitted in connection with the motions for summary judgment is of record only for consideration of those motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See, Levi Strauss & Co. v. R. Josephs Sportswear Inc., 28 USPQ2d 1464 (TTAB 1993); Pet Inc. v. Bassetti, 219 USPQ 911 (TTAB (1993); American Meat Institute v. Horace W. Longacre, Inc., 211 USPQ 712 (TTAB 1981).

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

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