

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

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Mailed: September 26, 2013

Cancellation No. 92051170

O2Micro International Limited

v.

O2 Holdings Limited

**Before Bucher, Ritchie, and Kuczma,
Administrative Trademark Judges.**

By the Board:

Petitioner seeks to cancel respondent's registration¹ for the mark O2 for "computer hardware and computer operating system software, and instructional manuals therefor sold as a unit therewith" in International Class 9. As grounds for cancellation, petitioner alleges that respondent committed fraud on the Office when it submitted its Combined Declaration of Use in Commerce & Application for Renewal Registration of a Mark under Sections 8 & 9, and that the mark has been abandoned.

Respondent denied the salient allegations in its answer.

This case now comes up for consideration of petitioner's motion (filed on July 3, 2013) for summary judgment on the grounds that the involved registration was abandoned through

¹U.S. Registration No. 2231093, issued March 9, 1999; renewed.

nonuse, that even if it was not abandoned respondent engaged in naked and uncontrolled licensing of the mark resulting in abandonment, and that respondent committed fraud on the Office when it filed its Combined Declaration of Use in Commerce & Application for Renewal Registration of a Mark under Sections 8 & 9 on March 9, 2009. The motion is fully briefed.

Summary judgment is only appropriate when there is no genuine dispute as to any material fact and the moving party is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(a). The Board may not resolve issues of material fact; it may only ascertain whether a genuine dispute regarding a material fact exists. See *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Old Tyme Foods, Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1542. 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. *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc.*, 22 USPQ2d at 1544.

After reviewing the arguments and supporting evidence, we conclude that disposition of this matter by summary judgment is not appropriate with respect to petitioner's abandonment claim because, at a minimum, genuine disputes of material

fact exist as to respondent's continuous use of its mark and whether respondent engaged in naked licensing of its involved mark. As to the fraud claim, genuine disputes of material fact exist with respect to respondent's intent at the time it filed its combined declaration under Sections 8 & 9 and whether respondent was and is using the mark for the goods identified in the subject registration.²

Accordingly, petitioner's motion for summary judgment on the claims of abandonment and fraud is denied.³

Proceedings are resumed. Dates in this proceeding are reset as follows:

Discovery Closes	11/29/2013
Plaintiff's Pretrial Disclosures	1/13/2014
Plaintiff's 30-day Trial Period Ends	2/27/2014
Defendant's Pretrial Disclosures	3/14/2014
Defendant's 30-day Trial Period Ends	4/28/2014
Plaintiff's Rebuttal Disclosures	5/13/2014
Plaintiff's 15-day Rebuttal Period Ends	6/12/2014

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 of completion of the taking of testimony. Trademark Rule 2.125.

² The fact that we have identified and discussed only a few genuine disputes of material fact as a sufficient basis for denying the motion for summary judgment should not be construed as a finding that these are necessarily the only disputes which remain for trial.

³ The parties should note that the evidence submitted in connection with the motions for summary judgment is of record only for consideration of the 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).

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.