

Goodman

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

Mailed: October 25, 2011

Cancellation No. 92052238

Marie Claire Album, S.A.

v.

Bata Brands S.A.R.L.  
Luxembourg, Succursale de  
Lausanne

Before Bucher, Kuhlke and Taylor, Administrative Trademark  
Judges.

By the Board:

Marie Claire Album, S.A. (petitioner) seeks to cancel the registration owned by Bata Brands S.A.R.L. Luxembourg, Succursale de Lausanne, (respondent) for the mark MARIE CLAIRE for "women's boots, shoes and sandals"<sup>1</sup> on the grounds of abandonment for three years nonuse with no intent to resume use, and for fraud in maintenance of the registration. Respondent, in its answer, has denied the essential allegations of the petition to cancel and pleaded certain affirmative defenses, including the defense of contractual estoppel.

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<sup>1</sup> Registration No. 838440, issued November 7, 1967, second renewal May 14, 2008.

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This case now comes up on petitioner's motion for summary judgment on the abandonment ground and respondent's cross-motion for summary judgment on the affirmative defense of contractual estoppel.<sup>2</sup>

A party is entitled to summary judgment when it has demonstrated that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). In reviewing a motion for summary judgment, the evidentiary record and all reasonable inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the nonmoving party. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could

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<sup>2</sup> It appears that the parties agreed to e-mail service. Both parties used service by e-mail for serving the motion/response, and respondent's certificate of service includes the statement that the response was "served . . . by email as per the parties' agreement." Respondent's response to the motion for summary judgment and cross-motion is untimely as it was filed 35 days (rather than 30 days) after the e-mail service of the motion for summary judgment. Nonetheless, in view of the potentially dispositive nature of petitioner's motion and respondent's cross motion on the affirmative defense, we have exercised our discretion and considered respondent's filing in its entirety. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1734 n. 2 (TTAB 2001) (exercising discretion and considering untimely response and cross-motion for summary judgment in view of the potentially dispositive nature of both opposer's motion and applicant's cross-motion on the affirmative defense); *Trek Bicycle Corp. v. Fier*, 56 USPQ2d 1527, 1528 (TTAB 2000) (considering untimely cross-motion and response for summary judgment in view of Board policy to resolve cases on their merits as well as minimal delay in filing response to motion).

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decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

We first consider whether entry of summary judgment is appropriate on the ground of contractual estoppel. See *Chromalloy American Corporation v. Kenneth Gordon (New Orleans), Ltd.*, 736 F.2d 694, 222 USPQ 187 (Fed. Cir. 1984).

The parties were involved in Cancellation No. 92014624 filed by petitioner on December 10, 1984, based on likelihood of confusion. The parties settled the cancellation by entering into a consent agreement, and the cancellation proceeding was dismissed on September 8, 1986. The parties' 1986 consent agreement provides in relevant part that:

2. Bata agrees that it shall not use the mark MARIE CLAIRE on or in connection with any goods other than men's, women's, and children's boots, shoes and sandals, or any other kind of variety of footwear (except hosiery) without the authorization of Marie Claire Album.
4. Marie Claire Album consents to the use or registration by Bata in the United States of the mark MARIE CLAIRE on or in connection with its goods, so long as such use is in accord with paragraph 2, above.
6. Marie Claire shall withdraw cancellation No. 14,624 upon the signing of the agreement, and shall not attempt to reinstitute cancellation proceedings based on the same set of facts alleged at the time of filing that petition.
9. This agreement shall remain in full force and effect so long as either party or any licensee or assignee continues to use the mark MARIE CLAIRE, or any registration of the mark by either party or a licensee

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or assignee remains in effect, or any new application for the mark is pending or has been approved.

The issue of whether petitioner is contractually barred from cancelling respondent's MARIE CLAIRE registration clearly falls within the jurisdiction of the Board. Cf. *Kimberly-Clark Corp. v. Fort Howard Paper Co.*, 772 F.2d 860, 227 USPQ 36 (Fed. Cir. 1985) (Board has jurisdiction to consider whether an agreement between the parties constitutes an independent basis for sustaining the opposition). The Board can give effect to a settlement agreement to the extent that the agreement is relevant to issues properly before the Board. See *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983).

As explained below, this case presents issues squarely within the parameters of the settlement agreement. The construction of an agreement is a question of law, and the meaning and interpretation of a contract may be resolved by the Board on summary judgment. See *Interstate Gen. Gov't Contractors, Inc. v. Stone*, 980 F.2d 1433 (Fed. Cir. 1992). As an initial matter, we note that the parties' settlement agreement lacks a choice of law clause. We therefore must apply general principles of contract interpretation. In interpreting contracts, "unless a different intention is manifested, ... where language has a generally prevailing meaning, it is interpreted in accordance with that meaning."

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See Restatement (Second) of Contracts, Section 202(3)(a) (1981). Thus, the interpretation of an agreement must be based, not on the subjective intention of the parties, but on the objective words of their agreement. See *Novamedix Ltd. v. NDM Acquisition Corp.*, 166 F.3d 1177, 49 USPQ2d 1613 (Fed. Cir. 1999).

Respondent argues that under paragraph 9 of the parties' agreement, petitioner is contractually estopped from seeking cancellation of the mark because the MARIE CLAIRE registration is still in effect ("only one condition needs to be true for the agreement to remain in effect" under paragraph 9) and therefore petitioner has no standing to petition to cancel the MARIE CLAIRE mark.

Petitioner argues, on the other hand, that paragraph 9 requires that the registration be "effective" and petitioner has established that respondent has abandoned the mark. Petitioner further argues that respondent's interpretation of paragraph 9 of the parties' agreement "violates public policy" and is "inconsistent with the plain meaning of the 1986 Agreement." Petitioner further argues that paragraph 6 "contemplates that future cancellation proceedings can be brought" on different facts than the earlier cancellation proceeding, and in this case the cancellation proceeding is based on different facts.

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After careful consideration of the parties' arguments and supporting papers, we hold that petitioner is contractually estopped from bringing the instant cancellation proceeding. See *Danskin, Inc. v. Dan River*, 498 F2d. 1386 Inc., 182 USPQ 370 (CCPA 1974) (affirming granting of summary judgment dismissing the opposition due to the terms of the parties' settlement agreement).

Under the plain terms of the agreement, petitioner consents "to use **or** registration" of MARIE CLAIRE in connection with "men's, women's, and children's boots, shoes and sandals, or any other kind of variety of footwear (except hosiery)" (paragraph 4) so long as respondent (or its assignee or licensee) "continues to use" MARIE CLAIRE or "any registration [for MARIE CLAIRE] remains in effect" (paragraph 9). The terms in paragraph 4 regarding use *or* registration are mirrored in paragraph 9--that is--the consent agreement provides petitioner's consent to respondent's use of MARIE CLAIRE *or* respondent's registration of MARIE CLAIRE. Thus the conditions of the agreement are met by either respondent's continued use of *or* respondent's maintenance of a registration of MARIE CLARE on *or* in connection with "men's, women's, and children's boots, shoes and sandals, or any other kind of variety of footwear (except hosiery)." The terms in paragraph 9 with regard to registration simply require that the MARIE CLAIRE

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registration remain in registered-renewed (rather than expired) status. We also read paragraph 6 as an agreement by petitioner that it will not seek to relitigate the issues resolved by the consent agreement, not a provision that contemplates future cancellation proceedings.

We therefore find as a matter of law that petitioner is contractually estopped from petitioning to cancel respondent's MARIE CLAIRE registration for "women's boots, shoes and sandals" in view of the parties' consent agreement and the involved registration's renewed status.

In view thereof, respondent's cross-motion for summary judgment is granted, and petitioner's motion for summary judgment is denied. Judgment is entered against petitioner, and this proceeding is dismissed with prejudice.