

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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

WINTER

Mailed: August 8, 2013

**Opposition No. 91205340 (parent)
Cancellation No. 92055201**

Plentyoffish Media, Inc.

v.

Miguel A. Maya

**Before Cataldo, Wolfson, and Greenbaum,
Administrative Trademark Judges.**

By the Board:

These consolidated cases now come up for consideration of the motion for partial summary judgment filed April 3, 2013, by opposer/petitioner (hereafter "POF") on its claim of priority and likelihood of confusion.¹

Preliminary Matters

In considering the pleadings, we note that POF's dilution and fraud claims in both proceedings are insufficiently pleaded. Specifically, in regard to the dilution claim (opposition, ¶12; petition, ¶11), POF fails to allege with respect to the Section 1(a) application for the opposed mark that POF's marks became famous prior to the date of first use of applicant/respondent's (hereafter "Maya")

¹ POF's claims of descriptiveness, non-use, abandonment, fraud, and dilution are not the subject of the instant motion.

mark or the filing date of said application and, with respect to the Section 1(b) application underlying the registration sought to be cancelled, that POF's marks became famous prior to the filing date of that application. See *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164, 1174 and 1174 n.9 (TTAB 2001) (To properly assert a ground of dilution, a plaintiff must plead that its mark became famous prior to the applicant's filing date and/or date of first use of the mark).

With regard to POF's fraud claims (opp. ¶¶ 19-21; canc. ¶¶ 18-20), POF has failed to allege how the asserted fraudulent statement was material to the approval and registration of Maya's marks. See *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009); *Standard Knitting, Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917 (TTAB 2006) (fraud found based on misrepresentation regarding use of the mark on goods identified in the filed applications); *First Int'l Services Corp. v. Chuckles Inc.*, 5 USPQ2d 1628 (TTAB 1988) (fraud found in applicant's filing of application with verified statement that the mark was in use on a range of personal care products when applicant knew it was in use only on shampoo and hair setting lotion).

In view of the foregoing, POF is allowed until **TWENTY DAYS** from the mailing date of this order to submit (separately, in each proceeding) amended pleadings with sufficient dilution and fraud claims, failing which said

claims shall be considered to be stricken. See Fed. R. Civ. P. 12(f).

Should POF file amended pleadings, Maya is allowed until **FORTY DAYS** from the mailing date of this order to submit an amended answer in each proceeding. In that regard, we also note that Maya failed to answer the allegations in the petition for cancellation numbered 1-6, but instead responded to the allegations only in paragraphs 7-27 of the petition. In view thereof, Maya is deemed to have denied paragraphs 1-6 as set forth in the petition for cancellation. However, should POF file amended pleadings, Maya is instructed to answer every allegation in each pleading without exception. See Trademark Rules 2.106(b)(1) and 2.114(b)(1).

Motion for Summary Judgment

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute with respect to any material fact, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c)(1). A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute as to a material fact, and that it is entitled to judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 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, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

Additionally, the evidence of record and all justifiable inferences that may be drawn from the undisputed facts must be viewed in the light most favorable to the non-moving party. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and *Opryland USA*, 23 USPQ2d at 1472. Further, in considering whether summary judgment is appropriate, the Board may not resolve genuine disputes as to material facts and, based thereon, decide the merits of the opposition. Rather, the Board may only ascertain whether any material fact cannot be disputed or is genuinely disputed. See *Lloyd's Food Products*, 25 USPQ2d at 2029; and *Olde Tyme Foods* 22 USPQ2d at 1542.

Based on our review of the arguments and evidence submitted by the parties, and drawing all inferences in favor of Maya, the non-movant, we find that, at a minimum, there is a genuine dispute as to material facts related to the similarity of the parties' marks, the relatedness of the

parties' services, and as to whether Maya chose his marks in bad faith.²

Accordingly, POF's motion for partial summary judgment on its claim of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), is **denied**.³

Proceeding Resumed; Trial Dates Reset

These consolidated proceedings are **resumed**. Trial dates are reset as shown in the following schedule:

Plaintiff's Pretrial Disclosures Due	9/23/2013
Plaintiff's 30-day Trial Period Ends	11/7/2013
Defendant's Pretrial Disclosures Due	11/22/2013
Defendant's 30-day Trial Period Ends	1/6/2014
Plaintiff's Rebuttal Disclosures Due	1/21/2014
Plaintiff's 15-day Rebuttal Period Ends	2/20/2014

² The fact that we have identified only a few material facts that are genuinely in dispute as a sufficient basis for denying the motion for summary judgment should not be construed as a finding that these are necessarily the only issues which remain for trial.

³ The parties are reminded that, absent the parties' stipulation that the evidence submitted in connection with POF's motion for summary judgment is to be considered of record for trial, said evidence is of record only for consideration of the motion for summary judgment. See TBMP § 501 (3d ed. rev.2 2013) and authorities cited therein. See also TBMP § 702.04(d). Any such evidence to be considered at final hearing must be properly introduced in evidence during their appropriate trial periods. See *Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

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** 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 Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(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.

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