

THIS DECISION 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

GCP

Mailed: March 31, 2014

Cancellation No. 92055269

Mango's Tropical Cafe, Inc.

v.

Tango Mango, Inc.

**Before Taylor, Wellington, and Ritchie,  
Administrative Trademark Judges.**

**By the Board:**

Tango Mango, Inc. (“respondent”) is the owner of the registration for the mark TANGO MANGO, in standard characters, for “carry-out restaurants; restaurant services; restaurants; take-out restaurant services” in International Class 43.<sup>1</sup>

Mango’s Tropical Cafe, Inc. (“petitioner”) has petitioned to cancel respondent’s registered TANGO MANGO mark on the following grounds: (1) priority and likelihood of confusion, and (2) abandonment through non-use

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<sup>1</sup> Registration No. 3328822, registered on November 6, 2007, claiming July 25, 2005 as both the date of first use and the date of first use in commerce. Section 8 affidavit accepted on November 6, 2013.

via an invalid assignment. In support of its amended petition to cancel,<sup>2</sup> petitioner pleads ownership of the following registered marks:



1. <sup>3</sup>



2. <sup>4</sup>

3. MANGO'S, in standard characters,<sup>5</sup> and

4. MANGO'S TROPICAL CAFE, in standard characters.<sup>6</sup>

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<sup>2</sup> Petitioner filed, on June 26, 2013, a motion for leave to file an amended petition for cancellation, including its amended petition for cancellation (1) adding two registrations to the five registrations it initially pleaded, (2) adding a claim of abandonment through non-use, and (3) deleting its claim of dilution. The motion was subsequently granted by the Board on August 16, 2013, and the petition for cancellation, as amended, became petitioner's operative pleading.

<sup>3</sup> Registration No. 3108906 (issued June 27, 2006, for "restaurant and bar services," in International Class 43).

<sup>4</sup> Registration Nos. 3284057 (issued August 28, 2007, for "restaurant and bar services," in International Class 42); 3512984 (issued October 7, 2008, for "[p]repackaged foods, namely, entrees consisting primarily of poultry," in International Class 29, and "[c]omputer services, namely, providing a website featuring entertainment information ...," in International Class 41); 3649192 (issued July 7, 2009, for "metal key chains," in International Class 6, "postcards, greeting cards, calendars and pens," in International Class 16, "towels," in International Class 24, "bottled drinking water," in International Class 32, and "smoker's articles ...," in International Class 34); and 3700648 (issued October 27, 2009, for "[c]lothing, namely, infant's and children's underwear and bodysuits, t-shirts, sweatshirts, pants, sweatpants, shorts, tank-tops, halter tops, hats, jackets, shirts and sleepwear," in International Class 25).

<sup>5</sup> Registration No. 4190731 (issued August 14, 2012, for "nightclub services," in International Class 41, and "restaurant and bar services," in International Class 43).

Petitioner alleges that the continued registration of respondent's mark would damage petitioner in that respondent's mark so resembles petitioner's pleaded MANGO marks as to be likely to cause the public to be confused, mistaken, or deceived into believing that respondent's services originate from petitioner or are in some way related to, associated with, or sponsored by petitioner. Petitioner also alleges that respondent has abandoned its mark through non-use due to an invalid assignment of the mark.

Respondent, in its answer to the amended petition to cancel, denied the salient allegations asserted therein, and asserted various "affirmative defenses," as more fully discussed, *infra*.

Now before the Board is petitioner's motion for summary judgment on its likelihood of confusion and abandonment claims, filed October 22, 2013; and respondent's cross-motion for summary judgment on the ground that its mark is not confusingly similar to petitioner's pleaded marks and that it has not abandoned its mark, filed November 26, 2013, in conjunction with its response to petitioner's motion. The parties' respective motions for summary judgment are fully briefed.

Petitioner, by its motion, asserts, among other things, that its use of its pleaded marks predates respondent's use of its similar mark, that petitioner's marks have attained fame, that the services offered by respondent are legally identical to services offered by petitioner, and that there is a likelihood of

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<sup>6</sup> Registration No. 4224643 (issued October 12, 2012, for "nightclub services," in International Class 41, and "restaurant and bar services," in International Class 43).

confusion between petitioner's "family" of MANGO'S trademarks, on the one hand, and respondent's TANGO MANGO mark, on the other.<sup>7</sup>

Additionally, petitioner contends that respondent has abandoned its subject mark through non-use because of an invalid assignment of the mark. Specifically, petitioner maintains that prior to the issuance of the subject registration, the underlying application, which was filed by an entity named Tango Mango, Inc., was assigned by a different entity identified as Tango Mango, LLC to Knightspin LLC which was eventually assigned back to Tango Mango, LLC via a *nunc pro tunc* assignment. Petitioner argues, however, that Tango Mango, LLC is a nonexistent entity and, therefore, could not assign the respondent's underlying application to Knightspin, LLC nor could Knightspin, LLC assign back the mark to a nonexistent entity. Furthermore, petitioner argues that the identification of Tango Mango, LLC in the two aforementioned assignment transactions is not a mere error or mistake that can be cured. In view of the foregoing, petitioner contends that there is no genuine dispute of material fact that respondent has abandoned through an invalid assignment.

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<sup>7</sup> It is unclear whether petitioner intends to assert a "family of marks" theory for its likelihood of confusion claim. However, this theory would present an unpleaded issue, which is inappropriate for consideration in connection with a motion for summary judgment and will be given no consideration. See Fed. R. Civ. P. 56(a); *Asian and Western Classics B.V. v. Lynne Selkow*, 92 USPQ2d 1478, 1480 (TTAB 2009); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1528 n. 3 (TTAB 2008).

In support of its motion, petitioner submitted the declaration of its chief operating officer, Joshua Wallack, which included as exhibits the following: (1) website printouts from petitioner's website showing actual use of petitioner's pleaded marks in connection with its restaurant, bar, and nightclub services, as well as on apparel and other merchandise; (3) several flyers for events taking place at petitioner's establishment; articles from various outlets announcing the opening of petitioner's second location in Orlando, Florida, and discussing petitioner's restaurant, nightclub and bar services; a list by Technomic, Inc. of the purported "Top 100" nightclubs and bars in the United States in 2013, listing petitioner as number ten; (4) status and title copies of petitioner's pleaded registrations downloaded from the USPTO's electronic database; (5) respondent's supplemental responses to petitioner's first set of interrogatories; and (6) respondent's responses to petitioner's first set of requests for admission.

In the declaration, Mr. Wallack declares that "due to the substantial success of Mango's restaurant and bar services, Mango's has received extensive unsolicited publicity and media coverage of its establishment," and that over the past 20 years petitioner's use of its mark has "resulted in tens of millions of dollars in sales and customers." *Id.*, ¶¶ 9 and 14. Petitioner also asserts that through this garnered fame, "Mango's has been successful in educating the public to associate the MANGO'S Marks with Mango's bar and restaurant services." *Id.*, ¶ 13.

Respondent contests petitioner's motion, and alternatively asserts that summary judgment should be entered in its favor based upon a finding that petitioner's pleaded marks are weak, as they are a part of a crowded field of MANGO-formative marks, that the parties' respective marks are dissimilar in appearance and connotation, that the actual services provided by petitioner are distinctly different than those provided by respondent, that petitioner has not established fame of its pleaded marks, and therefore, there is no likelihood of confusion between respondent's TANGO MANGO mark and petitioner's pleaded marks.

With regard to petitioner's abandonment claim, respondent contends that the misidentification of Tango Mango, LLC as the assignor in the assignment of respondent's underlying application to Knightspin, LLC, as well as the misidentification of Tango Mango, LLC as the assignee in the *nunc pro tunc* assignment by Knightspin, LLC, was a curable mistake which respondent maintains has been corrected by the recordation of a corrective assignment with the USPTO's Assignment Branch. In view thereof, respondent requests that judgment be entered in its favor with regard to petitioner's abandonment claim.

In support of its cross-motion for summary judgment and in response to petitioner's motion for summary judgment, respondent submitted the declaration of its president, Shirley Spinetta, which included as exhibits, *inter alia*, the following: (1) menu of respondent's restaurants, (2) sample

advertising of respondent's restaurant services which display respondent's subject mark, (3) copies of the assignments recorded with the USPTO's Assignment Branch that concern respondent's TANGO MANGO mark, (4) copies of third-party registrations downloaded from a USPTO electronic database for marks that contain the term MANGO used in association with various goods and services, including the services provided by petitioner under its pleaded marks, (5) electronic printouts of yellow page directories of restaurant business establishments in various U.S. states which utilize the term MANGO in their business name, (6) electronic printouts of reviews of third-party restaurants which employ the term MANGO in their restaurant name, (7) copies of petitioner's responses to respondent's first and second sets of interrogatories and first set of requests for admissions, and (8) copy of an online dictionary definition of the term MANGO.

Moreover, in her declaration, Ms. Spinetta declares that (1) unlike petitioner's restaurant services, respondent's restaurant services do not include "Latin-style cuisine," *Id.*, ¶ 3, (2) the TANGO MANGO mark was chosen because it rhymed, was cute and otherwise appealing, and not chosen in an attempt to trade off or create confusion with the trademark or service mark of any other person or entity, *Id.*, ¶ 12, (3) petitioner's services and goods offered under the marks, and the manner in which petitioner's services and goods are offered and advertised, are not consistent with the family-friendly atmosphere the respondent promotes and is not a nightclub or bar,

*Id.*, ¶¶ 14-15, (4) the assignor of the assignment of respondent's underlying application was erroneously identified as Tango Mango, LLC and not Tango Mango, Inc., *Id.*, ¶ 18, and (5) the assignee of the *pro tunc assignment* from Knightspin, LLC was erroneously identified as Tango Mango, LLC and not Tango Mango, Inc. *Id.*, ¶ 19.

### ***Pleadings***

A decision on summary judgment necessarily requires a review of the operative pleadings in the proceeding. Thus, before turning to the merits of the motions, the Board must examine the claims in the amended petition for cancellation, and respondent's amended answer and affirmative defenses.

After a review of petitioner's amended petition to cancel, we find that petitioner has sufficiently pleaded its standing, its claim of priority and likelihood of confusion, and its claim of abandonment through nonuse via an invalid assignment.

Additionally, inasmuch as respondent's affirmative defenses of estoppel, laches, acquiescence and unclean hands, *see* Paragraph 22 of respondent's answer to amended petition to cancel, are unsupported by factual background, and merely state the names of the asserted defenses, the pleading of these affirmative defenses is insufficient.

Affirmative defenses, like claims in a petition for cancellation, must be supported by enough factual background and detail to fairly place the petitioner on notice of the basis for the defenses. *See IdeasOne Inc. v.*

*Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1292 (TTAB 1999) (primary purpose of pleadings “is to give fair notice of the claims or defenses asserted”). A party must allege sufficient facts beyond a tender of ‘naked assertion[s]’ devoid of ‘further factual enhancement,’ to support its claims. *Ashcroft v. Iqbal*, 556 U.S. 662, 663 (2009), quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007).

Accordingly, these defenses are **STRICKEN** from respondent’s answer.

Further, respondent asserts as an “affirmative defense” that the amended petition for cancellation fails to state a claim upon which relief may be granted. The Board notes that this asserted “defense” is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading of petitioner’s claims rather than a statement of a defense to a properly pleaded claim. In view thereof, and in the absence of a formal motion to dismiss for failure to state a claim pursuant to Fed. R. Civ. P. 12(b)(6), this asserted defense will not be considered as such. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 n.7 (TTAB 2001).

As noted above, the Board finds that petitioner’s amended pleading of its priority and likelihood of confusion claim, as well as its abandonment claim due to an invalid assignment, are legally sufficient to the extent that

they clearly contain allegations which, if proven, would establish petitioner's standing, as well as the asserted grounds for cancellation. In view thereof, respondent's defense relating to the sufficiency of petitioner's amended pleading is **STRICKEN** from its answer.

Moreover, with regard to respondent's affirmative defense that petitioner lacks trademark rights in and lacks valid registration for petitioner's purported rights in its pleaded MANGO TROPICAL CAFÉ, MANGO'S MAMBO BAR, and MANGO'S mark, *see* Paragraph 24 of respondent's answer, we note that such an affirmative defense, absent a counterclaim, constitutes an impermissible collateral attack on the validity of petitioner's pleaded registrations. Trademark Rule 2.106 (2). Because respondent has not counterclaimed to cancel petitioner's pleaded registrations, respondent's affirmative defense contesting the validity of petitioner's pleaded registrations is hereby **STRICKEN** from its answer.

Finally, the "affirmative defenses" identified in Paragraphs 23, 25, and 26 merely amplify respondent's denials and provide fuller notice of how respondent intends to defend this cancellation. *See Ohio State Univ.*, 51 USPQ2d at 1292. Although they are not proper affirmative defenses, we need not strike them.

### ***Summary Judgment***

Summary judgment is only appropriate where there are no genuine disputes as to any material facts, thus allowing the case to be resolved as a

matter of law. Fed. R. Civ. P. 56(a). 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 Am. 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). Evidence on summary judgment 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. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472. The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1542.

Under Rule 56(a), the movant has the initial burden of demonstrating that there is no genuine dispute of material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

With regard to its claim of priority and likelihood of confusion, petitioner is correct in its assertion that both petitioner and respondent use their marks in connection with services that are legally identical, and that where this is the case, the similarity between the marks necessary to support a determination that confusion is likely declines. *See Bridgestone Am. Tire Operations, LLC v. Fed. Corp.*, 673 F.3d 1330, 1337, 102 USPQ2d 1061, 1064

(Fed. Cir. 2012); *In re Viterra Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992).

However, respondent has submitted evidence in support of its cross-motion and response showing third-party registration and marketplace usage of MANGO-formative marks in connection with similar services. Respondent asserts that the term MANGO when used in connection with restaurant and bar services is weak. Respondent argues that there is no likelihood of confusion notwithstanding any relatedness of the services that may be found, because petitioner's registered marks are entitled to a narrow scope of protection to the extent that the term MANGO is the only basis of similarity between the marks.

After consideration of the parties' respective arguments and the evidence submitted, we find that entry of summary judgment is inappropriate in this case as there are genuine disputes of material fact remaining for trial. At a minimum, there are genuine disputes of material fact as to the commercial impressions of the parties' marks; and the scope of protection that should be afforded petitioner's marks in light of the extent of the fame, if any, of petitioner's marks contending with the strength or weakness of petitioner's marks in view of the evidence of third-party usage of the term MANGO in relation to restaurant and bar services.

With regard to petitioner's claim of abandonment through non-use via an invalid assignment, based upon Office records, the Board notes the following:

1. The underlying application of the subject registration was filed by Tango Mango, Inc., a Massachusetts corporation, on February 23, 2007;
2. Prior to the issuance of the subject registration, an entity identified as Tango Mango, LLC assigned all rights, title, and interest in the underlying application to Knightspin, LLC. The assignment was executed on September 24, 2007 and was recorded with the USPTO's Assignment Branch on November 8, 2007 (two days after the subject registration issued);
3. The subject registration was then assigned back to Tango Mango, LLC by Knightspin LLC via a *nunc pro tunc* assignment effective September 20, 2010. This *nunc pro tunc* assignment was executed on April 30, 2012 and recorded with the USPTO's Assignment Branch on May 3, 2012;
4. A corrective assignment was executed on April 30, 2012 and recorded on November 6, 2013 confirming that the previous *nunc pro tunc* assignment from Knightspin LLC to Tango Mango, LLC was in error and that the receiving party should have been identified as Tango Mango, Inc. and not Tango Mango, LLC.

While the Board recognizes that the corrective assignment is a permissible cure to the misidentification of Tango Mango, LLC as the assignee in the *nunc pro tunc* assignment from Knightspin, LLC, see TMEP § 503.06(b) (October 2013); *In re Abacab Int'l Computers Ltd.*, 21 USPQ2d 1078 (Comm'r Pats. 1987), the Board nonetheless finds that a genuine dispute of material fact remains as to whether the original assignment of respondent's underlying application from Tango Mango, LLC to Knightspin, LLC was an invalid assignment or whether identifying Tango Mango, LLC as the assignor in the original assignment is also a curable mistake.<sup>8</sup>

Accordingly, the parties' cross-motions for summary judgment regarding both petitioner's priority and likelihood of confusion claim, as well as petitioner's claim of abandonment by way of an invalid assignment, are **DENIED**.<sup>9</sup>

### ***Trial Schedule***

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<sup>8</sup> Although Ms. Spinetta states in her declaration in support of respondent's cross-motion for summary judgment that Tango Mango, LLC was erroneously identified as the assignor in the assignment of the underlying application to Knightspin, LLC, the Board notes that a corrective assignment has not be filed with the Office's Assignment Branch with regard to this original assignment.

<sup>9</sup> The parties should note that the evidence submitted in connection with their cross-motions 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 (1983). Furthermore, the fact that we have identified certain genuine disputes as to material facts sufficient to deny the parties' cross-motions should not be construed as a finding that these are necessarily the only disputes which remain for trial.

Proceedings are hereby resumed. Trial dates, beginning with the deadline for petitioner's pretrial disclosures, are reset as follows:

Plaintiff's Pretrial Disclosures Due	<b>4/30/2014</b>
Plaintiff's 30-day Trial Period Ends	<b>6/14/2014</b>
Defendant's Pretrial Disclosures Due	<b>6/29/2014</b>
Defendant's 30-day Trial Period Ends	<b>8/13/2014</b>
Plaintiff's Rebuttal Disclosures Due	<b>8/28/2014</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>9/27/2014</b>

In each instance, a copy of the transcript of any testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of that testimony.

Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.