

ESTTA Tracking number: **ESTTA515632**

Filing date: **01/11/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92055679
Party	Plaintiff Your Photo On Canvas, LLC
Correspondence Address	ROGER N BEHLE JR FOLEY BEZEK BEHLE & CURTIS LLP 575 ANTON BOULEVARD, SUITE 710 COSTA MESA, CA 92626 UNITED STATES rbehle@foleybezek.com
Submission	Motion for Summary Judgment
Filer's Name	Roger Behle
Filer's e-mail	rbehle@foleybezek.com, ehuffman@foleybezek.com
Signature	/Roger Behle/
Date	01/11/2013
Attachments	Motion for Summary Judgment.pdf (14 pages)(454847 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of: Trademark Registration No. 4151869, on the Supplemental Register
Mark: your photo on canvas
Date Filed: February 23, 2011

<p style="text-align: center;">YOUR PHOTO ON CANVAS, LLC,</p> <p style="text-align: center;">Petitioner,</p> <p style="text-align: center;">vs.</p> <p style="text-align: center;">MALOVANI DESIGN CORP.,</p> <p style="text-align: center;">Registrant.</p>	<p>Cancellation No.: 92055679 Registration No.: 4,151,869</p>
--	---

**PETITIONER YOUR PHOTO ON CANVAS, LLC'S
MOTION FOR SUMMARY JUDGMENT; MEMORANDUM OF POINTS AND
AUTHORITIES IN SUPPORT THEREOF**

Pursuant to Rule 56 of the Federal Rules of Civil Procedure and Trademark Trial and Appeal board Manual for Procedure (“TBMP”) § 528, Petitioner Your Photo on Canvas, LLC (“YPOC”), respectfully moves the Board for entry of summary judgment in its favor, on the ground that Registrant, Malovani Design Corp. (“Registrant”) admits that it is not and at all relevant times was not the owner of the “Your Photo on Canvas” mark, which was registered on the Supplemental Register in its name. Thus, Petitioner requests that Registration No. 4,151,869 be canceled.

This motion is based on the attached Memorandum of Points and Authorities, the Declaration of Roger N. Behle, Jr., and the documents on file in this action.

Dated: January 10, 2013

FOLEY BEZEK BEHLE & CURTIS, LLP

/Roger N. Behle, Jr./
Roger N. Behle, Jr.
Attorney for Petitioner,
Your Photo On Canvas, LLC.

TABLE OF CONTENTS

I. Introduction/Summary of Argument..... 1

II. Summary of Undisputed Facts..... 1

III. Legal Standard for Summary Judgment 2

IV. The Undisputed Facts Establish that Registrant Does Not Own the Mark and Did Not Own the Mark When the Trademark Application Was Filed. 2

 A. A Trademark Application That is Not Made by the Owner of the Mark Is Void... 2

 B. According to Registrant Itself, Registrant Is Not the Owner of the Mark, and Was Not the Owner of the Mark When the Application Was Filed. 3

 C. Malovani Intended to Use the Mark in His Individual Capacity..... 4

V. Conclusion 5

MEMORANDUM OF POINTS AND AUTHORITIES

I. Introduction/Summary of Argument

Malovani Design Corp. (“Registrant”) has obtained registration on the Supplemental Register of the mark “your photo on canvas” (the “Mark”), covering photos printed on canvas, among other printed goods. Registrant has since revealed, however, that at the time its application to register the Mark was filed, Registrant did not own the Mark. Instead, Registrant had purportedly assigned all of its rights in the Mark to an individual, Adam Malovani (“Malovani”). Based on this revelation, Petitioner, Your Photo on Canvas, LLC (“YPOC”), now seeks to cancel Registrant’s Registration No. 4,151,869 on the grounds that Registrant is not, and was not at the time the application was filed, the owner of the Mark.

In this Motion, YPOC moves for summary judgment canceling registration of the Mark. The following undisputed facts establish that the Mark is not owned by the party that applied for and ultimately registered the Mark:

- Registrant filed its trademark application for the Mark on or about February 23, 2011, with Registrant attesting that *it* was the owner of the Mark; and
- On or about April 23, 2012, an undated assignment was produced by Malovani, *signed by Registrant* and stating that as of October 1, 2007, Registrant had assigned all of its right, title, and interest in the trademark and trade name “Your Photo on Canvas” to Malovani, an individual.

These are facts that originate from Registrant *itself*. Presuming the truth of Registrant’s facts, they clearly establish that Registrant is not and was not on the application date the owner of the Mark. Under 15 U.S.C. § 1051, a party seeking to register a trademark must be the owner of the mark for which registration is sought. *Huang v. Tzu Wei Chen Food Co. Ltd.*, 849 F.2d 1458, 1460 (Fed. Cir. 1988).

II. Summary of Undisputed Facts

The following material facts are not in dispute:

1. Malovani Design Corp. filed a trademark application for the Mark on February 23, 2011 (“Trademark Application”);
2. In the Trademark Application, Registrant attested that it was the owner of the Mark;

3. On or about April 23, 2012, an assignment agreement was produced (“Assignment Agreement”) between Malovani and Registrant, by which Registrant transferred all of its rights, title and interest in the Mark to Malovani, an individual, effective as of October 1, 2007 (nearly four years before the application was filed);
4. On or about May 29, 2012, the Mark was registered to Registrant on the Supplemental Register, bearing Registration No. 4,151,869.

Thus, according to Registrant, it is undisputed that Registrant did not own the Mark on the date the application was filed, and thus the registration must be cancelled. TMEP § 1201.02(b).

III. Legal Standard for Summary Judgment

Summary judgment is encouraged in *inter partes* trademark proceedings before the Board because the issues are limited to registrability and are therefore “particularly suitable” for disposition by summary judgment. *Phoenix Closures, Inc. v. Yen Shaing Corp.*, 9 USPQ2d 1891, 1892 (TTAB 1988); *Pure Gold, Inc. v. Syntex (U.S.A.) Inc.*, 222 USPQ 741, 744 n.2 (Fed. Cir. 1984). Summary judgment is appropriate where there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 961 (TTAB 1986). No genuine issue for trial exists where the record taken as a whole could not lead a rational trier of fact to find for the non-moving party. *Matsushita Electric Industrial Co. Ltd. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1987). A dispute is genuine only if, on the entirety of the record, a reasonable trier of fact could resolve a factual matter in favor of the non-moving party. *Sweats Fashion, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560 (Fed. Cir. 1987), citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242 (1986). Disputes over facts that will not affect the outcome under the governing law are immaterial and do not preclude summary judgment.

IV. The Undisputed Facts Establish that Registrant Does Not Own the Mark and Did Not Own the Mark When the Trademark Application Was Filed.

A. A Trademark Application That is Not Made by the Owner of the Mark Is Void.

An application for trademark registration must be filed by the owner of the mark as of the application filing date. *Sanders v. American Forests*, 2000 U.S. App. LEXIS 3692, *4 (Fed. Cir.

Mar. 10, 2000), citing 15 U.S.C. § 1051, Trademark Manual of Examining Procedure (“TMEP”) § 1201.02(b), *Huang v. Tzu Wei Chen Food Co. Ltd.*, 849 F.2d 1458, 1460 (Fed. Cir. 1988). An application is void if the wrong party is identified as the Registrant:

An application based on use in commerce under 15 U.S.C. 1051(a) must be filed by the party who owns the mark on the application filing date. If the Registrant does not own the mark on the application filing date, the application is void. 37 C.F.R. 2.71(d). *Huang v. Tzu Wei Chen Food Co. Ltd.*, 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988).

If the record indicates that the Registrant is not the owner of the mark, the examining attorney should refuse registration on that ground. The statutory basis for this refusal is §1 of the Trademark Act, 15 U.S.C. 1051, and, where related company issues are relevant, §§5 and 45, 15 U.S.C. §§1055 and 1127. The examining attorney should not have the filing date cancelled or refund the application filing fee.

TMEP § 1201.02(b)

A petition to cancel a mark registered on the Supplemental Register within the past five years may be brought to cancel a mark where the registrant is not (and was not, at the time of the filing of its application for registration) the rightful owner of the registered mark. TBMP § 309.03(c)(7); *Ballet Tech Foundation, Inc. v. The Joyce Theater Foundation, Inc.*, 89 USPQ2d 1262 (TTAB 2008). And, a trademark application brought in the name of the wrong party cannot be amended. See TMEP § 1201.02(b) (“When an application is filed in the name of the wrong party, this defect cannot be cured by amendment or assignment”); 37 C.F.R. 2.71(d) (“However, the application cannot be amended to set forth a different entity as the Registrant. An application filed in the name of an entity that did not own the mark as of the filing date of the application is void.”)

B. According to Registrant Itself, Registrant Is Not the Owner of the Mark, and Was Not the Owner of the Mark When the Application Was Filed.

On or about February 23, 2011, Registrant filed a trademark application for registration of the Mark, as shown below:

your photo on canvas

On this same day, Registrant attested that Registrant was the rightful owner of the Mark:

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the Registrant; **he/she believes the Registrant to be the owner of the trademark/service mark sought to be registered,** or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes Registrant to be entitled to use such mark in commerce; **to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce,** either in the identical form thereof or in such near resemblance thereto as to or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Trademark Application (emphasis added).

Despite declaring that *Registrant* was the owner of the Mark as of February 23, 2011, an Assignment Agreement was later produced reflecting that Malovani, an individual, has owned the Mark since October 1, 2007. This Assignment Agreement stated that as of October 1, 2007, Registrant assigned to Malovani, as an individual, all right title and interest in and to the Mark. A true and correct copy of the Assignment Agreement is attached to the Behle Declaration as Exhibit A.

Thus, the undisputed material facts, proffered by Registrant itself, confirm that Registrant was not the owner of the Mark when the trademark application was filed on February 23, 2011. The trademark registration should thus be canceled because the application is void *ab initio* and should be denied registration. See *Sanders*, 2000 U.S. App. LEXIS 3692 at *4 (finding that a trademark application was void *ab initio* under section 1(b) of the Trademark Act because the Registrant was not the true owner); 15 U.S.C. § 1051; TBMP § 309.03(c)(7); TMEP § 1201.02(b); *Huang*, 849 F.2d at 1460; *Ballet Tech Foundation, Inc.*, 89 USPQ2d 1262.

C. Malovani Intended to Use the Mark in His Individual Capacity.

Applying for registration of the Mark in Registrant's name rather than in Malovani's name was not a mistake. Even if the trademark application could be amended for a mistake in the name of the Registrant, which, under TMEP 1201.02(b) and 37 C.F.R. 2.71(d), it cannot, no mistake can be claimed here, as the Assignment Agreement reaffirms that someone other than Registrant owned the Mark on February 23, 2011.

Courts have looked at statements regarding the Registrant's intent when deciding if an intent to use application was filed by the correct party. In *Sanders*, the court found that the intent to use application for the mark LEAF RELEAF was void *ab initio* under section 1(b) of the Trademark Act because the Registrant was not the true owner. *Sanders v. American Forests*, 2000 U.S. App. LEXIS 3692, *3 (Fed. Cir. Mar. 10, 2000). The Registrant filed the application in her own name and indicated by checking a box that she was filing the application as an individual. *Id.* at 2. The TTAB subsequently determined that the Registrant as an individual did not have a *bona fide* intent to use the mark in commerce and thus the application was void *ab initio* because she was not the true owner of the mark. *Id.* at 3. This decision was based on the following evidence of her intent:

Sanders, submitting her application pro se, chose to file the application as an individual, even though Sanders intended to use the mark in partnership with her husband. Such intent is evident from Sanders' deposition and written opposition responses. Specifically, Sanders refers to "**their**" business or "**their**" product. In light of such evidence, the Board did not reversibly err in determining that Sanders failed to display a bona fide intent to use the mark in her individual capacity. **The true owner of the mark was the partnership of Barbara and Stephen Sanders; therefore the application, to comply with 15 U.S.C. § 1051, had to be filed by some entity rather than by an individual.**

Sanders, 2000 U.S. App. LEXIS 3692 at 4-5 (emphasis added).

Similarly here, the Assignment Agreement reflects that Malovani, not Registrant, was to own and control "all right, title and interest" in the Mark. Just like the Registrant in *Sanders*, who was found not to be the true owner because she intended to use the mark as part of an entity, rather than in her individual capacity, Registrant is not the true owner of the Mark because, even though Registrant declared that it had actually used the Mark in commerce, the Assignment Agreement reflects that only Malovani - as trademark assignee - had such rights. Therefore, the application, to comply with 15 U.S.C. § 1051, had to be filed by the individual, rather than some entity.

V. Conclusion

Based on the foregoing, Petitioner respectfully requests that its motion for summary judgment be granted, as Registrant Malovani Design Corp is not, according to the Assignment Agreement, the owner of the Mark and was not the owner of the mark when the application was filed. As such, the application for trademark registration is void *ab initio*, and the registration of the Mark should be cancelled.

Dated: January 11, 2013

FOLEY BEZEK BEHLE & CURTIS, LLP

/Roger N. Behle, Jr./
Roger N. Behle, Jr.
Attorney for Petitioner,
Your Photo On Canvas, LLC.

CERTIFICATE OF SERVICE

I hereby certify that on the 11th day of January, 2013, the foregoing PETITIONER YOUR PHOTO ON CANVAS, LLC'S MOTION FOR SUMMARY JUDGMENT; MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT THEREOF was served on Registrant by depositing same with the U.S. Postal Service, first-class postage prepaid, addressed as follows:

Robert Gilcrest
c/o Malovani Design Corp.
1908 Farrell Ave., #B
Redondo Beach, California 90278
UNITED STATES

FOLEY BEZEK BEHLE & CURTIS, LLP

/Roger N. Behle, Jr./
Roger N. Behle, Jr.
Attorney for Petitioner,
Your Photo On Canvas, LLC.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of: Trademark Registration No. 4151869, on the Supplemental Register
Mark: your photo on canvas
Date Filed: February 23, 2011

<p>YOUR PHOTO ON CANVAS, LLC,</p> <p style="text-align: center;">Petitioner,</p> <p style="text-align: center;">vs.</p> <p>MALOVANI DESIGN CORP.,</p> <p style="text-align: center;">Registrant.</p>	<p>Cancellation No.: 92055679 Registration No.: 4,151,869</p>
--	---

**DECLARATION OF ROGER N. BEHLE, JR. IN SUPPORT OF PETITIONER YOUR
PHOTO ON CANVAS, LLC'S
MOTION FOR SUMMARY JUDGMENT**

I, Roger N. Behle, Jr., declare as follows:

1. I am an attorney at law duly licensed to practice before all the Courts of the State of California and in the District Court for the Central District, and am a partner of Foley Bezek Behle & Curtis, LLP, attorneys of record for Petitioner Your Photo on Canvas, LLC. ("YPOC"). I make this Declaration based upon personal knowledge, except as to those statements made upon information and belief, and as to those statements, I believe them to be true. If called upon, I could and would competently testify thereto under oath.

2. Attached hereto as Exhibit A is a true and correct copy of an Assignment Agreement that was produced by Adam Malovani.

I declare the foregoing under penalty of perjury under the laws of the United States of America this 11th day of January 2013, at Orange County, California.

/s/ Roger N. Behle, Jr.
Roger N. Behle, Jr.

EXHIBIT A

Assignment Agreement

This assignment agreement memorializes an assignment of rights effective as of October 1, 2007 (the "Assignment"). The Assignment is by and between Malovani Design Corporation ("Design Company" or "Assignor") and Adam Malovani ("Malovani" or "Assignee"). Design Company and Malovani are collectively referred to herein as the "Parties".

RECITALS

WHEREAS, Design Company is the owner and holder of the trademark and trade name "Your Photo On Canvas" (the "YPOC Brand"). Malovani is the owner of Design Company.

WHEREAS, Design Company wishes to memorialize the assignment between it and Malovani for Malovani, among other things: (a) to take steps necessary to register and maintain the YPOC Brand with the United States Patents and Trademark Office; (b) to license the YPOC Brand to third parties; and (c) to enforce common law, statutory and contractual rights arising from the YPOC Brand and the licensing of same.

NOW THEREFORE, for good and valuable consideration, the mutual receipt and legal sufficiency of which are hereby acknowledged, the Assignor hereby assigns, transfers and sets over unto Assignee, all of Assignor's right, title and interest in and to the YPOC Brand, including but not limited to claims, causes of action, damages, penalties, costs and expenses (including attorney fees) relating to, arising out of, or in connection with the YPOC Brand.

The parties shall, upon request of the other, execute and deliver such further documents (in form and substance reasonably acceptable to the party to be charged) and do such other acts and things as are reasonably necessary and appropriate to effectuate the terms and conditions of this Assignment.

[Signatures on Next Page]

IN WITNESS WHEREOF, this Assignment has been executed as of the date first above written.

ASSIGNOR



Adam Malovani, President
For Malovani Design Corporation

ASSIGNEE



Adam Malovani