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

Proceeding	92056821
Party	Defendant Hollywood Burger Holdings, Inc.
Correspondence Address	HOLLYWOOD BURGER HOLDINGS INC 33 UNION SQUARE WEST, APT 4F C/O SCOTT L MATHIS NEW YORK, NY 10003 UNITED STATES
Submission	Motion for Summary Judgment
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Date	06/27/2013
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Hollywood Casino Corporation,	)	Cancellation No. 92056820
	)	Registration No. 4036289
Petitioner,	)	Cancellation No. 92056821
	)	Registration No. 4026623
v.	)	Cancellation No. 92056873
	)	Registration No. 3951706
Hollywood Burger Holdings, Inc.,	)	
	)	
Respondent.	)	

RESPONDENT'S MOTION FOR SUMMARY JUDGMENT;
POINTS AND AUTHORITIES IN SUPPORT THEREOF

MOTION

Respondent Hollywood Burger Holdings, Inc. ("Hollywood Burger") moves the Trademark Trial and Appeal Board pursuant to 37 C.F.R. § 2.127 and Rule 56 of the Federal Rules of Civil Procedure for entry of summary judgment in the above cancellation proceedings that Registration No. 3951706 for the mark shown to the right, Registration No. 4026623 for the mark **Hollywood Burger** and Registration No. 4036289 for the mark **Hollywood Café** should be canceled, and Petitioner Hollywood Casino Corporation's ("Hollywood Casino") petitions should thereafter be dismissed as moot with no judgment entered that would result in any *res judicata* effect on any future applications.

MEMORANDUM

I. UNDISPUTED FACTS

On September 29, 2009, Hollywood Burger filed Application No. 77831354 (now Registration No. 3951706) for the mark for, among other things "Fast-food

restaurants; Restaurant services featuring sandwiches" in Class 43. That same day, Hollywood Burger also filed Application No. 77831382 (now Registration No. 4026623) for the mark **Hollywood Burger** also for, among other things, "Fast-food restaurants; Restaurant services featuring sandwiches" in Class 43. Subsequently, on November 8, 2010, Hollywood Burger filed Application No. 85171303 (now Registration No. 4036289) for "Coffee-house and snack-bar services; Fast-food restaurant services; Fast-food restaurants and snackbars; Preparation of food and beverages; Providing of food and drink; Providing of food and drink via a mobile truck; Provision of food and drink in restaurants; Restaurant services, including sit-down service of food and take-out restaurant services; Restaurant services, namely, providing of food and beverages for consumption on and off the premises" in Class 43. The filing of the applications was authorized by Scott Mathis, President of Hollywood Burger. (Exhibit 1, Declaration of Scott Mathis, "Mathis Decl.", at ¶¶ 1 and 2.) Hereinafter, the above registrations are referred to as the "Hollywood Burger Registrations".

In 2011, Statements of Use were submitted in each of the above applications, based on a misunderstanding by Hollywood Burger of what constituted "use." At that time, Hollywood Burger was operating restaurants outside the United States under the marks, it was promoting franchising of restaurants under those names in the United States, and products (shirts, mugs, etc.) bearing the marks were being sold in the United States. Hollywood Burger understood the above constituted "use" of the mark. (Exhibit 1, Mathis Decl. at ¶ 3.)

Hollywood Burger has learned that its understanding of "use" was not correct. At the time the statements of use were filed in 2011, no restaurants or other food service establishments were being operated in the United States under the marks of Registration No. 3951706, Registration No. 4026623 or Registration No. 4036289, nor are any restaurants currently being

operated in the United States under those marks. (Exhibit 1, Mathis Decl. at ¶ 4; see also Answer to Amended Petition for Cancellation in Cancellation No. 92056820 at ¶¶ 20 and 24-29; Answer to Amended Petition for Cancellation in Cancellation No. 92056821 at ¶¶ 21 and 24-29; Answer to Amended Petition for Cancellation in Cancellation No. 92056873 at ¶¶ 21 and 24-29.)

II. RELEVANT STATUTORY AUTHORITY

Pursuant to Rule 56(c) of the Federal Rules of Civil Procedure, a party is entitled to entry of summary judgment

> if the pleadings, depositions, answers to interrogatories and admissions on file, together with the affidavits, if any, show that there is no genuine issue of material fact and that the moving party is entitled to a judgment as a matter of law.

As the Board has instructed:

> Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to summary judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548 (1986). If the nonmoving party fails to make a sufficient showing on an essential element of its case with respect to which it would have the burden of proof at trial, judgment as a matter of law may be entered in favor of the moving party. See Fed. R. Civ. P. 56(c); *Celotex Corp., supra*, 477 U.S. 322-23. The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc*., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). When the moving party's motion is supported by evidence sufficient to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely disputed facts that must be resolved at trial. The nonmoving party may not rest on the mere allegations of its pleadings and assertions of counsel, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine issue of material fact for trial.

Diaz v. Servicios De Franquicia Pardo's S.A.C., 83 USPQ2d 1320, 1327-28 (TTAB 2007).

With respect to registration of a service mark, an application that is filed on the basis of an intent-to-use a mark or which is converted into an intent-to-use application, as with the applications that resulted in the registrations that are the subject of the present cancellation proceedings, must at some point be placed into "use", and the applicant must submit a

> verified statement that the mark is in use in commerce and specifying the date of the applicant's first use of the mark in commerce and those goods or services specified in the notice of allowance on or in connection with which the mark is used in commerce.

15 U.S.C. § 1051(d)(1).

> The term "use in commerce" means the bona fide use of the mark in the ordinary course of trade, and mot merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce—
>
> * * *
>
> (2) on services when it is used or displayed in the sale or advertising services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

15 U.S.C. § 1127.

III. ARGUMENT

A. Hollywood Burger Has Not Yet "Used" the Marks of the Hollywood Burger Registrations within the Meaning of 15 U.S.C. § 1127

Hollywood Burger has used the

mark, the **Hollywood Burger** mark and the **Hollywood Café** mark in the operation of restaurants outside the United States, it has promoted franchising of restaurants under those names in the United States, and it has sold products, such as shirts, mugs, etc., bearing those marks in the United States. At the time it filed the statements of use, Hollywood Burger had the understanding that those activities constituted

"use" of the marks. (Exhibit 1, Mathis Decl at ¶ 3.) However, that understanding was incorrect. As set out in 15 U.S.C. § 1127, the "use" needed to support the filing of a statement of use in connection with an application for services, is that the mark must be "used or displayed in the sale or advertising services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services". *Id*. Hollywood Burger has not yet "used" the marks of the Hollywood Burger Registrations in the United States within the meaning of 15 U.S.C. § 1127 as it has not yet opened restaurants under those names in the United States (although it has sought franchisees to do so). (Exhibit 1, Mathis Decl. at ¶¶ 3 and 4; see also Answer to Amended Petition for Cancellation in Cancellation No. 92056820 at ¶¶ 20 and 24-29; Answer to Amended Petition for Cancellation in Cancellation No. 92056821 at ¶¶ 21 and 24-29; Answer to Amended Petition for Cancellation in Cancellation No. 92056873 at ¶¶ 21 and 24-29.)

Accordingly, as Hollywood Burger had not "used" the marks in the United States within the meaning of 15 U.S.C. § 1127 at the time the statements of use were filed, Registration No. 3951706 for the mark, Registration No. 4026623 for the **Hollywood Burger** mark and Registration No. 4036289 for the **Hollywood Café** mark, Hollywood Burger cannot dispute that the Hollywood Burger Registrations must be canceled as a result of its mistaken understanding of the "use" required for the submission of a statement of use.

B. Hollywood Casino's Petitions for Cancellation Should be Dismissed as Moot With Respect to the Claim of a Likelihood of Confusion

In view of the conclusion that the Hollywood Burger Registrations must be canceled on the ground that Hollywood Burger were not in "use" within the meaning of 15 U.S.C. § 1127

when the statements of use were filed, Respondent submits that the Petitions for Cancellation filed by Hollywood Casino should be dismissed as moot to the extent they have included claims that there is a likelihood of confusion between the Hollywood Burger Registrations and the **Hollywood Casino** mark. Thus conclusion, we submit, is self evident as the Hollywood Burger Registrations, which will be canceled, will no longer be subject to further cancellation.

Moreover, since the present cancellation proceedings have only just begun, since no discovery has been taken, and since no papers have been filed on the issue of the alleged "likelihood of confusion, Hollywood Burger submits that no judgment should be entered from which any *res judicata* effect could be drawn that would impact any future effort by Hollywood Burger to register any of the Hollywood Burger marks that it uses or intends to use in the United States in connection with restaurant-related services.

Accordingly, Hollywood Burger submits that judgment should be entered cancelling the Hollywood Burger Registrations and that, to the extent the Petitions for Cancellation filed by Hollywood Casino address the likelihood of confusion issue, they should be dismissed as moot.

IV. CONCLUSION

For all of the foregoing reasons, the undisputable facts show that Hollywood Burger had not "used" the marks that are the subject of the Hollywood Burger Registrations within the meaning of 15 U.S.C. § 1127, and Registration No. 3951706, Registration No. 4026623 and Registration No. 4036289 should be canceled. In view of the invalidity of those registrations, Hollywood Casino's Petitions for Cancellation, at least to the extent they claim there is a likelihood of confusion with the Hollywood Casino marks, should be dismissed as moot.

Respectfully submitted,

Hollywood Burger Holdings, Inc.

Date: June 27, 2013

By: /s/ Theodore R. Remaklus

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **Respondent's Motion for Summary Judgment; Points and Authorities in Support Thereof** has been served by first class mail, postage prepaid, this 27th day of June, 2013, on Petitioner's counsel as follows:

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EXHIBIT 1

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

Hollywood Casino Corporation, Petitioner, v. Hollywood Burger Holdings, Inc., Respondent.	Cancellation No. 92056820 Registration No. 4036289 Cancellation No. 92056821 Registration No. 4026623 Cancellation No. 92056873 Registration No. 3951706

DECLARATION OF SCOTT MATHIS

I, Scott Mathis, declare as follows:

1. I am President of Hollywood Burger Holdings, Inc. ("Hollywood Burger") and have been since it was formed in 2009. I have personal knowledge of the matters set forth herein and would so testify if called to give testimony in this matter.

2. In September of 2009, I authorized the filing of applications for the mark **Hollywood Burger** (Application No. 77831382, now Registration No. 4026623), and the mark shown below (Application No. 77831354, now Registration No. 3951706), each for restaurant-related services in Class 43.

3. Then, in November of 2010, I authorized the filing of an application for the mark **Hollywood Café** (Application No. 85171303, now Registration No. 4036289) for a variety of restaurant-related services in Class 43.

4. In 2011, statements of use were submitted in each of the above applications, based on a misunderstanding of what was "use." At that time, restaurants were operating outside the United States under the marks, Hollywood Burger was promoting franchising in the United States, and products (shirts, mugs, etc.) bearing the marks were being sold in the United States. We understood the above constituted "use" of the mark.

5. Hollywood Burger has learned that its understanding of "use" was not correct. At the time the statements of use were filed in 2011, no restaurants or other food service establishments were being operated in the United States under the marks of Registration No. 3951706, Registration No. 4026623 or Registration No. 4036289.

I declare under penalty of perjury that the foregoing is true and correct. Executed this 24 day of June, 2013.

Scott Mathis