

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

UNITED STATES PATENT AND TRADEMARK OFFICE  
**Trademark Trial and Appeal Board**  
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Alexandria, VA 22313-1451  
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Mailed: March 9, 2016

Cancellation No. **92058315**

*State of Michigan*

*v.*

*M22, LLC*

**Before Mermelstein, Kuczma and Adlin,  
Administrative Trademark Judges**

**By the Board:**

This matter comes up on Petitioner's motion (filed August 27, 2015) and Respondent's cross-motion (filed September 24, 2015) for partial summary judgment on Petitioner's claim of unlawful use in commerce. The motions are fully briefed.

The Board presumes the parties' familiarity with the pleadings, the history of the proceeding and the arguments and evidence submitted with the cross-motions. Accordingly, this order will not summarize the proceeding background or recount the parties' arguments except as necessary.

Decision

Summary judgment is a pretrial device intended to save the time and expense of a full trial when the moving party is able to demonstrate, prior to

trial, that there is no genuine dispute of material fact, and that it is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(a); *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). Where, as here, the parties have filed cross-motions for summary judgment, each party has the initial burden of demonstrating the absence of any genuine dispute of material fact with respect to its own motion. *See Univ. Book Store v. Univ. of Wisconsin Bd. of Regents*, 33 USPQ2d 1385 (TTAB 1994). If the moving party is able to meet this initial burden, the burden shifts to the nonmoving party to demonstrate the existence of specific genuinely disputed facts that must be resolved at trial.<sup>1</sup> The nonmoving party may not rest on mere allegations or assertions but must designate specific portions of the record or produce additional evidence showing the existence of a genuine dispute of material fact for trial. Should the nonmoving party fail to raise a genuine dispute of material fact as to an essential element of the moving party's case, judgment as a matter of law may be entered in the moving party's favor.

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 Olde*

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<sup>1</sup> That cross-motions for summary judgment have been filed does not necessarily mean that there is no genuine dispute as to a material fact and that trial is unnecessary. *See* 10A Wright, Miller, Kane, Marcus & Steinman, *Fed. Prac. & Proc. Civ.* § 2382 (3d ed. 2015).

*Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-moving party, and all reasonable 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, supra*. The Board does not resolve disputes of material fact but rather only ascertains whether disputes of material fact exist. *See Lloyd's Food Prods.*, 987 F.2d at 767, 25 USPQ2d at 2029; *Olde Tyme Foods*, 961 F.2d at 200, 22 USPQ2d at 1542.

“[T]rademark rights cannot accrue from an unlawful use of a mark in commerce.” *See Satinine Societa in Nome Collettivo dis S.A. e M. Usellini v. P.A.B. Produits et Appareils de Beaute*, 209 USPQ 958, 966 (TTAB 1981). The Board will find a use unlawful only “when the issue of compliance has previously been determined (with a finding of noncompliance) by an entity, such as a court or government agency, having competent jurisdiction under the statute in question, or when there has been a per se violation of a statute regulating the sale of a party's goods, or the rendering of his services, in commerce.” *Id.* at 964. However, “[t]here must be [some] nexus between the use of the mark and the alleged violation before it can be said that the unlawfulness ... has resulted in the invalidity of an application or registration.” *Id.* at 967.

Upon careful consideration of the arguments and evidence presented by the parties, and drawing all inferences with respect to each party's motion in

favor of the nonmoving party, we find that neither party has demonstrated the absence of a genuine dispute of material fact. At a minimum, genuine disputes of material fact remain as to the legal effect, if any, of the Manual on Uniform Traffic Control Devices (MUTCD), as supplemented, whether the provisions of the supplemented MUTCD apply to Respondent, whether there has been a violation of the supplemented MUTCD, and, if so, whether such violation can be considered unlawful so as to warrant the cancellation of Respondent's registrations. In view thereof, Petitioner's motion and Respondent's cross-motion for partial summary judgment are hereby **DENIED**.<sup>2</sup>

To the extent that Respondent seeks summary judgment on its affirmative defenses of laches and acquiescence, the cross-motion is **DENIED** as such equitable defenses are inapplicable against an unlawful use claim. *See United States Olympic Comm. v. O-M Bread Inc.*, 29 USPQ2d 1555, 1558 (TTAB 1993).

Proceedings herein are **RESUMED** and dates are **RESET** as follows:

Expert Disclosures Due	<b>5/9/2016</b>
Discovery Closes	<b>6/8/2016</b>
Plaintiff's Pretrial Disclosures Due	<b>7/23/2016</b>
Plaintiff's 30-day Trial Period Ends	<b>9/6/2016</b>
Defendant's Pretrial Disclosures Due	<b>9/21/2016</b>
Defendant's 30-day Trial Period Ends	<b>11/5/2016</b>

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<sup>2</sup> The parties are reminded that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced during the appropriate trial period. *See, e.g., Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

Plaintiff's Rebuttal Disclosures Due	<b>11/20/2016</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>12/20/2016</b>

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 taking of testimony. Trademark Rule 2.125.

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

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