

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
General Contact Number: 571-272-8500

JK

Mailed: August 2, 2016

Cancellation No. 92058315

State of Michigan

v.

M22, LLC

Before Mermelstein, Kuczma and Greenbaum,
Administrative Trademark Judges.

By the Board:

This proceeding is before the Board for consideration of Petitioner's fully briefed¹ motion (filed March 18, 2016) for partial summary judgment pursuant to Fed. R. Civ. P. 56(a) on the following claims:

- 1) the registered marks consist of an in insignia of a State, namely, the State of Michigan, pleaded pursuant to Trademark Act Section 2(b);² and
- 2) the registered marks falsely suggest a connection with the State of Michigan, pleaded pursuant to Trademark Act Section 2(a).³

The parties and the involved properties are as set forth in the May 31, 2014 and May 29, 2015 orders,⁴ and the Board presumes familiarity therewith. In this

¹ The pages of Respondent's brief are not numbered, as required by Trademark Rule 2.126(a)(5). TBMP § 106.03 (2016). The Board expects that all future filings submitted by Respondent will comply with this rule.

² 14 TTABVUE 15.

³ 14 TTABVUE 11-12.

⁴ 13 TTABVUE; 27 TTABVUE.

order, Petitioner's asserted sign design  is the "M-22 Sign,"⁵ and Respondent's involved registered marks are, respectively, the "M-22 Registration," *i.e.*, ⁶ and "M-22 Online Registration," ⁷.

Analysis

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. 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); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The moving party carries the burden of demonstrating the absence of any genuine dispute of material fact with respect to its motion. *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. 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

⁵ 14 TTABVUE 3.

⁶ Registration No. 3992159.

⁷ Registration No. 3348635.

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. *Olde 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 its favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA, supra*. On summary judgment, the Board does not resolve disputes of material fact but rather only ascertains whether disputes of material fact exist. *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.

- **Petitioner's Section 2(b) claim**

Trademark Act Section 2(b) provides:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

To prevail on summary judgment with respect to either of Respondent's involved registrations, Petitioner must establish that there is no genuine dispute that the registered mark includes, or includes a simulation of, the flag, coat of arms, or

other insignia of the United States, any state or municipality, or any foreign nation. In determining what matter falls within the prohibitions of the “other insignia” provision, the Board has drawn a distinction between insignia of national authority such as the Great Seal of the United States, the Presidential Seal, and seals of national government departments on one hand, and “insignia which are merely used to identify a service or facility of the Government (which) are not insignia of national authority and ... therefore do not fall within the general prohibitions of” the “or other insignia of the United States” provision of Section 2(b). *In re United States Dep’t of the Interior*, 142 USPQ 506, 507 (TTAB 1964). *See also, In re District of Columbia*, 101 USPQ2d 1588, 1600 fn. 18 (TTAB 2012), citing *In re United States Dep’t of the Interior, supra*; *In re Houston*, 101 USPQ2d 1534, 1539-40 (TTAB 2012).

Upon thorough consideration of the record that is appropriately before us,⁸ and drawing all inferences in favor of Respondent as the nonmovant, Petitioner has not carried its burden of demonstrating the absence of a genuine dispute of material fact. At a minimum, a genuine dispute exists regarding the material issue of whether the M-22 Sign is an insignia of the State of Michigan such that its registration is prohibited under Section 2(b) as “other insignia of” a state. There is a genuine dispute

⁸ Petitioner did not include an affidavit or declaration with its motion to authenticate those of its exhibits that are *not* self-authenticating and admissible in the same manner as printed publications in general circulation per Trademark Rule 2.122(e). TBMP § 528.05(e); *Cf.* TBMP § 704.08(b). Similarly, certain of Respondent’s exhibits are not properly of record; for example, it argues that the USPTO “has already registered several road signs” and references several third-party registrations that are not of record (and thus have little probative value). Trademark Rule 2.122(d)(1); TBMP § 528.05(d). *See also, In re Houston*, at 1541 (list of registrations, purported to be for official seals of cities mentioned in the marks, has very little probative value).

as to whether Petitioner's M-22 Sign is a state insignia akin to the Great Seal of the United States, and whether it was formally adopted in a manner as to be of the general class and character of flags and coats of arms. *Heroes Inc. v. The Boomer Esiason Hero's Found. Inc.*, 43 USPQ2d 1193, 1197 (D.D.C. 1997). In particular, whereas Petitioner advances the argument that its M-22 Sign is a traffic control device adopted in compliance with federal law, namely, the Manual on Uniform Traffic Control Devices or MUTCD, and thus is an insignia of governmental authority over its state trunkline highways,⁹ Respondent argues that "other insignia" is read narrowly, that the M-22 Sign does not serve the sole purpose of identifying the state or state authority, and that the "state route highway marker is not an emblem of authority because it is primarily a functional device used to identify a facility of the State of Michigan, namely, the State's highway system."¹⁰ Respondent submits the dictionary definition of the term "facility," pointing to two definitions - "something (such as a building or large piece of equipment) that is built for a specific purpose" and "something that makes an action, operation, or activity easier"¹¹ - to show that the M-22 Sign serves as a functional aspect of a state agency or facility, not an indication of governmental authority.¹² Although supported by minimal evidence, this is sufficient to raise a genuine dispute of material fact. Consequently, on this

⁹ 50 TTABVUE 4.

¹⁰ 51 TTABVUE 6-7.

¹¹ 51 TTABVUE 53-54.

¹² 51 TTABVUE 10. Respondent also references several third-party registrations which, as noted above (*see* footnote 8), have minimal probative value inasmuch as the registrations are not properly of record.

record there is a genuine dispute regarding whether the M-22 Sign falls within the Section 2(b) prohibition on the registration of “other insignia.”

In view thereof, Petitioner’s motion for partial summary judgment on its Section 2(b) claim is denied.

- **Petitioner’s Section 2(a) claim**

Trademark Act Section 2(a) provides, in pertinent part:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it

(a) Consists of or comprises ... matter which ... falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols...

To prevail on summary judgment with respect to either of the marks in Respondent’s involved registrations, Petitioner must establish that there is no genuine dispute that the mark:

- 1) is the same as, or a close approximation of, the name or identity previously used by another person or institution;
- 2) would be recognized as such, in that it points uniquely and unmistakably to that person or institution;
- 3) the person or institution identified in the mark is not connected with the goods or services sold by Respondent under the mark; and
- 4) the fame or reputation of the named person or institution is of such a nature that a connection with such person or institution would be presumed when Respondent’s mark is used on its goods or services.

Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co., 703 F.2d 1372, 217 USPQ 505, 508-10 (Fed. Cir. 1983); *Buffet v. Chi-Chi's, Inc.*, 226 USPQ 428, 429-30 (TTAB 1985).

In pleading this claim, Petitioner alleges, in pertinent part, that

The M-22 Sign is associated with a particular region within Petitioner's borders and the amenities that the region and Petitioner offers. The M-22 Sign points uniquely and unmistakably to the State of Michigan.¹³

Upon thorough consideration of the record, and drawing all inferences in favor of Respondent as the nonmovant, Petitioner has not carried its burden of demonstrating the absence of a genuine dispute of material fact as to the elements of its claim. We find that genuine disputes remain for trial on all four prongs of the test for false suggestion of a connection. For example, regarding the first prong, Petitioner has not demonstrated the absence of genuine dispute that the M-22 Sign is its name or identity. Additionally, regarding the second prong, a genuine dispute remains for trial as to whether the M-22 Sign points uniquely and unmistakably to the State of Michigan. On this point, Petitioner argues, *inter alia*, that its use of the route marker for one-hundred years in certain regions, campaigns to market and develop tourism in Northwest Michigan, and media coverage in 2015 from *USA Today*¹⁴ demonstrate that the M-22 Sign is unmistakably associated with Michigan.¹⁵ Respondent argues that the M-22 Sign is not the persona or personality of Petitioner, but rather identifies

¹³ 14 TTABVUE 12.

¹⁴ 50 TTABVUE 169-173.

¹⁵ 50 TTABVUE 24-25. Petitioner makes a general reference to, among other things, its exhibits 23-34 (50 TTABVUE 212-289), which appear to be pages from various websites that mention or discuss roads with the M-22 sign.

or is associated with a culture and a way of life.¹⁶ To show that Petitioner itself admits that the M-22 Sign is not a name or persona solely associated with the State of Michigan, and that Petitioner is not, in fact, M-22, Respondent points to Paragraph 5 of the petition to cancel, wherein Petitioner alleges

Through Petitioner's use of the M-22 Sign, the sign has come to represent and describe the culture of Northern Michigan. That culture is one of recreation and relaxation, vacations, cabins, lakes, Michigan wine, cherry orchards, sand dunes, water sports, skiing, hiking, and similar amenities immediately adjacent to the roadside. These associations come from Petitioner's use of the M-22 Sign and maintenance of the highway for travelers for nearly a century.¹⁷

Respondent also points to Petitioner's evidence of posts from Respondent's Facebook page,¹⁸ as well as its own evidence of Facebook pages,¹⁹ to demonstrate that the connection that people make to the M-22 Sign is that of a resort and recreational culture tied to a certain geographic region of the state.²⁰ On summary judgment, this is sufficient to raise a genuine dispute of material fact as to an essential element of Petitioner's claim, namely, whether the M-22 Sign points uniquely and unmistakably to the State of Michigan.

In view thereof, Petitioner's motion for partial summary judgment on its Section 2(a) claim of false association of a connection is denied.

¹⁶ 51 TTABVUE 13, 15.

¹⁷ 14 TTABVUE 3-4.

¹⁸ 50 TTABVUE 177-211.

¹⁹ 51 TTABVUE 15, 46-52.

²⁰ 51 TTABVUE 14-15.

Final Matters

Petitioner has moved for partial summary judgment twice in this proceeding and on several different claims. Under the Board's inherent authority to schedule the disposition of *inter partes* proceedings, Petitioner is prohibited from filing any further motion for summary judgment in this proceeding. TBMP § 510.01.

The parties shall further note that the evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion, absent a written stipulation providing otherwise. Any such evidence to be considered at final hearing must be properly introduced during the appropriate trial period. *Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993). Moreover, the fact that we have identified certain issues that are in dispute should not be construed as a finding that these are necessarily the only issues which remain for trial.

Lastly, inasmuch as discovery has not closed and is not complete, and insofar as the parties will now complete discovery and prepare for trial, the Board reminds the parties and their attorneys that the Board expects full cooperation with one another in the disclosure and discovery process, and looks with extreme disfavor on those who do not so cooperate. Each party and its attorney has a duty to make a good faith effort to satisfy the discovery needs of its adversary, and to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case. TBMP § 408.01.

Schedule

Proceedings are resumed. Discovery and trial dates are reset as follows:

Expert Disclosures Due	9/30/2016
Discovery Closes	10/30/2016
Plaintiff's Pretrial Disclosures Due	12/14/2016
Plaintiff's 30-day Trial Period Ends	1/28/2017
Defendant's Pretrial Disclosures Due	2/12/2017
Defendant's 30-day Trial Period Ends	3/29/2017
Plaintiff's Rebuttal Disclosures Due	4/13/2017
Plaintiff's 15-day Rebuttal Period Ends	5/13/2017

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.