

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

wbc

Mailed: January 26, 2016

Cancellation No. 92060029

Jahn & Associates, LLC

v.

*Melvin N.A. Avanzado
DBA The Avanzado Law Firm*

Before Ritchie, Wolfson, and Shaw,
Administrative Trademark Judges.

By the Board:

Melvin N.A. Avanzado DBA The Avanzado Law Firm (“Respondent”) is the listed owner of the registration of the mark BIG FIRM EXPERIENCE...SMALL FIRM SERVICE for “litigation services” in International Class 45.¹

Jahn & Associates, LLC (“Petitioner”) filed a petition to cancel Respondent’s registration on the ground of likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on Petitioner’s alleged common law rights and registration of the mark SMALL FIRM, BIG EXPERIENCE for “legal services” in International Class 45.²

¹ Registration No. 4015965 issued August 23, 2011, and claims a date of first use anywhere and in commerce of March 1, 2008.

² Registration No. 3642830 issued June 23, 2009, and claims a date of first use anywhere and in commerce of October 31, 2001.

This case now comes up for consideration before the Board on Petitioner's motion for summary judgment on the ground of likelihood of confusion. The motion has been fully briefed.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to any material fact, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating that there is no genuine issue of material fact remaining for trial and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1987); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). 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 the light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *See 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.

Petitioner alleges, *inter alia*, that Respondent's mark is likely to cause confusion because of the similarity in the parties' marks, services and channels of trade. Respondent alleges, *inter alia*, that the parties' marks are dissimilar in appearance, sound and meaning; that Petitioner's mark is weak because other law firms use similar phrases to Petitioner's mark;³ that there is no

³ Respondent attached Internet pages purportedly from various third-party law firm websites and supports those printouts with a declaration from Respondent's attorney. A document obtained from the Internet must identify its date of publication or the date it was accessed and printed, and its source (URL), which Respondent's Internet pages and supporting declaration fail to contain. *See, e.g., Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1759 (TTAB 2013); *Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012); *Calypso Tech. Inc. v. Calypso Capital Mgmt. LP*, 100 USPQ2d 1213, 1216-19 (TTAB 2011); TBMP § 528.05(e) ("Materials obtained from the Internet which identify: (1) either their dates of publication or the dates they were accessed and printed; and (2) their source (e.g., the URL), are considered to be self-authenticating and may be admitted into evidence in the same manner as a printed publication in general circulation in accordance with 37 CFR § 2.122(e)"). As the Internet pages do not include the URL or date they were accessed, they are inadmissible. *See* TBMP Section 528.05(e) ("materials which are not self-authenticating in nature [such as Internet evidence] may, on summary judgment, be introduced by the affidavit or declaration of a person who can clearly and properly authenticate and identify the materials, including identifying the nature, source and date of the materials.").

Respondent also included a summary listing of the Internet pages in its responsive brief and requested that the Board take judicial notice of the listing. The Board will not take judicial notice of facts subject to reasonable dispute. *See* Fed. R. Evid. 201(b); TBMP § 704.12(b). Even if the Board took judicial notice of the search summaries, such a listing of website links has no probative value, and the mere listing of a link to a website does not make the material that might be found on that website of record. *See In re Planalytics Inc.*, 70 USPQ2d 1453, 1457 (TTAB 2004). Moreover, assertions of counsel made in the brief are not evidence. *In re Simulations Publications, Inc.*, 521 F.2d 797, 187 USPQ 147, 148 (CCPA 1975); *In re Vesoyuzny Ordena Trudovogo Krasnogo Znameni*, 219 USPQ 69, 70 (TTAB 1983). *See also Spin Physics, Inc. v. Matsushita Electric Co.*, 168 USPQ 605, 607 (TTAB 1970) (the arguments and opinion of counsel are insufficient to overcome the facts).

In view thereof, the Board has not considered the Internet pages provided by Respondent.

evidence of actual confusion; and that the parties' customers are sophisticated and unlikely to be confused.⁴

Having carefully considered the evidence and arguments offered by the parties in connection with Petitioner's summary judgment motion, we conclude that, with respect to the claim of likelihood of confusion, there are, at a minimum, genuine disputes of material fact as to the similarity of the marks and the commercial impressions created by the marks.⁵ We also note Respondent's argument regarding third-party uses of purportedly similar marks and strength of Petitioner's mark. In view thereof, disposition of this proceeding by summary judgment is inappropriate. Petitioner's motion for summary judgment is **denied**.⁶

Proceedings herein are resumed. Dates are reset as follows:

Plaintiff's Pretrial Disclosures Due	2/14/2016
Plaintiff's 30-day Trial Period Ends	3/30/2016
Defendant's Pretrial Disclosures Due	4/14/2016
Defendant's 30-day Trial Period Ends	5/29/2016
Plaintiff's Rebuttal Disclosures Due	6/13/2016
Plaintiff's 15-day Rebuttal Period Ends	7/13/2016

⁴ Respondent also argues that laches should apply in this proceeding but has not separately moved for summary judgment on this basis.

⁵ The fact that we have identified certain genuine disputes as to material facts should not be construed as a finding that these are necessarily the only disputes which remain for trial.

⁶ Evidence submitted in connection with a motion for summary judgment is of record for purposes of that motion only. To be considered at trial, the parties must make all evidence properly of record during their testimony periods. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981); TBMP § 528.05(a).

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 the taking of 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.