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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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WINTER

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Cancellation No. 92060428

Quality Bicycle Products, Inc.

v.

Middlebrook Design LLC
DBA Love Traverse City

Before Zervas, Bergsman, and Wellington,
Administrative Trademark Judges.

By the Board:

This case now comes up for consideration of Petitioner's motion for summary judgment on Respondent's counterclaim of non-use, and on the parties' cross-motions for summary judgment on Petitioner's claim of likelihood of confusion.

For purposes of this order, we presume the parties' familiarity with the arguments made and the materials submitted in connection with the subject motions.

Background

Petitioner, Quality Bicycle Products, Inc., seeks to cancel two registrations owned by Respondent, Middlebrook Design LLC dba Love Traverse City, for the marks 45

DEGREES NORTH and design[1] and 45° NORTH and design,[2] shown below:

and

As the ground for cancellation, Petitioner alleges, *inter alia*, likelihood of confusion. In support of its claim of likelihood of confusion, Petitioner pleaded ownership of trademark Registration No. 4268136 for the mark 45NRTH in standard characters for use in connection with "bicycle parts, namely, tires."[3] Petitioner refers to the claim of misrepresentation on the ESTTA cover sheet to the petition for cancellation; however, misrepresentation is not pleaded in the attached petition. Therefore, said claim is insufficient and will not be considered. *See Embarcadero Technologies, Inc. v. RStudio, Inc.*, 105 USPQ2d 1825, 1827 n.2 (TTAB 2013) ("Although the content of the ESTTA cover sheet is read in conjunction with the notice of opposition as an

[1] U.S. Reg. No. 4496120, issued March 11, 2014, for use in connection with "Headwear; Hooded sweatshirts; T-shirts."

[2] U.S. Reg. No. 4414967, issued October 8, 2013, for use in connection with "Headwear; Hooded sweatshirts; T-shirts."

[3] U.S. Reg. No. 4268136, issued January 1, 2013.

integral component, the mere mention of a ground therein is insufficient."). In any event, it is not the subject of the parties' summary judgment motions.

Respondent denied the salient allegations of the complaint and filed a counterclaim to cancel Petitioner's registration on the ground that the underlying application, as well as Petitioner's two pending applications, were "void ab initio." In support thereof, Respondent alleges that Petitioner had not used its 45NRTH mark in commerce with any of the "services" identified as of the May 15, 2012 filing date of the application and on the October 1, 2011 alleged date of first use anywhere and in commerce, as required under Sections 1(a) and 45 of the Trademark Act.

Petitioner filed an answer to the counterclaim and alleged two affirmative defenses to the counterclaim, namely, that the counterclaim is barred by Petitioner's prior registration U.S. Reg. No. 4268136 and by Respondent's knowledge of Petitioner's prior use and registration of the mark

Respondent's Counterclaim

Before we can address Petitioner's motion for summary judgment on Respondent's counterclaim, we must first consider two issues raised by Respondent's pleading. First, Petitioner's two pending applications identified in the counterclaim, application Serial Nos. 86232330 and 83232342, have not yet been approved for publication and cannot be the subject of the counterclaim. Until a registration actually issues, there is no registration to cancel and only a registration may be the subject of a counterclaim. TBMP § 307.03 (2015). Therefore, reference to the two applications in the counterclaim is hereby stricken. *See* Fed. R. Civ. P. 12(f).

Accordingly, the parties' respective arguments and evidence pertaining to Petitioner's two pending applications, which are made or offered in connection with Petitioner's motion for summary judgment, will not be considered.

Second, with respect to the allegation that Petitioner had not used its mark by the October 1, 2011 alleged date of first use anywhere and in commerce, said allegation does not constitute a valid claim of non-use. A valid claim of non-use must allege that the owner of the underlying use-based application did not use the applied-for mark as of the filing date of the application. Therefore, as long as the owner used the mark in commerce by the filing date, it is immaterial whether the stated dates of first use may be incorrect. Accordingly, to the extent Respondent's non-use claim alleges that there was no *bona fide* use prior to the claimed first use dates in the application, said claim is stricken. *Id. See ShutEmDown Sports, Inc. v. Carl Dean Lacy*, 102 USPQ2d 1036, 1045 (TTAB 2012) (failure to use mark before application date on any of the goods or services listed means that the registration is void *ab initio*.).

In view of the foregoing, we construe Respondent's counterclaim to be comprised of the following allegation:

> 8. Upon information and belief, Petitioner had not used the "45NRTH" mark in commerce on or in connection with any of the goods identified in Application Serial No. 85625684 and resulting in Registration No. 4268136, as of the May 15, 2012 filing date of the application, as required under Trademark Act Sections 1(a) and 45, 15 U.S.C. §§ 1051(a) and 1127.

Petitioner's Motion for Summary Judgment

- *Legal Standard*

Summary judgment is an appropriate method of disposing of cases in which there is no genuine dispute with respect to any material fact, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c)(1). A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute as to a material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (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 American 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). Additionally, the evidence of record and all justifiable inferences that may be drawn from the undisputed facts must be viewed in the light most favorable to the non-moving party. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); and *Opryland USA,* 23 USPQ2d at 1472.

When a moving party's motion for summary judgment demonstrates that there is no genuine dispute as to any material fact and the moving party is entitled to judgment, the burden shifts to the non-moving party to demonstrate the existence of a genuine dispute regarding at least one material fact which requires resolution at trial. The non-moving party, however, may not rest on the mere allegations of its

pleadings and assertions, but must designate specific portions of the record or produce additional evidence showing the existence of a genuine dispute as to a material fact for trial. *See Barmag Barmer Maschinenfabrik AG v. Murata Machinery, Ltd.*, 731 F.3d 831, 221 USPQ 561, 564 (Fed. Cir. 1984) ("The party opposing the motion must point to an evidentiary conflict created on the record at least by a counter statement of a fact or facts set forth in detail in an affidavit by a knowledgeable affiant.").

Moreover, where the nonmoving party will bear the burden of proof at trial on a dispositive issue, a summary judgment motion may properly be made in reliance solely on the "pleadings, depositions, answers to interrogatories, and admissions on file" and "requires the nonmoving party to go beyond the pleadings and by her own affidavits, or by the depositions, answers to interrogatories, and admissions on file, designate specific facts showing that there is a genuine issue for trial." *Celotex Corp. v. Catrett*, 477 U.S. at 324. That is, the moving party may discharge its burden by showing that there is an absence of evidence to support the nonmoving party's case. *Id.* at 325; *Copelands' Enters. Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1298 (Fed. Cir. 1991).

An application can be held void if the plaintiff pleads and proves non-use of a mark for all identified goods prior to the application filing date. *Grand Canyon West Ranch LLC v. Hualapai Tribe,* 78 USPQ2d 1696, 1697 (TTAB 2006); *Justin Industries, Inc. v. D.B. Rosenblatt, Inc.*, 213 USPQ 968, 974-75 (TTAB 1981) (application void where application filed before first order or sale and delivery of goods under the mark

occurred). Petitioner argues that the evidence of record shows that there is no genuine dispute that it was using the mark 45NRTH with "Bicycle parts, namely, tires" prior to the filing date of the underlying application, *i.e.*, May 15, 2012. Petitioner, as the counterclaim defendant and moving party, must establish that there is no genuine dispute regarding this contention.

- *Petitioner's Evidence*

In support of its motion, Petitioner has submitted the following pertinent evidence:

1. A copy of a November 2, 2015 printout from the USPTO Trademark Status & Document Retrieval (TSDR) database of Application Serial No. 85625684 (the underlying application of the registration sought to be cancelled), which includes a photograph of a tire showing the mark 45NRTH and shows that the application was filed on May 15, 2012 (9 TTABVUE 14-21; Exh. A. to the declaration of Audrey Babcock, Petitioner's counsel);
2. A copy of a November 2, 2015 printout from the USPTO Trademark Electronic Search System (TESS) database showing the record of Petitioner's registration for the mark 45NRTH, attached (9 TTABVUE 24-26; Exh. C to the Babcock declaration);
3. A copy of spreadsheets submitted under seal showing invoice dates for sales of various types of tires, e.g., "45Nrth Dillinger Studles[s]26x4" 120tpi" or "45North Xerxes 700x30, 27tpi, 140 studs," beginning on October 6, 2011 through December 3, 2013 (10 TTABVUE 77-239; Exh. D, Part 1, to

Babcock declaration) and from October 6, 2011 through June 30, 2015 (11 TTABVUE 2-290; Exh. D, Part 2, to Babcock declaration).

- *Decision*

The photograph in the underlying application showing the registered mark 45NRTH on the bicycle tire, along with the invoices indicating sales of such tires since October 6, 2011, establish that there is no genuine dispute that Petitioner used the mark 45NRTH in connection with "bicycle parts, namely, tires" on or before the filing date of the underlying application, *i.e.*, May 15, 2012.

In contrast, Respondent has not submitted any evidence that would indicate that there is a genuine dispute as to whether Petitioner used its 45NRTH mark in connection with "bicycle parts, namely, tires" on or before the filing date of the underlying application. In fact, Respondent does not respond whatsoever to this claim. Thus, Respondent has failed to reveal specific facts showing that there is a genuine issue for trial. *Celotex Corp. v. Catrett*, 477 U.S. at 324. Rather, Respondent argues, in essence, that a genuine dispute exists with respect to an unpleaded issue, *i.e.*, whether Petitioner uses the designation 45NRTH in an ornamental manner, not as a trademark, for the various clothing items identified in Petitioner's two pending applications. As discussed *supra*, Petitioner's two pending applications are not the subject of Respondent's counterclaim.[4] Therefore, any discussion related to those

[4] Moreover, while the ESTTA cover sheet forms part of the pleadings, simply listing Petitioner's pending applications on the ESTTA cover sheet does not make them of record. *Cf. Melwani v. Allegiance Corp.*, 97 USPQ2d 1537, 1540 (TTAB 2010) ("[M]ere inputting of a registration number when prompted by ESTTA ... is insufficient to make the pleaded registrations of record").

applications is immaterial to the question before us, *i.e.*, whether there is a genuine dispute that Petitioner used its 45NRTH mark in connection with "bicycle parts, namely, tires" on or before the filing date of the underlying application. Further, any factual issues that might conceivably exist in connection with Petitioner's use of its mark for clothing items do not raise a factual question sufficient to preclude summary judgment in regard to Petitioner's use of its mark with bicycle tires. *See Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F.2d 624, 222 USPQ 741, 743 (Fed. Cir. 1984).

In view of the foregoing, Petitioner has met its burden on summary judgment by showing that there is no genuine dispute of fact that it used its 45NRTH mark for "bicycle parts, namely, tires" on or before the filing date of the underlying application. *Celotex*, 477 U.S. at 325; *Copelands' Ent.*, 20 USPQ2d at 1298. Accordingly, Petitioner's motion for summary judgment on Respondent's non-use counterclaim is **granted**[5] and said counterclaim is dismissed with prejudice.

Respondent's Motion for Summary Judgment and Petitioner's Cross-Motion for Summary Judgment on Petitioner's Claim of Likelihood of Confusion

Respondent requests summary judgment in its favor on Petitioner's claim of likelihood of confusion. In response, Petitioner seeks summary judgment in its favor on its claim. 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*

[5] Because this decision is interlocutory and nonfinal in nature, any appeal thereof can be raised only after final disposition of this proceeding. *See Copelands' Enterprises Inc. v. CNV Inc.,* 12 USPQ2d 1562 (Fed. Cir. 1989).

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 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. Finally, where, as here, both parties have moved for summary judgment, the mere fact that they have done so does not necessarily mean that there are no genuine disputes of material fact, or authorize the resolution of such disputes, or dictate that judgment should be entered in favor of one of them. *See Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1437 (TTAB 2007); *Fishking ProcessorsInc. v. Fisher King Seafoods Ltd.*, 83 USPQ2d 1762, 1764 (TTAB 2007); *University Book Store v. Universityof Wisconsin Board of Regents*, 33 USPQ2d at 1389.

Based on our review of the parties' arguments and supporting evidence, and drawing all inferences in favor of each non-moving party, we find that neither party has met its burden of establishing that there is no genuine dispute as to material facts and that it is entitled to judgment as a matter of law on Petitioner's likelihood

of confusion claim under Section 2(d) of the Trademark Act. At a minimum,[6] there exists a genuine dispute as to the commercial impressions evoked by the parties' respective marks. Accordingly, the parties' respective motions for summary judgment on Petitioner's likelihood of confusion claim are **denied**.[7]

Proceeding Resumed; Trial Dates Reset

In view of the foregoing decisions, this proceeding is resumed and shall move forward solely in connection with Petitioner's claim under Section 2(d) of the Trademark Act. The parties are not allowed to file any new motions for summary judgment. Petitioner is allowed until **TWENTY-ONE (21) DAYS** from the mailing date of this order to serve any supplementary pretrial disclosures on Respondent. Trial dates are reset as shown in the following schedule:

Plaintiff's 30-day Trial Period Ends	**7/10/2016**
Defendant's Pretrial Disclosures Due	**7/25/2016**
Defendant's 30-day Trial Period Ends	**9/8/2016**
Plaintiff's Rebuttal Disclosures Due	**9/23/2016**
Plaintiff's 15-day Rebuttal Period Ends	**10/23/2016**

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**

[6] The fact that we have identified in this order only particular material facts that are genuinely in dispute should not be construed as a finding that these are necessarily the only issues that remain for trial.

[7] 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 in evidence during the appropriate trial period. *See, e.g., Levi Strauss & Co. v. R. Joseph Sportswear Inc.,* 28 USPQ2d 1464 (TTAB 1993); TBMP § 528.05(a).

DAYS after completion of the taking of testimony. *See* Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

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