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

Proceeding	92066968
Party	Plaintiff Software Freedom Law Center
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SOFTWARE FREEDOM LAW CENTER, Petitioner, v. SOFTWARE FREEDOM CONSERVANCY, Respondent.	Cancellation No. 92066968

PETITIONER'S RESPONSE TO RESPONDENT'S REQUEST FOR RECONSIDERATION OF THE BOARD'S DENIAL OF SUMMARY JUDGMENT

Pursuant to Trademark Rule 2.127(b), 37 C.F.R. § 2.127(b), Petitioner, by its attorneys Ostrolenk Faber LLP, submits this brief in response to Respondent's Request for Reconsideration of the Board's Denial of Summary Judgment filed on January 21, 2019. For the reasons set forth below, the Board's sound reasoning was correct: Respondent failed to carry its burden of establishing a lack of genuine dispute of material fact and that it is entitled to judgment as a matter of law, and therefore Respondent's Motion for Summary Judgment on its Affirmative Defenses was properly denied.

I. INTRODUCTORY REMARKS

Under 37 CFR § 2.127(b) the Board shall grant a motion for reconsideration if, based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued. But, a motion for reconsideration "is limited to a demonstration that on the basis of the facts before the Board and applicable law, the Board's ruling was in error and requires appropriate change." *Guess? IP Holder LP v. Knowluxe LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015). See also

Vignette Corp. v. Marino, 77 USPQ2d 1408, 1411 (TTAB 2005) (reconsideration denied because Board did not err in considering disputed evidence). Such a motion may not properly be used to introduce additional evidence, nor should it be devoted simply to reargument of the points presented in a brief on the original motion. Rather, the motion normally should be limited to a demonstration that, based on the facts before it and applicable law, the Board's ruling is in error and requires appropriate change. TBMP §518. Here, Respondent's Request for Reconsideration of the Board's Denial of Summary Judgment fails to demonstrate that the Board's denial of Respondent's Motion for Summary Judgment on its Affirmative Defenses was in error.

II. ARGUMENT

Respondent's Request for Reconsideration of the Board's Denial of Summary Judgment does nothing more than reargue points presented in Respondent's Motion for Summary Judgment on its Affirmative Defenses under the misguided theory that Petitioner bears some kind of burden of proof as a nonmoving party. All Respondent has done in this case is attempt to prematurely address the issue of likelihood of confusion, and whether there exists inevitable confusion, by moving for summary judgment on its affirmative defenses.

It is black letter law that on a motion for summary judgment, the *moving* party has the burden of establishing that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). As noted by the Board in denying Respondent's Motion for Summary Judgment on its Affirmative Defenses, the Board does not resolve issues of material fact on summary judgment; it may only ascertain whether a genuine dispute regarding a material fact exists. *See Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Old Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542,

1544 (Fed. Cir. 1992).

Furthermore, the Board is entitled to draw inferences from undisputable facts in the light most favorable to the *nonmoving* party, which in this case is Petitioner. *See Lloyd's Food Prods*., 25 USPQ2d at 2029-30; *Olde Tyme Foods*, 22 USPQ2d at 1546. Here, the Board determined, easily by inference, that there are genuine disputes of material fact that remain as to whether the commercial impressions created by the parties' marks, coupled with the dissimilarity of the parties' goods and services, would render confusion between the marks inevitable. *See e.g. Reflange Inc. v. R-Con Int'l*, 17 USPQ2d 1125, 1131 (TTAB 1990); *Turner v. Hops Grill & Bar Inc.*, 52 USPQ2d 1310, 1313 (TTAB 1999). The Board also noted that the parties' marks are identical-in-part and that there are disputes of fact as to whether Respondent's services of "defending" open source software projects overlap with or are closely related to Petitioner's legal services and are provided to the same class of purchasers. The Board properly, and within its authority, drew favorable inferences from obvious facts set forth in Respondent's submissions that need not be stated by Petitioner in this submission.

Respondent also argued that the Board erred in denying its Motion for Summary Judgment because the question of inevitable confusion is reached only after the court or Board has decided that the equitable defense applies. Several of the authorities cited by Respondent are distinguishable from the procedural posture of this case. For example, in *TPI Holdings, Inc. v. Trailertrader.com, LLC*, 126 U.S.P.Q.2d 1409 (T.T.A.B. 2018), the Board's decision followed a full briefing by the parties. *TPI Holdings* was not decided at summary judgment. Similarly, *Teledyne Techs., Inc. v. W. Skyways, Inc*., 78 U.S.P.Q.2d 1203 (T.T.A.B. 2006), was also not decided at the summary judgment stage. Respondent's heavy reliance on *Ava Ruha Corp. v. Mother's Nutritional Ctr., Inc.*, 113 U.S.P.Q.2d 1575 (T.T.A.B. 2015), in its Motion for Summary Judgment and the Request for

Reconsideration now before the Board is misguided. For example, Respondent cites the Board's determination in *Ava Ruha* that "the burden is now for Petitioner to show that confusion is inevitable, absent which the claim is barred by Respondent's affirmative defense of laches." *Id.* at 1585. But, Respondent ignored the fact that in *Ava Ruha* the Board denied the parties cross-motions for summary judgment on the affirmative defense of laches with respect to likelihood of confusion. The Board pointed out in *Ava Ruha* that Respondent moved for summary judgment on its laches defense prior to trial and without Petitioner first having moved for summary judgment on its likelihood of confusion claim. *Id.* at 1584. Thus, on summary judgment there was no evidence on likelihood of confusion of record when the Board was called upon to consider the question of laches. *Id.* The Board even noted in its decision in *Ava Ruha* that it "would not have expected Petitioner to put in all of its evidence on likelihood of confusion claim to defend against Respondent's motion." *Id.* The Board's denial of Respondent's Motion for Summary Judgment on its Affirmative Defenses is consistent with its determination in *Ava Ruha*. And, here, there hasn't even been a cross-motion by Petitioner on any of Respondent's affirmative defenses.

Finally, the fact that the Board made a determination on Respondent's Motion for Summary Judgment on its Affirmative Defenses without a brief from Petitioner was not in error. Petitioner did not concede Respondent's Motion for Summary Judgment on its Affirmative Defenses. Instead, Petitioner filed its Motion under Fed. R. Civ. P. 56(d) for Discovery and to Defer Consideration of Respondents Motion' for Summary Judgment, which was deemed moot by the Board's denial of Respondent's Motion for Summary Judgment on its Affirmative Defenses. The Board properly decided to infer certain facts from the record, favorable to Petitioner as the nonmoving party.

III. CONCLUSION

Respondent contends that the Board made a "critical error" in denying Respondent's Motion for Summary Judgment on its Affirmative Defenses. However, Respondent has failed to demonstrate that the Board's denial of Respondent's Motion for Summary Judgment on its Affirmative Defenses was in error. The Board properly denied Respondent's Motion for Summary Judgment on its Affirmative Defenses because Respondent failed to establish that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Accordingly, Respondent's Request for Reconsideration of the Board's Denial of Summary Judgment should be denied. Petitioner respectfully requests that the trial schedule set forth in the Board's January 15, 2019 order denying Respondent's Motion for Summary Judgment on its Affirmative Defenses be reset.

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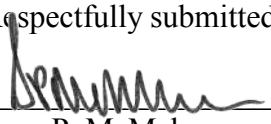
Dated: February 11, 2019
New York, New York

Respectfully submitted,



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CERTIFICATE OF SERVICE

I hereby certify that the foregoing **PETITIONER'S RESPONSE TO RESPONDENT'S REQUEST FOR RECONSIDERATION OF THE BOARD'S DENIAL OF SUMMARY JUDGMENT** was served upon Respondent this 11th day of February, 2019, by emailing a copy thereof to its counsel at pamela@chesteklegal.com and jlwtrademarks@wolfgreenfield.com:

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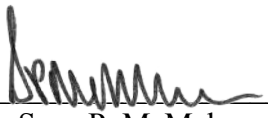

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