

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Ryan

MAILED: February 4, 2003

Opposition No. 119,317 (parent)
Opposition No. 119,597
Opposition No. 119,598

MV AGUSTA MOTOR S.p.A.

V.

TEAM OBSOLETE PRODUCTS, LTD.

Before Simms, Hohein, and Chapman, Administrative Trademark
Judges.

By the Board.

Applicant filed intent-to-use applications on September 2, 1997 to register the mark MV with a gear and lightning bolt design¹ and the marks MV² and MV AGUSTA³ in typed form. These applications cover various clothing items in International Class 25 and, with the exception of the application for the mark MV in typed form, motorcycles and their structural parts in International Class 12.

Registration has been opposed by an Italian company, MV Agusta Motor S.p.A., under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). In the notices of opposition filed separately against each of applicant's three applications, opposer alleges prior use in the United States and throughout the world, by

¹ Application Serial No. 75/350,788.

² Application Serial No. 75/350,791.

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opposer and its predecessors in interest, of the marks MV and MV AGUSTA in connection with motorcycles, structural parts therefor, wearing apparel and other goods. Opposer pleads that such use precedes the September 2, 1997 filing date of applicant's applications. Opposer also alleges that its marks are famous. Additionally, in Paragraph 6 in each notice of opposition, opposer asserts that applicant was not the owner of the marks at the time of filing application Serial Nos. 75/350,788, 75/350,791, and 75/350,790, and thus each application is null and void.⁴

Applicant answered, denying the salient allegations of opposer's claims in the notices of opposition. The three oppositions were consolidated by the Board on April 16, 2001.

This consolidated case now comes up for consideration of applicant's February 12, 2002 motion for summary judgment on the ground of priority whereby applicant asserts that opposer has failed to establish use of its pleaded marks in the United States prior to the September 2, 1997 filing date of each of applicant's applications.

The Board has carefully considered the evidence and arguments set forth in the applicant's summary judgment motion,

³ Application Serial No. 75/350,790.

⁴ Opposer further alleges that it has filed applications to register the mark MV AGUSTA with a gear and lightning bolt design. See Application Serial No. 75/355,732, filed September 12, 1997 under §1(b) of the Trademark Act, covering goods in International Classes 7, 12, 14, and 25 and Application Serial No. 75/371,378, filed October 10, 1997 under §1(b) of the Trademark Act, covering goods in International Classes 3 and 18. We observe that the Trademark Examining Operation has suspended action on both of these applications in view of applicant's prior applications.

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opposer's February 22, 2002 responsive brief, and applicant's reply thereto. However, the Board will give no consideration to opposer's March 27, 2002 surreply and applicant's April 11, 2002 "reply to opposer's surreply." The Trademark Rules of Practice do not provide for the filing of surreply briefs, and in fact, state that such papers will not be considered. See Trademark Rule 2.127(a) and (e)(1).

Based on the record now before us and for the reasons discussed below, we conclude that summary judgment is inappropriate in this case.

Generally, summary judgment is appropriate in cases where the moving party establishes that there are no genuine issues of material fact which require resolution at trial and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). An issue is material when its resolution would affect the outcome of the proceeding under governing law. See *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 106 S. Ct. 2505 (1986); and *Octocom Systems Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992);

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Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

In the first instance, applicant, as the party moving for summary judgment, must show, prima facie, the absence of a genuine issue as to priority. Then, if applicant does so, it is incumbent on opposer, as the non-movant, to show that there is a genuine issue as to priority in this proceeding.⁵ Based on the record before us, we conclude that opposer has proffered countering evidence sufficient to demonstrate a genuine factual dispute as to priority. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, supra at 1786. At a minimum, we find that genuine issues of material fact exist as to opposer's chain of title to its marks, whether the alleged interruptions in use by opposer and/or opposer's predecessors in interest constitute abandonment of its marks, and whether there has been sufficient exposure of opposer's marks in the United States to establish use analogous to trademark use. See *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996), vacating *PacTel Teletrac v. T.A.B. Systems*, 32 USPQ2d 1668 (TTAB 1994).

⁵ It is well established that likelihood of confusion under Section 2(d) of the Trademark Act cannot be recognized where one claimed to be aggrieved by that confusion does not have a right superior to the opponent's. In this case as in all opposition proceedings founded on §2(d), opposer must prove it has prior proprietary rights in its pleaded marks to demonstrate likelihood of confusion, whether by ownership of a registration, prior use of a technical "trademark," prior use in advertising, prior use as a trade name, or whatever other type of prior use may have developed a trade identity. See *Otto Roth & Co., Inc. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 43, 44, 45 (CCPA 1981).

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These issues are sufficient to preclude entry of summary judgment in favor of applicant.

We need not resolve the issue of whether opposer's asserted pre-sales activities, publicity, and promotions created an association in the relevant public's mind so as to constitute analogous use that precedes applicant's September 2, 1997 filing date.⁶ In deciding a motion for summary judgment, the Board may not resolve an issue of fact; it may only determine whether a genuine issue of material fact exists. See *Meyers v. Brooks Shoe Inc.*, 912 F.2d 1459, 16 USPQ2d 1055 (Fed. Cir. 1990). In this case, the record includes evidence of some exposure of opposer's mark in the United States prior to applicant's September 2, 1997 filing date.

Accordingly, applicant's motion for summary judgment is **denied.**

In the parties' summary judgment briefs, both parties gave much attention to the alleged bad faith of applicant. Looking at paragraph 6 in each of the three notices of opposition, it is unclear whether opposer intended not only to plead non-ownership of the marks, but also to plead fraud by applicant in prosecution of its three applications before the U.S. Patent and Trademark Office.

⁶ In inter partes disputes, a party can establish trademark priority by relying on pre-sales use in advertising if the use created a public awareness of the designation as a trademark identifying the party as a source. See, e.g., *T.A.B. Systems v. PacTel Teletrac*, 37 USPQ2d at 1883.

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In view thereof and under the circumstances, if opposer intends to raise a claim of fraud, it is allowed **thirty** days from the mailing date set forth on page one of this order to submit an amended pleading which properly asserts a claim of fraud in this consolidated opposition proceeding. See Fed. R. Civ. P. 9(b). If an amended pleading is filed by opposer, applicant is allowed **sixty** days from the mailing date set forth on page one hereof to file its answer thereto.

Proceedings herein are **resumed.**⁷ Trial dates are reset as follows:

DISCOVERY PERIOD TO CLOSE: **closed**

30-day testimony period for party in the position of plaintiff to close: **June 24, 2003**

30-day testimony period for party in the position of the defendant to close: **August 23, 2003**

15-day rebuttal period for party in the position of the plaintiff to close: **October 7, 2003**

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.

⁷ In its responsive brief on summary judgment, opposer requests permission "to take the necessary action to compel" discovery responses by applicant. If opposer seeks to compel such discovery, opposer must file a proper motion to compel in accordance with the rules applicable to Board proceedings. Opposer is reminded that the Board will not consider untimely motions to compel and will reject motions which fail to bear the requisite statement of good faith effort to resolve the parties' dispute without the Board's intervention. See, e.g., Trademark Rule 2.120(e).

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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.

If the parties seek any further extensions to the trial schedule in this case, any future consented motions to extend should set forth all dates in the format shown in this order. See Trademark Rule 2.121(d).

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