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

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Mailed: February 10, 2004

Opposition Nos. 91153915
91155119

Converse, Inc.

v.

Kischenna L. Coley

Before Seeherman, Quinn and Rogers, Administrative Trademark Judges.

By the Board:

Cross motions for summary judgment have been filed and fully briefed in the above-noted opposition proceedings.

As a preliminary matter, it is noted that Opposition Nos. 91153915 and 91155119 involve the same parties and common questions of law and fact. Accordingly, Opposition Nos. 91153915 and 91155119 are hereby consolidated and may be presented on the same record and briefs.[1] *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991). The Board file will be maintained in Opposition No. 91153915 as the "parent" case, but all papers filed herein must include

[1] In view of the consolidation of the above-identified proceedings, the parties should no longer file separate papers in connection with each proceeding.

the proceeding numbers of the consolidated cases, as set forth above.

Turning now to the cross motions for summary judgment filed in these consolidated proceedings, a party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material facts, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *See Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Finally, where both parties have moved for summary judgment, the mere fact that they have done so does not establish that there is no genuine issue of material fact, and that judgment should be entered in favor of one of them. *See University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1389 (TTAB 1994).

After careful consideration of the parties' arguments and materials submitted in support thereof, we find that neither party has established that it is entitled to summary judgment.[2]

[2] Opposer's objection to applicant's survey submitted as Exhibit I in opposition to opposer's motion and in support of applicant's cross motion is well taken and Exhibit I has been given no consideration. With regard to opposer's objection to Exhibit C attached to applicant's response, we find that the letter is

At a minimum, we find that there are genuine issues of material fact regarding the similarity, commercial impression and connotation of the parties' respective marks.[3] In addition, we find that there are genuine issues of material fact regarding the strength of opposer's marks and whether they constitute a family of marks.[4]

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inadmissible under Fed. R. Evid. 408 (a party may not offer evidence concerning settlement negotiations which is intended to prove invalidity of a claim). Accordingly, we also have not considered this letter. We hasten to add, however, both the unscientific survey and the letter are of little probative value and their consideration would not have changed our decision. Finally, applicant's arguments regarding its apparent discovery dispute with opposer have not been considered. If there is a discovery dispute that cannot be resolved after a good faith effort, a party's recourse is to file a motion to compel. See Trademark Rule 2.120. Moreover, when a summary judgment motion is pending, the only arguments that may be presented regarding discovery must be presented in a proper motion under Fed. R. Civ. P. 56(f).

[3] The fact that we have identified only a few genuine issues of material fact as sufficient bases for denying the cross motions for summary judgment should not be construed as a finding that these are necessarily the only issues which remain for trial.

[4] The Board notes that the self-serving declarations of opposer's vice president and product director have limited probative value in terms of establishing a public perception that opposer's star design marks form a family of marks. Further, the print-outs of opposer's registrations have not been properly made of record to establish the presumptions accorded registrations inasmuch as they are not copies showing status and title nor were they supported by an affidavit or declaration from an individual with requisite personal knowledge attesting to status and title. See TBMP Sections 528.05(d) and 704.03(b) (2d ed. June 2003). Finally, the information regarding other oppositions successfully brought by opposer submitted by applicant is not probative as to the question of the relative strength of opposer's star design marks; generally, evidence of third-party registrations and/or use of star design marks for related goods would be submitted for this purpose.

In view of the above, the parties' respective motions for summary judgment are denied.[5]

Discovery and trial dates are rescheduled as indicated below.[6]

DISCOVERY PERIOD TO CLOSE:	**June 15, 2004**
30-day testimony period for party in position of plaintiff to close:	**September 13, 2004**
30-day testimony period for party in position of defendant to close:	**November 12, 2004**
15-day rebuttal testimony period to close:	**December 27, 2004**

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[5] The Board reminds the parties that any evidence submitted in support of or opposition to a summary judgment motion is only considered of record for the purposes of that motion. See TBMP Section 528.05(a) (2d ed. June 2003). If the case goes to trial, the summary judgment evidence does not form part of the evidentiary record and will not be considered at final hearing unless it is properly introduced in evidence, during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.,* 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB (1993).

[6] Opposer's motion to suspend proceedings pending determination of the motion for summary judgment is granted to the extent indicated above.