UNITED STATES PATENT AND TRADEMARK OFFICE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Cataldo

Mailed: November 2, 2004

Opposition No. **91155308**

COGNIS CORPORATION

v.

DBC, LLC

Before Bucher, Holtzman and Rogers,
Administrative Trademark Judges.

By the Board:

Applicant, DBC, LLC, has filed an application to register the mark **XANGO** for "liquid dietary supplements."[1]

Registration has been opposed by opposer, Cognis Corporation, on the ground that applicant's involved mark so resembles opposer's previously used and registered mark, **XANGOLD**, for "dietary and nutritional supplements; dietary and nutritional food supplements," as to be likely to cause confusion, or to cause mistake or to deceive.[2] Applicant denied the salient allegations of the notice of opposition. Applicant also asserted certain affirmative defenses. In addition, applicant asserted a counterclaim to partially

[1] Application Serial No. 76403891 was filed on May 6, 2002, based upon applicant's assertion of its bona fide intention to use the mark in commerce.

[2] Registration No. 2,443,015 was issued on April 10, 2001, reciting September 18, 1998 as the date of first use and date of first use in commerce.

cancel opposer's pleaded registration by restricting the identification of goods therein. Specifically, applicant claims that opposer has not made use of its mark in commerce on all of the goods recited in its registration; that rather, opposer has used its mark in commerce only on lutein ester supplements sold directly to manufacturers.

This case now comes before the Board for consideration of opposer's motion for summary judgment on the issues of priority and likelihood of confusion; and applicant's motion for summary judgment on its counterclaim. Both parties submitted responses to the respective motions for summary judgment.[3]

It has often been said that summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986). The evidence must be viewed in a light favorable to the non-movant, and all justifiable

[3] In addition, both parties filed reply briefs which the Board has entertained. Consideration of reply briefs is discretionary on the part of the Board. *See* Trademark Rule 2.127(a). Further, in light of the Board's July 6, 2004 order *inter alia* resetting the parties' time in which to brief opposer's summary judgment motion, applicant's June 30, 2004 motion to strike opposer's earlier-filed reply brief is moot.

inferences are to be drawn in the non-movant's favor. *See Opryland USA, Inc. v. Great American Music Show, Inc.,* 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993).

The Board turns first to applicant's summary judgment motion inasmuch as our determination thereof may have a bearing on opposer's assertion that there exists a likelihood of confusion.[4] After reviewing the arguments and supporting papers of the parties, we conclude that applicant has failed to meet its burden of showing the lack of a genuine issue that opposer's use of its mark has been as limited with regard to scope and trade channels as applicant claims.

We turn next to opposer's summary judgment motion. Inasmuch as we have determined above that there are genuine issues with regard to the goods upon which opposer has used its mark in commerce, we find that it is inappropriate to dispose of opposer's likelihood of confusion claim by summary judgment. In other words, so long as it remains possible that opposer's registration may ultimately be restricted, we cannot say that there are no genuine issues

[4] Opposer's objection to the declaration of applicant's in-house counsel, submitted in support of applicant's summary judgment motion, is noted. However, we find that the declaration is acceptable for purposes of applicant's motion. *See* Fed. R. Civ. P. 56(e), Trademark Rule 2.20 and *Taylor Brothers, Inc. v. Pinkerton Tobacco Co.*, 231 USPQ 412 (TTAB 1986). *See also* TBMP §528.05(b) (2d ed. rev. 2004) and the authorities cited therein. Accordingly, we have considered applicant's declaration and the exhibits filed therewith in our determination of its summary judgment motion.

in dispute regarding the likelihood of confusion analysis required by opposer's claim under Section 2(d). Further, upon review of the arguments and supporting papers of the parties, we conclude that, even if there was no counterclaim, there are genuine issues of material fact which preclude disposition of opposer's claim by summary judgment. At a minimum, there exists a genuine issue of material fact with regard to the similarity or dissimilarity between the parties' marks.

In view thereof, both opposer's motion for summary judgment and applicant's motion for summary judgment are denied.[5]

Trial dates are reset as indicated below. **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. *See* Trademark Rule 2.l25.

DISCOVERY TO CLOSE:	CLOSED
Testimony period for party in position of plaintiff to close (opening thirty days prior thereto)	January 30, 2005
Testimony period for party in position of defendant to close (opening thirty days prior thereto)	March 31, 2005

[5] The parties should note that the evidence submitted in connection with their motions for summary judgment is of record only for consideration of those motions. Any such evidence to be considered at final hearing must be properly introduced in evidence during their appropriate trial periods. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.,* 28 USPQ2d 1464 (TTAB 1993).

Rebuttal testimony period to close (opening fifteen days prior thereto) May 15, 2005

Briefs shall be filed in accordance with Trademark Rule 2.l28(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.