

Wolfson

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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: October 24, 2006

Opposition No. 91163307

Opposition No. 91163331

SARAMAR, L.L.C.

v.

ARCTICSHIELD, INC.

**Before Seeherman, Walters and Walsh,
Administrative Trademark Judges.**

By the Board:

On August 29, 2006, applicant submitted the proper fee for its counterclaim to cancel opposer's pleaded registration No. 2913784. In view thereof, we now consider opposer's motion for summary judgment. Opposer's motion has been fully briefed.

Opposer moves for summary judgment on its pleaded claim of likelihood of confusion. Opposer bases its assertion of priority, a necessary element of the claim, on its pleaded registration. Opposer asserts that it has priority because its registration has an earlier application filing date than applicant's application.

Where an opposer pleads and establishes a valid registration against an application, the issue of priority

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does not arise. In such case, opposer does not have to prove prior use, and the filing date of its registration is irrelevant. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and *David Crystal, Inc. v. Shelburne Shirt Co., Inc.*, 465 F.2d 926, 175 USPQ 112, 113 (CCPA 1972) ("The question of priority does not arise against a registered trademark in an opposition proceeding"). However, in an opposition proceeding where the applicant counterclaims for cancellation of opposer's pleaded registration, the question of priority does arise. See *Ultratan Suntanning Centers Inc. v. Ultra Tan International AB*, 49 USPQ2d 1313 (TTAB 1998); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272, footnote 6 (CCPA 1974) ("prior use need not be shown by an opposer relying on a registered mark unless the applicant counterclaims for cancellation").

Here, in view of applicant's counterclaim to cancel opposer's pleaded registration, opposer may not rely solely on its registration to establish priority. The fact that the filing date of opposer's registration predates applicant's asserted date of first use is irrelevant.

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Opposer has not pleaded prior use or established that no genuine issue of material fact exists as to its priority.¹

Accordingly, opposer has not met its burden of establishing that no genuine issues of material fact exist as to its pleaded claim of likelihood of confusion.²

In view thereof, applicant's motion for summary judgment is denied.³ Proceedings herein are resumed and trial dates, including the close of discovery, are reset as follows. Opposer is allowed until THIRTY DAYS from the mailing date of this order to file its answer to the counterclaim.

THE PERIOD FOR DISCOVERY TO CLOSE:

April 30, 2007

Testimony period for
plaintiff in the opposition to close: (opening thirty days
prior thereto)

July 29, 2007

¹ On the contrary, opposer stated in its notice of opposition that it began using its mark "as early as December 31, 2003," which is later than the filing date, and therefore constructive use date, of applicant's application.

² The fact that we have identified the issue of priority as a genuine issue of material fact sufficient for denying the motion for summary judgment should not be construed as a finding that it is the only issue that remains for trial.

³ The parties should note that the evidence submitted in connection with opposer's motion for summary judgment is of record only for consideration of the motion. To be considered at final hearing, any such evidence must be 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 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

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Testimony period for defendant in the opposition
and as plaintiff in the counterclaim to close: September 27, 2007
(opening thirty days prior thereto)

Testimony period for defendant in the counterclaim
and its rebuttal testimony as plaintiff in the
opposition to close: November 26, 2007
(opening thirty days prior thereto)

Rebuttal testimony period for plaintiff in the
counterclaim to close: January 10, 2008
(opening fifteen days prior thereto)

Briefs shall be due as follows:
[See Trademark Rule 2.128(a)(2)].

Brief for plaintiff in the opposition shall be due: March 10, 2008

Brief for defendant in the opposition and as
plaintiff in the counterclaim shall be due: April 9, 2008

Brief for defendant in the counterclaim and its reply
brief (if any) as plaintiff in the opposition
shall be due: May 9, 2008

Reply brief (if any) for plaintiff in the
counterclaim shall be due: May 24, 2008

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.