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

Goodman

Mailed: January 22, 2007

TTAB

Opposition No. 91169802

Karl Storz Imaging, Inc.

v.

The Imaging Group, LLC

Before Seeherman, Bucher and Cataldo, Administrative
Trademark Judges.

By the Board:

Applicant has filed an intent-to-use application to register the mark **IMAGEONE** for "radiology imaging, specifically; general plain film, diagnostic, CAT scan, mammography, MRI, ultrasound, and interventional imaging" in International Class 44.¹ As grounds for the opposition, opposer alleges that applicant's mark, if used on the identified goods, so resembles opposer's registered marks²



IMAGE 1 and

for "electronic imaging

¹ Application Serial No. 76622434, filed on November 26, 2004.

² Reg. No. 2605738, issued August 6, 2002 and Reg. No. 2615958, issued September 3, 2002.

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equipment, namely, video cameras, computer hardware and related software for operating said equipment, all for industrial, scientific and medical use" in International Class 9 as to be likely to cause confusion, mistake or to deceive. Opposer has also alleged that applicant is not entitled to registration "due to improper conduct in making misleading statements to the USPTO."

In its answer, applicant denies the salient allegations in the notice of opposition.

This case now comes up on opposer's motion for summary judgment, filed September 29, 2006, on the claims of priority and likelihood of confusion. The motion is fully briefed.

In connection with the motion for summary judgment, we have reviewed the pleadings. Our review reveals that opposer alleges, among other things, that applicant made misleading statements to the USPTO with regard to the channels of trade of the parties' goods and services and that such statements resulted in the Examining Attorney's withdrawal of the refusal to register based on opposer's registrations. Opposer asserts that, due to this improper conduct, applicant is not entitled to a registration.

(Paragraphs 12, 13, and 14 of the notice of opposition). It is unclear whether opposer makes these allegations as further support of its likelihood of confusion claim or

whether opposer is attempting to assert a fraud claim. To the extent that opposer is attempting to assert the ground of fraud, it must clearly state this in order to put applicant on notice of the claim.³ Accordingly, if opposer wishes to assert the ground of fraud in addition to the ground of likelihood of confusion, it must file an amended notice of opposition that clearly sets forth the claim.⁴ Opposer is allowed 15 days from the mailing date of this order to file such an amended notice.

We now turn to the motion for summary judgment.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute and the moving party is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). The 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 a judgment as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986). The evidence must be viewed in a light favorable to the non-moving party, and all reasonable inferences are to be drawn in the non-

³ The ground of fraud must be pleaded with particularity. See Fed. R. Civ. P. 9(b).

⁴ The elements for a fraud claim are: the statement in question was false; the statement was made with knowledge that it was false; and the statement was material to the Examining Attorney's decision to approve the application. See, e.g., *Torres v. Cantine Torresella S.r.L.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986).

movant's favor. Thus, in considering the propriety of summary judgment, the Board may not resolve issues of material fact against the non-moving party; it may only ascertain whether such issues are present. See, e.g., *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Olde Tyme Foods, Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

Upon consideration of the arguments and evidence of the parties, we find genuine issues of material fact, at a minimum, with respect to the strength⁵ of opposer's marks and the relatedness of the goods and services.⁶

In view thereof, opposer's motion for summary judgment is denied. Opposer is allowed 15 days in which to file an amended notice of opposition, failing which the opposition will go forward solely on the ground of likelihood of confusion.

Proceedings are otherwise suspended.

⁵ While third-party registrations do not prove use of the marks, the registrations are sufficient to raise a genuine issue of material fact with respect to the extent of use by third parties of marks including the terms. See *Lloyds Food Products*, *supra*.

⁶ The fact that we have identified certain genuine issues of material fact as a sufficient basis for denying opposer's motion for summary judgment should not be construed as a finding that these are necessarily the only issues that remain for trial.

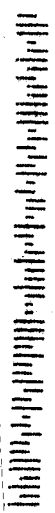
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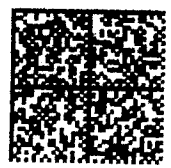
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