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

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Mailed: April 25, 2012

Opposition No. 91186206

General Motors Company

v.

California Motors LLC

Before Quinn, Ritchie, and Kuczma,
Administrative Trademark Judges.

By the Board:

This case comes up on opposer's motion (filed June 13, 2011) for partial summary judgment on the ground of priority and likelihood of confusion.

Motion for Summary Judgment

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to any material facts, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). General Motors Company, as the party moving for summary judgment, has the initial burden of demonstrating that there is no genuine

dispute of material fact remaining for trial and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1987); and *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). California Motors LLC, as the nonmoving party, must be given the benefit of all reasonable doubt as to whether genuine disputes 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).

The Board presumes familiarity with the issues, and for the sake of efficiency this order does not summarize the parties' arguments raised in the motion, brief in opposition thereto, or reply in support thereof. Upon careful consideration of the arguments and evidence presented by the parties, and drawing all inferences with respect to opposer's motion in favor of California Motors LLC as the nonmoving party, we find that General Motors Company has not demonstrated the absence of a genuine dispute of material fact for trial. Genuine disputes of material fact remain, at a minimum, as to priority, abandonment, and residual

goodwill.[1] In view thereof, opposer's motion for summary judgment is denied.[2]

Dilution

Although opposer did not move for summary judgment on the pleaded ground of dilution, we nonetheless address the dilution claim pleaded in the notice of opposition.

In order to properly assert a ground of dilution, a plaintiff must plead that its mark is famous and became famous prior to the applicant's filing date and/or use of the mark. *See Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164, 1174 (TTAB 2001). In the notice of opposition, opposer alleges that applicant's mark so resembles opposer's mark "as to cause dilution of [o]pposer's famous EV1 mark..." (para. 8); however, opposer does not allege that its mark became famous prior to applicant's filing date. In view thereof, opposer's ground of dilution is not well-pled.[3]

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[1] The fact that we have identified genuine disputes as to material facts as a sufficient basis for denying opposer's motion for partial summary judgment should not be construed as a finding that these are necessarily the only issues which remain for trial. *See, for example, Am. Express Mktg. & Dev. Corp. v. Gilad Dev. Corp.*, 94 USPQ2d 1294, 1301 n.5 (TTAB 2010).

[2] The parties are reminded that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced during the appropriate trial period. *See, for example, Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

[3] We do not construe opposer's statement on the last page of its motion for summary judgment that its reputation would be "tarnished" by applicant's use of the mark to indicate that opposer seeks summary judgment on its dilution ground. The

In view thereof, opposer is allowed until May 14, 2012, in which to file an amended notice of opposition that properly alleges dilution; failing which, the ground of dilution will be stricken and this case will proceed to trial only on the ground of priority and likelihood of confusion.[4] Applicant is allowed until May 30, 2012, in which to file an answer to the amended notice of opposition, if an amended notice of opposition is filed.

Schedule

Proceedings are resumed. Dates are reset on the following schedule.

Amended Notice of Opposition Due, if Filed	**5/14/2012**
Answer to Amended Notice Due, if Amended Notice is filed	**5/30/2012**
Plaintiff's Pretrial Disclosures	**6/1/2012**
Plaintiff's 30-day Trial Period Ends	**7/16/2012**

motion is clearly titled as one for partial summary judgment, and opposer argues the ground of priority and likelihood of confusion. Had opposer intended to move for summary judgment on the ground of dilution, it could not have obtained summary judgment thereon because, at a minimum, dilution is improperly pleaded in the complaint. *See, e.g.*, *Asian and Western Classics B.V. v. Lynne Selkow*, 92 USPQ2d 1478, 1480 (TTAB 2009); and *Intermed Communications, Inc. v. Chaney*, 197 USPQ 501, 503 n.2 (TTAB 1977)("if a claim has not been properly pleaded one cannot obtain summary judgment thereon").

[4] While it is permissible for opposer to replead a proper dilution claim, we remind opposer that "[f]ame for dilution purposes is difficult to prove … The party claiming dilution must demonstrate by the evidence that its mark is truly famous." *See Toro Co. v. ToroHead Inc.*, *supra*, at 1180 (TTAB 2001). *See also Avery Dennison Corp. v. Sumpton*, 189 F.3d 1868, 51 USPQ2d 1801, 1805 (9th Cir. 1999)("The Federal Trademark Dilution Act of 1995 applies only to a very select class of marks - those with such powerful consumer associations that even non-competing uses can impinge upon their value.").

Defendant's Pretrial Disclosures	**7/31/2012**
Defendant's 30-day Trial Period Ends	**9/14/2012**
Plaintiff's Rebuttal Disclosures	**9/29/2012**
Plaintiff's 15-day Rebuttal Period Ends	**10/29/2012**

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.l25. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.