

Goodman

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

**THIS OPINION IS NOT
A PRECEDENT
OF THE TTAB**

Mailed: May 13, 2013

Opposition No. **91192645**

Trummer Bar, LLC¹, Heather
Tierney, Christopher Tierney
and Eric Lopez

v.

Albert Trummer

**Before, Seeherman, Ritchie and Wolfson, Administrative
Trademark Judges.**

By the Board:

This case now comes up on opposers' motion, filed July 10, 2012, for summary judgment on the Section 2(d) ground, the fraud ground, and on the ground that applicant lacked a bona fide intent to use the mark in commerce in connection with the goods in the application. Applicant filed, on August 14, 2012, a cross-motion for summary judgment on the basis that the opposition is untimely because the extensions of time to oppose filed by Trummer Bar LLC constituted an ultra vires act not authorized under the terms of opposer Trummer Bar LLC's operating agreement, resulting in the

¹ Opposer states in its motion that by legal change of name, Trummer Bar, LLC is now Apotheke, LLC. However, opposer did not submit documentation in support; accordingly, we will not change the caption of this proceeding at this time. TBMP Section 512.02 (3d ed. rev. 2012).

opposition being null and void. Applicant further argues that the opposition is null and void because individual members of Trummer Bar LLC, namely Heather Tierney, Christopher Tierney and Eric Lopez, lacked the authority to act on behalf of Trummer Bar LLC in filing extensions of time to oppose, and therefore their filings were also ultra vires acts.

We have considered the parties' arguments and submissions and presume the parties' familiarity with the factual bases for the motions. Accordingly, we do not recount the facts or arguments here, except as necessary to explain the decision.

We turn first to applicant's cross-motion. Although applicant has captioned his cross-motion as one for summary judgment, we treat it as a motion to dismiss the opposition proceeding as untimely filed. See *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075 n.1 (TTAB 1993). Applicant essentially claims that the opposition should be time-barred because opposers did not have the authority to obtain the extensions of time such that the opposition filed on November 11, 2009 could be considered timely.

Applicant's arguments in his cross-motion focus on the alleged ultra vires August 12, 2009 filings of the extensions of time to oppose by opposers, and not on the filing of the opposition itself. Applicant concedes in his reply brief that the approvals signed August 22, August 24,

and August 25, 2009 by a majority of the members were effective under Section 4.03 of Trummer Bar LLC's operating agreement to authorize the November 11, 2009 filing of the notice of opposition itself.² In essence, applicant argues that under the terms of the Trummer Bar LLC Operating Agreement, the co-managers (applicant and Heather Tierney) were required to approve by their unanimous vote the hiring of the Colucci & Umans law firm and to permit the filing by the law firm of the requests for extensions of time to oppose the application. Applicant submits that "since he did not vote to approve" these actions, the extensions of time filed August 12, 2009 "were filed without authority and are null and void."

Applicant would have us endorse a theory that would effectively result in opposer Trummer Bar LLC or its members being unable to act in the face of actions by the co-managing manager which are alleged to be unauthorized, wrongful, or contrary to the interest of the limited liability company because the co-managing member did not provide his consent to take such action against himself.

We cannot read the operating agreement in such a manner nor can we accept applicant's argument. Trummer Bar LLC is a limited liability company organized under the laws of New

² See applicant's reply at 5 ("the express wording of the document approves prospective acts only, such as applying for a

York. Under New York law, managing members of a limited liability company owe a fiduciary duty to members. *Nathanson v. Nathanson*, 20 A.D.3d 403, 799 N.Y.S.2d 83, 84-85 (N.Y.A.D. 2 Dept. 2005). New York courts also have held that members of a limited liability company owe fiduciary duties to each other essentially on the theory that they are akin to partners.³ *Berman v. Sugo LLC*, 580 F.Supp.2d 191, 204 (S.D.N.Y. 2008).

Nothing in the operating agreement suggests substantive restrictions on a member such that he or she could not take action in the event of a breach of fiduciary duty or other wrongful act contrary to the interests of the limited liability company by another member or managing member. In any event, despite applicant's arguments to the contrary, the majority approval⁴ effectively ratified retroactively the hiring of the law firm and the filings of the extensions of time to oppose.⁵

further extension request of the time to oppose or the filing of a notice of opposition").

³ Members may be required to take action in a manner they believe to be in good faith to be in the best interest of the company. Section 4.03 of the Trummer Bar LLC Operating Agreement addresses these obligations by providing for majority approval of ". . . any action, decision or similar step required or permitted to be taken by the Members. . . ."

⁴ The approval states that "The Members hereby authorize Colucci & Umans a law firm . . . to apply for an extension of time to oppose the Application and to prepare and prosecute a Notice of Opposition against the Application on behalf of Trummer Bar, LLC."

⁵ "Ratification is the express or implied adoption, i.e., recognition and approval, of the unauthorized acts of another." *RLI Ins. Co. v. Athan Contracting Corp.*, 667 F.Supp.2d 229, 235

Accordingly, we find that the extensions of time to oppose are properly filed and granted, and therefore the opposition was timely and was properly instituted.

In view thereof, applicant's motion to dismiss is DENIED.

We now turn to opposers' motion for summary judgment.

A party is entitled to summary judgment when it has demonstrated that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). In reviewing a motion for summary judgment, the evidentiary record and all reasonable inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the nonmoving party. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

With respect to the fraud ground,⁶ we find, at a minimum, genuine disputes of material fact remain with respect to applicant's intent to commit fraud on the Office.

(E.D.N.Y. 2009) (citation omitted). See e.g., *In re Securities Group*, 926 F.2d 1051, 1055, n.9 (11th Cir. 1991) (discussing New York law that provides the ability of a partnership to ratify acts that lie outside the scope of its business such that a partnership can ratify an act after it occurs.)

⁶ Although opposer has used the "knew or should have known" language in its pleading, which has been found insufficient, see *In re Bose Corp.*, 580 F.3d 124091 USPQ2d 1938 (Fed. Cir. 2009), based on the rest of the fraud allegations, we construe the pleading to allege a knowing material misrepresentation of fact in connection with applicant's application i.e., that applicant "knew" and not merely that he "should have known." *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1485 (Fed.

As our precedent notes, the factual question of intent is particularly unsuited to disposition on summary judgment. *Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1299 (Fed. Cir. 1991).

Accordingly, opposers' motion for summary judgment is DENIED with respect to the fraud ground.⁷

With respect to opposers' motion seeking judgment on the basis that applicant lacks a bona fide intent to use the mark in commerce in connection with any of the goods in the application, opposers are seeking summary judgment on an unpleaded ground. The Board may not grant summary judgment on an unpleaded ground. *See Paramount Pictures Corp. v. White*, 31 USPQ2d 1768 (TTAB 1994); *see also American Express Marketing & Development Corp. v. Gilad Development Corp.*, 94 USPQ2d 1294, 1297 (TTAB 2010) ("the Board will not hesitate to deny any motion for summary judgment on an unpleaded claim or defense unless the motion for summary judgment is

Cir. 1986). If opposer amends the pleading, as discussed *infra*, this should be heeded.

⁷ The fact that we have identified and discussed a particular genuine dispute of material fact as a sufficient basis for denying opposers' motion for summary judgment on this ground should not be construed as a finding that this is necessarily the only dispute which remains for trial. We further note that opposers did not submit any evidence of standing in connection with their motion. Although applicant's answer asserts opposers' lack of standing, standing is part of an opposers' case in chief, and lack of standing is not an affirmative defense. *See Nobelle.com LLC v. Qwest Communications International Inc.*, 66 USPQ2d 1300, 1303 (TTAB 2003) ("'Lack of standing' is not an affirmative defense; rather, standing is an essential element of petitioner's case which, if it is not proved at trial, defeats petitioner's claim").

accompanied by an appropriate motion to amend or is withdrawn and refiled with such a motion to amend").

Accordingly, the motion for summary judgment is DENIED on this unpleaded claim.

With respect to the likelihood of confusion ground, we find that opposers are essentially arguing that applicant is not the owner of the mark, under the guise of a likelihood of confusion claim. Lack of ownership of the mark has not been pleaded, and, inasmuch as we cannot grant summary judgment on an unpleaded ground, opposers' motion for summary judgment is DENIED with respect to the likelihood of confusion claim.

However, opposers are granted leave to amend the pleading in response to our comments herein. Prior to filing any motion for leave to amend, opposers shall contact the interlocutory attorney within FIFTEEN DAYS of the mailing date of this order so that a teleconference can be convened with the parties to provide further instructions.⁸

Proceedings are resumed.

Dates are reset as follows:

Plaintiff's Pretrial Disclosures Due	6/17/2013
Plaintiff's 30-day Trial Period Ends	8/1/2013
Defendant's Pretrial Disclosures Due	8/16/2013
Defendant's 30-day Trial Period Ends	9/30/2013

⁸ Although this case is assigned to Interlocutory Attorney Richard Kim, for purposes of the motion to amend only, Interlocutory Attorney Cheryl Goodman, 571-272-4270, will be handling the teleconference.

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Plaintiff's Rebuttal Disclosures Due	10/15/2013
Plaintiff's 15-day Rebuttal Period Ends	11/14/2013

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.

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 2.129.