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T.T.A.B.

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

MBA

Mailed: April 15, 2011

Opposition No. 91190319 (parent)
Opposition No. 91192759
Opposition No. 91193028
Opposition No. 91193297
Opposition No. 91193298
Opposition No. 91195010
Opposition No. 91195203
Opposition No. 91198555
Cancellation No. 92052531

United States Playing Card Company

v.

Angel Playing Cards Co., Ltd.

**Before Walters, Zervas and Wellington, Administrative
Trademark Judges**

By the Board:

This case now comes up for consideration of United States Playing Card Company's ("opposer") motion, filed December 21, 2010, for summary judgment on Angel Playing Cards Co., Inc.'s ("applicant") counterclaim for abandonment. In addition, opposer's motion includes a motion to amend its involved registration "to reflect [opposer's] mark as [currently] used," and a motion to strike certain exhibits offered by applicant in its response

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to opposer's motion for summary judgment. Opposer's motion is fully briefed.

Background

This case currently comprises eight proceedings in which opposer is plaintiff and applicant is defendant. In each proceeding, applicant seeks or owns registration(s) of a design mark for "Playing cards."¹ Applicant's designs are described in the involved applications and Supplemental Registrations, as for example, "criss-crossing double diagonal lines in a rattan-like weave pattern" and "a repetitive pattern formed by lines made of segments of alternating ovals and circles intersecting at right angles and forming squares ...". In each of its currently-operative, amended pleadings, opposer alleges prior use and registration of four design marks, two of which include words, and all of which are used for "Playing cards,"² as well as prior use of ARISTOCRAT and Design for playing cards. As grounds for opposition and cancellation, opposer alleges that use of applicant's marks is likely to cause confusion with, and dilute, opposer's marks, and "falsely

¹ Application Serial Nos. 77244300 (Opposition No. 91190319), 77498608 (Opposition No. 91192759), 77411633 (Opposition No. 91193028), 77411574 (Opposition No. 91193297), 77411520 (Opposition No. 91193298), 79068914 (Opposition No. 91195010), 77860501, 77860456 and 77860480 (Opposition No. 91195203) and Supplemental Registration Nos. 3759470, 3759471, 3759472 and 3791673 (Cancellation No. 92052531).

² Registration Nos. 48763, 153892, 2694791 and 3049851.

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suggest a connection between Opposer and Applicant in violation of Section 2(a)" of the Act. In its answers, applicant denies the salient allegations in opposer's pleadings, asserts a number of affirmative defenses and counterclaims for cancellation of opposer's pleaded Registration No. 48763 (the "Registration")³ on the ground of abandonment. Specifically, applicant alleges that "although [opposer's Registration] describes [opposer's] Mark as having 'four light parallel strokes or lines' ... the specimens of use submitted in connection with the maintenance of the Subject Registration in 1945, 1965, 1971, 1985 and 2006 contain only three strokes" (emphasis in original). According to applicant, this "constitutes a material alteration" of the mark in the involved Registration and, as a result, opposer "has discontinued use of [the mark in the Registration] with the intent not to resume such use." In its answers, opposer denies the salient allegations in the counterclaim.

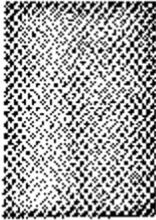
On March 24, 2010, after applicant filed its abandonment counterclaim, opposer filed a new application for registration of its involved mark as currently used,

³ Issued January 9, 1906 from an application filed June 27, 1905, based on dates of first use of 1885.

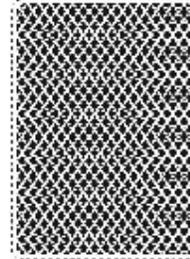
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i.e. with three strokes rather than four.⁴ Applicant opposes registration of this mark in Opposition No. 91198555, alleging that the mark as currently used is "merely ornamental," not inherently distinctive and without acquired distinctiveness. In its answer, opposer denies the salient allegations in this notice of opposition.

The drawings of opposer's mark as originally filed, and as currently used, are reproduced below:



Original (Registration No. 48763)

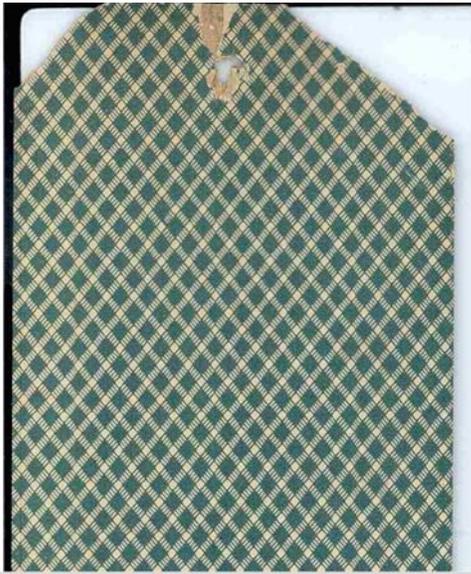


Currently Used
(Application Serial
No. 77967704)

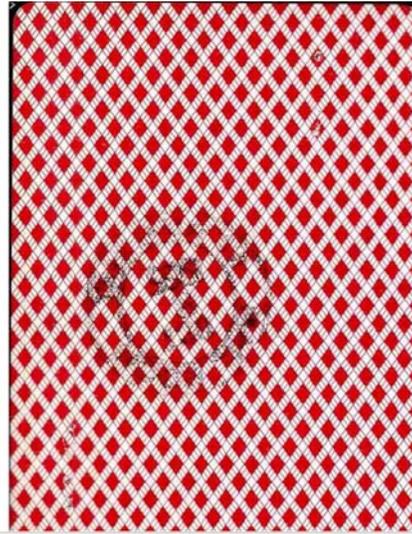
Opposer's specimens of use of the mark submitted at the time it filed its application, and at the time it renewed its involved Registration in 1965, are reproduced below:

⁴ Application Serial No. 77967704, alleging a date of first use of 1885 and claiming acquired distinctiveness under Section 2(f) of the Act.

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Original



Renewal (mark as currently used)

Opposer moves to amend the drawing and description of the mark in its involved Registration "to reflect the three-stroke design currently in use."

Consolidation

When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. See Fed. R. Civ. P. 42(a); see also, Regatta Sport Ltd. v. Telux-Pioneer Inc., 20 USPQ2d 1154 (TTAB 1991); TBMP § 511 (2d ed. rev. 2004). Here, there is no question that Opposition No. 91198555 and the eight previously-consolidated cases involve common questions of law and fact. Indeed, the parties are the same in all nine cases, and the marks, applications, registrations and claims are all related.

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Therefore, Opposition No. 91198555 is hereby consolidated with previously-consolidated Opposition No. 91190319. The consolidated cases may be presented on the same record and briefs. See Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618 (TTAB 1989) and Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993).

The Board file will be maintained in Opposition No. 91190319 as the "parent" case. As a general rule, from this point on only a single copy of any paper or motion should be filed herein; but that copy should bear all nine proceeding numbers in its caption.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file. The discovery and trial schedule in these consolidated cases shall, for the most part, be coextensive with the schedule set in the latest-filed case, Opposition No. 91198555, as set forth below.

Motion for Summary Judgment

Summary judgment is appropriate where there are no genuine issues of material fact in dispute, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P.

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56(a). The movant seeking summary judgment bears the initial burden of demonstrating the absence of any genuine dispute as to any material fact. See, Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986); Sweats Fashions, Inc. v. Pannill Knitting Co. Inc., 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. See, Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); Olde Tyme Foods, Inc. v. Roundy's, Inc., 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

The evidence on summary judgment must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. Lloyd's Food Products, Inc. v. Eli's, Inc., 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); Opryland USA, 23 USPQ2d at 1472. The Board may not resolve disputes of material fact; it may only ascertain whether any disputes as to material facts exist. See, Lloyd's Food Products, 25 USPQ2d at 2029; Olde Tyme Foods, 22 USPQ2d at 1542.

Under Section 45 of the Act, 15 U.S.C. §1127, a mark is considered abandoned when "its use has been discontinued with intent not to resume such use," and "[n]onuse for 3

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consecutive years shall be prima facie evidence of abandonment." Abandonment "is a question of fact." Crash Dummy Movie, LLC v. Mattel, Inc., 601 F.3d 1387, 94 USPQ2d 1315, 1316 (Fed. Cir. 2010).⁵

In this case, on the record presented, we find, at a minimum, that genuine disputes of material fact remain as to whether the "three stroke" form of opposer's mark is a material alteration of the "four stroke" form, and thus whether opposer has abandoned the mark in its involved Registration.⁶ Accordingly, opposer's motion for summary

⁵ Opposer argues that it has not abandoned its mark because "a change in the form of a mark," in this case opposer's change from the "four stroke" form to the "three stroke" form, "does not constitute abandonment or a break in continuous use if the change neither creates a new mark nor changes the commercial impression of the old mark." Paris Glove of Canada, Ltd. v. SBC/Sporto Corp., 84 USPQ2d 1856, 1861 (TTAB 2007). The standard for determining whether the "new" mark changes the commercial impression of the "old" mark is the "material alteration" standard. Id.; Trademark Rule 2.72. The parties dispute whether "material alteration" is a question of fact or law. Compare In re Thrifty Inc., 274 F.3d 1349, 61 USPQ2d 1121, 1123 (Fed. Cir. 2001) ("Whether a proposed amendment constitutes a material alteration of the mark is a question of fact.") and In re Hacot-Columbier, 105 F.3d 616, 41 USPQ2d 1523, 1525 (Fed. Cir. 1997) with In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001) ("Whether marks are legal equivalents is a question of law ...") and Van Dyne-Crotty, Inc. v. Wear-Guard Corp., 926 F.2d 1156, 17 USPQ2d 1866, 1868 (Fed. Cir. 1991). Because the issue here is abandonment, a question of fact, we need not resolve the apparent ambiguity at this time. Moreover, even if legal equivalence of the marks and material alteration are questions of law, and consideration of evidence beyond the marks is not required, that does not mean that the Board may not consider relevant evidence in appropriate cases.

⁶ Opposer's motion to strike certain exhibits to the Declaration of Holly Pekowsky is **GRANTED**, because the exhibits are not properly authenticated. Fed. R. Evid. 901(a). However, even if we had considered the exhibits, they would not have changed the decision herein.

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judgment is hereby **DENIED**. For the same reasons, consideration of opposer's motion to amend the description and drawing of the mark in its Registration is **DEFERRED** until final decision.

Conclusion

Opposer's motion for summary judgment is denied and consideration of its motion to amend the mark in its involved Registration is deferred. Proceedings herein are resumed. Discovery, disclosure, trial and other dates are hereby reset as follows:

Deadline for Discovery Conference	April 21, 2011
Discovery Opens	April 21, 2011
Initial Disclosures Due	May 21, 2011 ⁷
Expert Disclosures Due	September 18, 2011
Discovery Closes	October 18, 2011
Plaintiff's Pretrial Disclosures	December 2, 2011
30-day testimony period for plaintiff's testimony to close	January 16, 2012
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	January 31, 2012
30-day testimony period for defendant and plaintiff in the counterclaim to close	March 16, 2012 ⁸
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	March 31, 2012

⁷ If a discovery conference and/or initial disclosures in Opposition No. 91198555 would be entirely duplicative of the prior conference and disclosures, they need not be repeated. The parties may request that this schedule be abbreviated.

⁸ The testimony periods for Opposition No. 91198555 shall be coextensive with the testimony periods for applicant's counterclaim.

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30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	May 15, 2012
Counterclaim Plaintiff's Rebuttal Disclosures Due	May 30, 2012
15-day rebuttal period for plaintiff in the counterclaim to close	June 29, 2012
Brief for plaintiff due	August 28, 2012
Brief for defendant and plaintiff in the counterclaim due	September 27, 2012
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	October 27, 2012
Reply brief, if any, for plaintiff in the counterclaim due	November 11, 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 2.125.

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.
