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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91207525
Party	Defendant Starbucks Corporation DBA Starbucks Coffee Company
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Attachments	3-3-16 Applicant's Motion to Strike Opposer's Untimely Motion for Summary Judgment.pdf(318688 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

<p>TAZA SYSTEMS, LLC, Opposer,</p> <p style="text-align: center;">v.</p> <p>STARBUCKS CORPORATION dba STARBUCKS COFFEE COMPANY, Applicant.</p>	<p>Opposition No. 91207525</p> <p>Mark: TAZO Serial No.: 85439878 Filed: October 5, 2011</p>
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**APPLICANT’S MOTION TO STRIKE
OPPOSER’S UNTIMELY MOTION FOR SUMMARY JUDGMENT**

Applicant Starbucks Corporation dba Starbucks Coffee Company (“Starbucks” or “Applicant”) moves to strike Opposer’s Motion for Summary Judgment as untimely.

I. Opposer’s Motion is Untimely and Should Be Denied

A motion for summary judgment is a pretrial device, intended to save the time and expense of a full trial when a party is able to demonstrate, prior to trial, that there is no genuine issue of material fact, and that it is entitled to judgment as a matter of law. *See* TBMP §528.01, and the authorities cited therein. The primary purpose of a motion for summary judgment is to avoid the time and expense involved in a trial by the early disposal of cases in which there is no genuine issue as to any material fact. *La Maur, Inc. v. The Bagwells Enters., Inc.*, 193 U.S.P.Q. 234, 235 (T.T.A.B. 1976). It is, however, well settled that the motion should be made and pressed within such time as not to delay trial. *Id.*

Pursuant to 37 C.F.R. §2.127(e)(1), a motion for summary judgment should be filed *before* the commencement of the first testimony period, as originally set or as reset, and the Board may, in its discretion, deny as untimely any motion for summary judgment filed thereafter. *See La Maur*, 193 U.S.P.Q. at 235. Once the first testimony period has commenced,

any summary judgment motion filed during trial is untimely and should be denied, even if no trial evidence has actually been adduced by the plaintiff. *See Id.* at 236 (“A delay in the prosecution of an opposition resulting from a review of a motion for summary judgment is likely to injure the applicant who is awaiting a decision that will affect the full and productive use of its mark”); David J. Kera, *Tips from the TTAB: Summary Judgment*, 71 TRADEMARK REP. 59, 62 (1981); T. Jeffrey Quinn, *Tips from the TTAB: Inter Partes Summary Judgment Revisited*, 76 TRADEMARK REP. 73, at 73-74 (1986) (“The purpose of summary judgment is to avoid a useless trial...Consequently, once the period of a plaintiff’s testimony-in-chief has opened, a motion for summary judgment is untimely and will be denied on that basis.”). Opposer’s Motion for Summary Judgment, which was filed *after* the commencement of the most recently rescheduled first testimony period, should thus be denied as untimely.

This Opposition has a long, complicated, and motion-filled history. Initiated by Opposer on September 5, 2012, this action has been pending before the Board for three-and-a-half years. For the past one-and-one-half years, the proceeding has been delayed as result of Opposer’s repeated discovery violations, necessitating Applicant’s filing of a motion to compel, and a motion to test the sufficiency of responses to requests for admission (as to both of which Applicant prevailed).

Under the Board’s rules, a motion for summary judgment can be filed at any time following the parties’ exchange of initial disclosures. Significantly, Opposer revealed to both Applicant and the Board its intention to file a motion for summary judgment over eight months ago—in its Opposition to Applicant’s Motion to Test the Sufficiency of Opposer’s Responses to Requests for Admission, For Sanctions, and to Compel filed on June 17, 2015. In that pleading, Opposer claimed that it was “diligently working on a motion for summary judgment,

due June 1, 2015” and had already expended “thousands of dollars in attorney’s fees” in doing so.¹ Despite same, Opposer did not file its motion for summary judgment when proceedings subsequently resumed and before the commencement of its testimony period.

On February 17, 2016, the Board issued an Order compelling Opposer’s full responses to various of Applicant’s discovery requests by March 3, 2016, and resetting the close of Opposer’s testimony period for March 10, 2016. At the urging of Opposer, on February 18, 2016, the Board issued a revised scheduling order extending the close of Opposer’s thirty-day testimony period to March 29, 2016. According to the revised schedule, Opposer’s thirty-day testimony period opened on Sunday, February 28, 2016. Under the Board’s rules, the last day on which Opposer’s motion for summary judgment could have been timely filed was Saturday, February 27, 2016. Opposer’s motion was not filed by that deadline but, instead, after the start of its testimony period—on February 28, 2016.

As noted above, the primary purpose of a motion for summary judgment is to avoid the time and expense involved in a full trial on the merits. A motion for summary judgment is potentially dispositive of a proceeding and, as such, requires a review and consideration by three members of the Board. TBMP §502.04. Where, as here, the motion for summary judgment will be highly contested, and requires the Board to issue a ruling on the ultimate issues of fact and law, ruling on the motion will require as much time and effort as would be required to have a full

¹ Opposer also claimed in its response that Starbucks was aware of Opposer’s plan to file a Motion for Summary Judgment as of the Motion to Compel’s May 28, 2015 filing date, and that said motion was filed to “thwart” Opposer’s plans to file for summary judgment, thus causing Opposer to “rack up thousands of dollars in attorney’s fees” which expenditures were “squandered.” Opposer’s false representation to the Board about Starbucks’ knowledge of Opposer’s strategic plans was improper. Opposer’s claim that Applicant’s Motion to Compel would preclude its filing of any motion for summary judgment is not credible.

trial on the merits. Four years into this proceeding, there is no advantage to be gained, and no savings of time or effort prompted, by consideration of Opposer's untimely motion.

In prior decisions, the Board has expressly recognized that the principles governing such a motion should be applied in a common sense manner to the realities of the litigation at hand. The Board's decision in *La Maur* is instructive. There, because the opposer's testimony period opened on March 4, 1975, its motion for summary judgment (filed a little over a week after that date) was denied as untimely. *La Maur*, 193 U.S.P.Q. at 235. The Board then reset the opposer's testimony period to run from May 25, 1975 until June 24, 1975. On May 22—before the commencement of the newly-reset testimony period—the opposer re-filed its motion for summary judgment. *Id.* The Board again refused to consider the motion due to its untimeliness (even though it was technically filed before the start of the newly-reset testimony period). *Id.* The Board explained that “[a]t some point in the litigation, common sense dictates that it would require as much time and effort to review a motion for summary judgment as it would to have a full trial of the merits. *Id.* At that point, where there is no advantage to be gained in savings of time or effort, justice and judicial economy are best served by denying the motion as untimely and proceeding to trial.” *Id.* at 236. The Board stressed that “[t]his is particularly true when the issue presented by the motion is, as in this case, one of confusing similarity—an issue involving a degree of subjectivity and thus not readily determinable on a motion for summary judgment.” *Id.*

Here too, common sense dictates that judicial economy will be best served by denying Opposer's motion as untimely, and proceeding to trial. Indeed, Opposer's motion, improperly filed after the commencement of the testimony period, would require the Board to adjudicate as a matter of law the issue of likelihood of confusion, make fact-intensive determinations as to

conflicting linguistic expert reports submitted by both parties, and summarily adjudicate the entirety of Applicant's counterclaim to restrict Opposer's services—all without the aid of trial testimony, cross examinations, and trial briefs.

II. The Board Should Not Suspend Proceedings

According to the Board's Order of February 17, 2016, Opposer's responses to Applicant's discovery (which discovery was served on Opposer *over two years ago*) are due on March 3, 2016. The action's history reflects the significant delay that has occurred throughout the proceedings, depriving Applicant of a timely ruling that will affect the full and productive use of its mark. Because Opposer's Motion for Summary Judgment is untimely, the Board should not further suspend (and thus further delay) the proceedings in this case. Instead, Applicant respectfully requests that the Board, in its discretion, issue an immediate order denying Opposer's Motion as untimely that would allow the parties to finally proceed to trial.

If the Board, in its discretion, decides to consider Opposer's Motion for Summary Judgment, Applicant respectfully requests that it be permitted thirty (30) days to further substantively respond. Applicant does not substantively respond at this time in the interest of economy and judicial efficiency.

Dated: March 3, 2016

By: /Julia Anne Matheson/
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CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing APPLICANT'S MOTION TO STRIKE OPPOSER'S MOTION FOR SUMMARY JUDGMENT was served by first class mail, postage prepaid, on this 3rd day of March 2016, upon counsel for Opposer at the following address of record:

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