

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

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

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Mailed: December 27, 2016

Opposition No. **91207525**

Taza Systems, LLC

v.

Starbucks Corporation
d/b/a Starbucks Coffee Company

**Before Taylor, Masiello and Hightower,
Administrative Trademark Judges**

By the Board:

On September 5, 2012, Opposer filed a notice of opposition opposing the registration of Application Serial No. 85439878 for the mark TAZO in standard characters.¹ Opposer has asserted a claim of priority and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a pleading of three registered marks comprised, in whole or in part,

¹ Filed October 5, 2011, under Section 1(b) of the Trademark Act for goods and services in International Classes 3, 4, 29, 30, 32, 35 and 43. Only certain of the services in Class 35, i.e., “franchising, namely, providing technical assistance in the establishment and operation of restaurants, cafes, tea houses, coffee houses, and snack bars,” and all of the services in Class 43, i.e., “restaurant, cafe, cafeteria, snack bar, tea house, coffee bar and coffee house, carry out restaurant, and take out restaurant services; catering services; contract food services; food and beverage preparation,” are opposed.

of the term TAZA, and all for “restaurant and bar services” in International Class 43.² All three registrations contain a translation of TAZA as “fresh.”

On June 11, 2014, Applicant successfully sought leave of the Board to amend its answer to assert a counterclaim to restrict, under Section 18 of the Trademark Act, 15 U.S.C. § 1068, the services in each of the pleaded registrations to “restaurant and bar services, namely ethnic Lebanese restaurant and bar services.”

This matter now comes up on Opposer’s motion (filed February 28, 2016) for summary judgment on its Section 2(d) claim and Applicant’s Section 18 counterclaim. The motion is fully briefed.

The Board presumes the parties’ familiarity with the issues herein. Therefore, for the sake of efficiency, this order does not summarize the parties’ arguments raised in the briefs.

Decision

A motion for summary judgment is a pretrial device intended to save the time and expense of a full trial when the moving party is able to demonstrate, prior to trial, that there is no genuine dispute of material fact, and that it is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(a); *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Sweats*

² Registration No. 3213261 for TAZA A LEBANESE GRILL in standard characters with a disclaimer of A LEBANESE GRILL, Registration No. 3213262 for TAZA A LEBANESE GRILL in stylized form with a disclaimer of A LEBANESE GRILL, and Registration No. 3439240 for TAZA in standard characters.

Fashions Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). The evidence must be viewed in a light most favorable to the non-moving party, and all reasonable 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, supra*.

Upon careful consideration of the arguments and evidence presented by the parties, and drawing all inferences with respect to the motion in favor of Applicant as the nonmoving party, we find that Opposer has failed to demonstrate the absence of a genuine dispute of material fact for trial. Concerning its claim of likelihood of confusion, we find, at a minimum, a genuine dispute of material fact as to the similarities in sound and commercial impression of the parties' marks as well as the strength of Opposer's marks. As to Applicant's counterclaim, we find genuine disputes of material fact as to the commercial significance³ and accuracy⁴ of the proposed

³ While we are mindful that Applicant's own restaurant services are not correspondingly restricted, it would be premature and improper to decide the question of the Section 18 restriction separate and apart from the question of whether there is a likelihood of confusion between the marks. *See Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1270 (TTAB 1995) (in a proceeding involving likelihood of confusion, Board will not exercise authority under Section 18 to restrict an application or registration where restriction is divorced from the question of likelihood of confusion). Indeed, should the Board determine that a restriction to the involved Application is appropriate, we note that Applicant has previously agreed to restrict its application, as necessary, to conform to the findings of the Board pursuant to Trademark Rule 2.133(b). *See Reply in Support of Applicant's Motion for Leave to File an Amended Answer and Counterclaim*, 31 TTABVue 10.

⁴ There appears to be a dispute as to the scope of services offered under Opposer's pleaded marks. A consideration of the nature and extent of the non-Lebanese

Section 18 restriction. *See Eurostar Inc.*, 34 USPQ2d at 1270. Accordingly, Opposer's motion for summary judgment is hereby **DENIED**.⁵

Proceedings herein are **RESUMED** and the parties are ordered to proceed to trial. Dates are **RESET** as follows:

Plaintiff's testimony period opens	1/2/2017
30-day testimony period for plaintiff's testimony to close	1/31/2017
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	2/15/2017
30-day testimony period for defendant and plaintiff in the counterclaim to close	4/1/2017
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	4/16/2017
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	5/31/2017
Counterclaim Plaintiff's Rebuttal Disclosures Due	6/15/2017
15-day rebuttal period for plaintiff in the counterclaim to close	7/15/2017
Brief for plaintiff due	9/13/2017
Brief for defendant and plaintiff in the counterclaim due	10/13/2017
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	11/12/2017
Reply brief, if any, for plaintiff in the counterclaim due	11/27/2017

offerings must necessarily be a part of any determination of whether Opposer is using the mark on the services Applicant seeks to exclude from the registrations.

⁵ 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, e.g., Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

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 taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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NOTICE: CHANGES TO THE TRADEMARK TRIAL AND APPEAL BOARD (“BOARD”) RULES OF PRACTICE WILL BE EFFECTIVE JANUARY 14, 2017.

The USPTO published a Notice of Final Rulemaking in the Federal Register on October 7, 2016, at 81 Fed. Reg. 69950. It sets forth **several** amendments to the rules that govern *inter partes* (oppositions, cancellations, concurrent use) and *ex parte* appeal proceedings. A correction to the final rule was published on December 12, 2016, at 81 Fed. Reg. 89382.

For complete information, the parties are referred to:

- The Board’s home page on the uspto.gov website:
<http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab>
- The final rule:
<http://www.uspto.gov/sites/default/files/documents/81%20FR%2069950.pdf>
- The correction to the final rule:
<http://www.uspto.gov/sites/default/files/documents/81%20FR%2089382.pdf>
- A chart summarizing the affected rules and changes:
<http://www.uspto.gov/sites/default/files/documents/Chart%20Summarizing%20Rule%20Changes%2012-9-16.pdf>

For **all** proceedings, including those **already in progress on January 14, 2017**, some of the changes are:

- All pleadings and submissions must be filed through ESTTA. Trademark Rules 2.101, 2.102, 2.106, 2.111, 2.114, 2.121, 2.123, 2.126, 2.190 and 2.191.
- Service of all papers must be made by email, unless otherwise stipulated. Trademark Rule 2.119.
- Response periods are no longer extended by five days for service by first-class mail, Priority Mail Express®, or overnight courier. Trademark Rule 2.119.
- Deadlines for submissions to the Board that are initiated by a date of service are 20 days. Trademark Rule 2.119. Responses to motions for summary judgment remain 30 days. Similarly, deadlines for responses to discovery requests remain 30 days.
- All discovery requests must be served early enough to allow for responses prior to the close of discovery. Trademark Rule 2.120. Duty to supplement discovery responses will continue after the close of discovery.
- Motions to compel initial disclosures must be filed within 30 days after the deadline for serving initial disclosures. Trademark Rule 2.120.
- Motions to compel discovery, motions to test the sufficiency of responses or objections, and motions for summary judgment must be filed prior to the first pretrial disclosure deadline. Trademark Rules 2.120 and 2.127.
- Requests for production and requests for admission, as well as interrogatories, are each limited to 75. Trademark Rule 2.120.
- Testimony may be submitted in the form of an affidavit or declaration. Trademark Rules 2.121, 2.123 and 2.125.
- New requirements for the submission of trial evidence and deposition transcripts. Trademark Rules 2.122, 2.123, and 2.125.
- For proceedings **filed on or after January 14, 2017**, in addition to the changes set forth above, the Board's notice of institution constitutes service of complaints. Trademark Rules 2.105(a) and 2.113(a).

This is only a summary of the significant content of the Final Rule. All parties involved in or contemplating filing a Board proceeding, regardless of the date of commencement of the proceeding, should read the entire Final Rule.