

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

mw/ey

Mailed: January 6, 2017

Opposition No. 91224000

Spiritline Cruises LLC

v.

Tour Management Services, Inc.

Michael Webster, Interlocutory Attorney:

On December 23, 2016, Spiritline Cruises LLC (“Opposer”) filed a motion for summary judgment on the following asserted grounds: (1) the mark has not acquired distinctiveness; (2) the specimens submitted with the application are not acceptable under 37 C.F.R. 2.56; (3) the subject application is *void ab initio* because it was not filed by the owner of the mark; and (4) Applicant’s use of the mark is inconsistent with an assertion of trademark rights.¹

Pursuant to Fed. R. Civ. P. 56(a) a party may move for summary judgment on a claim or defense or a part of a claim or defense. However, a party may not obtain summary judgment on an issue that has not been pleaded. *Asian and Western Classics B.V. v. Lynne Selkow*, 92 USPQ2d 1478, 1480 (TTAB 2009); *Bausch & Lomb*

¹ Claim No. 4 in the motion appears to allege that the mark has been abandoned, under Trademark Act Section 45, 15 U.S.C. § 1127, due to the conduct of Applicant causing the mark to become the generic name for the services.

Inc. v. Karl Storz GmbH & Co. KG, 87 USPQ2d 1526, 1528 n.3 (TTAB 2008); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1438 n.12 (TTAB 2007).

In the notice of opposition (filed September 23, 2015), Opposer's sole pleaded claim is that the mark is highly geographically descriptive and has not acquired distinctiveness.² Because Opposer has not pleaded claim Nos. 2, 3, and 4 of the motion for summary judgment, the Board will not consider the unpleaded claims in determining the motion. *See Bausch & Lomb Inc.* 87 USPQ2d at 1528 n.3.

In addition, the Board notes that the insufficiency of the specimens does not constitute grounds for opposition. *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1358 (TTAB 1989); *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989) ("it is not the adequacy of the specimen, but the underlying question of service mark usage which would constitute a proper ground for opposition").³ Thus, Opposer's second ground for opposition in the motion for summary judgment is not a viable claim.

In view of the above, proceedings are **suspended** pending disposition of Opposer's motion for summary judgment solely with respect to the claim of lack of acquired distinctiveness. Any paper filed during the pendency of this motion which is not relevant thereto will be given no consideration. *See Trademark Rule 2.127(d)*.⁴

² The ESTTA cover sheet for the notice of opposition also identifies genericness under Trademark Act Section 23 as grounds for opposition. However, Opposer has not pleaded the genericness claim in the body of the complaint.

³ Moreover, if the Examining Attorney had objected to the specimens during examination, Applicant would have had an opportunity to submit acceptable substitute specimens. *See Century 21*, 10 USPQ2d at 2035.

⁴ To be clear, in response to the motion for summary judgment, Applicant need only address claim No. 1, namely, lack of acquired distinctiveness.

In addition to tolling the time to respond to outstanding discovery requests, suspension of proceedings tolls the time for parties to make required disclosures. *See* TBMP § 528.03.

The motion for summary judgment will be decided in due course.