This is not a precedent of the TTAB.

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: March 30, 2018

Opposition No. 91229200
Opposition No. 91232397

Ganz

v.

SJM Partners, Inc.

Before Cataldo, Mermelstein, and Hightower,
Administrative Trademark Judges.

By the Board.

Applicant has applied to register the mark GOOGLES[1] for "Educational and entertainment services, namely, a continuing program about animated characters accessible by means of radio, television, satellite, audio, video, web-based applications, mobile phone applications and computer networks" in International Class 41. Applicant has also applied to register the mark GOOGLES[2] for "Digital media, namely, pre-recorded DVDs, downloadable audio and video recordings, and CDs featuring and promoting games and animated characters" in International Class

[1] Application Serial No. 86052534, filed on August 30, 2013, claiming a bona fide intention to use the mark in commerce under Trademark Act Section 1(b).

[2] Application Serial No. 86053370, filed on August 31, 2013, claiming a bona fide intention to use the mark in commerce under Trademark Act Section 1(b).

9 and for "Wearable garments and clothing, namely, shirts" in International Class 25.[3]

As grounds for the opposition, Opposer alleges that Applicant's marks, when used on the identified goods and services, so resembles Opposer's previously used and registered mark GOOGLES for "plush toys" in International Class 28[4] as to be likely to cause confusion, mistake or deception. In addition, Opposer alleges fraud on the Office in the procurement of Applicant's applications and breach of contract involving a coexistence agreement between the parties.

Applicant denies the salient allegations of the notice of opposition and asserts certain affirmative defenses.

This case now comes up on Opposer's motion (filed October 4, 2017) for partial summary judgment based on its claim that Applicant has violated the coexistence agreement between the parties by applying to register the word mark GOOGLES alone, without incorporating a design element discussed *infra*. Applicant cross-moved for summary judgment on November 3, 2017. In such cross-motion, Applicant agrees with Opposer that the coexistence agreement between Opposer and Applicant's predecessor-in-interest, Steven Silvers, disposes of the issues in these proceedings. But Applicant argues that rather than providing a basis for refusing the two trademark applications at issue here, the coexistence agreement estops Opposer from

[3] In a February 2 2017 paralegal order (14 TTABVUE), the Board approved the parties' January 27, 2017 stipulation to consolidate (13 TTABVUE). We refer in this decision to the briefs and evidence in the parent proceeding, Opposition No. 91229200, unless otherwise noted.

[4] Registration No. 2554518, issued April 2, 2002; renewed.

opposing the applications because the agreement permits Applicant to use the GOOGLES mark on the goods and services identified in the subject applications. Applicant, therefore, asks the Board to dismiss the oppositions in their entirety based on contractual estoppel.[5]

Summary judgment is only appropriate when there is no genuine dispute as to any material fact and the moving party is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(a). The Board may not resolve issues of material fact; it may only ascertain whether a genuine dispute regarding a material fact exists. *See Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). 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. *Opryland USA Inc. v. Great Am. Music Show Inc.,* 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods,* 22 USPQ2d at 1542. The mere fact that cross-motions for summary judgment have been filed does not necessarily mean that there are no genuine disputes of material fact, or that a trial is unnecessary. *See Univ. Book Store v. Univ. of Wis. Bd. of Regents,* 33 USPQ2d 1385, 1389-90 (TTAB 1994).

In support of its position, Opposer asserts that in 2001 Opposer and Applicant's predecessors-in-interest, Steven A. Silvers and the Googles Children's Workshop (collectively "Silvers"), entered into a coexistence agreement wherein the parties

[5] The parties' stipulated motion filed December 1, 2017 regarding printouts from the Internet Archive is accepted.

agreed to resolve Opposer's then opposition to Silvers' trademark Application Serial No. 75547007 for the mark GOOGLES and design for "plush toys figurines, plastic toy figurines" by agreeing that Silvers would use its mark at all times with the design element as reflected in Application Serial No. 75547007. The mark appeared as follows:

[6]

Opposer asserts that according to the agreement, Opposer was given the unlimited right to register GOOGLES; that Silvers would abandon its application for Serial No. 75547007 and not seek to register at the federal or state level any mark containing, or confusingly similar to, GOOGLES for plush toys; and that Silvers was prohibited from using the word GOOGLES on or in connection with any product, image, or character without also using the character depicted in the design portion of the mark. Opposer alleges that Applicant's present attempt to register the word GOOGLES without the design element is in violation of the coexistence agreement, and would be a source of damage and injury to Opposer within the meaning of Section 13 of the Trademark Act. Opposer moves for summary judgment on the basis that registration of the GOOGLES marks through the two subject applications violates the terms of the coexistence agreement.

[6] Application Serial No. 75547007, filed September 2, 2998, based on Section 1(b) of the Trademark Act. Abandoned on June 11, 2001.

Applicant, on the other hand, seeks judgment as a matter of law arguing that there are no genuine disputes of material fact and that it is entitled to registration of its marks by virtue of the terms of the coexistence agreement between the parties. According to Applicant, contractual estoppel arising from the coexistence agreement disposes of all the grounds of the oppositions raised by Opposer and there is no breach of contract, likelihood of confusion, or fraud. Specifically, Applicant contends that the coexistence agreement imposed certain restrictions on its predecessor involving plush toys, but that "outside the area of plush toys" the coexistence agreement granted Silvers extensive rights to use GOOGLES as a word mark alone, including in connection with the goods and services claimed in the present applications. Moreover, Applicant contends, the use of the word mark GOOGLES by its predecessors confirms this interpretation. Applicant argues that Silvers and his successors continued to use GOOGLES as a word mark after the coexistence agreement was executed and Opposer was aware of this use and did not object to it.

Upon careful consideration of the arguments and evidence presented by the parties, and drawing all inferences in favor of the non-movants with respect to each motion, we find that neither Opposer nor Applicant has demonstrated the absence of a genuine dispute of material fact. At a minimum, the Board finds that genuine disputes of material fact exist as to whether (1) Applicant is estopped from registering the applied-for marks consisting of the word mark GOOGLES alone for goods and services of the types identified in the subject applications, and (2) Applicant has

committed fraud on the Trademark Office by failing to disclose the coexistence agreement in an effort to overcome the Examining Attorney's refusal.

In view thereof, the cross-motions for summary judgment are hereby denied.[7]

Proceedings herein are resumed. Dates are reset as follows:

Expert Disclosures Due	**5/14/2018**
Discovery Closes	**6/13/2018**
Plaintiff's Pretrial Disclosures Due	**7/28/2018**
Plaintiff's 30-day Trial Period Ends	**9/11/2018**
Defendant's Pretrial Disclosures Due	**9/26/2018**
Defendant's 30-day Trial Period Ends	**11/10/2018**
Plaintiff's Rebuttal Disclosures Due	**11/25/2018**
Plaintiff's 15-day Rebuttal Period Ends	**12/25/2018**

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.

[7] The parties should note that the evidence submitted in connection with the motions for summary judgment is of record only for consideration of the motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Josephs Sportswear Inc.,* 28 USPQ2d 1464 (TTAB 1993). In addition, the fact that we have identified and discussed only a few genuine disputes of material fact as a sufficient basis for denying the motions for summary judgment should not be construed as a finding that these are necessarily the only disputes which remain for trial.