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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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JK

October 17, 2019

Opposition No. 91245801

Lenôtre S.A.

v.

Alain LeNotre and Marie LeNotre

Before Thurmon, Deputy Chief Administrative Trademark Judge, Zervas, and Pologeorgis, Administrative Trademark Judges.

By the Board:

Background

On July 15, 2016, Alain LeNotre and Marie LeNotre (Applicants) filed application Serial No. 87105897 to register the mark LENOTRE in standard characters, asserting a bona fide intent to use the mark in commerce pursuant to Trademark Act Section 1(b), 15 U.S.C. § 1051(b), for:

> business consulting, management, and planning services in the field of culinary operations, restaurant management, and catering; business management consulting services in the field of culinary operations, restaurant management, and catering; career advancement consulting services in the field of culinary arts and restaurant operations, in International Class 35;
>
> educational services in the nature of culinary schools; educational services, namely, conducting classes, seminars, conferences, and workshops in the field of culinary arts, baking and pastry arts, and hospitality and restaurant management and distribution of course and

educational materials in connection therewith; educational services, namely, providing courses of instruction at the secondary level and distribution of course material in connection therewith, in International Class 41; and

consulting services in the field of culinary arts; consulting services in the field of hospitality; consulting in the field of menu planning for others; consulting in the field of restaurant menu development; restaurant and bar services, including restaurant carryout services; restaurant, bar and catering services; café and restaurant services, in International Class 43.

Applicants assert acquired distinctiveness pursuant to Trademark Act Section 2(f), 15 U.S.C. § 1052(f), based on ownership of four prior registrations:

1) Registration No. 1510466, registered October 25, 1988, for the mark ALAIN & MARIE LENOTRE, for "retail store services in the field of bakery and confectionary items" in International Class 42;

2) Registration No. 3564112, registered January 20, 2009 for the mark CULINARY INSTITUTE ALAIN & MARIE LENOTRE & design, for "educational services, namely, classes, workshops, and camps in the field of the culinary arts" in International Class 41;

3) Registration No. 4683926, registered February 10, 2015 for the mark CULINARY INSTITUTE LENOTRE, for "education services, namely, providing classes, workshops, and camps in the field of the culinary arts; Educational services, namely, conducting classes, seminars, conferences, workshops, retreats, camps and field trips in the field of the culinary arts and distribution of training material in connection therewith" in International Class 41; and

4) Registration No. 5212297, registered May 30, 2017 for the mark CULINARY INSTITUTE LENOTRE & design, for "educational services, namely, conducting classes, seminars, conferences, and workshops in the field of culinary arts, baking and pastry arts, and hospitality and restaurant management; educational services, namely, conducting classes, seminars, conferences, and workshops in the field of culinary arts, baking and pastry arts, and hospitality and restaurant management and distribution of course and educational materials in connection therewith; educational services, namely, providing classes, seminars, conferences, and workshops in the fields of culinary arts; educational services, namely, providing courses of

> instruction at the secondary level and distribution of course material in connection therewith" in International Class 41.

Lenotre S.A. filed a notice of opposition on the grounds of

1) likelihood of confusion;
2) no bona fide intent to use the mark in commerce for the identified services when the application was filed; and
3) Applicants are not the rightful owners of the mark.

Among other matters, Opposer alleges:

> As a result of previous litigation between the parties, the United States District Court for the Southern District of Texas issued a Consent Judgment and Decree dated February 4, 1987 in which the court ordered, decreed and adjudged that "The mark LENOTRE remains the trademark and service mark of the Plaintiff Lenotre S.A. and will not be used by Alain and Marie Lenotre except to the extent that Alain and Marie Lenotre represent and distribute products of Lenotre S.A."

("Consent Judgment"). 1 TTABVUE 4.

In their answer, Applicants denied all salient allegations. Opposer filed a motion for partial summary judgment pursuant to Fed. R. Civ. P. 56(a) solely on its claim that Applicants did not have a bona fide intent to use the mark in commerce when they filed the involved application. The motion is fully briefed.[1]

[1] Applicants' request for discovery pursuant to Fed. R. Civ. P. 56(d), requested as a "throw away" alternative as part of their response on the merits, see 9 TTABVUE 14, is **denied as moot** because Applicants responded substantively to Opposer's motion for partial summary judgment. *Bad Boys Bail Bonds, Inc. v. Yowell*, 115 USPQ2D 1925, 1930 (TTAB 2015) (Fed. R. Civ. P. 56(d) motion denied as moot because party filed substantive response to summary judgment motion); *Ava Ruha Corp. v. Mother's Nutritional Ctr., Inc.*, 113 USPQ2d 1575, 1578 (TTAB 2015) (same); *Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.*, 63 USPQ2d 2009, 2012 n.8 (TTAB 2002) (same); TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 528.06 (2019).

Summary Judgment Standard

Summary judgment is appropriate where the movant demonstrates that there is no genuine dispute as to any material fact, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). A party asserting that a fact cannot be true or is genuinely disputed must support its assertion by either: 1) citing to materials in the record, or 2) showing that the materials cited do not establish the absence or presence of a genuine dispute, or that an adverse party cannot produce admissible evidence to support the fact. Fed. R. Civ. P**.** 56(c). 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, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Olde Tyme Foods*, 22 USPQ2d at 1544. *See also,* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 528.01 (2019), and cases cited therein.

To prevail on summary judgment, Opposer must establish that there is no genuine dispute of material fact that Applicants did not have a bona fide intent to use the mark LENOTRE for the identified services as of July 15, 2016, the filing date of the involved application.

Standing

Standing is a threshold issue that must be pleaded and proven by the plaintiff in every inter partes case. *Empresa Cubana Del Tabaco v. Gen Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 171 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999). A plaintiff must allege and prove facts which show that it has a "real interest" in the proceeding as well as a "reasonable basis for its belief of damage." *Empresa Cubana*, 111 USPQ2d at 1062 ; *Ritchie v. Simpson*, 50 USPQ2d at 1025; *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024 , 213 USPQ 185, 189 (TTAB 1982).

The requirement is a low threshold. *See, e.g.*, *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1385 (TTAB 1991) ("[T]here is a low threshold for a plaintiff to go from being a mere intermeddler to one with an interest in the proceeding."). If a plaintiff can show standing on one ground, it has the right to assert any other ground(s) in an opposition or cancellation proceeding. *Coach Serv., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1728 (Fed. Cir. 2012); *Liberty Trouser Co. v. Liberty & Co., Ltd.*, 222 USPQ 357, 358 (TTAB 1983).

Opposer alleges likelihood of confusion, and may show proprietary rights in its pleaded common law marks. *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317 , 209 USPQ 40, 43 (CCPA 1981). With its motion, Opposer submitted a copy of the Consent Judgment which sets forth the District Court's findings including that "[t]he mark LENOTRE remains the trademark and service mark of the Plaintiff Lenotre S.A." (7 TTABVUE 56). It also submitted the declaration of its Chairman of

the Board of Directors (Decl. of Nathalie Szabo, 7 TTABVUE 11-13) who states based on personal knowledge that:

> Opposer uses its LENOTRE mark at its website at www.lenotre.com to promote Opposer's culinary school services and food products. The website includes both English and French sections, as shown in the attached Exhibit A.[2]
>
> Opposer uses LENÔTRE ("Opposer's Mark") for culinary school services rendered in France to persons who are residents of the United States.
>
> Opposer uses ÉCOLE LENOTRE (translated as "LENÔTRE SCHOOL") for a series of cookbooks currently available for purchase by persons in the United States on Amazon.com, as shown in the attached copy of a page from the Amazon.com website identified as Exhibit B.
>
> Opposer has entered into license agreements permitting other entities to use the mark UNE RECETTE LENOTRE PROFESSIONEL (translated as "A PROFESSIONAL LENOTRE RECIPE") in territories which include the United States. Attached hereto as Exhibit C is an example of such a license agreement in French, together with an English translation.[3]

By setting forth its use of the mark LENOTRE and of marks that include that term, and by being a party to the Consent Judgment, Opposer has demonstrated its basis for having a real interest in whether Applicants are granted the exclusive right to use the mark LENOTRE in connection with the identified services. Therefore, Opposer has established that it is not a mere intermeddler and has a reasonable basis for its belief of damage to its business of providing culinary school services and food products.

[2] 7 TTABVUE 11.
[3] 7 TTABVUE 12.

Accordingly, there is no genuine dispute of material fact as to Opposer's standing to bring this proceeding.[4]

Claim of No Bona Fide Intent[5]

Opposer's position is that Applicants could not have formed the requisite bona fide intent to use the mark LENOTRE, and that any intent to use which they had could not have been bona fide, because the Consent Judgment orders that LENOTRE is Opposer's mark and permanently enjoins Applicants from using it except in certain circumstances. Opposer further argues that any use by Applicants in their capacity as Opposer's distributors would not qualify as use of the mark for purposes of obtaining ownership rights in the mark. 7 TTABVUE 7-9.

Contesting the motion, Applicants argue, inter alia, that the Consent Judgment is ineffective and unenforceable because it was based on Opposer's four registrations which are now abandoned. Applicants cite the prefatory statement to the Consent Judgment:

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[4] We furthermore note that Applicants do not challenge Opposer's standing.

[5] Applicants' arguments on the equitable defenses of laches and abandonment are given no consideration. Applicants did not plead any affirmative defenses in their answer. 4 TTABVUE. Furthermore, Applicants' amended answer, filed with their brief opposing the motion for summary judgment and wherein they seek to set forth the defense, was not filed under a motion for leave to amend pursuant to Fed. R. Civ. P. 15(a), and hence we will give it no further consideration. Additionally, Opposer, when it filed its summary judgment motion, had no notice of the defenses. 9 TTABVUE 45. More to the point, under longstanding precedent, the affirmative defense of laches is generally not available in Board opposition proceedings. *See, e.g.*, *Nat'l. Cable Television Assoc. v. Am. Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 n.14 (TTAB 2007).

To the extent Applicants seek to assert laches, or a similar defense (i.e. acquiescence) vis-à-vis the validity of the Consent Judgment, the Board has no jurisdiction to adjudicate the validity of a district court order. That determination is within the province of the district court.

> Lenotre S.A. is the owner of U.S. Service Mark Registration Nos. 1,110,613 (Lenotre); 1,029,596 (Lenotre); 1,004,950 (Lenotre); and 934,274 (Lenotre) (Supplemental) and is desirous of avoiding confusion in the marketplace or any dilution of its trademarks and service mark rights in the United States and elsewhere

(9 TTABVUE 4; also 7 TTABVUE 57), and submitted Trademark Electronic Search System (TESS) printouts showing that Registration No. 1004950 expired on November 27, 1995, Registration No. 1110613 expired on October 11, 1999, Registration No. 934274 was canceled on February 22, 2003, and Registration No. 1029596 expired on April 30, 2018 (9 TTABVUE 5, 19, 22-37). Applicants contend that "while the Consent Judgment does not *expressly* state that it will expire if [Opposer's registrations] expire, that condition is *implicit* in the document." 9 TTABVUE 9. (Emphasis in original.)

In reply, Opposer maintains that the Consent Judgment is not conditioned on maintaining its registrations, but rather on that document's explicit goal of "avoiding confusion in the marketplace or any dilution." 10 TTABVUE 3; also 7 TTABVUE 57.

Analysis

Whether an applicant had a bona fide intent to use its mark in commerce is an objective determination based on all of the circumstances. *Bos. Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008). "[T]he focus is on the entirety of the circumstances, as revealed by the evidence of record." *Lane Ltd. v. Jackson Int'l Trading Co.*, 33 USPQ2d 1351, 1356 (TTAB 1994); *see also Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co.*, 108 USPQ2d 1463, 1471 (TTAB 2013). The evidentiary bar for showing bona fide intent to use is not high, but requires more than

"a mere subjective belief." *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892, 1897-98 (Fed. Cir. 2015). Here, the circumstances present a Consent Judgment that ended litigation between the parties with respect to rights in the mark LENOTRE, the terms of which the parties do not dispute and which set forth the conditions under which Applicants may use that term. In Paragraph 4 of the Consent Judgment (7 TTABVUE 57-58), the parties

1) acknowledged that that "[t]he mark LENOTRE remains the trademark and service mark of the Plaintiff Lenotre S.A. and will not be used by Alain and Marie Lenotre except to the extent that Alain and Marie Lenotre represent and distribute products of Lenotre S.A.;"

2) acknowledged that Applicants use their name ALAIN AND MARIE LENOTRE "to identify bakery, gourmet foods, café, catering and related businesses;"

3) agreed that Applicants may use their name ALAIN & MARIE LENOTRE as a mark in conjunction with the disclaimer "not affiliated with Lenotre Paris" on documents with letterhead, price lists, advertising in the telephone book, pastry boxes and invoices; and

4) agreed that Applicants will use the mark ALAIN & MARIE LENOTRE "in their own business or a business subject to their control giving the same proportion of size to each of their first (Alain and Marie) and last (Lenotre) names… for any type of business anywhere in the United States."

The Board must give effect to determinations of federal courts. *Cf. John W. Carson Found. v. Toilets.com Inc.*, 94 USPQ2d 1942, 1948 (TTAB 2010) ("It is incumbent on the Board to give effect to the determinations of the Sixth Circuit, including the remedy of the permanent injunction, and consider the terms of said injunction."). Accordingly, here the Board looks to the Consent Judgment, as necessary, to ascertain whether there is genuine dispute of material fact as to Applicants' bona fide intent to use the mark LENOTRE as of the filing date of the involved application.

By the plain terms of the Consent Judgment, Applicants are permitted, under specified conditions, the right to use the mark ALAIN & MARIE LENOTRE. The Consent Judgment does not allow for Applicants' use of the mark LENOTRE, alone, and thus precludes Applicants from forming the requisite bona fide intent to use the mark LENOTRE as a standalone mark. It necessarily follows that it was impracticable, and not possible as a matter of law, for Applicants to form the requisite bona fide intent to use the mark LENOTRE. Accordingly, we find that, under the plain language of the parties' agreement, there is no genuine dispute of material fact that Applicants did not have the requisite bona fide intent to use the mark LENOTRE in commerce as of the filing date of their application.[6]

We address Applicants' position that it is "implicit" in the Consent Judgment that if Opposer's registrations expire, the basis for the prohibitions set forth in Paragraph 4 of the Consent Judgment is removed. 9 TTABVUE 9. Applicants have not pointed to any portion or provision of the Consent Judgment that supports this position. Moreover, even if we were to apply Applicants' position, it would not impact the terms or validity of the Consent Judgment because Opposer's Registration No. 1029596 remained in full force and effect when Applicants filed their involved application.

For final clarity, the Board's jurisdiction is limited to determining the right to register. TBMP § 102.01, and authorities cited therein. The Board does not have the jurisdiction to adjudicate whether the Consent Judgment was or is currently valid

[6] Furthermore, under the terms of the Consent Judgment, Applicants cannot have lawful use of the mark in commerce. Trademark Act Section 45; *The Clorox Co. v. Armour-Dial, Inc.*, 214 USPQ 850, 851 (TTAB 1982).

and enforceable, or to entertain the affirmative defenses that Applicants now seek to assert "as a defense to *enforcement of the Consent Judgment*." 9 TTABVUE 12 (emphasis in original.) To the extent Applicants argue that the Consent Judgment is invalid due to their business activities, due to registrations issued to them subsequent to the date of the Consent Judgment, or due to abandonment, laches, acquiescence or some other doctrine, consideration of these matters, and any remedy that may be based upon them, lie with the District Court.

Decision

On the record before us, Opposer has carried its burden to demonstrate that there are no genuine disputes of material fact (1) as to Opposer's standing, and (2) that Applicants did not have a bona fide intent to use the mark LENOTRE in commerce when they filed their involved application, and that Applicants therefore did not fulfill the requirement for a Section 1(b) application.

Based on these findings, Opposer's motion for partial summary judgment on the ground of no bona fide intent to use is **granted**. The opposition is sustained, and registration of application Serial No. 87105897 is refused.