

This decision is not a precedent of the TTAB.

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
General Email: TTABInfo@uspto.gov

Baxley

April 28, 2021

Opposition No. 91255001

Trigon Turf Sciences LLC

v.

JRM, Inc.

Before Thurmon, Deputy Chief Trademark Judge, and
Wolfson and Heasley, Administrative Trademark Judges.

By the Board:

On April 23, 2021, Opposer filed a motion seeking partial summary judgment on the ground that, “under the doctrine of legal equivalents, the image in Opposer’s Mark and the wording in Applicant’s Mark are likely to impress the same mental image on purchasers.”¹ 28 TTABVUE 2. Rather than suspend this case to allow for full briefing of Opposer’s motion, we elect to decide the motion now for the reasons discussed fully below.

Although more than four months remain in the discovery period, Opposer has now filed two summary judgment motions in this proceeding. In a March 9, 2021 decision, 23 TTABVUE, we denied Opposer’s first motion for summary judgment on its pleaded

¹ In the motion, Opposer states that it would agree to Accelerated Case Resolution (ACR) in this case but that Applicant rejected this approach. Because ACR requires agreement of the parties, the Board does not impose case resolution under ACR. See TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 702.04(a) (2020).

claim under Trademark Act Section 2(d), 15 U.S.C. § 1052(d). In particular, we found that “Opposer has failed to meet its initial burden of establishing that there is no genuine dispute as to whether Opposer’s mark NINJA TINES and design and Applicant’s [standard character] mark SAMURAI TINES, when considered in their entirety, are confusingly similar.” 23 TTABVue 5. In other words, the Board found a genuine dispute of material fact as to the first *DuPont* factor. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). To the extent necessary, the March 9, 2021 order is incorporated by reference.

By its present, second motion, Opposer is essentially revisiting the issue of *DuPont* factor one, the similarity or dissimilarity of the marks at issue. However, a motion for summary judgment is intended to promote judicial economy. See TBMP §528.01 (2020). Judicial economy is not served by piecemeal entry of partial summary judgment for plaintiffs on individual likelihood of confusion factors, leaving disputes concerning remaining *DuPont* factors to be resolved at trial. That only impedes the review process and impairs the Board’s ability to compare the marks in their entirety when considering whether there is a likelihood of confusion.

The pitfalls posed by piecemeal adjudication are illustrated in this case. In its motion, Opposer improperly dissects its pleaded mark into design and word portions. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (marks must be compared in their entirety; “likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark”). Opposer has failed to meet its initial burden of establishing that there is no genuine dispute that purchasers, who

“normally retain a general rather than a specific recollection of trademarks,” would perceive Opposer’s complete pleaded registered mark -- NINJA TINES and design in



the following form, -- as incorporating a samurai design. *Roffler Indus., Inc. v. KMS Res. Labs.*, 213 USPQ 258, 263 (TTAB 1982). Indeed, given that there is nothing in the record to suggest that “ninja” and “samurai” are synonymous, such a perception would appear to be at odds with the wording in the pleaded mark.

Therefore, exercising our inherent authority to control the processing of cases on our docket, we find that judicial economy is better served by addressing all the factors for which is there is evidence and argument in the record and deciding Opposer’s likelihood of confusion claim in the final decision. Accordingly, Opposer’s motion is denied.

The filing of Opposer’s motion for partial summary judgment tolled the running of dates herein. *See* Trademark Rule 2.127(d). Proceedings are resumed. The parties are allowed until thirty days from the date of this order to serve responses to any outstanding written discovery requests. Bearing in mind that we have now denied two motions for summary judgment that Opposer filed in this case, **the Board will not consider any further motions for summary judgment from Opposer in this case. The parties are directed to move this case forward to trial without undue delay.**

We note that Opposer’s entitlement to bring a cause of action and priority will not be at issue with respect to Opposer’s pleaded mark for the goods identified in its

pleaded registration, 23 TTABVUE 3. We further note that the parties' goods are identical, 23 TTABVUE 4. Although the Board cannot impose ACR in this case, **we urge Applicant to reconsider its unwillingness to resolve this case by ACR.**²

Remaining dates are reset as follows.

Expert Disclosures Due	8/13/2021
Discovery Closes	9/12/2021
Plaintiff's Pretrial Disclosures Due	10/27/2021
Plaintiff's 30-day Trial Period Ends	12/11/2021
Defendant's Pretrial Disclosures Due	12/26/2021
Defendant's 30-day Trial Period Ends	2/9/2022
Plaintiff's Rebuttal Disclosures Due	2/24/2022
Plaintiff's 15-day Rebuttal Period Ends	3/26/2022
Plaintiff's Opening Brief Due	5/25/2022
Defendant's Brief Due	6/24/2022
Plaintiff's Reply Brief Due	7/9/2022
Request for Oral Hearing (optional) Due	7/19/2022

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at

² If the parties agree to pursue ACR, they should arrange a telephone conference with the interlocutory attorney assigned to this case to discuss specific ACR arrangements.

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final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).