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TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
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mbm

September 16, 2021

Opposition No. 91265455

*First Choice Appliance, LLC*

*v.*

*James Michael Morris*

Before Cataldo, Adlin, and English,  
Administrative Trademark Judges.

By the Board:

This proceeding now comes before the Board for consideration of Opposer's motion (filed May 10, 2021) for partial summary judgment on its pleaded claim of likelihood of confusion pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).<sup>1</sup> The motion is fully briefed.

## **I. Background**

Applicant seeks to register the mark shown below for "Services, namely, appliance repair" in International Class 37:<sup>2</sup>

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<sup>1</sup> 14 TTABVUE.

<sup>2</sup> Application Serial No. 88829427, filed March 11, 2020, pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). The description of the mark is as follows: "The mark consists of a coat of arms including a washer, dryer, refrigerator and stove, above the text 'First Choice Appliance Repair.'" "APPLIANCE REPAIR" is disclaimed.



In its January 20, 2021 amended notice of opposition, Opposer opposes registration of Applicant's involved mark on the grounds of likelihood of confusion and fraud.<sup>3</sup> In support of its entitlement to a statutory cause of action and claims, Opposer pleads prior use of the trade name FIRST CHOICE APPLIANCE, LLC and prior use of the mark FIRST CHOICE APPLIANCE in connection with appliance repair services. Opposer also pleads ownership of an Idaho state trademark registration for the mark FIRST CHOICE APPLIANCE.

In its February 9, 2021 answer, Applicant denies the salient allegations in the amended notice of opposition.<sup>4</sup>

## II. Opposer's Motion for Partial Summary Judgment

For purposes of this order, we presume the parties' familiarity with the arguments and evidence submitted with respect to Opposer's motion for partial summary

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<sup>3</sup> 8 TTABVUE.

<sup>4</sup> The Board's December 23, 2020 order struck Applicant's second, third, fourth, seventh, and eighth affirmative defenses from its November 25, 2020 answer. 7 TTABVUE 6-10. Applicant was provided leave to replead its defenses of unclean hands or waiver only and was advised **not** to reassert any of the remaining stricken affirmative defenses in its answer to the amended notice of opposition. *Id.* at 10. Applicant's February 9, 2021 answer reasserts each of the stricken affirmative defenses verbatim. Applicant's defenses of unclean hands and waiver also remain bald, conclusory statements with no factual support. Applicant's second, third, fourth, seventh, and eighth affirmative defenses accordingly remain **stricken** and will not be further considered.

judgment, and do not recount them here, except as necessary to explain this decision. *See Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

### **A. Summary Judgment Standard**

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to material facts, thus allowing resolution as a matter of law. *See* Fed. R. Civ. P. 56(a). A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute as to a material fact, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). *See also Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the nonmoving party. *See Opryland USA Inc v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

The evidence of record on summary judgment must be viewed in the light most favorable to the nonmoving party, and all justifiable inferences must be drawn from the undisputed facts in favor of the nonmoving party. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472; *Bad Boys Bail Bonds, Inc. v. Yowell*, 115 USPQ2d 1925, 1929 (TTAB 2015).

### **B. Discussion**

To prevail on its claim of likelihood of confusion on summary judgment, Opposer must establish that there is no genuine dispute of material fact that it has

entitlement to a statutory cause of action,<sup>5</sup> that it has priority of use, and that contemporaneous use of the parties' marks in connection with their respective services would be likely to cause confusion or mistake, or to deceive consumers. *See* 15 U.S.C. § 1052(d); *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001). To establish priority, "a party must prove that, vis-à-vis the other party, it owns 'a mark or trade name previously used in the United States....'" *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (quoting 15 U.S.C. § 1052(d)).

Unregistered marks are not entitled to the presumptions established by statute for registered marks. Trademark Act § 7(b)-(c), 15 U.S.C. § 1057(b)-(c). On summary judgment, Opposer must therefore demonstrate that there is no genuine dispute that it owns prior proprietary rights in its claimed mark. *See id.*; Trademark Act § 2(d), 15 U.S.C. § 1052(d). Opposer may also establish priority through prior use of a trade name. 15 U.S.C. § 1052(d).

In support of its motion for partial summary judgment, Opposer submitted a copy of a trademark registration issued by the State of Idaho for the mark FIRST CHOICE

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<sup>5</sup> Board decisions previously analyzed the requirements of Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063-64, under the rubric of "standing." Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 remain applicable. *See Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277 at \*6-7 (2020), *cert. denied*, \_\_ S. Ct. \_\_ (2021); *Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at \*2 (TTAB 2020).

Here, Opposer argues that its "standing" is undisputed, because the Board previously found it had "adequately pleaded [its] entitlement to a statutory cause of action..." 14 TTABVUE 5. While the Board previously found that Opposer has sufficiently **pleaded** its entitlement to a statutory cause of action, Opposer must affirmatively **prove** its entitlement to a statutory cause of action to prevail on summary judgment.

APPLIANCE and a copy of its certificate of organization with the State of Idaho.<sup>6</sup> A state trademark registration, by itself, does not establish priority of use because it does not carry the same presumptions as a federal registration. *See Faultless Starch Co. v. Sales Producers Assocs., Inc.*, 530 F.2d 1400, 189 USPQ 141, 142 n.2 (CCPA 1976); *Kraft, Inc. v. Balin*, 209 USPQ 877, 880 (TTAB 1981). Nor is Opposer's certificate of organization filed with the State of Idaho sufficient evidence of use. *See Liqwacon Corp. v. Browning Ferris Indus., Inc.*, 203 USPQ 305, 309 (TTAB 1979) (“[W]hile prior use of a trade name may be sufficient to give rise to superior rights in a mark, the mere act of incorporation, in itself, does not establish such priority of use.”).

Opposer submitted with its reply brief additional evidence in an attempt to support its allegations of priority, specifically the declaration of Vladimir Tsiro, its Manager, and accompanying exhibits.<sup>7</sup> The oral testimony of a single witness may be adequate to establish priority if it is sufficiently probative. *Executive Coach Builder, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1184 (TTAB 2017) (“Such testimony ‘should not be characterized by contradictions, inconsistencies, and indefiniteness but should carry with it conviction of its accuracy and applicability.’ Oral testimony is strengthened by corroborating evidence.”) (internal citations omitted); *Nat'l Bank Book Co. v. Leather Craft Prods., Inc.*, 218 USPQ 827, 828 (TTAB 1993); *GAF Corp. v. Amatol Analytical Servs., Inc.*, 192 USPQ 576, 577 (TTAB 1976). This evidence,

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<sup>6</sup> 14 TTABVUE 16-19.

<sup>7</sup> 17 TTABVUE 8-51.

however, is untimely and we have not considered it because Applicant did not have an opportunity to address the evidence in its opposition brief.<sup>8</sup> See *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1300 n.18 (TTAB 2016) (“Applicant submitted additional evidence with its reply brief which purportedly demonstrates use of Applicant’s mark on clothing items. This evidence is untimely submitted and has been given no consideration.”); *Kellogg Co. v. Pack’Em Enters. Inc.*, 14 USPQ2d 1545, 1549 n. 9 (TTAB 1990), *aff’d*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (evidence supporting a motion for summary judgment must be submitted with the motion). If Opposer wanted the Board to consider this evidence, it should have filed the declaration and accompanying exhibits with its original motion for summary judgment. In any re-filed motion, Opposer must file its evidence with the motion, as opposed to the reply brief, so that Applicant has an opportunity to respond.

Accordingly, we find that Opposer has not met its initial burden of establishing an absence of genuine disputes of material fact for trial and therefore Opposer is not entitled to summary judgment on its claim of likelihood of confusion. Based on the present record, we find, at a minimum, genuine disputes of material fact remain as to Opposer’s priority.<sup>9</sup>

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<sup>8</sup> In its reply brief, Opposer appears to argue that Applicant cannot contest Opposer’s priority, because Applicant did not plead an affirmative defense to that effect. 17 TTABVUE 3-4 (“Applicant[] has not pleaded that Opposer has never used his mark, or delayed starting using his mark, or has not maintained continuous use of his mark to date, or has abandoned his mark.”). However, it is unnecessary for Applicant to affirmatively defend the issue of priority as Opposer suggests. Opposer, as plaintiff in this proceeding, bears the burden of proof and must affirmatively establish its priority to prevail on its claim of likelihood of confusion.

<sup>9</sup> The fact that we have identified certain genuine disputes of material fact as sufficient bases for denying Opposer’s motion for partial summary judgment should not be construed as a

In view of the foregoing, Opposer's motion for partial summary judgment is **denied**.

### **III. Accelerated Case Resolution**

The legal issues presented in this proceeding appear to be appropriate for resolution by means of the Board's accelerated case resolution ("ACR") procedure, and the Board suggests that the parties stipulate to proceed as an ACR proceeding. This may take the form of the summary judgment briefing, and the evidence submitted therewith, with or without supplementation. *See, e.g., Freeman v. Nat'l Ass'n of Realtors*, 64 USPQ2d 1700 (TTAB 2002) (parties agreed that evidence and arguments submitted with opposer's motion for summary judgment and applicant's response could be treated as the final record and briefs); *see also* TRADEMARK BOARD MANUAL OF PROCEDURE (TBMP) § 528.05(a)(2) (2021) and authorities cited therein. In the event the parties agree to ACR using summary judgment briefs and incorporating the current evidence, including any supplementation of evidence they may agree would be appropriate, they will need to stipulate that the Board may determine any genuine disputes of material fact the Board may find to exist. *See* TBMP § 702.04 for more information.

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finding that such disputes necessarily are the only disputes that remain for trial. Additionally, the parties are reminded that the evidence submitted in connection with a motion for summary judgment or opposition thereto is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial period. *See Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983). The parties may, however, stipulate that any or all of the summary judgment evidence be treated as properly of record for purposes of final decision. *See, e.g., Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998).

The parties are encouraged to jointly contact the Board's Interlocutory Attorney responsible for this proceeding by telephone to discuss the possibility of ACR, any necessary or desired stipulations, and an agreed schedule for proceeding under ACR.

#### **IV. Schedule**

Proceedings are resumed. The parties are allowed until thirty days from the date of this order to respond to any outstanding discovery.<sup>10</sup> Remaining dates are reset as follows:

Expert Disclosures Due	<b>1/12/2022</b>
Discovery Closes	<b>2/11/2022</b>
Plaintiff's Pretrial Disclosures Due	<b>3/28/2022</b>
Plaintiff's 30-day Trial Period Ends	<b>5/12/2022</b>
Defendant's Pretrial Disclosures Due	<b>5/27/2022</b>
Defendant's 30-day Trial Period Ends	<b>7/11/2022</b>
Plaintiff's Rebuttal Disclosures Due	<b>7/26/2022</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>8/25/2022</b>
Plaintiff's Opening Brief Due	<b>10/24/2022</b>
Defendant's Brief Due	<b>11/23/2022</b>
Plaintiff's Reply Brief Due	<b>12/8/2022</b>
Request for Oral Hearing (optional) Due	<b>12/18/2022</b>

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

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<sup>10</sup> This allotment of time does not constitute an order to compel discovery but merely serves as a scheduling order.

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

### **TIPS FOR FILING EVIDENCE, TESTIMONY, OR LARGE DOCUMENTS**

The Board requires each submission to meet the following criteria before it will be considered: 1) pages must be legible and easily read on a computer screen; 2) page orientation should be determined by its ease of viewing relevant text or evidence, for example, there should be no sideways or upside-down pages; 3) pages must appear in their proper order; 4) depositions and exhibits must be clearly labeled and numbered – use separator pages between exhibits and clearly label each exhibit using sequential letters or numbers; and 5) the entire submission should be text-searchable. Additionally, submissions must comply with Trademark Rules 2.119 and 2.126. Submissions failing to meet all of the criteria above may require re-filing. **Note:** Parties are strongly encouraged to check the entire document before filing.<sup>11</sup> The Board will not extend or reset proceeding schedule dates or other deadlines to allow time to re-file documents. For more tips and helpful filing information, please visit the [ESTTA help](#) webpage.

Submissions in Board proceedings must be made via ESTTA, the Electronic System for Trademark Trials and Appeals, and must be in compliance with

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<sup>11</sup> To facilitate accuracy, ESTTA provides thumbnails to view each page before submitting.

Trademark Rules 2.126(a) and (b). *See* TBMP § 110.01. The ESTTA user manual, ESTTA forms, and instructions for their use are at <http://estta.uspto.gov/>.

It is recommended that any pro se party be familiar with the latest edition of Chapter 37 of the Code of Federal Regulations, which includes the Trademark Rules of Practice. Parties should also be familiar with the Trademark Trial and Appeal Board Manual of Procedure (TBMP), available at <http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab>, the TTABVUE system for viewing the record for all Board proceedings, available at <http://ttabvue.uspto.gov/ttabvue/>, and the Standard Protective Order, available at <https://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/standard-documents-and-guidelines-0>.

Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is required of all parties, whether or not they are represented by counsel. *McDermott v. S.F. Women's Motorcycle Contingent*, 81 USPQ2d 1212, n.2 (TTAB 2006), *aff'd unpub'd*, 240 Fed. App'x. 865 (Fed. Cir. 2007).

#### **PRO SE INFORMATION**

It is noted that Opposer is representing itself in this proceeding. While Patent and Trademark Rule 11.14 permits any person to represent itself, it is strongly advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in *inter partes* proceedings before the Board to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney. *See* TBMP § 114.02.

Trademark Rules 2.119(a) and (b) require that every submission filed in a proceeding before the Board must be served upon the other party or parties, and proper proof of such service must be made before the submission will be considered by the Board. Accordingly, all submissions filed in this proceeding must be accompanied by a statement, signed by the attorney or other authorized representative, attached to or appearing on the original submission when filed, clearly stating the date and manner in which service was made, the name of each party or person upon whom service was made, and the email address or address. *See* TBMP § 113.03. Service must be made by email unless otherwise stipulated, or unless the filing party has satisfied the requirements for another method of service as set forth in Trademark Rule 2.119(b). The statement will be accepted as prima facie proof of service, must be signed and dated, and should take the form of a Certificate of Service as follows:

I hereby certify that a true and complete copy of the foregoing (insert title of submission) has been served on (insert name of opposing counsel or party) by forwarding said copy on (insert date of mailing), via email (or insert other appropriate method of delivery) to: (set out name, address, and email address of opposing counsel or party).

Signature \_\_\_\_\_  
Date \_\_\_\_\_

Submissions in Board proceedings must be made via ESTTA, the Electronic System for Trademark Trials and Appeals, and must be in compliance with Trademark Rules 2.126(a) and (b). *See* TBMP § 110.01. The ESTTA user manual, ESTTA forms, and instructions for their use are at <http://estta.uspto.gov/>.

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