TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

10-15-2002
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #61

TOMAS, L.L.C., Petitioner,	:	Cancellation No. 92040968
	:	Registration No. 2222067
v.	:	
HARRIET CARTER GIFTS, INC., Registrant.	:	

02 OCT 21 AM 12:30

Box TTAB/No Fee
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Attention: Trademark Trial and Appeal Board

HARRIET CARTER GIFTS, INC.'S
MOTION FOR SUMMARY JUDGMENT

In its petition for cancellation, Petitioner Tomas, L.L.C. ("Petitioner") erroneously alleges that, "Registrant [Harriet Carter Gifts, Inc.] owns Registration No. 2222067 for the mark TOMA'S TAN PERFECT in connection with the sale of exfoliating lotions; instant tanning lotions; and tan enhancing moisturizing lotions in International Class 3, claiming a date of first use of January 19, 1998." Petition at ¶1. Contrary to the averment of the petition, Harriet Carter Gifts, Inc. is not the current owner or registrant of the TOMA'S TAN PERFECT mark. As

reflected in the official records of the Patent and Trademark Office, Harriet Carter Gifts, Inc. had assigned all rights, title and interest in the mark to H.C.T.V., Inc. long before this cancellation proceeding was commenced. In view of the incontrovertible evidence establishing that the Petition was brought against a party other than the owner and registrant of the trademark in question, the cancellation proceeding is a nullity and summary judgment must be entered in favor of Harriet Carter Gifts, Inc.

I. ARGUMENT

A. Legal Standard For Entry of Summary Judgment

As discussed in the Trademark Trial and Appeal Board Manual of Procedure (the "T.B.M.P."), summary judgment is regarded as "'a salutary method of disposition,' and the Board does not hesitate to dispose of cases on summary judgment when appropriate." T.B.M.P. § 528.01 (1st ed. 1995) (citing cases). Rule 56(c) of the Federal Rules of Civil Procedure provides that summary judgment is appropriate if the "pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c). The principal purpose of the rule is to dispose of factually unsupported claims or defenses. Celotex Corp. v. Catrett, 477 U.S. 317, 325 (1986).

In considering a motion for summary judgment, the Board must examine all the evidence in the light most favorable to the non-moving party. United States v. Diebold, Inc., 369 U.S. 654, 655 (1962). Where the moving party does not bear the burden of proof on an element at trial, it may show that no genuine issue of material fact remains by demonstrating that "there is an absence of evidence to support the non-moving party's case." Celotex, 477 U.S. at 325. The

moving party is not required to produce evidence showing the absence of a genuine issue of material fact on such issues, nor must the moving party "negate the elements of the non-moving party's claims." Lujan v. National Wildlife Fed'n, 497 U.S. 871, 885 (1990); United Steelworkers v. Phelps Dodge Corp., 865 F.2d 1539, 1542 (9th Cir. 1989), cert. denied, 493 U.S. 809 (1989).

Once the moving party meets the requirement of Rule 56 by either showing that no genuine issue of material fact remains or that there is an absence of evidence to support the non-moving party's case, the burden shifts to the party resisting the motion, who "must set forth specific facts showing that there is a genuine issue for trial." Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 256 (1986) (requiring plaintiffs to present "concrete evidence from which a reasonable jury could return a verdict in [their] favor"). It is not enough for the party opposing a properly supported motion for summary judgment to "rest on mere allegations or denials of his pleadings." Id.; see also Fed. R. Civ. P. 56(e) (to same effect). Moreover, "genuine" factual issues must exist that "can be resolved only by a finder of fact because they may reasonably be resolved in favor of either party." Anderson, 477 U.S. at 250; see also Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586 (1986) (the "opponent must do more than simply show that there is some metaphysical doubt as to the material facts"). If the non-movant does not respond with "specific facts showing that there is a genuine issue for trial," summary judgment should be entered in the movant's favor. Fed. R. Civ. P. 56(e); see also Lujan, 497 U.S. at 885 ("the motion may, and should, be granted so long as whatever is before the district court demonstrates that the standard for the entry of summary judgment, as set forth in Rule 56(c), is satisfied.").

B. Harriet Carter Gifts, Inc. Is Entitled to Summary Judgment

The requirements to prosecute a cancellation petition are well-recognized. Petitioner must set forth a "short and plain statement": (1) showing how the petitioner is or will be damaged by the registration; (2) stating the grounds for cancellation; and (3) indicating the respondent party. See, e.g., 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 20:41 (4th ed. 1999) (discussing prima facie elements of proceeding).

In the present matter, Petitioner has brought this petition against the wrong respondent party. As Petitioner is fully aware from prior pending litigation,[1] Harriet Carter Gifts, Inc. is neither the current owner nor registrant of the TOMA'S TAN PERFECT mark. The official records of the Patent and Trademark Office establish beyond all question that the entire interest and goodwill in the TOMA'S TAN PERFECT mark are owned by H.C.T.V., Inc. which acquired these rights by assignment from Harriet Carter Gifts, Inc. See Assignment Recordation Form filed with the Patent and Trademark Office on July 5, 2001, a true and correct copy of which is attached hereto as Exhibit "A"; see also microfilm version of Recordation Form maintained by the Assignment Branch of United States Patent and Trademark Office at Reel/Frame 2329/0333.

Pursuant to Federal Rule of Evidence 803(8), public records of the Patent and Trademark Office are admissible to prove the assignment and transfer of ownership of the mark without further corroborating evidence. See F. R. Evid. 803(8) (providing that the following are not excluded by the hearsay rule, even though the declarant is available as a witness: records, reports, statements, or data compilations, in any form, of public offices or agencies, setting forth the activities of the office or agency); see, e.g., Farmers & Merchants Nat'l Bank v. Bryan, 902

[1] A civil action between Tomas LLC and H.C.T.V., Inc. was commenced in Oklahoma Superior Court in May, 2002. During the course of this litigation, Petitioner became aware that both the mark TOMAS TAN PERFECT and the related marks, TOMAS and TAN SECRET, are owned by H.C.T.V., Inc.

F.2d 1520 (10th Cir. 1990) (finding reports from Office of Comptroller of Currency were admissible in suit against bank officers under "public records" exception to hearsay rule). In view of the undisputed evidence that the named "registrant," Harriet Carter Gifts, Inc., is not the owner or registrant of the TOMAS TAN PERFECT mark, summary judgment must be entered in favor of Harriet Carter Gifts, Inc. and the petition for cancellation dismissed with prejudice.

Respectfully submitted,

HARRIET CARTER GIFTS, INC.

Dated: October 9, 2002

By: _____
TIMOTHY D. PECSENYE
DENNIS P. McCOOE
Its Attorneys
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box TTAB/No Fee, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on October 9, 2002.

_____
Dennis P. McCooe, Esquire

CERTIFICATE OF SERVICE

I, Dennis P. McCooe, do hereby certify that on the 9th day of October, 2002, the foregoing HARRIET CARTER GIFTS, INC.'S MOTION FOR SUMMARY JUDGMENT, was served by first class United States Mail, postage prepaid, upon the following:

Joseph P. Titterington, Esquire
Robert Trent Pipes, Esquire
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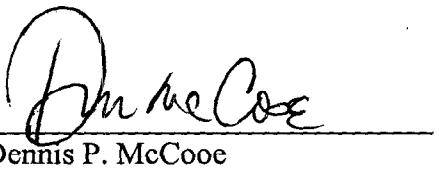

Dennis P. McCooe