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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: February 15, 2007

Cancellation No. 92045423

Piazza Espresso, Inc.

v.

Sara Lee DE/N.V.

Before Hairston, Drost and Walsh, Administrative Trademark Judges.

By the Board:

This case now comes up on petitioner's motion for summary judgment on the issues of priority and likelihood of confusion. Respondent concurrently filed a response to the summary judgment motion and a cross-motion for discovery under Fed. R. Civ. P. 56(f). Petitioner did not respond to respondent's cross-motion for discovery.

By way of relevant background, petitioner seeks to cancel respondent's registration for the mark PIAZZA D'ORO for electric coffee and tea makers, and refrigerated and heated dispensing units for dispensing hot and cold beverages.[1] As grounds therefor, petitioner alleges infringement and illegal competition, apparently based on a likelihood of confusion with petitioner's registered marks

[1] Registration No. 2963079, registered June 21, 2005.

PIAZZA ESPRESSO OF AMERICA and Design, PIAZZA 50, PIAZZA 80, and PIAZZA 150 for non-electric coffee/tea/espresso makers for domestic and commercial use.[2] Petitioner does not allege priority.

In its answer, respondent denied the allegations set forth in the petition to cancel.

Before turning to the summary judgment motion, we note that petitioner did not plead priority or likelihood of confusion in the petition to cancel. Instead, as discussed above, petitioner pleaded infringement and illegal competition, matters beyond the limited jurisdiction of the Board. See authorities cited in TBMP § 102.01 (2nd ed. rev. 2004). However, because the infringement claim includes language associated with a claim of likelihood of confusion, and because respondent responded to the issues of priority and likelihood of confusion raised in petitioner's summary judgment motion, we will decide the motion on its merits, rather than denying the motion because it is based on an unpleaded issue. See Fed. R. Civ. P. 56(a) and (b); S Industries Inc. v. Lamb-Weston Inc., 45 USPQ2d 1293, 1297 (TTAB 1997).

[2] Registration Nos. 2361226, 2342317, 2342316 and 2464183, registered June 27, 2000, April 18, 2000, April 18, 2000, and June 26, 2001, respectively. Section 8 affidavits accepted for each registration.

MOTION FOR SUMMARY JUDGMENT

It is well settled that a party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material facts, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. Opryland USA Inc. v. The Great American Music Show, Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

Upon careful consideration of the arguments and evidence presented by opposer, and drawing all inferences with respect to the summary judgment motion in favor of respondent as the non-moving party, we find that petitioner has not carried its burden of demonstrating the absence of a genuine issue of material fact for trial. Specifically, as respondent aptly notes, petitioner's entire summary judgment motion consists of vague and irrelevant arguments based on respondent's collateral marks, none of which is at issue in this proceeding, rather than focusing on respondent's involved mark. Thus, petitioner has failed to show that any of its pleaded marks is likely to be confused with respondent's involved mark. In view thereof, petitioner's

motion for summary judgment is denied, and respondent's motion for discovery under Fed. R. Civ. P. 56(f) is moot.[3]

SCHEDULING ORDER

Proceedings are resumed. The parties are allowed THIRTY DAYS from the mailing date of this order to serve responses to any outstanding discovery requests.

Petitioner is allowed the same THIRTY DAYS to file an amended petition to cancel that clearly sets forth a claim under Section 2(d) of the Trademark Act and deletes the current claims of infringement and illegal competition. As previously stated, the Board does not have jurisdiction over infringement and illegal competition claims, and the petition does not properly set forth a claim of priority and likelihood of confusion.

If petitioner files an amended petition within the allotted time, petitioner does not have to seek leave of the Board, and respondent's amended answer will be due THIRTY DAYS after petitioner serves the amended petition on respondent.

Trial dates, including the close of discovery, are reset as follows:[4]

[3] The parties should note that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced during the appropriate trial period. See, for example, Levi Strauss & Co. v. R. Joseph Sportswear Inc., 28 USPQ2d 1464 (TTAB 1993).

[4] The parties must note that this is merely a scheduling order, and not an order compelling discovery.

DISCOVERY PERIOD TO CLOSE: **June 25, 2007**

Thirty-day testimony period for party in position of plaintiff to close: **September 23, 2007**

Thirty-day testimony period for party in position of defendant to close: **November 22, 2007**

Fifteen-day rebuttal testimony period to close: **January 6, 2008**

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.l25.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.