

**THIS OPINION
IS NOT A PRECEDENT
OF THE T.T.A.B.**

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

DUNN

Mailed: April 13, 2009

Cancellation No. 92048839

Joseph Melluso

v.

Sea Dining LLC

Before Grendel, Rogers, and Taylor, Administrative Trademark
Judges:

By the Board:

This case comes up on respondent's motion, filed
September 18, 2008, for summary judgment on the affirmative
defense of laches. The motion has been fully briefed.

On February 7, 2008, Joseph Melluso filed a petition to
cancel Registration No. 2673458 for the mark TIN FISH for
restaurant services on the ground of priority of use and
likelihood of confusion with petitioner's mark THE TIN FISH,
the subject of pending Application Serial No. 77385056 and
common law use, for restaurant services. Respondent's
answer denied the salient allegations of the petition to

cancel and asserted that petitioner's unreasonable delay in filing the petition resulted in prejudice to respondent.

The party bringing a motion for summary judgment bears the burden of showing the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. See Fed. R. Civ. Pro. 56(c); and *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S. Ct. 2548 (1986). In assessing each motion, the evidence must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

In support of its motion for summary judgment respondent submits excerpts from the prior application of a company related to petitioner to register THE TIN FISH mark for restaurant services, and the declaration of Colin Turner, member/manager of respondent. Respondent's submission indicates that petitioner had actual notice of respondent's intent to register its mark since April 9, 2002 when respondent's earlier-filed Trademark Act Section 1(b) application was the basis for suspending examination of petitioner's Application Serial No. 76358180, and that petitioner had actual notice of respondent's Supplemental Register Registration No. 2673458 since August 19, 2004, when the Office cited the registration as a Section 2(d) bar

to registration of petitioner's mark by the related company.¹ Mr. Turner's declaration avers that while respondent's application was pending, he never heard any objection from anyone to the proposed use of the mark, that as a result he decided to use TIN FISH as the name of his restaurant, and that since the restaurant's opening in 2002, he has made significant expenditures on promotion of the TIN FISH restaurant.

In opposition to the motion for summary judgment on the laches defense, petitioner does not dispute any of the foregoing facts but submits three declarations indicating that there has been actual confusion regarding the source of the TIN FISH and THE TIN FISH restaurant services offered by the parties, and that the laches defense is inapplicable here where public confusion as to the source of the services is inevitable.

In order to prevail on the affirmative defense of laches, a defendant must establish that there was undue or unreasonable delay by the plaintiff in asserting its rights, and prejudice to the defendant resulting from the delay.

Bridgestone/Firestone Research Inc. v. Automobile Club de

¹ Because Registration No. 2673458 issued on the Supplemental Register, it is not accorded any of the presumptions of Section 7 of the Act, and cannot serve as constructive notice of respondent's claimed rights in its mark. *McCormick & Company, Inc. v. Summers*, 148 USPQ 272, 276 (CCPA 1966); *Parr Instrument Co. v. Princeton Applied Research Corp.*, 178 USPQ 250 (TTAB 1973).

l'Ouest de la France, 245 F.3d 1359, 58 USPQ2d 1460, 1462-1463 (Fed. Cir. 2001); *Lesley Hornby a/k/a Lesley Lawson a/k/a Twiggy v. TJX Companies, Inc.*, 87 USPQ2d 1411, 1419 (TTAB 2008). Even though proven, laches will not prevent cancellation where the marks and goods or services of the parties are substantially similar and it is determined that confusion is inevitable. This is so because any injury to respondent caused by petitioner's delay is outweighed by the public's interest in preventing confusion in the marketplace. *Turner v. Hops Grill & Bar Inc.*, 52 USPQ2d 1310, 1313 (TTAB 1999); *Coach House Restaurant v. Coach and Six Restaurants*, 223 USPQ 176, 178 (TTAB 1984). To determine whether confusion is inevitable, the Board must use the multifactor analysis required by *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *Turner v. Hops Grill & Bar Inc.*, at 1313.

Upon careful consideration of the arguments and evidence presented by the parties, and resolving all reasonable inferences in the non-movant's favor, the Board finds that respondent has failed to carry its burden of establishing that it is entitled to judgment as a matter of law. At a minimum, respondent has failed to demonstrate that on the undisputed facts its laches defense is sufficient as a matter of law and, moreover, petitioner has demonstrated the existence of material issues of fact in

regard to its contention that confusion is inevitable, thus precluding entry of summary judgment for respondent on its defense.

In view thereof, respondent's motion for summary judgment is denied.²

Proceedings herein are resumed, and dates reset below.

Expert Disclosures Due	5/16/09
Discovery Closes	6/15/09
Plaintiff's Pretrial Disclosures	7/30/09
Plaintiff's 30-day Trial Period Ends	9/13/09
Defendant's Pretrial Disclosures	9/28/09
Defendant's 30-day Trial Period Ends	11/12/09
Plaintiff's Rebuttal Disclosures	11/27/09
Plaintiff's 15-day Rebuttal Period Ends	12/27/09

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 2.125.

² Although we have only mentioned a few genuine issues of material fact in this decision, that is not to say that there are not other factual issues that may be disputed.

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 in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

Inasmuch as each party asserts actual use in commerce prior to the other party's application filing date, the parties may wish to consider seeking concurrent use registrations. See Trademark Rule 2.99; Trademark Trial and Appeal Board Manual of Procedure (TBMP) §1103 (2nd ed. rev. 2004).

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:
<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:
<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>