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

Proceeding	92055355
Party	Plaintiff Eateries, Inc.
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Attachments	2012.05.18 Motion for Judgment on the Pleadings.pdf ( 7 pages )(29163 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

EATERIES, INC., )  
 )  
Petitioner, )  
 ) Cancellation No. 92055355  
v. ) Registration No. 4,104,723  
 ) Mark: GARFIELD'S PLACE "LET  
GARFIELD'S PLACE, LLC, ) THE GOOD TIMES FLOW" &  
 ) Design  
Registrant. )

**MOTION FOR JUDGMENT ON THE PLEADINGS**

Pursuant to Federal Rule of Civil Procedure 12(c) and Trademark Rule of Procedure 2.127(d), Petitioner Eateries, Inc. ("Petitioner") moves for the entry of judgment in its favor on the pleadings on the following grounds:

**I. Background Facts**

Petitioner seeks cancellation of the registration by Garfield's Place, LLC ("Registrant") for the mark GARFIELD'S PLACE "LET THE GOOD TIMES FLOW" & Design (Registration No. 4,104,723) on the grounds that Petitioner has significant undisputed prior use of a confusingly similar GARFIELD'S mark for identical services and, accordingly, Registrant is not entitled to maintain its federal registration.

In its detailed Petition for Cancellation ("Petition"), Petitioner sets forth that since at least November 1, 1984, Petitioner, through its predecessor and their respective licensees, has been, and is currently, using the GARFIELD'S mark in word and design form in connection with bar and restaurant services. (See Dkt. 1, ¶ 2) In contrast, Registrant's registration reflects that it did not begin use of its GARFIELD'S PLACE "LET THE GOOD TIMES FLOW" and design mark in connection with bar and related services until April 8, 2011. See Registration No. 4,104,723. Petitioner's Petition also notes, *inter alia*, the reputation and goodwill of Petitioner's GARFIELD's mark, as well as the likelihood of confusion and damage to Petitioner and its GARFIELD'S mark that would result from the continued registration of the GARFIELD'S PLACE "LET THE GOOD TIMES FLOW" & Design mark. (Dkt. 1, ¶¶ 3, 6).

Registrant's one-page Answer fails to contest Petitioner's prior use of a closely similar mark for identical services, Petitioner's assertion that Registrant's mark is likely to be confused with Petitioner's mark, or that Petitioner would be damaged by the registration. Rather, Registrant contends that it is entitled to maintain its registration because it obtained its registration first. (See Dkt. 5).

Accordingly, because Registrant has failed to contest the essential facts set forth in the Petition and Registrant's "defense" to Petitioner's Petition as set forth in its Answer is legally without merit, the registration at issue should be cancelled as a matter of law.

## **II. Applicable Legal Standard**

"A motion for judgment on the pleadings, which is provided for under Fed. R. Civ. P. 12(c), will be granted only if the moving party clearly establishes that no material issue of fact remains to be resolved and that it is entitled to judgment as a matter of law. For purposes of the motion, all well-pleaded factual allegations of the nonmoving party are assumed to be true and the inferences drawn therefrom are to be viewed in a light most favorable to the nonmoving party." *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 U.S.P.Q.2d 1048, 1049 (T.T.A.B. 1992); TBMP § 504.02.

In addition, "any allegation in the complaint not specifically denied or explained in an answer filed . . . shall be deemed to be admitted to be true and shall be so found by the Board, unless good cause to the contrary is shown." See Trademark Rule of Procedure 102.20. Here, based on the pleadings in the case, no material issues of fact remain and

based on the undisputed facts, Petitioner is entitled to judgment as a matter of law.

### **III. Registrant's Argument Fails as a Matter of Law**

Registrant's Answer fails to address the core issue of whether Registrant is entitled to maintain its federal registration and, instead, attempts to distract the Board with irrelevant arguments regarding Petitioner's own pending application.

Registrant does not deny Petitioner's prior rights in its GARFIELD'S mark, or that its mark is likely to be confused with Registrant's mark - issues that are the crux of this cancellation action and should be admitted for the purposes of this motion. See Dkt. 5; Trademark Rule of Procedure 102.20. Instead, in its one-page Answer, Registrant simplistically, and erroneously, argues that it should be able to maintain its registration "because it was filed first and that is just the right thing to do." See Dkt. 5. However, the timing and status of Petitioner's own federal filings (or any perceived delay in the same) has no bearing on this proceeding or whether Registrant is entitled to maintain its registration. "First-to-file" is not the standard and Registrant's irrelevant arguments should be rejected by the Board.

It is black letter law that "[p]rior use anywhere in the United States by the cancellation petitioner, without abandonment by it, is a sufficient basis for cancellation of a principal or supplemental registration." 4 Callmann on Unfair Competition, Trademarks, and Monopolies § 26:53 (2012) (citing *Osage Oil & Trans., Inc. v. Standard Oil Co.*, 226 U.S.P.Q.2d 905, 907-908 (T.T.A.B. 1985), *rev'd on other grounds*, (10 U.S.P.Q.2d 1554 (N.D. Okla. 1988))). Here, it is undisputed that Petitioner first used its GARFIELD'S mark in 1984, prior to Registrant's date of first use reflected in Registration No. 4,104,723 and that the parties' respective marks encompass identical services.

Because Registrant fails to contest Petitioner's prior use of a closely similar mark for identical services, Petitioner's assertion that Registrant's mark is likely to be confused with Petitioner's mark, or that Petitioner would be damaged by the continued registration of Registrant's mark, the registration at issue should be cancelled as a matter of law.

#### **IV. Conclusion**

For the foregoing reasons, Petitioner respectfully requests that the Board enter judgment in Petitioner's favor and

against Registrant based on the pleadings herein and cancel  
Registration No. 4,104,723.

Date: May 18, 2012

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing MOTION FOR JUDGMENT ON THE PLEADINGS was served on Registrant on May 18, 2012 via first class mail to:

Melissa Goble Dobbins  
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Dalton, GA 30721

/Christopher P. Bussert/  
Christopher P. Bussert  
Attorney for Petitioner  
Eateries, Inc.

**CERTIFICATE OF TRANSMITTAL**

I hereby certify that a true copy of the foregoing MOTION FOR JUDGMENT ON THE PLEADINGS is being filed electronically with the PTO via ESTTA on May 18, 2012.

/Christopher P. Bussert/  
Christopher P. Bussert  
Attorney for Petitioner  
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