

ESTTA Tracking number: **ESTTA788304**

Filing date: **12/09/2016**

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

Proceeding	92063649
Party	Defendant Lincoln Global, Inc.
Correspondence Address	THOMAS M WILLIAMS ULMER & BERNE LLP 500 WEST MADISON STREET, SUITE 3600 CHICAGO, IL 60661 UNITED STATES twilliams@ulmer.com, mrink@ulmer.com, msaunders@ulmer.com
Submission	Opposition/Response to Motion
Filer's Name	Thomas M. Williams
Filer's e-mail	twilliams@ulmer.com, mrink@ulmer.com, msaunders@ulmer.com, amehta@ulmer.com
Signature	/Thomas M. Williams/
Date	12/09/2016
Attachments	FINAL Respondent Opposition to MSJ.pdf(219770 bytes)

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

The ESAB Group, Inc.,)	
)	
Petitioner,)	Cancellation No. 92/063,649
)	
v.)	
)	Mark: FLASHBACK FRIDAY
)	
Lincoln Global, Inc.)	
)	
Respondent.)	Registration No. 4,562,560

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

**RESPONDENT’S OPPOSITION TO PETITIONER’S MOTION
FOR SUMMARY JUDGMENT**

Respondent Lincoln Global, Inc. (“Respondent” or “Lincoln”) hereby submits its Opposition to Petitioner The ESAB Group, Inc.’s (“Petitioner” or “ESAB”) Motion for Summary Judgment. Petitioner’s Motion must be denied because the asserted ground, mere descriptiveness, involves an inherently fact-intensive analysis. As a result, summary judgment is inappropriate—particularly at this pre-discovery stage—due to genuine issues of material fact. Moreover, Respondent has asserted several fact-intensive affirmative defenses, including acquired distinctiveness, which further confirms that summary judgment is inappropriate at this time. Respondent is entitled to prove its affirmative defenses during its testimony period. Therefore, Respondent respectfully requests the Board to deny Petitioner’s Motion for Summary Judgment.

I. STATEMENT OF FACTS

Respondent, Lincoln, owns a federal service mark registration covering the mark “FLASHBACK FRIDAY” for use in connection with an “online journal, namely, text and graphic works featuring information in the field of welding” (U.S.P.T.O. Reg. No. 4,562,560). The registration issued on July 8, 2014 and is in full force and effect. A mark registered on the Principal Register is presumed to be valid. 15 U.S.C. §§ 1057(b), 1115(a).

Lincoln has extensively used the FLASHBACK FRIDAY mark in promoting its welding and cutting equipment. Its use of the FLASHBACK FRIDAY mark has been an integral piece of Lincoln’s marketing activities. Moreover, Lincoln has taken steps to protect and enforce its FLASHBACK FRIDAY mark in the welding industry. For example, as noted in Petitioner’s Motion, Lincoln was forced to challenge Petitioner, ESAB, based on its infringing use of the FLASHBACK FRIDAY mark in connection with its directly-competing welding goods. Lincoln provided ESAB with timely notice of the infringing use of its federally registered FLASHBACK FRIDAY service mark on April 27, 2016 and demanded that ESAB cease and desist. (*See* Dkt. #6 ¶44). On May 2, 2016, Petitioner filed its Petition to Cancel Respondent’s FLASHBACK FRIDAY trademark (Dkt. #1).¹ Respondent served discovery requests during the discovery period. Rather than responding to Respondent’s discovery requests, Petitioner filed the present Motion for Summary Judgment on descriptiveness grounds (Dkt. #7).

In its Motion, Petitioner provided various allegedly supporting forms of evidence. This evidence primarily consisted of “slang” definitions (Dkt. #7 at p. 10) and various internet references. It also included examples of Petitioner’s infringing use of FLASHBACK FRIDAY (Dkt. #7 at pp. 2-3), and various third-party uses of “Flashback Friday” in wholly-unrelated fields

¹ Respondent acknowledges that the parties are currently engaged in patent litigation (*see* Dkt. #1; Dkt. #7); however, this has no bearing on this proceeding.

from sources bearing no relevance to the welding industry, such as: *People Magazine* (Dkt. #7 at p. 15); *The Huffington Post* (*id.*); an *E-Online* article about pop-culture curiosity Kim Kardashian (*id.* at p. 16); *Entertainment Weekly* (*id.* at 16); and an Official Media Release from the National Basketball Association (*id.*). The exhibits submitted by Petitioner to show third-party uses apply to the following overbroad criteria: “relate to almost anything in the past,” “involve nostalgic, older photographs,” and are posted by “people or businesses.” (Dkt. #7 at p. 9). Petitioner’s analysis is purportedly focused on all Internet subscribers that are on a “social media app such as Instagram or Vine, or on a website like Facebook, Twitter, YouTube, Tumblr, Reddit, etc.” (Dkt. #7 at p. 10). With the exception of Respondent’s trademark use of FLASHBACK FRIDAY and Petitioner’s infringing use, nothing in Petitioner’s Motion even remotely relates to the welding industry identified in Respondent’s challenged registration.

II. BURDEN OF PROOF

Petitioner has failed to meet its burden of proof to succeed on summary judgment. A mark registered on the Principal Register is presumed to be valid. 15 U.S.C. §§ 1057(b), 1115(a). As noted by the Federal Circuit, “[d]ue to this presumption of validity, the burden of persuasion in a cancellation proceeding rests on the party seeking to cancel the registration.” *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 92 U.S.P.Q.2d 1626, 1628 (Fed. Cir. 2009). The court clarified that, “[a] party seeking to cancel a registration must overcome the registration’s presumption of validity by a preponderance of the evidence.” *Id.* Petitioner has failed to do so.

As explained below, genuine issues of material fact preclude summary judgment on Petitioner’s descriptiveness claim. Moreover, Respondent has pleaded acquired distinctiveness under Section 2(f) as an affirmative defense. It is a fundamental principle of trademark law that an allegedly merely descriptive mark is entitled to registration if the trademark owner can prove

that the mark has acquired distinctiveness. *Cold War Museum*, 92 U.S.P.Q.2d at 1358. At this stage of the proceedings, Petitioner has not overcome the presumption of validity, and Respondent has not had an opportunity to present its evidence of acquired distinctiveness. As a result, Petitioner’s Motion is untimely and must be denied.

III. THE EVIDENCE OF RECORD IS INADEQUATE AND SUMMARY JUDGMENT IS INAPPROPRIATE.

A genuine dispute as to a material fact “is shown to exist if sufficient evidence is presented such that a reasonable fact finder could decide the question in favor of the nonmoving party.” *Opryland USA Inc. v. The Great Am. Music Show, Inc.*, 23 U.S.P.Q.2d 1471, 1472 (Fed. Cir. 1992). At this stage of the proceedings, there has been no written discovery, no document production, and no testimony. The only “evidence” is various internet materials presented by Petitioner in its moving papers. This meager “record,” containing nothing from the wedding industry—other than Respondent’s trademark use and Petitioner’s infringing use—does not establish that there are no genuine issues of material fact. Petitioner has not met its burden.

A. Whether a Mark is Merely Descriptive is a Fact-Intensive Inquiry.

A determination of mere descriptiveness on summary judgment is inappropriate. As the Board has held, “[t]he determination that a mark is merely descriptive is a finding of fact and must be based upon substantial evidence.” *Fextel Inc. v. Avatar Technologies Inc.*, Opp. No. 91/220,616, 2016 BL 167598, at *3 (T.T.A.B. April 27, 2016) (dismissing opposition because the evidence of record was insufficient to show that the mark was merely descriptive) (not precedential) (citing *In re Bayer Aktiengesellschaft*, 82 U.S.P.Q.2d 1828, 1831 (Fed. Cir. 2007)). In the present case, the Board should decline to enter summary judgment because there are genuine issues of material fact as to the descriptiveness of Respondent’s FLASHBACK FRIDAY mark. There are also factual issues as to whether the mark has acquired

distinctiveness. “[W]here the absence of a genuine issue of material fact is not clearly established,” summary judgment is inappropriate. *Consolidated Foods Corporation v. Big Red, Inc.*, 226 U.S.P.Q. 829, 834 (T.T.A.B. 1985) (finding the evidence “predicated on mere descriptiveness or a mark...would not entitle applicant to a judgment as a matter of law, [thus] the motion for summary judgment is unfounded”); *see also The Target Man LLC, & Spartan Armor Sys., LLC v. Armored Republic LLC*, Cancellation No. 92/058,599, 2015 WL 9906650, at *4 (T.T.A.B. May 13, 2015) (denying summary judgment on descriptiveness grounds) (not precedential).

It is clear that a mark’s classification as suggestive, descriptive, or otherwise, is “a factual issue” and cannot be resolved on summary judgment. *Xtreme Lashes, LLC v. Xtended Beauty, Inc.*, 576 F.3d 221, 227 (5th. Cir. 2009) (denying summary judgment based on factual issue as to whether mark was descriptive or suggestive); *see also Baroness Small Estates, Inc. v. American Wine Trade, Inc.*, Cancellation 92/051,369, 2011 WL 901977, at *3 (T.T.A.B. March 1, 2011) (dismissing petition to cancel mark and denying summary judgment based on genuine disputes of material fact for descriptiveness) (not precedential); *Anderson Consulting, L.L.P. v. Graj & Gustavsen, Inc.*, Cancellation No. 92/028,806, 2003 WL 21301456 (T.T.A.B. June 4, 2003) (denying summary judgment based on genuine disputes of material fact on the issue of descriptiveness) (not precedential). Summary judgment is inappropriate.

B. Petitioner Has Failed to Establish that Respondent’s Mark is Merely Descriptive as a Matter of Law

“The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used.” *In re Jose Remacle*, 66 U.S.P.Q.2d 1222, 1224 (T.T.A.B. 2002). “Further, it is well-established that the

determination of mere descriptiveness *must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought*, the context in which the mark is used or is intended to be used, and the impact that it is likely to make on the average purchaser of such goods or services.” *Id.* (emphasis added). In *In re Remacle*, the Board reversed an Examiner’s refusal to register because it “cannot conclude that [the mark] is merely descriptive in connection with the identified goods and services. There is little evidence in this record that is clearly relevant to applicant’s identified goods and services.” *Id.* at 1224. Petitioner’s “evidence” suffers a similar deficiency. Petitioner repeatedly and incorrectly analyzes the alleged claim of mere descriptiveness of FLASHBACK FRIDAY in the abstract, i.e. as it relates to “social media, to refer to the posting of old photos, frequently for nostalgic purposes.” (Dkt. #7 at p. 19). Petitioner *does not* properly assess the issue of mere descriptiveness in relation to the welding-related services covered by the registration. In fact, Petitioner has presented *no evidence* that the mark is descriptive with respect to the identified services, namely journals in the welding field.

Importantly, as stated above, Petitioner has the burden of overcoming the presumption of validity of Respondent’s federally registered FLASHBACK FRIDAY trademark. It has failed to do so. Respondent’s mark, FLASHBACK FRIDAY, is valid and inherently distinctive as applied to the services identified in Reg. No. 4,562,560, namely, an “online journal, namely, text and graphic works featuring information in the field of welding.” First, the term “flashback,” on its face, as defined by Petitioner, in no way describes online informational services in the field of welding. Second, although Respondent has used the mark on Fridays, Respondent has explained and established in its response to an Office Action that its FLASHBACK FRIDAY content is available *every day of the week*. See Response to Office Action, filed January 13, 2014 at p. 4.

Furthermore, Respondent disclaimed the exclusive right to use “Friday” apart from the mark as shown. Respondent has used the FLASHBACK FRIDAY mark in its entirety as a source indicator for providing information in the field of welding. “[A] mark sought to be registered must be *considered in its entirety*,” with a view toward “what the purchasing public would think when confronted with the mark as a whole.” *In re Hutchinson Tech. Inc.*, 7 U.S.P.Q.2d 1490, 1492 (Fed. Cir. 1988) (emphasis added).

At the very least, FLASHBACK FRIDAY is *suggestive* of Respondent’s online welding journals. It is suggestive because it “requires imagination, thought and perception to reach a conclusion as to the nature of the goods.” *StonCor Grp., Inc. v. Specialty Coatings, Inc.*, 111 U.S.P.Q.2d 1649, 1652 (Fed. Cir. 2014). The Federal Circuit’s *StonCor* decision is particularly relevant here because, as noted by the court, opposer merely presented evidence of the ARMORSTONE applicant’s advertising, along with dictionary definitions for the words “armor” and “stone.” *Id.* The court observed that “[n]one of [opposer’s] evidence demonstrates that the mark, as a whole, conveys ‘an immediate idea of the ingredients, qualities or characteristics of the products.’” *Id.* at 1333 (affirming Board’s dismissal of opposition on descriptiveness grounds). Petitioner’s Motion for Summary Judgment is based on similarly limited evidence.

Significantly, Petitioner has not addressed the relevant purchasing public. Respondent Lincoln’s consumer base implicated by the recitation of services in the registration (namely, the welding industry) constitutes the relevant “purchasing public.” However, Petitioner incorrectly argues that ordinary consumers using various social media platforms or perusing celebrity gossip websites is the relevant universe, which is a grossly overbroad and incorrect analysis. “The perception of the mark to nonprospective purchasers would be irrelevant, because a mark primarily functions to indicate a single quality control source of the goods or services involved,

and this is meaningful only to prospective purchasers or patrons.” *In re Abcor Dev. Corp.*, 200 U.S.P.Q. 215, 219, n. 15 (C.C.P.A. 1978). Petitioner has presented no evidence establishing that the relevant purchasing public would fail to associate the mark with its single source. As Respondent will establish in connection with its acquired distinctiveness affirmative defense, Lincoln has historically been the sole user of FLASHBACK FRIDAY in the welding industry—until Petitioner’s infringement. However, this substantial exclusivity is an issue of material fact that cannot be resolved on summary judgment. “A trademark is a trademark only if it is used in trade. When it is used in trade it must have some impact upon the purchasing public, and it is that impact or impression which should be evaluated in determining whether or not the primary significance of a word when applied to a product is significant[t].” *In re Hutchinson Tech. Inc.*, 7 U.S.P.Q.2d 1490, 1492 (Fed. Cir. 1988) (quoting *Application of Kahan & Weisz Jewelry Mfg. Corp.*, 184 U.S.P.Q 421, 422 (C.C.P.A. 1975)). Although Petitioner argues that FLASHBACK FRIDAY has been used in the broad context of the Internet, this fact alone does not determine whether the mark is merely descriptive as it relates to Respondent’s services. Rather, when Respondent uses FLASHBACK FRIDAY, the impact on the relevant consuming public (the welding industry) is an association with Lincoln and its welding goods and services.

IV. RESPONDENT’S AFFIRMATIVE DEFENSES PRECLUDE SUMMARY JUDGMENT.

In its Answer to the Petition for Cancellation, Respondent pleaded three affirmative defenses: acquired distinctiveness, laches, and unclean hands. *See* Dkt. 6, ¶¶ 42, 43, 44. An affirmative defense is “[a] defendant’s assertion raising new facts and arguments that, if true, will defeat the plaintiff’s or prosecution’s claim, even if all allegations in the complaint are true.” *H.D. Lee Co. v. Maidenform Inc.*, 87 U.S.P.Q.2d 1715, 1720 (T.T.A.B. 2008) (citing

Black's Law Dictionary, p. 430 (7th ed. 1999)). Each raises genuine issues of material fact that preclude summary judgment.

A. Acquired Distinctiveness

Although Respondent denies that its mark is merely descriptive, Respondent has alleged, in the alternative, that its mark has acquired distinctiveness through Respondent's extensive use and promotion of the mark in commerce. (Dkt. #6, ¶42). As Respondent alleged in its Affirmative Defenses, "Respondent's mark has acquired distinctiveness through Respondent's extensive use and promotion of the mark in commerce." (Dkt. #6, ¶42). "It is well-established that a descriptive mark can be registered if it has acquired secondary meaning." *Coach Servs., Inc. v. Triumph Learning LLC*, 101 U.S.P.Q.2d 1713, 1729 (Fed. Cir. 2012).

A determination of acquired distinctiveness is a highly fact-intensive inquiry. *Neapco Inc. v. Dana Corp.*, 12 U.S.P.Q.2d 1746 (T.T.A.B. 1989); *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 6 U.S.P.Q.2d 1001, 1008 (Fed. Cir. 1988) ("The issue of acquired distinctiveness is a question of fact."). In *Neapco*, the petitioner sought summary judgment in a cancellation proceeding on the grounds that registrant's registered mark (5-280X), at the time of registration, was merely descriptive. *Neapco*, 12 U.S.P.Q.2d at 1746. The Board denied petitioner's motion for summary judgment on the issue of mere descriptiveness *and* lack of secondary meaning "because a genuine dispute as to material facts" existed. *Id.* Similarly, there is a genuine dispute as to material facts in this case. The mark is not registered or used merely for general information associated with pop culture, unlike the various third-party use evidence presented by Petitioner. Instead, Respondent uses FLASHBACK FRIDAY specifically as a source indicator for Lincoln and its services and goods within the welding industry. The only evidence on the record regarding acquired distinctiveness favors Respondent. This evidence shows that

FLASHBACK FRIDAY is not used merely to describe a single instance of nostalgia through an old photograph (*see* Dkt. #7 at p. 19), but rather, that Lincoln has used FLASHBACK FRIDAY *recurrently* since 2012 as a source indicator for providing text and graphic information in the field of welding. Respondent Lincoln's use is available to the public *every day of the week*. Regardless, Respondent is not required to prove its acquired distinctiveness claim at this stage, where there has been no discovery, no testimony, and no evidence. It is entitled to do so at trial. Thus, Petitioner's Motion for Summary Judgment is, at the very least, premature and must be denied.

B. Laches

Respondent also pleaded laches as an affirmative defense. Specifically, Respondent pleaded, "Petitioner's claims are barred by the doctrine of laches. Petitioner unduly and unreasonably delayed in asserting its claims, and Respondent has been prejudiced by this delay." (Dkt. #6 ¶43). Respondent has used the FLASHBACK FRIDAY mark in connection with the welding industry for over four years, dating back to May 2012. The registration issued on July 8, 2014. Petitioner filed its Petition to Cancel over two years later, on May 2, 2016. Throughout this time, Respondent has made continuous, consistent and substantially exclusive use of the FLASHBACK FRIDAY mark in connection with goods and services in the welding industry. Lincoln has invested significant advertising expenditures and has inured a great amount of goodwill in its mark. (Dkt. #6, ¶43). By statute, the defense of laches is available in trademark proceedings. *See* 15 U.S.C. § 1069. The Board recognizes laches as an affirmative defense in cancellation proceedings. *See Teledyne Technologies, Inc. v. Western Skyways, Inc.*, Cancellation No. 92041265, 78 U.S.P.Q.2d 1203, 1211-12 (T.T.A.B. 2006) (denying petition for cancellation; "the essential inquiry herein is to determine if there was a change in the economic

position of respondent during the period of petitioner's delay.") Like acquired distinctiveness, laches is a fact-intensive inquiry. *Id.* (finding that respondent established a laches defense based on a strong evidentiary record).

C. Unclean Hands

Respondent also alleged unclean hands as an affirmative defense. "Petitioner's claims are barred by the doctrine of unclean hands." (Dkt. #6, ¶44). "The doctrine of 'unclean hands' imposes upon a complainant the burden of showing not only that he has a good and meritorious cause of action, but that he comes into court with clean hands." *Hitachi Metals International, Ltd. v. Yamakyu Chain Kabushiki Kaisha*, 209 U.S.P.Q. 1057, 1065-66 (T.T.A.B. 1981).

Respondent articulated its unclean hands affirmative defense in its Answer and Affirmative Defenses. As alleged therein, Petitioner's claims are barred by the doctrine of unclean hands because Petitioner, a direct competitor in the welding and cutting industry, has engaged in a pattern of infringing Respondent's federally-registered trademarks, including the FLASHBACK FRIDAY mark at issue in this proceeding. Petitioner conducted its infringing activity through social media postings on Facebook, Twitter, and Google under FLASHBACK FRIDAY or confusingly similar marks intended to deceive and confuse consumers, and to divert consumers into visiting Petitioner's social media pages and websites. Respondent learned of Petitioner's unlawful actions and sent a letter in a timely manner, dated April 27, 2016, in order to protect its federally registered trademark, demanding that Petitioner cease and desist. Five days later, on May 2, 2016, in response and retaliation, Petitioner sought, in bad faith, to cancel Respondent's asserted FLASHBACK FRIDAY trademark. (Dkt. #6 ¶44). Unclean hands is available as an affirmative defense in Board proceedings. *See* Trademark Rule 2.106(b)(1). If

proven, unclean hands would defeat Petitioner's cancellation claim. *H.D. Lee Co.*, 87 U.S.P.Q.2d at 1720. As a result, summary judgment is improper at this stage of the proceedings.

V. Petitioner's Summary Judgment Motion is Premature .

At the very least, summary judgment is premature because there is no record, and the parties have not completed discovery. Respondent served its First Set of Interrogatories, First Set of Requests for Admission and First Set of Requests for Production to Petitioner on October 10, 2016. *See* Declaration of Anisha A. Mehta ("Mehta Decl."), submitted herewith (attaching Respondent's discovery requests as Exhibits A, B, and C).² Respondent has not received Petitioner's responses to the discovery requests, which is necessary in order to properly address the factual issues inherent in this cancellation action, such as descriptiveness and acquired distinctiveness.

For example, Respondent has requested Petitioner to "[i]dentify and describe the factual basis for Petitioner's claim that Respondent's Mark is merely descriptive with respect to the services identified in U.S.P.T.O. Reg. No. 4,562,560." *See* Mehta Decl. at Exhibit A, at #1. Petitioner did not provide a response to this request.

Respondent has also requested that Petitioner admit that it is unaware of any third-party uses of FLASHBACK FRIDAY in connection with goods or services in the welding industry and that it was aware of Respondent's prior use of FLASHBACK FRIDAY in connection with goods or services in the welding industry. *See* Mehta Decl. at Exhibit B, at ##1-2. Respondent further requested admission that Petitioner is unaware of any market research or consumer surveys concerning the mark or consumer perception of the mark. *See id.* at ##3-4. Petitioner did not provide responses to these requests.

² This Declaration is made in support of Respondent's Opposition to Petitioner's Motion for Summary Judgment as well as Respondent's Motion to Request Discovery Pursuant to Fed. R. Civ. P. 56(d), filed concurrently herewith.

Furthermore, Respondent has requested that Petitioner produce documents relating to Petitioner's use of FLASHBACK FRIDAY, including use on social media; Petitioner's selection or adoption of FLASHBACK FRIDAY, including use on social media and trademark searches; when Petitioner first became aware of Respondent's Mark and the circumstances relating to Petitioner's first knowledge of Respondent's Mark; when Petitioner first used its mark; and Petitioner's support for and contradictions to the argument that Respondent's Mark is merely descriptive, among other requests. *See* Mehta Decl. at Exhibit C, at ##1-4, 6, 13-14. Equally important, Respondent served multiple document requests relating to third-party use (or lack thereof) of FLASHBACK FRIDAY in the welding industry. *See id.* at ##7-8. Petitioner has not provided responses to these requests.

As outlined above, the issue of descriptiveness is highly fact-intensive. Petitioner's responses to Respondent's Interrogatories, Requests for Admission and Requests for Production are necessary in order to aid in this factual assessment as well as in responding to the arguments made in Petitioner's Motion. Concurrently with this Opposition, Respondent has filed a Motion to Request Discovery Pursuant to Fed. R. Civ. P. 56(d) in response to Petitioner's Motion for Summary Judgment due to the unavailability of material facts necessary to further support Respondent's Opposition.

VI. PETITIONER'S AUTHORITIES ARE INAPPLICABLE AND READILY DISTINGUISHABLE.

Most notably, Petitioner's Motion does not cite *any* cases where mere descriptiveness was determined on a motion for summary judgment.³ While it is possible that such a case exists,

³ Petitioner cites to *Hewlett-Packard Dev. Co. v. Vudu Inc.*, 92 U.S.P.Q.2d 1630 (T.T.A.B. 2009) and *Texas Dep't of Transp. v. Tucker*, 95 U.S.P.Q.2d 1241 (T.T.A.B. 2010) to establish the standard for summary judgment; however, both of these cases were based on the issues of priority and likelihood of confusion. Furthermore, unlike the instant dispute, the Petitioner's cited authorities involved ample undisputed factual evidence for the Board to make determinations solely as a matter of law.

it would be rare for the Board to grant summary judgment on descriptiveness grounds, particularly: (a) prior to discovery; and (b) where the defendant alleges acquired distinctiveness as an affirmative defense. In fact, a Federal Circuit case cited by Petitioner (Dkt. #7 at p. 8), *DuoProSS Meditech Corp. v. Inviro Med. Devices Ltd.*, 103 U.S.P.Q.2d 1753 (Fed. Cir. 2012), confirms Respondent’s primary argument: “The determination of whether a mark is merely descriptive is a question of fact.” *Id.* at 1755-56.

While largely ignoring its “no genuine issue of material fact” problem in connection with its fact-intensive descriptiveness claim, Petitioner attempts to address another significant shortcoming in its Motion by burying it in a footnote. In footnote 4, p. 20, Petitioner argues that Respondent’s claim that its mark is not merely descriptive is akin to arguing that “BLOG” would not be merely descriptive in connection with a blog in a particular field. (Dkt. #7 at p. 20, n.4.) This argument is misplaced. There is no doubt that BLOG is *generic* with respect to a blog. Thus, it bears little relevance to the question of whether FLASHBACK FRIDAY is *merely descriptive* in connection with online welding journals. Moreover, as a generic term, BLOG would not be registrable, even with a showing of acquired distinctiveness. In contrast, FLASHBACK FRIDAY, as a purportedly “merely descriptive” phrase per Petitioner’s Motion, is registrable if Respondent proves its acquired distinctiveness affirmative defense. Petitioner’s citation to *In re Fat Boys Water Sports LLC*, 118 U.S.P.Q.2d 1511 (T.T.A.B. 2016), as support within that footnote, is similarly inapplicable. In that case, the applicant seeking to register HOUSEBOAT BLOB for inflatable float mattresses acknowledged that the term “BLOB” was generic, and the evidence established that applicant marketed the product for use in connection with “HOUSEBOATS.” *Id.* at 1515-16. Here, Respondent has registered and used FLASHBACK FRIDAY in connection with online welding journals. FLASHBACK FRIDAY is

not merely descriptive with respect to those goods. Petitioner's arguments neglect a basic tenet of trademark law: the mark must be considered in connection with the applicable goods or services. For example, "APPLE" is descriptive of fruit retail services, but not computers. There are genuine issues of material fact as to whether FLASHBACK FRIDAY is merely descriptive of online welding journals.

Even if Petitioner provided adequate evidence to support its argument of mere descriptiveness, which Respondent disputes, it fails to address the issue of acquired distinctiveness. This assessment is required for resolution upon a summary judgment motion in the present case because Respondent alleged acquired distinctiveness as an affirmative defense. *See Yamaha Int'l Corp.*, 6 U.S.P.Q.2d at 1005-06; *see also Neapco*, 12 U.S.P.Q.2d at 1747 (denying summary judgment). In fact, *Neapco* acknowledged that "as the registrant makes more use of its mark with the passage of time, it is likely that secondary meaning will only increase, not decrease." *Id.* at 1747. It is clear that the Board encourages parties to provide substantial factual evidence in order to assess the merits of secondary meaning. This has yet to be fleshed out by the parties at this stage of the proceedings.

Petitioner also relies on *Coach/braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 U.S.P.Q.2d 1458 (T.T.A.B. Mar. 24, 2014) as precedent for using third-party sources to assess the perception of the purchasing public with regard to descriptiveness. (Dkt. #7 at p. 9). However, the Board in *Coach/braunsdorf Affinity* confirmed that it is necessary to properly identify the relevant consuming public "on the basis of the services as set forth in the registrations." *Coach/braunsdorf*, 110 U.S.P.Q.2d at 1463. Here, Petitioner is not following suit. Petitioner completely ignores the "welding" industry identified in the registration and instead

focuses on what it believes to be the general public's perception of FLASHBACK FRIDAY.
This fails to recognize that the proper universe is the welding industry, not the general public.

VII. CONCLUSION

For the aforementioned reasons, Respondent respectfully requests the Board to deny
Petitioner's Motion for Summary Judgment.

Respectfully Submitted,

Dated: December 9, 2016

By: /s/ Thomas M. Williams
Thomas M. Williams
Ulmer & Berne LLP
500 West Madison St., Suite 3600
Chicago, IL 60661
Telephone (312) 658-6556
Facsimile (312) 658-6557
twilliams@ulmer.com
Attorney for Respondent Lincoln Global, Inc.

CERTIFICATE OF SERVICE

I hereby certify that I served a true and correct copy of the following **RESPONDENT'S OPPOSITION TO PETITIONER'S MOTION FOR SUMMARY JUDGMENT** upon Petitioner's counsel via electronic mail, per the agreement of the parties, on December 9, 2016, addressed as follows:

Michael E. Hall
Kacvinsky Daisak Bluni PLLC
3120 Princeton Pike, Suite 303
Lawrenceville, New Jersey 08648
mhall@kdbfirm.com

/s/ Thomas M. Williams
Thomas M. Williams