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

Proceeding	92063649
Party	Plaintiff The ESAB Group, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

The ESAB Group, Inc., Petitioner,)	
)	
v.)	Cancellation No. 92063649
)	Mark: FLASHBACK FRIDAY
Lincoln Global, Inc.)	Registration No. 4562560
Respondent.)	
)	

Attorney Ref.: 1800TCE3540

**PETITIONER’S REPLY BRIEF IN SUPPORT OF ITS
MOTION FOR SUMMARY JUDGMENT**

Petitioner respectfully submits this reply brief in support of Petitioner’s motion that summary judgment be granted on the descriptiveness ground and that Respondent’s registration be cancelled.

I. Summary Judgment May Be Granted on Descriptiveness Ground

As an initial matter, Respondent makes several categorical statements to the effect that summary judgment simply cannot be granted where the ground is descriptiveness. For example, Respondent makes the following assertions:

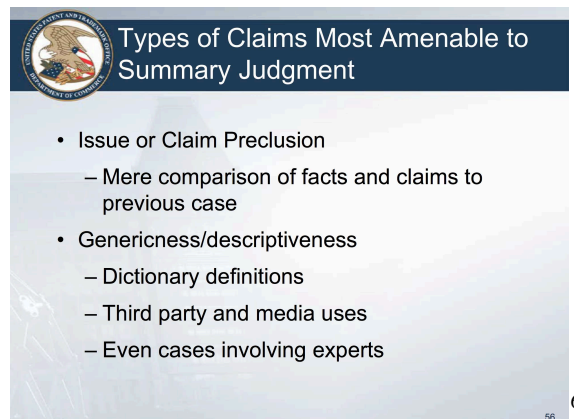
- “Petitioner’s Motion must be denied because the asserted ground, mere descriptiveness, involves an inherently fact-intensive analysis.”¹
- “A determination of mere descriptiveness on summary judgment is inappropriate.”²
- “It is clear that a mark’s classification as suggestive, descriptive, or otherwise, is ‘a factual issue’ and cannot be resolved on summary judgment.”³

¹ Respondent’s Brief at 1.
² Respondent’s Brief at 4.

Appearing to soften slightly on its categorical position, Respondent later argues:

Most notably, Petitioner’s Motion does not cite *any* cases where mere descriptiveness was determined on a motion for summary judgment. While it is possible that such a case exists, 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.⁴

Petitioner’s motion did not cite any cases in which summary judgment was granted on descriptiveness grounds because the point is uncontroversial. Suffice it to say, the Board does indeed grant summary judgment on descriptiveness grounds where Rule 56 is satisfied.⁵ Indeed, on February 13, 2014, Judges Adlin and Goodman from the Board participated in a webinar hosted by the American Bar Association, which was titled *TTAB Tips: Motions for Summary Judgment*. The Board’s presentation listed descriptiveness among the types of claims most amenable to summary judgment:



³ Respondent’s Brief at 5.

⁴ Respondent’s Brief at 13-14.

⁵ See, e.g., *The Loglan Institute Inc. v. The Logical Language Group Inc.*, 22 U.S.P.Q.2d 1531 (Fed. Cir. 1992) (affirming Board’s granting of summary judgment to cancellation petitioner on ground of genericness, which is the ultimate in descriptiveness); *Callaway Vineyard & Winery v. Endsley Capital Group Inc.*, 63 U.S.P.Q.2d 1919 (T.T.A.B. 2002) (granting summary judgment to opposer on descriptiveness ground); *Oxy Metal Indus. Corp. v. Technic, Inc.*, 191 U.S.P.Q. 50 (T.T.A.B. 1976) (granting summary judgment to opposer on descriptiveness ground); *NJoy Spirits, LLC v. Frank Lin Distillers Prods., Ltd.*, Cancellation No. 92060288 (T.T.A.B. February 5, 2016) (non-precedential) (granting summary judgment to cancellation petitioner on descriptiveness ground).

⁶ See slide 56 at http://www.ipo.org/wp-content/uploads/2014/03/allfiles_bo3_32114.pdf.

II. Petitioner Will Address Respondent’s Rule 56(d) Motion in a Separate Brief Filed in Response to that Motion

Respondent claims that Petitioner’s motion for summary judgment is “premature”⁷ and moved, separately, for discovery under Rule 56(d). Petitioner is filing its brief in opposition to that motion concurrently herewith. In this reply brief, Petitioner simply notes that a motion for summary judgment is not premature merely because no discovery has been taken. *See Paris Glove of Canada Ltd. v. SBC/Sporto Corp.*, 84 U.S.P.Q.2d 1856, 1860 (T.T.A.B. 2007) (“Contrary to petitioner’s contention, respondent’s motion for summary judgment is not premature because it was filed before any discovery commenced.”).

III. Petitioner Has Met Its Burden: There Is No Genuine Dispute as to Any Material Fact and Petitioner Is Entitled to Judgment as a Matter of Law

Petitioner will not regurgitate all the evidence attached to its motion for summary judgment bearing on the public’s use and understanding of “Flashback Friday” or “FlashbackFriday” or the hashtags “#FlashbackFriday” or “#flashbackfriday”. The evidence comes from a variety of sources, including but not limited to ABC News, *People*, Fox Sports, the NBA, *The Atlanta Journal-Constitution*, *The New York Times*, the University of Cincinnati, the *Pittsburgh Tribune-Review*, and many others. Briefly stated, this evidence demonstrates that a Flashback Friday is an online posting of content (including on social media) looking back in time, such as a nostalgic photo with or without an accompanying story, on Friday and tagged with “Flashback Friday” or “FlashbackFriday” or the hashtags “#FlashbackFriday” or “#flashbackfriday”. Moreover, as shown by the evidence, it is done without explanation of the term because the audience

⁷ Respondent’s Brief at 12.

is assumed to understand it. To give but one example from Petitioner’s evidence,⁸ below is a tweet from Google on Friday, October 7, 2016:



In fact, Respondent has admitted (Answer ¶ 26) that it has used “Flashback Friday®” and “#flashbackfriday” in the same Twitter post, as shown below:



Tellingly, although Petitioner pointed out in its motion Respondent’s various uses of “#flashbackfriday” in connection with its services, Respondent’s brief does not address this. In short, there is no *genuine* dispute as to any material fact, as required by Rule 56, and the evidence leaves no room to doubt that FLASHBACK FRIDAY merely describes Respondent’s services.

Respondent’s only substantive argument is that Petitioner’s third-party use – again, Respondent’s brief ignores its own use of “#flashbackfriday” – does not relate to the services in Respondent’s registration: “online journal, namely, text and graphic works featuring information in the field of welding.” For example, Respondent argues that

⁸ See Exhibit 12 attached to Petitioner’s motion for summary judgment.

“Petitioner *does not* properly assess the issue of mere descriptiveness in relation to the welding-related services covered by the registration.”⁹

Respondent’s argument is specious. Applicant’s services are providing online text and graphic works, and welding is merely the field or subject matter of those services. Thus, the third-party evidence *does* relate to Respondent’s services of providing online text and graphic works, and the evidence shows that “Flashback Friday” is a particular manner of presenting online text and graphic works. The third-party evidence attached to Petitioner’s motion is compelling on this point, but if there were any doubt at all, Respondent’s own use makes it crystal clear that the mark is (at least) merely descriptive of Respondent’s services. The fact that FLASHBACK FRIDAY does not describe any particular subject matter – whether welding, cooking, or origami – is irrelevant to whether the term is merely descriptive.¹⁰ In view of the established meaning of “Flashback Friday” and Respondent’s own use of “#flashbackfriday”, anyone viewing Respondent’s use of FLASHBACK FRIDAY would immediately understand that Respondent’s text and graphic works are presented as a Flashback Friday.

IV. Respondent Has Not Pointed to Any Material Fact Allegedly in Dispute

Respondent argues that, “As explained below, genuine issues of material fact preclude summary judgment on Petitioner’s descriptiveness claim.”¹¹ And further:

The only “evidence” is various internet materials presented by Petitioner in its moving papers. The meager “record,” containing nothing from the welding industry – other than Respondent’s trademark use and Petitioner’s

⁹ Respondent’s Brief at 6.

¹⁰ *See, e.g., In re Pennzoil Prods. Co.*, 20 U.S.P.Q.2d 1753, 1755 (T.T.A.B. 1991) (“It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them.”).

¹¹ Respondent’s Brief at 3.

infringing use – does not establish that there are no genuine issues of material fact.¹²

However, Respondent points to no material facts that it actually disputes.

V. Respondent’s Affirmative Defense of Acquired Distinctiveness

Respondent complains that Petitioner’s motion for summary judgment “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.”¹³ However, the fundamental problem with Respondent’s position is that, as an affirmative defense, *Respondent* is the party that bears the burden of proof on acquired distinctiveness. The Supreme Court has made clear that “where the nonmoving party will bear the burden of proof at trial on a dispositive issue,” the nonmoving party must “go beyond the pleadings and by her own affidavits [or other evidence] designate ‘specific facts showing that there is a genuine issue for trial.’” *Celotex Corp. v. Catrett*, 477 U.S. 317, 324 (1986). “While the non-moving party is not required to present its entire case in response to a motion for summary judgment, to defeat the motion the non-movant must present sufficient evidence to show an evidentiary conflict as to the material fact in dispute.” *Opryland USA Inc. v. The Great Am. Music Show Inc.*, 23 U.S.P.Q.2d 1471, 1472-73 (Fed. Cir. 1992). In other words, “a party opposing a motion for summary judgment cannot merely rely upon the allegations of its pleadings and hold back its evidence.” 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 20:132 (4th ed. 2016).

In this case, Respondent submitted *no evidence at all* to support its affirmative defense, and as *Celotex* and the other authorities cited above make clear, it was

¹² Respondent’s Brief at 4.

¹³ Respondent’s Brief at 15.

Respondent's burden to produce evidence, if it could, in support of its affirmative defense.¹⁴ Thus, Respondent's position that it should have the opportunity to prove its affirmative defense later at trial misses the point entirely.

It is worth noting that Respondent's "Statement of Facts" contains assertions by Respondent's attorney going to acquired distinctiveness. For instance, counsel asserts that "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."¹⁵ Respondent cites to no part of the record to support these statements and indeed nothing in the record does support these statements. Though counsel's assertions appear under the heading "Statement of Facts,"

¹⁴ See also *Midwest Oilseeds, Inc. v. Limagrain Genetics Corp.*, 387 F.3d 705, 714 (8th Cir. 2004) ("The specificity requirement of Rule 56 applies with equal force where the defendant resists summary judgment, especially where the defendant resists by asserting affirmative defenses which it has a burden to prove. As the party resisting summary judgment in this case, then, [defendant] had an affirmative burden to identify specific facts in the record showing its defenses raised a triable issue . . ."), *cert. denied*, 544 U.S. 977 (2005); *Residential Funding Co., LLC v. Terrace Mortgage Co.*, 850 F.Supp.2d 961, 964-65 (D.Minn. 2012) ("Where the non-movant has alleged affirmative defenses but has not based any summary judgment motion of its own on such defenses, it nevertheless must still 'come forward with evidence to support [its] affirmative defenses' in its opposition to the movant's motion. . . . The mere fact that a defendant has alleged affirmative defenses in its answer is not enough to preclude a plaintiff's motion for summary judgment. . . . Because the moving plaintiff need not disprove the non-movant's affirmative defenses, the 'defendant must *support* its affirmative defenses in the response to a plaintiff's motion for summary judgment.") (citations omitted); *Frankel v. ICD Holdings S.A.*, 930 F.Supp. 54, 64-65 (S.D.N.Y. 1996) ("The fact that [defendants] are entitled to raise a fraud defense . . . does not mean that they have done so in a manner sufficient to defeat plaintiffs' motion for summary judgment. . . . [The language of Rule 56] necessarily means that one who relies upon an affirmative defense to defeat an otherwise meritorious motion for summary judgment must adduce evidence which, viewed in the light most favorable to and drawing all reasonable inferences in favor of the non-moving party, would permit judgment for the non-moving party on the basis of that defense. Not surprisingly, cases decided since *Celotex Corp.* have so held."), *motion for reargument and relief from judgment denied*, 939 F.Supp. 1124 (S.D.N.Y. 1996); *Harper v. Delaware Valley Broadcasters, Inc.*, 743 F.Supp. 1076, 1090-91 (D.Del. 1990) ("A party resisting summary judgment cannot expect to rely on the bare assertions or mere cataloguing of affirmative defenses. The requirement of pointing to specific facts to defeat a summary judgment motion is especially strong when the nonmoving party would bear the burden of proof at trial, as these defendants would on the affirmative defenses they plead. . . . [D]efendants were seeking to defeat plaintiff's summary judgment motion. It is in that context that defendants should have come forward with evidence to support their affirmative defenses. At trial, defendants would bear the burden of proof regarding their affirmative defenses. Even viewing the record in the light most favorable to defendants, they have failed to meet their burden on summary judgment.") (citations omitted), *aff'd without opinion*, 932 F.2d 959 (3d Cir. 1991).

¹⁵ Respondent's Brief at 2.

they are not evidence sufficient to preclude summary judgment.¹⁶ In another portion of Respondent’s brief, Respondent argues (all emphasis in original):

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*.¹⁷

Respondent cites to no part of the record to substantiate its claim that it has used its mark continuously since 2012,¹⁸ and, again, the record does not support that assertion. If Respondent is attempting to rely on the date of first use claimed in its registration – May 18, 2012 – it may not do so because “[t]he allegation in an application for registration, or in a registration, of a date of first use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence.”

Trademark Rule 2.122(b)(2).

Respondent’s arguments in support of its affirmative defense of acquired distinctiveness are just that: arguments. For example, in *Consolidated Foods Corp. v. Big Red, Inc.*, 226 U.S.P.Q. 829 (T.T.A.B. 1985), opposer moved for summary judgment on the ground of descriptiveness. In response, the applicant *argued* that the term had

¹⁶ See, e.g., *Enzo Biochem Inc. v. Gen-Probe Inc.*, 76 U.S.P.Q.2d 1616, 1622-23 (Fed. Cir. 2005) (“the court was faced only with [the non-movant’s] arguments and perhaps a suggestion of what [the non-movant] might present at trial; that alone is insufficient to meet its burden of production. Attorney argument is no substitute for evidence.”); *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 222 U.S.P.Q. 741, 743 (Fed. Cir. 1984) (“In countering a motion for summary judgment, more is required than mere assertions of counsel.”).

¹⁷ Respondent’s Brief at 9-10.

¹⁸ Additionally, Respondent’s attempt to distinguish its use from others’ use is self-contradictory because if Respondent’s position is that when it posts on a Friday, that post remains visible “every day of the week,” the same would be true for others’ postings of old photographs.

acquired distinctiveness but the Board pointed out the insufficiency of applicant's mere assertions:

In view [of the burden to produce evidence placed by Rule 56 on the non-movant], and since applicant has not furnished any affidavits or other evidence supportive of its assertion that the designation "BIG RED" has acquired distinctiveness, its argument in this regard cannot be taken as raising a genuine issue of material fact.

Id. at 835 n.19. There is no evidence of record to support Respondent's contention that its mark has acquired distinctiveness, and it was Respondent's burden to produce evidence, if it could, in support of that affirmative defense to avoid summary judgment.

VI. Respondent's Affirmative Defenses of Laches and Unclean Hands

In addition to acquired distinctiveness, Respondent also asserted an affirmative defense of laches and argued that "[t]he Board recognizes laches as an affirmative defense in cancellation proceedings."¹⁹ Although true as a general proposition, however, laches is legally unavailable here because Petitioner seeks to cancel Respondent's registration on the ground of descriptiveness. *See Callaway Vineyard & Winery v. Endsley Capital Group Inc.*, 63 U.S.P.Q.2d 1919, 1923 (T.T.A.B. 2002) ("[W]e find that, as a matter of law, applicant's affirmative defenses are unavailable in this case. The equitable defenses of laches, estoppel, and acquiescence cannot be asserted against a claim of descriptiveness.").

Respondent also asserted an affirmative defense of unclean hands, but it, like laches, should not be available against a claim of descriptiveness. The Board has explained that "it is within the public interest to preclude registration of merely descriptive designations." *Southwire Co. v. Kaiser Aluminum & Chem. Corp.*, 196 U.S.P.Q. 566, 573 (T.T.A.B. 1977). *Southwire* involved the defense of estoppel, but it

¹⁹ Respondent's Brief at 10.

applies with equal force to unclean hands. Although a non-precedential decision, the Board held last year that the affirmative defense of unclean hands is unavailable against other claims that, as with descriptiveness, are grounded in distinctiveness:

Here, Opposers' purported unclean hands would not prevent Opposers from prevailing on the claims that Applicant's marks are deceptive *or deceptively misdescriptive or a surname* because there is a broader public interest at stake, namely preventing the registration of a mark that may deceive the public or which is a surname that should be available for others to use in their businesses.

Creel Abogados, S.C. v. Creel, García-Cuéllar, Aiza y Enríquez, S.C., Opposition No. 91217047 (T.T.A.B. June 22, 2015) (non-precedential) (emphasis added; citations omitted). Accordingly, Petitioner respectfully submits that Respondent's defense of unclean hands is legally unavailable in this proceeding involving descriptiveness.

For the reasons stated above, Petitioner respectfully requests that its motion for summary judgment be granted and that Respondent's registration be cancelled.

Respectfully submitted,

Date: December 23, 2016

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Certificate of Service

I hereby certify that on December 23, 2016, a copy of the foregoing Petitioner's Reply Brief in Support of Its Motion for Summary Judgment was served via email (by agreement) on Respondent's counsel, Thomas M. Williams, at twilliams@ulmer.com.

/Michael E. Hall/