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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: September 13, 2017

Cancellation No. **92063649**

The ESAB Group, Inc.

v.

Lincoln Global, Inc.

Before Lykos, Shaw and Hightower, Administrative Trademark Judges

By the Board:

On May 2, 2016, The ESAB Group, Inc. ("Petitioner") filed a petition to cancel Registration No. 4562560[1] for the standard character mark FLASHBACK FRIDAY on the Principal Register for "online journal, namely, text and graphic works featuring information in the field of welding" in International Class 42 on grounds of genericness and mere descriptiveness. Lincoln Global, Inc. ("Respondent") answered the petition on May 18, 2016 denying the salient allegations and set forth affirmative defenses of acquired distinctiveness, laches and unclean hands.

This matter now comes up on Petitioner's motion (filed on November 9, 2016) for partial summary judgment on its claim of mere descriptiveness. Respondent has contested the motion and has also separately moved for discovery under Fed. R. Civ. P. 56(d).

[1] Registered July 8, 2014.

The Board presumes the parties' familiarity with the issues herein. Therefore, for the sake of efficiency, this order does not summarize the parties' arguments raised in the briefs.

<u>Decision</u>

As a preliminary matter, Respondent's motion for Rule 56(d) discovery is moot in view of its substantive response to Petitioner's motion for summary judgment. *See Bad Boys Bail Bonds, Inc. v. Yowell*, 115 USPQ2d 1925, 1930 (TTAB 2015).

As to Petitioner's motion for summary judgment, such motion is a pretrial device intended to save the time and expense of a full trial when the moving party is able to demonstrate, prior to trial, that there is no genuine dispute of material fact, and that it is entitled to judgment as a matter of law. *See* Fed. R. Civ. P. 56(a); *Celotex Corp. v. Catrett,* 477 U.S. 317 (1986); *Opryland USA Inc. v. Great Am. Music Show Inc.,* 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); and *Sweats Fashions Inc. v. Pannill Knitting Co.,* 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001) (if moving party meets burden of demonstrating absence of genuine issue of material fact, non-moving party must present evidence that one or more material facts is at issue). The evidence must be viewed in a light most favorable to the non-

moving party, and all reasonable inferences are to be drawn in the non-movant's favor. *Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA*, *supra*.

Upon careful consideration of the arguments and evidence presented by the parties, and drawing all inferences with respect to the motion in favor of Respondent as the nonmoving party, we find that Petitioner has failed to demonstrate the absence of a genuine dispute of material fact for trial. At a minimum, a genuine dispute of material fact exists as to the nature of Respondent's services and the descriptiveness of the mark vis-à-vis those services. In view thereof, Petitioner's motion for summary judgment is hereby **DENIED**.[2]

To the extent that Respondent has raised the issue of its affirmative defenses, Petitioner's point that the equitable defenses of laches and unclean hands are unavailable as against a claim of mere descriptiveness is well taken. *See Callaway Vineyard & Winery v. Endsley Capital Group, Inc.*, 63 USPQ2d 1919, 1923 (TTAB 2002). Since the same holds true as against a claim of genericness, *see Loglan Inst., Inc. v. Logical Language Group, Inc.*, 22 USPQ2d 1531, 1534 (Fed. Cir. 1992), these defenses are **STRICKEN** from Respondent's answer.

Proceedings herein are **RESUMED** and dates are **RESET** as follows:

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[2] The parties are reminded 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, e.g., Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

Expert Disclosures Due	**10/16/2017**
Discovery Closes	**11/15/2017**
Plaintiff's Pretrial Disclosures Due	**12/30/2017**
Plaintiff's 30-day Trial Period Ends	**2/13/2018**
Defendant's Pretrial Disclosures Due	**2/28/2018**
Defendant's 30-day Trial Period Ends	**4/14/2018**
Plaintiff's Rebuttal Disclosures Due	**4/29/2018**
Plaintiff's 15-day Rebuttal Period Ends	**5/29/2018**
Plaintiff's Opening Brief Due	**7/28/2018**
Defendant's Brief Due	**8/27/2018**
Plaintiff's Reply Brief Due	**9/11/2018**

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, matters in evidence, the manner and timing of taking testimony, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence.

Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).

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NOTICE: CHANGES TO THE TRADEMARK TRIAL AND APPEAL BOARD ("BOARD") RULES OF PRACTICE (EFFECTIVE JANUARY 14, 2017).

The USPTO published a Notice of Final Rulemaking in the Federal Register on October 7, 2016, at 81 Fed. Reg. 69950. It sets forth **several** amendments to the rules that govern *inter partes* (oppositions, cancellations, concurrent use) and *ex parte* appeal proceedings. A correction to the final rule was published on December 12, 2016, at 81 Fed. Reg. 89382.

For complete information, the parties are referred to:

- The Board's home page on the uspto.gov website: http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab

- The final rule: http://www.uspto.gov/sites/default/files/documents/81%20FR%2069950.pdf

- The correction to the final rule: http://www.uspto.gov/sites/default/files/documents/81%20FR%2089382.pdf

- July 2017 clarification of the final rule: https://www.uspto.gov/sites/default/files/documents/82%20FR%2033804%20%28Final%20rule%29.pdf

- A chart summarizing the affected rules and changes: http://www.uspto.gov/sites/default/files/documents/Chart%20Summarizing%20Rule%20Changes%2012-9-16.pdf

For **all** proceedings, including those **already in progress on January 14, 2017**, some of the changes are:

- All pleadings and submissions must be filed through ESTTA. Trademark Rules 2.101, 2.102, 2.106, 2.111, 2.114, 2.121, 2.123, 2.126, 2.190 and 2.191.
- Service of all papers must be made by email, unless otherwise stipulated. Trademark Rule 2.119.
- Response periods are no longer extended by five days for service by first-class mail, Priority Mail Express®, or overnight courier. Trademark Rule 2.119.
- Deadlines for submissions to the Board that are initiated by a date of service are 20 days. Trademark Rule 2.119. Responses to motions for summary judgment remain 30 days. Similarly, deadlines for responses to discovery requests remain 30 days.

- All discovery requests must be served early enough to allow for responses prior to the close of discovery. Trademark Rule 2.120. Duty to supplement discovery responses will continue after the close of discovery.
- Motions to compel initial disclosures must be filed within 30 days after the deadline for serving initial disclosures. Trademark Rule 2.120.
- Motions to compel discovery, motions to test the sufficiency of responses or objections, and motions for summary judgment must be filed prior to the first pretrial disclosure deadline. Trademark Rules 2.120 and 2.127.
- Requests for production and requests for admission, as well as interrogatories, are each limited to 75. Trademark Rule 2.120.
- Testimony may be submitted in the form of an affidavit or declaration. Trademark Rules 2.121, 2.123 and 2.125.
- New requirements for the submission of trial evidence and deposition transcripts. Trademark Rules 2.122, 2.123, and 2.125.
- For proceedings **filed on or after January 14, 2017**, in addition to the changes set forth above, the Board's notice of institution constitutes service of complaints. Trademark Rules 2.105(a) and 2.113(a).

This is only a summary of the significant content of the Final Rule. All parties involved in or contemplating filing a Board proceeding, regardless of the date of commencement of the proceeding, should read the entire Final Rule.